

ESTTA Tracking number: **ESTTA303544**

Filing date: **08/28/2009**

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	Secret Charm LLC		
Entity	Limited Liability Company	Citizenship	California
Address	1437 East 20th Street Los Angeles, CA 90011 UNITED STATES		

Attorney information	Brent LaBarge ARNOLD & PORTER LLP 555 12th Street, N.W. Trademark Docketing Washington, DC 20004 UNITED STATES TrademarkDocketing@aporter.com Phone:202-942-5000		
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Registration Subject to Cancellation

Registration No	3231154	Registration date	04/17/2007
Registrant	Yaeger-Wolfe, Rebecca 6861 E. 9th Street Long Beach, CA 90815 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2005/05/00 First Use In Commerce: 2005/05/00 All goods and services in the class are cancelled, namely: Clothing, namely dresses, jackets, skirts, jumpsuits, tops, blouses
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Grounds for Cancellation

False suggestion of a connection	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)
Other	Failure to use the AS U WISH mark in commerce; Respondent is not the proper owner of the mark (Trademark Act section 1)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	AS U WISH		

Goods/Services	Clothing, namely dresses
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Attachments	3231154.PetitionToCancel.pdf (8 pages)(622088 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	/Brent LaBarge/
Name	Brent LaBarge
Date	08/28/2009

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

SECRET CHARM LLC)	
)	
Petitioner,)	Cancellation No. _____
)	
v.)	Registration No. 3,231,154
)	
REBECCA YAEGER-WOLFE,)	Mark: AS U WISH
)	
Respondent.)	
)	

PETITION TO CANCEL

Secret Charm LLC, a California limited liability company with its principal place of business at 1437 East 20th Street, Los Angeles, California 90011 (“Petitioner”), believes that it is being damaged and will continue to be damaged by Rebecca Yaeger-Wolfe’s (“Respondent”) registration of AS U WISH, Registration No. 3,231,154 (“Respondent’s Registration”), and hereby petitions to cancel the same pursuant to Section 14 of the Lanham Act (15 U.S.C. § 1064) and Section 2.111 of the Trademark Rules of Practice.

The grounds for cancellation in this Petition are: Respondent’s false claim of ownership of the AS U WISH mark made during the prosecution of the application resulting in her obtaining Respondent’s Registration; Respondent’s assertion of knowingly false statements and representations made to procure Respondent’s Registration; Respondent’s failure to use the AS U WISH mark in commerce; and a likelihood of confusion between Respondent’s Registration and Petitioner’s AS U WISH mark.

Petitioner hereby alleges as follows:

1. Petitioner is a California limited liability company formed in September 2003 that manufactures and sells women's and children's apparel. Petitioner consists of three divisions, including a division that goes by the trade name "AS U WISH." The "AS YOU WISH" division was formed and began operations in 2004-2005 to market and sell women's clothing. Petitioner's clothing items (specifically dresses) offered under the AS U WISH mark have been sold and shipped to customers throughout the United States, including in California and New York.

2. Petitioner has continuously and exclusively used the AS U WISH mark in connection with the sale of dresses since at least as early as July 6, 2005.

3. Petitioner has invested significant resources to promote its goods sold under the AS U WISH mark through, among other things, the Internet and store and print advertising. Through promotion and sales of its goods, the AS U WISH mark has become associated with Petitioner and its goods in the U.S., and consumers have come to rely on the AS U WISH mark to identify Petitioner's goods and to distinguish them from the goods of its competitors.

4. Petitioner has significant common law rights in its AS U WISH mark and has developed valuable goodwill with respect to its AS U WISH mark.

5. On or about May 2, 2005, Respondent was hired by Petitioner as a Senior Vice President of what would come to be known as the "AS U WISH" Division.

6. On May 24, 2005, while Respondent was employed by Petitioner, an intent-to-use application under Section 1(b) of the Trademark Act was filed for "[c]lothing, namely dresses, jackets, skirts, pants, jumpsuits, tops, blouses, sweaters and coats" in Class 25 for the mark AS U WISH and assigned Serial No. 78/636,465. The application designated Respondent as the "applicant" and identified her as an "individual." The U.S. Patent and Trademark Office

(USPTO) online database records for this application reflect that it was signed by Respondent.

This application to register the mark in her own name was filed while Respondent was employed by Petitioner and without authorization or permission of Petitioner.

7. On November 9, 2006, a Statement of Use was submitted in connection with application Serial No. 78/636,465, attesting to the truth of the statement that Respondent had adopted and was using the AS U WISH mark for “[c]lothing, namely dresses, jackets, skirts, jumpsuits, tops, blouses” (deleting “pants, sweaters, and coats” from the original description of goods). In addition, Respondent asserted that the dates of first use of the AS U WISH mark anywhere and in interstate commerce were “May 2005.” The USPTO online database records for the Statement of Use reflect that it was signed by Respondent. The statements made in the Statement of Use were material to the approval of the application and issuance of Respondent’s Registration.

8. On April 17, 2007, a registration issued for the AS U WISH mark for “[c]lothing, namely dresses, jackets, skirts, jumpsuits, tops, blouses” in Class 25 designating Respondent -- as an individual -- as the owner of the registration, which was assigned Reg. No. 3,231,154.

9. Petitioner is, and at all times herein was, the owner of the AS US WISH mark for apparel, specifically dresses. Respondent was not the owner of the mark at the time the application detailed in Paragraph 6 above was filed.

