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

Proceeding	92051821
Party	Plaintiff Zoba International Corp. dba CD Digital Card
Correspondence Address	Karl M. Steins Steins & Associates, P.C. 2333 Camino del Rio South, Suite 120 San Diego, CA 92108 UNITED STATES karl@steins-patents.com
Submission	Other Motions/Papers
Filer's Name	Karl M. Steins
Filer's e-mail	karl@steins-patents.com
Signature	/Karl M. Steins/
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Attachments	Petition to Cancel 602 amended final 040811.pdf (12 pages)(138031 bytes)

**In the United States Patent and Trademark Office
Before the Trademark Trials and Appeals Board**

Atty. Docket #:
SAB14C-M85

ZOBA INTERNATIONAL CORP., DBA
CD DIGITAL CARD

Petitioner,

vs

DVD FORMAT/LOGO LICENSING
CORPORATION

Registrant

AMENDED PETITION TO CANCEL

Cancellation No.: 92051821

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

ZOBA INTERNATIONAL CORP., DBA CD DIGITAL CARD believes that it will be damaged by registration of Applicant's mark shown in Registration Number 2,711,602 and, therefore, Petitions to Cancel Registrant's Mark on the following grounds:

BACKGROUND AND STANDING

1. DVD FORMAT/LOGO LICENSING CORPORATION (herein called “Registrant”), a Japanese Corporation having its principle place of business at 2-3-8 Shibadamaimon, Minato-ku Tokyo, Japan, is the Owner of U.S. Trademark Registration for 2,711,602” for “Blank optical discs for use through recording as carriers for data, sound, images, computer games, computer programs and map information; personal computers; optical disc readers; computer game equipment containing memory devices, namely, optical discs; CD players; hand-held karaoke players; digital video cameras; and digital still video cameras.” (the “Registered Goods”) The Application which matured into Registration Number 2,711,602, was filed on 9/28/1998 alleges both date of first use, and first use in commerce of 10/1/1996.

2. ZOBA INTERNATIONAL CORP., DBA CD DIGITAL CARD (herein called “Petitioner”) is a California corporation, having its principle place of business at 11150 White Birch Dr., Rancho Cucamonga, California 91730.

3. Petitioner has standing to file the instant Petition because Petitioner has a real interest in the proceedings, a reasonable basis for its belief of damage, and a direct and personal stake in the outcome of the case according to the following fact(s):

- (a) Registrant, on June 12, 2009, filed Case No. 09 CIV 5461 in United States District Court, Southern District of New York “the Complaint,” alleging, in pertinent part, that Petitioner is infringing the litigated Marks (as identified below). A copy of the Complaint is attached hereto as Exhibit A.
- (b) While Registrant did not include allegations of infringement of the subject Mark in the Complaint, the subject Mark is one of Registrant’s DVD Logo Family of Marks (as identified below), the subject Mark covers goods in Petitioner’s market, and therefore continued registration of the subject Mark places Petitioner in peril that the Complaint could be amended or otherwise re-filed to include the allegations that Petitioner is infringing the subject Mark.

Petitioner has been expended substantial cost in defending itself against the allegations of the Complaint, and by continued registration of the subject Mark, is in continued peril of suffering duplicative costs related to litigation over the subject Mark.

ALLEGATIONS OF FACT SUPPORTING THE GRANT OF THE PETITION

4. Registrant, a Japanese Corporation, is alleged by Registrant as being established in April 2000; Registrant's shareholders are:

- (a) Hitachi, Ltd.;
- (b) Koninklijke Philips Electronics N.V.;
- (c) Mitsubishi Electric Corporation;
- (d) Panasonic Corporation;
- (e) Pioneer Corporation;
- (f) Sony Corporation;
- (g) Thompson;
- (h) Time Warner, Inc.;
- (i) Toshiba Corporation; and
- (j) Victor Company of Japan, Ltd.

5. Registrant is owner, by assignment, of the subject Registration. Upon information and belief, Registrant does not, and has never, manufactured the Registered Goods. Registrant "oversees a program by which its 'licensees' verify their understanding of, and compliance with, 'the DVD Specifications' that are published and licensed by Registrant," presumably on behalf of its shareholders.

6. On information and belief, Koninklijke Philips Electronics N.V., Sony Corporation, and Time Warner, Inc. are NOT "licensees" of the Registered Mark.

