

ESTTA Tracking number: **ESTTA373347**

Filing date: **10/14/2010**

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	Phillips-Van Heusen Corporation		
Entity	Corporation	Citizenship	Delaware
Address	200 Madison Avenue New York, NY 10016 UNITED STATES		

Attorney information	Floyd A. Mandell, Cathay Y. N. Smith Katten Muchin Rosenman LLP 525 W. Monroe Street Chicago, IL 60661 UNITED STATES floyd.mandell@kattenlaw.com, cathay.smith@kattenlaw.com, lisa.shebar@kattenlaw.com
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Registration Subject to Cancellation

Registration No	3823241	Registration date	07/20/2010
Registrant	APPLE INC. 1 INFINITE LOOP CUPERTINO, CA 95014 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2005/11/00 First Use In Commerce: 2005/11/00 All goods and services in the class are cancelled, namely: Clothing, namely, sweaters, sweatshirts, jogging suits, jackets, and coats; footwear

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Nonuse / Void Ab Initio

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	655860	Application Date	02/15/1956
Registration Date	12/17/1957	Foreign Priority Date	NONE
Word Mark	IZOD		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1947/03/00 First Use In Commerce: 1947/03/00 MEN'S AND WOMEN'S SPORT SHIRTS, HOSE, JACKETS, BELTS, AND TIES, AND MEN'S SLACKS AND SWIM TRUNKS

U.S. Registration No.	756956	Application Date	12/21/1962
Registration Date	09/17/1963	Foreign Priority Date	NONE
Word Mark	IZOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1962/12/04 First Use In Commerce: 1962/12/04 Raincoats		

U.S. Registration No.	840548	Application Date	07/21/1967
Registration Date	12/12/1967	Foreign Priority Date	NONE
Word Mark	IZOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1947/03/00 First Use In Commerce: 1947/03/00 MEN'S WALKING SHORTS, SLACKS, SWEATERS, [GOLF CAPS AND GOLF GLOVES,] SOCKS, JACKETS; AND MEN'S AND WOMEN'S SPORT SHIRTS		

U.S. Registration No.	1311169	Application Date	12/23/1983
Registration Date	12/25/1984	Foreign Priority Date	NONE
Word Mark	IZOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1947/03/00 First Use In Commerce: 1947/03/00 APPAREL FOR MEN, WOMEN AND CHILDREN-NAMELY, SHIRTS, BLOUSES, SWEATERS, PANTS, JEANS, SHORTS, OVERALLS, SKIRTS, CULOTTES, DRESSES, JUMPERS, VESTS, JACKETS, RAIN SUITS, WARM-UP SUITS, SWEATSHIRTS, SWIMSUITS, TENNIS WEAR, SOCKS, [LEGWARMERS, SCARVES,] HATS, BELTS, [LEOTARDS, TIGHTS,] TIES, [HEAD BANDS, WRIST BANDS,] DIAPER SETS, CREEPERS, STRETCHIES		

U.S. Registration No.	2627773	Application Date	04/26/2001
Registration Date	10/01/2002	Foreign Priority	NONE

		Date	
Word Mark	IZOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1939/00/00 First Use In Commerce: 1939/00/00 MEN'S, WOMEN'S, AND CHILDREN'S SPORTS SHIRTS, DRESS SHIRTS, TEE SHIRTS, SWEATERS, VESTS, PANTS, SHORTS, JACKETS OF CLOTH AND FLEECE, AND SWIM WEAR		

U.S. Registration No.	2692600	Application Date	12/28/2001
Registration Date	03/04/2003	Foreign Priority Date	NONE
Word Mark	IZOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 ROBES, PAJAMAS AND LOUNGEWEAR		

Attachments	76353177#TMSN.gif (1 page)(bytes) Petition to Cancel.pdf (5 pages)(221868 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	/s/
Name	Cathay Y. N. Smith
Date	10/14/2010

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

In the matter of Registration No. 3,823,241
Issued July 20, 2010

PHILLIPS-VAN HEUSEN CORPORATION,)	
)	
Petitioner,)	
)	
v.)	No. _____
)	
APPLE INC.,)	
)	
Registrant.)	

PETITION TO CANCEL

Petitioner, Phillips-Van Heusen Corporation, a Delaware corporation with its principal place of business at 200 Madison Avenue, New York, New York 10016, believes that it has been, and will continue to be, damaged by U.S. Registration No. 3,823,241 (the "Registration") for the mark IPOD ("Registrant's Mark") for "clothing, namely, sweaters, sweatshirts, jogging suits, jackets, and coats; footwear" (collectively, "Registrant's Goods") in International Class 25. The Registration was issued July 20, 2010, to Registrant, Apple Inc., a California corporation with an address identified in the Registration as 1 Infinite Loop, Cupertino, California 95014. Accordingly, for the reasons set forth below, Petitioner hereby petitions to cancel the Registration, pursuant to 37 CFR §2.111(b).

