

ESTTA Tracking number: **ESTTA501875**

Filing date: **10/24/2012**

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	Milano Series International Products, Ltd.		
Entity	Corporation	Citizenship	New York
Address	453 North MacQuesten Parkway Mount Vernon, NY 10552 UNITED STATES		

Attorney information	Roberta S. Bren Oblon, Spivak, McClelland, Maier & Neustadt, LLP 1940 Duke Street Alexandria, VA 22314 UNITED STATES tmdocket@oblon.com, rbren@oblon.com, ndyson@oblon.com Phone:703-413-3000
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Registration Subject to Cancellation

Registration No	4215599	Registration date	09/25/2012
Registrant	Milano Bags Inc. 12901 SW 197 St Miami, FL 33177 UNITED STATES		

Goods/Services Subject to Cancellation

Class 018. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: Leather bags and wallets; Leather briefcases; Leather credit card wallets; Leather handbags; Leather pouches; Leather purses; Wallets made of leather or other materials
Class 025. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: Belts made of leather; Leather belts; Leather boots; Leather jackets; Leather shoes

Grounds for Cancellation

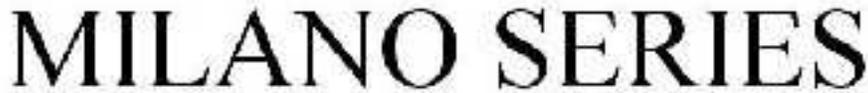
Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1900675	Application Date	05/27/1994
Registration Date	06/20/1995	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 020. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 picture frames Class 021. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 candlesticks not of precious metal

U.S. Registration No.	1478357	Application Date	09/19/1986
Registration Date	03/01/1988	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 PORTABLE CALCULATORS Class 018. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 LUGGAGE AND DUFFEL BAGS Class 020. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 [OUTDOOR FURNITURE, CUSHIONS AND REPLACEMENT CANVASSES FOR OUTDOOR FURNITURE]		

U.S. Registration No.	4120784	Application Date	04/19/2011
Registration Date	04/03/2012	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/00/00 First Use In Commerce: 2005/00/00 Laptop bags Class 014. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Jewelry boxes and jewelry cases Class 016. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 Lunch bags, photo albums, photo storage boxes Class 018. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 Briefcases, all purpose carry bags, tote bags, umbrellas, diaper bags, cosmetic		

	cases sold empty, sport bags, duffle bags, luggage tags Class 020. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 Picture and photograph frames
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Attachments	85298884#TMSN.jpeg (1 page)(bytes) MILANO BAGS - PETITION.pdf (6 pages)(180061 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	/Roberta S. Bren/nmd/
Name	Roberta S. Bren
Date	10/24/2012

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

_____)	
MILANO SERIES INTERNATIONAL)	
PRODUCTS, LTD.,)	
)	
Opposer,)	
)	Cancellation No.: _____
v.)	Supplemental Registration No. 4,215,599
)	Mark: MILANO BAGS
MILANO BAGS INC.)	
)	
Applicant.)	
_____)	

The Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION

In the matter of the Registration of the mark MILANO BAGS, with “Bags” disclaimed, for leather bags and wallets; leather briefcases; leather credit card wallets; leather handbags; leather pouches; leather purses; wallets made of leather or other materials, in International Class 18 and belts made of leather; leather belts; leather boots; leather jackets; leather shoes in International Class 25, Supplemental Registration No. 4,215,599, filed July 22, 2011 and registered September 25, 2012.

Milano Series International Products, Ltd. (“Petitioner”) is a corporation organized and existing under the laws of the State of New York with a place of business at 453 North MacQuesten Parkway, Mount Vernon, NY 10552, and believes that it would be damaged by

registration of the mark shown in Registration No. 4,215,599, and hereby petitions to cancel same.

As grounds for cancellation, it is alleged that:

1. Since long prior to January 1, 2007, Petitioner has been, and Petitioner is now, engaged in the marketing, shipment and sale of various types of bags under the mark MILANO SERIES (“Petitioner’s Mark”).

2. Petitioner’s products sold under Petitioner’s Mark include tote and carry bags, briefcases, cosmetic cases and jewelry cases.

3. Petitioner is the owner of and will rely herein, upon the following Federal trademark registrations:

<u>MARK</u>	<u>REGISTRATION NO.</u>	<u>ISSUED</u>
MILANO SERIES	1,900,675	June 20, 1995
MILANO SERIES	1,478,357	March 1, 1988
MILANO SERIES	4,120,784	April 3, 2012

Said registrations of Petitioner are valid and subsisting. Commencing long prior to Milano Bags Inc.’s (“Respondent’s”) asserted date of first use, Petitioner, through its predecessor, has used, and Petitioner is now using, Petitioner’s Mark in connection with Petitioner’s goods distributed and sold by Petitioner in commerce.

