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Filing date: **02/10/2011**

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	Excelsior-Henderson Motorcycles		
Entity	Corporation	Citizenship	MN
Address	1509 Keller Lake Road Burnsville, MN 55306 UNITED STATES		

Attorney information	Matthew Swyers The Swyers Law Firm 344 Maple Avenue West, Suite 389 Vienna, VA 22180 UNITED STATES mswyers@SwyersLaw.com Phone:(866) 455-8800 x704
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**Registration Subject to Cancellation**

Registration No	3915734	Registration date	02/08/2011
Registrant	John's Repair, Inc. 301 North Main Street Le Sueur, MN 56058 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 037. First Use: 2002/05/10 First Use In Commerce: 2002/05/10 All goods and services in the class are cancelled, namely: Maintenance and repair of motorcycles and motorcycle parts
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Related Proceedings	92052333, 92052364, 92052259, Opposition of 77886667 filed 02-10-11.
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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	EXCELSIOR HENDERSON		
Goods/Services	Motorcycles, motorcycle parts, and related goods and services.		

Attachments	Petition to Cancel.pdf ( 7 pages )(21853 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	/Matthew H. Swyers/
Name	Matthew Swyers
Date	02/10/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**The Trademark Trial and Appeal Board**

In the matter of U.S. Registration 3,915,734,  
For the mark EXCELSIOR HENDERSON,  
Registered on the Principal Register on February 8, 2011

Excelsior-Henderson Motorcycles,	:	
	:	
Petitioner,	:	
	:	
	:	Petition No. _____
vs.	:	
	:	
John’s Repair, Inc.	:	
	:	
Registrant.	:	

**PETITION TO CANCEL**

Petitioner, Excelsior-Henderson Motorcycles (hereinafter “Petitioner”), a Minnesota corporation, doing business at 1509 Keller Lake Road, Burnsville, Minnesota, 55306, believes that it is and will continue to be damaged by the continued registration of U.S. Registration 3,915,734 for the mark EXCELSIOR HENDERSON and, accordingly, hereby petitions this honorable tribunal to cancel the same pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111(b).

**Grounds for Cancellation**

As grounds for the instant Petition to Cancel, it is alleged that the continued registration of Registrant John’s Repair, Inc. (hereinafter “Registrant”) mark EXCELSIOR HENDERSON, as more fully displayed in U.S. Registration No. 3,915,734 (hereinafter “JR Mark”), would be likely to cause confusion with Petitioner’s mark EXCELSIOR-HENDERSON and related marks (hereinafter “Petitioner’s Marks”) which retain priority of use over the JR Mark by virtue of their prior use in commerce in the United States. In addition, it is alleged that the Registrant obtained the JR Mark through fraudulent means by virtue of misrepresentation of information supplied on the application to register the mark.

## **Statement of Facts**

In support of the instant Petition to Cancel, it is alleged that:

1. Petitioner and/or its predecessors in interests, is the owner of the mark EXCELSIOR-HENDERSON and related marks used on or in connection with motorcycles, motorcycle parts, and memorabilia.
2. Petitioner has used Petitioner's Marks in connection with the above-identified goods in interstate commerce since as early as December 19, 1995.
3. Petitioner has maintained continuous use and/or periods of permissible non-use of the Petitioner's Marks in connection with the above-identified goods since as early as December 19, 1995.
4. Petitioner has invested significant sums of money in the promotion of Petitioner's Marks and the Petitioner's goods in the United States.
5. As a result of the aforesaid, Petitioner has developed a valuable reputation and goodwill in Petitioner's Marks and has achieved a following among relevant consuming public prior to the filing, registration and/or priority date of the JR Mark.
6. Petitioner had several previous registrations with the United States Patent and Trademark Office (hereinafter "USPTO"). These marks are identified more fully in U.S. Registration No. 2,477,236, U.S. Registration No. 2,250,626, and U.S. Registration No. 2,143,816.
7. Due to financial hardship, Petitioner permitted his registrations to expire.
8. Based upon information and belief, Registrant is a Minnesota corporation, owned and operated by John Jones, a U.S. citizen, located and doing business at 301 North Main Street, Le Sueur, Minnesota, 56058.

9. Registrant claims to use the JR Mark in connection with maintenance and repair of motorcycles and motorcycle parts in International Class 37.

10. The JR Mark, identified more fully in U.S. Registration No. 3,915,734, was filed with the USPTO on December 4, 2009.

11. In the application to register the JR Mark, Registrant claims a date of first use of its mark of May 10, 2002.

12. Of note, Registrant's principal, John Jones, was an employee of the Petitioner in 1999, years prior to the filing of the JR Mark.

13. Only following the separation of employment by principal of the Registrant John's Repair from the Petitioner did Registrant file for the JR Mark.

