

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

ALASKA CENTRAL EXPRESS, INC.,)	
)	
Petitioner,)	
)	Cancellation No. _____
v.)	
)	U.S. Registration No. 5,491,203
FREIGHT RUNNERS EXPRESS, INC.,)	
)	
)	
Registrant.)	
)	

PETITION FOR CANCELLATION

Petitioner, Alaska Central Express, Inc., an Alaska corporation with an address of P.O. Box 190248, Anchorage, Alaska 99519, believes that it is being damaged by and will continue to be damaged by the registration of the service mark **ACE AIR CHARTER EXPRESS & Design** (U.S. Reg. No. 5,491,203) for “air charter services” in International Class 39, owned by Registrant Freight Runners Express, Inc., a Wisconsin corporation with an address of 1901 E. Layton Ave., Milwaukee, Wisconsin 53235.


As grounds for this Petition, Petitioner asserts that Registrant’s mark **ACE AIR CHARTER EXPRESS & Design** is confusingly similar to Petitioner’s prior-used marks **ACE AIR CARGO, ACE & Design** and **ACE TO THE RESCUE!**.

Therefore, continued registration of Registrant’s **ACE AIR CHARTER EXPRESS & Design** mark is prohibited by Section 2(d) of the Federal Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1052(d).

Factual Background

(1) Petitioner is an Alaska airline offering scheduled cargo flights, passenger and cargo charters, small package service and logistics service.

(2) Petitioner owns the following service mark applications (the “**ACE Marks**”), all covering “air transport services”:

<u>Mark</u>	<u>Ser. No.</u>	<u>First Use Date</u>
ACE AIR CARGO	87/890,298	1996
ACE & Design 	87/892,354	1996
ACE TO THE RESCUE!	87/890,316	2005

(3) Petitioner’s use of its **ACE Marks** has been continuous since 1996 (**ACE AIR CARGO** and **ACE & Design**) and 2005 (**ACE TO THE RESCUE!**). Printouts from the U.S. Patent and Trademark Office’s database showing the current status of Registrant’s **ACE Marks** are attached as Exhibits A-C.

(4) Petitioner’s **ACE Marks** are symbols of extensive goodwill and recognition built up by Petitioner through decades of use, along with substantial amounts of time and effort in advertising and promotion of Petitioner’s services.

(5) Notwithstanding Petitioner's prior rights in its **ACE Marks**, on October 26, 2017, Registrant applied to register **ACE AIR CHARTER EXPRESS & Design** with the U.S. Patent & Trademark Office. The application was published for opposition on March 27, 2018, and on June 12, 2018, the application issued as Registration No. 5,491,203.

(6) The alleged first use date of the **ACE AIR CHARTER EXPRESS & Design** mark is March 1, 2014, several years later than Petitioner's first use of its **ACE Marks**.

(7) Registrant's **ACE AIR CHARTER EXPRESS & Design** registration has been cited as a basis for refusal of Petitioner's applications for its **ACE Marks** pursuant to Section 2(d) of the Lanham Act in Office Actions dated August 17, 2018.

Likelihood of Confusion

(8) Registrant's mark, **ACE AIR CHARTER EXPRESS & Design**, so resembles the **ACE Marks** previously used by Petitioner as to cause mistake, or to deceive, or to cause confusion as to source, sponsorship or affiliation.

(9) Registrant's mark, **ACE AIR CHARTER EXPRESS & Design**, has a highly similar connotation and commercial impression to Petitioner's **ACE Marks**, as the dominant element in all of the marks is the shared term "ACE."

(10) Registrant disclaimed the phrase "AIR CHARTER EXPRESS" in the mark **ACE AIR CHARTER EXPRESS & Design**, presumably because this phrase is merely descriptive of Registrant's "air charter services." Accordingly, the only protectable elements in Registrant's **AIR CHARTER EXPRESS & Design** is the term "ACE" and the design element appearing the mark. The term "ACE" appears in and is a dominant element in all of Petitioner's **ACE Marks**.

(11) The **ACE AIR CHARTER EXPRESS & Design** registration covers “air charter services” which is identical and highly related to the “air transport services” provided under Registrant’s **ACE Marks**.

(12) Accordingly, Registrant and Petitioner use their respective marks in the same and highly related fields of use, thereby exacerbating the likelihood of confusion.

(13) As the **ACE AIR CHARTER EXPRESS & Design** registration includes no limitations on Registrant’s channels of trade or classes of consumers, they are presumed to be identical or overlapping.

(14) Consumers encountering Registrant’s **ACE AIR CHARTER EXPRESS & Design** mark are likely to believe, mistakenly, that Registrant’s services are those of Petitioner, or are sponsored, endorsed or approved by Petitioner, or that there is a license, relationship or other connection between the parties.

