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Filing date: **06/24/2014**

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	Leonard Cocco		
Entity	Individual	Citizenship	UNITED STATES
Address	1288 Hummel Ave. Holbrook, NY 11741 UNITED STATES		

Attorney information	Angelo Notaro Notaro, Michalos & Zaccaria P.C. 1270 Broadway, Suite 807 New York, NY 10001-3224 UNITED STATES anotaro@notaromichalos.com Phone:(212) 278-8600		
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Registration Subject to Cancellation

Registration No	4544774	Registration date	06/03/2014
Registrants	DOrta, John 54 Windermere Dr. Holbrook, NY 11741 UNITED STATES DePrisco, Patrick 1531 Glendale Ave. N.W. Palm Bay, FL 32907 UNITED STATES Mercado, Richard 4 Snowdance Ln. Nesconset, NY 11767 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2007/05/08 First Use In Commerce: 2007/05/08 All goods and services in the class are cancelled, namely: Entertainment in the nature of Live Musical Group

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Non-use

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LENNY COCCO AND THE CHIMES		
Goods/Services	Entertainment services in the nature of live performances of a singing group		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE CHIMES		
Goods/Services	Entertainment services in the nature of live performances of a singing group		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE ORIGINAL CHIMES		
Goods/Services	Entertainment services in the nature of live performances of a singing group		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LENNY COCCO AND THE ORIGINAL CHIMES		
Goods/Services	Entertainment services in the nature of live performances of a singing group		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LENNY AND THE CHIMES		
Goods/Services	Entertainment services in the nature of live performances of a singing group		

Attachments	J1259-002-PetitionToCancel.pdf(681254 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	/J1259-002-AN-KT/
Name	Angelo Notaro
Date	06/24/2014

since prior to the filing date of Respondents' trademark application for the Registration and, on information and belief, prior to the date of first use of Respondents' trademark The Original Chimes, if said mark has been used by Respondents.

2. In 1959, Petitioner founded a singing group that from 1959 to 1965 provided public entertainment in the nature of live performances of doo-wop songs under the name The Chimes; the group was composed of Leonard Cocco (the Petitioner), Pat McGuire, Richard Mercado, Patrick DePrisco, Joe Croce and John Riccobone.
3. During the years, 1966 to 1969, Leonard Cocco (Petitioner), Joe Croce and Richard Mercado performed as The Chimes.
4. The Chimes did not perform in 1970.
5. From 1971 to 1973, Leonard Cocco (Petitioner), Richard Mercado, John Riccobone and Angelo Diddio performed as The Chimes.
6. In 1973, The Chimes disbanded and no one performed as The Chimes during the following six years.
7. Leonard Cocco, Richard Mercado, Patrick DePrisco and Greg D'Agostino performed as The Chimes from 1980 until 1983 when the group disbanded again.
8. The Chimes did not perform during 1984.
9. In or about 1985, Petitioner organized a singing group and adopted "Lenny Cocco and the Chimes" as a trademark and trade name to designate, promote activities and present live performances as a singing group and musicians.
10. At that time, the members of Lenny Cocco and the Chimes comprising Leonard Cocco (Petitioner), Joseph Locicero, Rocco Marsciano, Joseph Ficarotto, Joseph

Amato, Dennis Cerolia, and Thomas Jelineh, entered into a written agreement by which they acknowledged and agreed, *inter alia*, that Petitioner had the exclusive right to use the name “Chimes” as the name of a band or singing group, that Petitioner could use the name in any manner he deemed appropriate, that Petitioner had the sole right to determine who may be a member of the band, that if he left the band the remaining members agreed to stop using the names “Lenny Cocco and the Chimes” and “The Chimes” unless Petitioner permitted them to do so in writing, and that they would stop using the names “Lenny Cocco and the Chimes” and “The Chimes” or either of these names, unless Petitioner permitted them to do so in writing.

11. For the next twenty-three years, from 1985 to 2008, Petitioner Leonard Cocco arranged for performances by the singing group under the trademark and trade name “Lenny Cocco and the Chimes” in numerous venues including theaters, casinos, night clubs, church halls, on television and other places of entertainment.
12. For the next twenty-three years, from 1985 to 2008, the Petitioner employed the singers and, from time to time, musicians and other persons incident to such performances.
13. For the next twenty-three years, from 1985 to 2008, while the individual performers performing under the trademark and trade name “Lenny Cocco and the Chimes” changed from time to time, all of said performers were engaged by, paid by and performed on behalf of and under the direction and control of, Petitioner as independent contractors.
14. On August 29, 1990, Petitioner filed a trademark application, Trademark Application

74092868, for registration of the trademark THE CHIMES for "Entertainment services in the nature of a music group" and was issued U.S. Trademark Registration 1,653,261 on August 6, 1991.

