

ESTTA Tracking number: **ESTTA372436**

Filing date: **10/08/2010**

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	Primary One, LLC		
Entity	Limited Liability Company	Citizenship	New York
Address	6631 Otto Road Glendale, NY 11385 UNITED STATES		

Attorney information	Craig J. Mariam 633 West Fifth Street, 49th Floor Los Angeles, CA 90071 UNITED STATES cmariam@gordonrees.com, bamato@gordonrees.com, bfong@gordonrees.com, mmims@gordonrees.com Phone:213-576-5000		
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Registration Subject to Cancellation

Registration No	3684910	Registration date	09/22/2009
Registrant	MOROCCANOIL, INC. 5757 WEST CENTURY BOULEVARD, SUITE 880 LOS ANGELES, CA 90045 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 2007/03/11 First Use In Commerce: 2007/03/11 All goods and services in the class are cancelled, namely: Hair conditioners, namely, curl creams, hydrating style creams, intense moisturizing masques, and styling and finishing oils

Grounds for Cancellation

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)

Related Proceedings	United States District Court, Central District of California, case no. 10 cv 01430 DMG AGR. Also cancellation proceedings for Registration Nos. 3478807 and 3684910.
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Attachments	Cancellation-M Moroccanoil 910 Design Mark.pdf (6 pages)(22139 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 Overnight Courier on this date.

Signature	/Monica L. Mims/
Name	Monica L. Mims
Date	10/08/2010

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

In the matter of Registration No. 3,684,910) Cancellation No.
For the Trademark **M MOROCCANOIL** (Design)) _____
Registered September 22, 2009)
_____))
PRIMARY ONE, LLC))
))
Petitioner,))
v.))
))
MOROCCANOIL, INC.))
))
Registrant.))
_____))

PETITION FOR CANCELLATION

Primary One, LLC (“Petitioner”), a New York limited liability company having its principal place of business at 6631 Otto Road, Glendale, New York 11385, believes that it is and will continue to be damaged by Registration No. 3,478,807, and hereby petitions to cancel the same. As grounds for cancellation, Petitioner asserts the following:

1. On information and belief, Moroccanoil, Inc. (“Registrant”) is a California corporation with its principal place of business in Los Angeles, California.
2. Petitioner distributes and sells genuine Moroccanoil-branded hair care products.
3. On or around February 25, 2010, Registrant filed a complaint against Petitioner in the United States District Court, Central District of California, under case no. 10-cv-01430-DMG-AGR. Among other claims, Registrant alleged claims of trademark counterfeiting and infringement, false designation of origin and false representation, unfair business practices, and common law unfair competition, all arising from Registrant’s trademark registration nos. 3,684,910 (“the Registration”); 3,478,807; and 3,684,909.

4. On or around October 4, 2010, Petitioner filed counterclaims against Registrant, alleging that the Registrations are invalid due to the marks being generic, merely descriptive, primarily geographically descriptive, deceptively misdescriptive, and primarily geographically deceptively misdescriptive.

5. Petitioner is being damaged and will continue to be damaged by the Registration because, unless canceled, Registrant is and will continue to use the Registration to assert trademark-related claims, despite the lack of protectability of Registrant's trademark under the Registration due to its lack of distinctiveness.

BASIS FOR CANCELLATION – GENERIC

6. The argan tree, a tree primarily found in Morocco, produces the argan nut, the oil of which is used in beauty and hair care products. The generic term for this argan nut oil is "Moroccan oil," the key ingredient in Registrant's products and the basis for the Registration for M MOROCCANOIL.

7. To allow the continuation of a monopoly on a generic term would be contrary to the public interest in promoting competition.

8. The Registration for M MOROCCANOIL should not exist in view of the lack of protection afforded to generic terms.

BASIS FOR CANCELLATION – MERELY DESCRIPTIVE

9. The term "Moroccan oil" is highly descriptive of Registrant's hair care products, the key ingredient of which is Moroccan oil.

10. Consumers do not associate the mark M MOROCCANOIL with a single source, and the mark has no secondary meaning.

11. “Moroccan oil” has been a descriptive term used in connection with the argan nut oil and beauty and hair care goods since well prior to Registrant’s Application for Federal Registration.

