

ESTTA Tracking number: **ESTTA75982**Filing date: **04/12/2006**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	DerekPeck		
Entity	Individual	Citizenship	UNITED STATES
Address	876 Valencia Street, Apt B San Francisco, CA 94110 UNITED STATES		

Attorney information	Tsan Abrahamson Cobalt, LLP 819 Bancroft Way Berkeley, CA 94710 UNITED STATES tsan@campcobalt.com, trademarks@campcobalt.com, sophie@campcobalt.com Phone:510-841-9800
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**Registration Subject to Cancellation**

Registration No	1324518	Registration date	03/12/1985
Registrant	Editorial Planeta, S.A. 273-277 Corcega St. Barcelona, SPAIN		
Goods/Services Subject to Cancellation	Class 016. First Use: 1944/00/00 , First Use In Commerce: 1954/00/00 Goods/Services: Fiction and Non-Fiction Books a Variety of Topics		
Grounds for Cancellation	The registration was obtained fraudulently.		

Related Proceedings	Opposition No. 91167364
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Attachments	Answer to opp1.pdf ( 6 pages )
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Signature	/Tsan Abrahamson/
Name	Tsan Abrahamson
Date	04/12/2006

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

In the matter of Trademark Application

Serial No.: 78/320,320  
Filed: September 20, 2003  
By: Derek Peck  
Published: October 29, 2005  
For the Trademark: PLANET

Editorial Planeta, S.A.

Opposer,

v.

Derek Peck,

Applicant.

Opposition No. 91167364

**APPLICANT’S ANSWER, AFFIRMATIVE DEFENSES, and  
PETITION TO CANCEL**

Applicant, Derek Peck (“Applicant”), by and through counsel, hereby answers the Notice of Opposition filed by Editorial Planeta, S.A. (“Opposer”) against application for registration of Applicant’s trademark PLANET (the “Mark”), filed October 29, 2003, and published in the Official Gazette of September 20, 2005 (the “Application”) pleads and avers as follows - by addressing each allegation and stating affirmative defenses.

**ANSWERS**

Answering the preamble to the Notice of Opposition on page 1 of the Notice of Opposition, Applicant is without information or belief sufficient to admit or deny the allegations concerning the Opposer’s organization, location, and/or belief with respect to the Mark, and on that basis, denies those allegations and further denies Opposer will be damaged by Applicant’s registration of the Mark.

1. Answering the allegations of Paragraph 1 of the Notice of Opposition, admits that he is seeking to register the mark PLANET for a consumer lifestyle magazine.

2. Answering the allegations of Paragraph 2 of the Notice of Opposition, Applicant admits the Opposer purports to assert ownership of the trademark, PLANETA but is without knowledge or information sufficient to form a belief as to the truth, on those grounds, denies each and every allegation of Paragraph 1 of the Notice of Opposition

3. Answering the allegations of Paragraph 3 of the Notice of Opposition, Applicant is informed that a U.S. Trademark Registration No. 1,324,518 was issued. Applicant admits Opposer purports to assert ownership of said Federal Registration, but is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 3 and, basing its denial on those grounds, denies each and every allegation of Paragraph 3 of the Notice of Opposition and further denies that Opposer is entitled to the relief sought, or damages, as alleged or at all.

4. Answering the allegations of Paragraph 4 of the Notice of Opposition, Applicant is without sufficient knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 and, basing its denial on those grounds, denies each and every allegation therein.

5. Answering the allegations of Paragraph 5 of the Notice of Opposition, Applicant denies each and every allegation therein.

6. Answering the allegations of Paragraph 6 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the language allegations of Paragraph 6 and, basing its denial on those grounds, denies each and every allegation.

7. Answering the allegations of Paragraph 7 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth

of the language allegations of Paragraph 6 and, basing its denial on those grounds, denies each and every allegation

8. Answering the allegations of Paragraph 8 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 8 and, basing its denial on those grounds, denies each and every allegation therein.

