

ESTTA Tracking number: **ESTTA434633**

Filing date: **10/07/2011**

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	Nouvelle Parfumerie Gandour		
Entity	Corporation	Citizenship	Ivory Coast
Address	c/o Advanced Beauty Cosmetics Inc. 1852 NE 144th Street North Miami, FL 33181 UNITED STATES		

Attorney information	Scott R. Austin Gordon & Rees LLP 200 S. Biscayne Blvd., Suite 4300 Miami, FL 33131 UNITED STATES saustin@gordonrees.com, msarah@gordonrees.com, mmims@gordonrees.com Phone:305-668-4433
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Registration Subject to Cancellation

Registration No	3504398	Registration date	09/23/2008
Registrant	Y.Z.Y., INC. 6300 N.W. 72ND AVENUE MIAMI, FL 33166 UNITED STATES		

Goods/Services Subject to Cancellation

Class 003. First Use: 2000/12/00 First Use In Commerce: 2000/12/00 All goods and services in the class are cancelled, namely: Body and beauty care cosmetics; Body cream; Body lotions; Body oil; Cosmetic soaps

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)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BIO CLAIRE		
Goods/Services	Body and beauty care cosmetics		

Attachments	Petition For Cancellation Reg. 3504398.pdf (8 pages)(72415 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	/Maha Sarah/
Name	Maha Sarah
Date	10/07/2011

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

In the Matter of Trademark Registration)	
Registration No.: 3,504,398)	
Serial No. 77/385,169)	
Filed: January 31, 2008)	
By: Y.Z.Y., Inc.)	
For the Trademark: "BIO CLAIRE")	
<hr style="border: 1px solid black;"/>)	Cancellation No. _____
)	
NOUVELLE PARFUMERIE GANDOUR,)	
an Ivory Coast Corporation,)	
Petitioner,)	
v.)	
)	
Y.Z.Y., Inc.,)	
a Florida Corporation,)	
)	
Respondent.)	
<hr style="border: 1px solid black;"/>)	

PETITION FOR CANCELLATION

Petitioner Nouvelle Parfumerie Gandour is a corporation organized and existing under the laws of the country of the Ivory Coast, having a principal place of business at Yopougon in the Ivory Coast ("Petitioner" or "Petitioner NPG"). Registrant Y.Z.Y., Inc., on information and belief, is a corporation organized and existing under the laws of the State of Florida with its principal place of business at 6300 N.W. 72nd Avenue, Miami, Florida, 33166 ("Registrant" or "Registrant Y.Z.Y."). Registrant Y.Z.Y. is the purported owner of record of the word mark "BIO CLAIRE," as shown in U.S. Trademark Registration No. 3,504,398 ("Registrant's Mark"). A true and correct copy of the Certificate of Registration for this mark is attached hereto as Exhibit A. Petitioner NPG believes that it will be damaged and is damaged by the continued registration of Registrant's Mark and hereby petitions the Trademark Trial and Appeal Board for cancellation of the same.

As grounds for the Petition to Cancellation, Petitioner NPG alleges as follows:

1. Registrant's Mark is registered on the Principal Register in International Class 003. Registrant's Mark claims the following goods: "Body and beauty care cosmetics; Body cream; Body lotions; Body Oil; and Cosmetic Soaps." An application for the registration of Registrant's Mark was filed with the United States Patent and Trademark Office on January 31, 2008. This application subsequently registered on September 23, 2008. In this registration, Registrant Y.Z.Y. claims a date of first use and date of first use in commerce of 12/00/2000.

2. Petitioner NPG is the creator of the mark and coined the term "BIO CLAIRE" ("Petitioner's Mark" or "BIO CLAIRE Mark"). Petitioner created the BIO CLAIRE Mark and brand on or around February 2001 in the Ivory Coast and Cameroon. The BIO CLAIRE Mark was registered in Cameroon through the African Intellectual Property Organization (OAPI), effective August 30, 2002, claiming a first use in 2001.

3. Registrant Y.Z.Y. is a distributor of Petitioner NPG. Registrant began ordering Petitioner's Bio Claire Lightening Body Cream product from Petitioner in or about October 2001, and began selling this product in the United States in the beginning of 2002. The parties understood that the BIO CLAIRE Mark was owned by Petitioner and that Registrant's role was simply to serve as an importer and distributor of these goods, not the source of these goods or the owner of the BIO CLAIRE Mark.

4. Although Registrant Y.Z.Y. has attempted to market advertise, distribute and sell Petitioner's product in the United States as its own, Petitioner's name, along with Petitioner's Mark appeared on the product's label from 2001 until at least 2011. Registrant's name did not appear on the product label in any manner during that time period.

5. In 2011, Registrant began offering for sale and selling counterfeits of Petitioner's products using the BIO CLAIRE Mark. It was not until Registrant began offering and selling the counterfeits, that Registrant's name appeared on the counterfeit labels.

6. Petitioner did not give Registrant permission to use the BIO CLAIRE Mark in any manner—Registrant was solely the distributor of Petitioner’s product. Nor did Petitioner give Registrant its consent to register the BIO CLAIRE Mark with the United States Patent and Trademark Office.

