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Filing date: **07/29/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Chutter, Inc.		
Entity	Corporation	Citizenship	California
Address	9071 Santa Monica Boulevard West Hollywood, CA 90069 UNITED STATES		

Attorney information	Bruce W. Baber King & Spalding LLP 1180 Peachtree Street Atlanta, GA 30309 UNITED STATES bbaber@kslaw.com, kmccarthy@kslaw.com, nytrademarks@kslaw.com Phone:404-572-4826		
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Registration Subject to Cancellation

Registration No	2929764	Registration date	03/01/2005
Registrant	Great Concepts, LLC P. O. Box 2937 Duluth, GA 30096 UNITED STATES		

Goods/Services Subject to Cancellation

Class 043. First Use: 2003/09/30 First Use In Commerce: 2003/09/30 All goods and services in the class are cancelled, namely: Steak and Seafood Restaurant

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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Attachments	Petition to Cancel.pdf(35278 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Bruce W. Baber/
Name	Bruce W. Baber
Date	07/29/2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHUTTER, INC.,)	
)	
Petitioner,)	CANCELLATION NO.
)	
v.)	
)	
GREAT CONCEPTS, LLC,)	_____
)	
Registrant.)	

PETITION TO CANCEL

CHUTTER, INC., a corporation organized under the laws of the State of California having a place of business at 9071 Santa Monica Boulevard, West Hollywood, California 90069 (“Petitioner”), believes that it has been and will be damaged by Registration No. 2,929,764 for the mark DANTANNA’S for steak and seafood restaurant services (the “Registration”), which was issued on March 1, 2005, was renewed on November 21, 2014, and is owned by Great Concepts, LLC, a limited liability stock company organized under the laws of the State of Georgia having a place of business at P.O. Box 2937, Duluth, Georgia 30096 (“Registrant”).

By and through its undersigned counsel, Petitioner hereby requests that said registration be cancelled in accordance with Section 14 of the Lanham Act, 15 U.S.C. § 1064(3).

The grounds for cancellation are as follows:

1. Petitioner is the owner, by assignment from its predecessor Dan Tana (“Tana”), of all rights in and to the mark DAN TANA’S for restaurant services. Petitioner and its predecessor in interest have been engaged in the operation of a restaurant in West Hollywood, California named DAN TANA’S continuously for over fifty years, since at least as early as 1964.

2. Petitioner uses the DAN TANA’S mark for both restaurant services and pasta sauce, as well as for apparel items and packaging for food products such as boxes and canvas and plastic bags.

3. Petitioner has a real interest in continuing to use the mark DAN TANA’S for restaurant services, pasta sauces and related goods in the United States.

4. Petitioner is the owner of U.S. Trademark Registration No. 3,420,716, issued on April 29, 2008 on the Principal Register for the mark DAN TANA’S for clothing, namely tee shirts, sweat shirts, hats and aprons, in International Class 25.

5. Petitioner and its predecessor Tana have also filed, at various times, applications to register the DAN TANA’S mark for restaurant, cafe and bar services in International Class 43 and for pasta sauces and salad dressings, in International Class 30, which applications have been refused by the Patent and Trademark Office based on an alleged likelihood of confusion with the mark shown in the Registration.

6. Petitioner is the owner of and applicant in applications Serial Nos. 86-452,290 and 86-452,382, filed on November 12, 2014, for the mark DAN TANA’S for restaurant services in International Class 43 and for marinara sauce in International Class 30, respectively (“Petitioner’s Pending Applications”).

7. On March 4, 2015, the U.S. Patent and Trademark Office (“USPTO”) issued Office Actions refusing Petitioner’s Pending Applications under Section 2(d) because of the Registration.

8. Petitioner has been damaged, is being damaged, and will continue to be damaged by the Registration.

9. The Registration was issued on March 1, 2005, based on an application that was filed on June 9, 2003, and is for the mark DANTANNA’S for steak and seafood restaurant services in International Class 43.

10. Commencing in approximately June of 2006 and continuing until at least December 14, 2010, Petitioner’s predecessor Tana and Registrant were engaged in proceedings in which Registrant’s right to register and use the mark DANTANNA’S for restaurant services were involved. More specifically, on June 6, 2006, Petitioner’s predecessor Tana filed with the Trademark Trial and Appeal Board a petition to cancel the Registration, Cancellation No. 92045947 (the “Prior Cancellation Proceeding”), and, on March 13, 2008, Petitioner’s predecessor Tana commenced a civil action for infringement against Registrant in the United States District Court for the Northern District of Georgia, Civil Action No. 1:08-CV-975-TWT (the “Civil Action”).

