

ESTTA Tracking number: **ESTTA491172**

Filing date: **08/27/2012**

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	Pendery's, Inc.		
Entity	Corporation	Citizenship	Texas
Address	1221 Manufacturing St. Dallas, TX 75207 UNITED STATES		

Attorney information	Deborah L. Lively Thompson & Knight LLP 1722 Routh Street, Suite 1500 Dallas, TX 75201 UNITED STATES deborah.lively@tklaw.com Phone:214-969-1700		
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Registration Subject to Cancellation

Registration No	3285051	Registration date	08/28/2007
Registrant	Penzeys, Ltd. 19300 West Janacek Court Brookfield, WI 53045 UNITED STATES		

Goods/Services Subject to Cancellation

Class 030. First Use: 1992/03/31 First Use In Commerce: 1992/03/31 All goods and services in the class are cancelled, namely: SPICES, SPICE BLENDS, SEASONINGS, PROCESSED HERBS, EXTRACTS USED FOR FLAVORING
Class 041. First Use: 2003/12/31 First Use In Commerce: 2004/10/31 All goods and services in the class are cancelled, namely: PUBLICATION OF MAGAZINES

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85580093	Application Date	03/26/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PENDERY'S		

Design Mark	<h1>PENDERY'S</h1>		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1895/01/01 First Use In Commerce: 1895/01/01 Chili powders; Chili seasoning; Dry spice rub for meats and fish; Edible spices; Hot sauce; Relish; Seasoning mixes; Spice blends; Spice rubs; Spices		

U.S. Application No.	85580100	Application Date	03/26/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PENDERY'S		
Design Mark			
Description of Mark	The mark consists of the word "PENDERY'S" in stylized font and formed in a semicircle arc.		
Goods/Services	Class 030. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 Chili powders; Chili seasoning; Dry spice rub for meats and fish; Edible spices; Hot sauce; Relish; Spice blends; Spice rubs; Spices		

U.S. Application No.	85621031	Application Date	05/09/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PENDERY'S		
Design Mark			
Description of Mark	The mark consists of the word "PENDERY'S" in stylized font above a top hat having a hole in the left side and which rests on interlaced branches of leaves		

	and chili peppers and berries which are tied together with a ribbon.
Goods/Services	Class 030. First use: First Use: 1993/00/00 First Use In Commerce: 1993/00/00 hot sauce; relish; sauces; spice blends; spice rubs; spices

Attachments	85580093#TMSN.jpeg (1 page)(bytes) 85580100#TMSN.jpeg (1 page)(bytes) 85621031#TMSN.jpeg (1 page)(bytes) Pet for Canc.pdf (6 pages)(1544760 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	/deborah l. lively/
Name	Deborah L. Lively
Date	08/27/2012

and fish, spices, hot sauce, relish, seasoning mixes, spice blends, spice rubs, and the like since at least as early as 1895.

2. Petitioner owns the pending trademark application for PENDERY'S (Serial No. 85/580093), which was filed with the U.S. Patent and Trademark Office on March 26, 2012, and which covers chili powders; chili seasoning; dry spice rub for meats and fish; edible spices; hot sauce; relish; seasoning mixes; spice blends; spice rubs; spices in International Class 30 and has a date of first use at least as early as January 1, 1895.

3. Petitioner owns the pending trademark application for the stylized mark PENDERY'S (Serial No. 85/580100), which was filed with the U.S. Patent and Trademark Office on March 26, 2012, and which covers chili powders; chili seasoning; dry spice rub for meats and fish; edible spices; hot sauce; relish; spice blends; spice rubs; spices in International Class 30 and has a date of first use at least as early as 1988.

4. Petitioner owns the pending trademark application for the mark PENDERY'S & Design (Serial No. 85/621031), which was filed with the U.S. Patent and Trademark Office on May 9, 2012, and which covers hot sauce; relish; sauces; spice blends; spice rubs; spices in International Class 30 and has a date of first use at least as early as 1993.

5. The marks identified in paragraphs 1, 2, 3 and 4 above are collectively the "PENDERY'S Mark's."

6. The PENDERY'S Marks have been used extensively throughout the United States and have been in use continuously since their respective first dates of use. Products have been, and continue to be sold, nationwide under the PENDERY'S Marks by mail-order catalog services, retail store services, and online retail ordering services.

7. The application for Registrant's PENZEYS mark ("Registrant's Mark" or the "PENZEYS Mark" or "PENZEYS"), which was filed on November 17, 2006 and for which the Registration issued on August 28, 2007, covers "spices, spice blends, seasonings, processed herbs, extracts used for flavoring" in class 30 and "publication of magazines" in class 41.

8. Registrant claims a first date of use of the PENZEYS Mark for the class 30 goods as March 31, 1992 and a first date of use for the class 41 services as December 31, 2003.

9. There is no issue of priority with respect to two of the PENDERY'S Marks. Petitioner's dates of first use of the PENDERY'S word mark (U.S. Ser. No. 85/580093) and PENDERY'S stylized mark (U.S. Ser. No. 85/580100) are prior to Registrant's date of first use, March 31, 1992, and prior to Registrant's filing date, November 17, 2006, as claimed in the Registration for the PENZEYS Mark.

10. Through its extensive and continuous use of the PENDERY'S Marks, Petitioner has acquired a substantial and valuable interest and goodwill in the marks and said marks have come to signify goods and services originating with Petitioner. Specifically, Petitioner's PENDERY'S Marks are now famous marks within the meaning of 15 U.S.C. § 1125(c).

11. Petitioner's PENDERY'S word mark (U.S. Ser. No. 85/580093) and PENDERY'S stylized mark (U.S. Ser. No. 85/580100) (collectively "Petitioner's Famous Marks") were famous prior to the dates of first use and the filing date for the PENZEYS Mark.

12. The PENZEYS Mark and the PENDERY'S Marks both begin with the same three letters "PEN" and end with the same two letters "YS." In addition to such visual similarities, the pronunciation of the first and last syllables of the marks sounds the same. Furthermore, the PENZEYS Mark and the PENDERY'S Marks cover spices and food seasonings and other similar goods in class 30, and both Registrant and Petitioner sell their products through retail, catalog and online sales. Accordingly, the PENZEYS Mark so nearly resembles the PENDERY'S Marks that it is likely to cause confusion in the minds of consumers, to cause mistake or to deceive, or otherwise injure, diminish or detract from the prior rights firmly established by Petitioner in and to the PENDERY'S Marks.

13. Registrant's Mark, by reason of its similarity to the PENDERY'S Marks will be able to gain a subliminal or subconscious association to the PENDERY'S Marks and thereby trade on the reputation of Petitioner and the PENDERY'S Marks.

14. Upon information and belief, Registrant's Mark has caused actual consumer confusion in the trade.

15. Registrant's Mark causes dilution of Petitioner's Famous Marks under 15 U.S.C. § 1125(c). Registrant's Mark so resembles Petitioner's Famous Marks as to diminish the distinctiveness of said famous marks, thereby damaging and injuring Petitioner.

16. If Registrant is permitted to maintain the registration for the PENZEYS Mark, there will be confusion in the trade resulting in damage and injury to Petitioner because of the similarity between the parties' respective marks, goods and services. Those familiar with the PENDERY'S Marks are likely to purchase Registrant's goods

with the mistaken belief that they are goods offered for sale by Petitioner. Any such confusion in the trade would inevitably result in loss of business to Petitioner. Furthermore, any defect, objection, or fault found with Registrant's products marketed under the PENZEYS Mark would necessarily reflect upon and seriously injure the reputation for excellence that Petitioner has established goods provided under its PENDERY'S Marks.

17. If Registrant is permitted to maintain its registration for PENZEYS, it will thereby have at least a *prima facie* exclusive right to the use of the mark. Such a registration would damage and injure Petitioner.

WHEREFORE, it is respectfully requested that this petition be sustained and that Registration No. 3,285,051 be cancelled.

Dated: August 27, 2012

Respectfully submitted,



Deborah L. Lively
Herbert J. Hammond

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ATTORNEYS FOR PETITIONER
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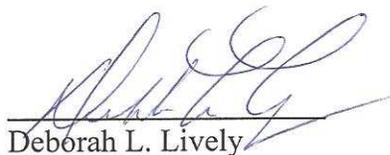
CERTIFICATE OF SERVICE

I hereby certify that this Petition for Cancellation is being served on Registrant via Certified Mail, postage prepaid, on this 27th day of August 2012, at the following address:

Penzeys, Ltd.
19300 West Janacek Court
Brookfield, Wisconsin 53045

A courtesy copy is also being served on Registrant's attorney of record, Cobby J. Shereff, via Certified Mail, postage prepaid, on this 27th day of August 2012, at the following address:

Cobby J. Shereff
Blumenfield & Shereff, LLP
1001 W. Glen Oaks Ln., Suite 110
Mequon, Wisconsin 53092-3366


Deborah L. Lively