

ESTTA Tracking number: **ESTTA603267**

Filing date: **05/08/2014**

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	Nite Ize, Inc.		
Entity	Corporation	Citizenship	Colorado
Address	5660 Central Avenue Boulder, CO 80301 UNITED STATES		

Attorney information	Robert P. Ziemian PATTON BOGGS LLP 2550 M Street, NW Washington, DC 20037 UNITED STATES IPDocketing@pattonboggs.com, rziemian@pattonboggs.com, tcope@pattonboggs.com Phone:303-894-6330		
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**Registration Subject to Cancellation**

Registration No	4179235	Registration date	07/24/2012
Registrant	MO, ZHANGWEI GROUP 3, TAISHA VILLAGE GUIZHOU PROVINCE,, CHINA		

**Goods/Services Subject to Cancellation**

Class 011. First Use: 2008/10/11 First Use In Commerce: 2010/05/01 All goods and services in the class are cancelled, namely: Aquarium lights; Bicycle lights; Diving-lights; Flashlights; Landscape lightinginstallations; Overhead lamps; Pocket search lights; Safety lamps for underground use; Searchlights; Ultraviolet lamps not for medical purposes; table, floor and street lamps
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**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Petitioner as Basis for Cancellation**

U.S. Registration	1620077	Application Date	02/20/1990
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No.			
Registration Date	10/30/1990	Foreign Priority Date	NONE
Word Mark	NITE IZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1990/02/13 First Use In Commerce: 1990/02/13 HEADBANDS TO BE WORN BY A PERSON AND DESIGNED TO HOLD A FLASHLIGHT		

U.S. Registration No.	2237945	Application Date	07/22/1996
Registration Date	04/13/1999	Foreign Priority Date	NONE
Word Mark	NITE IZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1990/02/13 First Use In Commerce: 1990/02/13 holders for and attachments to flashlights, namely, non-metallic bands for holding a flashlight to a person or to another object; non-metallic connectors for holding a flashlight to a bicycle; cords for attachment to a flashlight for use in carrying a flashlight; non-metallic loops for holding a flashlight; non-metallic holders for carrying a flashlight; non-metallic hand held holders for carrying a flashlight and spare flashlight batteries; non-metallic holsters for carrying a flashlight and spare flashlight batteries; adapters for attaching a fiber optic light element to a flashlight; connectors for holding a flashlight to a helmet; magnetic holders for attaching a flashlight to magnetic or magnetically permeable articles; mouth-piece shaped holders for use in holding a flashlight in the mouth of a person; non-metallic attachments for converting a flashlight to a signal light; non-metallic holders in the shape of a sleeve for holding a flashlight; non-metallic holders in the shape of a sleeve with a combined hand strap for holding a flashlight; non-metallic underwater holders for flashlights; non-metallic underwater holders, including a float, for flashlights; and display racks for holding any or all of the above flashlight holders and attachments		

Attachments	75137013#TMSN.gif( bytes ) NITEYE CANCELLATION.pdf(52191 bytes ) Exhibit A - Flashlight Sets.pdf(339921 bytes ) Exhibit B - Inova.pdf(353656 bytes ) Exhibit C - NITEYE Sales.pdf(1485762 bytes ) Exhibit D - NITEYE (R).pdf(5185949 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 Overnight Courier on this date.

Signature	/Robert P. Ziemian/
Name	Robert P. Ziemian
Date	05/08/2014

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

In re Registration of:

Registrant : MO, ZHANGWEI  
Reg. No. : 4179235  
Mark : NITEYE  
Registration Date : July 24, 2012  
NITE IZE, Inc., :  
Petitioner :  
:  
v. : Cancellation No.  
:  
MO, ZHANGWEI :  
Registrant/Respondent :

Commissioner for Trademarks  
Box TTAB, FEE P.O. Box 1451  
Alexandria, VA 22313-1451

**PETITION TO CANCEL**

1. Petitioner Nite Ize, Inc. ("Petitioner"), a corporation duly organized and existing under the laws of the State of Colorado and having a principal place of business at 5660 Central Avenue, Boulder, CO 80301, believes that it will be damaged by Registration No. 4,179,235 for the mark NITEYE ("NITEYE Mark") and hereby petitions, in accordance with 37 C.F.R. §2.111(b), to cancel said registration. Petitioner owns and uses the mark NITE IZE (the "NITE IZE Mark") in a number of channels of commerce.

2. On information and belief, name and address of the current registrant of the NITEYE Registration is MO, ZHANGWEI ("Respondent"), a Chinese

Corporation with a place of business at CHINA GROUP 3, TAISHA VILLAGE  
NANMING TOWN, JIANHE COUNTY, GUIZHOU PROVINCE, CHINA.