11. Registrant was represented in both the Prior Cancellation Proceeding and the Civil Action by several attorneys, including attorney Frederick K. Taylor of the firm of Procopio Cory Hargreaves & Savitch LLP in San Diego, California (“Attorney Taylor”). Attorney Taylor participated as counsel for Registrant in both proceedings and, in his capacity as counsel for Registrant, filed numerous documents with the Trademark Trial and Appeal Board in the Prior Cancellation Proceeding.

12. On December 31, 2008, proceedings in the Prior Cancellation Proceeding were suspended pending disposition of the Civil Action.

13. On September 15, 2009, the Court entered an order granting summary judgment in favor of Registrant in the Civil Action and a judgment in accordance with said order was entered that same day.

14. Following entry of the judgment by the District Court in the Civil Action, Petitioner's predecessor Tana appealed to the U.S. Court of Appeals for the Eleventh Circuit.

15. Tana's appeal to the Eleventh Circuit was pending at least until July 15, 2010, on which date the Eleventh Circuit issued an opinion affirming the judgment of the District Court.

16. Tana's appeal to the Eleventh Circuit remained pending at least until August 13, 2010, on which date the Eleventh Circuit issued its mandate and closed its case docket.

17. At the time Tana's appeal to the Eleventh Circuit was concluded, the Prior Cancellation Proceeding was still pending before the Trademark Trial and Appeal Board.

18. On September 1, 2010, Registrant's counsel Attorney Taylor filed with the Trademark Trial and Appeal Board a request to resume the Prior Cancellation Proceeding.

19. On December 14, 2010, the Board entered an Order terminating the Prior Cancellation Proceeding.

20. In accordance with Section 8 of the Lanham Act, 15 U.S.C. § 1058, an affidavit or declaration of continuing use with respect to the Registration was required to be filed between March 1, 2010 and March 1, 2011.

21. In accordance with Section 15 of the Lanham Act, 15 U.S.C. § 1065, an affidavit or declaration of incontestability with respect to the Registration, if the requirements of Section 15 were met, could have been filed on or after March 1, 2010.

22. On March 8, 2010, while both the appeal in the Civil Action and the Prior Cancellation Proceeding were still pending, Attorney Taylor signed and filed with the USPTO on behalf of Registrant a "Combined Declaration of Use and Incontestability under Sections 8 & 15" (the "Declaration") with respect to the Registration.

23. In the Declaration, Attorney Taylor declared under penalty of perjury that:

There has been no final decision adverse to the owner's claim of ownership of such mark, or to the owner's right to register the same or keep the same on the register; ***and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.***

24. At the time Attorney Taylor signed and filed the Declaration, Tana's appeal of the Civil Action was pending before the U.S. Court of Appeals for the Eleventh Circuit and had not been finally disposed of.

25. Tana's appeal of the Civil Action to the U.S. Court of Appeals for the Eleventh Circuit involved Registrant's right to register and use the mark that is the subject of the Registration and to keep the mark on the register.

26. At the time Attorney Taylor signed and filed the Declaration, the Prior Cancellation Proceeding was pending before the Trademark Trial and Appeal Board.

27. The Prior Cancellation Proceeding involved Registrant's right to register the mark that is the subject of the Registration and to keep the mark on the register.

28. The statement in the Declaration signed and filed by Attorney Taylor on March 8, 2010 regarding pending proceedings, namely that there was "no proceeding involving said rights [to register the same or keep the same on the register] pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts," was false.

29. As of March 8, 2010, Attorney Taylor was one of Registrant's counsel in both the then-pending Civil Action and the then-pending Prior Cancellation Proceeding.

30. Attorney Taylor knew that the statement in the Declaration regarding pending proceedings was false as of March 8, 2010.

31. Attorney Taylor had actual knowledge and was aware, both shortly before and shortly after filing the Declaration, that both the Civil Action and the Prior Cancellation Proceeding were still pending.

