

ESTTA Tracking number: **ESTTA486558**

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	a partnership, d.b.a. Ku de Ta, comprised of Guy Neale, Aki Kotzamichalis, Made Wiranatha, et al.		
Entity	Partnership	Citizenship	Australia
Composed Of:	a partnership, d.b.a. Ku de Ta, comprised of Guy Neale, Aki Kotzamichalis, Made Wiranatha, White Horses Trading Company Limited, Arthur Chondros, and White Horses Investments Limited		
Address	Jalan Laksamana No 9 Seminyak Bali, 80361 INDONESIA		

Attorney information	David S. Elkins Squire Sanders (US) LLP 600 Hansen Way Palo Alto, CA 94304 UNITED STATES David.Elkins@squiresanders.com, joseph.grasser@squiresanders.com,trademark@squiresanders.com Phone:(650) 856-6500
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Registration Subject to Cancellation

Registration No	4120131	Registration date	04/03/2012
International Registration No.	NONE	International Registration Date	NONE
Registrant	Nine Squares Pty Ltd 39 Milton Street Elwood VIC 3184 AUSTRALIA		

Goods/Services Subject to Cancellation

Class 009. All goods and services in the class are cancelled, namely: Music recordings; prerecorded audio cassettes, audio tapes, and compact discs featuring music; Prerecorded video cassettes and DVDs featuring music; downloadable audio files featuring music; digital music downloadable from the Internet; downloadable MP3 files and MP3 recordings featuring music provided via MP3 websites on the Internet
Class 043. All goods and services in the class are cancelled, namely: Restaurants; providing of food and drink; providing temporary accommodation; hotels

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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Other	Registrant is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark
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Attachments	KU_DE_TA_Petition_to_Cancel.pdf (10 pages)(35291 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	/David S. Elkins/
Name	David S. Elkins
Date	07/31/2012

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

In the Matter of Trademark Registration No. 4,120,131

Mark: **KU DE TA**

Registered on April 3, 2012

A partnership, d.b.a. Ku de Ta, comprised of:

Guy Neale,
Aki Kotzamichalis,
Made Wiranatha,
White Horses Trading Company Limited,
Arthur Chondros, and
White Horses Investments Limited,

Petitioner,

v.

Nine Squares Pty Ltd.,

Registrant.

Cancellation No. _____

PETITION TO CANCEL

David S. Elkins
David.Elkins@squiresanders.com
Joseph P. Grasser
Joseph.Grasser@squiresanders.com
SQUIRE SANDERS (US) LLP
600 Hansen Way
Palo Alto, California 94304
Telephone: (650) 856-6500
Facsimile: (650) 843-8777

Attorneys for Petitioner

In the matter of U.S. Trademark Reg. No. 4,120,131 for the mark **KU DE TA** (the “Mark”), as currently registered by Nine Squares Pty Ltd., a company organized under the laws of Australia, with a business address of 39 Milton Street, Elwood, VIC 3184 Australia (“Respondent”), the partnership, d.b.a. Ku de Ta, comprised of Guy Neale, Aki Kotzamichalis, Made Wiranatha, White Horses Trading Company Limited, Arthur Chondros, and White Horses Investments Limited (collectively, the “Partnership”), organized under the laws of Victoria, Australia, with a business address of Jalan Laksamana No 9 Seminyak, Bali, Indonesia 80361 (“Petitioner”), believes that it is, and will continue to be, damaged by the registration of the Mark, and hereby petitions for cancellation of the Mark in whole.

As grounds for the cancellation, Petitioner avers as follows:

1. Respondent is the owner of the **KU DE TA** mark for “Music recordings; prerecorded audio cassettes, audio tapes, and compact discs featuring music; Prerecorded video cassettes and DVDs featuring music; downloadable audio files featuring music; digital music downloadable from the Internet; downloadable MP3 files and MP3 recordings featuring music provided via MP3 websites on the Internet” in International Class 009, and for “Restaurants; providing of food and drink; providing temporary accommodation; hotels” in International Class 043.

2. Petitioner is informed and believes and on that basis alleges that Respondent does not, and has not at any time, used the Mark in commerce. Petitioner is informed and believes and on that basis alleges that the Mark is a phonetic variant of the French phrase, “coup d’état,” and a literal variant of the Indonesian work “kudeta,” both of which translate into English to mean “uprising” or “revolution.”

3. Petitioner has significant interest in and to the term **KU DE TA**, and variations thereof, as a trademark. Petitioner is the owner of a U.S. trademark application for **KU DE TA** (U.S. Serial No. 85/677,000) for “Music recordings; prerecorded audio cassettes, audio tapes, and compact discs featuring music; Prerecorded video cassettes and DVDs featuring music; downloadable audio files featuring music; digital music downloadable from the Internet;

downloadable MP3 files and MP3 recordings featuring music provided via MP3 websites on the Internet” in International Class 09, and for “Restaurants; providing of food and drink; providing temporary accommodation; hotels” in International Class 43 (the “Application”). Petitioner’s **KU DE TA** mark has the same meaning and translation as the Mark.

4. Petitioner has a bona fide intent to use the **KU DE TA** mark for related goods and services but reasonably expects that registration of its Application will be refused over Respondent’s Mark. *See* TBMP §303.03(b). Petitioner is informed and believes and on that basis alleges that Respondent does not use or intend to use the Mark in the United States, and that it obtained its registration for the purpose of blocking Petitioner’s expansion into the United States. *See Person’s v. Christman*, 900 F.2d 1565, 1570 (Fed. Cir. 1990) (*citing Davidoff Extension, S.A. v. Davidoff Int’l.*, 221 U.S.P.Q. 465 (S.D.Fla. 1983)). Petitioner therefore has a real interest in this proceeding and a reasonable basis for its belief that it would suffer damage if the Mark remains in force.

COUNT I — APPLICATION BASED ON INCORRECT OWNERSHIP — § 1(a)

5. Petitioner incorporates by reference paragraphs 1-4 above as if set forth here.

6. The founding partners for the Partnership are Messrs. Neale, Kotzamichalis, Wiranatha and Chondros (collectively the “Founding Partners”), who together established the Partnership in or around January 2000. The agreed business purpose of the Partnership was to establish and operate a restaurant and nightclub under the business name “Ku de Ta” (the “Establishment”).

7. From the Partnership’s inception, the Founding Partners understood and agreed that both the Establishment and all business assets related to the Establishment (including the name and mark **KU DE TA**) would be collectively owned by the Partnership, and that no individual partner would singly own or have rights in the property of the Partnership. The Founding Partners memorialized this understanding in a partnership agreement executed in or around February 2000 (“Partnership Agreement”).

8. In or around April 2009, the Founding Partners executed a new partnership agreement backdated to January 10, 2000 (“Revised Partnership Agreement”). By way of a Deed of Assignment dated April 7, 2009, Mr. Chondros assigned to White Horses Trading Company Limited percentages of his equity in the Partnership. By way of another Deed of Assignment dated August 20, 2010, Mr. Chondros assigned to White Horses Investments Limited percentages of his equity in the Partnership. The Revised Partnership Agreement again memorialized the Partnership’s understanding that the Establishment and all business assets related to the establishment (including the name and mark **KU DE TA**) would be collectively owned by the Partnership, and that no individual partner would singly own or have rights in the property of the Partnership.

9. In or around June 1999, the Partnership successfully secured an empty plot of beachfront property in Bali, Indonesia for the Establishment. Construction of the Establishment and hiring of staff and other employees for the Establishment commenced shortly afterward. The Establishment opened for business in or around December 2000 as **KU DE TA**, the name and mark under which it has since operated. Since the Establishment’s inception, the Partnership has been responsible for its ownership, operation, and management.

10. The Establishment has thrived since its opening. It has become internationally renowned as a premier vacation destination, known and receiving notoriety in at least Singapore, Indonesia, New Zealand, France, Belgium, the United Kingdom, the United States, Hong Kong, Brazil, Malaysia, Japan, Italy, China, Canada, and the United Arab Emirates. The name “Ku de Ta” has gained recognition internationally as referring exclusively to the Partnership, the goodwill created and fostered by the Establishment, the services that the Partnership provides, and the events that it hosts. Because of the Establishment’s success, the Partnership anticipates opening similar establishments in other locations, including within the United States.

11. On or around January 9, 2003, Mr. Chondros incorporated Nine Squares Pty Ltd. (“Nines Squares”) in Australia. Petitioner is informed and believes and on that basis alleges that at all material times Mr. Chondros was a shareholder in and a leading director of Nine Squares.

