

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

In The Matter Of:
Trademark Registration No.: 2,724,479
For The Mark: ACTEK HEAVY DUTY
Date Registered: June 10, 2003

CBC Industries, Inc.

v.

Actek Enterprises, Inc.

Cancellation No.: _____

PETITION TO CANCEL

Your Petitioner:

CBC Industries, Inc.
a Maryland Corporation
licensed to do business in California as CBC Industries, Inc.
and having a place of business at
7141 A Paramount Blvd.
Pico Rivera, CA 90660

believes that it will be damaged by the above-identified registration, and hereby petitions to
cancel the same as to all Classes.

To the best of petitioner's knowledge, the name and address of the current owner of the
registration are:

Actek Enterprises, Inc.
11911 Hamden Place
Santa Fe Springs, CA 90670

The grounds for cancellation are as follows:

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1. Petitioner is a corporation in good standing of the State Of Maryland, licensed to do business in the State of California as CBC Industries, Inc.

2. Registrant is on information and belief a corporation of the State of California.

3. Beginning at least as early as 1989, and continuously at all times since, Petitioner's has used the mark HEAVY DUTY in connection with the sales, distribution, and marketing in commerce of its host rings and components therefor. Such use has been valid, substantial, and continuous since at least as early as 1989, and has not been abandoned. Petitioner's HEAVY DUTY trademark is symbolic of, has at all times mentioned herein been symbolic of, or has come since prior to 1998 to symbolize extensive goodwill and consumer recognition built up by Petitioner through substantial amounts of time, effort and expense in advertising and promotion. Petitioner has continuously since 1989 extensively advertised and promoted and made substantial sales throughout the United States and elsewhere of its goods bearing its HEAVY DUTY trademark. Respondent's registered mark so resembles Petitioner's mark as to be likely to cause confusion, or to cause mistake, or to deceive.

4. Petitioner's mark so resembles Registrant's mark as to be likely, when applied to the goods of Petitioner, to cause confusion, or to cause mistake, or to deceive, and Registrant's Registration No. 2,724,479 should be cancelled because Petitioner has priority of use.

5. Registrant's mark so resembles Petitioner's mark as to be likely, when applied to the goods of Registrant, to cause confusion, or to cause mistake, or to deceive, and Registrant's Registration No. 2,724,479 should be cancelled because Petitioner has priority of use.

6. Registrant's mark so resembles Petitioner's Mark that, when these marks are applied to the goods of Petitioner and Registrant, respectively, as to cause customers and potential customers to mistakenly assume that the goods of Petitioner are those of Registrant or are sponsored by Registrant, and the goods of Registrant are those of Petitioner or are sponsored by Petitioner, and Registrant's Registration No. 2,724,479 should be cancelled because Petitioner has priority of use.

7. Registrant applied for and received a Registration on the Principal Register for a Trademark as follows:

Mark:	ACTEK HEAVY DUTY
Registration No.:	2,724,479
Registered:	June 10, 2003
Filing Date:	May 6, 1998
Serial No.:	75/480,112
Goods:	metal fasteners, namely bolts, nuts, screws, eye-bolts, hoist rings, lifting rings, and related accessories, namely, bushings, washers, drill bushings, and replacement parts for the aforesaid goods, in International Class 006
Alleging For All Goods:	
First Use:	July 1, 2000
First Use In Commerce:	July 1, 2000

8. Petitioner filed an application to register a Trademark on the Principal Register as follows:

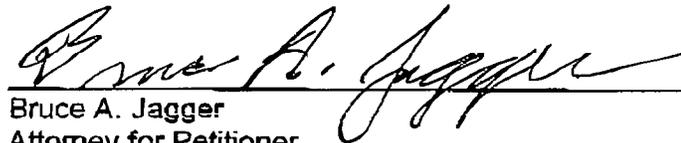
Mark:	HEAVY DUTY
Serial No.:	76/484,025
Filing Date:	January 21, 2003
Goods:	hoist rings and components thereof, in International Class 007

Alleging:
First Use: 1989
First Use In Commerce: 1989

9. On or about July 3, 2003, the Trademark Examining Attorney refused registration of Petitioner's Trademark, HEAVY DUTY, on the grounds that, "...applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. 2724479 as to be likely to cause confusion, to cause mistake, or to deceive..."

10. Registrant's registration and use of "HEAVY DUTY" in a trademark sense is unlawful and in violation of Consent Decrees stipulated to by CBC Industries, Inc. and Actek Enterprises, Inc., and entered in United States Federal District Courts.

By


Bruce A. Jagger
Attorney for Petitioner,
CBC Industries, Inc.

Date: December 26, 2003

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Patent, Trademark, and Copyright Causes6100 Center Drive, Suite 630
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(310) 846-4795**FACSIMILE TRANSMITTAL SHEET**
FROM FACSIMILE NO. (310) 846-4799Please deliver to: Examiner George WoodsFirm or Company Name: Trademark Trial and Appeal BoardTelecopier No. (703) 308-9333From: Bruce A. Jagger, Esq.Date: 7/20/2004Time: 2:37 PMTotal number of pages including cover sheet: 5Re: Petition to CancelOur Client: Petitioner CBC Industries, Inc.**MESSAGE**

Dear Examiner Woods: Per your telephonic request, attached please find a copy of the Petition to Cancel which was filed on December 29, 2003. Thank you for your assistance with this matter.

Denise Kellogg,
Secretary to Bruce A. Jagger

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