

ESTTA Tracking number: **ESTTA300034**

Filing date: **08/10/2009**

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	Lorenzo Jewelry Limited		
Entity	Corporation	Citizenship	Hong Kong
Address	Unit No. 12, 12/F, Block A Focal Ind. Center 21 Man Lok Street Hungghom, Kowloon, HONG KONG		

Attorney information	James M. Slattery BIRCH, STEWART, KOLASCH & BIRCH, LLP PO Box 747 Falls Church, VA 22040-0747 UNITED STATES jms@bskb.com, johnst@bskb.com, mailroom@bskb.com, bg@bskb.com Phone:703-205-8000		
----------------------	--	--	--

Registration Subject to Cancellation

Registration No	3142782	Registration date	09/12/2006
Registrant	Simon Golub & Sons, Inc. P.O. Box 80866 Seattle, WA 98108 UNITED STATES		

Goods/Services Subject to Cancellation

Class 014. First Use: 2006/06/01 First Use In Commerce: 2006/06/01 All goods and services in the class are cancelled, namely: Jewelry
--

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2887427	Application Date	04/26/2001
Registration Date	09/21/2004	Foreign Priority Date	NONE
Word Mark	LORENZO YIH		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 014. First use: First Use: 2004/05/03 First Use In Commerce: 2004/05/03 Jewelry; loose semi-precious gemstones; jewelry settings made of precious metal

U.S. Application No.	78387788	Application Date	03/19/2004
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	LORENZO
-----------	---------

Design Mark	
-------------	---

Description of Mark	NONE
---------------------	------

Goods/Services	Class 014. First use: Jewelry, in particular diamond, pearl, precious and semi-precious gems, precious metals and their alloys; jewelry with diamond, pearl, precious and semi-precious gems set into or attached to various metals, alloys and mixed metals; goods of precious metals or coated therewith, namely, earrings, rings, necklaces, pendants, chains, bracelets, charms, tie tacks, tie pins, tie bars, lapel pins, cufflinks, brooches, buckles, lockets, anklets, money clips, jewel boxes and cases
----------------	---

Attachments	78387788#TMSN.jpeg (1 page)(bytes) 2009-08-10 Petition for Cancellation.pdf (20 pages)(2357920 bytes)
-------------	---

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	/Robert J. Kenney/
Name	James M. Slattery
Date	08/10/2009

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

IN THE TRADEMARK REGISTRATION OF

Registration No.: 3,142,782
Granted: September 12, 2006
Mark: ADRIANO LORENZO
Class: Int'l. Class 14

LORENZO JEWELRY LIMITED)	
)	
Petitioner,)	
)	Cancellation
v.)	
)	
SIMON GOLUB & SONS, INC.)	
)	
Respondent)	

ATTN: BOX TTAB

PETITION FOR CANCELLATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Petitioner, LORENZO JEWELRY LTD. (hereinafter, "Petitioner"), a corporation of Hong Kong, organized under the law of Hong Kong, with a business address at Unit No. 12, 12/F., Block A, Focal Ind. Center, 21 Man Lok Street, Hunghom, Kowloon, Hong Kong, believes that it will be damaged by Registration No. 3,142,782, and hereby petitions to cancel said registration.

1. Since 1987, Petitioner has been using the business names “LORENZO,” the first name of Mr. Lorenzo Yih, the founder of “Lorenzo Jewelry Manufacturing (H.K.) Limited,” the former name of Petitioner’s corporation.

2. On or about 2000, Petitioner first adopted the name “LORENZO” as a trademark for jewelry products.

3. Since then, Petitioner sold jewelry products under the mark “LORENZO” in the U.S. and other parts of the world through the Petitioner’s distributors. See Exhibit 1.

4. Petitioner is the owner of Registration No. 2,887,427 for the mark “LORENZO YIH” registered on September 21, 2004, in connection with “jewelry; loose semi-precious gemstones; jewelry settings made of precious metal,” in International Class 14, in the U.S. Patent and Trademark Office. This trademark registration is still valid and in full force and effect. See Exhibit 2.

5. In addition, Petitioner is the owner of U.S. Application No. 78/387,788 for the mark “LORENZO” filed on March 19, 2004, used in connection with “jewelry, in particular diamond, pearl, precious and semi-precious gems, precious metals and their alloys; jewelry with diamond, pearl, precious and semi-precious gems set into or attached to various metals, alloys and mixed metals; goods of precious metals or coated therewith, namely, earrings, rings, necklaces, pendants, chains, bracelets, charms, tie tacks, tie pins, tie bars, lapel pins, cufflinks, brooches, buckles, lockets, anklets, money

clips, jewel boxes and cases,” in International Class 14, with a claim of intent to use of the mark. This application is presently pending. See Exhibit 3.