7. The Original Registrant of the Subject Registration was TIME WARNER ENTERTAINMENT COMPANY, L.P. (the “LIMITED PARTNERSHIP”). The LIMITED PARTNERSHIP, a Delaware Limited Partnership, at the time of Application for Registration of the subject Registration, was composed of the following GENERAL PARTNERS:

- (a) American Television and Communications Corporation;
- (b) Memphis CATV, Inc.;
- (c) People’s Cable Corporation;
- (d) Time Warner Operations, Inc.;
- (e) Warner Communications, Inc.; and
- (f) Warner Cable Communications, Inc.

8. Upon information and belief, on November 28, 2002, THE LIMITED PARTNERSHIP filed specimens of its use of the subject Mark along with a Statement of Use that were photographic examples of covers for blank DVD-RAM discs produced by Panasonic, Inc..

9. Upon information and belief, Panasonic, Inc. was not an agent of THE LIMITED PARTNERSHIP, nor was it a licensee of THE LIMITED PARTNERSHIP on November 28, 2002.

10. The Assignment of rights from THE LIMITED PARTNERSHIP to Registrant was made effective on August 21, 2003.

11. The subject Registration is one of five Trademark Registrations for the subject Mark and currently owned by Registrant (the “DVD LOGO FAMILY OF MARKS”). All of the DVD LOGO FAMILY OF MARKS are “licensed” and/or otherwise handled under the same set of “licensing” guidelines by Registrant, with the differences between the individual registrations comprising the DVD LOGO FAMILY OF MARKS being their goods classes. All of the logo designs are identical. The list includes:

<u>Registration Number</u>	<u>Registration Date</u>	<u>Goods/Services</u>
2,295,726	11/30/1999	Optical disc players; compact discs containing digital information for display of filmed products.
2,381,677	4/29/2000	compact discs containing digital information for display of filmed products.
2,711,602 (the Subject Mark)	4/29/2003	Blank optical discs for use through recording as carriers for data, sound, images, computer games, computer programs and map information; personal computers; optical disc readers; computer game equipment containing memory devices, namely, optical discs; CD players; hand-held karaoke players; digital video cameras; and digital still video cameras.
2,717,743	5/20/2003	Digital versatile discs featuring music, comedy, drama, action, adventure, and/or animation.
2,924,607	2/8/2005	compact disc carrying cases and recorded video disc

carrying cases.

12. Upon information and belief, Registrant's "licensing" program grants "licensees" the right to display the Registered Mark on the "licensees" products. In order to obtain such right, "Licensees" must: (a) enter into Registrant's "License Agreement;" (b) pay an NDA/Book fee to obtain a "DVD Format Book," if such DVD Format Book is desired by "Licensee;" (c) pay a single "License Fee;" and (d) Verification by a qualified lab that the proposed "licensees" product(s) is/are compliant with the DVD Specifications.

13. Upon information and belief, Registrant does not charge a "per piece" royalty from "licensees," nor does it require "licensees" to re-Verify that their products comply with the DVD Specifications, nor does Registrant obtain and test "licensees" products to independently verify that the products comply with the DVD Specifications. A new verification is only required if the DVD Specifications are changed and re-issued by Registrant.

14. Upon information and belief, numerous DVD replicators and other individuals and entities engaging in the business of mass-producing duplicate pre-recorded DVD products for others ("Replicators") are producing DVD's displaying the marks of THE DVD LOGO FAMILY OF MARKS, including the Mark that is the subject of the instant Petition. Upon information and belief, numerous Replicators are producing DVD's displaying the subject Mark open and notoriously, and without a license from DVDFLLC nor with "instruction" from a licensee of the subject Mark.

GROUND FOR CANCELLATION OF THE SUBJECT REGISTRATION (AMENDED AS TO FRAUD CLAIM ONLY)

FRAUD – IMPROPER STATEMENT OF USE UNDER 15 U.S.C.§1051 (AMENDED GROUNDS)

15. Registrant fraudulently filed the Statement of Use setting forth goods in connection with which the subject Mark was then in use by THE LIMITED PARTNERSHIP (Applicant for the subject Mark).

16. The Affidavit was fraudulent because the Specimens filed by Applicant in support of its Statement of Use were specimens of use of the subject Mark by Panasonic, Inc., in the form of photographic examples of a product manufactured by Panasonic, Inc..