3. The registration and use of the NITEYE Mark is damaging to Nite Ize, Inc. and should be cancelled because there is a likelihood of confusion with the NITE IZE Mark owned by Petitioner, the NITEYE Mark dilutes a famous mark, the Respondent used the NITEYE Mark to trade on the goodwill of Petitioner, and the NITEYE Mark was fraudulently obtained.

4. Petitioner, develops, manufactures and sells innovative products and accessories throughout the United States and internationally. Petitioner has been in continuous business since 1989 and began selling flashlight accessories under the NITE IZE Mark in 1989.

5. Petitioner, is the owner of two registrations for the mark NITE IZE, including registration No. 1,620,077 in international class 025, having a registration date of October 30, 1990 and a date of first use in commerce of February 2, 1990 for “headbands to be worn by a person and designed to hold a flashlight” and registration No. 2,237,945 in international class 011, having a registration date of April 13, 1999 and a date of first use in commerce of February 2, 1990 for “holders for and attachments to flashlights, namely, non-metallic bands for holding a flashlight to a person or to another object; non-metallic connectors for holding a flashlight to a bicycle; cords for attachment to a flashlight for use in carrying a flashlight; non-metallic loops for holding a flashlight; non-metallic holders for carrying a flashlight; non-metallic hand held holders for carrying a flashlight and spare flashlight batteries; non-metallic holsters for carrying a flashlight and spare flashlight batteries; adapters

for attaching a fiber optic light element to a flashlight; connectors for holding a flashlight to a helmet; magnetic holders for attaching a flashlight to magnetic or magnetically permeable articles; mouthpiece shaped holders for use in holding a flashlight in the mouth of a person; non-metallic attachments for converting a flashlight to a signal light; non-metallic holders in the shape of a sleeve for holding a flashlight; non-metallic holders in the shape of a sleeve with a combined hand strap for holding a flashlight; non-metallic underwater holders for flashlights; non-metallic underwater holders, including a float, for flashlights; and display racks for holding any or all of the above flashlight holders and attachments.”

6. These registrations for the NITE IZE Mark have become incontestable as a matter of law under 15 U.S.C. §1065.

7. The NITE IZE Mark has been in continuous use by Petitioner since the date of first use.

8. Petitioner’s use of the NITE IZE Mark and the filing for their registration, both predate the NITEYE Mark.

9. Petitioner's NITE IZE Mark is symbolic of extensive goodwill established by Petitioner, has acquired a high degree of recognition through continued use and expenditures of time, effort and money in advertising and promotion, and serves as a unique identifier of the goods offered by Petitioner.

10. In addition to selling flashlight accessories, Petitioner has sold flashlights under the NITE IZE Mark in combination flashlight sets at least since November 3, 2005. See Exhibit A, which is a copy of a webarchive.com record of Petitioner’s website recorded by webarchive.com on November 3, 2005.

11. At least as early as May 24, 2010, Petitioner began selling INOVA brand flashlights under the NITE IZE Mark. See Exhibit B, which is a copy of a webarchive.com record of Petitioner's website recorded by webarchive.com on May 24, 2010.

12. Respondent's NITEYE Mark is similar to the NITE IZE Mark in that they both use the term "nite" and refer to eyes or eye. The commercial impression that the marks make is very similar.

13. On July 24, 2012, the mark NITEYE was registered with the USPTO. The Application alleged a date of first use in commerce of May 1, 2010. The application for the NITEYE Mark was filed on December 2, 2011.

14. Upon information and belief, on June 3, 2012, Niteyelight Technology Co., Ltd., published the website [www.niteye.com](http://www.niteye.com) and began selling flashlights, bicycle lights, and tactical pens online to the United States. According to the website Niteyelight Technology Co., Ltd. is a brand of JETBeam Ltd. See Exhibit C, which is a copy of a webarchive.com record of the website [www.niteye.com](http://www.niteye.com) recorded by webarchive.com on June 3, 2012.

15. There is no recorded assignment of the NITEYE Mark to Niteyelight Technology Co., Ltd. or JETBeam Ltd. or any other entity. The products sold on the website [www.niteye.com](http://www.niteye.com) include the registration symbol indicating federal registration of the mark NITEYE on packaging shown on the site. See Exhibit D, which is a copy the website [www.niteye.com](http://www.niteye.com).