Petitioner is informed and believes that Mr. Chondros employed Nine Squares to help him in carrying out his duties in the day-to-day management of the Establishment. Petitioner has come to be informed and believe and on that basis alleges that on or around October 17, 2002, Mr. Chondros and his colleague, Daniel Ellaway, applied to register the **KU DE TA** mark in Australia for “[r]estaurants; provision of food and drink; temporary accommodation; hotels” in International Class 043, which issued on June 19, 2003 (AUS Reg. No. 931112). Petitioner further alleges on information and belief that on or around January 29, 2004, Mr. Chondros and Mr. Ellaway assigned the Australian **KU DE TA** mark to Nine Squares (recorded with the Australian Trademark Office on February 11, 2004), which remains the registered owner of the mark in that country.

12. Petitioner is informed and believes and on that basis alleges that, on or around February 16, 2004, Nine Squares, under the direction of Mr. Chondros, applied for a United States trademark under the Madrid Protocol for **KU DE TA**, using the Australian **KU DE TA** mark as the basis for its §66(a) application (U.S. Serial No. 79/001,426), which issued on September 27, 2005 (U.S. Reg. No. 3,002,059). The registration is now subject to automatic cancellation by the United States Patent and Trademark Office due to Nine Squares’ failure to file the required Section 71 Affidavit of Use or Excusable Non-use, the grace period deadline for which expired on March 27, 2012.

13. In addition, Petitioner is informed and believes and on that basis alleges that, on March 24, 2011, Nine Squares, under the direction of Mr. Chondros, again applied for a United States trademark under the Madrid Protocol for **KU DE TA**, using the Australian **KU DE TA** mark as the basis for its §66(a) application (U.S. Serial No. 79/096,199), which issued on April 3, 2012 (U.S. Reg. No. 4,120,131, or “the ‘131 Reg.’”). This registration is the subject of the present petition to cancel.

14. Petitioner is informed and believes and on that basis alleges that Respondent has made never made any use of the Mark—including Respondent’s first **KU DE TA** registration (U.S.

Reg. No. 3,002,059, “the ‘059 Reg.”)—in commerce, and that Respondent’s United States registrations were made solely to block Petitioner’s expansion into the United States.

15. Petitioner is and at all relevant times was the Mark’s owner. Mr. Chondros was at all relevant times a partner in the Partnership. As a partner he knew and agreed that the Partnership collectively owned the Establishment and all of its business assets, including the Mark. The Partnership was never consulted about nor ever consented to filing for a United States trademark for the Partnership’s **KU DE TA** mark, whether by Mr. Chondros himself or through Nine Squares. Contrary to Respondent’s United States application for what became the ‘131 Reg., neither Mr. Chondros nor Nine Squares has ever owned the Mark at issue.

16. The ‘131 Reg. for **KU DE TA** is void *ab initio* because Respondent was not the owner of the Mark at the time the application was filed. *See* 15 U.S.C. §1051(a); TMEP §1201.02(b); *see also Chien Ming Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458 (Fed. Cir. 1988). Rather, Petitioner owned the Mark at the time of the application and needed to be included and classified as such. *See* TMEP §803.02(b).

17. Petitioner has been damaged and will continue to be damaged by the continued registration of the ‘131 Reg. In particular, the ‘131 Reg.’s existence will block Petitioner’s application to register its **KU DE TA** mark in the United States, and precludes Petitioner’s use of the mark without reasonable apprehension regarding litigation.

18. By virtue of the foregoing, if Respondent’s ‘131 Reg. remains on the Principal Register, with all the presumptions conferred by its status as a Principal registration, Petitioner will continue to suffer substantial and irreparable harm to its business and to the goodwill of the **KU DE TA** mark. Moreover, Respondent will unlawfully enjoy benefits and advantages to which it is not entitled under the Trademark Act of 1946.

COUNT II — FRAUDULENT APPLICATION FOR REGISTRATION

19. Petitioner incorporates by reference paragraphs 1-18 above as if set forth here.

20. Respondent's '131 Reg. should be canceled because respondent committed fraud on the U.S. Patent and Trademark Office ("Office") in connection with its application for registration of the Mark.

