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Filing date: **04/23/2012**

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	Tijs M. Verwest		
Entity	Individual	Citizenship	NETHERLANDS
Address	c/o Gelfand Rennert & Feldman LLP 360 Hamilton Avenue, Suite 100 White Plains, NY 10601 UNITED STATES		

Attorney information	Brad D. Rose Pryor Cashman LLP 7 Times Square New York, NY 10036 UNITED STATES mshine@pryorcashman.com, tmdocketing@pryorcashman.com, tlee@pryorcashman.com Phone:212-326-0875
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Registration Subject to Cancellation

Registration No	3607748	Registration date	04/14/2009
Registrant	HAYABUSA FIGHTWEAR INC. 641 MELROSE STREET KINGSTON, ONTARIO, K7M 9G8 CANADA		

Goods/Services Subject to Cancellation

Class 025. First Use: 2006/03/00 First Use In Commerce: 2006/03/00 All goods and services in the class are cancelled, namely: clothing, namely, t-shirts, shorts, compression shorts, compression shirts, sweatshirts, hats, baseball caps, toques, beanies, kimonos, and grappling shoes
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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.	79094052	Application Date	12/20/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	<p>The mark consists of a stylized bird with outstretched wings appearing within an incomplete circle. The bird's wings and tail feathers extend outside the circle.</p>
Goods/Services	<p>Class 009. First use: Apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers; prerecorded magnetic data carriers featuring music and musical shows and DJ performances; prerecorded video discs; prerecorded digital video discs; compact discs featuring music; super audio compact discs featuring music; blank recordable DVDs; prerecorded DVDs featuring music and musical shows and DJ performances; blank CD-ROMs for sound or video recording; digital music downloadable from the Internet; MP3 players; personal digital assistants; electronic handheld units for the wireless receipt and/or transmission of sound</p> <p>Class 016. First use: Paper, cardboard and goods made from these materials, not included in other classes, namely paper bags for packaging, boxes of paper or cardboard, cardboard cartons, cardboard containers, cardboard signboards, cardboard tubes, cardboard packaging, containers for storage or transport made of paper or cardboard; posters; calendars; stickers; decals; bumper stickers; iron-on and plastic transfers; sheet music; blank cards; gift and greeting cards; motivational cards; trading cards; postcards; scrapbooks; note pads; bookmarks; paper pennants; address and appointment books; autograph books; guest books; paper tags; paper flags; paper banners; book covers; brag books; photographic prints; collages; lithographs; illustrations; coasters made of paper; printed paper signs; printed emblems; printed awards; printed holograms; paper illustration boards; tour books; printed concert programs; event programs and albums; books, magazines, leaflets, journals, newsletters, booklets, pamphlets and brochures, all of the aforesaid featuring music and musical entertainment; photographs; stationery; plastic materials for packaging, not included in other classes, namely, plastic bags for packaging</p> <p>Class 025. First use: Clothing, namely, shirts, long-sleeved shirts, T-shirts, under shirts, polo shirts, cardigans, jerseys, bottoms, shorts, boxer shorts, tops, stretch tops, crop tops, tank tops, tankinis, sweat shirts, hooded sweat shirts, sweat jackets, sweat shorts, sweat pants, vests, pullovers, jackets, sports jackets, turtlenecks, swimwear, beachwear, headwear, caps, hats, visors, headbands, wrist bands, sweat bands, aprons, scarves, bandanas, belts, neckwear, underwear, socks, loungewear, robes, underclothes, pajamas, sleepwear, hosiery, gloves, rainwear, footwear, flip-flops, and slippers</p> <p>Class 041. First use: Entertainment and relaxation, namely, organizing sporting and cultural events; disc jockey services; entertainment in the nature of visual and audio performances by disc jockeys, artists and dancers; recording studio services; impresario services, namely, organizing, arranging and conducting live musical and dance performances and events; presentation of live show performances</p>

Attachments	79094052#TMSN.jpeg (1 page)(bytes) Cancellation Tiesto.PDF (8 pages)(284658 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 Overnight Courier on this date.

Signature	/Brad D. Rose/
Name	Brad D. Rose
Date	04/23/2012

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

In the Matter of:

U.S. Registration No. 3,607,748 for
Hayabusa Fightwear Bird Logo

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TIJS M. VERWEST,	:	
	:	
Petitioner,	:	
	:	Cancellation No.
-against-	:	
	:	
HAYABUSA FIGHTWEAR INC.,	:	
	:	
Respondent	:	
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PETITION FOR CANCELLATION

Tijs M. Verwest, an individual and Dutch citizen with an address at c/o Gelfand Rennert & Feldman LLP, 360 Hamilton Avenue, Suite 100, White Plains, NY 10601 (hereinafter "Petitioner" or "Tiësto"), believes that it is being and will continue to be damaged by Registration

No. 3,607,748 for the trademark Hayabusa Fightwear Bird Logo () (otherwise referred to herein as the "Registered Mark" or "HF Bird Logo) for "clothing, namely, t-shirts, shorts, compression shorts, compression shirts, sweatshirts, hats, baseball caps, toques, beanies, kimonos, and grappling shoes" in International Class 25 (hereinafter "Registration"), owned by Hayabusa Fightwear Inc. (hereinafter "Respondent"), and hereby petitions to cancel said registration pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111. As grounds therefor, it is alleged that:

Background on Tijs M. Verwest p/k/a Tiësto:

1. Respondent, Tijs M. Verwest p/k/a Tiësto, is an internationally renown musician, DJ and record producer of electronic dance music. In 2001, Tiësto released his first solo album entitled “In My Memory” which included several major hits that launched his career. Tiësto was crowned the “World’s No. 1 DJ” three (3) consecutive years by DJ Magazine from 2002 through 2004. In 2003, Tiësto released a compilation album entitled “Nyana” bearing for the first time

Tiësto’s famous logo:  (hereinafter “Bird Logo”). After releasing his second studio album entitled “Just Be” in 2004, Tiësto performed live at the opening ceremony of the Summer Olympics in Athens, Greece, becoming the first DJ ever to play live on stage at an Olympics Game opening ceremony. In April 2007, Tiësto released his third album entitled “Elements of Life” which was included among the “Billboard Top Electronic Albums” in the U.S. and also received a nomination for a Grammy Award in 2008.

2. Tiësto released his fourth studio album entitled “Kaleidoscope” in October 2009 to critical acclaim. His 2010 “Kaleidoscope World Tour” spanned more than 15 (fifteen) months and one hundred and seventy-five (175) dates across six continents playing to over one million (1,000,000) people. The tour culminated with a sold out event at the Home Depot Center in Los Angeles where Tiësto performed before an audience of twenty-six thousand (26,000) fans, making it the largest single headline DJ show in United States history. The hugely successful tour was recognized by Billboard Magazine who nominated Tiësto for two 2010 Billboard Touring Awards and placed him among Billboard’s Top 25 biggest touring acts of 2010.

3. With over eleven (11) million friends on Facebook, one million followers on Twitter, close to three hundred (300) million hits on YouTube, his globally syndicated Club Life radio show as well as his Club Life iTunes artist podcast (#1 music podcast globally), Tiësto has truly become a worldwide phenomenon. Voted “The Greatest DJ of All Time” by Mixmag in 2011, Tiësto has worked with superstars such as Kanye West, Coldplay, Katy Perry, Nelly Furtado and many more.

4. Tiësto promotes himself throughout the United States, via the internet, and through the website www.Tiësto.com, Facebook, Twitter and MySpace.

5. Tiësto has been using the Bird Logo continuously and extensively on or in connection with music and entertainment related goods and services in the United States since 2003. Since that time, Tiësto has extended his use of the Bird Logo to other goods including but not limited to apparel. Specifically, Tiësto first used the Bird Logo in the United States on or in connection with apparel in 2005. The Bird Logo is also used prominently on Tiësto’s official website and Facebook page. As a result of Tiësto’s long-standing use of the Bird Logo coupled with Tiësto’s phenomenal musical achievements, the Bird Logo has become famous.

6. In addition to the common law rights that Tiësto owns in and to the Bird Logo, Tiësto is also the owner of U.S. Trademark Application Serial No. 79/094,052 covering a variety of goods and services in cls. 9, 16 and 41 and “clothing, namely, shirts, long-sleeved shirts, T-shirts, under shirts, polo shirts, cardigans, jerseys, bottoms, shorts, boxer shorts, tops, stretch tops, crop tops, tank tops, tankinis, sweat shirts, hooded sweat shirts, sweat jackets, sweat shorts, sweat pants, vests, pullovers, jackets, sports jackets, turtlenecks, swimwear, beachwear, headwear, caps, hats, visors, headbands, wrist bands, sweat bands, aprons, scarves, bandanas, belts, neckwear, underwear,

socks, loungewear, robes, underclothes, pajamas, sleepwear, hosiery, gloves, rainwear, footwear, flip-flops, and slippers,” in cl. 25 (hereinafter “Bird Logo Trademark”)¹.

7. The Bird Logo Trademark has been in valid and continuous use in connection with apparel since the date of first use and has not been abandoned.

8. As a result of Tiësto’s phenomenal success in the music industry, as demonstrated by his sold-out musical concerts and tours, gold selling albums, national and international public and media appearances, solicited and unsolicited publicity he has received, combined with the substantial amount of time and money Tiësto has expended over the years in advertising and promoting merchandise, including apparel, under the Bird Logo Trademark, Tiësto has acquired substantial goodwill in his famous Bird Logo such that the public has come to associate

the trademark  solely and exclusively with Tiësto.

