

ESTTA Tracking number: **ESTTA354918**

Filing date: **06/25/2010**

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	Frost King Inc.		
Entity	Corporation	Citizenship	Nevada
Address	2625 South Chester Avenue Bakersfield, CA 93304 UNITED STATES		

Attorney information	James M. Duncan Klein, DeNatale, Goldner, Cooper, Rosenlieb & Kimball, LLP P.O. Box 11172 Bakersfield, CA 93389 UNITED STATES JDuncan@kleinlaw.com Phone:661-395-1000
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### Registration Subject to Cancellation

Registration No	3537613	Registration date	11/25/2008
Registrant	Frosty King, Inc. 204 Randel Avenue Oak Hill, FL 32759 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 043. First Use: 2008/02/01 First Use In Commerce: 2008/02/01 All goods and services in the class are cancelled, namely: Restaurant services
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### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FROSTY KING		
Goods/Services	Restaurant Services		

Attachments	Petition to Cancel.pdf ( 8 pages )(272357 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	/James M. Duncan/
Name	James M. Duncan
Date	06/25/2010

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

-----X  
Frosty King Inc., a Nevada Corporation, :  
 : Cancellation No.:  
 Petitioner, :  
 :  
 -against- :  
 :  
 Frosty King, Inc. a Florida Corporation, :  
 :  
 Respondent. :  
 :  
-----X

**PETITION TO CANCEL**

Frosty King Inc., a Nevada Corporation (“Petitioner”) believes that it is, or will be, damaged by U.S. Trademark Registration No. 3,537,613 for the trademark FROSTY KING granted to Frosty King, Inc. a Florida Corporation (“Respondent”), and therefore files this petition for cancellation of this registration in its entirety. As grounds for the cancellation, Petitioner, by its attorneys, Klein, DeNatale, Goldner, Cooper, Rosenlieb & Kimball, LLP, alleges as follows:

1. Petitioner is a Nevada corporation with a principal business address of 2625 South Chester Ave., Bakersfield, CA 93304.
2. Upon information and belief, Respondent is a Florida Corporation with a principal business address of 204 Randel Avenue, Oak Hill, FL 32759.
3. On December 1, 2006, Respondent filed an intent-to-use application for a U.S. trademark registration for FROSTY KING for restaurant services in International

Class 43. On November 25, 2008 U.S. Trademark Reg. No. 3537613 was issued to Respondent following the filing of an allegation of use which alleged a first use in commerce of February 1, 2008. A copy of Respondent's registration for this mark is annexed hereto as Exhibit A.

**PETITIONER'S PRIORITY OF USE**

4. Petitioner is a Nevada Corporation with its principal of business in Kern County California, which is one of the locations where it operates a chain of restaurants under the name FROSTY KING. Petitioner, and/or petitioner's predecessors-in-interest, have operated restaurants under the name FROSTY KING since 1979, thus earlier than the Respondent's filing date of December 1, 2006 and claimed date of first use of February 1, 2008. Petitioner was incorporated in Nevada under the name FROSTY KING on April 19, 2006. Under the name FROSTY KING, Petitioner was issued a certificate of qualification by the California Secretary of State to transact intrastate commerce in the State of California on November 3, 2006. Thus Petitioner had created public records in both Nevada and California of doing business under the name FROSTY KING before the date the Respondent filed its initial application and before the Respondent allegedly began use of the Trademark.

5. Petitioner had developed and enjoys goodwill and recognition in California and elsewhere with respect to the FROSTY KING trademark used in connection with Petitioner's restaurant services.

6. The FROSTY KING mark has been used by Petitioner for many years prior to use by Respondent and is still being used by Petitioner. Petitioner never

abandoned the mark. Petitioner has used and is still using the FROSTY KING mark to identify its restaurants.

7. In the view of the marks being identical and being used on similar goods and services, it is alleged that Respondent's registered mark so resembles Petitioner's mark previously used in the United States by Petitioner, as to be likely to cause confusion, or to cause mistake or to deceive.

8. On information and belief, Respondent had knowledge, or constructive notice, of Petitioner's prior use of the FROSTY KING trademark when it filed the application that matured into U.S. Trademark Reg. No. 3,537,613.