6. Respondent, Simon Golub & Sons, Inc., a corporation of Washington, with a business address of P. O. Box 80866, Seattle, Washington, U.S.A., owns the mark “ADRIANO LORENZO” under Registration No. 3,142,782, registered on September 12, 2006, in connection with “jewelry” in International Class 14. The first date of use of this mark in commerce is claimed as June 1, 2006. See Exhibit 4.

7. The Trademark Attorney in the USPTO cited Registration No. 3,142,782, to refuse registration of the Petitioner’s application under Application No. 78/387,788.

8. Petitioner has advertised its mark “LORENZO” in connection with jewelry products in the United States in the past nine (9) years.

9. Petitioner has established a reputation with regard to the jewelry products through use of the mark “LORENZO” since May, 2000 in the United States, and the Petitioner’s marks have become famous in the United States. The Petitioners’ marks are symbolic of extensive goodwill and consumer recognition built up by the Petitioner through a substantial amount of time, effort and expense in promoting and selling goods using the Petitioner’s marks. Therefore, the Petitioner’s marks have become distinctive and famous among its customers.

10. Respondent is not a true owner of the mark. As the trademark owner and manufacturer, Petitioner agreed to appoint the Respondent as the

U.S. distributor for all Petitioners' "LORENZO" branded jewelry products in the United States in November, 2001.

11. Respondent filed the U.S. Trademark Application No. 78/163,641 for the mark "ADRIANO LORENZO" on September 12, 2002 without the authorization and knowledge of the Petitioner.

12. Petitioner learned of the filing of the U.S. application under 78/163,641 by Respondent after a Notice of Publication was issued on April 2, 2003.

13. After the Petitioner communicated with the representative for Respondent on April 15, 2003, regarding the fact of the filing of the trademark application by Respondent, Petitioner requested the representative to assign the legal ownership of the mark "ADRIANO LORENZO" as set forth in Application No. 78/163,641 to Petitioner and this was agreed by the representative of Respondent on May 6, 2003.

14. Petitioner was also asked to reimburse the Respondent's legal costs for the registration of the mark "ADRIANO LORENZO" and the Petitioner actually did reimburse the Respondent for the legal costs.

15. Petitioner believes that the goods set forth in the Respondent's mark are closely related to the goods used under the Petitioner's marks in International Class 14. It is believed that such use by the Registrant is likely to cause confusion, deception and mistake, all to the Petitioner's damage.

16. Petitioner believes there is a likelihood of confusion between the Petitioner's marks and the Registrant's mark in appearance, pronunciation and meaning, all to the Petitioner's damage.

17. During prosecution of the Petitioner's Application No. 78/387,788, Petitioner has negotiated with the Respondent in an attempt to obtain an assignment of the Respondent's trademark under Registration No. 3,142,782, but failed to do so.

18. Petitioner is the true owner of the mark "ADRIANO LORENZO" in connection with the goods set forth in Registration No. 3,142,782, in the United States.

19. The registration and use of the Respondent's mark in connection with the related goods have diluted Petitioner's Registration No. 2,887,427, all to the damage of the Petitioner.

20. Respondent obtained Registration No. 3,142,782 fraudulently by claiming that he "believes the Applicant to be the owner of the trademark/service mark sought to be registered" and "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near a resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive" in Application No. 78/163,641, which became Registration No. 3,142,782, all to the damage of the Petitioner. See Exhibit 5.

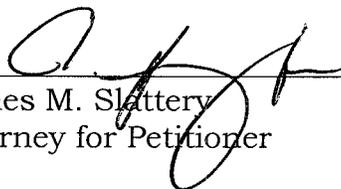
21. Petitioner believes that it will be damaged by registration of the mark shown in the above-identified application Registration No. 3,142,782 and hereby petitions for cancellation of the same.

WHEREFORE, Petitioner prays that Registration No. 3,142,782 be canceled in favor of Petitioner.

The fee in the amount of \$300.00 for filing the Petition for Cancellation should be charged to the Deposit Account No. 02-2448.

Respectfully submitted,

Date: August 10, 2009



James M. Slattery
Attorney for Petitioner

JMS/BG/adt
BS

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing PETITION FOR CANCELLATION has been served upon counsel for the Opposer:

Susan Thorbrogger
SHORT CRESSMAN & BURGESS PLLC
999 Third Avenue, Suite 3000
Seattle, WA. 98104
Phone: 206-682-3333
Fax: 206-340-8856

via first-class mail, postage prepaid, on this 10th day of August, 2009.