As grounds therefor, Petitioner alleges as follows:

PETITIONER

1. Petitioner is one of the world's largest apparel companies and sells and markets a variety of goods, including clothing and footwear (collectively, "Petitioner's Goods"), under a number of brands, including the trademark IZOD ("Petitioner's Mark").
2. Petitioner, through its predecessor-in-interest, adopted and began using Petitioner's Mark in the late 1930s. Petitioner's Mark has been continuously used in the United States since that time, and, through extensive sales, advertising and promotion, Petitioner's Mark has come to represent enormous and valuable goodwill owned by Petitioner. Petitioner's Mark has been a top-selling brand in the United States for many years, and Petitioner's Goods have been sold and marketed under Petitioner's Mark in retail stores and via the Internet both in the United States and internationally. Petitioner's Mark has become a famous mark and achieved such fame long prior to June 18, 2005.
3. Petitioner owns numerous valid and subsisting trademark registrations in International Class 25 for Petitioner's Mark in the United States Patent and Trademark Office

("USPTO") and throughout the world. Petitioner's many U.S. Registrations include, but are not limited to:

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>
IZOD	0655860	December 17, 1957
IZOD	0756956	September 17, 1963
IZOD	0840548	December 12, 1967
IZOD	1311169	December 25, 1984
IZOD	2627773	October 1, 2002
IZOD	2692600	March 4, 2003

REGISTRANT

4. Registrant markets, distributes, and sells portable media players under the mark IPOD.

5. On June 18, 2005, Registrant filed Application Serial No. 78653669 ("Registrant's Application") in the USPTO under Section 1(b) of the Trademark Act based on Registrant's claimed intent to use Registrant's Mark on Registrant's Goods in International Class 25. On May 6, 2010, Registrant filed the Statement of Use in Registrant's Application, and, on July 20, 2010, the Registration was issued.

6. According to the Registration, Registrant claims to have commenced use of Registrant's Mark for Registrant's Goods in November 2005 ("Registrant's Alleged First Use Date"). Both the filing date of Registrant's Application and Registrant's Alleged First Use Date are decades after Petitioner and its predecessor-in-interest adopted and began using Petitioner's Mark in the United States, and long after Petitioner's Mark became famous.

LIKELIHOOD OF CONFUSION

7. Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 6 of this Petition to Cancel.

8. Petitioner's mark is arbitrary and strong, and it has become famous for Class 25 goods.

9. Petitioner's Goods on which Petitioner's Mark is used and Registrant's Goods are identical or closely related.

10. Registrant's Mark so resembles Petitioner's Mark in sight, sound, and commercial impression as to be likely, when applied to Registrant's Goods, to cause confusion, mistake or

deception by causing the public to believe that Petitioner is the source of such goods, and/or that such goods are otherwise sponsored or endorsed by Petitioner, in violation of §2(d) of the Lanham Act, 15 U.S.C. §1052(d), with consequent damages to Petitioner and the public.

DILUTION

11. Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 10 of this Petition to Cancel.

12. Use of Registrant's Mark on Registrant's Goods is likely to dilute the distinctive quality of Petitioner's Mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), with consequent damage to Petitioner and the public.

NONUSE AND VOID *AB INITIO*

13. Petitioner realleges and incorporates herein by reference the matters alleged in Paragraphs 1 through 12 of this Petition to Cancel.

14. On May 6, 2010, Registrant submitted a Statement of Use alleging that Registrant's "[M]ark is in use in commerce on or in connection with" Registrant's Goods (the "Representation").

15. Registrant, whether directly or through any alleged licensee, is not using and has not used Registrant's Mark as a trademark to designate Registrant's Goods. Petitioner has not found any clothing, namely, sweaters, sweatshirts, jogging suits, jackets, coats, or footwear branded with Registrant's Mark. The only use of Registrant's Mark that Petitioner found in connection with any International Class 25 goods has been in descriptive advertising: (a) on website pages that do not prominently display Registrant's Mark in connection with the advertised product or otherwise use Registrant's Mark as an indicator of source, and/or (b) referencing the fact that they can be used with Registrant's IPOD portable media player.

16. For an application under Section 1(b), such as Registrant's Application, a mark must be in use in commerce as of the filing date of a statement of use and as of the registration date to be entitled to registration.

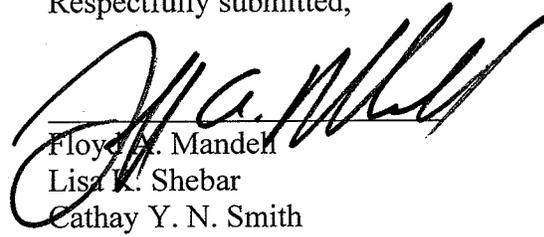
17. When Registrant filed the Statement of Use in Registrant's Application on May 6, 2010, and as of the registration date of the Registration, Registrant was not using and had not used Registrant's Mark as a trademark to designate any of Registrant's Goods, let alone all of them. Any use of Registrant's Mark prior to filing its Statement of Use was not in fact a *bona fide* trademark use in the ordinary course of commerce, making the Registration void *ab initio*.

REQUEST FOR RELIEF

WHEREFORE, Petitioner believes that it is likely to be damaged by U.S. Registration No. 3,823,241, and Petitioner respectfully requests that this Petition to Cancel be sustained and the Registration be cancelled.

Dated: October 14, 2010

Respectfully submitted,



Floyd A. Mandel

Lisa K. Shebar

Cathay Y. N. Smith

Katten Muchin Rosenman LLP

Attorneys for Petitioner

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Chicago, Illinois 60661

(312) 902-5200

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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PHILLIPS-VAN HEUSEN CORPORATION,)	
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Petitioner,)	
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v.)	No. _____
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APPLE INC.,)	
)	
Registrant.)	

CERTIFICATE OF SERVICE

I hereby certify that on this 14th day of October, 2010, I caused a true and correct copy of the foregoing Petition to Cancel (Registration No.: 3,823,241) to be served upon:

Lisa G. Widup
Apple Inc.
1 Infinite Loop, MS 3TM
Cupertino, CA 95014

via First Class Mail, postage prepaid.


Cathay Y. N. Smith