9. Answering the allegations of Paragraph 9 of the Notice of Opposition, Applicant denies each and every allegation therein and further denies that Opposer is entitled to the relief sought, or damages, as alleged or at all.

### **AFFIRMATIVE DEFENSES**

1. Applicant has superior rights in the mark PLANET.

2. Opposer relies on a trademark registration that grants rights broader than those actually used by Opposer. Had Opposer received a registration for the goods it actually markets under the mark, Opposer would have no grounds for opposition against Applicant.

3. The Notice of Opposition, and each paragraph thereof, taken individually or collectively, fails to state a cause of action upon which relief may be granted.

4. Opposer's claims for relief are barred by the equitable doctrine of unclean hands.

5. Opposer's claims are barred by the equitable doctrine of laches in that Applicant has been openly and continuously using its trademark "PLANET" in commerce.

6. Opposer lacks standing to oppose registration of the Mark in that Opposer does not have rights, superior or otherwise sufficient to support the Notice of Opposition.

7. Opposer does not possess, maintain or retain any enforceable trademark rights to the mark "PLANET."

8. Opposer has never continuously used the term "PLANET" in commerce.

9. Applicant's acts are privileged and lawful.

**PETITION FOR CANCELLATION OF REGISTRATION NO. 1,324,518**

As grounds for cancellation of Registration 1,324,518, Applicant alleges, on information and belief that:

1. Notwithstanding the fact that the referenced registration is over 5 years old and statutorily incontestable, Applicant believes, pursuant to 15 U.S.C. §1064(3), that the registration was procured fraudulently, and therefore, Applicant has standing to seek this cancellation.

2. On July 11, 1984, Opposer filed an application for registration of the PLANETA mark based upon use of all the goods listed in the identification of goods, namely, "fiction and non-fiction books on a variety of topics." On March 12, 1985, Opposer received a registration.

3. On information and belief, Applicant believes that Opposer publishes books exclusively in the Spanish language and did so at the time it filed its application.

4. At the time of filing the application, the Opposer did not disclose in the application or to the examining attorney, that the goods were sold exclusively in the Spanish language, a material omission.

5. By not disclosing information that Opposer knew, or should have known was material, Opposer's representations were misleading, and it procured a registration on fraudulent grounds.

6. On December 19, 1990 Opposer filed its Declaration of Continued Use of the mark, at which time it had an opportunity to correct the material omission and appropriately narrow the trademark registration to the goods Opposer actually sold. At that time, it failed to correct the identification of goods, thus knowingly making a false statement as to a material fact in conjunction with a trademark application.

7. On March 8, 2005, Opposer filed its combined Declaration of Use and Application for Renewal of Mark. At that time, Opposer again failed to correct the identification of goods.

8. Opposer's complete failure to make use of the mark on English book before filing its application and its repeated failures to amend the mark is not merely an oversight; it is a blatant attempt to maintain and trademark registration that exceeds its rights in the mark, and thus, constitutes fraud. Case against Applicant is based upon a trademark registration that provides Opposer rights significantly broader than its actual use.

9. Applicant believes it, and the Patent and Trademark Office will be damaged if Opposer's registration is allowed to stand.

WHEREFORE, Applicant prays that the instant opposition be dismissed, Opposer's registration be cancelled, or at the very least, be limited to books in the Spanish language only, and a Registration be issued in connection with Applicant's application Serial No. 78/320,320.

Date: April 12, 2006

**COBALT LLP**

By: /s/ Tsan Abrahamson  
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## CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 12th day of April, 2006, a true and correct copy of the foregoing Answer to the Notice of Opposition and Petition to Cancel was deposited in a U.S. Mailbox to be served upon Opposer by U.S. First Class Mail in an envelope, postage pre-paid, addressed as follows:

Julie Seyler, Esq.  
Attorney for Opposer,  
Editorial Planeta, S.A.  
Abelman Frayne & Schwab  
666 Third Avenue  
New York, NY 10017

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Norma Black