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Filing date: **01/31/2014**

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	Nick Mascitelli Imports Pty Ltd		
Entity	Proprietary Company	Citizenship	Australia
Address	35-43 Balfour Street Chippendale, NSW 2008 AUSTRALIA		

Attorney information	Nicholas D. Wells Wells IP Law, LLC 299 S. Main St., Suite 1300 Salt Lake City, UT 84111 UNITED STATES nwells@wellsiplaw.com Phone:801-444-7143		
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Registration Subject to Cancellation

Registration No	3930041	Registration date	03/08/2011
Registrant	BRANDO ENTERPRISES, L.P. Dressler & Associates, Inc. LOS ANGELES, CA 90025 GERMANY		

Goods/Services Subject to Cancellation

Class 025. First Use: 2009/10/00 First Use In Commerce: 2009/10/00 All goods and services in the class are cancelled, namely: clothing, namely, shirts, sweatshirts and jackets
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Grounds for Cancellation

The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	Lack of bona fide use in commerce under Trademark Act section 1(d); void ab initio because of assignments made before Statement of Use was filed, per Trademark Act section 10(a).

Related Proceedings	Petition to cancel THE BRANDO, U.S. Reg. No. 3939084 (proceeding number pending)
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Attachments	MARLON BRANDO--Petition to Cancel.pdf(99077 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	/Nicholas Wells/
Name	Nicholas D. Wells
Date	01/31/2014

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

Mark: MARLON BRANDO
Registration No.: 3930041

Nick Mascitelli Imports Pty Ltd	
Petitioner,	
v.	Cancellation No. _____
Brando Enterprises, L.P.,	
Respondent	

PETITION FOR CANCELLATION

In the matter of Trademark Registration No. 3930041 for MARLON BRANDO,
issued March 8, 2011 to Brando Enterprises, L.P.:

Nick Mascitelli Imports Pty Ltd , an Australian Proprietary Company having a
place of business at 35-43 Balfour Street, Chippendale NSW 2008, Australia
("Petitioner"), believes that it will be damaged by the registration issued for the goods
and services therein identified and hereby petitions to cancel the registration of said
trademark. The grounds for cancellation are set forth herein.

1. Petitioner is the owner of the luxury brand BRANDO, which has been
used in Australia for over thirty years.
2. Petitioner is the owner of International Registration 1142443 for
BRANDO for use in connection with "Boot and shoe polish and creams; waxes for

leather” in International Class 03; “Sunglasses/eyewear and accessories thereof; mobile phone cases, covers and accessories thereof” in International Class 09; “Watches, clocks and accessories and parts thereof; jewellery of precious metal” in International Class 14; “Bags; backpacks; shoulder belts and straps; purses and wallets; umbrellas; luggage and travelling trunks” in International Class 18; and “Clothing; footwear; headgear; belts” in International Class 25.

3. Petitioner has expended significant resources in the design, manufacturing and promotion of Petitioner’s luxury goods.

4. Petitioner’s BRANDO mark has become well known and famous as an identifier of Petitioner’s goods.

5. Petitioner has sought registration of its BRANDO mark in New Zealand through the Madrid Protocol under New Zealand IP Number 977908.

6. Petitioner’s application to register its BRANDO mark in New Zealand has been opposed by Respondent, Brando Enterprises, L.P.

7. Respondent’s opposition to Petitioner’s New Zealand application to register its BRANDO mark is based at least in part on the alleged fame of Respondent’s MARLON BRANDO mark, such that Respondent alleges a right to protection of its MARLON BRANDO mark on goods for which, or in geographic regions in which the mark has not been used in commerce.

8. For the reasons set forth in this Petition, Respondent’s United States trademark Reg. No. 3930041 for MARLON BRANDO is void ab initio and invalid.

9. Respondent's invalid United States trademark Reg. No. 3930041 for MARLON BRANDO is a supporting fact in Respondent's efforts to oppose Petitioner's New Zealand trademark application for the mark BRANDO.