14. Upon information and belief, Registrant first used the mark EXCELSIOR HENDERSON in connection with the services covered by its registration in the United States no earlier than 2002.

**Count I**  
**Likelihood of Confusion**

15. Petitioner hereby incorporates Paragraphs 1 through 14 as if fully set forth herein.

16. Petitioner's rights in the Petitioner's Marks have priority of use over Registrant's rights, if any, in the JR Mark, inasmuch as Petitioner commenced its use of the Petitioner's Marks in connection with its goods in interstate commerce prior to the filing, registration, and/or priority of use date of the Registrant's registration and use of the JR Mark.

17. Petitioner believes that consumers confronted with the JR Mark will inevitably be confused and deceived into the mistaken belief that the Registrant's goods have their origin or are in some manner connected with the Petitioner and/or Petitioner's goods offered in connection with the Petitioner's Marks.

18. The continued registration of the JR Mark confers upon Registrant rights to which it is not entitled and is inconsistent with the prior established rights of Petitioner in the Petitioner's Marks.

19. By reason foregoing, Registrant will be seriously damaged by the continued registration of the JR Mark.

**Count II**  
**Fraud in the Procurement of U.S. Reg. No. 3915734**

20. Petitioner hereby incorporates Paragraphs 1 through 19 as if fully set forth herein.

21. As stated above, the principal of the Registrant was employed by Petitioner in 1999.

22. Following leaving the employ of the Petitioner Registrant intentionally began use of Petitioner's Marks in an effort to misappropriate the good will associated therewith.

23. Petitioner initially approached Registrant to become a licensee of Petitioner's Marks upon discovering the misappropriation thereof.

24. Despite ongoing conversations between Petitioner and the principal of the Registrant to become a licensee of the Petitioner's Marks Registrant, on December 4, 2009, filed the instant application which would ultimately mature into the registration at issue in the instant proceeding.

25. In the subject application Registrant claimed a date of first use anywhere as early as May 10, 2002 also with a date of first use in commerce of May 10, 2002.

26. In so doing, Registrant provided knowingly false and material representations to the U.S. Patent and Trademark Office concerning its non-existent rights in the mark as a whole insofar as it knew it had no legitimate rights to the mark based upon Petitioner's rights therein. Registrant's filing was merely perpetrated with the subjective intent of misleading the U.S.

Patent and Trademark Office to grant rights in a mark for the Registrant in an ongoing effort to misappropriate the trademark rights and good will of the Petitioner.

27. Specific instances of Registrant's knowingly false and intentional material misrepresentations to the U.S. Patent and Trademark Office in its effort to mislead the same to grant the subject registration include:

(a) Providing a date of first use which registrant knew was false at the time of filing the application;

(b) Submitting a declaration under 18 U.S.C. Section 1001 declaring he/she believes the applicant to be the owner of the trademark/service mark sought to be registered and to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive all the while during licensing negotiations with the true trademark owner, the Petitioner in the instant matter.

28. By reason foregoing, Registrant will be seriously damaged by the continued registration of the JR Mark.

WHEREFORE Petitioner Excelsior-Henderson Motorcycles, by counsel, prays that the instant petition be granted and U.S. Registration No. 3,915,734 be cancelled.

Petitioner hereby appoints Matthew H. Swyers, Esquire of The Swyers Law Firm, PLLC, 344 Maple Ave. West, Suite 389, Vienna, Virginia 22180, to act as his attorney for Petitioner herein, with full power to prosecute said petition, to transact all relevant business with the United States Patent and Trademark Office, and to receive all official communication in connection with this petition.

Respectfully submitted this 10<sup>th</sup> day of February, 2011.

THE SWYERS LAW FIRM, PLLC

/Matthew H. Swyers/

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Vienna, VA 22180

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Attorney for Petitioner

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
The Trademark Trial and Appeal Board**

In the matter of U.S. Registration 3,915,734,  
For the mark EXCELSIOR HENDERSON,  
Registered on the Principal Register on February 8, 2011

Excelsior-Henderson Motorcycles,	:	
	:	
Petitioner,	:	
	:	
	:	Petition No. _____
vs.	:	
	:	
John's Repair, Inc.	:	
	:	
Registrant.	:	

**CERTIFICATE OF REGISTRATION**

I hereby certify that a true and accurate copy of the foregoing pleading was sent via U.S.

Mail this 10<sup>th</sup> day of February, 2011 to the following:

John's Repair, Inc.  
301 North Main Street  
LeSueur, MN 56058

and

Karen A. Brennan  
Winthrop & Weinstine, P.A.  
Suite 3500  
225 South Sixth Street  
Minneapolis MN 55402

/Matthew H. Swyers/  
Matthew H. Swyers