17. At the time of the filing of the Affidavit in support of the Statement of Use, Panasonic, Inc. was not a limited partner, agent, or licensee of THE LIMITED PARTNERSHIP, and therefore use alleged by Panasonic, Inc. could not inure to the benefit of Applicant.

18. At the time of the filing of the Affidavit in support of the Statement of Use, Applicant had not itself used the subject Mark, had no intention of using the subject Mark, and knew that it had no intention of using the subject Mark.

19. These acts or omissions are material regarding the use of the subject Mark, and Applicant knew that they were false.

ABANDONMENT – UNCONTROLLED LICENSING

20. Registrant does not use the subject Mark, but purports to “license” the subject Mark to licensees. Registrant does not, however, exercise the requisite control over the nature and quality of the goods sold by “licensees” under the licensed mark. Specifically: (a) on

information and belief, shareholders of Registrant are permitted to use the subject Mark without becoming “licensees” according to Registrant’s published licensing requirements; (b) upon information and belief, Registrant does not exercise any routine testing and examination of “licensees” goods to insure compliance with the DVD Format Books – Registrant relies, instead upon a one-time verification by “licensees” that they are able to manufacture goods that comply with the DVD Specifications; and (c) Registrant permits unlicensed use of the subject Mark, or use that is not compliant with Registrant’s DVD specifications for extensive periods of time with indifference.

ABANDONMENT – FAILURE TO POLICE 15 U.S.C.§1127

21. Registrant does not use the subject Mark, but purports to “license” the subject Mark to licensees. Registrant permits unlicensed use of the subject Mark, or use that is not compliant with Registrant’s DVD specifications for extensive periods of time with indifference.

ABANDONMENT – NONUSE/MISUSE 15 U.S.C.§§1054 and 1127

22. Examination of Registrants “Licensing” and “Verification” documents and processes reveals that, in fact, Registrants, since acquisition of the subject Registration through assignment, have used the subject Mark as a CERTIFICATION MARK, and not a TRADEMARK. Specifically, on information and belief: (a) any uses of the mark are other than by its owner; and (b) display of the mark is intended to indicate that the goods material, mode of manufacture, quality, accuracy or other characteristics of such licensees goods comply with an established certification standard. These use characteristics define a Certification Mark.

23. The subject Mark is NOT used as a TRADEMARK because, upon information and belief: (a) the subject Mark is not used by its owner or a related company; and (b) because, under Registrant’s “Licensing” program, “licensed” use of the subject Mark is not intended to identify and distinguish its goods from those manufactured or sold by others, nor does it indicate the source of the goods. Rather, display of the subject mark is intended to indicate that the goods

material, mode of manufacture, quality, accuracy or other characteristics of such licensee's goods comply with an established certification standard. As such, Registrant is not using the mark as required by the definition of a Trademark.

WHEREFORE, Petitioner, by and through its counsel, respectfully prays that its Cancellation be sustained and that Registrant's registration be canceled.

Dated: 4/8/2011

Respectfully submitted,

STEINS & ASSOCIATES

By Karl M. Steins/
Karl M. Steins
Registration No. 40,186
2333 Camino del Rio South, Suite 120
San Diego, California 92108
Telephone: (619) 692-2004
Attorney for PETITIONER

EXHIBIT A

DVD FORMAT/LOGO LICENSING CORP. v U-TECH MEDIA USA and ZOBA
INTERNATIONAL CORP., d/b/a CD DIGITAL CARD
(U.S. Dist. Ct., So. Dist. of NY; 09 CIV 5461)

(previously filed and incorporated herein by reference)

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Before the Trademark Trials and Appeals Board**

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SAB14C-M85

ZOBA INTERNATIONAL CORP., DBA CD DIGITAL CARD Petitioner, vs DVD FORMAT/LOGO LICENSING CORPORATION Registrant

Cancellation No.: 92051821

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the accompanying AMENDED PETITION TO CANCEL was served upon counsel for Registrant by email at the following email addresses this 8th day of March 2011:

Mr. Mark I. Peroff / Mr. Robert P. Parker
rparker@paulweiss.com
wbrownlow@paulweiss.com

Respectfully submitted,

STEINS & ASSOCIATES

By Karl M. Steins/

Karl M. Steins
Registration No. 40,186
2333 Camino del Rio South, Suite 120
San Diego, California 92108
Telephone: (619) 692-2004
Attorney for PETITIONER