

ESTTA Tracking number: **ESTTA533459**

Filing date: **04/20/2013**

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 parties request to cancel indicated registration.

Petitioner Information

Name	Rin, Inc.		
Entity	Corporation	Citizenship	California
Address	6374 Arizona Circle Los Angeles, CA 90045 UNITED STATES		

Name	Jeff Miller		
Entity	Individual	Citizenship	UNITED STATES
Address	6374 Arizona Circle Los Angeles, CA 90045 UNITED STATES		

Name	Max Kleven		
Entity	Individual	Citizenship	UNITED STATES
Address	33150 Barber Road Agua Dulce, CA 91390 UNITED STATES		

Attorney information	Kevin M. Welch The Law Office of Kevin M. Welch P.O. Box 494 Hermosa Beach, CA 90254 UNITED STATES kevin@kmwlawoffice.com Phone:(310) 929-0553		
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Registrations Subject to Cancellation

Registration No	3111161	Registration date	07/04/2006
Registrant	Hereford, Daphne Post Office Box 27 Crockett, TX 75835 UNITED STATES		

Goods/Services Subject to Cancellation

Class 016. First Use: 2001/04/06 First Use In Commerce: 2001/04/06 All goods and services in the class are cancelled, namely: Printed publications, namely, children's books

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		Trademark Act section 14	
Registration No	2969852	Registration date	07/19/2005
Registrant	Hereford, Daphne Post Office Box 27 Crockett, TX 75835 UNITED STATES		

Goods/Services Subject to Cancellation

Class 016. First Use: 2002/11/18 First Use In Commerce: 2002/11/23 All goods and services in the class are cancelled, namely: Printed publications, namely, magazines, pamphlets, books and comic books about German Shepard dogs; activity and coloring books, posters, stickers, business cards, and cards in the nature of greeting cards and trading cards
Class 028. First Use: 2002/11/18 First Use In Commerce: 2002/11/23 All goods and services in the class are cancelled, namely: Playing cards
Class 041. First Use: 2002/11/18 First Use In Commerce: 2002/11/23 All goods and services in the class are cancelled, namely: Entertainment services in the nature of an ongoing television series in the field of variety and motion pictures featuring a German Shepard dog as a live or animated character

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)		
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14		
Registration No	3582436	Registration date	03/03/2009
Registrant	Daphne Hereford P.O. Box 27 Crockett, TX 75835 UNITED STATES		

Goods/Services Subject to Cancellation

Class 031. First Use: 1980/12/17 First Use In Commerce: 1980/12/17 All goods and services in the class are cancelled, namely: live German Shepherd dogs of Rin Tin Tin lineage
Class 041. First Use: 1980/12/17 First Use In Commerce: 1980/12/17 All goods and services in the class are cancelled, namely: Animal exhibitions and live animal performances featuring a German Shepherd dog

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)		
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14		
Priority and likelihood of confusion	Trademark Act section 2(d)		

Dilution		Trademark Act section 43(c)	
Registration No	2538312	Registration date	02/12/2002
Registrant	Hereford, Daphne P.O. Box 27 Crockett, TX 75835 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 1980/12/17 First Use In Commerce: 1980/12/17
All goods and services in the class are cancelled, namely: mail order fan club service providing materials promoting the breeding, training, raising and showing of the authentic RIN TIN TIN German Shepherd dog lineage

Grounds for Cancellation

False suggestion of a connection		Trademark Act section 2(a)	
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		Trademark Act section 14	
Registration No	2384745	Registration date	09/12/2000
Registrant	RIN TIN TIN INC. P.O. Box 27 Crockett, TX 75835 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 1998/02/25 First Use In Commerce: 1998/05/08
All goods and services in the class are cancelled, namely: EDUCATION AND ENTERTAINMENT; NAMELY promotion of responsible dog ownership through programs presented to schools and groups

Grounds for Cancellation

False suggestion of a connection		Trademark Act section 2(a)	
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>		808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)	
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		Trademark Act section 14	
Registration No	1763135	Registration date	04/06/1993
Registrant	Hereford, Daphne P.O. BOX 27 CROCKETT, TX 75835 UNITED STATES		