By Tiffany C. Jansen.

As seen in

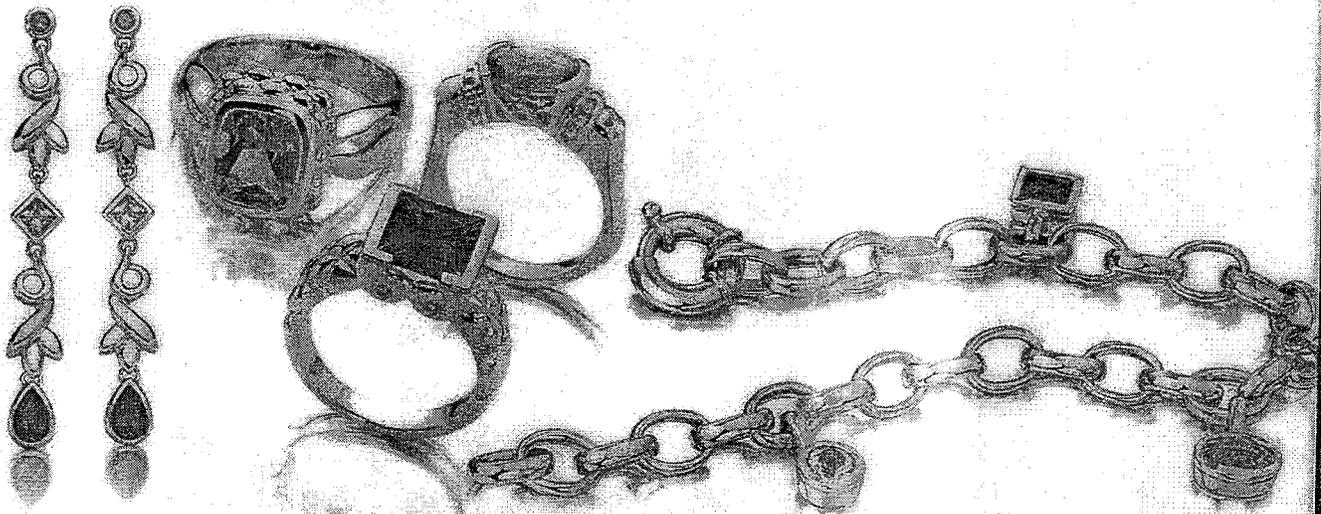
FACETS

FOR JEWELRY LOVERS & WATCH ENTHUSIASTS

Sterling · 18K gold · Color

Contemporary sterling
silver & 18K gold jewelry
paired with the world's
most exquisite gemstones.

Vibrant color,
exceptional faceting,
superb quality.



LORENZO
Artistic Expressions in Sterling & 18 Karat Gold

As seen in

FACETS
FOR JEWELRY LOVERS & WATCH ENTHUSIASTS

18K gold. Pavé. Color

Feminine
sophisticated
jewelry designs
pairing premier gemstone
& diamond pavé...
a vision of beauty
from all sides.



LORENZO
18 Karat Gold Expressions

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-07-28 16:14:29 ET

Serial Number: 78060462 Assignment Information Trademark Document Retrieval

Registration Number: 2887427

Mark (words only): LORENZO YIH

Standard Character claim: No

Current Status: Registered.

Date of Status: 2004-09-21

Filing Date: 2001-04-26

Transformed into a National Application: No

Registration Date: 2004-09-21

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2004-10-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. LORENZO JEWELRY LIMITED

Composed Of:

CHANGE OF NAME

Address:

LORENZO JEWELRY LIMITED

UNIT NO. 12, 12/F, BLOCK A FOCAL IND. CENTER 21 MAN LOK ST.

HUNGHOM, KOWLOON

Hong Kong

Legal Entity Type: Corporation

State or Country of Incorporation: Hong Kong

GOODS AND/OR SERVICES

International Class: 014

Class Status: Active

Jewelry; loose semi-precious gemstones; jewelry settings made of precious metal

Basis: 1(a)

First Use Date: 2004-05-03

First Use in Commerce Date: 2004-05-03

ADDITIONAL INFORMATION

Name Portrait Consent: The name "LORENZO YIH" identifies a living individual whose consent is of record.

