TTAB

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

Mailed: June 21, 2007

Cancellation No. 92047698
Reg. No. 3013558

76/436,565

Wilkenfeld, David
c/o Steven J. Czik
110 Greene St, Suite 1102
New York, NY 10012 UNITED STATES

Promgirl, Inc.

v.

Wilkenfeld, David

Susan Okin Goldsmith
Duane Morris LLP
744 Broad St, Ste 1200
Newark, NJ 07102 UNITED STATES

Karl Kochersperger, Paralegal

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

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. Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available on the TTAB's web page 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.

06-28-2007
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

Discovery and testimony periods are set as follows:

Discovery period to open:	**7/11/07**
Discovery period to close:	**1/7/08**
30-day testimony period for party in position of plaintiff to close:	**4/6/08**
30-day testimony period for party in position of defendant to close:	**6/5/08**
15-day rebuttal testimony period for plaintiff to close:	**7/20/08**

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* TBMP § 502.06(a) (2d ed. rev. 2004).

If the parties to this proceeding are (or during the pendency of this proceeding, become) parties to another Board or civil proceeding involving related marks or other common issues of law or fact, they shall notify the Board immediately, so that the Board can consider consolidation or suspension of proceedings, if appropriate.

New Developments at the Trademark Trial and Appeal Board

For faster handling of all papers, the TTAB strongly encourages electronic filing whenever possible. TTAB forms for electronic filings are available at http://estta.uspto.gov. Images of TTAB proceeding files can be viewed using TTABvue at http://ttabvue.uspto.gov.

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

In re Registration No. 3,013,558
Registered: November 8, 2005

PROMGIRL, INC.	
Petitioner,	
v.	
DAVID WILKENFELD	
Registrant.	

PETITION FOR CANCELLATION

Promgirl, Inc. ("Petitioner"), believes that it is and will be damaged by the continued registration on the Principal Register of the alleged mark PROM GIRL (and Design), as shown in Registration No. 3,013,558 issued on November 8, 2005 to David Wilkenfeld, an individual U.S. citizen ("Registrant"), and hereby petitions to cancel the same pursuant to Section 24 of the Trademark Act, 15 U.S.C. § 1064.

As grounds therefor, Petitioner alleges as follows:

1. On November 8, 2005, Registrant obtained a registration on the Principal Register for the alleged mark PROM GIRL (Stylized) for "Clothing or clothing accessories for women and girls, namely, dresses, blouses, skirts, shirts, pants, jeans, jumpsuits and overalls" in International Class 25. The Registration Certificate was amended as of October 24, 2006, so

that the subject of this action is now shown as a design mark, as opposed to a stylized word mark.

2. The application to register the said mark was filed on July 31, 2002 based on a bona fide intent to use the mark in connection with the goods initially identified in the application, namely "Clothing, apparel, accessories for women and girls."

3. Registrant's application was refused by the Examining Attorney based on both an unclear identification of goods and the descriptiveness of the PROM GIRL mark under Section 2(e) of the Trademark Act.

4. The Registrant's identification of goods was amended for clarification. The amended recitation included all of the goods identified above in paragraph 1.

5. With regard to the "descriptiveness" refusal, the Registrant stated on June 3, 2003, in a letter response to the Office Action, that the alleged PROM GIRL mark was intended for use in connection with sportswear or casual wear (e.g. jeans, jumpsuits, overalls), was "not intended for formal wear that young ladies would wear to a prom," and therefore was not descriptive of the goods offered in connection with the mark.

6. A Notice of Allowance was issued on December 16, 2003. The Notice of Allowance identified the following goods in Class 25: "Clothing or clothing accessories for women and girls, namely, dresses, blouses, skirts, shirts, pants, jeans, jumpsuits and overalls."

7. On May 12, 2004, Registrant filed a Statement of Use with a signed Declaration, asserting use of the alleged PROM GIRL mark in connection with all of the goods identified in the Notice of Allowance. The Declaration claimed a date of first use of November 30, 2002.