16. The goods which bear both registered marks are substantially similar. The goods sold under both registered marks are related goods and there would be a

likelihood of confusion for the buying public based on this similarity. The goods sold, namely flashlights, under the common law rights in the NITE IZE Mark are the same as the goods sold, namely flashlights, under the registered mark NITEYE and the sale of flashlights under the NITE IZE Mark predates the sale and filing for registration of the NITEYE Mark.

17. Upon information and belief, Respondent's goods with which it uses the NITEYE Mark, as claimed in Respondent's Application, and the products with which Petitioner uses its NITEYE Mark are offered for sale and are sold through the same channels of trade and offered and sold to the same class of purchasers.

## **COUNT I**

### **LIKELIHOOD OF CONFUSION**

18. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in all of the preceding paragraphs.

19. Petitioner's dates of use of its NITE IZE Mark are prior to the date of filing of Respondent's Application and the date of Respondent's claimed date of first use.

20. The registrations for the NITE IZE Mark are valid and subsisting and are prima facie evidence of Petitioner's exclusive right to use the NITE IZE Mark in commerce on the goods specified in such registrations.

21. In view of the similarity of the respective marks, identical channels of trade and the similar and identical goods offered for sale by the respective parties, Respondent's NITEYE Mark so resembles Petitioner's NITE IZE Mark, previously

used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Respondent's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Petitioner.

22. The NITEYE mark that is subject to Registration No. 4,179,235 is confusingly similar to the NITE IZE Mark, and is likely to cause mistake or to deceive consumers. Accordingly, said registration should be cancelled pursuant to Trademark Act sections 2(d) and 18, 15 U.S.C. §§1052(d), 1068.

## COUNT II

### **RESPONDENT'S MARK DILUTES THE DISTINCTIVE QUALITY OF PETITIONER'S**

#### **FAMOUS MARK**

23. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in all of the preceding paragraphs.

24. Petitioner's above-referenced NITE IZE Mark is valid and subsisting. In addition to the above-referenced trademark registrations, Petitioner also owns two addition registrations for the NITE IZE Mark and common law rights in its other related uses of the NITE IZE Mark and iterations. Among other products and services offered under the NITE IZE Mark, Petitioner currently offers flashlights.

25. Due to Petitioner's long-term use of the NITE IZE mark in the United States, significant public exposure to the NITE IZE Mark as a result of extensive advertising and promotion of that mark, the distinctiveness of the NITE IZE Mark and

other relevant factors, Petitioner's mark NITE IZE has become famous in the United States.

26. Petitioner has been in business since 1989 and is well known. Petitioner's NITE IZE-branded goods are sold at stores such as Target, The Home Depot, Lowes, TrueValue Hardware, etc. Petitioner's NITE IZE-branded goods have been featured in publications such as the Wall Street Journal, House Beautiful, Real Simple, Better Homes and Gardens, Men's Journal, Backpacker Magazine, U.S. News & World Reports, and National Geographic Adventure, among others.

27. Petitioner has extensively offered and promoted its goods under its NITE IZE Mark and devoted substantial resources to promotion and cultivation of the mark and goods under that mark. Due to Petitioner's efforts, the mark NITE IZE enjoys significant goodwill and fame. Petitioner is recognized as a pioneer and a leader in bringing innovative products to market.

28. As a result of Petitioner's exclusive use and promotion of this mark, as well as the renown that this mark enjoys, the mark NITE IZE has become famous. It is widely recognized and associated with Petitioner and Petitioner's products. Petitioner's NITE IZE mark is associated with Petitioner in the minds of the relevant consumers.

29. Customers and other users of Petitioner's NITE IZE goods utilize Petitioner's goods in the area of personal lighting, including flashlights and flashlight accessories. Respondent uses their NITEYE Mark in relation to flashlights which could lead to confusion and mistake. In addition, users of Registrant's NITE IZE goods could believe, mistakenly, that Registrant is associated with, or has approved

or endorsed Respondent's NITEYE goods, which could harm Petitioner's reputation and goodwill, and mislead and deceive consumers.

30. Respondent's use of the NITEYE Mark dilutes Petitioner's famous NITE IZE mark. This dilution is in violation of 15 U.S.C. §§ 1052(a) and (d), and 15 § USC 1125(c). Accordingly, the registration of the NITEYE Mark should be cancelled.

### **COUNT III**

#### **RESPONDENT HAS USED ITS MARK SO AS TO MISREPRESENT THE SOURCE OF ITS GOODS**

31. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in all of the preceding paragraphs.

32. On information and believe, Respondent's use of the NITEYE Mark is part of a scheme by a suit of companies to trade on the goodwill of Petitioner.

