

ESTTA Tracking number: **ESTTA230474**

Filing date: **08/14/2008**

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	Ms. Cecilia Holmes		
Entity	Individual	Citizenship	UNITED STATES
Address	8 East 110th Street Apt. 1E New York, NY 10029 UNITED STATES		

Attorney information	Perla M. Kuhn, Mary Elizabeth Pierce Hughes Hubbard & Reed, LLP One Battery Park Plaza New York, NY 10004 UNITED STATES kuhn@hugheshubbard.com, pierce@hugheshubbard.com Phone:212.837.6000		
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Registration Subject to Cancellation

Registration No	2614467	Registration date	09/03/2002
Registrant	Parham, Toikeon c/o John Ferguson MUSO Entertainment3575 West Cahuenga Boulevard, Suite 524 Los Angeles, CA 90068 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 1998/02/00 First Use In Commerce: 1998/02/00 All goods and services in the class are cancelled, namely: musical sound recordings; pre-recorded video cassettes featuring music, pre-recorded audio cassettes featuring music, and compact discs featuring music
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Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
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Related Proceedings	Application for Trademark Registration, Serial No. 77320809
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77320809	Application Date	11/03/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TOY !!!		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1992/11/23 First Use In Commerce: 1992/11/23 Entertainment in the nature of live performances by a female entertainer

U.S. Registration No.	1865426	Application Date	09/10/1992
Registration Date	11/29/1994	Foreign Priority Date	NONE
Word Mark	MC TOY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1993/08/16 First Use In Commerce: 1993/08/16 entertainment in the nature of a musical group		

Attachments	77320809#TMSN.jpeg (1 page)(bytes) #60375580, v1 _EAST_ - Petition for Cancellation_ MS. TOI_pdf - WorkSite Acrobat Integration.pdf (5 pages)(209740 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mary Elizabeth Pierce/
Name	Perla M. Kuhn, Mary Elizabeth Pierce
Date	08/14/2008

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

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Cecilia Holmes,	:
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Petitioner,	:
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-v-	:
	:
Toikeon Parham,	:
	:
Respondent.	:
	:
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PETITION FOR CANCELLATION

Petitioner, Cecilia Holmes (“Petitioner”), an individual, having a principal business address of 8 E. 110th St., Apt 1E, New York, NY, 10029-3111, believes that she will be damaged by the continued existence of the above-identified registration for the trademark MS. TOI in the name of Toikeon Parham (“Respondent”) on the Principal Register, and hereby petitions to cancel the same.

As grounds for this Cancellation, Petitioner relies upon the rights developed by her and alleges on knowledge as to herself and otherwise upon information and belief, as follows:

1. Petitioner is a female entertainer whose professional work under the mark TOY !!! includes live performance, sound recordings, songwriting, merchandising, and voice-overs in film and television.
2. Petitioner commenced use of the mark TOY !!! in commerce with the United States in connection with music and live entertainment at least as early as 1991.

3. Petitioner has continuously used the mark TOY !!! and variations thereof (e.g., TOY and MC TOY) in this professional capacity since at least as early as 1991.

4. On November 29, 1994, Petitioner obtained Registration No. 1,865,426 for the mark MC TOY in connection with “entertainment in the nature of a musical group” in International Class (“IC”) 041 (the “MC TOY Registration”).

5. On June 1, 2001, Petitioner filed a Section 8 declaration of continued use and a Section 15 declaration of incontestability for the MC TOY Registration, which filings the PTO accepted and acknowledged on July 28, 2001. On September 3, 2005, No. 1,865,426 became cancelled because Petitioner inadvertently did not file the renewal papers.

6. Petitioner has expended substantial amounts of time and effort in advertising and promoting herself under the TOY !!! mark. As a result of such advertising and promotional activities, the TOY !!! mark has become well known, the relevant public has come to associate and identify the TOY !!! mark with Petitioner and Petitioner derives substantial goodwill from such identification by consumers.

