

ESTTA Tracking number: **ESTTA596109**

Filing date: **04/02/2014**

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	Karen Millen		
Entity	Individual	Citizenship	UNITED KINGDOM
Address	THE LODGE TONBRIDGE ROAD, WATERINGBURY KENT, ME185PA UNITED KINGDOM		

Attorney information	Louis S. Ederer and Laura W. Tejada Arnold & Porter LLP 399 Park Avenue New York, NY 10022 UNITED STATES trademarkdocketing@aporter.com, louis.ederer@aporter.com, laura.tejada@aporter.com, elisabeth.richards@aporter.com Phone:2127151000
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**Registration Subject to Cancellation**

Registration No	3469389	Registration date	07/15/2008
Registrant	KAREN MILLEN FASHIONS LIMITED THE TRIANGLE, STANTON HARCOURT WITNEY, OXFORDSHIRE, GBX EC4A 3WA GBX		

**Goods/Services Subject to Cancellation**

Class 009. First Use: 2005/04/00 First Use In Commerce: 2005/04/00 All goods and services in the class are cancelled, namely: Sunglasses and sunglass frames; cases, namely, cases for sunglasses
Class 035. First Use: 2002/08/00 First Use In Commerce: 2002/08/00 All goods and services in the class are cancelled, namely: Retail store services featuring eyewear and apparel

**Grounds for Cancellation**

Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
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Attachments	Cancellation Petition Against Registration No. 3469389 (KAREN MILLEN in Classes 9 and 35).pdf(149975 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	/Louis S. Ederer/
Name	Louis S. Ederer and Laura W. Tejada
Date	04/02/2014



result of Petitioner's time, effort and success, her name has become closely associated with high quality women's fashion apparel products.

2. In or about 1981, Petitioner began to design a line of women's fashion apparel products under her own name, and started her own company in the UK, namely, KML. Thereafter, in or about 2002, Petitioner's women's fashion apparel products were first sold in commerce in the United States.

3. Subsequently, in or about 2004, Petitioner severed her relationship with KML, and has not been affiliated with KML since that time. Upon information and belief, the Respondent in this proceeding, KMFL, is a successor-in-interest to KML.

4. Upon information and belief, without informing Petitioner, and without her consent, on June 28, 2005, KML filed an application in the United States Patent and Trademark Office ("USPTO") to register the mark KAREN MILLEN in International Classes 9 and 35. In that application, KML represented to the USPTO that the name contained in such mark identified Karen Millen, a living individual, "whose consent to register is submitted." Such purported consent to register, however, was actually a Consent to Use the name Karen Millen that had been executed by Petitioner prior to the filing of, and specifically in reference to a different, earlier application to register the mark KAREN MILLEN in International Classes 18 and 25 (App. Ser. No. 76/129,319), which application was filed on September 18, 2000, at a time when Petitioner was still affiliated with KML. A copy of said Consent to Use is attached as Exhibit A hereto.

5. The aforesaid application to register the Trademark was granted, and on July 15, 2005, a Certificate of Registration issued therefor in International Class 9 (for sunglasses and sunglass frames; cases, namely, cases for sunglasses) and International Class 35 (for retail store services featuring eyewear and apparel).

6. As indicated in the Registration Certificate, the Trademark refers to a living individual, namely, Petitioner. However, and contrary to the record, at no time did Karen Millen, the individual, consent to such registration, or sign any consent to register that particular Trademark, namely, KAREN MILLEN in Classes 9 and 35, or any other trademark for that matter.

7. Notably, in response to a subsequent application filed by KML to register the mark KAREN MILLEN in International Classes 3, 9, 14 and 35, filed on November 12, 2007 (App. Ser. No. 79/048,901), once again, in order to meet the USPTO requirement that a Consent to Register by a living individual must be made of record, KML attempted to rely on the same Consent to Use that it had relied upon in connection with the aforesaid App. Ser. No. 76/129,319. On this occasion, however, the USPTO Examining Attorney correctly refused such application, finding that such Consent to Use was not also a Consent to Register, and that in any event such Consent to Use had been executed years earlier, and had been filed in connection with a different application. Thereafter, following a Final Refusal of such application, and the Denial of a Request for Reconsideration, KML allowed such application to go abandoned. Copies of such Final Refusal and Denial are attached as Exhibit B hereto.

