

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

In the Matter of Registration No. 2,585,720
Issued: June 25, 2002

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LIMCO, INC. and TOO, INC., : Cancellation

Petitioners, : No.

v. :

AMERICAN MARKETING ENTERPRISES, INC., :

Respondent. :



12-06-2002

U.S. Patent & TMO/TM Mail Rcpt Dt #77

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PETITION FOR CANCELLATION

Petitioners, Limco, Inc., a Delaware corporation, having its principal office and place of business at 1105 North Market Street, Wilmington, Delaware 19801 and Too, Inc., a Delaware corporation, having its principal office and place of business at 8323 Walton Parkway, New Albany, Ohio 43054 believe that they are being damaged by American Marketing Enterprises, Inc.'s United States Registration No. 2,585,720 of the mark TOONITE for clothing for children, namely, pants, shirts, slacks, t-shirts, socks, shorts, dresses, skirts, jeans, jumpers, jumpsuits, jackets, coats, sport jackets, neckties, sweatsuits, sweatshirts, sweatpants, anklets, bathing suits, bathing trunks, bathrobes, beach coverups, belts, hats, cloth bibs, shoes, sneakers, boots, sandals, slippers, pajamas, nightshirts, nightgowns, underpants, undershirts, sweaters, masquerade costumes and masks, overalls, coveralls, gloves, evening gowns,

nightgowns, gym shorts, gym suits, halter tops, head bands, jogging suits, leggings, overcoats, petticoats, playsuits, pullovers, rainwear, suits, sweat bands, athletic uniforms, unitards and vests in International Class 25.

Therefore pursuant to Section 14(3) of the Trademark Act of 1946, as amended, 15 U.S.C. Section 1064(3), hereby petitions to cancel said registration.

As grounds therefor, Petitioners allege:

1. American Marketing Enterprises, Inc. (herein "respondent"), a New York corporation, having its principal office and place of business at 10 West 33rd Street, New York, New York 10001 is not now and never was entitled to register as a trademark the designation TOO NITE which was assigned United States Registration No. 2,585,720 for clothing for children, namely, pants, shirts, slacks, t-shirts, socks, shorts, dresses, skirts, jeans, jumpers, jumpsuits, jackets, coats, sport jackets, neckties, sweatsuits, sweatshirts, sweatpants, anklets, bathing suits, bathing trunks, bathrobes, beach coverups, belts, hats, cloth bibs, shoes, sneakers, boots, sandals, slippers, pajamas, nightshirts, nightgowns, underpants, undershirts, sweaters, masquerade costumes and masks, overalls, coveralls, gloves, evening gowns, nightgowns, gym shorts, gym suits, halter tops, head bands, jogging suits, leggings, overcoats, petticoats, playsuits, pullovers, rainwear, suits, sweat bands, athletic uniforms, unitards and vests in International Class 25.

2. Respondent is not entitled to use or registration of the designation TOO NITE which was assigned United States

Registration No. 2,585,720 on November 25, 1998, the date respondent filed the intent-to-use application to register the subject mark, in December, 2000, the date of its alleged first use or on June 25, 2002, the date of registration.

3. Petitioner, Limco, Inc. is the owner and petitioner, Too, Inc. is the exclusive user of the trademark LIMITED TOO which are the subject of the following United States registrations:

<u>MARK</u>	<u>REGISTRATION/APPLICATION NO.</u>	<u>GOODS/SERVICES</u>
LIMITED TOO	Registration No. 1,492,347	clothing
LIMITED TOO	Registration No. 1,636,474	retail store services
LIMITED TOO	Registration No. 1,726,609	personal care products
LIMITED TOO and Daisy Design	Registration No. 2,243,565	clothing and retail store services
LTD 2 SWIM and Design	Registration No. 2,327,461	clothing and swimwear
LIMITED TOO and Daisy Design	Registration No. 2,336,279	personal care products
LTD 2	Registration No. 2,353,539	clothing and swimwear
LIMITED TOO	Registration No. 2,427,419	mail order services

Said registrations are now outstanding, validly subsisting and uncanceled.

4. Petitioner, Too, Inc. is the owner and exclusive user of the corporate name TOO, INC., the trade name TOO, alone, and exclusive user of the following "TOO" marks which are the subject of the following United States registrations and pending applications:

<u>MARK</u>	<u>REGISTRATION/APPLICATION NO.</u>	<u>GOODS/SERVICES</u>
TOO	Registration No. 2,609,813	clothing
TOO	Application No. 78/096,517	personal care products, clothing, retail store and catalog services
TOOWARE	Registration No. 2,553,951	clothing
TOO BUCKS	Registration No. 2,349,865	retail store services
TEAM TOO	Application No. 78/130,773	clothing
TOO ZZZZ'S	Application No. 78/113,081	clothing
TOO SWIM	Application No. 78/093,237	towels, footwear and swimming goggles
TOO SWIM	Application No. 78/092,228	swimwear
TOO TWISTED and Design	Registration No. 2,386,563	personal care products
TOO THE GYM and Design	Registration No. 2,462,251	personal care products
TOES BY TOO and Design	Registration No. 2,400,776	personal care products and bags
TOO LIPS	Registration No. 2,504,431	personal care products
TOO MUCH SHINE	Registration No. 2,611,990	personal care products
TOO MUCH SHINE	Application No. 78/075,377	personal care products
TOO 'DO	Registration No. 2,592,460	hair care products
TOO 'DO	Application No. 76/428,598	hair care products
TEAM TOO	Application No. 78/135,467	personal care products
TOO SWEETS	Application No. 78/134,994	personal care products
TOO IN ONE and Design	Application No. 75/456,372	personal care products
TOO TUNES	Application No. 78/113,252	compact discs
TOO GIRLS	Application No. 75/690,870	personal care products, clothing and retail store services
TOO MUCH FUN	Application No. 76/194,512	crafts

