

ESTTA Tracking number: **ESTTA232101**

Filing date: **08/21/2008**

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	Linden Research, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	945 Battery Street San Francisco, CA 94111 UNITED STATES		

Attorney information	Bobby A. Ghajar and James R. Cady Howrey LLP 1950 University Avenue, 4th Floor East Palo Alto, CA 94303 UNITED STATES CadyJ@howrey.com, GhajarB@howrey.com, IPDocketing@howrey.com Phone: (650) 798-3500
----------------------	--

**Registration Subject to Cancellation**

Registration No	3399258	Registration date	03/18/2008
Registrant	Minsky, Richard P. 413 County Route 22 Hudson, NY 12534 UNITED STATES		

**Goods/Services Subject to Cancellation**

<p>Class 041. First Use: 2006/12/09 First Use In Commerce: 2006/12/14 All goods and services in the class are cancelled, namely: Multimedia publishing of books, magazines, journals, software, games, music, and electronic publications; On-line publication of art; Publication of electronic magazines; Publication of electronic newspapers accessible via a global computer network; Publication of the editorial content of sites accessible via a global computer network; Publishing of electronic publications; Art exhibitions; Conducting workshops and seminars in art; Instruction in the field of art; Workshops and seminars in the field of art; Publication and editing of printed matter; Publication of books; Publication of books, magazines, almanacs and journals; Publication of books, of magazines, of journals, of newspapers, of periodicals, of catalogs, of brochures; Publication of books, reviews; Publication of brochures; Publication of documents in the field of training, science, public law and social affairs; Publication of journals; Publication of leaflets; Publication of magazines; Publication of manuals; Publication of musical texts; Publication of printed matter; Publication of text books; Publication of texts, books, journals; Publication of texts, books, magazines and other printed matter; Education in the field of art rendered through correspondence courses; Education in the field of art rendered through video conference; Educational services in the nature of art schools; Organizing community festivals featuring a variety of activities, namely, sporting events, art exhibitions, flea markets, ethnic dances and the like</p>
---

**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l. Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
--	---

Related Proceedings	Civil Case No.: 08-CV-819 (N.D.N.Y.)
---------------------	--------------------------------------

Attachments	Petition to Cancel - SLART - 08-21-2008.pdf ( 6 pages )(375138 bytes )
-------------	--

### **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	/JRCady/
Name	James R. Cady
Date	08/21/2008

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

Linden Research, Inc.,	§	
	§	
Petitioner,	§	Cancellation No. _____
	§	
v.	§	Registration No.: 3399258
	§	
Richard Minsky,	§	Date of Issue: March 18, 2008
	§	
Registrant.	§	Subject Mark: SLART
	§	
	§	

**PETITION FOR CANCELLATION**

Petitioner, Linden Research, Inc., a Delaware corporation with principal address at 945 Battery Street, San Francisco, California 94111 hereby petitions to cancel Registration No. 3399258 registered to Richard P. Minsky, an individual and citizen of the United States with principal address at 413 County Route 22, Hudson, New York 12534 on grounds that the Registration was obtained through fraud on the United States Patent and Trademark Office.

As grounds for the Petition, it is alleged that:

1. Petitioner created and operates SECOND LIFE<sup>®</sup>, the world's leading 3D online virtual world, in which users (called "residents") interact, explore, and create content and experiences for social, business, and educational purposes – much like how users create websites on the internet, but in a virtual 3D environment.

2. SECOND LIFE<sup>®</sup> has over 14 million subscribers in the United States and around the world. It is featured regularly in news commentary and popular culture, and has been licensed for use in several prime time television shows. Many educational institutions, including Harvard, Princeton, and Stanford Universities, have virtual campuses in SECOND LIFE<sup>®</sup> where they host classes, events, and information resources. As a result, the SECOND LIFE<sup>®</sup> virtual world has rapidly become well-known among the general population.

3. Petitioner has adopted and uses the mark SL as an abbreviation for its SECOND LIFE<sup>®</sup> virtual world. The SL mark is used by Petitioner and its licensees in connection with products and services in and for the SECOND LIFE<sup>®</sup> virtual world environment.

4. In addition to its valid common law rights in the SL mark, Petitioner is the owner of Application Serial No. 77/198345 to register the SL mark for various goods and services in International Classes 9, 38 and 42.

5. Registrant is a “resident” of SECOND LIFE<sup>®</sup>, or SL<sup>™</sup>. Registrant uses the term “SLART,” which is a combination of Petitioner’s SL mark and the generic/descriptive term “ART” as the name of a magazine, book and/or art exhibit featuring art from Petitioner’s SECOND LIFE<sup>®</sup> virtual world.

