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Filing date: **01/13/2011**

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	Baron Nahmias Inc.		
Entity	Corporation	Citizenship	New York
Address	4525 Henry Hudson Parkway Suite 804 Bronx, NY 10471 UNITED STATES		

Attorney information	Adam Kotok, Esq. 2600 Netherland Avenue # 411 Riverdale, NY 10463 UNITED STATES adam@kotoklaw.com Phone:646.342.0715
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Registrations Subject to Cancellation

Registration No	3291386	Registration date	09/11/2007
Registrant	ATLANTIC BOTTLING, LLC 831 NORWOOD AVE. LONG BRANCH, NJ 07740 UNITED STATES		

Goods/Services Subject to Cancellation

Class 033. First Use: 2006/11/20 First Use In Commerce: 2006/11/20 All goods and services in the class are cancelled, namely: ALCOHOLIC BEVERAGES, NAMELY, DISTILLED LIQUOR AND LIQUEURS

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Genericness	Trademark Act section 23		
Registration No	3234012	Registration date	04/24/2007
Registrant	ATLANTIC BOTTLING, LLC 831 NORWOOD AVE. LONG BRANCH, NJ 07740 UNITED STATES		

Goods/Services Subject to Cancellation

Class 033. First Use: 2006/07/15 First Use In Commerce: 2006/07/15 All goods and services in the class are cancelled, namely: Alcoholic beverages, namely, distilled liquor and liqueurs

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Petition Fnl Complt_ESTTA filing.pdf (10 pages)(9746025 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	/adam kotok/
Name	Adam Kotok, Esq.
Date	01/13/2011

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

X-----X	:	
	:	Cancellation No.: _____
BARON NAHMIAS INC.	:	
<i>Petitioner</i>	:	In the matter of
	:	Trademark Registration Nos.:
v.	:	3291386
	:	3234012
ATLANTIC BOTTLING, LLC	:	<i>For the marks:</i>
<i>Registrant-Respondent</i>	:	MAHIA
	:	Registered: September 11, 2007
	:	<i>and</i>
	:	MAHIA LE FIG
	:	Registered: April 24, 2007
X-----X		

CONSOLIDATED PETITION TO CANCEL

Baron Nahmias Inc. ("Petitioner"),
a corporation duly formed under the laws of the State of New York,
4525 Henry Hudson Parkway, Suite 804
Bronx, NY 10471

Petitioner Baron Nahmias Inc. states the following for its consolidated petition for
cancelation against Registration Nos. 3291386 and 3234012:

1. Petitioner is a corporation duly formed according to the laws of the State
of New York, with an address of 4525 Henry Hudson Parkway, Suite 804, Bronx, NY
10471.

2. To the best of Petitioner's knowledge, the name and address of the current
owner of the registration, via assignment, is Atlantic Bottling, LLC, 831 Norwood
Avenue, Long Branch, New Jersey 07740.

3. Petitioner was formed to conduct the business of developing, manufacturing and marketing distilled spirits.

4. Further to Petitioner's business, Petitioner has expended significant money, time and other resources to, *inter alia*, acquire and finance distilling equipment, develop a business plan, design and develop packaging and bottle prototypes and secure business loans.

5. Moreover, Petitioner's primary product, a distilled spirit made from figs, is in a product category known as *mahia* which is an element of both trademark registrations sought to be canceled herein.

6. The subject marks "MAHIA" and "MAHIA LE FIG" (the "Alleged Marks") make use of the Arabic term *mahia*, which is used generically to describe distilled spirits originating from or consumed in Morocco, or manufactured in the Moroccan style, derived from fruits such as figs.

7. Petitioner has a bona fide intent to manufacture distilled fig spirits in the product category of *mahia*, and using the term to name the product.

8. Accordingly, Petitioner believes it will be damaged by Registration Nos. 3291386 and 3234012 and hereby petitions to cancel same.

GROUNDS FOR CANCELLATION

9. Petitioner repeats and re-alleges the content of Paragraphs 1 thru 8 as set forth in full therein.

10. Petitioner's business has been formed to manufacture, *inter alia*, *mahia*, a product category of spirits distilled from fruits, most commonly figs, with its origins in Morocco.

11. *Mahia*, a Moroccan Arabic term derived from the Arabic phrase for, “water of life,” also is a term to describe a class of Moroccan-styled distilled fruit spirits.

12. In fact, the word is used to literally denote Moroccan or Moroccan-styled distilled spirits.

13. In addition, *mahia* translates to *eau de vie*, a term used in the spirit industry to denote clear or light-colored fruit-based brandies.

14. Petitioner’s *mahia* operation and production plan has grown out of the knowledge and experience of its personnel, including Vice President David Nahmias.

15. Mr. Nahmias’s knowledge and experience with *mahia* dates back to his native Morocco.

MAHIA LE FIG

16. On or about January 27, 2005, Regaleinu Distillery Inc. (“Regaleinu”) filed an application for registration of the MAHIA LE FIG word mark as a trademark on the Principal Register with the United States Patent and Trademark Office (the “USPTO”), Serial Number 76629494.

