

ESTTA Tracking number: **ESTTA558843**

Filing date: **09/11/2013**

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 | Qualcomm Incorporated | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 5775 Morehouse Drive San Diego, CA 92121 UNITED STATES | | |

| | |
|----------------------|--|
| Attorney information | N. Christopher Norton Arent Fox LLP 1717 K Street, NW Washington, DC 20036-5342 UNITED STATES tmdocket@arentfox.com, christopher.norton@arentfox.com, anthony.peluso@arentfox.com, kristen.koines@arentfox.com Phone:2028576000 |
|----------------------|--|

Registration Subject to Cancellation

| | | | |
|--------------------------------|--|---------------------------------|------------|
| Registration No | 3746888 | Registration date | 02/09/2010 |
| International Registration No. | NONE | International Registration Date | NONE |
| Registrant | BNK 4 S.A. 6, rue Adolphe Fischer L-1520 Luxembourg LUXEMBOURG | | |

Goods/Services Subject to Cancellation

| |
|---|
| <p>Class 009. All goods and services in the class are cancelled, namely: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, supervisory checking, life-saving and teaching apparatus and instruments other than medical apparatus and instruments, namely, computers; apparatus for recording, transmitting, reproducing or processing sound or images; magnetic recording media, namely, blank magnetic tapes for tape recorders, blank acoustic or blank optical discs, blank floppy computer discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers; calculating machines; data processing and computer equipment, namely, computer, modems, software for computer games; computer software for use in database management, computer peripheral devices; optical goods, namely, eye glasses, sun glasses, blank smart cards and blank integrated circuit cards; transaction and secure payment devices for electronic commerce, namely, e-commerce by credit cards; microprocessors; magnetically encoded payment, bank, credit, check guarantee, and store cards; computer software for processing electronic payment from third parties and in favor of third parties, authentication software</p> |
| <p>Class 038. All goods and services in the class are cancelled, namely: Telecommunication services, namely, local and long distance transmission of voice, data, graphic and video by means of broadband optical or</p> |

| |
|---|
| wireless networks; Telecommunication services, namely, providing internet access via broadband optical or wireless networks; News agencies, namely, the transmission of news items to news reporting organizations; rental of telecommunication equipment; radio broadcasting; television broadcasting; audio and video teleconferencing services; electronic mail services; Providing multiple-user access to a global computer information network; instant electronic messaging services |
|---|

Grounds for Cancellation

| | |
|-------------|--------------------------|
| Abandonment | Trademark Act section 14 |
|-------------|--------------------------|

| | |
|-------------|---|
| Attachments | Petition for Cancellation (Reg. No. 3746888) (9.11.13).pdf(123514 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 | /adpeluso/ |
| Name | Anthony D. Peluso |
| Date | 09/11/2013 |

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

In re Registration No. 3,746,888 for the mark BORN, registered on February 9, 2010.

QUALCOMM INCORPORATED :
 :
 :
 Petitioner, : Cancellation No. _____
 :
 :
 v. :
 :
 :
 BNK 4 S.A. :
 :
 :
 Registrant. :

PETITION FOR CANCELLATION

Petitioner Qualcomm Incorporated (“Petitioner”), a Delaware Corporation, having an address of 5775 Morehouse Drive, San Diego, California 92121, believes it will be damaged by the continued existence of Registration No. 3,746,888 for the mark BORN, registered by BNK 4 S.A. (“Registrant”), a Luxembourg corporation. Petitioner hereby petitions to cancel this registration pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064. As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner is the owner of all right, title, and interest in and to the mark BORN MOBILE (“Petitioner’s Mark”).
2. Petitioner filed application Ser. No. 85/781,611 for Petitioner’s Mark on November 16, 2012.
3. Registration of Petitioner’s Mark in Classes 9 and 38 was refused under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with the subject mark (the “BORN Mark”) (Reg. No 3,746,888), pursuant to an Office Action that issued on March 12, 2013.

4. Registrant obtained a U.S. trademark registration for the BORN Mark on the basis of an extension of protection under §66(a) of the Trademark Act of 1946, 15 U.S.C. §1141f, pursuant to the Madrid Protocol on February 9, 2010.

5. Upon information and belief, Registrant has not used the BORN Mark in the United States with the goods and services listed in the subject registration.

6. Upon information and belief, Registrant has not used the BORN Mark in the United States with the goods and services listed in the subject registration for over three years, which is *prima facie* evidence of abandonment.

7. Upon information and belief, Registrant has abandoned the BORN Mark, without intent to use or to resume use of the mark, and is therefore not entitled to maintain the subject registration.

8. As the subject registration is blocking registration of Petitioner's Mark, and as Registrant has abandoned its rights in that mark, Petitioner will be damaged if Registration No. 3,746,888 is not cancelled.

WHEREFORE, Petitioner requests that its petition be granted and that Registration No. 3,746,888 be cancelled.

Respectfully submitted,

QUALCOMM INCORPORATED

Dated: September 11, 2013

By:



N. Christopher Norton, Esq.
Anthony D. Peluso, Esq.
Arent Fox LLP
1717 K Street, NW
Washington, DC 20036
(202) 857-6000

Attorneys for Petitioner

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing **Petition for Cancellation** (re R/N 3,746,888) is being served upon Registrant's Domestic Representative, Lawrence E. Abelman of Abelman, Frayne & Schwab, at 666 3rd Avenue, New York, New York 10017-5621, by first class mail, postage prepaid, on September 11, 2013.



Anthony D. Peluso, Esq.
Attorney for Petitioner