6. Registrant’s attempt to claim ownership of, and derive rights from, Petitioner’s mark SL, and his attempts to enforce these alleged rights against third parties, including other “residents” in the SECOND LIFE<sup>®</sup> virtual world, is contrary to Petitioner’s rights.

7. On March 22, 2007, Registrant filed Application Serial No. 77/137283 for registration on the Principal register of the mark “SLART” for a long list of services. Specifically, the application was filed under Section 1(a) based on allegations of actual use of “SLART” in commerce on the following services: “Multimedia publishing of books, magazines, journals, software, games, music, and electronic publications; On-line publication of art; Publication of electronic magazines; Publication of electronic newspapers accessible via a global computer network; Publication of the editorial content of sites accessible via a global computer network; Publishing of electronic publications; Art exhibitions; Conducting workshops and seminars in art; Instruction in the field of art; Workshops and seminars in the field of art.”

8. In addition, the application claimed an intent-to-use “SLART” under Section 1(b) for the following services: “Publication and editing of printed matter; Publication of books; Publication of books, magazines, almanacs and journals; Publication of books, of magazines, of journals, of newspapers, of periodicals, of catalogs, of brochures; Publication of books, reviews; Publication of brochures; Publication of documents in the field of training, science, public law and social affairs; Publication of journals; Publication of leaflets; Publication of magazines; Publication of manuals; Publication of musical texts; Publication of printed matter; Publication of text books; Publication of texts, books, journals; Publication of texts, books, magazines and other printed matter; Education in the field of art rendered through correspondence courses; Education in the field of art rendered through video conference; Educational services in the

nature of art schools; Organizing community festivals featuring a variety of activities, namely sporting events, art exhibitions, flea markets, ethnic dances and the like.”

9. In support of his application, Registrant signed a declaration in which he stated that “to the best of his ... knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.”

10. On July 5, 2007, the Examining Attorney issued an Official Action refusing the mark under Section 2(e)(1) of the Trademark Act on the basis that the mark merely describes the applicant’s services. Specifically, the Examining Attorney asserted that “applicant seeks registration of “SLART” for publication services related to Second Life Art. ... The term “SLART” is commonly used to describe art within the online world Second Life.”

11. On July 12, 2007, Registrant filed a response to the Office Action, in which he stated that SLART “is a slang term, and NOT one that refers to art in Second Life.” Registrant further argued against the refusal stating “[t]he mark SLART does not ‘merely describe the feature of applicant’s services.’ A ‘SLART’ is not a feature of a service, except perhaps in the sense of the services described in those 5 urban definitions, and those are not services I listed in the Classes of Goods & Services.” The 5 urban definitions to which Registrant referred were “other word for slut,” “[a] fart that escapes during sleep, sometimes waking the slarter him(her)self,” “[a] fart emitted by a slut, or a slut that smells like farts,” “a cross between a slut and a tart used in a derogatory [sic] term manly aimed at females” and someone “too tarty to be a slut, and not good enough to be a tart.”

12. On December 21, 2007, Registrant filed a Statement of Use in support of registration of his applied for mark SLART. In support of his Statement of Use, Registrant asserted that he had established use of the mark on all the services listed in the application, including those services for which he originally claimed an intent-to-use (*see supra* paragraph 8). In his Statement of Use, Registrant claimed the SLART mark was first used anywhere on or in connection with the services in the application on December 9, 2006; was first used on or in

connection with these same goods in interstate commerce on December 14, 2006; and was currently in use on or in connection with all of the services listed in the application at the time of filing the Statement of Use. Registrant submitted a declaration to the United States Patent and Trademark Office in support of this Statement of Use in which he swore that all statements in the Statement of Use were true.

13. This application matured into Registration No. 3399258 on March 18, 2008.

**Registrant's Misrepresentations to the USPTO**

14. On information and belief, at the time of filing Registrant was aware that Petitioner had rights in the mark SL.

15. On information and belief, at the time of filing Registrant was aware that members of the general public encountering his mark as used on or in connection with his services understood his mark to mean "SECOND LIFE<sup>®</sup> art" or otherwise refer to "art in SECOND LIFE<sup>®</sup>."