15. U.S. Trademark Registration 1,653,261 was cancelled on February 9, 1998.
16. On September 13, 1999, Petitioner in partnership with his wife Jennie Cocco filed a trademark application, Trademark Application 75780111, for registration of the trademark THE CHIMES for "Entertainment services in the nature of a music group" and was issued U.S. Trademark Registration 2,582,895 on June 18, 2002.
17. U.S. Trademark Registration 1,653,261 was cancelled on January 25, 2013.
18. Through the Petitioner's efforts, the trademark and trade name "Lenny Cocco and the Chimes" gained recognition as an entertainment group under said name.
19. From 2008 until October 2009, the Petitioner, Patrick DePrisco, Richard Mercado, and John Riccobone (until 2009) performed live entertainment services as a singing group under the trademark "The Original Chimes." Patrick DePrisco, Richard Mercado and John Riccobone were employed as independent contractors by Petitioner and Petitioner paid them and issued IRS 1099 forms to them.
20. From February 2011 to June 2012, the Petitioner, Patrick DePrisco, Richard Mercado and John DOrta performed live entertainment services as a singing group under the trademark "The Original Chimes." Patrick DePrisco, Richard Mercado and John DOrta were employed as independent contractors by Petitioner and Petitioner paid them and issued IRS 1099 forms to them.
21. The Original Chimes disbanded and ceased performing in June 2012.
22. Continuously from August 2012 to the date hereof, Petitioner Leonard Cocco has rendered group performances as "Lenny Cocco and the Chimes" employing Frank

Pionegro, Frank DiBlasi, Pasquale DePrisco (until February 2014) and Angelo Perrone (since February 2014) who have performed with Petitioner, under his direction and control, as a singing group.

23. At all time from 1959 to the present, Petitioner employed the performers who performed in the singing groups under the trademarks "Lenny Cocco and the Chimes," "The Chimes," "Lenny and the Chimes," "Lenny Cocco and the Original Chimes" and "The Original Chimes."
24. For more that fifty years since 1959, Petitioner is and has always been the sole point of contact for bookings of performances of the singing groups performing under the trademarks "Lenny Cocco and the Chimes," "The Chimes," "Lenny and the Chimes," "Lenny Cocco and the Original Chimes" and "The Original Chimes."
25. For more that fifty years since 1959, Petitioner dealt with promoters, he solely selected and arranged for bookings of performances, entered into contracts and received payments for the live entertainment performance services rendered by the singing groups performing under the trademarks "Lenny Cocco and the Chimes," "The Chimes," "Lenny and the Chimes," "Lenny Cocco and the Original Chimes" and "The Original Chimes."
26. For more that fifty years since 1959, Petitioner selected, employed and paid the performers who sang and the musicians who provided music for the performances by the singing groups performing under the trademarks "Lenny Cocco and the Chimes," "The Chimes," "Lenny and the Chimes," "Lenny Cocco and the Original Chimes" and "The Original Chimes."
27. For more that fifty years since 1959, Petitioner determined whether to use CD tracks as background music for the performances, to use a live band, and whether to use

a band of his choice or a band associated with the venue at which the performances took place by the singing groups performing under the trademarks “Lenny Cocco and the Chimes,” “The Chimes,” “Lenny and the Chimes,” “Lenny Cocco and the Original Chimes” and “The Original Chimes.”

28. For more than fifty years since 1959, Petitioner has selected the songs to be performed, the sequence of the songs, and the number of songs to fit the time allotted for the performances by the singing groups performing under the trademarks “Lenny Cocco and the Chimes,” “The Chimes,” “Lenny and the Chimes,” “Lenny Cocco and the Original Chimes” and “The Original Chimes.”
29. For more than fifty years since 1959, Petitioner determined who would be the lead singer for particular songs which were performed by the singing groups performing under the trademarks “Lenny Cocco and the Chimes,” “The Chimes,” “Lenny and the Chimes,” “Lenny Cocco and the Original Chimes” and “The Original Chimes.”
30. For more than fifty years since 1959, Petitioner arranged the choreography and style of the performances, and organized rehearsals for performances by the singing groups performing under the trademarks “Lenny Cocco and the Chimes,” “The Chimes,” “Lenny and the Chimes,” “Lenny Cocco and the Original Chimes” and “The Original Chimes.”
31. Petitioner has acquired and holds a valuable property right and goodwill in the trademark and trade name “Lenny Cocco and the Chimes” by virtue of the services rendered under that trademark and as a trade name and the trademarks “The Chimes,” “Lenny and the Chimes,” “Lenny Cocco and the Original Chimes” and “The Original Chimes.”
32. For more than fifty years, at all times from 1959 to the present, Petitioner Leonard

Cocco has been continuously and closely associated with and recognized by the public and the applicable trade as being the lead performer, founder, organizer, sponsor and source of singing group live entertainment performance services under the trademarks and/or trade names -- "The Chimes," "Lenny and The Chimes," "The Original Chimes," "Lenny Cocco and the Original Chimes" and "Lenny Cocco and The Chimes".

