

ESTTA Tracking number: **ESTTA547255**

Filing date: **07/08/2013**

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 party requests to cancel indicated registration.

Petitioner Information

Name	Shirley's World, L.P.		
Entity	California Limited Partnership	Citizenship	California
Address	101 Lakeview Drive Woodside, CA 94062 UNITED STATES		

Attorney information	Jackie M. Joseph Eisner Kahan Gorry Chapman Ross & Jaffe 9601 Wilshire Boulevard Suite 700 Beverly Hills, CA 90210 UNITED STATES jjoseph@eisnerlaw.com, vmcloud@eisnerlaw.com Phone:310-855-3200
----------------------	---

Registration Subject to Cancellation

Registration No	3418196	Registration date	04/29/2008
Registrant	Prater, Earl C. J. 3540 Yosemite Place Reno, NV 895033839 UNITED STATES		

Goods/Services Subject to Cancellation

Class 032. First Use: 2003/05/02 First Use In Commerce: 2003/05/02 All goods and services in the class are cancelled, namely: CARBONATED SOFT DRINKS, NAMELY, SODA POP FLAVORED LIKE A SHIRLEY TEMPLE
--

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
<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
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

Attachments	Petition for Cancellation - Reg. No. 3418196.pdf(485162 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/s/ Jackie M. Joseph
Name	Jackie M. Joseph
Date	07/08/2013

Petition for Cancellation in the United States Patent and Trademark Office

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

**In the Matter of Registration No. 3418196
Issued on April 29, 2008**

Shirley's World, L.P.)	Cancellation No.:
)	
Petitioner,)	
)	
v.)	
)	
Earl C.J. Prater,)	
)	
Registrant.)	
_____)	

PETITION FOR CANCELLATION

Petitioner, Shirley's World, L.P., a California limited partnership ("Petitioner"), located at 101 Lakeview Drive, Woodside, CA 94062, believes that it is being damaged by Registration No. 3418196 and hereby petitions to cancel same on the following grounds:

1. Upon information and belief, Registrant, Earl C.J. Prater, an individual residing in the State of Nevada, and doing business at 3540 Yosemite Place, Reno, Nevada 89503, is the registered owner of United States Trademark Registration No. 3418196 for THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP (and Design) for "Carbonated soft drinks, namely, soda pop flavored like a Shirley Temple" in International Class 32.

2. Registrant claims a date of first use of THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP (and Design) mark on May 2, 2003.

3. Upon information and belief, Registrant has abandoned Registration No. 3418196 in that he has discontinued use of the mark with intent not to resume such use.

4. Petitioner owns the right, title and interest in and to the name, voice, likeness and other personal characteristics and attributes of Shirley Temple Black (“Mrs. Temple”) as a child and adult, including without limitation, her maiden name “Shirley Temple.”

5. Mrs. Temple is the world-famous and highly acclaimed actor, singer and author, and Petitioner has been using or licensing her name commercially in connection with entertainment services, DVD sets, apparel, collectible dolls, collectible plates, collectible mugs, collectible trinket items, and other products and services since at least 1999 — long before Registrant first used his THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP (and Design) mark. As a result of Mrs. Temple’s widespread and worldwide fame and Mrs. Temple and Petitioner’s use of Mrs. Temple’s name in connection with entertainment services, DVD sets, apparel, collectible dolls, collectible plates, collectible mugs, collectible trinket items, and other products and services, Mrs. Temple’s name has acquired great distinctiveness and extensive goodwill, and is extremely well known and recognized by the public (indeed, it is a household name) as identifying Mrs. Temple, and products and services that are affiliated with or have been authorized by Petitioner or Mrs. Temple.

6. Registrant’s use of the mark THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP (and Design) is likely to cause confusion, mistake or deception as to the source of origin of

Registrant's goods in that the public, the trade and others are likely to believe that Registrant's goods are provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Mrs. Temple.

7. Moreover, the continued existence of Registrant's THE ORIGINAL SHIRLEY TEMPLE DIET SODA POP (and Design) registration casts a cloud upon Petitioner's right to continue to use and to expand the use of Mrs. Temple's name and mark.

6. Registrant applied for and obtained Registration No. 3418196 without requesting Mrs. Temple's or Petitioner's consent to utilize her name in the registered mark. Mrs. Temple and Petitioner did not and do not consent to the use of Mrs. Temple name in said registered mark. Accordingly, Registration No. 3418196 falsely suggests a connection with Mrs. Temple in violation of 15 U.S.C. § 1052(a) and may be cancelled pursuant to 15 U.S.C § 1064(3).