32. Attorney Taylor had actual knowledge and was aware, both shortly before and shortly after filing the Declaration, that both the Civil Action and the Prior Cancellation Proceeding involved Registrant's right to register the mark that is the subject of the Registration and keep the same on the register.

33. On February 1, 2010, five weeks before signing and filing the Declaration, Attorney Taylor filed with the Trademark Trial and Appeal Board a Status Report on behalf of Registrant in the Prior Cancellation Proceeding, in which Attorney Taylor advised the Board of the status of Tana's then-pending appeal of the Civil Action.

34. On February 4, 2010, approximately four weeks before Attorney Taylor signed and filed the Declaration, the Trademark Trial and Appeal Board entered an order in the Prior Cancellation Proceeding, continuing the suspension of the Prior Cancellation Proceeding because the Civil Action remained pending.

35. On September 1, 2010, less than six months after signing and filing the Declaration, Attorney Taylor filed with the Trademark Trial and Appeal Board a document entitled "Great Concepts' Request To Remove Suspension Of Proceedings" on behalf of Registrant in the Prior Cancellation Proceeding, in which Attorney Taylor advised the Board that the Civil Action had been terminated with the issuance of the Eleventh Circuit decision on July 15, 2010 and "are now disposed."

36. Attorney Taylor knowingly made the false statement in the Declaration with the intent that the USPTO would rely on it and to induce the USPTO to accept the Declaration.

37. On March 26, 2010, the USPTO issued a combined Notice of Acceptance (as to Section 8) and Notice of Acknowledgment (as to Section 15) (the "Combined Notice") with respect to the Registration, which Combined Notice advised that the Declaration "meets the requirements of" both Section 8 and Section 15.

38. The USPTO relied on the Declaration in issuing the Combined Notice with respect to the Registration.

39. The USPTO would not have issued the Combined Notice but for the filing of the Declaration.

40. But for the filing of the Declaration, the Registration would have been cancelled under Section 8.

41. The Declaration was material with respect to the continued validity of the registration and its alleged incontestable status.

42. Attorney Taylor made the false statement in the Declaration with intent to deceive the USPTO and to thereby obtain benefits for Registrant to which Registrant was not entitled.

43. Attorney Taylor made the false statement in the Declaration with reckless disregard for the truth or falsity of the statement.

44. Attorney Taylor's actions in signing and filing the Declaration constitute fraud.

45. As a result of the filing by Attorney Taylor of the Declaration and the fraud in connection therewith, the Registration should be cancelled in accordance with Section 14(3) of the Lanham Act, 15 U.S.C. § 1064, which provides that a petition to cancel on grounds of fraud may be filed at any time.

46. On November 4, 2014, Registrant filed a Combined Declaration of Use and Application for Renewal of the Registration Under Section 9 of the Lanham Act, 15 U.S.C. § 1059 (the "Renewal Application").

47. In the Renewal Application, Registrant was identified as the owner of the Registration and/or of the mark that is the subject of the Registration.

48. The USPTO accepted the Renewal Application on November 21, 2014, and the Registration was renewed in Registrant's name.

49. Upon information and belief, Registrant is the current owner of the Registration.

The Patent and Trademark Office is authorized to deduct the filing fees of three hundred dollars (\$300.00), and any other fees necessary in connection with the filing of this Petition to Cancel from the deposit account of King & Spalding LLP, Petitioner's undersigned counsel, account number 11-0980.

WHEREFORE, Petitioner respectfully requests that the Trademark Trial and Appeal Board cancel Registration 2,929,764 for the mark DANTANNA'S.

This 29th day of July, 2015.

Respectfully submitted,

KING & SPALDING LLP

/Bruce W. Baber/

Bruce W. Baber
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Attorneys for Petitioner
CHUTTER, INC.

CERTIFICATE OF SERVICE

This is to certify, in accordance with Rule 2.111(b) of the Trademark Rules of Practice, that I have this day served the foregoing Petition To Cancel upon Registrant, by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to the Registrant as follows:

Great Concepts, LLC
P.O. Box 2937
Duluth, Georgia 30096

and by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Registrant's last counsel of record as follows:

Ms. Lisel M. Ferguson
Procopio, Cory, Hargreaves & Savitch, LLP
525 B Street, Suite 2200
San Diego, California 92101-4474

This 29th day of July, 2015.

/Bruce W. Baber/
Bruce W. Baber