4. Since the initial use of the MILANO SERIES mark, Petitioner and its predecessor have for many years advertised and promoted goods under the MILANO SERIES mark. Petitioner and its predecessor have used, advertised, promoted and offered Petitioner’s goods bearing Petitioner’s Mark to the relevant purchasing public in commerce, with the result that Petitioner’s customers and potential purchasers know and recognize Petitioner’s Mark and

associate same with Petitioner and/or goods sold by Petitioner. Petitioner has built goodwill in connection with the sales of products under Petitioner's Mark.

5. Petitioner will also rely herein on its common law rights in and to its MILANO SERIES trademark and trade name used on personal items not identified in the Federal trademark registrations.

6. Petitioner currently sells tote bags, carry all bags, laptop bags, wine bags, lunch bags, diaper bags, toiletry bags and messenger bags as well as reader and tablet sleeves under the mark MILANO SERIES.

7. Respondent has registered the mark MILANO BAGS on the Supplemental Register for leather bags and wallets; leather briefcases; leather credit card wallets; leather handbags; leather pouches; leather purses; wallets made of leather or other materials in International Class 18 and belts made of leather; leather belts; leather boots; leather jackets; leather shoes in International Class 25 (hereinafter "Respondent's goods").

8. The term "Bags" has been disclaimed in Respondent's mark MILANO BAGS in Class 18.

9. Upon information and belief, Respondent did not make any use in interstate commerce or commerce with the United States of its mark, MILANO BAGS on or in connection with Respondent's goods prior to January 1, 2007.

10. Upon information and belief, Respondent's goods, as identified in the registration, under the trademark MILANO BAGS, are or will be distributed in and through the same channels of commerce and/or sold and/or rendered to the same classes of purchasers of Petitioner's products under Petitioner's MILANO SERIES mark.

11. Respondent's mark MILANO BAGS is confusingly similar in sound, appearance, meaning and commercial impression to Petitioner's MILANO SERIES mark.

12. Petitioner believes and alleges that consumers are likely to believe that MILANO BAGS identifies goods which originate with Petitioner.

13. Respondent's use and registration of the mark MILANO BAGS will enable Respondent to trade upon and utilize the goodwill established by Petitioner in Petitioner's Mark.

14. Petitioner believes and alleges that Respondent's trademark when applied to Respondent's goods is likely to cause confusion or mistake or to deceive and will deceive and mislead the purchasing public into believing that Applicant is licensed or controlled by Petitioner or that Respondent is a subsidiary of or in some way related to Petitioner. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

15. Petitioner, upon information and belief, avers that it will be damaged by the registration by Respondent of the MILANO SERIES trademark, as set forth in Respondent's Supplemental Registration No. 4,215,599, in that the mark is confusingly similar to Petitioner's MILANO SERIES Mark and common law rights and will be used in connection with goods closely related to the goods offered by Petitioner.

WHEREFORE, this Petitioner, Milano Series International Products, Ltd., believes and avers that it is being and will continue to be damaged by registration of the MILANO BAGS trademark as aforesaid, and prays that said Supplemental Registration No. 4,215,599 be cancelled, and that this Cancellation be sustained in favor of Petitioner.

POWER OF ATTORNEY

The undersigned hereby appoints Roberta S. Bren, and the following attorneys of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., as its attorneys with full powers of substitution and revocation, to file and prosecute this opposition.

Norman F. Oblon
Marvin J. Spivak
Gregory J. Maier
Arthur I. Neustadt
Jeffrey H. Kaufman
Roberta S. Bren
Jonathan Hudis
Jordan S. Weinstein

Kathleen Cooney-Porter*
Beth A. Chapman*
Christopher I. Donahue
Kyoko Imai
David H. Aleskow*
Richard D. Kelly
James D. Hamilton
Eckhard H. Kuesters

Robert T. Pous
Charles L. Gholz
Jean-Paul Lavalleye
Stephen G. Baxter
Richard L. Treanor
Richard L. Chinn

Members of the Bar of Virginia (except as indicated)
*Member of the Bar other than Virginia

Please address all correspondence to **Roberta S. Bren** at OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, LLP, 1940 Duke Street, Alexandria, Virginia 22314.

The required filing fee in the amount of \$600.00 for this Petition to Cancel was paid online.

Respectfully submitted,

MILANO SERIES INTERNATIONAL
PRODUCTS, LTD.

By: Roberta S. Bren
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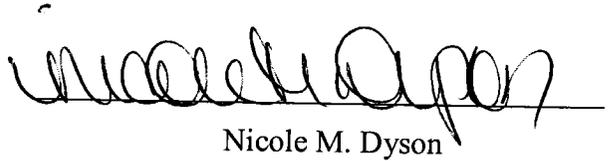
Date: October 24, 2012

RSB/nmd {7481386_1.DOC}

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITION TO CANCEL was served on counsel for Respondent, this 24th day of October, 2012, by sending same via First Class mail, postage prepaid, to:

MILANO BAGS INC.
12901 SW 197 St.
Miami, Florida 33177-4808



Nicole M. Dyson