33. On information and belief SYSMAX Industry Trading Company produces the flashlights and other goods that are sold by Niteyelight Technology Co., Ltd., Nitecore, and Jetbeam Electronic Technology Co. The marks of NITEYE and NITECORE that these products trade under are specifically calculated to trade on the goodwill of Petitioner due to the similarity of the marks and products.

34. The description of goods in the registration for the NITEYE mark are specifically calculated to obscure the goods that are sold under the NITEYE Mark, which are almost exclusively flashlights. On information and belief, Respondent has never sold many of the products, such as aquarium lights, described in the registration for the NITEYE mark.

35. At least as early as May 24, 2010, Petitioner began selling INOVA brand flashlights under the NITE IZE Mark. On information and belief, SYSMAX Industry Trading Company recognized this sale and in 2011 partnered with Respondent to trade on the goodwill of Nite Ize. On information and belief in 2012, Respondent or related entities began selling online, flashlights similar to the INOVA brand flashlights sold under the NITE IZE Mark.

36. For the above reasons, Respondent has used the mark to misrepresent the source of goods and the NITEYE Mark should be cancelled under Section 14(3).

#### **COUNT IV**

#### **RESPONDENT COMMITTED FRAUD IN THE PROCUREMENT OF ITS REGISTRATION**

37. Petitioner hereby incorporates by reference and realleges each and every allegation set forth in all of the preceding paragraphs.

38. The application for registration of the NITEYE Mark was filed under section 1A, indicating that the Respondent had actually used the mark in commerce. The application indicated that the mark had been used in commerce at least as early as May 1, 2010.

39. On information and belief, the description of goods for the NITEYE mark are specifically calculated to obscure the goods that were sold or were intended to be sold under the NITEYE Mark. Almost exclusively flashlights are sold under the NITEYE Mark.

40. On information and belief, Respondent has never sold nor intended to sell many of the products, such as aquarium lights, described in the registration for the NITEYE mark.

41. On information and belief, the statement related actual use of the mark on goods sold in commerce was false and made intentionally to deceive the Patent and Trademark Office and obscure that the NITEYE Mark would be used primarily with flashlights.

42. On information and belief, the NITEYE Mark was not used in commerce in the United States as early as May 1, 2010.

43. Respondent knowingly made those false and material misrepresentations with the intent to defraud the U.S. Patent and Trademark Office and in order to obtain trademark registrations for the NITEYE Mark.

44. The above false and fraudulent statements constitute fraud and warrant the cancellation of Reg. No. 4,179,235 in toto.

*(Intentionally left blank)*

**WHEREFORE**, MO, ZHANGWEI's NITEYE Mark, Registration No. 4179235, is damaging to Nite Ize, Inc. in that there is a likelihood of confusion with the NITE IZE Mark, the NITEYE Mark dilutes a famous mark, the Respondent used the NITEYE Mark to trade on the goodwill of Nite Ize, Inc., and the NITEYE Mark was fraudulently obtained, and Nite Ize, Inc., accordingly, requests that the instant Petition to Cancel be granted and that the aforesaid registration be cancelled.

The fee required by §2.6(a)(16) is enclosed herewith.

Respectfully submitted,

Patton Boggs LLP

By: /s/ Robert P. Ziemian

Robert P. Ziemian  
1801 California Street  
Suite 4900  
Denver, CO 80202

Dated: May 8, 2014

Attorneys for Petitioner  
Nite Ize, Inc.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this date a true and correct copy of the **Petition to Cancel** was mailed via Federal Express to Respondent, the owner of record, at the correspondence address of record: Anita Yu, 458 Castle Peak Road, Flat F, 23/F, Block 1, Kam Fung Garden, Tsuen Wan, Hong Kong and to the e-mail of record gx6668@yahoo.com.hk.

/Robert P. Ziemian/  
\_\_\_\_\_  
NAME  
Of Counsel for Petitioner, Nite Ize, Inc.

