

ESTTA Tracking number: **ESTTA497858**

Filing date: **10/02/2012**

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	Toddland, Inc.		
Entity	Corporation	Citizenship	California
Address	2929 Newport Blvd. Newport Beach, CA 92663 UNITED STATES		

Attorney information	William J. Seiter Seiter Legal Studio 220 26th Street, Suite 202 Santa Monica, CA 90402 UNITED STATES williamjseiter@seiterlegalstudio.com Phone:(310) 395-6100		
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Registration Subject to Cancellation

Registration No	3991181	Registration date	07/05/2011
Registrant	Scarlet Row, LLC 3822 SW Coquina Cove Way #106 Palm City, FL 34990 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2010/09/30 First Use In Commerce: 2010/10/30 All goods and services in the class are cancelled, namely: T-shirts

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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. Application No.	85589496	Application Date	04/04/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	IT'S NICE TO BE NICE		

Design Mark	IT'S NICE TO BE NICE
Description of Mark	NONE
Goods/Services	Class 025. First use: Clothing, namely, t-shirts, shirts, tank tops, sweat shirts, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, caps, headbands, visors and bandanas; footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes

Attachments	85589496#TMSN.jpeg (1 page)(bytes) Petition to Cancel (US TM Reg No. 3991181).pdf (7 pages)(124059 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	/wjs/
Name	William J. Seiter
Date	10/02/2012

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

In the Matter of Trademark
Registration No.: 3991181
For the mark: IT'S JUST NICE TO BE NICE
Date registered: July 5, 2011

Toddland, Inc.,)
A California Corporation)
)
Petitioner,)
)
v.) Cancellation No. _____
)
Scarlet Row, LLC,)
A Florida Limited Liability Company)
)
Registrant.)

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PETITION TO CANCEL

Petitioner:

Toddland, Inc.

2929 Newport Blvd.

Newport Beach, CALIFORNIA 92663

UNITED STATES

To the best of petitioner's knowledge, the name and address of the current owner of the registration is:

Scarlet Row, LLC,

3822 SW Coquina Cove Way #106

Palm City, FLORIDA 34990

UNITED STATES

Petitioner believes that it will be damaged by the registration, and hereby petitions to cancel the same as to all goods listed in the registration.

The grounds for the cancellation are as follows:

1. With a filing date of April 4, 2012, Petitioner filed U.S. Trademark Application Serial No. 85589496 for the mark “IT'S NICE TO BE NICE” in International Class 25 for “*Clothing, namely, t-shirts, shirts, tank tops, sweat shirts, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, caps, headbands, visors and bandanas; footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes*” based on intent-to-use in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. Section 1051(a).

2. Previous thereto, on August 5, 2010, Registrant filed Application Serial No. 85100829 for the mark “It's Just Nice To Be Nice” in International Class 25 for “*T-shirts*” based on intent-to-use in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. Section 1051(a).

3. On March 16, 2011, Registrant filed a Statement of Use submitting a specimen showing a “T-shirt with the logo” and declaring that the mark was first used at least as early as September 30, 2010, and first used in United States commerce at least as early as October 30, 2010. On April 13, 2011, the Trademark Examining Attorney issued an office action refusing registration of the applied-for mark on the basis that the applied-for mark, as shown on the specimen, is merely ornamental because the mark is displayed on the goods, namely t-shirts, as a decoration rather than as an indicator of source.

4. On May 11, 2011, the Registrant filed a response to the Office Action, together with a substitute specimen of use showing the mark as depicted on a t-shirt label. Said application registered for the aforementioned goods under U.S. Trademark Registration No. 3991181 on July 5, 2011.

5. Upon information and belief, Petitioner alleges that Registrant had made no bona fide use of the aforementioned mark in U.S. commerce on or in connection with the Class 25 goods applied for under Application Serial No. 85100829 on or before September 30, 2010, Registrant's claimed date of first use and October 30, 2010, the date of first use in U.S. commerce.

6. Upon information and belief, Petitioner alleges that Registrant has made no bona fide use of the aforementioned mark in U.S. commerce at any time on or in connection with the Class 25 goods applied for under Application Serial No. 85100829 on or before April 4, 2012, Petitioner's filing date.

7. Upon information and belief, Petitioner alleges that Registrant had made no bona fide use of the mark in U.S. Registration No. 3991181 in U.S. commerce at any time on or in connection with the goods registered in International Class 25.

8. Upon information and belief, Petitioner alleges that Registrant's declaration made in its response of May 11, 2011 to office action regarding Application Serial No. 85100829 that the mark was in use in U.S. commerce on or in connection with the applied for goods on or before September 30, 2010, Registrant's claimed date of first use and October 30, 2010, the date of first use in U.S. commerce, constituted a false, material misrepresentation of fact, which Registrant knew to be false. Accordingly, U.S. Trademark Registration No. 3991181 was obtained through fraud.

9. Upon information and belief, Petitioner alleges that the Registrant has not and/or is not using the mark as an indicator of source but rather the registered mark, as shown on the specimen submitted by the Registrant on March 16, 2011, is merely ornamental because the mark is displayed on the goods, namely t-shirts, as a decoration.

10. Petitioner alleges that the substitute specimen filed by Registrant on May 11, 2011 in response to the Office Action issued April 13, 2011, a supposed specimen of a t-shirt label is not a good faith specimen but merely a stick-on label with the words “It’s Just Nice to be Nice”. Upon information and belief, Petitioner alleges that Registrant was not and is not using the mark in U.S. commerce in the manner depicted in the submitted substitute specimen and that such specimen was filed is bad faith.

11. Accordingly, Registrant has abandoned use of the mark in Registration No. 3991181, without a bona fide intent to resume use, and the registration should be cancelled in accordance with Trademark Act Section 14(3), 15 U.S.C. §1064(3).

12. The mark that Registrant has registered is almost identical in appearance, sound and commercial impression to Petitioner’s mark, and could be used in connection with goods identical to and/or closely related to the goods offered by Petitioner and in connection with which Petitioner uses its mark. Based on the similarity of the two marks and the sameness, similarity and relatedness of the parties’ respective goods, the public is likely to associate the goods of Registrant under the mark “It’s Just Nice to be Nice” with Petitioner or with Petitioner’s goods, or to believe that Registrant’s goods are sponsored, endorsed or licensed by Petitioner, or that there exists some relationship between Registrant and Petitioner.

13. For the above reasons, any use of the mark “It’s Just Nice to be Nice” by Registrant for goods in International Class 25 is likely to cause confusion, cause mistake or

deceive the public, and cause the public to believe that the services offered under the mark by Registrant emanate from or are otherwise sponsored or endorsed by Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Petitioner will be irreparably harmed and financially damaged by the registration of Registrant's mark because Registrant's mark has been cited against Petitioner's pending Application Serial No. 85589496 as grounds for refusal in an Office Action issued July 18, 2012. Therefore, Registrant's mark should be cancelled.

Request For Relief

15. Petitioner is the owner of U.S. Trademark Application Serial No. 85589496, for its trademark "IT'S NICE TO BE NICE" in International Class 25 for "*Clothing, namely, t-shirts, shirts, tank tops, sweat shirts, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, caps, headbands, visors and bandanas; footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes*", and is using such mark in U.S. commerce.

16. Petitioner will be irreparably harmed and financially damaged by Registrant's Trademark Registration No. 3991181, because Registrant's mark has been cited against Petitioner's pending Application Serial No. 85589496, as a ground for refusal, under an Office Action dated July 18, 2012.

17. Therefore, the registration should be cancelled as to all goods listed therein.

18. For the foregoing reasons, Petitioner requests cancellation of Trademark Registration No. 3991181.

DATED: October 2, 2012

Respectfully submitted,
SEITER LEGAL STUDIO

By: /s/ William J. Seiter
William J. Seiter
Attorneys for Petitioner
220 26th Street, Suite 202
Santa Monica, CA 90402
Phone: (310) 395-6100

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Applicant's Petition to Cancel has been forwarded via First Class Mail, postage prepaid, to Registrant to its addresses of record, as follows:

Scarlet Row, LLC,
3822 SW Coquina Cove Way #106
Palm City, FLORIDA 34990
UNITED STATES

on this 2nd day of October, 2012.

/s/
William J. Seiter