17. Upon information and belief, Regaleinu knew at the time of application that *mahia* was a generic term denoting a category of distilled beverage products.

18. On or about August 26, 2005, Allison Holtz, USPTO Trademark Examining Attorney, Law Office 111, issued an Office Action in response to the MAHIA LE FIG application stating that, pursuant to 37 C.F.R. §2.61(b), “[t]he applicant must specify whether “MAHIA LE FIG” has any significance in the alcoholic beverage trade or industry, any geographical significance, or any meaning in a foreign language.” (the “Office Action”)

19. Days later, on September 1, 2005, David Nahmias met personally with Mordechai Kairey, also known as Martin Kairey, then President of Regaleinu.

20. At the meeting both men discussed the product category of *mahia* and its methods of production.

21. Both men acknowledged that *mahia* was a generic name for a category of Moroccan-styled brandies.

22. Mr. Nahmias also discussed his intention to manufacture *mahia*, either in partnership with a company such as Regaleinu, or independently.

23. By virtue of Mr. Kairey's statements at their meeting, Petitioner knows that Regaleinu knew as early as September 1, 2005 of *mahia*'s generic use to denote a generic product category within the distilled beverage industry.

24. However, on or about September 12, 2005, Regaleinu, through its counsel, Joseph Sutton, Esq., submitted a statement in response to the Office Action that "the Mark translates in English to 'Water of Life.' It has no geographical significance or significance in the alcoholic beverage trade or industry."

25. Regaleinu knew that MAHIA LE FIG contained the term *mahia*, which was and is significant in the alcoholic beverage trade and industry as a type of Moroccan-styled fruit brandy.

26. Regaleinu also failed to disclose that *mahia*, also translated to *eau de vie*, and that same was and is a generic term – even among English-speakers – used to describe a class of spirits derived from fruits such as figs.

27. Relying on Regaleinu's misrepresentations and omissions, the USPTO issued a Notice of Allowance on February 21, 2006.

28. On March 21, 2006, an assignment of MAHIA LE FIG from Regaleinu to Respondent herein was recorded with the USPTO.

29. On April 24, 2007, MAHIA LE FIG was ultimately registered on the Principal Register of Trademarks, Reg. No. 3234012.

MAHIA

30. On or about January 3, 2006, Regaleinu proceed to file an application with the United States Patent and Trademark Office (USPTO) to register “MAHIA” as a mark of its own, on an intent-to-use basis, pursuant to 15 U.S.C. 1051(b).

31. Said application, serial number 76652795, was filed on or about January 3, 2006.

32. Regaleinu again failed to disclose that *mahia* actually signifies a certain product category of distilled Moroccan spirit in the distilled spirit industry, and that accordingly, others do have the right to use the term in commerce.

33. Rather, the MAHIA application stated only that “Applicant is the owner of U.S. Application No. 76,629,494 for ‘Mahia Le Fig.’”

34. Regaleinu, thereby incorporated the misrepresentations contained in the MAHIA LE FIG application, detailed in 16 through 29 hereof.

35. The MAHIA application includes the statement that:

The undersigned, being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both . . . if the application is being filed under 15 U.S.C. 1051(b), he believes the applicant to be entitled to use such mark in commerce; to the best of his knowledge and belief, no other person, firm, corporation or association has the right to use the mark in commerce . . . as to be likely . . . to cause confusion, or to cause

mistake, or to deceive; and that all statements made of his own knowledge are true and all statement made on information and belief are believed to be true.

36. On the application, below the above statement, appears the signature of a person described as “Martin Kairey, President.”

37. On or about March 21, 2006, an assignment of MAHIA, then with its registration still pending, was recorded with the USPTO, assigning the entire interest of MAHIA from Regaleinu to Registrant.

38. Upon information and belief, Mordechai Kairey, also known as Martin Kairey, is President of Registrant.

39. In fact, on or about March 8, 2007, Registrant filed a Statement of Use, bearing the signature of “Martin Kairey, President,” dated February 28, 2007.

40. MAHIA was ultimately registered as a trademark on or about September 11, 2007.

41. As a result of the registrations of MAHIA LE FIG and MAHIA (the “Alleged Marks”) owned by Registrant, Petitioner, by merely using the term *mahia* by its ordinary and accepted use, namely, as a product category descriptor, faces the risk of injunction, litigation or other legal obstacles.

42. Such obstacles are wrongfully in place, as the Alleged Marks are unregistrable and must be canceled because they are (I) generic, (II) generic under the doctrine of foreign equivalents, (III) the product of fraud, and (IV) because MAHIA LE FIG is merely descriptive.

COUNT I – The Alleged Marks are Generic

43. Petitioner restates and re-alleges the contents of Paragraphs 1 through 42 as if fully set forth herein.

44. *Mahia* is a term used generically to describe a product category of distilled spirits commonly consisting of fruit based-brandies.

45. *Mahia* is merely a genus of which certain Moroccan-styled spirits, including brandies distilled from figs, are a species.

