UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 15, 2005

The Brand Experience LLC

Rivo Alto Island US 1st Terrance
Miami Beach, FL 33139

Cancellation No. 92044624
Reg. No. 2384600, 2593603,

2477694
Michael A. Grow
Arent Fox Pllc
1050 Connecticut Avenue, NW
Washington, DC 20036

Mr.JChCarnovale

V.

Brand Experience LLC, The

Duion L. Walker, Legal Assistant

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68

08-24-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #39

Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	**July 05, 2005**
Discovery period to close:	**January 01, 2006**
30-day testimony period for party in position of plaintiff to close:	**April 01, 2006**
30-day testimony period for party in position of defendant to close:	**May 31, 2006**
15-day rebuttal testimony period for plaintiff to close:	**July 15, 2006**

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "*Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board,*" 1235 TMOG 68 (June 20, 2000). The notice is available at

http://www.uspto.gov. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABVue at http://ttabvue.uspto.gov.

ESTTA Tracking number: **ESTTA35694**
Filing date: **06/14/2005**

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	Mr.JChCarnovale		
Entity	Individual	**Citizenship**	CANADA
Address	785 Pacific Road Oakville, Ont L6L 6M3 CANADA		

Attorney information	Michael A. Grow 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES henrye@arentfox.com Phone:202 857 6389

Registrations Subject to Cancellation

Registration No	2384600	**Registration date**	09/12/2000
Registrant	Sunsafe, Inc. 6465 S.W. 135 Drive Miami, FL 331567050 UNITED STATES		
Goods/Services Subject to Cancellation	Class 025. First Use: 19980528, First Use In Commerce: 19980528 Goods/Services: sun protective, clothing, namely, swim wear, hats, shirts, shorts, and shoes		
Registration No	2477694	**Registration date**	08/14/2001

Registrant	SunSafe, Inc. 115, 1st Terrace Rivo Alto Island Miami Beach, FL 33139 UNITED STATES		
Goods/Services Subject to Cancellation	Class 025. First Use: 19980528, First Use In Commerce: 19980528 Goods/Services: Sun protective clothing, namely swimwear, long and short sleeved shirts, T-shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear		
Registration No	2593603	**Registration date**	07/16/2002
Registrant	SunSafe, Inc. 115, 1st Terrace Rivo Alto Island Miami Beach, FL 33139 UNITED STATES		
Goods/Services Subject to Cancellation	Class 025. First Use: 19980528, First Use In Commerce: 19980528 Goods/Services: Sun protective clothing, namely swimwear, long and short sleeved shirts, T-shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear		

Attachments	sunscreen.pdf (6 pages)

Signature	/michael a. grow/
Name	Michael A. Grow
Date	06/14/2005

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

In re Registration No. 2,384,600 for the mark THE 50+ SUNSCREEN THAT WON'T RUB OFF issued on September 12, 2000; Registration No.2,477,694 for the mark THE SUNSCREEN THAT WON'T RUB OFF issued on August 14, 2001; and Registration No.2,593,603 for the mark SUNSCREEN KIDS WANT TO WEAR issued on July 16, 2002

J. CHRISTOPHER CARNOVALE	:	
Petitioner	:	
v.	:	Canc. No.
THE BRAND EXPERIENCE LLC.	:	
Registrant	:	

PETITION FOR CANCELLATION

Petitioner J. Christopher Carnovale ("Petitioner") believes that he will be damaged by the continued existence of Registration Nos. 2,384,600; 2,477,694; and 2,593,603 and hereby petitions to cancel these registrations pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064. As grounds for cancellation, Petitioner alleges that:

1. Petitioner is the owner of all right, title and interest in and to the mark THE SUNSCREEN THAT NEVER WEARS OFF! for a variety of clothing products in Class 25.

2. Since long prior to the acts complained of in this petition, Petitioner has continuously used the mark THE SUNSCREEN THAT NEVER WEARS OFF! in connection with its clothing products in several countries, including the United States.

3. Since the initial use of the mark, Petitioner has made a substantial investment in advertising and promoting its goods under the mark THE SUNSCREEN THAT NEVER WEARS OFF!.

4. As a result of the significant advertising and publicity, and several years of continuous use in the marketplace, Petitioner's mark has become well known as a distinctive indicator of the origin of Petitioner's goods, and as a symbol of Petitioner's valuable goodwill.

5. Petitioner has filed with the United States Patent and Trademark Office (the "Office") Appl. S/N 76/599,475 THE SUNCREEN THAT NEVER WEARS OFF! for men's, ladies' and children's clothing, namely, shirts, tops, blouses, jackets, cover-ups, skirts, pants, jumpsuits, robes, and hats, in Int. Class 25.

6. Notwithstanding Petitioner's prior rights in its mark, Registrant has obtained the following registrations:

- Registration No. 2,384,600, for the mark THE 50+ SUNSCREEN THAT WON'T RUB OFF for "sun protective clothing, namely, swim wear, hats, shirts, shorts, and shoes", in Int. Class 25, issued on September 12, 2000;
- Registration No. 2,477,694 for the mark THE SUNSCREEN THAT WON'T RUB OFF for "sun protective clothing, namely, swimwear, long and short sleeved shirts, T-shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear", in Int. Class 25, issued on August 14, 2001; and
- Registration No. 2,593,603, for the mark SUNSCREEN KIDS WANT TO WEAR for "sun protective clothing, namely, swimwear, long and short sleeved shirts, T-

shirts, jackets, cover-ups, shorts, pants, dresses, footwear and headwear", in Int. Class 25, issued on July 16, 2002.