10. Cancellation of Respondent's invalid United States trademark Registration No. 3930041 will demonstrate that Respondent's alleged MARLON BRANDO mark is not a famous mark and thus is not entitled to the protection that Respondent has alleged against Petitioner.

11. Petitioner has intentions to extend its sales to the United States and to seek protection for its BRANDO mark in the United States.

12. Cancellation of Respondent's invalid United States trademark Registration No. 3930041 is likely to permit Petitioner to obtain protection for its BRANDO mark in the United States.

13. On August 4, 2004 U.S. trademark application serial number 78462068 was filed under applicant name THE EXECUTORS OF THE MARLON BRANDO ESTATE seeking to register the mark MARLON BRANDO, intended for use in connection with, among numerous other goods and services, "figurines not of precious metal" in International Class 006; "trading cards" in International Class 16; "clothing, namely, shirts, sweatshirts and jackets" in International Class 25; and "historical figure licensing services" in International Class 35 (collectively "Respondent's Goods and Services").

14. In connection with all six classes in the original application serial number 78462068, the filing basis was Section 1(b) of the Trademark Act.

15. On December 11, 2007, the Office issued a Notice of Allowance in relation to application serial number 78462068.

16. On February 27, 2009, the owner of application serial number 78462068 filed an assignment, seeking to assign ownership in application serial number 78462068 from the original applicant, THE EXECUTORS OF THE MARLON BRANDO ESTATE, to THE TRUSTEES OF THE MARLON BRANDO LIVING TRUST. As of that date, no Statement of Use or Amendment to Allege Use was filed for application serial number 78462068.

17. On April 8, 2009, the ostensible owner of application serial number 78462068 filed an assignment, seeking to assign ownership in application serial number 78462068 from THE TRUSTEES OF THE MARLON BRANDO LIVING TRUST to Respondent BRANDO ENTERPRISES, L.P. As of that date, no Statement of Use or Amendment to Allege Use was filed for application serial number 78462068.

18. The “assignments” of the Section 1(b) application that matured into the registration sought to be cancelled herein were both made prior to the filing of a Statement of Use and/or an Amendment to Allege Use, thereby rendering said assignments void and/or invalid.

19. On December 8, 2010, Respondent filed a Statement of Use and corresponding specimens of use in relation to application serial number 78462068 for MARLON BRANDO.

20. By reason of the foregoing two invalid assignments, the Statement of Use in application serial number 78462068 was not filed by the applicant and/or owner of the mark/application sought to be registered.

21. On March 8, 2011, nearly seven years after it was filed, Respondent's alleged MARLON BRANDO mark was registered under U.S. Reg. No. 3930041.

22. By reason of the foregoing, Paragraphs 16 through 20, inclusive, Registration No. 3930041 is void ab initio.

23. Mr. Marlon Brando, Jr. (the "Actor Marlon Brando") was a widely known and respected American stage and screen actor who was born April 3, 1924 and died July 1, 2004.

24. On information and belief, the principals of Respondent control assets originating in the estate of the Actor Marlon Brando.

25. The fame of the Actor Marlon Brando as a person is irrelevant to legal questions regarding trademark usage under the United States Trademark Act.

26. The specimen of use submitted by Respondent on December 8, 2010 as to use of the MARLON BRANDO mark in Class 03 for "figurines not of precious metal" was erroneously accepted by the Examining Attorney because the specimen does not show trademark use of the alleged MARLON BRANDO mark but is merely an ornamental use of the name of the Actor Marlon Brando and thus these words do not function as a trademark, as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

27. The specimen of use submitted by Respondent on December 8, 2010 as to use of the MARLON BRANDO mark in Class 16 for "trading cards" was erroneously accepted by the Examining Attorney because the specimen does not show trademark use of the alleged MARLON BRANDO mark but is merely ornamental use of the name of

the Actor Marlon Brando and thus these words do not function as a trademark, as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

