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Filing date: **04/18/2011**

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	PI-Design AG		
Entity	Corporation	Citizenship	Switzerland
Address	Kantonsstrasse 100 Triengen, 6234 SWITZERLAND		

Attorney information	Julie B. Seyler Abelman Frayne & Schwab 666 Third Avenue New York, NY 10017 UNITED STATES JBSeyler@lawabel.com, Rdahl@lawabel.com Phone:2129499022		
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**Registration Subject to Cancellation**

Registration No	2867434	Registration date	07/27/2004
Registrant	PRESSO UK Ltd. 2 Scala Street London, W1T2HN, UNITED KINGDOM		

**Goods/Services Subject to Cancellation**

Class 021. First Use: 2003/10/01 First Use In Commerce: 2004/03/01 All goods and services in the class are cancelled, namely: Non-electric coffee makers, coffee cups, coffee pots not of precious metal, hand-operated coffee grinders, non-electric pots not of precious metal
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**Grounds for Cancellation**

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Application No.	85179011	Application Date	11/17/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PRESSO		

Design Mark	<h1>PRESSO</h1>
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 Non-electric coffeemakers and double wall coffeemakers, double wall drinking glasses and glass storage jars

Attachments	85179011#TMSN.jpeg ( 1 page )( bytes ) PI-DESIGN V PRESSO - PETITION TO CANCEL - 4-18-11.pdf ( 6 pages )(246634 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	/Julie B. Seyler/
Name	Julie B. Seyler
Date	04/18/2011

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

In re Registration No. 2,867,434  
Dated: July 27, 2004

PI-Design AG	:	
	:	
Petitioner,	:	Cancellation No.
v.	:	
	:	
Presso UK Ltd.	:	
Registrant.	:	
	:	

**PETITION FOR CANCELLATION**

PI-Design AG, a corporation organized and existing under the laws of Switzerland with an office at Kantonsstrasse 100, Triengen 6234, Switzerland (“Petitioner”), believes it will be damaged by Registration No. 2,867,434 for PRESSO and Design and hereby petitions to cancel this registration.

As grounds for cancellation, it is alleged that:

**Petitioner’s Standing**

1. Petitioner is the owner of the trademark PRESSO.
2. Petitioner has used the trademark PRESSO continuously in commerce in connection with coffee makers since at least as early as 1985.
3. Petitioner has filed Application No. 85/179011 to register PRESSO on “non-electric coffeemakers and double wall coffeemakers, double wall drinking glasses and glass storage jars” based on use in commerce since 1985.
4. Petitioner’s Application No. 85/179011 for PRESSO has been refused registration because of Registration No. 2,867,434 for PRESSO for “non-electric coffee

makers, coffee cups, coffee pots not of precious metal, hand-operated coffee grinders; and non-electric pots not of precious metal”.

## **Fraud**

5. Registrant is the owner of record of Registration No. 2,867,434 for PRESSO for “non-electric coffee makers, coffee cups, coffee pots not of precious metal, hand-operated coffee grinders, non-electric pots not of precious metal”.
6. Registrant committed fraud when it filed its Section 8 and 15 Affidavits of Use because it made material misstatements of facts concerning the use of the trademark PRESSO in commerce.
7. On April 27, 2010, Registrant filed an Affidavit of Use under Section 8 of the Trademark Act that the registered “mark is in use in commerce on or in connection with all of the goods listed in the existing registration for this specific class”.
7. Registrant’s statement was made with knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document.
8. On April 27, 2010, Petitioner filed an Affidavit of Incontestability under Section 15 of the Trademark Act that the registered “mark has been continuously used in commerce for five (5) consecutive years after the date of registration...and is still in use in commerce on or in connection with all goods...listed in the existing registration for this class.”
9. Registrant’s statement was made with knowledge that willful false statements and

the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document.