Dated: May 8, 2014\_\_\_\_\_



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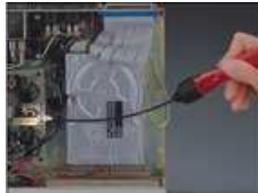
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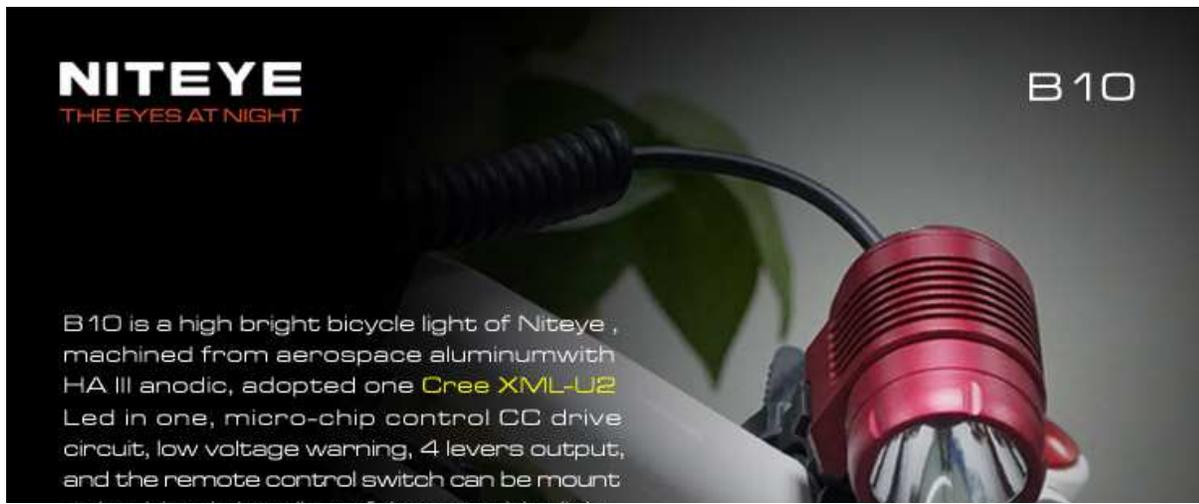
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  - NE01

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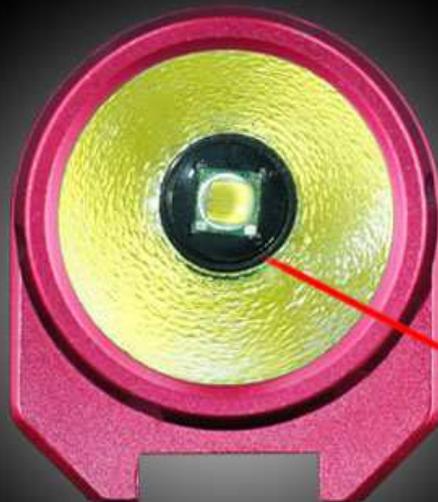
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THE EYES AT NIGHT

B10



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Orange peel reflector for flawless beam,  
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Cree XM-L U2 LED

**NITEYE**  
THE EYES AT NIGHT

B10

regulate button  
power switch



Remote control switch for regulating light safely

1. On and off; long time press power switch
2. High-middle-low models: click regulation button
3. Signal of giving way: click the power switch at ON state

**NITEYE**  
THE EYES AT NIGHT

B10

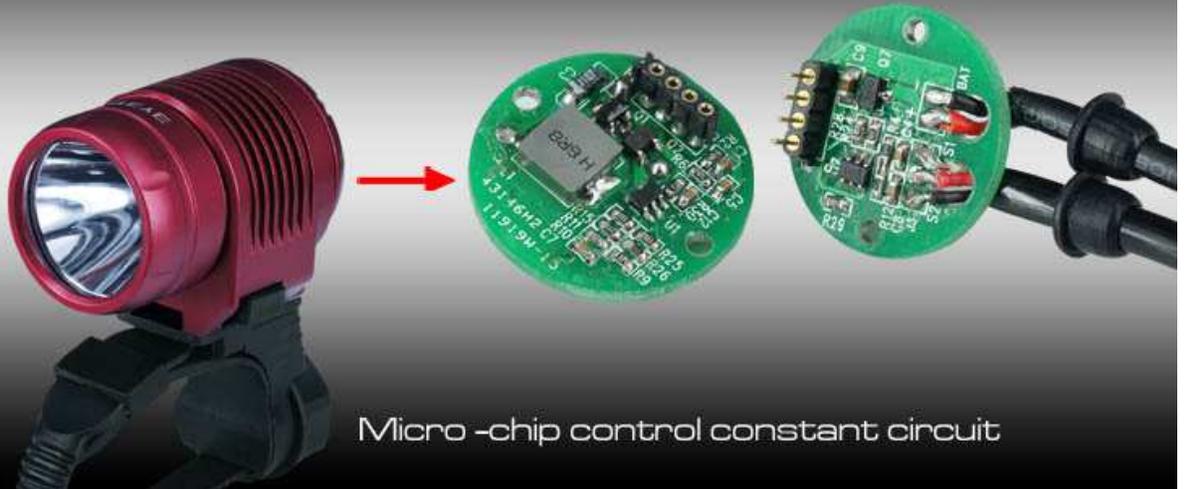




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**NITEYE**  
THE EYES AT NIGHT

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