7. Through the sale of its goods bearing the BIO CLAIRE Mark within the United States and other countries, Petitioner’s Mark has developed and represents valuable, substantial and exclusive goodwill and reputation, which inures to Petitioner’s benefit alone. Petitioner’s Mark is valid, subsisting, and is recognized by a significant portion of the relevant public as identifying the goods of Petitioner. Therefore, Petitioner’s Mark and goodwill associated therewith are valuable assets of the Petitioner, and Petitioner’s reputation and goodwill will be harmed by the use and continued registration of Registrant’s Mark.

8. Wherefore, Petitioner NPG petitions to cancel Registrant’s Mark on the grounds that its registration was obtained fraudulently in violation of 15 U.S.C. § 1064(3). Specifically, on January 31, 2008, Registrant’s attorney, Richard S. Ross, Esq., knowingly made a false material representation of fact in connection with Registrant’s application by verifying that he “believed applicant to be the owner of the trademark/service mark sought to be registered” and that “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.” This is false because Registrant knew that Petitioner had prior rights in and to the BIO CLAIRE Mark as Registrant was purchasing the Bio Claire Lightening Body Cream product from Petitioner and because Petitioner’s name appeared on the original product label. Thus, Registrant Y.Z.Y. in bad faith obtained the rights in a U.S. Trademark Registration for

Petitioner's mark despite the fact that it knew Petitioner owned and had priority and senior rights in the BIO CLAIRE Mark based on first use.

9. Additionally, Registrant's Mark so resembles Petitioner's Mark so as to be likely to cause confusion, mistake or deceive as to the source or origin of Registrant's goods by creating the erroneous impression that Registrant's goods originate with, are sponsored, approved, endorsed, licensed by, affiliated, or associated with, or in some other way legitimately connected to Petitioner, the Petitioner's Mark or its goods. Such confusion, mistake or deception by Registrant's Mark has and will continue to damage Petitioner.

10. The registration of Registrant's Mark is contrary to 15 U.S.C. § 1052(d) and violates or diminishes Petitioner's prior and superior rights in its Mark. Registrant has obtained statutory rights in its Mark in violation and in derogation of Petitioner's established prior rights in and to its Mark.

WHEREFORE, for the foregoing reasons, Petitioner NPG prays that U.S. Registration No. 3,504,398 be cancelled under 15 U.S.C. § 1064, and that this Petition for Cancellation be sustained in favor of Petitioner NPG.

Please direct all correspondence concerning this Petition for Cancellation to:

Scott R. Austin
Gordon & Rees LLP
200 S. Biscayne Blvd, Suite 4300
Miami, FL 33131
Phone: (305) 668-4433
Fax: (877) 634-7245

Petitioner hereby appoints Scott R. Austin and Maha Sarah of Gordon & Rees LLP as its attorneys to transact all business in the United States Patent and Trademark Office and/or Trademark Trial and Appeal Board relating to this matter with full power of substitution.

Accompanying the duplicate signed copies of this Petition for Cancellation is the required fee of \$300.00. Please charge any excess fees or credit any overpayment to Deposit Account No. 50-1990 of Petitioner's counsel as noted below.

Date: October 6, 2011

Respectfully submitted,

GORDON & REES LLP

/s/ Scott R. Austin

Scott R. Austin

Florida State Bar No. 434140

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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above document was filed electronically with the Trademark Trial and Appeal Board on this 6th day of October, 2011.

GORDON & REES LLP

/s/ Maha Sarah

Maha Sarah

EXHIBIT A

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 3,504,398

Registered Sep. 23, 2008

**TRADEMARK
PRINCIPAL REGISTER**

BIO CLAIRE

Y.Z.Y., INC. (FLORIDA CORPORATION)
6300 N.W. 72ND AVENUE
MIAMI, FL 33166

FOR: BODY AND BEAUTY CARE COSMETICS;
BODY CREAM; BODY LOTIONS; BODY OIL; COS-
METIC SOAPS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51
AND 52).

FIRST USE 12-0-2000; IN COMMERCE 12-0-2000.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-
TURE(S) SHOWN IN THE MARK DOES NOT IDEN-
TIFY A PARTICULAR LIVING INDIVIDUAL.

SER. NO. 77-385,169, FILED 1-31-2008.

MICHELE SWAIN, EXAMINING ATTORNEY

Certificate of Mailing by "First Class U.S. Mail"

I hereby certify that a copy of this PETITION FOR CANCELLATION is being served by First Class U.S. Mail service to the below addressee on October 6, 2011, as follows:

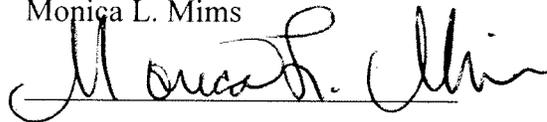
RICHARD S. ROSS, ESQ.
4801 S. UNIVERSITY DR. STE. 237
FT. LAUDERDALE, FL 33328-3836

Y.Z.Y., INC.
6300 N.W. 72ND AVENUE
MIAMI, FL 33166

Date of Mailing: October 6, 2011

Printed Name: Monica L. Mims

Signature:

A handwritten signature in black ink, appearing to read "Monica L. Mims", written over a horizontal line.