7. The Office refused Petitioner's Application S/N 76/599,475 THE SUNSCREEN THAT NEVER WEARS OFF! on the ground that Petitioner's mark is allegedly confusingly similar to the marks identified in Registrant's Reg. Nos. 2,384,600; 2,477,694; and 2,593,603.

8. Upon information and belief, Registrant made no use of its alleged marks in commerce prior to May 28, 1998, the alleged date of first use in commerce.

9. Upon information and belief, when Registrant applied to register the marks at issue, Registrant had full knowledge of Petitioner's prior rights in the mark THE SUNSCREEN THAT NEVER WEARS OFF!.

10. Petitioner continuously has used its mark THE SUNSCREEN THAT NEVER WEARS OFF! in connection with its goods, in interstate commerce, since long prior to the alleged date of first use of the marks identified in Reg. No. 2,384,600; Reg. No. 2,477,694; and Reg. No. 2,593,603, and long prior to the application filing dates listed in each registration.

A. Likelihood Of Confusion

11. Registrant's alleged marks so resemble Petitioner's mark that the use thereof by Registrant, and the continued existence of Registration Nos. 2,384,600; 2,477,694; and 2,593,603 is likely to cause confusion, mistake and/or deception within the meaning of Section 2(d) of the Trademark Act as to the source or origin of Registrant's goods, and will injure and damage Petitioner and the goodwill and reputation symbolized by Petitioner's mark.

12. Petitioner has been and will be damaged by the continued existence of Registration No. 2,384,600, Registration No. 2,477,694; and Registration No. 2,593,603 because the marks shown in these registrations are likely to cause confusion, mistake or deception among consumers who may believe that the goods of Registrant emanate from or are in some way sponsored or endorsed by or associated with Petitioner.

13. Registrant is not affiliated or connected with or endorsed or sponsored by Petitioner, nor has Petitioner approved any goods or services offered or sold by Registrant under the mark THE 50+SUNSCREEN THAT WON'T RUB OFF, THE SUNSCREEN THAT WON'T RUB OFF, and SUNSCREEN KIDS WANT TO WEAR, nor has Petitioner granted Registrant permission to use said marks.

14. Petitioner's goods and those of Registrant are identical or so closely related that the public is likely to be confused and to assume erroneously that Registrant's goods are Petitioner's goods or that Registrant is connected with, sponsored by or affiliated with Petitioner.

15. Upon information and belief, Registrant adopted the registered marks and has subsequently used the registered marks with a deliberate intent to cause confusion among purchasers as to the source of its products.

16. Petitioner has been and will be damaged by the continued existence of Registration No. 2,384,600, Registration No. 2,477,694; and Registration No. 2,593,603 because said registrations have been cited by the Office as a bar to the registration of Petitioner's mark THE SUNSCREEN THAT NEVER WEARS OFF! on the ground that Petitioner's mark is likely to cause confusion, mistake or deception among consumers who may believe that the goods of Registrant emanate from or are in some way

sponsored or endorsed by or associated with Petitioner. Because Petitioner has prior rights, Petitioner is entitled to obtain an order directing that Registrant's registrations be cancelled.

B. Abandonment

17. Upon information and belief, Registrant has discontinued all use of the marks THE 50+ SUNSCREEN THAT WON'T RUB OFF, THE SUNSCREEN THAT WON'T RUB OFF, and SUNSCREEN KIDS WANT TO WEAR with intent not to resume such use.

18. Upon information and belief, Registrant has forfeited all rights it may ever have had in its alleged marks and the marks have been abandoned.

19. Notwithstanding the fact that the Registrant's marks have been abandoned, the registrations for said marks have been cited as a bar to registration of Petitioner's mark.

20. By reason of the foregoing, Petitioner will be damaged by the continued existence of Registration Nos. 2,384,600; 2,477,694; and 2,593,603, and said registrations should be cancelled.

WHEREFORE, Petitioner requests that the Board grant this petition for cancellation.

J. CHRISTOPHER CARNOVALE

By _____

Michael A. Grow
Chiara Giuliani
Arent Fox PLLC
1050 Connecticut Avenue, NW
Washington, D.C. 20036
(202) 857-6000

Attorneys for Petitioner
June 14, 2005

United States Patent and Trademark Office
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA. 22313-1451
If Undeliverable Return in Ten Days

OFFICIAL BUSINESS
PENALTY FOR PRIVATE USE, $300

AN EQUAL OPPORTUNITY EMPLOYER

ALEXANDRIA VA

U.S. OFFICIAL MAIL
PENALTY FOR PRIVATE USE $300
PB METER 5507977
0.83
U.S. POSTAGE

RECEIVED
AUG 24 2005
USPTO MAIL CENTER

92044624

THE BRAND EXPERIENCE LLC
RIVO ALTO ISLAND US 1ST TERRANCE
MIAMI BEACH, FL 33139