7. Registrant applied for and obtained Registration No. 3418196 fraudulently in that he knowingly made a false, material misrepresentation of fact in connection with his application when he filed a response to Office Action dated November 22, 2004, in which he asserted, in response to inquiry from the USPTO Examining Attorney, that Mrs. Temple's name shown in the mark does not identify a particular living individual. See Exhibit A. Accordingly, Registration No. 3418196 may be cancelled pursuant to 15 U.S.C § 1064(3). Petitioner hereby gives notice that, in accordance with Trademark Rule 2.122(c), it will rely on said Response to Office Action as evidence on its behalf in this proceeding, and copies thereof will be introduced into evidence during the period for the taking of testimony.

WHEREFORE, Petitioner believes that it will be damaged by Registration No. 3418196 and prays that this Petition for Cancellation be sustained in favor of Petitioner, that judgment be entered against Registrant and that U.S. Trademark Registration No. 3418196 be canceled.

Dated: July 8, 2013

EISNER KAHAN
GORRY CHAPMAN ROSS & JAFFE

By: /s/ Jackie M. Joseph
Jackie M. Joseph
Attorneys for Petitioner, Shirley's World,
L.P.

EXHIBIT A

Subj: TRADEMARK APPLICATION NO. 78345712 - THE ORIGINAL
SHIRLEY TEMPLE DIET SODA POP ETC. - N/A
Date: 8/11/2004 2:30:36 PM Pacific Daylight Time
From: ECoM110@USPTO.GOV
To: shirleytemplepop@cs.com
File: 78285474P002OF002.zip (121492 bytes) DL Time (49333 bps): < 1 minute
Received from Internet: [click here for more information](#)

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/345712

APPLICANT: Earl C. J. Prater

CORRESPONDENT ADDRESS:

The Shirley Temple Soda Pop Company
Earl C. J. Prater, President
3540 YOSEMITE PL
RENO NV 89503-3839

78345712

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: THE ORIGINAL SHIRLEY TEMPLE DIET
SODA POP ETC.

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT EMAIL ADDRESS:

shirleytemplepop@cs.com

americantrader@cs.com

CORRESPONDENT TELEPHONE(S):

(775) 747-2470, (800) 490-7955

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.



11-22-2004

U.S. Patent & TMO/TM Mail Report Dt. #32

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 78/345712

The assigned examining attorney has reviewed the referenced application and determined the following.

POTENTIAL SIMILAR MARK FOUND

The examining attorney has searched the Office records and has found no similar registered mark which bars registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01. Please note that the examining attorney has found a potentially conflicting pending application.

The examining attorney encloses information regarding pending Application Serial No. 78285474. The filing date of the referenced application precedes the applicant's filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If the referenced application matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01.

However, in the interim, the following must be addressed:

Informalities

Lining - Feature of the Mark

Applicant must submit a statement that the lining shown in the drawing is a feature of the mark. 37 C.F.R. §2.37; TMEP §807.09(e).

Applicant response, Earl C.J. Prater, 11/16/04: "The lining shown in the drawing is a feature of the mark"..

Name of an Individual

If the name Shirley Temple shown in the mark identifies a particular living individual, the applicant must submit a written consent from such individual, authorizing the applicant to register the name. If the name does not identify a living individual, the

applicant should state so for the record. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §§813 and 1206 *et seq.*

Applicant response, Earl C.J. Prater, 11/16/04: "The name of the soft drink, "The Original Shirley Temple Soda Pop", first U.S. trademarked April 23, 1991 and subsequently in February 19, 2002, does not identify a living individual but the name of the carbonated soft drink beverage only." The first trademark application for The Original Shirley Temple Soda Pop was submitted July 10, 1987 and approved by the U.S. Trademark Office April 23, 1991. The second trademark renewal application was submitted February 13, 2001 and approved February 19, 2002.

Disclaimer

The applicant must disclaim all of the wording in the mark apart from the mark as shown except of the wording SHIRLEY TEMPLE. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.02(a). The wording is merely descriptive because it imparts immediate information about the goods.

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.09(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use [INSERT all of the wording *except* SHIRLEY TEMPLE , i.e., SODA POP, PLEASE RECYCLE, NUTRIANO FACTS (include SPECIFY ALL THE WORDING in the nutritional facts rectangle), CONTENTS: [insert all of the ingredients shown in the drawing], CAFFEINE FREE DIET, 100% CAFFEINE FREE, SUGAR FREE DIET SODA, 12 FL. OZ. (354 ML.)]" apart from the mark as shown.