7. On September 3, 2002, Respondent obtained Registration No. 2,614,467 for the mark MS. TOI, which covers “musical sound recordings, pre-recorded video cassettes featuring music, pre-recorded audio cassettes featuring music, and compact discs featuring music” in International Class 9 (the “MS. TOI Registration”). The MS. TOI Registration claims February 1998 as the date of first use by the mark MS. TOI. Respondent is the owner of record for the MS. TOI Registration.

8. On November 3, 2007, Petitioner filed an application to register the trademark TOY !!! (Ser. No. 77/320,809) for “entertainment in the nature of live performance by a female” in IC 041 (the “TOY !!! Application”).

9. On February 15, 2008, the PTO issued an Office Action refusing registration of the mark TOY !!! based on a likelihood of confusion with the MS. TOI Registration.

Count One: Likelihood of Confusion

10. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 9 hereof as if fully set forth herein.

11. The MS. TOI Registration, as set forth in the registrations opposed herein, is substantially similar in commercial impression to Petitioner’s mark TOY !!!.

Respondent’s mark MS. TOI and Petitioner’s mark TOY !!! both incorporate alternate spellings of the term “toy.” The marks have nearly identical sounds. The marks differ only by their spellings of the term “toy” and by the inclusion of “!!!” in Petitioner’s mark and the term “MS.” in Respondent’s mark. The additional elements do not serve to distinguish the marks. The respective goods and services are proximate as musical recordings and performances by a musician are very similar.

12. Accordingly, Respondent’s mark is likely to cause confusion, mistake or to deceive the public into believing the Respondent’s goods are somehow affiliated or associated with, connected to or sponsored by Petitioner, and registration must be refused under Section 2(d) of the Lanham Act.

13. Petitioner’s Mark has an earlier date of first use and therefore has priority over Respondent’s Mark.

Count Two: False Suggestion of Connection

14. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 13 hereof as if fully set forth herein.

15. Petitioner has no connection with the activities performed by Respondent under the MS. TOI Registration.

16. Petitioner has continuously used the mark TOY !!! and variations thereof (e.g. TOY and MC TOY) as her professional name since at least as early as 1991, and she obtained registration for the mark MC TOY in November 1994.

17. Respondent's first use of the MS. TOI mark was not until at least 1998, and Respondent did not obtain the MS. TOI Registration until September 3, 2002, after Petitioner's mark was in use for approximately six years.

18. The MS. TOI Registration is a close approximation of Petitioner's previously used professional names and identity, MC TOY and TOY Respondent's mark MS. TOI and Petitioner's mark TOY !!! both incorporate alternate spellings of the term "toy." The marks have nearly identical sounds. The marks differ only by their spellings of the term "toy" and by the inclusion of "!!!" in Petitioner's mark and the term "MS." in Respondent's mark. The additional elements do not serve to distinguish the marks. They are closely related as musical recordings and performances by a musician are very similar.

19. The TOY !!! mark has become well known and closely associated with Petitioner's identity and persona among a relevant and identifiable customer base, namely the specialized market segment comprised of listeners of contemporary music.

20. Accordingly, Respondent's MS. TOI mark falsely suggests a connection with Petitioner's MC TOY and TOY !!! mark, and thus is likely to harm Petitioner's ability to protect her identity and persona developed under the mark TOY!!!, and registration must therefore be refused under Section 2(a) of the Lanham Act.

21. Petitioner will be damaged by the continued existence of the MS. TOI Registration on the Register because it gives color of rights to Respondent in the mark MS. TOI, infringes Petitioner's mark TOY !!!, impedes her ability to protect the identity and persona she has developed under the name TOY !!!, and will continue to be an impediment to Petitioner's ability to register the mark TOY !!!.

WHEREFORE, Petitioner prays that this petition to cancel be granted and that Reg. No. 2,614,467 for the mark MS. TOI be cancelled.

Dated: New York, New York
August 13, 2008

Respectfully submitted,
HUGHES HUBBARD & REED LLP

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Attorneys for Petitioner

CERTIFICATE OF MAILING

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, P.O. Box 1451, Alexandria, VA 22313-1451.

on M.E.P.
HUGHES HUBBARD & REED LLP

Dated: 8/14/08 By: M.E. PIERCE
Name: