

ESTTA Tracking number: **ESTTA554469**

Filing date: **08/16/2013**

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	Arctic Cat Inc.		
Entity	Corporation	Citizenship	Minnesota
Address	601 Brooks Avenue South Thief River Falls, MN 56701 UNITED STATES		

Attorney information	Lora Friedemann Fredrikson & Byron, P.A. 200 South Sixth Street Suite 4000 Minneapolis, MN 55402-1425 UNITED STATES lfriedemann@fredlaw.com, lmyers@fredlaw.com, jpickerill@fredlaw.com Phone:6124927000
----------------------	--

Registrations Subject to Cancellation

Registration No	3490382	Registration date	08/19/2008
Registrant	SABERTOOTH MOTORCYCLES, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 2005/12/01 First Use In Commerce: 2006/02/01 All goods and services in the class are cancelled, namely: motorcycles
--

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		
Other	Failure to comply with 15 U.S.C. 1060		
Registration No	3554107	Registration date	12/30/2008
Registrant	Sabertooth Motorcycles, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 2005/12/01 First Use In Commerce: 2006/02/01 All goods and services in the class are cancelled, namely: Motorcycles
--

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	
Other		No bona fide use in commerce at the time the use-based application was filed (15 U.S.C. 1051(a))	
Registration No	3561054	Registration date	01/13/2009
Registrant	Sabertooth Motorcycles, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 2005/12/01 First Use In Commerce: 2006/02/01 All goods and services in the class are cancelled, namely: Motorcycles
--

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	
Other		No bona fide use in commerce at the time the use-based application was filed (15 U.S.C. 1051(a))	
Registration No	3580465	Registration date	02/24/2009
Registrant	Sabertooth Motorcycles, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 2005/12/01 First Use In Commerce: 2006/02/01 All goods and services in the class are cancelled, namely: Motorcycles
--

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	
Other		No bona fide use in commerce at the time the use-based application was filed (15 U.S.C. 1051(a))	
Registration No	3950962	Registration date	04/26/2011
Registrant	Sabertooth Motorcycles, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 2006/02/01 First Use In Commerce: 2006/03/01 All goods and services in the class are cancelled, namely: Motorcycles
--

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	
Other		No bona fide use in commerce at the time the use-based application was filed (15 U.S.C. 1051(a))	
Registration No	4209078	Registration date	09/18/2012
Registrant	Sabertooth Motorcycles, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 032. First Use: 2005/12/15 First Use In Commerce: 2006/03/01
All goods and services in the class are cancelled, namely: Beer; Bottled water; Energy drinks; Flavored bottled water; Powders used in the preparation of isotonic sports drinks and sports beverages; Soft drinks; Soft drinks, namely, sodas; Sports drinks; Sports drinks, namely, energy drinks

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	
Other		No bona fide use in commerce at the time the use-based application was filed (15 U.S.C. 1051(a))	
Registration No	3576038	Registration date	02/17/2009
Registrant	Sabertooth Motorcycles, LLC 26 Lyman Rd. Chestnut Hill, MA 02467 UNITED STATES		

Goods/Services Subject to Cancellation

Class 012. First Use: 2005/12/01 First Use In Commerce: 2006/02/01
All goods and services in the class are cancelled, namely: Motorcycles

Grounds for Cancellation

Abandonment	Trademark Act section 14
Related Proceedings	U.S. Application Serial No. 85308858 Civil Case No. 0:13-cv-00146-MJD-LIB in the United States District Court of Minnesota
Attachments	Arctic Cat Petition to Cancel.pdf(36770 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 First Class Mail on this date.

Signature	/Laura L. Myers/
Name	Laura L. Myers
Date	08/16/2013

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

ARCTIC CAT INC.)	Cancellation No. _____
)	
Petitioner,)	Registration Nos. 3,490,382; 3,554,107;
)	3,561,054; 3,580,465; 3,950,962;
v.)	4,209,078; 3,576,038
)	
SABERTOOTH MOTORCYCLES, LLC)	Marks: Wildcat; Sabertooth Midnight
)	WildCat; WildCat 427; WildCat X;
Registrant.)	WildCat 427X; WildCat; 
)	

PETITION TO CANCEL

Petitioner Arctic Cat Inc. believes it is being damaged by U.S. Registration No. 3,490,382, issued August 19, 2008, for the mark “Wildcat”; U.S. Registration No. 3,554,107, issued December 30, 2008, for the mark “Sabertooth Midnight WildCat”; U.S. Registration No. 3,561,054, issued January 13, 2009, for the mark “WildCat 427”; U.S. Registration No. 3,580,465, issued February 24, 2009, for the mark “WildCat X”; U.S. Registration No. 3,950,962, issued April 26, 2011 for the mark “WildCat 427X”; U.S. Registration No. 4,209,078, issued September 18, 2012, for the mark “WildCat”; and U.S. Registration No. 3,576,038, issued February 17, 2009 for , and hereby petitions for cancellation of the same and alleges as follows:

1. Petitioner Arctic Cat, Inc. (“Arctic Cat”) is a Minnesota corporation with its principal place of business at 601 Brooks Avenue South, Thief River Falls, Minnesota 56701.
2. Arctic Cat designs, engineers, manufactures, and markets snowmobiles, all-terrain vehicles (ATVs), and Side by Sides under the ARCTIC CAT brand name, as well as related

parts, garments, and accessories. The ARCTIC CAT brand name is among the most widely recognized and respected names in the snowmobile, ATV, and Side by Side industry.

3. Sabertooth Motorcycles, LLC (“Sabertooth”) is a Delaware limited liability company with its address of record at 26 Lyman Road, Chestnut Hill, Massachusetts 02467.

4. The United States Patent and Trademark Office (“USPTO”) records identify Sabertooth as the owner of U.S. Registration No. 3,490,382, dated August 19, 2008, for the mark “Wildcat” for “motorcycles” in International Class 12; U.S. Registration No. 3,554,107, dated December 30, 2008, for the mark “Sabertooth Midnight WildCat” for “motorcycles” in International Class 12; U.S. Registration No. 3,561,054, dated January 13, 2009, for the mark “WildCat 427” for “motorcycles” in International Class 12; U.S. Registration No. 3,580,465, dated February 24, 2009, for the mark “WildCat X” for “motorcycles” in International Class 12; and U.S. Registration No. 3,950,962, dated April 26, 2011 for the mark “WildCat 427X” in International Class 12 (the “Wildcat Registrations”).

5. None of the Wildcat Registrations has been registered for five years.

6. On April 29, 2011, Arctic Cat filed U.S. Serial No. 85/308,353 for the mark WILDCAT for “recreational off-highway vehicles, parts and accessories therefor” in International Class 12 and “clothing, namely, shirts, sweatshirts, T-shirts, jerseys, jackets, headwear, pants, underwear, gloves, caps, and hats” in International Class 25 (the “Wildcat Application”).¹

7. In a final office action dated May 14, 2012, the examining attorney refused registration of Arctic Cat’s WILDCAT mark in International Class 12 due to an alleged

¹ Subsequently, U.S. Serial No. 85,308,858 was divided and the original application contained the identified goods in International Class 12 and a new child application (U.S. Serial No. 85/979,276) contained the identified goods in International Class 25.

likelihood of confusion with the Wildcat Registrations. Accordingly, Arctic Cat is being damaged by the continued registration of U.S. Registration Nos. 3,490,382; 3,554,107; 3,561,054; 3,580,465; and 3,950,962.

8. On December 27, 2005, a company called VX Unlimited, Inc. filed an intent-to-use application for the WILDCAT mark in U.S. Registration No. 3,490,382.

9. On May 2, 2007, a “new assignment” form was filed at the USPTO indicating that there was a “change of name” from VX Unlimited, Inc. to Sabertooth Motorcycles, LLC. No underlying written assignment of the application or WILDCAT mark was filed with the form document.

10. VX Unlimited, Inc. was a corporation and Sabertooth is a limited liability company. Because the two companies are distinct corporate entities, more than a simple “change of name” would have been required to transfer VX Unlimited, Inc.’s business and goodwill, if any, associated with the WILDCAT mark to Sabertooth.

11. In addition, Sabertooth was formed on November 9, 2006, but VX Unlimited, Inc. continued to exist at that time and was not dissolved until March 30, 2009 – almost two years after the alleged name change occurred.

12. Without a transfer of VX Unlimited, Inc.’s business and goodwill associated with the WILDCAT mark to Sabertooth, there was no assignment of the trademark under 15 U.S.C. § 1060(a)(1).

13. Furthermore, 15 U.S.C. § 1060(a)(1) prevents any assignment of an intent-to-use application before the statement of use is filed, unless the assignment is to a successor to the business of the applicant.

14. There is no indication that Sabertooth is the successor to VX Unlimited, Inc. and the alleged “assignment” was recorded at the USPTO more than a year before Sabertooth filed a statement of use on June 18, 2008.

15. Accordingly, there is no valid assignment of the WILDCAT mark in U.S. Registration No. 3,490,382 from VX Unlimited, Inc. to Sabertooth.

16. Sabertooth filed used-based applications for the remaining Wildcat Registrations between June 24, 2008 and September 23, 2010.

17. On information and belief, there was no bona fide use of the marks in U.S. Registration Nos. 3,554,107; 3,580,465; 3,561,054; and 3,950,962 in commerce prior to the filing of the use-based applications.

18. In addition to its non-use of the marks at the time of filing, during prosecution of the Wildcat Registrations, Sabertooth knowingly made false, material misrepresentations with the intent to deceive the USPTO.

19. For each of the Wildcat Registrations except Registration No. 3,950,962 for WildCat 427X, the date of “first use” alleged by Sabertooth is December 1, 2005 with a first use “in commerce” date of February 1, 2006.

20. For Registration No. 3,950,962, the date of “first use” alleged by Sabertooth is February 1, 2006 with a first use “in commerce” date of March 1, 2006.

