

ESTTA Tracking number: **ESTTA547240**

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	The George Nelson Foundation		
Entity	nonprofit corporation	Citizenship	Michigan
Address	174 Oakwood Avenue Holland, MI 49424 UNITED STATES		

Attorney information	William J. Dorsey Katten Muchin Rosenman 525 West Monroe St Chicago, IL 60661 UNITED STATES william.dorsey@kattenlaw.com, carolyn.passen@kattenlaw.com, julia.kasper@kattenlaw.com, deborah.wing@kattenlaw.com Phone:312.902.5200
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**Registration Subject to Cancellation**

Registration No	3463818	Registration date	07/08/2008
Registrant	EMPIRE IP HOLDINGS LLC 2 MEADOWBROOK ROAD SYOSSET, NY 11791 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 014. First Use: 2007/09/01 First Use In Commerce: 2007/09/01 All goods and services in the class are cancelled, namely: Clocks
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**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)
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/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GEORGE NELSON		
Goods/Services	Modern furniture, including benches, cabinets, sofas, chairs, settees,		

	bedroom pieces, wall and table clocks, tables, lamps, fireplace pieces and tools, planters, room dividers
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	NELSON		
Goods/Services	Modern furniture, including benches, cabinets, sofas, chairs, settees, bedroom pieces, wall and table clocks, tables, lamps, fireplace pieces and tools, planters, room dividers		

Attachments	Petition and exhibits.pdf(1928351 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	/wjd/
Name	William J. Dorsey
Date	07/08/2013

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

In the matter of U.S. Trademark Registration No. 3,463,818  
Mark: GEORGE NELSON BY VERICHRON  
Date of Registration: July 8, 2008

THE GEORGE NELSON FOUNDATION,

Petitioner,

v.

EMPIRE IP HOLDINGS

Registrant.

Cancellation No.: \_\_\_\_\_

**PETITION TO CANCEL**

Petitioner, the George Nelson Foundation, a nonprofit Michigan corporation with its principal place of business in New York, New York and an address at 174 Oakwood Avenue, Holland, Michigan 49424, believes that it has been, and will continue to be, damaged by U.S. Registration No. 3,463,818 (the "Registration") for the mark GEORGE NELSON BY VERICHRON in International Class 14 for "clocks." The Registration was issued July 8, 2008 to Wen Chen Wu and assigned, on November 16, 2012, to its current owner Empire IP Holdings, a New York Limited Liability Company having a principal place of business located at 2 Meadowbrook Road, Syosset, New York 11791 ("Registrant"). For the reasons set forth below, Petitioner hereby petitions to cancel the Registration, pursuant to 37 CFR §2.111(b) and alleges as follows:

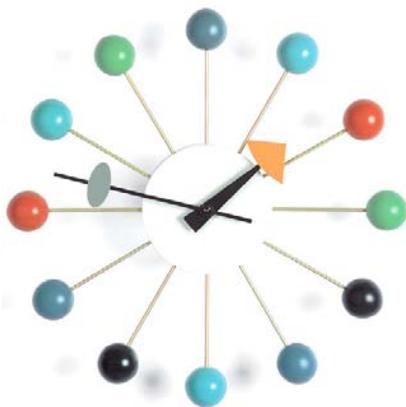
**Background**

**GEORGE NELSON, THE RENOWNED DESIGNER**

1. George Nelson was a famous American industrial designer and one of the

founding fathers of American Modernism. During his lifetime, George Nelson created much of the 20th century's most iconic modern furniture, including benches, cabinets, sofas (e.g., the "Marshmallow sofa"), chairs, settees, bedroom pieces, wall and table clocks, tables, lamps, wrought iron fireplace pieces and tools, planters, room dividers, and the Action Office (a precursor to the modern office cubicle). Each of these products prominently featured the George Nelson name on their labels, in their promotional materials and/or on their packaging.

2. Among George Nelson's most widely-recognized designs are his iconic "Ball Clocks," which he designed in 1949. These clocks feature wire rods with multi-colored balls and are available in different color variations, one of which is shown below:



Stardust, <http://www.stardust.com/BALLCLOCK.html> (website selling clock manufactured by licensee).