Goods/Services Subject to Cancellation

Class 031. First Use: 1980/12/17 First Use In Commerce: 1980/12/17
All goods and services in the class are cancelled, namely: live German shepherd puppies

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14

Related Proceedings	Petition for Cancellation no.: 92056642; newly filed Petition for Cancellation Trdacking No.: ESTTA533450; and United States District Court Case No.: CV13-2783 ABC (AGRx)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	RIN TIN TIN- RIN TIN TIN is the name of the iconic fictional German Shepherd charcter that is featured in multiple movies and television shows owned by Petitioners.		
Goods/Services	Movie and televisionshows, and various items that feature the iconic ficitonal German Shepherd character featured in mulitple movies and television shows.		

Attachments	13.04.19 Final Complaint.pdf (8 pages)(374422 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 Personal Delivery on this date.

Signature	/Kevin M. Welch/
Name	Kevin M. Welch
Date	04/20/2013

PETITION TO CANCEL

Petitioner Jeff Miller is an individual with a mailing address of 6374 Arizona Circle, Los Angeles, California 90045, Petitioner Max Kleven is an individual and resident of the state of California and currently resides in Los Angeles county, California, and Petitioner Rin, Inc. is a corporation formed under the laws of the State of California with a mailing address of 6374 Arizona Circle, Los Angeles, California 90045 (collectively "Petitioners"). Petitioners believe that they are currently being damaged and will continue to be damaged by Registration Nos.: 3111161; 2969852; 3582436; 2538312; 2384745; and 1763135 and hereby petition for cancellation of the same.

Upon information and belief, Respondent Daphne Hereford is an individual and resident of the state of Texas with a mailing address of P.O. Box 27, Crockett, Texas 75835 and Respondent Rin Tin Tin, Inc. is a corporation organized under the laws of the state of Texas with a mailing address of P.O. Box 27, Crockett, Texas 75835.

Description of Respondents' Trademark registrations:

Registration no.: 3111161 filed on March 30, 2004 for the word mark RIN TIN TIN and registered on the Principal Register on July 4, 2006 for "*Printed publications, namely, children's books*" in international class 016 claiming a first use in commerce of April 6, 2001.

Registration no.: 2969852 filed on June 9, 2003 for the word mark RIN TIN TIN and registered on the Principal Register on July 19, 2005 for "*Printed publications, namely, magazines, pamphlets, books and comic books about German Shepard dogs; activity and coloring books, posters, stickers, business cards, and cards in the nature of greeting cards and trading cards*" in international class 016 claiming a first use in commerce November 23, 2002; for "*Playing cards*" in international 028 claiming a first use in commerce November 23, 2002; for "*Entertainment services in the nature of an ongoing television series in the field of variety and motion pictures featuring a German Shepard dog as a live or animated character*" in international class 041 claiming a first use in commerce of November 23, 2002.

Registration no.: 3582436 filed on February 1, 2008 for the word mark RIN TIN TIN and registered on the Principal Register on March 3, 2009 for “*live German Shepherd dogs of Rin Tin Tin lineage*” in international class 031 claiming a first use in commerce December 17, 1980; for “*Animal exhibitions and live animal performances featuring a German Shepherd dog*” in international class 041 claiming a first use in commerce of December 17, 1980.

Registration no.: 2538312 filed on August 8, 2001 for the word mark RIN TIN TIN and registered on the Principal Register on February 12, 2002 for “*mail order fan club service providing materials promoting the breeding, training, raising and showing of the authentic RIN TIN TIN German Shepherd dog lineage*” in international class 041 claiming a first use in commerce of December 17, 1980.

Registration no.: 2384745 filed on October 22, 1998 for the word mark RIN TIN TIN AMBASSADOR CLUB registered on the Principal Register on September 12, 2000 for “*EDUCATION AND ENTERTAINMENT; NAMELY promotion of responsible dog ownership through programs presented to schools and groups*” in international class 041 claiming a first use in commerce May 8, 1998.

Registration no.: 1763135 filed on April 27, 1992 for the stylized mark RIN TIN TIN (as stylized) registered on the Principal Register on April 6, 1993 for “*live German Shepard puppies*” in international class 031 claiming a first use in commerce of December 17, 1980.