21. As set forth above, the Founding Partners—including Mr. Chondros—agreed that both the Establishment and all business assets related to the Establishment (including the name and mark **KU DE TA**) would be collectively owned by the Partnership. The Founding Partners, again including Mr. Chondros, agreed that no individual partner would singly own or have rights in physical or intangible Partnership property. Mr. Chondros and the other Founding Partners memorialized these and their other agreements in the February 2000 Partnership Agreement. The Revised Partnership Agreement again memorialized the partners' agreement that the Establishment and all of its related business assets (including the **KU DE TA** name and mark) are collectively owned by the Partnership, and that no individual partner singly owns or has rights in the property of the Partnership.

22. As also alleged above, Mr. Chondros is the founder, a leading director of and a shareholder in Respondent Nine Squares. His knowledge is thus imputed to Respondent. As one of Petitioner's Founding Partners, Mr. Chondros knows and knew at all relevant times that (a) the **KU DE TA** mark is collectively owned by the Partnership, (b) no individual partner owns or has rights to the **KU DE TA** mark, (c) the Partnership never authorized Mr. Chondros, either on his own or through Respondent, to seek registration of the mark in the United States. Petitioner is informed and believes and therefore alleges that at the time Respondent filed its application for the '131 Reg. on March 24, 2011, Respondent did not have a good faith belief that no other person, firm, corporation, or association had the right to use the **KU DE TA** mark in commerce, when used in connection with the goods and services cited above, and, therefore, knowingly made a false, material representation with the intent to deceive the Office.

23. In addition, Respondent has never used the **KU DE TA** mark in United States commerce since the time that it filed the application for the '052 Reg. over eight years ago on April 8, 2004. Petitioner is informed and believes and therefore alleges that at the time Respondent filed its application for the '131 Reg. on March 24, 2011, Respondent did not have a good faith intent to use the **KU DE TA** mark in commerce and, therefore, knowingly made a false, material representation with the intent to deceive the Office.

24. Petitioner is informed and believes that had Respondent disclosed the true facts alleged above in its March 24, 2011 application for registration, the Office would have refused to issue the '131 Reg.

25. By virtue of the foregoing, if Respondent's '131 Reg. remains on the Principal Register, with all the presumptions conferred by its status as a Principal registration, Petitioner will continue to suffer substantial and irreparable harm to its business and to the goodwill of the **KU DE TA** mark. Moreover, Respondent will unlawfully enjoy benefits and advantages to which it is not entitled under the Trademark Act of 1946.

PRAYER FOR RELIEF

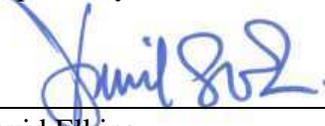
WHEREFORE, Petitioner requests that Registration No. 4,120,131 be cancelled and stricken from the Register, and that this Petition be sustained in favor of Petitioner.

Petitioner appoints the following as attorneys for Petitioner in this proceeding, as to whom all matters in this proceeding should be addressed:

David S. Elkins and Joseph P. Grasser, members of the State Bar of California and the firm of Squire Sanders (US) LLP, 600 Hansen Way, Palo Alto, California, 94304, telephone (650) 856-6500, facsimile (650) 843-8777.

The U.S. Patent and Trademark Office and the Trademark Trial and Appeal Board hereby are authorized to charge to Squire Sanders (US) LLP's Deposit Account No. 07-1850 the required filing fees plus any deficiencies or additional amounts due for this Petition to Cancel.

Respectfully submitted,

A handwritten signature in blue ink, appearing to read "David Elkins", is written over a horizontal line.

Date: July 31, 2012

David Elkins
Joseph P. Grasser
SQUIRE SANDERS (US) LLP
600 Hansen Way
Palo Alto, California 94304
Telephone: (650) 856-6500
Facsimile: (650) 843-8777

Attorneys for Petitioner
PARTNERSHIP, D.B.A. KU DE TA, COMPRISED OF GUY
NEALE, AKI KOTZAMICHALIS, MADE WIRANATHA,
WHITE HORSES TRADING COMPANY LIMITED,
ARTHUR CHONDROS, AND WHITE HORSES
INVESTMENTS LIMITED

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **Petition to Cancel** has been served on the Domestic Representative for the owner of record for the registration at the address of record in the U.S. Patent and Trademark Office by mailing said copy via First Class Mail, postage prepaid to:

STITES & HARBISON PLLC
1199 North Fairfax Street, Suite 900
Alexandria, Virginia 22314-1437
United States of America

this 31st day of July, 2012.

By:



David Elkins