

ESTTA Tracking number: **ESTTA486501**

Filing date: **07/31/2012**

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	BHPC ASSOCIATES LLC		
Entity	limited liability corporation	Citizenship	Delaware
Address	1370 Broadway New York, NY 10018 UNITED STATES		

Attorney information	Robert L. Epstein Epstein Drangel LLP 60 East 42nd Street, Suite 2410 New York, NY 10165 UNITED STATES mail@ipcounselors.com Phone:2122925390		
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**Registration Subject to Cancellation**

Registration No	3378599	Registration date	02/05/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	Royal County of Berkshire Polo Club Ltd. North Street, Winkfield, Windsor Berkshire, SL4 4TH UNITED KINGDOM		

**Goods/Services Subject to Cancellation**

Class 009. All goods and services in the class are cancelled, namely: Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefore, namely, chains for spectacles and sunglasses, holders for spectacles and sunglasses, and lenses for spectacles and sunglasses
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**Grounds for Cancellation**

Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

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

U.S. Registration No.	1751058	Application Date	10/01/1991
Registration Date	02/09/1993	Foreign Priority Date	NONE
Word Mark	BEVERLY HILLS POLO CLUB		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1991/05/31 First Use In Commerce: 1991/05/31 ophthalmic eyewear; namely, eyeglass frames, lenses, chains, and cases; eyeglasses; and sunglasses</p> <p>Class 014. First use: First Use: 1991/08/31 First Use In Commerce: 1991/08/31 watches</p> <p>Class 018. First use: First Use: 1991/03/31 First Use In Commerce: 1991/03/31 wallets, umbrellas, and small leather goods; namely, credit card cases, key cases, and coin purses</p> <p>Class 024. First use: First Use: 1991/03/01 First Use In Commerce: 1991/03/01 beach towels, bath towels, table linens and textile placemats, and bed and bath accessories; namely, fabric toilet seat covers</p> <p>Class 025. First use: First Use: 1989/10/31 First Use In Commerce: 1989/10/31 clothing for men, women and children; namely, shirts, sweatshirts, sweaters, tee shirts, pants, caps, hats, jackets, dresses, socks, hosiery, raincoats and outerwear; namely, coats and jackets, and belts</p>

Attachments	74209022#TMSN.gif ( 1 page )( bytes ) 073112 Petition for Cancellation.pdf ( 14 pages )(314025 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	/robert l. epstein/
Name	Robert L. Epstein
Date	07/31/2012

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

BHPC ASSOCIATES LLC,	x	
	:	
	:	
Petitioner,	:	Cancellation No.
	:	
v.	:	
	:	
	:	
ROYAL COUNTY OF BERKSHIRE POLO CLUB LTD	:	
	:	
Registrant.	x	

**PETITION OF CANCELLATION**

Petitioner, BHPC Associates LLC, of 1370 Broadway, New York City, New York 10018, believes that it is being damaged by Registration No. 3378599 issued February 5, 2008 for the trademark ROYAL BERKSHIRE POLO CLUB and Polo Player Design in International Class 009 and therefore petitions to cancel said registration.

As grounds for its petition, Petitioner, by and through its undersigned attorneys, alleges as follows:

1. Continuously and long prior to the filing date of March 12, 2006 of Application Serial No. 78835089 upon which Registration No. 3378599 is based, Petitioner has offered and continues to offer a variety of goods, including ophthalmic eyewear and sunglasses bearing the mark BEVERLY HILLS POLO CLUB and a design including the image of a polo player on horseback swinging his mallet (the "BEVERLY HILLS POLO CLUB and Polo Player Design mark").

2. Over a prolonged period of time, Petitioner has invested a substantial amount of time, effort and money promoting its BEVERLY HILLS POLO CLUB and Polo Player Design mark and the goods bearing that mark. As a result of its promotional efforts, a tremendous volume of sales, and extensive use of the BEVERLY HILLS POLO CLUB and Polo Player Design mark, Petitioner's BEVERLY HILLS POLO CLUB and Polo Player Design mark has attained widespread acclaim in the United States, and has come to be exclusively recognized as identifying the products of Petitioner. Since long before any use of or alleged rights of Registrant in the mark of Registration No. 3378599 sought to be cancelled, Petitioner's BEVERLY HILLS POLO CLUB and Polo Player Design mark has become distinctive of Petitioner's goods and represents a tremendous amount of goodwill of Petitioner's business.

3. In addition to its common law rights, Petitioner owns the following incontestable United States trademark registrations of the BEVERLY HILLS POLO CLUB and the Polo Player Design mark for use in the aggregate in connection with Petitioner's goods:

MARK	Class(es)	REGISTRATION NUMBER	REGISTRATION DATE
	09,14,18,24,25	1751058	02-09-1993

4. Petitioner's registration is valid, subsisting, in full force and effect, incontestable, and are evidence of Petitioner's exclusive rights to use its registered marks on the identified goods, pursuant to 15 U.S.C. §§ 1057 and 1115.

5. Upon information and belief, Royal County of Berkshire Polo Club Ltd. ("Registrant") filed with the United States Patent and Trademark Office an Application Ser. No. 78835089 dated March 12, 2006, for the trademark ROYAL BERKSHIRE POLO CLUB and Polo Player Design ("Registrant's Mark") for the following goods in International Class 009: "Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefor". A copy of Application Serial No. 78835089 is annexed hereto as **EXHIBIT A**.

6. Upon information and belief, said Application Ser. No. 78835089 was allowed by the United States Patent and Trademark Office and issued into Registration No. 3378599 on February 5, 2008, the registration which Petitioner seeks to cancel.

7. Registrant is not connected to Petitioner in any way and has not been authorized by Petitioner to use the mark of Registration No. 3378599.

#### **COUNT I: Priority and Likelihood of Confusion**

8. Petitioner repeats and re-alleges each and every allegation contained in paragraphs 1 through 7 as if fully set forth herein.

9. Upon information and belief, Petitioner acquired rights in the BEVERLY HILLS POLO CLUB and Polo Player Design mark prior to any date on which Applicant can rely in connection with the mark of Registration No. 3378599.

10. Petitioner's BEVERLY HILLS POLO CLUB and Polo Player Design mark is the same as or similar to the mark of Registration No. 3378599 in appearance, sound, meaning and commercial impression, both marks including the words POLO CLUB and confusingly similar polo player images, arranged in a similar manner, with the confusingly similar polo player images situated above the words POLO CLUB.

11. The goods of the respective parties are identical or commercially related, and/or the conditions and activities surrounding the marketing of same are such that they would or could be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source.

12. As a result, the mark of Registration No. 3378599, when used in connection with the goods identified said registration, is likely to cause confusion or mistake or to deceive and mislead the trade and the purchasing public into believing that Registrant's goods are the goods of Petitioner, or that Registrant or its goods are authorized, licensed or controlled by Petitioner, or that Registrant is affiliated with or in some way related to Petitioner. Accordingly, any such use or/and the continued registration of the mark of Registration No. 3378599 would and does violate Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

13. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark of Registration No. 3378599.

## **COUNT II: ABANDONMENT**

14. Petitioner repeats and realleges each of the allegations set forth in Paragraphs 1 through 13 of the Petition above, as though same were fully set forth herein.

15. Upon information and belief, Registrant has not used Registrant's Mark in commerce on some or all of the goods identified in Registration No. 3378599.

16. Upon information and belief, Registrant has no bona fide intention to use Registrant's Mark in commerce on some or all of the goods identified in Registration No. 3378599.

17. Upon information and belief, Registrant has abandoned any right it may have, or may have had, to use Registrant's Mark on the goods identified in Registration No. 3378599.

18. Upon information and believe, Registrant has abandoned Registration No. 3378599.

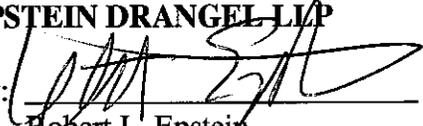
19. Upon information and belief, Registration No. 3378599 is invalid because of abandonment and should be cancelled in its entirety.

20. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark of Registration No. 3378599.

**WHEREFORE**, it is respectfully requested that this petition for cancellation be sustained and that the Registration No. 3378599 be cancelled .

Respectfully submitted,

**EPSTEIN DRANGEL LLP**

By: 

Robert L. Epstein  
William C. Wright  
Jason M. Drangel  
60 East 42<sup>nd</sup> Street, Suite 2410  
New York, New York 10165  
Tel. No.: (212) 292-5390  
Fax. No.: (212) 292-5391

Dated: July 31, 2011

# EXHIBIT A

# Trademark/Service Mark Application, Principal Register

Serial Number: 78835089

Filing Date: 03/12/2006

The table below presents the data as entered.

Input Field	Entered
<b>MARK SECTION</b>	
MARK FILE NAME	\\TICRS\EXPORT6\IMAGEOUT6 788\350\78835089\xml1\AP P0002.JPG
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	ROYAL BERKSHIRE POLO CLUB
COLOR MARK	NO
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	928 x 901
<b>OWNER SECTION</b>	
NAME	Royal County of Berkshire Polo Club Ltd.
STREET	North Street, Winkfield, Windsor
CITY	Berkshire
ZIP/POSTAL CODE	SL4 4TH
COUNTRY	United Kingdom
EMAIL	trademarks@eitangroup.com
AUTHORIZED EMAIL COMMUNICATION	Yes
<b>LEGAL ENTITY SECTION</b>	
TYPE	CORPORATION
STATE/COUNTRY OF INCORPORATION	United Kingdom
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	009

DESCRIPTION	Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefor.
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION</b>	
INTERNATIONAL CLASS	009
DESCRIPTION	Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefor.
FILING BASIS	Section 44(e)
FOREIGN REGISTRATION NUMBER	22186
FOREIGN REGISTRATION COUNTRY NAME	European Community (EMX)
FOREIGN REGISTRATION DATE	12/18/2000
FOREIGN EXPIRATION DATE	04/01/2006
FOREIGN RENEWAL DATE	04/01/2006
<b>SIGNATURE SECTION</b>	
SIGNATURE	/te/
SIGNATORY NAME	A. Tally Eitan
SIGNATORY DATE	03/12/2006
SIGNATORY POSITION	Attorney for Applicant
<b>PAYMENT SECTION</b>	
NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
SUBTOTAL AMOUNT	325
TOTAL AMOUNT	325
PAYMENT METHOD	DA
<b>ATTORNEY</b>	
NAME	A. Tally Eitan
FIRM NAME	Eitan Law Group, Eitan Mehulal Pappo Kugler
INTERNAL ADDRESS	c/o Edna Eisemann
STREET	18106 Kitchen House Court
CITY	Germantown