16. On information and belief, at the time of filing his response to the Office Action Registrant was aware and knew that SLART refers to "SECOND LIFE art" and he misrepresented that fact to the United States Patent and Trademark Office ("USPTO") when he filed his response to the Office Action with the USPTO and claimed that SLART "is a slang term, and NOT one that refers to art in Second Life ..." and that "[t]he mark SLART does not 'merely describe the feature of applicant's services.' A 'SLART' is not a feature of a service."

17. On information and belief, at the time of filing the application Registrant was not using the mark SLART on or in connection with all of the services for which he claimed actual use in commerce under Section 1(a) of the Trademark Act.

18. On information and belief, when Registrant filed the application and supporting declaration with the USPTO and claimed that he was currently using the mark on or in connection with the services listed under Section 1(a) (*see supra* paragraph 7), that sworn statement was false.

19. Additionally, on information and belief, at the time of filing the Statement of Use Registrant was not using the mark SLART on or in connection with all of the services listed in the application, which he represented were in use in the Statement of Use.

20. On information and belief, when Registrant filed his Statement of Use with the USPTO and claimed that he was currently using the mark on or in connection with all the services identified in the application, that sworn allegation was false.

21. On information and belief, Registrant misrepresented the nature of his use in commerce of the alleged mark at the time he submitted his Statement of Use and continued to prosecute the trademark application that led to the registration that is the subject of this petition.

22. On information and belief, Registrant procured the aforementioned registration by false means and/or by knowingly and willfully making false and/or fraudulent declarations or representations to the USPTO, including *inter alia* falsely alleging in a Declaration under 37 C.F.R. § 1(a) that Registrant was using the mark on “Publication and editing of printed matter; Publication of books; Publication of books, magazines, almanacs and journals; Publication of books, of magazines, of journals, of newspapers, of periodicals, of catalogs, of brochures; Publication of books, reviews; Publication of brochures; Publication of documents in the field of training, science, public law and social affairs; Publication of journals; Publication of leaflets; Publication of magazines; Publication of manuals; Publication of musical texts; Publication of printed matter; Publication of text books; Publication of texts, books, journals; Publication of texts, books, magazines and other printed matter; Education in the field of art rendered through correspondence courses; Education in the field of art rendered through video conference; Educational services in the nature of art schools; Organizing community festivals featuring a variety of activities, namely sporting events, art exhibitions, flea markets, ethnic dances and the like” when Registrant had not used the mark on these alleged services.

23. On information and belief, the aforementioned false statements were made with the intent to induce authorized agents of the USPTO to grant said registration, and reasonably relying on the truth of said false statements, the USPTO did, in fact, grant said registration to Registrant.

24. On information and belief, Registrant knew at the time they were made that the statements claiming exclusive right to use the mark SLART; claiming that SLART is a term that does not refer to art in SECOND LIFE<sup>®</sup> and therefore does not describe a feature of Registrant’s services; claiming use on the services listed under Section 1(a) in the application at the time of filing; and claiming actual use of the mark on all services listed in the application at the time of

filing the Statement of Use that ultimately led to his application maturing into Registration No. 3399258, were all false.

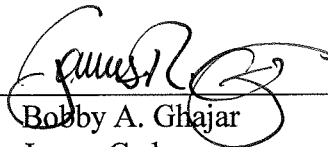
25. Petitioner believes that it has been and will continue to be damaged by registration of said mark.

26. In view of foregoing, Registrant is not entitled to Registration No. 3399258 because Registrant, upon information and belief, committed fraud in the procurement of the subject registration.

WHEREFORE, Petitioner respectfully requests that Registration No. 3399258 be cancelled.

Respectfully submitted,  
LINDEN RESEARCH, INC.

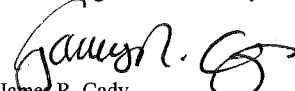
Date: 21 August 2008

By:   
Bobby A. Ghajar  
James Cady  
HOWREY LLP  
1950 University Avenue, 4th Floor  
East Palo Alto, CA 04022  
(650) 798-3500

CERTIFICATE OF ELECTRONIC TRANSMISSION


DATE OF DEPOSIT August 21, 2008

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

  
James R. Cady

CERTIFICATE OF SERVICE VIA MAIL & FACSIMILE

I, Rosario F. Renojo, secretary to James R. Cady, of Howrey LLP, attorneys for Petitioner Linden Research, Inc., hereby certify that a true and complete copy of the foregoing PETITION FOR CANCELLATION was served on Registrant, Richard P. Minsky, 413 County Route 22, Hudson, NEW YORK 12534, via postage prepaid by first-class mail on August 21, 2008.

  
Rosario F. Renojo