

ESTTA Tracking number: **ESTTA305713**

Filing date: **09/11/2009**

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	Li & Fung (B.V.I.) Limited		
Entity	Limited Liability Company	Citizenship	British Virgin Islands
Address	P.O. Box 957 Offshore Incorporations Centre, Road Town, VIRGIN ISLANDS, BRITISH		

Attorney information	Brent E. Routman Merchant & Gould, P.C. P.O. Box 2910 Minneapolis, MN 55402-0910 UNITED STATES broutman@merchantgould.com Phone:612.336.4619		
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Registration Subject to Cancellation

Registration No	3009327	Registration date	10/25/2005
Registrant	Ness, Michael 31652 Second Avenue c/o Rebel Waltz Management Laguna Beach, CA 92677 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2003/07/05 First Use In Commerce: 2003/09/08 All goods and services in the class are cancelled, namely: ARTICLES OF CLOTHING, FOR MEN, WOMEN AND CHILDREN, NAMELY, PAJAMAS, NIGHTSHIRTS, ROBES, JOGGING SUITS, SWEATSUITS, T-SHIRTS, SWEATSHIRTS, JERSEYS, TANK TOPS, COLLAR SHIRTS, BLOUSES, SHORTS, PANTS, JUMPERS, OVERALLS, ROMPERS, LEOTARDS, DRESSES, SKIRTS, SHORT SETS COMPRISED OF SHORTS AND TOPS, SWEATERS, JACKETS, COATS, RAINCOATS, SCARVES, BANDANNAS, UNDERWEAR, VESTS, CLOTH BIBS FOR INFANTS AND CHILDREN, TIES, BELTS AND SUSPENDERS, SOCKS, TIGHTS, LEGGINGS, HOSIERY, GLOVES, MITTENS, APRONS, SWIMSUITS, KNITTED HEADWEAR, HATS, CAPS AND VISORS; FOOTWEAR AND MASQUERADE COSTUMES

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	828730	Application Date	12/06/1962
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Registration Date	05/16/1967	Foreign Priority Date	NONE
Word Mark	BLACK CAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U009 (International Class 013). First use: First Use: 1952/02/23 First Use In Commerce: 1952/02/23 FIRECRACKERS AND FIREWORKS		

U.S. Registration No.	2999953	Application Date	03/03/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	BLACK CAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 013. First use: First Use: 1952/01/01 First Use In Commerce: 1952/01/01 Fireworks and fire crackers		

U.S. Registration No.	3107457	Application Date	09/10/2002
Registration Date	06/20/2006	Foreign Priority Date	NONE
Word Mark	BLACK CAT GOLD COLLECTION		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 013. First use: First Use: 2002/12/30 First Use In Commerce: 2002/12/30 fireworks and fire crackers

U.S. Application No.	78408562	Application Date	04/27/2004
Registration Date	NONE	Foreign Priority Date	04/23/2004

Word Mark	BLACK CAT
Design Mark	

Description of Mark	NONE
Goods/Services	Class 025. First use: Clothing and headgear, namely, t-shirts, hats, 6-panel caps, visors, polo shirts, denim shirts, sweatshirts, jackets, casual pants, boxers, shorts and aprons; footwear

U.S. Application No.	78408650	Application Date	04/27/2004
Registration Date	NONE	Foreign Priority Date	04/23/2004

Word Mark	BLACK CAT
Design Mark	

Description of Mark	NONE
Goods/Services	Class 025. First use: Clothing and headgear, namely, t-shirts, hats, 6-panel caps, visors, polo shirts, denim shirts, sweatshirts, jackets, casual pants, boxers, shorts and aprons; footwear

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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	/ber/
Name	Brent E. Routman
Date	09/11/2009

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

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LI & FUNG (B.V.I.) Limited)	
	Petitioner,)	Cancellation No. _____
)	Mark: BLACK KAT
v.)	Registration No. 3,009,327
MICHAEL NESS,)	
	Registrant.)	
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CANCELLATION PETITION