3. George Nelson's extraordinary achievements in furniture design garnered him countless awards and tremendous recognition, including, but not limited to the following awards: Lifetime Achievement Award, American Institute of Graphic Arts (1991); Scholar in Residence, Smithsonian Institute National Museum of Design (1984); Chairman, International Design Conference in Aspen (1965 and 1982); Good Design Award, Museum of Modern Art (1954); Trailblazer Award, National Home Furnishings League (1954); Best Office of the Year, New

York Times (1953); Gold Medal, Art Directors Club of New York (1953); and Prix de Rome for architecture (1932). George Nelson's designs are also featured in the permanent collections of the Museum of Modern Art, the Brooklyn Museum of Art, and the Philadelphia Museum of Art.

4. In addition, George Nelson authored and co-authored several iconic books on Modern American design, including Tomorrow's House (1945), Living Spaces (1952), Chairs and Display (1953), Storage (1954), Problems with Design (1957), How to See: Visual Adventures in a World God Never Made (1977), and George Nelson on Design (1979). He has also been the subject of many books, including George Nelson: Architect /Writer / Designer / Teacher (2009) and George Nelson: The Design of Modern Design (2000).

#### **THE NELSON MARKS AND PETITIONER**

5. George Nelson developed and enjoyed extensive goodwill and recognition throughout the United States and the world with respect to his name and marks, GEORGE NELSON and NELSON (the "GEORGE NELSON Marks").

6. George Nelson died in 1986 in New York City, where he had been residing. Upon his death, his widow Jacqueline Nelson inherited all rights, title and interest in and to the GEORGE NELSON Marks, as well as other intellectual property. The GEORGE NELSON Marks have been in continuous use in connection with modern furniture since at least 1947 pursuant to various licenses.

7. In January 2013, Jacqueline Nelson assigned to Petitioner her rights, interest and title in and to the GEORGE NELSON Marks, as well as related Intellectual Property. Petitioner continues to license the GEORGE NELSON Marks in connection with the George Nelson's modern furniture designs, and serves to preserve and protect George Nelson's important legacy.

## **REGISTRANT, ITS FRAUDULANT ACTS AND REGISTRATION**

8. At the time Registrant's predecessor-in-interest applied to register the mark GEORGE NELSON BY VERICHRON for "clocks" (the "Registered Mark"), he was well-aware of George Nelson, the designer and his famous clock designs.

9. Indeed, Registrant's clocks sold under the mark GEORGE NELSON BY VERICHRON are pale imitations of the authentic GEORGE NELSON clock designs. Examples of Petitioner's clocks manufactured and offered under the GEORGE NELSON Marks through its licensee are attached as Exhibit A, and examples of knock-off clocks offered by Registrant under the Registered Mark are attached as Exhibit B.

10. Registrant's use of the GEORGE NELSON marks and George Nelson clock designs is unauthorized. Neither the Registrant nor its predecessor-in-interest have ever been licensed users of the GEORGE NELSON marks; and neither has any known affiliation with Petitioner, George Nelson, or Ms. Nelson.

### **Grounds for Cancellation**

#### **False Suggestion of Connection**

11. The allegations set forth in the preceding paragraphs are adopted and incorporated by reference as if fully set forth herein.

12. Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits registration of a mark which disparages or falsely suggests a connection with a person, living or dead, or which brings them into contempt or disrepute.

13. The Registered Mark – GEORGE NELSON BY VERICHRON – wholly incorporates the name of the late George Nelson.

14. Given that the Registered Mark is for "clocks," which are unauthorized imitations of the widely-recognized clocks designed by the famous George Nelson in 1949, the public

would recognize the Registered Mark as referring to the late George Nelson and presume a connection between Registrant and/or its clocks and George Nelson.

15. Registrant is in no way connected with Petitioner or George Nelson.

16. Therefore, the Registration should be cancelled pursuant to 15 U.S.C. § 1052(a), because it disparages or falsely suggests a connection with the deceased George Nelson.

### **Likelihood of Confusion**

17. The allegations set forth in the preceding paragraphs are adopted and incorporated by reference as if fully set forth herein.

18. Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), prohibits registration of a mark which consists of or comprises a mark which so resembles a mark previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion.

