

ESTTA Tracking number: **ESTTA599903**

Filing date: **04/22/2014**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Dean Burnett		
Entity	Individual	Citizenship	United States
Address	2012 S. Florida Avenue Lakeland, FL 33803 UNITED STATES		

Attorney information	Amber N. Davis, Esquire Beusse Wolter Sanks Mora & Maire, P.A. 390 North Orange Avenue Suite 2500 Orlando, FL 32801 UNITED STATES adavis@iplawfl.com, kwimberly@iplawfl.com, bmahan@iplawfl.com Phone:(407) 926-7716		
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Applicant Information

Application No	85890526	Publication date	03/25/2014
Opposition Filing Date	04/22/2014	Opposition Period Ends	04/24/2014
Applicant	Burnetti, P.A. 211 South Florida Ave. Lakeland, FL 33801 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 1994/06/30 First Use In Commerce: 1994/06/30 All goods and services in the class are opposed, namely: Legal services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is primarily merely a surname	Trademark Act section 2(e)(4)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant is not and was not the owner of the mark at the time of filing its application (TBMP 309.03(c)(7))

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	BURNETTI and DEAN BURNETTI
Goods/Services	Legal Services (IC 045)

Attachments	20140422150512.pdf(3433953 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	/Amber N. Davis/
Name	Amber N. Davis, Esquire
Date	04/22/2014

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED ELECTRONICALLY TO THE COMMISSIONER FOR TRADEMARKS <http://estta.uspto.gov/filing-type.jsp>

BY: 

DATE: 4/22/2014

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

In the Matter of Application Serial No. 85890526
Date of Publication: March 25, 2014

_____)
DEAN BURNETTI,)
)
)
Opposer,)
)
v.)
)
BURNETTI, P.A.,)
)
Applicant.)
_____)

To: Box TTAB FEE
Honorable Commissioner for Trademarks
P.O. Box 1451
Arlington, Virginia 22313-1415

NOTICE OF OPPOSITION

Opposer, DEAN BURNETTI (“Opposer”) an individual residing in Florida, hereby files his Notice of Opposition to the registration of the BURNETTI, P.A. trademark that is the subject of application Serial No. 85/890,526, published in the Official Gazette on March 25, 2014, and requests that registration to Applicant be refused for the reasons set forth below.

To the best of Opposer’s knowledge, the name and address of Applicant is as follows:

Burnetti, P.A.
211 South Florida Ave.
Lakeland, Florida 33801

Opposer believes that it will be damaged by and opposes the grant of application Serial No.: 85/890,526, Filing Date: March 29, 2013 for the Mark BURNETTI, P.A. for “legal services” in Class 045.

As grounds and in support of its opposition, Opposer asserts as follows:

1. Applicant, BURNETTI, P.A. (“Applicant”), seeks to register BURNETTI, P.A. as a trademark for “legal services” in Class 045 (“Applicant’s Mark” or “the BURNETTI, P.A. Mark”).
2. The application herein opposed was filed on March 29, 2013 on the basis of Section 1(a). Applicant claims no date earlier than June 30, 1994 for the purpose of claiming priority.
3. Opposer, well prior to Applicant’s use and/or filing of the subject application, has adopted and continuously used the terms BURNETTI and DEAN BURNETTI as trademarks for legal services in interstate commerce (“Opposer’s Marks” or “the BURNETTI Marks”).
4. In fact, on October 17, 1986, Opposer was admitted to the practice of law in the State of Florida and has been using his last name, BURNETTI and his full name DEAN BURNETTI, as trademarks and in association with the provision of legal services since that date. Opposer’s date of first use in commerce was 12/31/1987, which is six and a half (6 ½) years before Applicant’s June 30, 1994 first use date.
5. Opposer, DEAN BURNETTI, and Applicant’s owner, DOUGLAS BURNETTI, are brothers and are both attorneys located in Florida. DEAN BURNETTI is the older brother and hence, has been practicing law for a longer period of time.

6. Prior to Opposer joining BURNETTI, P.A. in 1996 as a shareholder and prior to Applicant's June 30, 1994 first use date, Opposer used the BURNETTI Marks in commerce substantially exclusively and continuously in association with the provision of legal services.

7. In 1996, the two brothers went into business together wherein DEAN BURNETTI and DOUGLAS BURNETTI each owned 50% of the shares of BURNETTI, P.A.

8. From 1996 until August 27, 2012 any and all advertising or use of the BURNETTI, P.A. Mark was done at the behest of and at the expense of both DEAN BURNETTI (Opposer) and DOUGLAS BURNETTI (Applicant's owner).

9. DOUGLAS BURNETTI and DEAN BURNETTI disagreed as to how the law firm, BURNETTI, P.A., should be managed and because of this, on August 27, 2012, DOUGLAS BURNETTI invoked the provisions of a Share Transfer Agreement between the parties and terminated DEAN BURNETTI's employment. A true and correct copy of the Share Transfer Agreement is attached hereto as Exhibit "A."

10. DEAN BURNETTI is no longer a shareholder of Burnetti, P.A., but the parties have yet to resolve the amount owed to DEAN BURNETTI for his 50% share in Burnetti, P.A.

11. The parties are involved in two lawsuits in Florida State Court wherein the first, identified as *Dean Burnetti v. Douglas Burnetti, and Burnetti, P.A., a Florida corporation*, Case No. 53-2012CA-7825, in the Circuit Court of the Tenth Judicial Circuit in and for Polk County, Florida ("Burnetti I") is related to the amount owed to DEAN BURNETTI for his 50% ownership of BURNETTI, P.A. A true and correct copy of the Burnetti I Complaint is attached hereto as Exhibit "B."

12. The second lawsuit, identified as *Burnetti, P.A. v. Dean Burnetti, et. al.*, Polk County Circuit Court, Case No. 2013CA-2314 in the Circuit Court of the Tenth Judicial

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