<u>MARK</u>	<u>REGISTRATION/APPLICATION NO.</u>	<u>GOODS/SERVICES</u>
TOO MUCH FUN	Application No. 75/671,223	games
TOO BANDS	Application No. 76/194,486	jewelry
TOO CHAT	Application No. 75/671,100	website services

5. Petitioner, Too, Inc. is also the owner and operator of over five hundred (500) LIMITED TOO retail clothing stores nationwide which sell a wide range of merchandise under the TOO marks, including, but not limited to clothing, personal care products and accessories for girls ages 7-14 years. In fiscal year 2001 said LIMITED TOO stores had combined yearly sales in excess of 500 million dollars.

6. Petitioners' trademark and service mark LIMITED TOO, the aforesaid TOO trademarks and the trade name TOO are herein collectively as "the TOO Marks".

7. Upon the introduction of the aforesaid goods of petitioners so marked upon the market and continuously thereafter, petitioners became and are now widely known and recognized by the Too Marks, which are closely and universally associated with petitioners, as means by which petitioners and their merchandise have become known to the public and their source and origin identified.

8. As a result of petitioners' extensive advertising and sales of goods and rendering of services under the Too Marks, as well as the extensive media coverage that petitioners and their TOO Marks have received, the TOO Marks have become and now are well-known and famous.

9. Respondent knew or should have known of

petitioners' TOO Marks and the valuable goodwill represented and symbolized by said marks when it adopted the designation TOO NITE.

10. Respondent's adoption of the designation TOO NITE is without the license or permission of petitioners.

Count I - Likelihood of Confusion

11. Petitioners repeat and reaver the averments set forth in paragraphs 1 through 10 inclusive of this petition for cancellation as if more fully set forth herein again.

12. The designation respondent has registered, namely, TOO NITE, so resembles petitioners' TOO Marks, as to be likely, when applied to the goods of respondent, to cause confusion or mistake or to deceive persons by creating the erroneous impression that respondent's goods originate with or come from the same source as petitioners' goods, or are endorsed by, or are sponsored by petitioners, or that respondent and its goods are connected or associated in some way with petitioners, and the registration thereof would be injurious to petitioners.

Count II - Dilution

13. Petitioners repeat and reaver the averments set forth in paragraphs 1 through 10 inclusive of this petition for cancellation as if more fully set forth herein again.

14. Respondent's use and registration of the designation TOO NITE is likely to and will dilute, blur and erode the distinctiveness of petitioners' TOO Marks, or tarnish the reputation of petitioners and their famous TOO Marks, and/or damage the goodwill associated with their TOO Marks.

15. This petition is filed herewith in duplicate and accompanied by the required fee of \$600.00 [37 C.F.R. 2.6(1)].

WHEREFORE, Petitioners, Limco, Inc. and Too, Inc. pray that said Registration 2,585,720 be cancelled.

Dated: New York, New York
December 12, 2002

Respectfully submitted,

COLUCCI & UMANS

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Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

Enclosed is the original and a copy of Limco, Inc.'s
and Too, Inc.'s Petition to Cancel American Marketing
Enterprises, Inc.'s United States Registration No. 2,585,720 of
the mark TOO NITE for clothing for children, namely, pants,
shirts, slacks, t-shirts, socks, shorts, dresses, skirts, jeans,
jumpers, jumpsuits, jackets, coats, sport jackets, neckties,
sweatsuits, sweatshirts, sweatpants, anklets, bathing suits,
bathing trunks, bathrobes, beach coverups, belts, hats, cloth
bibs, shoes, sneakers, boots, sandals, slippers, pajamas,
nightshirts, nightgowns, underpants, undershirts, sweaters,
masquerade costumes and masks, overalls, coveralls, gloves,
evening gowns, nightgowns, gym shorts, gym suits, halter tops,
head bands, jogging suits, leggings, overcoats, petticoats,
playsuits, pullovers, rainwear, suits, sweat bands, athletic

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uniforms, unitards and vests in International Class 25.

In addition, the United States Patent and Trademark Office credit card payment form in the amount of \$600.00 to cover the fee for filing the Petition for Cancellation is enclosed herewith.

If for any reason the United States Patent and Trademark Office filing fee should exceed \$600.00, please charge any additional sums to our firm's Deposit Account No. 20-0050.

Kindly acknowledge receipt of the above by having your mail room date stamp the enclosed postcard and deposit it with the United States Postal Service.

Dated: New York, New York
December 12 2002

Respectfully submitted,

COLUCCI & UMANS

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

Frank J. Colucci

Signature

December 12, 2002
Date of Signature

BY Frank J. Colucci
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