9. The Respondent filed application papers, pursuant to §1001 of Title 18 of the United States Code, which state that to the best of Respondent's "knowledge and belief, no other person, firm, corporation or association has the right to use said mark in commerce either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods or services of such other person, to cause confusion, to cause mistake or to deceive." However, on information and belief, Petitioner alleges that Respondent should have reasonably known of the existence of Petitioner's right of priority at the time Respondent filed its application papers. Respondent's FROSTY KING mark is a direct copy of Petitioner's identical mark and Respondent was aware, or should have reasonably been aware, of Petitioner's prior use of the mark at the time the application was sworn as a result of the available public records evidencing Petitioner's use of the FROSTY KING mark prior to the application date of Respondent's mark. Respondent was aware, or should have been aware, of these facts when it filed the application which resulted in Registration No. 3,537,613.

10. On information and belief, the statement made by Respondent in its trademark application set forth in Paragraph 9 herein was made by Respondent with the knowledge and belief that said statement was likely untrue. Said statement was made with the intent to induce authorized agents of the United States Patent and Trademark Office (hereinafter “USPTO”) to grant said registration, and reasonably relying upon the truth of said statement, the USPTO did, in fact, grant said registration to Respondent. Petitioner was and will be damaged by said untrue statement and the registration issued in reliance thereon in that Petitioner continues to use the mark to identify its restaurant services. Petitioner’s legal use of the mark will be impaired by the continued registration of said mark by Respondent.

#### **HARM TO PETITIONER**

11. Respondent’s mark is identical to Petitioner’s trademark, so that confusion and deception as to the origin of Respondent’s serviced identified by Respondent’s mark would occur, all to the damage and detriment of the Petitioner. Confusion to the public resulting in damage and injury to the Petitioner can and will occur by reason of the Petitioner’s and Respondent’s marks being identical. Consumers are likely to believe that Respondent or its services are affiliated, associated or endorsed by Petitioner, which is false.

12. On information and belief, Respondent has demanded that restaurants in California, operating under the name FROSTY KING, cease and desist use of the FROSTY KING trademark on the grounds of a claimed right of priority under Registration No. 3,537,613. Such demands have led to confusion as to the ownership of rights in the FROSTY KING mark, and claims of priority to the same.

13. Petitioner intends to expand its restaurants in California and other western states based upon the priority of right it has established by its prior use and its filings in California and Nevada, by expansion of restaurants owned by the Petitioner, to licensees and/or franchisees in those states. However, Petitioner reasonably believes, based upon Respondent's prior demands to other restaurants utilizing the FROSTY KING trademark in California, that potential licensee and/or franchisees would be dissuaded from entering such agreements because of threat of legal recourse by Respondent. Thus, Respondent's registration is and will thus be a source of damage and injury to petitioner.

14. Respondent's FROSTY KING registration must be cancelled based upon:

- (a) It is likely to cause confusion, or to cause mistake, or to deceive;
- (b) It falsely suggests a connection with or authorization by Petitioner;
- (c) It tends to damage Petitioner's goodwill in its trademark; and
- (d) It is likely to prevent Petitioner from lawful uses of its trademark, including licensing and/or franchising in those jurisdictions for which Petitioner has established priority of right.

15. This petition is being submitted in triplicate, along with the fee required pursuant to Section 2.6(a)(1) of \$300.00 per class is enclosed.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be granted by the Trademark Trial and Appeal Board and that Registration No. 3,537,613 issued on November 25, 2008 be cancelled.

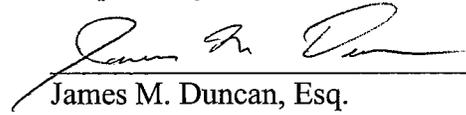
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Dated: 25 June 2010

Respectfully submitted,

A handwritten signature in black ink, appearing to read "James M. Duncan", is written over a horizontal line.

James M. Duncan, Esq.  
Attorneys for Petitioner

FROSTY KING INC., a Nevada Corp.

# Exhibit A



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# FROSTY KING

<b>Word Mark</b>	FROSTY KING
<b>Goods and Services</b>	IC 043. US 100 101. G & S: Restaurant services. FIRST USE: 20080201. FIRST USE IN COMMERCE: 20080201
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77055550
<b>Filing Date</b>	December 1, 2006
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	June 26, 2007
<b>Registration Number</b>	3537613
<b>Registration Date</b>	November 25, 2008
<b>Owner</b>	(REGISTRANT) Frosty King, Inc. CORPORATION FLORIDA 204 Randel Avenue Oak Hill FLORIDA 32759
<b>Attorney of Record</b>	Marvin H. Kleinberg
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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