10. Respondent, in her individual capacity, was not the owner of or entitled to use the AS U WISH mark at the time the application was filed; therefore, the application was void *ab initio* under Trademark Act § 1, 15 U.S.C. § 1051, because the Application was not filed by the true owner of the mark. As a result, Respondent’s Registration, which matured from this application, should be cancelled.

11. Petitioner further alleges, on information and belief, that Respondent's Registration was obtained fraudulently and should therefore be cancelled since Respondent, under notice of 18 U.S.C. § 1001, knowingly and willfully made false and/or fraudulent declarations or representations to the USPTO concerning at least the following: Respondent's bona fide intent and entitlement to use the mark; her ownership and use of the mark; the dates of first use of the mark; and the goods on which the mark was used.

12. In the application for AS U WISH detailed in Paragraph 6 above, Respondent falsely represented under penalty of perjury that she had a bona fide intent to use the mark on all of the goods in the application, and that she "believes [herself] to be entitled to use such mark in commerce" and that "to the best of . . . her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce." These statements were false since Petitioner was the exclusive owner of the mark.

13. On information and belief, Respondent knew or should have known that statements in the application regarding her bona fide intent and entitlement to use the mark to the exclusion of others were false and were made with the intent to induce authorized agents of the USPTO to grant Respondent's Registration.

14. In the Statement of Use for AS U WISH detailed in Paragraph 7 above, Respondent falsely represented under penalty of perjury that she was the owner of the mark; that she used the mark; that the mark was in use with the goods as of May 2005; and that the mark was in use with jackets, skirts, jumpsuits, tops, blouses. These statements were false since Petitioner is and was the exclusive owner of the mark; Petitioner and not Respondent has used the mark in commerce and, on information and belief, Respondent has never used the mark in commerce in her individual capacity; the mark was not in use in commerce until at least as early

as July 6, 2005; and the mark was only in use with dresses and not jackets, skirts, jumpsuits, tops, blouses.

15. On information and belief, Respondent knew or should have known that the statements in the Statement of Use were false and were made with the intent to induce authorized agents of the USPTO to grant Respondent's Registration. By reasonably relying upon the truth of Respondent's false statements, the USPTO did, in fact, grant Respondent's Registration, which issued in the name of Respondent as an individual and for goods which were not in use with the mark.

16. The putative mark reflected in Respondent's Registration as applied to the goods recited therein is so similar to Petitioner's previously used AS U WISH mark as to be likely to create confusion, mistake, or deception as to the source, sponsorship, or affiliation of Respondent's goods, all to the damage of Petitioner for the following reasons, among others:

17. The putative mark reflected in Respondent's Registration is identical to Petitioner's AS U WISH mark.

18. AS U WISH is an inherently distinctive and strong mark and is therefore entitled to a broad scope of protection. It has come to be associated with Petitioner through its longstanding and widespread use and promotion of this mark in connection with the sale of dresses.

19. The dresses in Respondent's Registration are identical to the goods on which Petitioner is using its AS U WISH mark. Potential customers for Respondent's goods are likely to believe that any goods offered by Respondent under the AS U WISH mark originate with, or are sponsored or approved by Petitioner, when in fact they are not, resulting in damage to Petitioner.

20. On information and belief, Respondent offers its goods, if any, to the same persons and groups to whom Petitioner offers its goods.

21. On information and belief, the channels of trade for Petitioner's goods and the channels of trade for any goods offered by Respondent, if any, are identical.

22. There is no issue with respect to priority. Petitioner's use predates any rights the Respondent may claim.

23. The AS U WISH mark in Respondent's Registration is for the same or substantially the same goods as those manufactured and sold by Petitioner and identical to Petitioner's AS U WISH mark, and is thus likely to create confusion, mistake, or deception as to the source, sponsorship, or affiliation of Respondent's goods, all to the damage of Petitioner.

24. Any such confusion or deception would inevitably result in damage to Petitioner. Further, any defect, objection or fault found with Respondent's goods sold under the AS U WISH mark would necessarily reflect upon and seriously injure the reputation which Petitioner has established for its goods manufactured and sold under the same mark.

25. The continued existence of Respondent's Registration for AS U WISH further damages Petitioner, as the registration confers upon Respondent various statutory presumptions to which she is not entitled given Petitioner's longstanding use and common law rights in its AS U WISH mark, and may affect Petitioner's ability to obtain registration of its AS U WISH mark, resulting in damage to Petitioner under the provisions of the Trademark Act §§ 1, 2(d), 14(3) (15 U.S.C. §§ 1051, 1052(d), 1064(3)) pursuant to the allegations stated above.

26. WHEREFORE, Petitioner, believing that it will be damaged by the continued registration of Respondent's Registration, hereby requests that this Petition to Cancel be

sustained; that the registration for Respondent's Registration, Registration No. 3,231,154 be cancelled; and that Petitioner be granted such other and further relief as may be just.

27. This Petition to Cancel is submitted electronically and the undersigned hereby authorizes the payment of all official filing fees or any other fees due from Deposit Account No. 50-2387.

August 28, 2009

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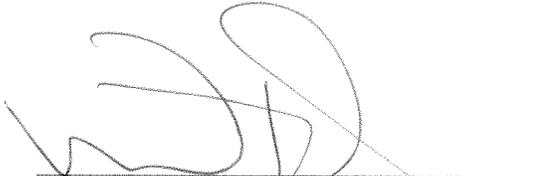
Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petition to Cancel has been served on Respondent by mailing said copy on August 28, 2009, via First Class Mail, postage prepaid to the following:

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