33. That at times in the past, Respondents Richard Mercado, Patrick DePrisco and John DOrta, were members of the performing groups known as The Chimes or The Original Chimes.
34. On April 4, 2013, Respondents filed an intent-to-use trademark application, Trademark Application 86890405, for the Registration of the trademark The Original Chimes ("Respondents' Application").
35. The Respondents' Application contains a declaration that Respondents are "hereby warned that willful false statements and the like so made 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 the application or any resulting registration" and so being warned Respondents declared "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true." Respondents made this declaration to induce the Patent and Trademark Office

- (“PTO”) to issue a registration.
36. On March 6, 2014, Respondents filed a Trademark/Service Mark Statement of Use (“Statement of Use”) in connection with the application for the Registration.
 37. The Statement of Use declared Respondents were “the owner of the mark sought to be registered.” The Respondents made this representation to induce the PTO to issue a registration.
 38. The Statement of Use declared the Respondents were “using the mark in commerce on or in connection with the services.” The Respondents made this representation to induce the PTO to issue a registration.
 39. The Statement of Use declared the “attached specimen(s)” showed “the mark as used in commerce.” The Respondents made this representation to induce the PTO to issue a registration.
 40. Upon information and belief, the Respondents have not performed as, or as part of, The Original Chimes since June 2012 when they performed with Petitioner.
 41. The specimens attached to the Statement of Use did not show current use of the mark by the Respondents.
 42. The specimens were not for performances being provided by the Respondents as of March 6, 2014 but displayed Petitioner Leonard Cocco and the Respondents in advertisements for performances some twenty-two to thirty-four months earlier on the dates of May 14, 2011, February 11, 2012, March 31, 2012 and May 13, 2012.
 43. The Original Chimes mark sought to be registered by Respondent was not in use as of March 6, 2014 and was not being used by Respondents as of March 6, 2014.
 44. The representations made by the Respondents to the PTO on April 4, 2013 and on March 6, 2014 were each false.

45. Respondents knew the representations were false.
46. Respondents knowingly and intentionally made material misrepresentations to the PTO to procure the Respondents' Registration.
47. The Respondents had never solely (without Petitioner) rendered live performance services using "The Original Chimes" mark as of or prior to March 6, 2014.
48. Respondent DOrta was never an original performer in the group The Chimes as misleadingly indicated by Respondents' The Original Chimes mark.
49. In the Statement of Use, the Respondents falsely and knowingly declared that the specimens attached to the Statement of Use were in use, and falsely and intentionally declared that the mark sought to be registered was in use when the Statement of Use was filed, and falsely and knowingly declared that the Respondents were the sole owner of the mark sought to be registered.
50. The false statements of Respondents were made with intent to deceive the PTO.
51. The false statement of Respondents were material statements made to induce the PTO to wrongfully register The Original Chimes in the name of the Respondents.

COUNT I

Likelihood of Confusion

52. Petitioner incorporates by reference the allegations contained in paragraphs 1-51.
53. The Respondents mark "The Original Chimes" so closely resembles the Petitioner's trademarks and trade name Lenny Cocco and the Chimes, and the prior uses of The Chimes, Lenny Cocco and the Chimes, The Original Chimes and Lenny Cocco and the Original Chimes by Petitioner, that when applied to the services identified in the Registration as to be likely to cause confusion, mistake or deception with

respect to the source of origin of the services of the Petitioner, with respect to Petitioner's sponsorship thereof or connection or affiliation therewith, and/or in other ways; and customers and users of Petitioner's services and the public are likely to be confused, mistaken or deceived into believing that the services rendered under "The Original Chimes" mark are produced by, emanate from, or are in some way directly or indirectly associated with or sponsored by Petitioner, to the risk, damage and detriment of Petitioner and the reputation of Petitioner. Accordingly, the Registration should be canceled under the Trademark Act, Section 2(d), 15 U.S.C. § 1052(d).

COUNT II

False Connection

54. Petitioner incorporates by reference the allegations contained in paragraphs 1-53.
55. The Respondents mark The Original Chimes is the same as, or a close approximation of, the trade name and trademarks of the Petitioner and because of Petitioner's priority of use and continuity of use The Chimes, The Original Chimes and Lenny Cocco and the Chimes, the mark would be recognized as such, in that it points uniquely and unmistakably to the Petitioner.
56. The Petitioner is not connected with the Respondent's activities, if any, performed by Respondents under The Original Chimes mark.
57. The fame or reputation of the Petitioner is such that, when The Original Chimes mark is used with the Respondents' services, a connection with the Petitioner would be presumed.
58. The specimens of use of The Original Chimes submitted to the PTO by the

Respondents include pictures of the Petitioner and falsely suggest that Respondents were associated and connected with Petitioner and were used to mislead the PTO and induce the PTO to issue the Registration.

