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

Proceeding	92048998
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Registration No. 3,388,869
Issued: February 26, 2008

JONATHAN M. KELLY, Petitioner, v. CITYSTAY HOTELS, LLC, Registrant.	Cancellation No. 92048998 **PETITIONER JONATHAN M. KELLY'S ACCELERATED CASE RESOLUTION (ACR) REPLY BRIEF**

Registrant CityStay Hotels, LLC's Accelerated Case Resolution ("ACR") brief makes it clear that its Registration No. 3,388,869 for CITYSTAY HOTELS must be cancelled. CityStay Hotels, LLC ("CSH") fails to refute the fact that it has never used the mark on any hotel lodging, the service designated in the registration. Indeed, CSH's brief fails to indicate *any* goods or services the mark is being used with. Without use in commerce, the registration is simply not valid and cannot remain on the Register.

CSH's brief betrays profound confusion about three separate things: constitutional interstate commerce, international classification, and goods and services designation.

Interstate commerce provides the constitutional basis for Congress to authorize the United States Patent and Trademark Office to regulate the national registration of trademarks. Thus its broad interpretation, e.g., "all commerce that the Congress may regulate." However, a trademark registration cannot be maintained merely through use in commerce – any commerce – that Congress may regulate. The use must be made on the goods or services actually designated in the trademark registration.

The international classification of goods and services organizes the universe of goods and services for administrative and ministerial purposes but does not confer any substantive rights and does not affect the interpretation of the goods or services actually designated by an applicant. Here, there is no dispute that CSH's designated service, hotel lodging, falls under International Class 43. The international classification system therefore has no bearing on the issues in this cancellation proceeding.

To the extent CSH's confusing argument could be understood, it seems to be saying that because "hotel lodging" does not exist in the Acceptable Identification of Goods and Services Manual (the "ID Manual"), CSH's registration somehow gets to subsume the entire breadth of International Class 43. This reasoning is completely wrong:

> The listing is *not exhaustive*, but is intended to serve as a guide to both examining attorneys in acting on applications and to filers in preparing applications. Using language directly from the ID Manual helps avoid objections by examining attorneys concerning "indefinite" identifications of goods or services; however, applicants must assert *actual use in commerce* or a bona fide intent to use the mark in commerce *for the goods or services specified*. Therefore, even with definite identification, examining attorneys may inquire as to whether the identification chosen accurately identifies the applicant's goods or services.

http://www.uspto.gov/trademarks/resources/index.jsp (emphasis added). Thus the ID Manual does not preclude a designation for "hotel lodging." CSH cannot flee its "hotel lodging" designation and fumble around the ID Manual to find some other as yet *in*definite, unspecified services on which to claim use in commerce.

The goods and services designation actually applied for and examined by the Trademark Office is the only thing that matters. CSH admits that it voluntarily used the word "lodging" in its designation to "further define the activity scope/range of the hotel services that CSH was conducting." Registrant's ACR Brief, p. 4. It never indicated that this was an inaccurate description of its services. That being the designation under which its application was examined, CSH is bound to it. The Examining Attorney did

nothing to suggest that CSH's registration covered some indefinite range of "hotel service(s)" conceivably spanning the entirety of International Class 43. Nor would he have been permitted to do so under United States trademark law or the Trademark Manual of Examining Procedures.

Once the fog of CSH's confusion is dispelled, the Board is left with the simple phrase "hotel lodging." CSH has effectively conceded that it has never used the mark in commerce for "hotel lodging." Indeed, CSH has not explained how it has used the mark in commerce on *any* services whatsoever that CSH *sold*. On that basis alone, Mr. Kelly's petition for cancellation must be granted and nothing more need be said.

But CSH has gone further to cast reckless aspersions on Mr. Kelly and to make a veiled threat to bombard the Board with future meritless proceedings. Though the irrelevance and impropriety of such comments should be transparent, petitioner Kelly must clarify the record. First, his standing is unchallenged. The Trademark Office has suspended his application, citing CSH's registration, and that is the only standing Mr. Kelly needs to seek cancellation. The statements referenced in Joint Stipulated Facts 15 through 17 were made through Mr. Kelly's previous counsel and *not* under penalty of perjury.[1] And of course, they are entirely irrelevant to the standing issues in this cancellation proceeding: The Examining Attorney apparently rejected them, forcing Mr. Kelly to petition for cancellation.[2]

More disturbing is CSH's threat of "weighing down the TTAB with more oppositions and cancellations toward Mr. Kelly, should he be awarded cancellation in this proceeding." Though it was not necessary for Mr. Kelly to argue fraud in this ACR

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[1] Moreover, at the time Mr. Kelly's previous attorney submitted those statements, CSH's application was for CITISTAY. It amended the mark to CITYSTAY HOTELS on September 27, 2007.

[2] There is also nothing wrong in Mr. Kelly's use of the "tm" designation on his website and nothing to prevent a 1(b) applicant like himself to claim harm and standing in a cancellation proceeding. Registrant's ACR Brief, p. 6.

procedure, he may be forced to prove fraud in a future civil lawsuit if CSH continues to use its false application – which was filed with legal advice (Joint Stipulated Fact No. 10) – and invalidly maintained registration to cause harm to Mr. Kelly. "Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof." 15 U.S.C. § 1120. While this would compensate Mr. Kelly for the harm done by CSH, it would unfortunately not compensate the Board for wasted effort in future frivolous filings by CSH. Mr. Kelly therefore sincerely hopes that CSH would not pursue this foolish course.

Nevertheless, CSH's threat is not a basis for denying Mr. Kelly the cancellation that the facts and law mandate. Petitioner respectfully requests that Registration No. 3,388,869 be immediately cancelled.

DATED: March 22, 2010

Respectfully submitted,
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