Applicant response, 11/16/04, Earl C.J. Prater, "NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE: "PLEASE RECYCLE, 100% CAFFEINE FREE, SUGAR FREE, VERY LOW SODIUM, NUTRITION FACTS {SERVING SIZE, CALORIES, TOTAL FAT, SODIUM, TOTAL CARB, PROTEIN, VITAMIN C}, CONTENTS (CARBONATED WATER, CITRIC ACID, POTASSIUM CITRATE, POTASSIUM BENZOATE AS A PRESERVATIVE, NATURAL AND ARTIFICIAL FLAVORS, ASPARTAME, AND RED 40, CAFFEINE FREE DIET, 12 FL. OZ. (354 ML.), APART FROM THE MARK AS SHOWN.

See In re Oyatonna Tool Co., 231 USPQ 43 (Comm'r Pats. 1983).

Prior Registration

If the applicant is the owner of Registration No. 2540238, the applicant must submit a claim of ownership. 37 C.F.R. Section 2.36; TMEP section 812.

"I, Earl C.J. Prater, an individual, am the owner of the mark(s) respectively under current and prior Registration No. 2540238, approved February 19, 2002 as "The Original Shirley Temple Soda Pop" and Registration No. 73671138 approved April 23, 1991 as "The Original Shirley Temple Soda Pop".

"This specific carbonated soft drink beverage product is highly recognized for its exclusive and well established name and design, "The Original Shirley Temple Soda Pop" and "The Original Shirley Temple Diet Soda Pop", which were first produced in April of 1987. (Response, /Earl C.J. Prater/, 11/16/04).

Specimen Required

An application based on use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), must include a specimen showing use of the mark in commerce on or in connection with the goods/services. TMEP §904. The application does not contain a specimen. The applicant must submit a specimen, and must submit the following statement:

"The Original Shirley Temple Soda Pop" and "The Original Shirley Temple Diet Soda Pop" carbonated soft drink beverage products were first used in commerce at least as early as April of 1987." (Response, /Earl C.J. Prater/ 11/16/04).

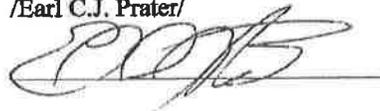
This statement must be verified with an affidavit or a declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(a); TMEP §904.09.

The following is a properly worded declaration under 37 C.F.R. §2.20. At the end of the response, the applicant should insert the declaration signed by a person authorized to sign under 37 C.F.R. §2.33(a).

DECLARATION

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that the facts set forth in this application are true; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

/Earl C.J. Prater/



(Signature)

Earl C.J. Prater, Owner

(Print or Type Name and Position)

Dated, November 16, 2004



Instructions for Applicants Not Represented By An Attorney

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number to speed up further processing.

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response.

The applicant may wish to hire a trademark attorney because of the technicalities involved in the application. The Patent and Trademark Office cannot aid in the selection of an attorney.

NOTICE: TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

My Law Office will move on October 25, 2004. To reach me by phone after that date call **(571) 272-9373**.

To submit a fax response to this Office action after that date, send your response to the Law Office fax number, namely **(571) 272-9373**.

If further information or assistance is needed in responding to this Office Action, please feel free to contact the trademark attorney listed below.

/Shari L. Sheffield/

Shari Sheffield

Trademark Attorney

Law Office 110

703-308-9110 ext. 467

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

CERTIFICATE OF SERVICE

I hereby certify that the foregoing **PETITION FOR CANCELLATION** was served upon Registrant in this action addressed as follows:

Earl C.J. Prater
3540 Yosemite Place
Reno, Nevada 89503

BY OVERNIGHT DELIVERY: I am readily familiar with the firm's practice of collection and processing items for delivery with Overnight Delivery. Under that practice such envelope(s) is deposited at a facility regularly maintained by Overnight Delivery or delivered to an authorized courier or driver authorized by Overnight Delivery to receive such envelope(s), on the same day this declaration was executed, with delivery fees fully provided for at 9601 Wilshire Boulevard, Suite 700, Beverly Hills, California 90210, in the ordinary course of business.

Executed on July 8, 2013, at Beverly Hills, California.

By: /s/ Jackie M. Joseph
Jackie M. Joseph

EISNER KAHAN
GORRY CHAPMAN ROSS & JAFFE

9601 Wilshire Blvd., Suite 700
Beverly Hills, CA 90210
Tel: (310) 855-3200
Fax: (310) 855-3201

Attorneys for Petitioner, Shirley's World, L.P.