8. On information and belief, Registrant did not use, and has never used, the alleged mark in connection with all of the goods identified in the Notice of Allowance; specifically,

Registrant has never sold or offered for sale "jeans, jumpsuits and overalls" bearing the alleged mark PROM GIRL (and Design).

9. The Registrant knew or should have known at the time of responding to the Examining Attorney's Section 2(e) "descriptiveness" refusal that Registrant had no intention of using the alleged mark in connection with "sportswear and/or casual wear."

10. The alleged mark, PROM GIRL (and Design) is and has been used solely in connection with formal wear of the type worn by young ladies at proms.

11. The response to the Office Action that was submitted on June 3, 2003 included materially false statements about the intended use of the alleged mark, which were intended to induce the Examining Attorney to pass the application through to publication, and which did result in withdrawal of the "descriptiveness" objection by the Examining Attorney.

12. Registrant knew or should have known at the time of submission of the Statement of Use and Declaration, that Registrant was not actually using the alleged mark in commerce in connection with all goods identified in the Notice of Allowance.

13. The Statement of Use made materially false statements about the use of the alleged mark on all of the goods identified in the Notice of Allowance.

14. The subject registration was secured through materially false statements made in (a) the June 3, 2003 letter response to an Office Action and (b) the Statement of Use. False statements with regard to use of the mark constitute fraud in the securing and maintenance of the registration of a federal trademark and are grounds for the cancellation thereof pursuant to 15 U.S.C. § 1064(3).

15. Registrant's alleged mark, PROMGIRL (and Design), is substantially identical to the Petitioner's business name, Promgirl, Inc., and the name used in its business directed to prom

girls and conducted through the website <www.promgirl.net> since prior to July 31, 2002, the filing date of the application that resulted in the subject registration.

16. Registrant fraudulently obtained registration of the subject of this cancellation action, for a mark that is used on goods which are similar or related to those sold by Petitioner, and which are used by both parties to provide goods and/or services to prom girls.

17. Registrant obtained registration of a mark that is descriptive of the goods and/or services offered by both Registrant and Petitioner.

18. Registration of the mark which is the subject of this cancellation action has caused damage and injury to Petitioner, in that the Registrant, his licensee or related company, has asserted registration of the alleged mark in a claim of trademark infringement by Petitioner.

WHEREFORE, Petitioner requests that Registration No. 3,013,558 be canceled.

Respectfully submitted,

DUANE MORRIS LLP

Dated: June 20, 2007

By: /Susan Goldsmith/
Susan Okin Goldsmith

Attorney for Petitioner
Promgirl, Inc.
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(973) 424-2064

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Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov
ESTTA Tracking number: **ESTTA146751**
Filing date: **06/20/2007**

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	Promgirl, Inc.		
Entity	Corporation	Citizenship	Pennsylvania
Address	311 Fawn Hill Lane Narberth, PA 19072-1106 UNITED STATES		

Attorney information	Susan Okin Goldsmith Duane Morris LLP 744 Broad Street Suite 1200 Newark, NJ 07102 UNITED STATES sogoldsmith@duanemorris.com Phone:9734242064

Registration Subject to Cancellation

Registration No	3013558	Registration date	11/08/2005
Registrant	Wilkenfeld, David c/o Steven J. Czik, Esq. 110 Greene Street Suite 1102 New York, NY 10012 UNITED STATES		
Goods/Services Subject to Cancellation	Class 025. First Use: 2002/11/30 , First Use In Commerce: 2002/11/30 Goods/Services: Clothing or clothing accessories for women and girls, namely, dresses, blouses, skirts, shirts, pants, jeans, jumpsuits and overalls		

Related Proceedings	Opposition No. 91177463 has been filed by this Petitioner against the named owner of a related mark.

Attachments	PROMGIRL Petition for Cancellation of PROM GIRL in Class 25.pdf (4 pages)(14694 bytes)

Signature	/Susan Goldsmith/
Name	Susan Okin Goldsmith
Date	06/20/2007

United States Patent and Trademark Office
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92047698

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