19. The GEORGE NELSON Marks owned by Petitioner have been in continuous use in the United States since 1947, predating the Registrant's first use date of the Registered Mark (September 1, 2007) by several decades.

20. Petitioner's GEORGE NELSON Marks are distinctive.

21. Furthermore, many of George Nelson's clock designs, including his iconic ball clock, have been sold in the United States under the GEORGE NELSON Marks since at least 1999 through a licensee.

22. The Registered Mark so resembles the GEORGE NELSON Marks, in sight, sound, and commercial impression, as to be likely, when used with the imitation clocks offered by Registrant, to cause confusion.

### **Dilution**

23. The allegations set forth in the preceding paragraphs are adopted and incorporated by reference as if fully set forth herein.

24. 15 U.S.C. § 1064 provides that a petition to cancel a registration may be filed by any person who believes that he is or will be damaged as a result of a likelihood of dilution.

25. The countless awards and tremendous name recognition George Nelson received and continues to receive for his furniture designs offered under the GEORGE NELSON Marks demonstrate that the GEORGE NELSON Marks are famous, and became famous before Registrant started using the Registered Mark in September 2007.

26. The Registered Mark is likely to dilute the distinctive quality of Petitioner's GEORGE NELSON Marks in violation of § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and, as such, the Registration should be cancelled.

### **Bad Faith / Fraud**

27. The allegations set forth in the preceding paragraphs are adopted and incorporated by reference as if fully set forth herein.

28. 15 U.S.C. § 1064(d) provides that a petition to cancel a registration may be filed, at any time, if the registration was obtained fraudulently.

29. Fraud on the trademark office occurs when an applicant knowingly makes false, material representations of fact in connection with its registration.

30. At the time Registrant's predecessor-in-interest, Mr. Wu, filed the application for the Registered Mark, he was well-aware of the designer George Nelson and his famous clock designs. This is evident from the fact that Registrant's clocks are imitations of the original GEORGE NELSON clock designs (see Exhibits A and B). Further, at the time the application

was filed, the GEORGE NELSON mark was being used by authorized licensees, and had been in use by George Nelson and/or licensees for decades. Moreover, at the time the application was filed, the GEORGE NELSON Marks were being used (by an authorized licensee) in connection with the very clock designs Registrant copies and sells under the Registered Mark.

31. Yet, in the application, Mr. Wu's authorized representative signed a declaration (on Mr. Wu's behalf) falsely stating that Mr. Wu:

is the owner of the trademark/service mark sought to be registered . . . [and] to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive . . .

32. The above representation was false, and this false representation is material to the registrability of the Registered Mark.

33. On information and belief, Registrant intentionally concealed these material facts from the United States Patent and Trademark Office in order to procure the Registration.

34. Because the Registration was obtained by fraud, it should be cancelled pursuant to 15 U.S.C. § 1064(d).

### **Request for Relief**

WHEREFORE, Petitioner believes that it is likely to be damaged by the continued registration of Registration No. 3,463,818, and Petitioner respectfully requests that this Petition to Cancel be sustained and the mark shown in U.S. Trademark Registration No. 3,463,818 be cancelled.

Dated: July 8, 2013

Respectfully submitted,

By: /s/ Carolyn M. Passen

William J. Dorsey

Carolyn M. Passen

Julia L. Kasper

KATTEN MUCHIN ROSENMAN LLP

525 W. Monroe Street

Chicago, Illinois 60661

312-902-5200

*Attorneys for Petitioner*

**CERTIFICATE OF SERVICE**

I, Carolyn M. Passen, an attorney, hereby certify that on today's date I caused a copy of the foregoing PETITION TO CANCEL and Exhibits A-B to be served upon counsel for Registrant, and Registrant, via U.S. Mail and e-mail (to counsel only), at the following address:

Steven N. Fox, Esq.  
62 South Main Street  
Sharon, Massachusetts 02067  
snf33237@gmail.com

Empire IP Holdings  
2 Meadowbrook Road  
Syosset, New York 11791

Dated: July 8, 2013

/s/ Carolyn M. Passen

# **EXHIBIT A**

Filter: Category Designer Topics

You have selected **George Nelson**. Clear



Asterisk Clock  
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Fernando the Fish  
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Flock of Butterflies  
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