

ESTTA Tracking number: **ESTTA421684**

Filing date: **07/26/2011**

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	Earth Heart, Inc.		
Entity	Corporation	Citizenship	Illinois
Address	P.O. Box 427 Dundee, IL 60018 UNITED STATES		

Attorney information	Matthew H. Swyers The Trademark Company 344 Maple Avenue West Suite 151 Vienna, VA 22180 UNITED STATES mswyers@thetrademarkcompany.com Phone:800-906-8626		
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Registration Subject to Cancellation

Registration No	3995953	Registration date	07/19/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	IDEA INTERNATIONAL CO., LTD. 3F, M.T.C. Building 5-13-18, Shiba, Minato-ku Tokyo 108-0014, JAPAN		

Goods/Services Subject to Cancellation

<p>Class 003. All goods and services in the class are cancelled, namely: Anti-static preparations for household purposes; de-greasing preparations for household purposes; rust removing preparations; stain removing benzine; fabric softeners for laundry use; laundry bleach; adhesives for affixing false hair; adhesives for affixing false eyelashes; laundry starch; funori, namely, seaweed gelatine for laundry use; paint stripping preparations; shoe and boot cream; shoe black, namely, shoe polish; polishing preparations; soaps and detergents; shampoos for pets; dentifrices; cosmetics and non-medicated toiletries; cosmetics for animals; natural perfumery made from plants; natural perfumery prepared from animal extracts; synthetic perfumery; compound perfumery; food flavorings prepared from essential oils; incenses and fragrances; abrasive paper, namely, sandpaper; abrasive cloth; abrasive sand; artificial pumice stone; polishing paper; false nails; false eyelashes</p>
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85324713	Application Date	05/19/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EARTH HEART		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1992/05/00 First Use In Commerce: 1992/05/00 Aromatic preparations, namely, body sprays; Bath salts; Beauty creams; Face and body lotions; Massage oils; Reeds and scented oils sold as a unit for use in room scent diffusers</p> <p>Class 005. First use: First Use: 1992/05/00 First Use In Commerce: 1992/05/00 Aromatherapy creams for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Aromatherapy lotions for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Aromatherapy oils, other than essential oils, for treating anxiety; Aromatherapy sprays for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Herbal anti-itch and sore skin ointment for pets; Liniments; Medicated balms for treatment of treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Medicated lotions for treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Medicated serums for treatment of treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Natural supplements for treating depression and anxiety; Nausea treatment preparations</p>		

Attachments	85324713#TMSN.jpeg (1 page)(bytes) Petition to Cancel TERRACUORE.pdf (7 pages)(274532 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 H. Swyers
Date	07/26/2011

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

In the matter of U.S. Registration 3,995,953,
For the mark TERRACUORE and design,
Registered on the Principal Register on July 19, 2011.

Earth Heart, Inc.,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Petition No. _____
	:	
Idea International Co. Ltd.,	:	
	:	
Registrant.	:	

PETITION TO CANCEL

Petitioner, Earth Heart, Inc. (hereinafter "Petitioner"), an Illinois corporation, whose corporate address is P.O. Box 427, Dundee, Illinois, 11372, believes that it is and will continue to be damaged by the continued registration of U.S. Registration 3,995,953 for the mark and design TERRACUORE 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 Idea International Co. Ltd.'s (hereinafter "Registrant") mark and design TERRACUORE as more fully displayed in U.S. Registration No. 3,995,953 would be likely to cause confusion with Petitioner's mark and design EARTH HEART which retains priority of use over Registrant's mark and design TERRACUORE by virtue of its prior use in commerce in the United States.

Statement of Facts

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

1. Petitioner is the owner of the mark EARTH HEART used on or in connection with “Aromatic preparations, namely, body sprays; Bath salts; Beauty creams; Face and body lotions; Massage oils; Reeds and scented oils sold as a unit for use in room scent diffusers” in International Class 3 and “Aromatherapy creams for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Aromatherapy lotions for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Aromatherapy oils, other than essential oils, for treating anxiety; Aromatherapy sprays for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Herbal anti-itch and sore skin ointment for pets; Liniments; Medicated balms for treatment of treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Medicated lotions for treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Medicated serums for treatment of treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Natural supplements for treating depression and anxiety; Nausea treatment preparations” in International Class 5.

2. Petitioner first used the mark EARTH HEART in connection with the above-identified services in interstate commerce on or about May 1992.

3. Petitioner’s use of the mark EARTH HEART in connection with the above-identified services has been continuous since on or about May 1992.

4. Petitioner has invested significant sums of money in the promotion of the mark EARTH HEART and the Petitioner’s services in the United States.

5. As a result of the aforesaid, Petitioner has developed a valuable reputation and goodwill in its EARTH HEART mark and has achieved a following among the relevant consuming public

prior to the filing, registration and/or priority date of Registrant's application to register the mark and design TERRACUORE identified more fully in U.S. Registration No. 3,995,953.

