

ESTTA Tracking number: **ESTTA563312**

Filing date: **10/04/2013**

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	AktSIONERNO DrouJestvo "Bulgartabac-Holding"		
Entity	JOINT STOCK COMPANY	Citizenship	Bulgaria
Address	"Graf Ignatiev" Str. 62 SOFIA, BG-1000 BULGARIA		

Attorney information	Alexander Lazouski Lazouski & Associates LLC Suite 2C Westwood, NJ 07675 UNITED STATES info@lzlawoffice.com Phone:2016455616
----------------------	---

Registration Subject to Cancellation

Registration No	3277001	Registration date	08/07/2007
Registrant	Kolev, Kolio 2251 Westview Drive Des Plaines, IL 60018 UNITED STATES		

Goods/Services Subject to Cancellation

Class 034. First Use: 2006/12/01 First Use In Commerce: 2006/12/01 All goods and services in the class are cancelled, namely: Cigarettes, cigarette mastercases not of precious metal, cigarette lighters not of precious metal and matchboxes not of precious metal

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

Attachments	PETITION FOR CANCELLATION.pdf(203498 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	/asl/
Name	Alexander Lazouski

Date	10/04/2013
------	------------

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

Aktsionerno Droujestvo "Bulgartabac-Holding",

Petitioner,

v.

Cancellation No.:
Registration No.: 3,277,001
Mark: MM

Kolio Kolev,

Respondent.

PETITION FOR CANCELLATION

Petitioner, Aktsionerno Droujestvo "Bulgartabac-Holding", a Bulgarian-based company at "Graf Ignatiev" Str. 62 BG-1000, Sofia, Bulgaria ("Petitioner"), believes that it will be damaged by continued registration of Registration No. 3,277,001 for the mark MM ("Respondent's Mark") by Kolio Kolev, ("Respondent"), and hereby petitions to cancel same on the basis of (1) Respondent willfully and knowingly perpetrated a fraud in connection with the Serial No. 78/667,240 (Reg. No. 3,277,001), which resulted in its registration and acceptance of Affidavits of Use and Incontestability and (2) use of the mark in the Respondent's Mark never occurred or has been discontinued with no intent to resume use of the Mark.

As grounds for the cancellation, it is alleged that:

1. Petitioner is the largest and oldest manufacturer and exporter of cigarettes ("Petitioner's Goods") from Bulgaria to various countries, including the U.S. Petitioner has been in tobacco business for over 70 years.
2. Petitioner utilizes the MM brand throughout the world as one of its flagship cigarette brands and the MM brand is widely recognized as representing premium quality cigarettes.
3. Consumers seeking products have come to associate the term MM when used in connection with cigarettes with Petitioner's famous brand, in view of extensive use of the term MM by Petitioner in the US market.

4. As a result of the quality of Petitioner's Goods, and the considerable effort Petitioner has expended in promoting its Goods under the Petitioner's Marks, Petitioner's Goods have met with highly favorable acceptance. The Petitioner's Marks have become a well-known symbol of the goodwill and rights associated with the mark.
5. In connection with Petitioner's Mark, Petitioner filed a Request for Extension Of Protection designating the U.S., and such designation was assigned U.S. Trademark Application Serial No. 79/126,279 ("Petitioner's Application").
6. During the examination of Petitioner's Application, the USPTO refused registration due to with likelihood of confusion with the Respondent's mark Registration Reg. No. 3,277,001.
7. According to an Office Action issued in connection with Petitioner's Application, the USPTO believes that the mark in Petitioner's Application so resembles the mark in the Respondent's Mark as to be likely to cause confusion, or to mistake or deceive.
8. Therefore, Petitioner is likely to be damaged by the continued registration of the Respondent's Mark.
9. On information and belief, Respondent, Kolio Kolev, is an Illinois resident with an address of 2251 Westview Drive, Des Plaines, Illinois 60018.
10. Notwithstanding Petitioner's fame of and extensive use of Petitioner's Mark, on July 11, 2005, Respondent filed Application Serial No. 78/667,240 for the mark MM.
11. Respondent's mark matured into registration on Aug. 07, 2007 under U.S. Registration Number 3,277,001 and covers "cigarettes, cigarette mastercases not of precious metal, cigarette lighters not of precious metal and matchboxes not of precious metal" ("Respondent's Goods") in International class 34. Respondent claimed use of Respondent's mark in commerce in connection with Respondent's Goods as early as December 1, 2006.
12. Petitioner's Mark is a famous trademark, is inherently distinctive, and has developed goodwill and a good reputation exclusive to Petitioner. Continued registration of Respondent's Registration will

dilute the distinctiveness of Petitioner's MM Mark by tarnishing the Mark and by blurring the distinctiveness of the Mark.

13. Upon information and belief, Respondent is affiliated with a company USB Corp., which is located at Respondent's address and exports various alcoholic and tobacco products from Europe, mostly from Bulgaria.

14. Upon information and belief, Registrant knew about Petitioner and Petitioner's Mark when filing Respondent's Mark Serial No. 78/667,240 (Reg. No. 3,277,001).

15. Given the identity in marks and the strength of Petitioner's Mark, it is clear that Respondent adopted Petitioner's Mark with the intent of trading upon the goodwill and reputation of Petitioner, thus demonstrating bad faith.

16. On December 25, 2006 Respondent filed a Statement of Use and submitted the following sample of use



17. On December 25, 2016, while filing the Statement of Use for Application Serial No. 78/667,240, Respondent knowingly made a fraudulent statement wherein he claimed "Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The

undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.”