21. Sabertooth was not formed until November 9, 2006 – months after the alleged first use and first use in commerce dates alleged by Sabertooth in the Wildcat Registrations.

22. Sabertooth knew that it had not used the marks in the Wildcat Registrations in commerce on the dates identified in the Wildcat Registrations because the company did not exist at the time.

23. Sabertooth also knew that it had not manufactured, offered for sale, or sold any motorcycles in connection with the marks in the Wildcat Registrations on the alleged first use dates.

24. Sabertooth falsely represented its first use of the marks in the Wildcat Registrations with the intent to deceive the USPTO.

25. Sabertooth also knowingly submitted improper specimens as proof of use in commerce during prosecution of the Wildcat Registrations with the intent to deceive the USPTO.

26. On information and belief, the specimens submitted by Sabertooth were fabricated to allege actual use in commerce. The specimens themselves do not evidence any actual use in commerce as of the filing date of the Wildcat Registrations.

27. The USPTO records also identify Sabertooth as the owner of U.S. Registration No. 4,209,078, dated September 18, 2012, for the mark “WildCat” for “beer; bottled water; energy drinks; flavored bottled water; powders used in the preparation of isotonic sports drinks and sports beverages; soft drinks; soft drinks, namely, sodas; sports drinks; sports drinks, namely, energy drinks” in International Class 32 and U.S. Registration No. 3,576,038, dated February 17, 2009, for  for “motorcycles” in International Class 12.

28. U.S. Registration Nos. 4,209,078 and 3,576,038 have not been registered for five years.

29. In Case No. 13-cv-00146-MJD-LIB in the District of Minnesota, Sabertooth has asserted U.S. Registration Nos. 4,209,078 and 3,576,038 against Arctic Cat, and accused Arctic Cat of trademark infringement under the Lanham Act. Accordingly, Arctic Cat is being damaged by the continued registration of U.S. Registration Nos. 4,209,078 and 3,576,038.

30. Sabertooth's use of the marks in the Wildcat Registrations and U.S. Registration Nos. 4,209,078 and 3,576,038 in commerce, if any, has been extremely limited and sporadic.

31. On information and belief, Sabertooth did not sell any motorcycles for a period of at least three years.

32. On information and belief, Sabertooth has never used the WILDCAT mark in connection with the goods identified in U.S. Registration No. 4,209,078, even though it filed a use-based trademark application that alleged a "first use" date of December 15, 2005 and a first use "in commerce" date of March 1, 2006.

33. On information and belief, the specimen Sabertooth submitted during prosecution of U.S. Registration No. 4,209,078 was fabricated to allege actual use in commerce. The specimen itself does not evidence any actual use in commerce as of the filing date of U.S. Registration No. 4,209,078.

34. Thus, during prosecution of U.S. Registration No. 4,209,078, Sabertooth knowingly made false, material misrepresentations with the intent to deceive the USPTO.

35. Accordingly, cancellation of U.S. Registration No. 3,490,382 for WILDCAT is warranted because there is no assignment of the underlying application or the business and goodwill associated with the mark to Sabertooth, and any attempt to assign the mark to Sabertooth prior to the filing of the statement of use was improper and invalid under 15 U.S.C. § 1060(a)(1).

36. Cancellation of U.S. Registration Nos. 3,554,107; 3,580,465; 3,561,054; 3,950,962; and 4,209,078 is warranted because there was no bona fide use of the marks at the time Sabertooth filed its use-based applications.

37. Cancellation of the Wildcat Registrations and U.S. Registration No. 4,209,078 is also warranted because Sabertooth committed fraud during prosecution of the registrations by knowingly making false, material misrepresentations and submitting improper specimens with the intent to deceive the USPTO.

38. Finally, cancellation of the Wildcat Registrations and U.S. Registration Nos. 3,576,038 and 4,209,078 is warranted because Sabertooth abandoned the registered marks through non-use with the identified goods for at least three years.

WHEREFORE, Arctic Cat respectfully requests that the Board cancel U.S. Registration Nos. 3,490,382; 3,554,107; 3,561,054; 3,580,465; 3,950,962; 4,209,078; and 3,576,038 and grant such other and further relief as may be just and proper.

Dated: August 16, 2013

/s/ Laura L. Myers

Lora M. Friedemann

lfriedemann@fredlaw.com

John C. Pickerill

jpickerill@fredlaw.com

Laura L. Myers

lmyers@fredlaw.com

FREDRIKSON & BYRON, P.A.

200 South Sixth Street, Suite 4000

Minneapolis, MN 55402-1425

Telephone: 612.492.7000

Facsimile: 612.492.7077

ATTORNEYS FOR PETITIONER

ARCTIC CAT INC.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the PETITION TO CANCEL was served on Registrant Sabertooth Motorcycles, LLC, by mailing it to its address of record at 26 Lyman Road, Chestnut Hill, Massachusetts 02467 by first class mail, postage prepaid, this 16th day of August, 2013.

/s/ Laura L. Myers

Laura L. Myers

7140957_1.DOCX