28. The specimen of use submitted by Respondent on December 8, 2010 as to use of the MARLON BRANDO mark in Class 25 for “clothing, namely, shirts, sweatshirts and jackets” was erroneously accepted by the Examining Attorney because the specimen does not show trademark use of the alleged MARLON BRANDO mark but is merely ornamental use of the name of the Actor Marlon Brando and thus these words do not function as a trademark, as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

29. The specimen of use submitted by Respondent on December 8, 2010 as to use of the MARLON BRANDO mark in Class 35 for “historical figure licensing services” was erroneously accepted by the Examining Attorney because the specimen does not show trademark use of the alleged MARLON BRANDO mark but merely describes the historical figure for whom “licensing services” are being provided, namely, the Actor Marlon Brando. Thus, the specimen of use does not show these words functioning as a trademark, as required by §§1, 2, and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, and 1127.

30. The appearance of the likeness of Actor Marlon Brando within every specimen of use submitted by Respondent on December 8, 2010 is further evidence that the term MARLON BRANDO appearing within such specimens is not valid trademark use, but is merely ornamental and/or merely descriptive of the goods or services being sold.

31. On information and belief, Respondent has not sold and does not currently sell any of the goods and services listed in Registration No. 3930041 to consumers located in the United States in a manner that constitutes trademark use of the alleged MARLON BRANDO mark.

32. The alleged mark MARLON BRANDO, when used in connection with the appearance, likeness, or signature of the Actor Marlon Brando, is incapable of serving as an identifier of a “secondary source” and is therefore not registrable on either the Principal Register or the Supplemental Register.

33. Respondent has failed to demonstrate use of the alleged MARLON BRANDO mark in commerce as to any classes within U.S. Reg. No. 3930041.

34. Because Respondent did not file a valid Statement of Use within a thirty-six month period after the issuance date of the notice of allowance for application 78462068, as required under 15 U.S.C. §§1051(d)(1)–1051(d)(2), Respondent’s registration is invalid.

35. The specimens of use submitted by Registrant on December 8, 2010 demonstrate that Respondent’s alleged MARLON BRANDO mark is merely descriptive of its goods and services because the alleged mark describes an “ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services.” T.M.E.P. § 1209.01(b).

36. Because Respondent’s mark merely describes an “ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods or services,” Respondent’s mark is not eligible for registration on the Principal Register under §2(e)(1) of the Trademark Act.

37. As a result of the registration of the mark that is the subject of this petition notwithstanding the two invalid assignments, the lack of bona fide use in commerce of the subject mark in connection with the subject goods and services, and the merely descriptive nature of the alleged mark, Petitioner's ability to obtain protection for its BRANDO mark in the United States and elsewhere is significantly and wrongly impeded.

WHEREFORE, Petitioner prays that Registration No. 3,930,041 be cancelled.

Respectfully submitted,

Dated: Salt Lake City, Utah
January 31, 2014

WELLS IP LAW, LLC

By: /s/Nicholas D. Wells

Nicholas D. Wells
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Salt Lake City, Utah 84111
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Attorney for Petitioner
Nick Mascitelli Imports Pty Ltd

CERTIFICATE OF SERVICE

I hereby certify that on the 31st day of January, 2014, I served a copy of this **PETITION FOR CANCELLATION** on the Respondent, as designated below, by placing said copy in the United States Mail, first class, postage prepaid, addressed as follows:

BRANDO ENTERPRISES, L.P.
DRESSLER & ASSOCIATES, INC.
10390 SANTA MONICA BLVD., #360
LOS ANGELES, CALIFORNIA 90025

Copy to:

Kevin S. Costanza
Seed IP Law Group PLLC
701 Fifth Avenue, Suite 5400
Seattle, WA 98104

By: /s/Nicholas D. Wells

Nicholas D. Wells
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