

ESTTA Tracking number: **ESTTA345974**

Filing date: **05/06/2010**

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	The Saul Zaentz Company		
Entity	Corporation	Citizenship	Delaware
Address	2600 Tenth Street Berkeley, CA 94710 UNITED STATES		

Attorney information	Michael A. Grow Arent Fox LLP 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES henrye@arentfox.com, grow.michael@arentfox.com, TMDocket@arentfox.com Phone:202 857 6389
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**Registration Subject to Cancellation**

Registration No	3629849	Registration date	06/02/2009
International Registration No.	NONE	International Registration Date	NONE
Registrant	ARWIN BIO-TECH. (TAIWAN) CO., LTD. 1F, No.68, Lane 382, Sec.1, YangHsin Rd. Yang Mei Town, TAIWAN		

**Goods/Services Subject to Cancellation**

Class 003. All goods and services in the class are cancelled, namely: Cosmetics
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**Grounds for Cancellation**

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Related Proceedings	Opposition No. 91194762
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**Marks Cited by Petitioner as Basis for Cancellation**

U.S. Registration No.	3274479	Application Date	12/22/2005
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Registration Date	08/07/2007	Foreign Priority Date	NONE
Word Mark	ARWEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Computer mouse; Decorative magnets</p> <p>Class 014. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Jewelry</p> <p>Class 016. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Bookmarks; Postcards</p> <p>Class 020. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Plastic key chain tags</p> <p>Class 021. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Goblets</p> <p>Class 025. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Costumes for use in role-playing games; Halloween costumes; Masquerade costumes; T-shirts</p> <p>Class 026. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Cloth patches for clothing; Ornamental cloth patches; Ornamental novelty buttons</p> <p>Class 028. First use: First Use: 2004/07/31 First Use In Commerce: 2004/07/31 Action figures and accessories therefor; Fantasy character toys; Toy figures</p>		
U.S. Registration No.	3669112	Application Date	02/04/2009
Registration Date	08/18/2009	Foreign Priority Date	NONE
Word Mark	ARWEN		

Design Mark	<h1>ARWEN</h1>		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2009/01/14 First Use In Commerce: 2009/01/14 Bracelets; Brooches; Rings; Rings being jewelry		

U.S. Registration No.	3507968	Application Date	02/20/2008
Registration Date	09/30/2008	Foreign Priority Date	NONE

Word Mark	ARWEN
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Design Mark	<h1>ARWEN</h1>		
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Description of Mark	NONE		
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Goods/Services	<p>Class 016. First use: First Use: 2004/03/05 First Use In Commerce: 2008/02/13 Figures of cardboard</p> <p>Class 020. First use: First Use: 2002/04/20 First Use In Commerce: 2008/02/13 Ornaments made of resin, non-metal key chains</p> <p>Class 021. First use: First Use: 2003/03/27 First Use In Commerce: 2008/02/13 Pewter goblets, pewter shot glasses, pewter toasting flutes</p> <p>Class 026. First use: First Use: 2004/05/17 First Use In Commerce: 2008/02/13 Ornamental cloth patches, wigs</p>		
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U.S. Registration No.	3365506	Application Date	06/01/2007
Registration Date	01/08/2008	Foreign Priority Date	NONE

Word Mark	ARWEN
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Design Mark	<h1>ARWEN</h1>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2007/05/16 First Use In Commerce: 2007/05/16 Letter openers		

U.S. Registration No.	2976575	Application Date	11/13/2000
Registration Date	07/26/2005	Foreign Priority Date	NONE
Word Mark	ARWEN EVENSTAR		
Design Mark	<h2>ARWEN EVENSTAR</h2>		
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 2005/03/02 First Use In Commerce: 2005/03/02 materials, and figurines incorporated into settings made of plastics Class 025. First use: First Use: 2005/03/02 First Use In Commerce: 2005/03/02 clothing, namely, costumes		

U.S. Registration No.	2983437	Application Date	07/28/2000
Registration Date	08/09/2005	Foreign Priority Date	NONE
Word Mark	ARWEN EVENSTAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2005/03/21 First Use In Commerce: 2005/03/21 toy figures; collectible toy figures; fantasy character toys		

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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	/Michael A. Grow/
Name	Michael A. Grow
Date	05/06/2010

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



In re Registration No. 3629849 for the mark issued on June 2, 2009

THE SAUL ZAENTZ COMANY	:	
	:	
Petitioner	:	
	:	
v.	:	Canc. No.
	:	
ARWIN BIO-TECH (TAIWAN) CO., LTD.	:	
	:	
Registrant	:	

**PETITION FOR CANCELLATION**

The Saul Zaentz Company (“Petitioner”), having an address of 2600 Tenth Street, Berkeley, California 94710, believes that it will be damaged by the continued registration of the above identified mark and hereby petitions to cancel the same under the provisions of Section 14 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the cancellation, it is alleged that:

1. Petitioner owns all right, title and interest in and to all trademarks and service marks derived from the fictitious names, places and things mentioned in J.R.R. Tolkien’s highly popular series of books, including THE HOBBIT and the LORD OF THE RINGS trilogy, (the “LOTR Books”).
2. Petitioner is the owner of all right, title and interest in and to the famous marks ARWEN and ARWEN EVENSTAR for a variety of goods including clothing (collectively, “Petitioner’s Mark”).
3. The Patent and Trademark Office has recognized Petitioner’s exclusive right to use its Mark by issuing the following registrations:

- (a) Registration No. 3274479, ARWEN, issued on August 7, 2007
- (b) Registration No. 3669112, ARWEN, issued on August 18, 2009
- (c) Registration No. 3507968, ARWEN, issued on September 30, 2008
- (d) Registration No. 3365506, ARWEN, issued on January 8, 2008
- (e) Registration No. 2976575, ARWEN EVENSTAR, issued on July 26, 2005
- (f) Registration No. 2983437, ARWEN EVENSTAR, issued on August 9, 2005

4. The registrations are valid and subsisting, and provide prima facie evidence of Petitioner's ownership of its ARWEN Marks, and of its exclusive right to use said marks in commerce.

5. Petitioner also obtained the film rights to the LOTR Books and, thus far, Petitioner or its related companies have released the following motion pictures (the "LOTR Movies"):

- *The Lord of the Rings: The Fellowship of the Ring*
- *The Lord of the Rings: The Two Towers*
- *The Lord of the Rings: The Return of the King*

6. Petitioner also has registered or applied for registration of numerous other marks derived from the LOTR Books and Petitioner has common law rights in such marks (the "LOTR Marks").

7. ARWEN and ARWEN EVENSTAR are two of the marks derived from the LOTR Books and Movies, which have been used by Petitioner or its related companies in connection with and on clothing, action figures and other products.

8. The marks ARWEN and ARWEN EVENSTAR are derived from the name of the leading female character in the LOTR Movies who marries Aragorn and becomes Queen of the Reunited Kingdom of Amor and Gondor.

9. On information and belief, Registrant made no use of its alleged mark in commerce prior to the filing date of its application for registration, or any priority date that it might claim, nor has Registrant used its mark in commerce for at least the last three years.

10. Since long prior to the filing date of Registrant's application or any priority date it might claim, Petitioner has used the marks ARWEN and ARWEN EVENSTAR and these marks are immediately identifiable as fanciful designations that evoke images associated with the LOTR Books and the LOTR Movies as well as Petitioner's products.

11. Because of the fame and popularity of the LOTR Books, the LOTR Movies, and the collateral products sold under the LOTR Marks, Petitioner's Mark has become indelibly linked with Petitioner in the minds of consumers throughout the United States.

12. The LOTR Books have been in print continuously since their initial publication dates (*i.e.*, *Fellowship of the Rings* 1954, *The Two Towers* 1955, and *Return of the King* 1956).

13. Each book became enormously popular soon after publication and there have been approximately fifty (50) printings of the LOTR Books.

14. Since 1938, when Tolkien's book *The Hobbit* was published, more than 45 million copies of the Tolkien works have been sold in the United States alone and the books have been translated into more than thirty-five (35) languages.

15. Before the LOTR Movies were released, an estimated 100 million copies of the Tolkien books had been sold.

16. After the release of LOTR Movies another 50 million copies of the LOTR Books were sold bringing the total to 150 million copies sold as of February 2007.

17. In a 2008 Harris Poll, the LOTR Books were ranked as the second most favorite book (behind only the Bible) among men, people residing in the Eastern United States, and college graduates; and the books were ranked third among all persons polled over eighteen (18) years old.

18. The LOTR Movies garnered seventeen (17) Academy Awards altogether including a Best Picture award.

19. Each of the LOTR Movies is in the top twenty (20) grossing films of all time, each has received over \$300 million in box office receipts in the United States alone, and the trilogy is the most nominated in the history of the Academy of Motion Picture Arts and Sciences for the Oscar Award.

20. ARWEN and other LOTR Marks have been so widely publicized that these marks point uniquely to Petitioner as the source of origin of all such products.

21. Notwithstanding Petitioner's prior rights in its Mark, Registrant obtained a registration of A ARWIN & Design for cosmetics.

22. Upon information and belief, Registrant knew of the LOTR Books and LOTR Movies, and of Petitioner's rights in the LOTR Marks, before applying to register A ARWIN & Design as a trademark.

23. Upon information and belief, Registrant adopted its alleged mark in bad faith with an intent to cause deception, to create a false suggestion of connection or association with Petitioner, and to trade on the fame, popularity and goodwill associated with the LOTR Marks.