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2004-09-21 - Registered - Principal Register

2004-07-12 - Allowed for Registration - Principal Register (SOU accepted)

2004-06-28 - Assigned To Examiner

2004-06-23 - Statement of use processing complete

2004-05-18 - Amendment to Use filed

2004-06-01 - Extension 2 granted

2004-05-18 - Extension 2 filed

2004-05-28 - Case File In TICRS

2004-05-18 - PAPER RECEIVED

2004-04-26 - Assigned To Examiner

2004-01-08 - Extension 1 granted

2003-11-20 - Extension 1 filed

2003-11-20 - PAPER RECEIVED

2003-05-20 - Noa Mailed - SOU Required From Applicant

2002-09-23 - PAPER RECEIVED

2002-08-15 - Extension Of Time To Oppose Received

2002-07-16 - Published for opposition

2002-06-26 - Notice of publication

2002-05-09 - PAPER RECEIVED

2002-04-11 - PAPER RECEIVED

2002-04-11 - Approved for Pub - Principal Register (Initial exam)

2002-04-01 - Previous allowance count withdrawn

2002-03-11 - Approved for Pub - Principal Register (Initial exam)

2001-08-15 - Communication received from applicant

2001-12-20 - Communication received from applicant

2001-08-10 - Non-final action mailed

2001-07-20 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

JAMES M. SLATTERY

Correspondent

JAMES M. SLATTERY

BIRCH STEWART KOLASCH & BIRCH LLP

PO BOX 747

FALLS CHURCH, VA 22040-0747



United States Patent and Trademark Office

[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)



Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 1

Serial #: 78060462

Filing Dt: 04/26/2001

Reg #: 2887427

Reg. Dt: 09/21/2004

Registrant: LORENZO JEWELRY LIMITED

Mark: LORENZO YIH

Assignment: 1

Reel/Frame: 2598/0419

Received: 10/16/2002

Recorded: 09/23/2002

Pages: 3

Conveyance: CHANGE OF NAME

Assignor: LORENZO JEWELRY MFG. (H.K.) LIMITED

Exec Dt: 05/02/2002

Entity Type: CORPORATION

Citizenship: HONG KONG

Assignee: LORENZO JEWELRY LIMITED

UNIT NO. 12, 12/F, BLOCK A FOCAL IND.

CENTER 21 MAN LOK ST.

HUNGHOM, KOWLOON, HONG KONG

Entity Type: CORPORATION

Citizenship: HONG KONG

Correspondent: BIRCH, STEWART, KOLASCH ET AL.

JAMES M. SLATTERY

P.O. BOX 747

FALLS CHURCH, VA 22040-0747

Search Results as of: 07/28/2009 04:14 PM

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350.

Web interface last modified: October 18, 2008 v.2.0.2

| [.HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-07-28 16:15:47 ET

Serial Number: 78387788 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark



(words only): LORENZO

Standard Character claim: Yes

Current Status: An ex parte appeal of a final refusal to register the applied for mark is pending before the Trademark Trial and Appeal Board.

Date of Status: 2009-02-17

Filing Date: 2004-03-19

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 101

Attorney Assigned:
STOIDES KATHERINE

Current Location: L1X -TMEG Law Office 101 - Examining Attorney Assigned

Date In Location: 2008-08-10

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Lorenzo Jewelry Ltd.

Address:
Lorenzo Jewelry Ltd.

Unit No. 12, 12/F., Block A, Focal Ind. Center, 21 Man Lok Street, Hunghom;
Kowloon
Hong Kong
Legal Entity Type: Corporation
State or Country of Incorporation: Hong Kong

GOODS AND/OR SERVICES

International Class: 014

Class Status: Active

Jewelry, in particular diamond, pearl, precious and semi-precious gems, precious metals and their alloys; jewelry with diamond, pearl, precious and semi-precious gems set into or attached to various metals, alloys and mixed metals; goods of precious metals or coated therewith, namely, earrings, rings, necklaces, pendants, chains, bracelets, charms, tie tacks, tie pins, tie bars, lapel pins, cufflinks, brooches, buckles, lockets, anklets, money clips, jewel boxes and cases

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Name Portrait Consent: The name "Lorenzo" identifies a living individual whose consent is of record.