10. In support of the filing of the Section 8 and 15 Affidavit Registrant submitted a “Digitally scanned image from a National Newspaper. 21-March-2010”.
11. Patrick Hunt, the Director of Presso UK located in London, filed the Section 8 and 15 Affidavit and therefore the “National Newspaper” was a publication of the United Kingdom, not the United States.
12. The content of the news article indicated that the product was advertised for sale for £80 (80 pounds).
13. The news article stated in relevant part that “The Italians invented steam powered espresso makers around the turn of the 20<sup>th</sup> century; now a British company has gone one up on them by developing the first hand-pumped machine.”
14. The news article also stated “In fact you’ll make 100 coffees before you add £1 to your electricity bill.”
15. The specimen submitted by Registrant establishes that on March 21, 2010, Registrant’s goods were the subject of a news article in the United Kingdom and that Registrant had recently developed a hand-pumped espresso maker.
16. The specimen submitted by Registrant, on its face, fails to show that the trademark PRESSO was in use in commerce on the registered goods on the date the Section 8 and 15 was filed.
17. Bush Branding and Marketing ([www.bushmarketing.com](http://www.bushmarketing.com)) is responsible for the promotion of Registrant’s PRESSO product.

18. The website [www.bushmarketing.com](http://www.bushmarketing.com) states that “The Bush team is responsible for the start up, marketing and distribution of the Presso Espresso maker in Australia, Canada and most recently the USA.”
19. Registrant was not using the trademark PRESSO in commerce on April 27, 2010 the date the Section 8 Affidavit was filed on all of the goods claimed in the registration.
20. Registrant did not use the mark continuously in commerce for five (5) consecutive years after the date of registration on or in connection with all of the goods claimed in the registration.
21. Registrant intentionally made material misstatements of fact to maintain its registration.
22. By virtue of the facts set forth in the foregoing allegations, Petitioner has been damaged and will continue to be damaged within the meaning of 15 U.S.C. §1064.
23. WHEREFORE, it is respectfully requested that Registration No. 2,867,434 be cancelled on the basis of fraud.

**Abandonment**

24. On information and belief, Registrant, through non-use, abandoned the trademark PRESSO in connection with the goods identified in Registration No. 2,867,434.
25. On information and belief, any goodwill which may have been associated with the mark PRESSO has been destroyed due to Registrant’s abandonment and non-use of the mark in commerce.
26. Petitioner is being damaged by the existence of the subject registration.

Specifically, the Trademark Examiner has refused registration of Petitioner's application in view of the Registrant's registration. In addition, the existence of the registrations places a cloud upon Petitioner's title.

**Section 2(A)**

27. Petitioner's mark is famous.
28. Petitioner has used, promoted and advertised PRESSO in commerce within the United States since long prior to March 1, 2004, the claimed date of first use in commerce in Registration No. 2,867,434.
29. As a result of Petitioner's extensive and world-wide use of PRESSO, Petitioner possesses a goodwill of inestimable value and an enviable reputation with respect to its mark.
30. Registrant's mark PRESSO is identical to Petitioner's mark.
31. Registrant's goods are identical and/or commercially related to Petitioner's goods.
32. Registrant's mark is a colorable imitation of Petitioner's mark.
33. Registrant is attempting to trade on the goodwill previously established by Petitioner in the PRESSO marks.
34. Petitioner and Registrant are not related companies or in any way connected.
35. Petitioner's trademark PRESSO is of such fame and repute that Registrant's use of the mark PRESSO on the goods set forth in the registration will lead purchasers to assume a connection with Petitioner and to falsely suggest a common association, sponsorship, or origin of said goods between Registrant and Petitioner, all to Petitioner's irreparable damage and injury.

36. For the foregoing reasons, Petitioner submits that registration of Registrant's mark should be refused under Section 2(a) of the Trademark Act.

Respectfully submitted,

  
Julie B. Seyler

Date: April 18, 2011

ABELMAN, FRAYNE & SCHWAB  
666 Third Avenue  
New York, New York 10017-5612  
Telephone: (212) 949-9022

#### CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITION TO CANCEL was served by first class mail, postage prepaid this 18<sup>th</sup> day of April, 2011 upon the following:

Laura J. Hein  
GRAY PLANT MOOTY MOOTY & BENNETT  
P.O. Box 2096  
Minneapolis MN 55402-0906

  
JULIE B. SEYLER