46. Both the MAHIA and MAHIA LE FIG registrations afford trademark protection to use of the generic term *mahia*.

47. Accordingly, both of the Alleged Marks are generic and both must be canceled.

48. Alternatively, MAHIA must be canceled and a disclaimer entered disclaiming *mahia* apart from its use in MAHIA LE FIG, Registration No. 3234012.

**COUNT II – The Alleged Marks Are Generic under
the Doctrine of Foreign Equivalents**

49. Petitioner restates and re-alleges the contents of Paragraphs 1 through 48 as if fully set forth herein.

50. *Mahia*, in the Moroccan Arabic dialect, is a term used generically to describe a product category of distilled spirits, including and especially that of fruit-based brandies.

51. It also translates loosely to *eau de vie*, which – even among English-speaking consumers – is a term for clear or light-colored fruit based brandies.

52. Accordingly, the Alleged Marks are generic and both must be canceled.

53. Alternatively, MAHIA must be canceled and a disclaimer entered disclaiming *mahia* apart from its use in MAHIA LE FIG, Registration No. 3234012.

COUNT III – Fraud

54. Petitioner restates and re-alleges the contents of Paragraphs 1 through 53 as if fully set forth herein.

55. Registrant and original applicant Regaleinu, and specifically their principal, Mordechai Kairey, also known as Martin Kairey, knew that *mahia* was not a distinctive trademark but, rather, a generic name for Moroccan-style fruit brandy.

56. In fact, Mr. Kairey, as detailed *supra*, on behalf of the original applicant, Regaleinu, Registrant's predecessor in interest of the Alleged Marks, discussed this very fact – the generic *mahia* product category of distilled spirits, and his knowledge thereof – with Mr. Nahmias in September of 2005.

57. Regaleinu and Registrant knowingly and intentionally misrepresented to the USPTO that the alleged marks had no meaning in the alcoholic beverage trade.

58. They also intentionally failed to disclose the true meaning in Moroccan Arabic, that it meant Moroccan-styled liquor, including spirits distilled and derived from fruits such as figs.

59. Pursuant to the Trademark Act, whether a mark is generic or not is a dispositive threshold matter, material to decisions on registration.

60. These misrepresentations were committed with the intent of deceiving the USPTO and calculated to have the desired effect of creating unfair barriers to entry into the industry of Moroccan-styled fruit brandies, by preventing parties such as Petitioner from calling their product by its rightful name.

61. Relying on these false representation and omissions, the USPTO granted registration of the Alleged Marks.

62. Therefore, the Alleged Marks were procured by fraud and must be canceled pursuant to 15 U.S.C. § 1064(3), or alternatively, MAHIA must be canceled and Registrant a disclaimer must be entered disclaiming *mahia* apart from its use in the MAHIA LE FIG, Registration No. 3234012.

**COUNT IV – Mere Descriptiveness,
as to MAHIA LE FIG
15 U.S.C. § 1052(e)(1)**

63. Petitioner restates and re-alleges the contents of Paragraphs 1 through 62 as if fully set forth herein.

64. *Mahia* is a generic term for a class of spirits including fruit-based brandies.

65. *Mahia Le Fig* adds only “*le fig*” to the generic term, which, according to Regaleinu’s own filings in support of the MAHIA LE FIG application, translates to “of the fig” in French.

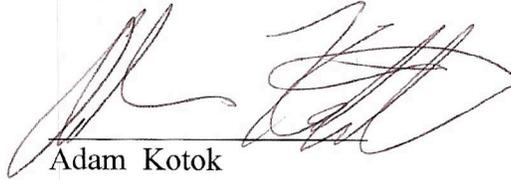
66. Therefore the mark merely describes the subject goods as *mahia* made or derived from figs, defining only a particular characteristic of the product that does not require any exercise of the imagination

67. Accordingly, the mark MAHIA LE FIG is merely descriptive and Registration No. 3234012 must be canceled.

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained in favor of Petitioner and that Registration Nos. 3291386 and 3234012 be canceled, or

alternatively, that Registration No. 329186 be cancelled and a disclaimer entered disclaiming *mahia* apart from its use in MAHIA LE FIG, Registration No. 3234012.

Respectfully submitted,

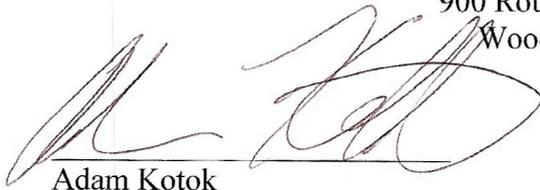


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CERTIFICATE OF MAILING

I, Adam Kotok, Esq., hereby certify that this Petition is being deposited with the United State Postal Service with sufficient postage thereon for first class registered mail delivery on January 13, 2011, in envelope addressed to Registrant's Correspondent and Attorney of Record, who accepts service of same, at the following address:

Joseph E. Sutton
Ezra Sutton & Associates
Plaza 9
900 Route 9 North, Suite 201
Woodbridge, NJ 07095



Adam Kotok