The Registered Mark is Confusingly Similar to the Bird Logo Trademark:

9. On July 6, 2006, Respondent filed an intent to use trademark application with the U.S. Patent and Trademark Office (“U.S.P.TO.”) for the alleged mark HF Bird Logo () which ultimately proceeded to registration on April 14, 2009 as set forth under Reg. No. 3,607,748 (otherwise referred to herein as the “Registration”). Respondent’s Registration covers “clothing, namely, t-shirts, shorts, compression shorts, compression shirts, sweatshirts, hats, baseball caps, toques, beanies, kimonos, and grappling shoes,” in cl. 25 and alleges March 2006 as the date of first use in commerce.

¹ On April 10, 2012, Tiësto filed a Request to Divide Application Serial No. 79/094,052 whereby the cl. 25 goods would be retained in the parent application and the class 9, 16 and 41 goods and services would be transferred to the new child application.

10. Tiësto's first use of the Bird Logo in 2005 in connection with apparel precedes Respondent's date of first use of its alleged mark HF Bird Logo, which was March 2006, as set forth in the materials filed by Respondent with the U.S.P.T.O.

11. Respondent's HF Bird Logo () is visually similar to Tiësto's Bird Logo (). Indeed, both the Bird Logo and HF Bird Logo consist of a similarly stylized bird with outstretched wings appearing within a circle. The different tail and addition of non-Latin characters in the HF Bird Logo does not reduce the likelihood of consumer confusion.

12. In addition, Respondent's use of the HF Bird Logo in connection with "clothing, namely, t-shirts, shorts, compression shorts, compression shirts, sweatshirts, hats, baseball caps, toques, beanies, kimonos, and grappling shoes" (as set forth in the Registration) will likely cause confusion amongst consumers given that Tiësto's Bird Logo Trademark covers *inter alia* "clothing, namely, shirts, long-sleeved shirts, T-shirts, under shirts, polo shirts, cardigans, jerseys, bottoms, shorts, boxer shorts, tops, stretch tops, crop tops, tank tops, tankinis, sweat shirts, hooded sweat shirts, sweat jackets, sweat shorts, sweat pants, vests, pullovers, jackets, sports jackets, turtlenecks, swimwear, beachwear, headwear, caps, hats, visors, headbands, wrist bands, sweat bands, aprons, scarves, bandanas, belts, neckwear, underwear, socks, loungewear, robes, underclothes, pajamas, sleepwear, hosiery, gloves, rainwear, footwear, flip-flops, and slippers" – goods which clearly overlap and are therefore essentially identical and highly related to those goods covered in the Registration.

13. Given that the Registration does not contain any limitations with respect to the channels of trade through which Respondent is selling its apparel, it can be presumed and expected that such apparel is marketed and sold to the same types of consumers through the same or similar channels of trade as Tiësto sells and markets and/or could sell and market his apparel under the Bird Logo Trademark. This increases the likelihood of consumer confusion.

14. Since the Bird Logo has become exclusively associated with Tiësto and his goods and services, Respondent's registration and use of the HF Bird Logo in connection with apparel will inevitably cause confusion in the minds of the public, thereby misleading the public to believe that Respondent's goods emanate from Tiësto or that Respondent is in some way associated with or connected to Tiësto, when, in fact, no such relationship exists.

15. Finally, because the Bird Logo Trademark is famous, use and registration of the HF Bird Logo by Respondent will unquestionably dilute Tiësto's Bird Logo Trademark.

16. In sum, the continued active existence of the Registration would likely cause considerable dilution, confusion, mistake and/or deception in view of the facts that:

- (i) Tiësto's Bird Logo Trademark has been used since at least as early as 2005;
- (ii) Tiësto's use of the Bird Logo Trademark on or in connection with apparel pre-dates Respondent's alleged use in March 2006;
- (iii) Tiësto's Bird Logo is famous;
- (iv) the goods in connection with which Respondent uses the HF Bird Logo (i.e., apparel) are identical to the goods marketed under Tiësto's Bird Logo Trademark (i.e., apparel); and
- (v) the Registered Mark is deceptively and confusingly similar to Tiësto's Bird Logo Trademark.

Certificate of Mailing Through ESTTA

I hereby certify that this Petition for Cancellation is being filed electronically through ESTTA with the Trademark Trial and Appeal Board, United States Patent and Trademark Office, Alexandria, VA 22313-1451 on the date indicated below.

Date of Deposit: 4/23/12

Signed: Maira B Shine
Name: Moira B Shine

Certificate of Service by FEDEX

I hereby certify that a true and correct copy of PETITION FOR CANCELLATION is being served by "FEDEX" and addressed to Respondent, on 4/23/12 at the addresses listed below:

Hayabusa Fightwear Inc.
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Signed: Maira B Shine

Name: Moira B Shine