WHEREFORE, the Board should grant this Petition on the ground that the continued registration of **ACE AIR CHARTER EXPRESS & Design**, U.S. Reg. No. 5,491,203, is prohibited by Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Respectfully submitted,

ALASKA CENTRAL EXPRESS, INC.

Dated: February 19, 2019 By: /s/ James L. Bikoff
James L. Bikoff
Holly B. Lance
Darlene K. Tzou
SMITH, GAMBRELL & RUSSELL, LLP
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Washington, D.C. 20007

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Attorneys for Petitioner

EXHIBIT A

Due to high-volume usage, you may experience intermittent issues on the Trademark Status and Document Retrieval (TSDR) system between 6 – 8 a.m. ET. Refreshing your web browser should resolve the issue. If you still need assistance accessing a document, email teas@uspto.gov and include your serial number, the document you are looking for, and a screenshot of any error messages you have received.

Starting Oct. 4, 2018, bulk data customers should no longer obtain direct access to TSDR data through tsdrsec.uspto.gov. [There are two alternative ways to receive bulk data from TSDR.](#)

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Print

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Mark: ACE AIR CARGO

ACE AIR CARGO

US Serial Number: 87890298

Application Filing Date: Apr. 24, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Aug. 17, 2018

Mark Information

Mark Literal Elements: ACE AIR CARGO

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Air transport services

International Class(es): 039 - Primary Class

U.S Class(es): 100, 105

Class Status: ACTIVE

Basis: 1(a)

First Use: 1996

Use in Commerce: 1996

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Alaska Central Express, Inc.

DBA, AKA, Formerly: AKA ACE Air Cargo

Owner Address: P.O. Box 190248
Anchorage, ALASKA UNITED STATES 99519

Legal Entity Type: CORPORATION

State or Country Where Organized: ALASKA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: James L. Bikoff

Docket Number: 034858.001

Attorney Primary Email Address: jbikoff@sgrlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JAMES L. BIKOFF
SMITH, GAMBRELL & RUSSELL, LLP
1055 THOMAS JEFFERSON STREET, NW
SUITE 400
WASHINGTON, DISTRICT OF COLUMBIA UNITED STATES 20007

Phone: 202-263-4300

Fax: 2022634329

Correspondent e-mail: jbikoff@sgrlaw.com dklinksieck@sgrlaw.com
dcdocketing@sgrlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 17, 2018	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 17, 2018	NON-FINAL ACTION E-MAILED	6325
Aug. 17, 2018	NON-FINAL ACTION WRITTEN	90291
Aug. 15, 2018	ASSIGNED TO EXAMINER	90291
May 03, 2018	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 27, 2018	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: PREET, KAMAL

Law Office Assigned: LAW OFFICE 112

File Location

Current Location: TMO LAW OFFICE 112 - EXAMINING ATTORNEY ASSIGNED

Date in Location: Aug. 17, 2018

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EXHIBIT B

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Mark: ACE



US Serial Number: 87892354

Application Filing Date: Apr. 25, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

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Status Date: Aug. 17, 2018

Mark Information

Mark Literal Elements: ACE

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the word ACE in stylized font centered above three solid horizontal stripes with an encircled star design superimposed in the center of the three horizontal stripes.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 01.01.03 - Star - a single star with five points
26.01.17 - Circles, two concentric; Concentric circles, two; Two concentric circles
26.17.01 - Bands, straight; Bars, straight; Straight line(s), band(s) or bar(s); Lines, straight
26.17.05 - Bands, horizontal; Horizontal line(s), band(s) or bar(s); Bars, horizontal; Lines, horizontal

Goods and Services

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Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

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Current Owner(s) Information

Owner Name: Alaska Central Express, Inc.

DBA, AKA, Formerly: AKA ACE Air Cargo

Owner Address: P.O. Box 190248
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Legal Entity Type: CORPORATION

State or Country Where Organized: ALASKA

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Attorney of Record

Attorney Name: James L. Bikoff

Docket Number: 034858.001

Attorney Primary Email Address: jbikoff@sgrlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JAMES L. BIKOFF
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dcdocketing@sgrlaw.com

Correspondent e-mail Authorized: Yes

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Aug. 17, 2018	NON-FINAL ACTION WRITTEN	90291
Aug. 15, 2018	ASSIGNED TO EXAMINER	90291
May 05, 2018	NOTICE OF DESIGN SEARCH CODE E-MAILED	
May 04, 2018	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 28, 2018	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: PREET, KAMAL

Law Office Assigned: LAW OFFICE 112

File Location

Current Location: TMO LAW OFFICE 112 - EXAMINING ATTORNEY ASSIGNED

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Mark: ACE TO THE RESCUE!

ACE TO THE RESCUE!

US Serial Number: 87890316

Application Filing Date: Apr. 24, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



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Mark Information

Mark Literal Elements: ACE TO THE RESCUE!

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