6. On May 19, 2011, Petitioner filed an application to register its mark EARTH HEART used on or in connection with "Aromatic preparations, namely, body sprays; Bath salts; Beauty creams; Face and body lotions; Massage oils; Reeds and scented oils sold as a unit for use in room scent diffusers" in International Class 3 and "Aromatherapy creams for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Aromatherapy lotions for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Aromatherapy oils, other than essential oils, for treating anxiety; Aromatherapy sprays for treating headaches, relieving stress, curing insomnia, anxiety and nausea; Herbal anti-itch and sore skin ointment for pets; Liniments; Medicated balms for treatment of treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Medicated lotions for treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Medicated serums for treatment of treating headaches, relieving stress, curing insomnia, anxiety, skin irritation, immune system health and nausea; Natural supplements for treating depression and anxiety; Nausea treatment preparations" in International Class 5. The application received Trademark Application No. 85/324,713.

7. By and through a research report conducted by Petitioner's Attorney, the attorney cited Registrant's Application as a possible blocking mark to Petitioner's Application based upon the opinion that, if registered, Petitioner's mark would be likely to create a likelihood of confusion with Registrant's mark and design for TERRACUORE, U.S. Registration No. 3,797,584, as it is a direct English translation of "Earth Heart", under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

8. The research report referenced hereinabove was Petitioner's first notice that Registrant was using the mark and design TERRACUORE in the United States.

9. Based upon information and belief, Registrant is a Japanese corporation located and doing business at 3F, M.T.C. Building 5-13-18, Shiba, Minato-ku, Tokyo, 108-0014, Japan.

10. Registrant is using the mark and design TERRACUORE in connection with "Anti-static preparations for household purposes; de-greasing preparations for household purposes; rust removing preparations; stain removing benzine; fabric softeners for laundry use; laundry bleach; adhesives for affixing false hair; adhesives for affixing false eyelashes; laundry starch; funori, namely, seaweed gelatine for laundry use; paint stripping preparations; shoe and boot cream; shoe black, namely, shoe polish; polishing preparations; soaps and detergents; shampoos for pets; dentifrices; cosmetics and non-medicated toiletries; cosmetics for animals; natural perfumery made from plants; natural perfumery prepared from animal extracts; synthetic perfumery; compound perfumery; food flavorings prepared from essential oils; incenses and fragrances; abrasive paper, namely, sandpaper; abrasive cloth; abrasive sand; artificial pumice stone; polishing paper; false nails; false eyelashes" in International Class 3.

11. Registrant's registration identified more fully in U.S. Registration No. 3,995,953 was filed with the United States Patent and Trademark Office on August 3, 2010.

12. Upon information and belief, Registrant first used the mark and design TERRACUORE in connection with the goods covered by its registration in the United States in August 2010.

13. As such, Petitioner's rights in the mark and design EARTH HEART has priority of use over Registrant's rights in the mark and design TERRACUORE, U.S. Registration No. 3,995,953, inasmuch as Petitioner commenced its use of the mark EARTH HEART in

connection with its services in interstate commerce prior to the filing, registration, and/or priority of use date of the Registrant's registration and use of the mark and design TERRACUORE.

14. Petitioner believes that consumers confronted with the Registrant's mark and design TERRACUORE will inevitably be confused and deceived into the mistaken belief that the Registrant's services have their origin or are in some manner connected with the Petitioner and/or Petitioner's goods offered in connection with its mark EARTH HEART.

15. The continued registration of Registrant's mark confers upon Registrant rights to which it is not entitled and is inconsistent with the prior established rights of Petitioner in its mark EARTH HEART.

16. By reason of the foregoing, Registrant will be seriously damaged by the continued registration of Registrant's mark and design TERRACUORE.

WHEREFORE Petitioner Earth Heart, Inc., by counsel, prays that the instant petition be granted and U.S. Registration No. 3,995,953 be cancelled.

Petitioner hereby appoints Matthew H. Swyers, Esquire of The Trademark Company, PLLC, 344 Maple Ave., West, Suite 151, Vienna, Virginia 22180, to act as his attorney for Opposer 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 26th day of July, 2011.

The Trademark Company, PLLC



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Counsel for Petitioner Earth Heart, Inc.

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

In the matter of U.S. Registration 3,995,953,
For the mark TERRACUORE and design,
Registered on the Principal Register on July 19, 2011.

Earth Heart, Inc.,	:	
	:	
Petitioner,	:	
	:	
vs.	:	Petition No. _____
	:	
Idea International Co. Ltd.,	:	
	:	
Registrant.	:	

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I caused a copy of the foregoing this 26th day of July, 2011, to
be served, via first class mail, postage prepaid, upon:

M. Scott Alprin
Alprin Law Offices
1260 21st St., N.W., Suite 702
Washington, D.C. 20036

/Matthew H. Swyers/
Matthew H. Swyers