Opposer Li & Fung (B.V.I.) Limited (“Opposer”), a limited liability company, having its principal place of business at P.O. Box 957, Offshore Incorporations Centre, Road Town, British Virgin Islands (hereinafter referred to as “Petitioner”), believes that it is, or will be, damaged by the existence of Registration No. 3,009,327 for the mark BLACK KAT owned by Michael Ness (hereinafter referred to as “Registrant”), and hereby petitions to cancel said registration. The grounds for cancellation are as follows:

1. Registrant has obtained a registration on the Principal Register for the mark BLACK KAT, Registration No. 3,009,327, for “articles of clothing, for men, women and children, namely, pajamas, nightshirts, robes, jogging suits, sweat suits, t-shirts, sweatshirts, jerseys, tank tops, collar shirts, blouses, shorts, pants, jumpers, overalls, rompers, leotards, dresses, skirts, short sets comprised of shorts and tops, sweaters, jackets, coats, raincoats, scarves, bandannas, underwear, vests, cloth bibs for infants and children, ties, belts and suspenders, socks, tights, leggings, hosiery, gloves, mittens, aprons, swimsuits, knitted headwear,

hats, caps and visors; footwear and masquerade costumes in International Class 25 (“Registrant’s Mark”). Registrant’s registration is based on an application filed on December 20, 2002, and asserts a first use date of July 5, 2003.

2. Since at least as early as 1952, Petitioner or its predecessors in interest, has used the mark BLACK CAT, or marks incorporating the words BLACK CAT, in connection with fireworks and firecrackers and said marks are strong and famous.

3. Since at least as early as 1992, Petitioner or its predecessors in interest, has used the mark BLACK CAT, or marks incorporating the words BLACK CAT, in connection with articles of clothing.

4. Petitioner owns numerous registrations for its BLACK CAT mark, including the following (all marks referenced in paragraphs 2, 3, 4, and 6 are collectively referred to herein as “Petitioner’s BLACK CAT Marks”);

Trademark	Reg. No./ Reg. Date	Use Date (as least as early as)	Goods/Services
BLACK CAT 	828730 Registered May 16, 1967	February 23, 1952	(Int'l Class:13) Firecrackers and Fireworks
BLACK CAT	2,999,953 Registered September 27, 2005	January 1, 1952	(Int'l Class: 13) Firecrackers and Fireworks
BLACK CAT GOLD COLLECTION	3,107457 Registered June 20, 2006	December 30, 2002	(Int'l Class: 13) Firecrackers and Fireworks

Trademark	Reg. No./ Reg. Date	Use Date (as least as early as)	Goods/Services
			

5. The registrations listed in the above table have not been cancelled, are valid, and are now in full force and effect.

6. Petitioner also owns two pending trademark applications for BLACK CAT marks as follows: Serial Nos. 78/408,562 and 78/408,650 for “clothing and headgear, namely, t-shirts, hats, 6-panel caps, visors, polo shirts, denim shirts, sweatshirts, jackets, casual pants, boxers, shorts and aprons; footwear.”

7. Petitioner has advertised and promoted its BLACK CAT Marks extensively. Petitioner has also made substantial sales of products under said marks. As a result of such use and promotion, Petitioner’s BLACK CAT Marks have developed and represent valuable goodwill inuring to the benefit of Petitioner.

8. Petitioner’s BLACK CAT Marks are famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), and entitled to broad protection, and became famous before Registrant commenced use of Registrant’s BLACK KAT mark.

9. Petitioner has used its mark in commerce for clothing items and has a bona fide intent to sell clothing and other items in Class 25 as evidenced by Petitioner’s pending applications, and, therefore, Petitioner has “bridged the gap” in demonstrating its interest in

preserving avenues of expansion and areas related to the goods already sold by the Petitioner in the United States.

10. Petitioner has priority with respect to the marks at issue in this proceeding. Petitioner or its predecessors in interest adopted and commenced use of the mark BLACK CAT as a trademark long before Registrant adopted the BLACK KAT mark. Petitioner or its predecessor in interest's usage of the BLACK CAT Marks commenced at least as early as 1952, fifty (50) years prior to Registrant's filing date of its application and fifty one (51) years prior to the first use date alleged in Registrant's registration.