59. Upon information and belief, the Respondents have secured the Registration knowing of the Petitioner's prior trademark and trade name right with intent to trade on the goodwill and reputation of Petitioner's trademarks and trade name and to cause consumers to make a false connection with Petitioner.
60. The Registration suggests a false connection with Petitioner under The Trademark Act, Section 2(a), 15 U.S.C. §1052(a).

COUNT III

Non-Use

61. Petitioner incorporates by reference the allegations contained in paragraphs 1-60.
62. The Respondents have not performed in public since 2012 as The Original Chimes.
63. For an application under Section 1(b), a mark must be in use in commerce as of the filing date of a statement of use to be entitled to registration.
64. For an application under Section 1(b), a mark must be in use in commerce as of the registration date to be entitled to registration.
65. The Respondents were not using The Original Chimes in commerce as of the date of the Statement of Use.
66. The Respondents were not using The Original Chimes in commerce as of the date of the Registration.
67. Respondent's mark does not meet the requirements for registration because upon information and belief, Respondents have not made a bona fide use of

Respondents mark in commerce as is required under § 1(a) of the Trademark Act on or in connection with Respondents' services prior to the filing date of the application for the Registration or the Statement of Use and, thus, the Registration is void.

COUNT IV

Fraudulent Procurement

68. Petitioner incorporates by reference the allegations contained in paragraphs 1-67.
69. The Registration is invalid because Respondents intentionally made false, material representations that Respondents knew to be false.
70. On April 4, 2013, Respondents filed a trademark application for the Registration in which Respondents represented to the PTO that no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive. Respondents made this representation to induce the PTO to issue the Registration.
71. Respondents knew that Petitioner was then currently performing and had been performing, under the trademark and trade name Lenny Cocco and the Chimes, prior to and up until the filing of the Respondent's application on April 4, 2013, singing group entertainment services in the nature of live musical group under the trademark and trade name Lenny Cocco and the Chimes.
72. On May 6, 2014, Respondents submitted a Statement of Use to the PTO in which Respondents represented to the PTO that they were using The Original Chimes

mark in commerce in connection with entertainment in the nature of live musical group. Respondents made this representation to induce the PTO to issue the Registration.

73. On May 6, 2014, Respondents submitted specimens to the PTO in which Respondents represented to the PTO that the specimens showed The Original Chimes mark as used by Respondents in commerce in connection with entertainment in the nature of live musical group. Respondents made this representation to induce the PTO to issue the registration.
74. Respondents were not entitled to obtain the Registration of The Original Chimes mark because the Statement of Use falsely indicated that the mark was in use in commerce when it was not.
75. Respondents were not entitled to obtain the Registration of The Original Chimes mark because the specimens of use submitted to the PTO were not specimens of current use, nor were the specimens use the mark solely by Respondents, and falsely indicated that the specimens were specimens of their current use of the mark when they were not.
76. Respondents are not entitled to obtain the Registration of The Original Chimes mark because they knew of Petitioner's use of the mark at the time of the filing of the application for the Registration and falsely indicated otherwise.
77. Respondents knew that the representations were false and made those representations with the intent to deceive the PTO.
78. The misrepresentations of the Respondents were material misrepresentations.
79. Respondents knowingly and intentionally made material misrepresentations to the PTO to procure the Registration.

80. The PTO relied on the representations of the Respondents in issuing the Registration.
81. The PTO would not have issued the Registration but for Respondents' false representations.
82. Respondents actions in the procurement of the Registration constitutes fraud, thereby invalidating the Registration. Accordingly, the Registration should be canceled in its entirety.

WHEREFORE, Petitioner prays that Registration No. 4,544,774 be cancelled and that this Petition To Cancel be sustained in favor of Petitioner.

Dated: June 24, 2014

Respectfully submitted,

NOTARO, MICHALOS & ZACCARIA P.C.

/s/ Angelo Notaro

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITION TO CANCEL** has been served on Richard Mercado, Patrick DePrisco and John DOrta, Respondents, by mailing said copy on June 24, 2014 via First Class Mail, postage prepaid, to:

Richard Mercado
4 Snowdance Ln.
Nesconset, New York 11767

Patrick DePrisco
1531 Gendale Ave. N.W.
Palm Bay, Florida 32907

John DOrta
54 Windmere Dr.
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Kristin Petro