18. Upon information and belief, Respondent fabricated a sample of use or used a picture of Petitioner’s Goods to support a Statement of Use.

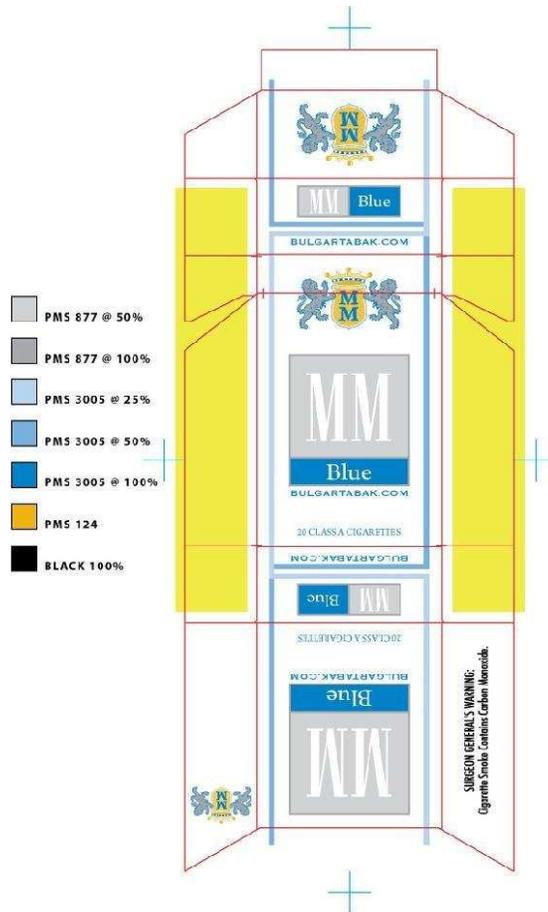
19. Upon information and belief, Respondent did not use Respondent Mark in commerce in connection with the goods covered by the Mark Serial No. 78/667,240 (Reg. No. 3,277,001) during the filing of the Statement of Use.

20. Respondent knowingly made a false, material misrepresentation of fact in connection with Mark Serial No. 78/667,240 (Reg. No. 3,277,001) during the filing of the Statement of Use with intent to commit a fraud against the United States Patent and Trademark Office (“USPTO”).

21. The USPTO relied on the false and fraudulent declaration when it acknowledged the Statement of Use for the Application Serial No. 78/667,240 (Registration No. 3,277,001) and allowed it to be registered.

22. As a result, Respondent willfully and knowingly perpetrated a fraud in connection with the Registration No. 3,277,001.

23. On October 9, 2012 Respondent filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 and submitted the following sample of use



24. Upon information and belief, Respondent fabricated a sample of use to support the Combined Declaration of Use and Incontestability under Sections 8 & 15.

25. On October 9, 2012, while filing the Combined Declaration of Use and Incontestability under Sections 8 & 15, Respondent knowingly made a fraudulent statement wherein it claimed “The mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce. There has been no final decision adverse to the owner's claim of ownership of such mark, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts. The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001,

and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.”

26. Upon information and belief, by October 9, 2012 Respondent did not use Respondent’s Mark in commerce in connection with the goods covered by the Registration No. 3,277,001.

27. Upon information and belief, by October 9, 2012 Respondent’s Mark has not been in continuous use in commerce for five (5) consecutive years after the date of registration in commerce in connection with all of the goods covered by the Registration No. 3,277,001.

28. Respondent knowingly made a false, material misrepresentation of fact in connection with Registration No. 3,277,001 during the filing of the Combined Declaration of Use and Incontestability under Sections 8 & 15 in connection with Respondent mark with intent to commit a fraud against the USPTO.

29. The USPTO relied on the false and fraudulent declaration when it acknowledged the Combined Declaration of Use and Incontestability under Sections 8 & 15 for the Registration No. 3,277,001 and accepted the Combined Declaration.

30. As a result, Respondent willfully and knowingly perpetrated a fraud in connection with the Registration No. 3,277,001.

31. Respondent was not entitled to Registration of the Application Serial No. 78/667,240 (Registration No. 3,277,001) as Respondent knowingly committed fraud when it filed a Statement of Use and a Combined Declaration of Use and Incontestability under Sections 8 & 15.

32. On information and belief, Respondent never used Respondent’s mark in commerce or Respondent is no longer using Respondent’s Mark, having abandoned said mark with no intent to resume use of such mark.

33. According to TBMP §309.03(c)(11), such nonuse of Respondent’s Mark for three consecutive years constitutes prima facie evidence of abandonment.

WHEREFORE, Petitioner prays that the mark of Registration No. 3,277,001 be cancelled, and that this Petition be sustained in favor of Petitioner.

Petitioner has complied with the requirements for filing the petition to the Director by submission of the \$300 petition fee filed herewith.

Respectfully submitted,



Date: October 4, 2013

Alexander S. Lazouski
Lazouski & Associates LLC
157 Third Avenue, Suite 2C
Westwood, NJ 07675
(201) 645-5616

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petition for Cancellation has been served on Respondent's counsel by mailing said copy on October 4, 2013 via First Class Mail, postage prepaid to:

Kolev, Kolio
2251 Westview Drive
DES PLAINES, ILLINOIS 60018
UNITED STATES

Date: October 4, 2013



Alexander S. Lazouski