Prior Registration Number(s):

2887427

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-02-17 - Ex parte appeal - Instituted

2009-02-13 - EXPARTE APPEAL RECEIVED AT TTAB

2008-08-10 - Notification Of Final Refusal Emailed

2008-08-10 - Final refusal e-mailed

2008-08-10 - Final Refusal Written

2008-04-22 - Amendment From Applicant Entered

2008-04-22 - Communication received from applicant

2008-04-21 - PAPER RECEIVED

2007-10-22 - Notification Of Non-Final Action E-Mailed

2007-10-22 - NON-FINAL ACTION E-MAILED

2007-10-22 - Non-Final Action Written

2007-09-27 - LIE Checked Susp - To Atty For Action

2007-02-21 - Report Completed Suspension Check Case Still Suspended

2007-02-21 - Assigned To LIE

2006-08-10 - LETTER OF SUSPENSION E-MAILED

2006-08-10 - Suspension Letter Written

2006-08-03 - Amendment From Applicant Entered

2006-07-14 - Communication received from applicant

2006-07-14 - PAPER RECEIVED

2006-01-10 - LETTER OF SUSPENSION E-MAILED

2006-01-10 - Suspension Letter Written

2005-12-02 - Amendment From Applicant Entered

2005-11-15 - Communication received from applicant

2005-11-15 - PAPER RECEIVED

2005-05-13 - LETTER OF SUSPENSION E-MAILED

2005-05-13 - Suspension Letter Written

2005-04-11 - Amendment From Applicant Entered

2005-03-29 - Communication received from applicant

2005-03-29 - PAPER RECEIVED

2004-09-29 - Non-final action e-mailed

2004-09-29 - Non-Final Action Written

2004-09-29 - Assigned To Examiner

2004-03-31 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

James M. Slattery

Correspondent

JAMES M SLATTERY

BIRCH, STEWART, KOLASCH & BIRCH LLP

PO BOX 747

FALLS CHURCH, VA 22040-0747

Phone Number: (703) 205-8000

Fax Number: (703) 205-8050

Domestic Representative

James M. Slattery

Phone Number: (703) 205-8000

Fax Number: (703) 205-8050

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-07-21 15:42:34 ET

Serial Number: 78163641 Assignment Information Trademark Document Retrieval

Registration Number: 3142782

Mark (words only): ADRIANO LORENZO

Standard Character claim: No

Current Status: Registered.

Date of Status: 2006-09-12

Filing Date: 2002-09-12

Transformed into a National Application: No

Registration Date: 2006-09-12

Register: Principal

Law Office Assigned: LAW OFFICE 117

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-08-04

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Simon Golub & Sons, Inc.

Address:

Simon Golub & Sons, Inc.
P.O. Box 80866
Seattle, WA 98108
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Washington

Phone Number: 206-762-4800

Fax Number: 206-767-6870

GOODS AND/OR SERVICES

International Class: 014
Class Status: Active
Jewelry
Basis: 1(a)
First Use Date: 2006-06-01
First Use in Commerce Date: 2006-06-01

ADDITIONAL INFORMATION

Name Portrait Consent: The name in the mark does not identify a living individual.

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2006-09-12 - Registered - Principal Register
2006-07-29 - Law Office Registration Review Completed
2006-07-28 - Assigned To LIE
2006-07-14 - Allowed for Registration - Principal Register (SOU accepted)
2006-07-13 - Statement of use processing complete
2006-06-21 - Amendment to Use filed
2006-06-21 - TEAS Statement of Use Received
2006-01-10 - Extension 5 granted
2006-01-10 - Extension 5 filed
2006-01-10 - TEAS Extension Received
2005-07-12 - Extension 4 granted
2005-07-12 - Extension 4 filed
2005-07-12 - TEAS Extension Received
2005-01-10 - Extension 3 granted
2004-12-20 - Extension 3 filed

2004-12-20 - TEAS Extension Received
2004-08-03 - Extension 2 granted
2004-07-07 - Extension 2 filed
2004-07-14 - Case File In TICRS
2004-07-07 - TEAS Extension Received
2004-03-08 - PAPER RECEIVED
2004-03-04 - FAX RECEIVED
2004-03-01 - TEAS Change Of Correspondence Received
2003-08-13 - Extension 1 granted
2003-08-04 - Extension 1 filed
2003-08-04 - TEAS Extension Received
2003-07-15 - Noa Mailed - SOU Required From Applicant
2003-04-22 - Published for opposition
2003-04-02 - Notice of publication
2003-02-11 - Approved for Pub - Principal Register (Initial exam)
2003-02-06 - Examiner's amendment mailed
2003-01-31 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Zachary A. Wright

Correspondent

Susan Thorbrogger
Short Cressman & Burgess PLLC
Suite 3000
999 Third Avenue
Seattle WA 98104
Phone Number: 206-682-3333
Fax Number: 206-340-8856