### **LIKELIHOOD OF CONFUSION - §2(d)**

24. Registrant's mark so resembles Petitioner's Mark that the use and continued registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Registrant's goods and will injure and damage Petitioner and the goodwill and reputation symbolized by Petitioner's Mark.

25. The goods of Registrant are so related to the goods sold under Petitioner's Mark that the public is likely to be confused, to be deceived and to assume erroneously that Registrant's goods are those of Petitioner or that Registrant is in some way connected with, licensed or sponsored by or affiliated with Petitioner, all to Petitioner's irreparable damage.

26. Likelihood of confusion in this case is enhanced by the extraordinary fame of Petitioner's Mark, and by the fact that consumers associate ARWEN with goods sold, approved or endorsed by Petitioner; moreover, individuals that might purchase Registrant's goods are prospective purchasers of products sold under Petitioner's Mark.

27. Likelihood of confusion in this case is enhanced by the fact that Registrant's alleged mark A ARWIN is nearly identical to Petitioner's ARWEN Mark, and that the goods in the registration at issue are related to the goods shown in Petitioner's registrations for its Mark.

### **DECEPTION/FALSE SUGGESTION OF CONNECTION - §2(a)**

28. Registrant's mark so closely resembles Petitioner's Mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that said mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Registrant's goods.

29. Registrant's alleged mark so closely resembles Petitioner's Mark that it falsely suggests a connection with Petitioner in violation of Section 2(a) of the Trademark Act, because Registrant's alleged mark points uniquely to Petitioner, and purchasers will assume that goods sold under Registrant's alleged mark are connected with Petitioner.

30. If Registrant's alleged mark is used on goods of the type described in its application, Registrant's alleged mark will cause purchasers to refrain from purchasing Petitioner's authorized goods based on the mistaken assumption that Petitioner is endorsing, attempting to promote, or encouraging the sale of Registrant's goods by permitting Registrant to use said mark.

31. Registrant's mark is deceptive in that it falsely suggests a connection with, or approval by, Petitioner.

32. Use and continued registration by Registrant of its alleged mark will deprive Petitioner of the ability to protect its reputation, persona and goodwill.

33. Likelihood of damage to Petitioner's goodwill is enhanced by the fact that prospective customers who encounter defects in the quality of Registrant's goods will attribute those defects to Petitioner and this will injure Petitioner's reputation and goodwill.

#### **DILUTION - §43(c)**

34. For many years, Petitioner's Mark has been widely used in the United States and, therefore, the name and mark have become well known and famous as a distinctive symbol of Petitioner's goodwill.

35. On information and belief, Registrant intends to use its alleged mark in commerce with the willful intent to trade on Petitioner's reputation or to cause dilution of Petitioner's famous Mark.

36. Petitioner's Mark was well known and famous before Registrant used, applied to register or registered its alleged mark.

37. The mark shown in the registration at issue will cause dilution of the distinctive quality of Petitioner's Mark.

38. Use or continued registration of Registrant's alleged mark will lessen the capacity of Petitioner's famous Mark to identify and distinguish Petitioner's goods and services.

39. Use and continued registration of Registrant's alleged mark will deprive Petitioner of the ability to protect its reputation, persona and goodwill.

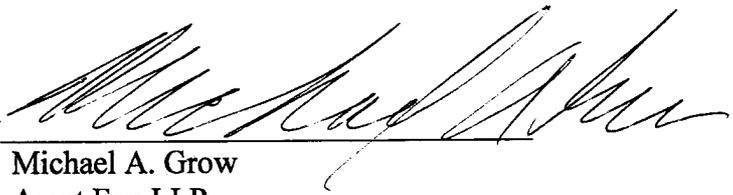
40. Registrant's use or continued registration of its alleged mark for the goods listed in its registration will tarnish the goodwill symbolized by Petitioner's Mark.

41. Likelihood of tarnishment and damage to Petitioner's goodwill is enhanced by the fact that prospective customers who are dissatisfied with or encounter defects in the quality of Registrant's goods will attribute those defects to Petitioner.

WHEREFORE, Petitioner prays that this petition to cancel be granted and that the registration be cancelled.

THE SAUL ZAENTZ COMPANY

By

  
Michael A. Grow  
Arent Fox LLP  
1050 Connecticut Avenue, NW  
Washington, DC 20036  
Telephone: (202) 857-6000  
Attorney for Petitioner

May 6, 2010

**CERTIFICATE OF SERVICE**

It is hereby certified that a copy of the foregoing has been served upon Registrant at 1F, No. 68, Lane 382, Sec. 1, Yan Hsin Road, Tang Mei Town, Taiwan and Registrant's counsel Lin-Yun Chen of Pro-Techtor International Services, 20775 Norada Court, Saratoga, California 95070, by first class mail, postage prepaid, on May 6, 2010.

A handwritten signature in black ink, appearing to read 'Lin-Yun Chen', is written over a horizontal line.