STATE	Maryland
ZIP/POSTAL CODE	20874
COUNTRY	United States
PHONE	518-280-8924
FAX	301-972-0370
EMAIL	trademarks@eitangroup.com
AUTHORIZED EMAIL COMMUNICATION	Yes
ATTORNEY DOCKET NUMBER	T-8252-09-US
OTHER APPOINTED ATTORNEY(S)	Vladimir Sherman
<b>DOMESTIC REPRESENTATIVE SECTION</b>	
NAME	A. Tally Eitan
FIRM NAME	Eitan Law Group, Eitan Mehulal Pappo Kugler
INTERNAL ADDRESS	c/o Edna Eisemann
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STATE	Maryland
ZIP/POSTAL CODE	20874
COUNTRY	USA
PHONE	518-280-8924
FAX	301-972-0370
EMAIL	trademarks@eitangroup.com
AUTHORIZED EMAIL COMMUNICATION	Yes
<b>CORRESPONDENCE SECTION</b>	
NAME	A. Tally Eitan
FIRM NAME	Eitan Law Group, Eitan Mehulal Pappo Kugler
INTERNAL ADDRESS	c/o Edna Eisemann
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PHONE	518-280-8924
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EMAIL	trademarks@eitangroup.com
AUTHORIZED EMAIL COMMUNICATION	Yes
<b>FILING INFORMATION</b>	
SUBMIT DATE	Sun Mar 12 03:54:10 EST 2006
TEAS STAMP	USPTO/BAS-21214310136-200 60312035410965012-7883508 9-20051c78d9184c717b78c6e 6c6a4b957bac-DA-1059-2006 0312035247411423

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## **Trademark/Service Mark Application, Principal Register**

**Serial Number: 78835089**

**Filing Date: 03/12/2006**

### **To the Commissioner for Trademarks:**

**MARK:** ROYAL BERKSHIRE POLO CLUB (stylized and/or with design, see mark)

The literal element of the mark consists of ROYAL BERKSHIRE POLO CLUB.

The applicant, Royal County of Berkshire Polo Club Ltd., a corporation of United Kingdom, residing at North Street, Winkfield, Windsor, Berkshire, United Kingdom, SL4 4TH, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

**Intent to Use:** The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

International Class 009: Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefor.

**Based on Foreign Registration:** Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of European Community registration number 22186, registered 12/18/2000 with a renewal date of 04/01/2006 and an expiration date of 04/01/2006, and translation thereof, if appropriate. 15 U. S.C. Section 1126(e), as amended.

International Class 009: Spectacles, spectacle cases, spectacle frames, spectacle glasses, sun glasses; and accessories therefor.

The applicant hereby appoints A. Tally Eitan and Vladimir Sherman of Eitan Law Group, Eitan Mehulal Pappo Kugler, c/o Edna Eisemann, 18106 Kitchen House Court, Germantown, Maryland, United States, 20874 to submit this application on behalf of the applicant. The attorney docket/reference number is T-8252-09-US.

The applicant hereby appoints A. Tally Eitan of Eitan Law Group, Eitan Mehulal Pappo Kugler, c/o Edna Eisemann, 18106 Kitchen House Court, Germantown, Maryland, USA 20874 as applicant's representative upon whom notice or process in the proceedings affecting the mark may be served.

The USPTO is authorized to communicate with the applicant or its representative at the following email address: trademarks@eitangroup.com.

A fee payment in the amount of \$325 will be submitted with the application, representing payment for 1 class(es).

## Declaration

The undersigned, being hereby warned that willful false statements and the like so made 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 the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; 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; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /te/ Date: 03/12/2006

Signatory's Name: A. Tally Eitan

Signatory's Position: Attorney for Applicant

### Mailing Address:

A. Tally Eitan  
c/o Edna Eisemann  
18106 Kitchen House Court  
Germantown, Maryland 20874

RAM Sale Number: 1059

RAM Accounting Date: 03/13/2006

Serial Number: 78835089

Internet Transmission Date: Sun Mar 12 03:54:10 EST 2006

TEAS Stamp: USPTO/BAS-21214310136-200603120354109650

12-78835089-20051c78d9184c717b78c6e6c6a4

b957bac-DA-1059-20060312035247411423



*Royal Berkshire*  
POLO CLUB

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Petition for Cancellation was served by First Class Mail, with sufficient postage prepaid, on this 31<sup>st</sup> day of July, 2012, upon Registrant's attorney of record:

A. Tally Eitan, Esq.  
c/o Edna Eisemann  
18106 Kitchen House Court  
Germantown, Maryland 20874

BY:   
Robert L. Epstein

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