As for grounds for this petition for cancellation, Petitioners, on personal knowledge as to their own actions and on information and belief as to actions of others, plead that:

COUNT I
Falsely Suggests a Connection
15 U.S.C. §1052(a)

1. RIN TIN TIN is the name of an internationally famous and iconic fictional German Shepard character that is featured in multiple movies and television shows from the 1920's until present day.

2. Petitioners are the owners of the current and valid copyrights to multiple works featuring the iconic fictional German Shepard character named RIN TIN TIN.

3. Petitioners are the owners of the common law trademark RIN TIN TIN used in conjunction with multiple television shows and movies featuring the iconic fictional German Shepard character named RIN TIN TIN.

4. The name RIN TIN TIN is internationally famous and is recognized uniquely and unmistakably as pointing to the fictional German Shepard character named RIN TIN TIN featured in the multiple copyrighted television shows and movies owned by Petitioners.

5. Respondents' federal trademark registration nos.: 3111161; 2969852; 3582436; 2538312; and 1763135 all consist of the words RIN TIN TIN which is identical to the name of the iconic fictional German Shepard character featured in multiple copyrighted television shows and movies owned by Petitioners.

6. Respondents' federal trademark registration nos.: 3111161; 2969852; 3582436; 2538312; and 1763135 all consist of the words RIN TIN TIN which is identical to the mark used prior, continuously, and owned by Petitioners.

7. Respondents' federal trademark registration no.: 2384745 consists of the words RIN TIN TIN CANINE AMBASSADOR CLUB which includes the name of the iconic fictional German Shepard character featured in multiple copyrighted television shows and movies that are owned by Petitioners.

8. Respondents' federal trademark registration no.: 2384745 comprises the words RIN TIN TIN CANINE AMBASSADOR CLUB which includes the identical the mark used prior, continuously, and owner by Petitioners.

9. Petitioners are not associated, affiliated, or connected with the activities performed by Respondents under the above identified marks.

10. Petitioners have not condoned or authorized the activities performed by Respondents under the above identified marks.

11. The fame of the fictional German Shepard character named RIN TIN TIN featured in multiple copyrighted television shows and movies owned by Petitioners is such that when used by Respondents to identify Respondents' goods and services a false association, affiliation, or connection between Petitioners and Respondents is presumed by the consuming public.

12. Petitioner used the mark RIN TIN TIN in commerce in conjunction with multiple

copyrighted television shows and movies featuring the iconic fictional German Shepard character named RIN TIN TIN decades before Respondents began attempting to commandeer the mark and profits from the goodwill and reputation of Petitioners' copyrighted character and trademark.

13. Petitioners believes that they have been and will continued to be damaged by the continued registration of the federal trademark registration nos. 3111161; 2969852; 3582436; 2538312; 2384745; and 1763135 and respectfully request that the Board cancel the same.

COUNT II

Fraud

(Torres v. Contine Torresella S.r.l. 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986))

14. Petitioners reallege and incorporate by reference the preceding allegations of their Petition for Cancellation.

15. Petitioners began using the mark RIN TIN TIN in commerce well before Respondents signed the oath of application for any of the above referenced federal trademark registrations.

16. Respondents were well aware of Petitioners prior and continuous use of the mark RIN TIN TIN at the time Respondents signed the oath of application for any of the above referenced federal trademark registrations.

17. The above referenced federal trademark registrations comprise or include the name RIN TIN TIN which is identical to the mark used continuously and owned by Petitioners at common law.

18. Respondents offer goods and services under the above referenced marks related to Petitioners iconic fictional German Shepard character featured in multiple copyrighted television shows and movies, thereby intentionally creating false presumptions of association, affiliation, or connection between Respondents and Petitioners.

19. Respondents marks are entirely identical or include Petitioners' mark RIN TIN TIN and are; therefore, confusing similar.

20. Respondents knew that Petitioners superior rights in the mark RIN TIN TIN at the time Respondents signed the oath of application.

21. Respondents, in failing to disclose these facts to the United States Patent and Trademark Office intended to procure a registration to which Respondents were not entitled.

22. Petitioners believe that they have been and will continued to be damaged by the continued registration of the federal trademark registration nos. 3111161; 2969852; 3582436; 2538312; 2384745; and 1763135 and respectfully request that the Board cancel the same.