8. Because the Trademark that is the subject of this proceeding refers to a living individual, namely, Petitioner, whose consent to register is required pursuant to Section 2(c) of the Lanham Act, 15 U.S.C. § 1052, and Petitioner has never provided her written consent to register such Trademark, Registration No. 3,459,389 should be cancelled.

9. For all the foregoing reasons, Karen Millen is and will continue to be injured by the registration of the KAREN MILLEN trademark that is the subject of Registration No. 3,459,389.





# **EXHIBIT A**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICANT: : KAREN MILLEN LIMITED  
MARK: : KAREN MILLEN  
SERIAL NUMBER: : N/A  
FILING DATE: : N/A  
Docket No. : 2201.001

DECLARATION UNDER 37 C.F.R. §2.20 FOR CONSENT OF USE OF NAME

That I, Karen Millen, hereby state that I have given my consent to KAREN MILLEN LIMITED to the exclusive and continuous use of my name, indefinitely, for the goods as stated in the above captioned Trademark Application, filed herewith. ✓

That I have been warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S. C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, I declare that the facts set forth in this application, amendment, and declaration are true; that all statements made of my own knowledge are true; and that all statements made on information and belief are believed to be true.

Respectfully submitted,



Karen Millen

Date: 23.08.2005

PRINT

The mark identifies a particular living individual whose consent is of record

# **EXHIBIT B**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 79/048901

**MARK:** KAREN MILLEN

**\*79048901\***

**CORRESPONDENT ADDRESS:**

DECHERT LLP  
160 Queen Victoria Street  
London EC4V 4QQ  
UNITED KINGDOM

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** KAREN MILLEN LTD

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**

N/A

**CORRESPONDENT E-MAIL ADDRESS:**

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:**

**THIS IS A FINAL ACTION.**

This letter responds to applicant's communication filed on 8-28-08. The applicant's amended goods and services descriptions have been accepted and entered in the record. However the Consent form used by applicant is insufficient and must be redone for legal validity.

**CONSENT TO USE AND REGISTER THE NAME**

Applicant has given her consent to Karen Millen, Ltd. to use her name exclusively and continuously. This is an improper consent. Applicant must consent to allow the United States Patent and Trademark Office to use and register the name "KAREN MILLEN."

Applicant must change the entity to whom she gives the consent and the consent must be to the use and registration of the name.

Applicant must submit a proper consent in this matter. This requirement is hereby made FINAL.

## APPROPRIATE RESPONSE TO FINAL REQUIREMENT

If applicant does not respond within six months of the mailing date of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

## INFORMAL COMMUNICATIONS

The most expeditious way to solve disclaimer or goods or services description issues is by informal E-mail or voicemail. The following personal contact information is for applicant's convenience, for trial runs, discussions or solutions involving examiner's amendments.

**Jill C. Alt**

**[jill.alt@uspto.gov](mailto:jill.alt@uspto.gov)**

**(571) 272-9444 (Tel.)**

**(571) 273-9444 (Fax)**

Formal communications must utilize the TEAS system of electronic response or the United States Postal Service.

/Jill C. Alt/

Law Office 114, Tel. (571) 272-9444

Fax. (571) 273-9444

[jill.alt@uspto.gov](mailto:jill.alt@uspto.gov)

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451,

Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/048901

MARK: KAREN MILLEN

CORRESPONDENT ADDRESS:

DECHERT LLP  
160 Queen Victoria Street  
London EC4V 4QQ  
UNITED KINGDOM

  
RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: KAREN MILLEN LTD

CORRESPONDENT'S  
REFERENCE/DOCKET NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

OFFICE ACTION

ISSUE/MAILING DATE:

INTERNATIONAL REGISTRATION NO. 0950616

RECONSIDERATION – CONTINUATION OF FINAL REQUIREMENT: FILE RETURNED  
TO TTAB

The trademark examining attorney has reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the outstanding issue in the final Office action. Accordingly, applicant's request for reconsideration is **denied** and the requirement a proper consent for the Office to use and register the name "KAREN MILLEN" is continued. 37 C.F.R. §2.64(b); TMEP §§715.03, 715.04(a).

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal. TMEP §715.04(a).

/Jill C. Alt/  
Law Office 114, Tel. (571) 272-9444  
Fax. (571) 273-9444  
jill.alt@uspto.gov

**RESPOND TO THIS ACTION:** Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov). For questions about the Office action itself, please contact the assigned examining

attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.