12. To allow the continuation of a monopoly on a descriptive term where the term has no secondary meaning would be contrary to the public interest in promoting competition.

13. The Registration for M MOROCCANOIL, which is merely descriptive and lacking in secondary meaning, should not exist in view of 15 U.S.C. § 1052(e).

BASIS FOR CANCELLATION – GEOGRAPHICALLY DESCRIPTIVE

14. The term “Moroccan oil” is highly descriptive of the geographic region in which the key ingredient of Registrant’s hair care products are found; i.e., Morocco.

15. Consumers do not associate the mark M MOROCCANOIL with a single source, and the mark has no secondary meaning.

16. To allow the continuation of a monopoly on a primarily geographically descriptive term where the term has no secondary meaning would be contrary to the public interest in promoting competition.

17. The Registration for M MOROCCANOIL, which is primarily geographically descriptive and lacking in secondary meaning, should not exist in view of 15 U.S.C. § 1052(e).

BASIS FOR CANCELLATION – DECEPTIVELY MISDESCRIPTIVE

18. Moroccan oil is a highly desirable ingredient in hair care products to a certain segment of the purchasing public. The term “Moroccan oil” is highly deceptively misdescriptive when used or associated with Registrant’s products because Registrant’s customers will likely believe that the primary ingredient of the goods is Moroccan oil, when in fact the content of the following ingredients exceed the content of Moroccan oil:

cyclopentasiloxane, dimethicone, cyclomethicone, butylphenyl, and methylpropional. The term “Moroccan oil” gives a false indication of the primary ingredients contained in Registrant’s products to that segment of the purchasing public which may be interested in the ingredients and the concentration of Moroccan oil, and the mark is likely to deceive them and serve as a material factor for the purchase of Registrant’s products.

19. Moroccan oil from Morocco is a highly desirable ingredient in hair care products to a certain segment of the purchasing public. The term “Moroccan oil” is highly deceptively misdescriptive because Registrant’s customers will likely believe that the goods are made in Morocco, when in fact the goods are made in Israel. The term “Moroccan oil” gives a false indication of geographical origin to that segment of the purchasing public which may be interested in the country of origin, and the mark is likely to deceive them and serve as a material factor for the purchase of Registrant’s products.

20. Consumers do not associate the mark M MOROCCANOIL with a single source, and the mark has no secondary meaning.

21. To allow the continuation of a monopoly on a deceptively misdescriptive term would be contrary to the public interest in consumer protection and fair competition.

22. The Registration for M MOROCCANOIL, which is deceptively misdescriptive, should not exist in view of 15 U.S.C. § 1052(e).

BASIS FOR CANCELLATION – GEOGRAPHICALLY MISDESCRIPTIVE

23. Moroccan oil from Morocco is a highly desirable ingredient in hair care products to a certain segment of the purchasing public. The term “Moroccan oil” is highly primarily geographically deceptively misdescriptive because Registrant’s customers will likely believe that the goods are made in Morocco, when in fact the goods are made in Israel. The term

“Moroccan oil” gives a false indication of geographical origin to that segment of the purchasing public which may be interested in the country of origin, and the mark is likely to deceive them and serve as a material factor for the purchase of Registrant’s products.

24. Consumers do not associate the mark M MOROCCANOIL with a single source, and the mark has no secondary meaning.

25. To allow the continuation of a monopoly on a primarily geographically deceptively misdescriptive term would be contrary to the public interest in consumer protection and fair competition.

26. The Registration for M MOROCCANOIL, which is primarily geographically deceptively misdescriptive, should not exist in view of 15 U.S.C. § 1052(e).

WHEREFORE, Petitioner prays that Registration No. 3,478,807 be cancelled pursuant reasons enumerated above. The required fee of \$300.00 is submitted herewith.

Respectfully submitted,

Date: October 8, 2010

/s/ Craig J. Mariam
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CERTIFICATE OF SERVICE

I hereby certify that a copy of this Petition for Cancellation is being served on October 8, 2010 by overnight mail on Registrant's address of record, 5757 West Century Boulevard, Suite 880, Los Angeles, California 90045 and also on its Attorney of Record, Mark D. Kremer, at Conkle, Kremer & Engel PLC, 3130 Wilshire Blvd, Suite 500, Santa Monica, CA 90403.



Yuo-Fong C. Amato