COUNT III
Misrepresentation of Source
15 U.S.C. §1054(3)

23. Petitioners reallege and incorporate by reference the preceding allegations of their Petition for Cancellation.

24. Respondents have deliberately and intentionally attempted to misrepresent the source of the good and services provided under the above identified federal trademark registrations.

25. Respondents make multiple representations on their internet website, www.rintintin.com, to the iconic fictional German Shepard character named RIN TIN TIN featured in multiple copyrighted television shows and movies owned by Petitioners that would lead consumers to believe that Respondents goods and services originate or are affiliated with the creators of the multiple copyrighted television shows and movies.

26. Defendants multiple efforts to pass off its goods as those of Petitioners is deliberate and intentional.

27. Petitioners believes that they have been and will continued to be damaged by the continued registration of the federal trademark registration nos. 3111161; 2969852; 3582436; 2538312; 2384745; and 1763135 and respectfully request that the Board cancel the same.

COUNT VI
Likelihood of Confusion
15 U.S.C. §1052(d) (directed toward Reg No.:3582436 only)

28. Petitioners reallege and incorporate by reference the preceding allegations of their Petition for Cancellation.

29. Respondents' mark RIN TIN TIN, Reg. no. 3582436 has been registered for less than five years.

30. Respondents' mark RIN TIN TIN, Reg. no. 3582436 is identical to Petitioners' mark RIN TIN TIN.

31. Respondents' services identified by Respondent in Reg. No. 3582436 are related to German Shepherds and therefore it is likely consumers will assume that there exists an association or affiliation to Petitioners multiple copyrighted works featuring the iconic fictional German Shepherd character named RIN TIN TIN.

32. Petitioners began using the mark RIN TIN TIN decades prior to the date upon which Respondent filed the application that matured into Reg. no.: 3582436 and the date that Respondents claim to have first used the mark in commerce.

33. Respondents' Reg. no.: 3582436 so resembled Petitioner's mark, or a mark or trade name previously used in the United States by Petitioners and not abandoned, as to be likely, when used on or in connection with the services identified by Respondents, to cause confusion, or to cause mistake, or to deceive, under §2(d) of the Lanham Act, 15 U.S.C. §1052(d).

34. Petitioners believes that they have been and will continued to be damaged by the continued registration of federal trademark registration no. 3582436 and respectfully request that the Board cancel the same.

COUNT VII

Dilution

15 U.S.C. §1025 (directed toward Reg No.: 3582436 only)

35. Petitioners reallege and incorporate by reference the preceding allegations of their Petition for Cancellation.

36. Petitioners mark RIN TIN TIN is internationally famous due to the nearly 100 years of providing movies and television shows featuring the iconic fictional German Shepherd character named RIN TIN TIN.

37. Petitioners mark RIN TIN TIN was famous well before Respondents first use of the identical mark.

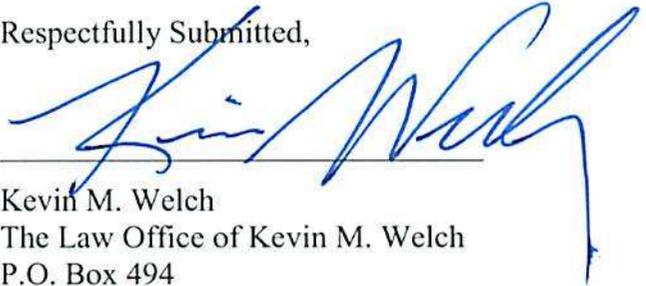
38. Respondents' use of federal trademark registration no.: 3582436 will blur the distinction with which consumers will associate Petitioner's mark RIN TIN TIN with Petitioners.

39. Respondents use of federal registration no.: 3582436 will tarnish the image of the goodwill and reputation Petitioners have amassed in the minds of consumers.

40. Petitioners believe that they have been and will continue to be damaged by the

continued registration of federal trademark registration no. 3582436 and respectfully request that the Board cancel the same.

Respectfully Submitted,

A handwritten signature in blue ink, appearing to read "Kevin Welch", is written over a horizontal line. The signature is fluid and cursive.

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