11. Registrant's BLACK KAT mark is confusingly and deceptively similar to Petitioner's previously used and duly registered BLACK CAT Marks.

12. Registrant's alleged goods are closely related to Petitioner's goods used by Petitioner in connection with its BLACK CAT Marks.

13. Registrant's BLACK KAT mark is similar in sight, sound, and commercial impression to Petitioner's BLACK CAT Marks.

14. Due to the similarities between Registrant's claimed mark, BLACK KAT, and Petitioner's previously used and duly registered BLACK CAT Marks, the closely related nature of the goods of the respective parties, customers and potential customers are likely to believe that Registrant's goods originate from Petitioner, resulting in a likelihood of confusion in the marketplace, and damage to Petitioner.

15. The use and continued registration by Registrant of the mark BLACK KAT for Registrant's goods is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Petitioner's previously used and duly registered BLACK CAT Marks, again resulting in damage to Petitioner.

16. Because of the closely related nature of the goods, and the similarities of the marks, use and continued registration of the mark BLACK KAT by Registrant is likely to cause confusion, mistake, or deception that Registrant's goods are those of Petitioner, or are otherwise endorsed, sponsored, or approved by Petitioner for use with Petitioner's goods causing further damage to Petitioner.

17. Continued registration of the mark shown in Registration No. 3,009,327 will result in damage to Petitioner under the provisions of Section 2 of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

18. Registrant's use of the mark BLACK KAT and the continued registration of the BLACK KAT mark will likely dilute the distinctive nature of Petitioner's famous BLACK CAT mark and its variants, by blurring.

19. The BLACK CAT mark and its variants, enjoy a very high degree of consumer recognition.

20. Consumers recognize the BLACK CAT mark and its variants as a source indicator for various goods and services.

21. Petitioner's BLACK CAT Marks, and their variants, have become famous due to Petitioner's extensive sales of products bearing the BLACK CAT mark and its variants, Petitioner's extensive advertising and promotion of the mark and because Petitioner has educated consumers to recognize the BLACK CAT mark and its variants as an indicator of quality products sold by Petitioner.

22. Registration No. 3,009,327 for the purported mark BLACK KAT should be cancelled as it will likely dilute the distinctive nature of Petitioner's famous BLACK CAT mark by blurring.

WHEREFORE, Petitioner prays that the registration be cancelled and that this Petition be sustained.

Accompanying this Cancellation Petition and exhibits is the required fee of \$300.00.

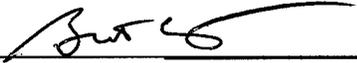
The undersigned hereby appoints Brent E. Routman; Scott W. Johnston, Gregory Golla, Andrew Ehard, and Chris Schulte, of the firm of MERCHANT & GOULD P.C., 3200 IDS Center, 80 South Eighth Street, Minneapolis, Minnesota, 55402, its attorneys to prosecute this petition with full power of substitution and revocation, and to transact all business in the Patent and Trademark Office connected therewith.

Please direct all correspondence to the attention of Brent E. Routman, P.O. Box 2910, Minneapolis, Minnesota 55402, Telephone: (612) 336-4619.

Respectfully submitted,

LI & FUNG (B.V.I.) Limited
By its Attorneys,

Date: September 11, 2009



Brent E. Routman
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
(612) 336-4619
brouman@merchantgould.com

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing PETITION TO CANCEL has been served on Registrant, Michael Ness at 31652 Second Avenue, c/o Rebel Waltz Management, Laguna Beach, California, 92677, by electronic mail and first class mail, postage prepaid, and counsel for Registrant, Jill M. Pietrini, Manatt, Phelps & Phillips, LLP, 11355 W. Olympic Blvd., Los Angeles CA 90064 by electronic mail and first class mail, postage prepaid, this 11 day of September

Date: September 11, 2009



Brent E. Routman
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
(612) 336-4619
brouman@merchantgould.com