

ESTTA Tracking number: **ESTTA621507**

Filing date: **08/14/2014**

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	Golestan Co.		
Entity	Iranian Company	Citizenship	Iran
Address	32 Golestan Boulevard Ashrafi Esfahani Expressway Tehran, IRAN, ISLAMIC REPUBLIC OF		
Attorney information	Sepehr Daghighian, Esq. Law Offices of Sepehr Daghighian, P.C. 433 North Camden Drive Fourth Floor Beverly Hills, CA 90210 UNITED STATES sepehr@daghighian.com Phone:3108871333		

**Registrations Subject to Cancellation**

Registration No	4153549	Registration date	06/05/2012
Registrant	MAHALAXMI EXPORTS FZE 7TH FLOOR , 708 , FAIRMONT HOTEL TOWER DUBAI, UNITED ARAB EMIRATES		

**Goods/Services Subject to Cancellation**

Class 030. First Use: 2010/11/15 First Use In Commerce: 2010/11/15 All goods and services in the class are cancelled, namely: Rice; Tea
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**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)
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)
Other	(a) Respondent is not, was not at the time of the filing of its applications for registration, nor has it ever been at any time, the rightful owner of the Registration and/or the marks contained therein. (TBMP Â§ 309.03(c)(7).) (b) Respondent did not have bona fide use of the mark in Registration No. 4,153,549 in commerce prior to the filing of the use-based application. (Trademark Act Â§ 1(a), 15 U.S.C. Â§ 1051(a).)

Registration No	3915265	Registration date	02/01/2011
Registrant	Mahalaxmi Exports FZE Sh. Zayed road Dubai, UNITED ARAB EMIRATES		

## Goods/Services Subject to Cancellation

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Priority and likelihood of confusion	Trademark Act section 2(d)
Other	(a) Respondent is not, was not at the time of the filing of its applications for registration, nor has it ever been at any time, the rightful owner of the Registration and/or the marks contained therein. (TBMP Â§ 309.03(c)(7).) (b) Respondent did not have a bona fide intention to use the mark in Registration No. 3,915,265 with the identified goods as of the filing date. (Trademark Act Â§ 1(b), 15 U.S.C. Â§ 1051(b).)

## Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86366133	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

Attachments	GOLESTAN - Petition for Cancellation (Complaint).pdf(138582 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	/Sepehr Daghighian/
Name	Sepehr Daghighian, Esq.

Date	08/14/2014
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### PETITION

3. Petitioner, Golestan Co. (hereinafter, "**Petitioner**"), by and through its counsel, Sepehr Daghighian, Esq., hereby petitions for the cancellation of United States Trademark Numbers 4,153,549 and 3,915,265 (hereinafter, collectively the "**Registrations**").

4. Petitioner is an Iranian Company having a business address of No. 32 Golestan Boulevard, Ashrafi Esfahani Expressway, Tehran, Iran.

5. Petitioner is a world famous manufacturer of food products including, but not limited to, rice and tea, that markets and sells its products under the "GOLESTAN" trademark all over the world, and currently intends to expand such sales into the United States market.

6. To the best of Petitioner's knowledge, the name and address of the current owner of the Registrations is: Mahalaxmi Exports FZE, Sh. Zayed Road, 708, 7<sup>th</sup> Floor, Fairmont Hotel Tower, Dubai, United Arab Emirates (hereinafter, "**Respondent**").

7. Petitioner has a real interest in this proceeding and reasonably believes that it will be damaged by the entirety of the Registrations because Petitioner has a bona fide intention to use the "GOLESTAN" mark for identical goods, has recently filed an intent-to-use application to register "GOLESTAN" for the same (Application Serial No. 86366133), and therefore believes that registration of its mark(s) will be refused because of Respondent's Registrations.

8. Based upon Petitioner's investigations and findings, the Registrations should be cancelled in their entirety because: (a) there was no bona fide use of the mark in Registration No. 4,153,549 in commerce prior to the filing of the use-based application (Trademark Act § 1(a), 15 U.S.C. § 1051(a)); (b) Respondent did not have a bona fide intention to use the mark in Registration No. 3,915,265 with the identified goods as of the filing date (Trademark Act § 1(b), 15 U.S.C. § 1051(b)); (c) Respondent is not, was not at the time of the filing of its applications for registration, nor has it ever been at any time, the rightful owner of the Registrations and/or the marks contained therein (TBMP § 309.03(c)(7)); (d) Respondent has purposefully used the marks to misrepresent the source of its goods (TBMP § 309.03(c)(15)); (e) Respondent has obtained the Registrations, which undoubtedly comprise matter that falsely suggest a connection with Petitioner (Trademark Act § 2(a)); (f) Petitioner has prior use of the mark in connection with all such goods, and therefore, there is a likelihood of confusion between Petitioner's mark and the Registrations (Trademark Act § 2(a)); and perhaps most egregiously, (g) Respondent committed multiple frauds in the procurement of its Registrations during the prosecution of its applications for registration (TBMP § 309.03(c)(17)).

9. Accordingly, Petitioner prays that the Trademark Trial and Appeal Board cancel United States Trademark Numbers 4,153,549 and 3,915,265 in their entireties.

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**PETITIONER'S STANDING (TBMP § 309.03(b))**

10. Petitioner has a reasonable basis for its belief that it will be damaged by the entirety of the Registrations because Petitioner has a bona fide intention to use the "GOLESTAN" mark for identical goods, has recently filed an intent-to-use application to register "GOLESTAN" for the same (Application Serial No. 86366133), and therefore believes the registration of its mark(s) will be refused because of Respondent's Registrations.

11. Accordingly, Petitioner has standing to file this action (TBMP § 309.03(b)).

**GROUND FOR CANCELLATION**

12. The Registration should be cancelled based upon at least the following grounds:

13. Respondent did not have bona fide use of the mark in Registration No. 4,153,549 in commerce prior to the filing of the use-based application. (Trademark Act § 1(a), 15 U.S.C. § 1051(a).)

14. Respondent did not have a bona fide intention to use the mark in Registration No. 3,915,265 with the identified goods as of the filing date. (Trademark Act § 1(b), 15 U.S.C. § 1051(b).)

15. Respondent is not, was not at the time of the filing of its applications for registration, nor has it ever been at any time, the rightful owner of the Registrations and/or the marks contained therein. (TBMP § 309.03(c)(7).)

16. Respondent has purposefully used the marks to misrepresent the source of its goods. (TBMP § 309.03(c)(15).)

17. Respondent has obtained Registrations which undoubtedly comprise matter that falsely suggest a connection with Petitioner. (Trademark Act § 2(a).)

18. Petitioner has prior use of the GOLESTAN mark in connection with all such goods, and therefore, there is a likelihood of confusion between Petitioner's mark and the Registrations. (Trademark Act § 2(a).)

19. And, most egregiously, Respondent committed multiple frauds in the procurement of the Registrations during the prosecution of its applications for registration. (TBMP § 309.03(c)(17).)

### **ARGUMENT**

20. As identified above, Petitioner is a world famous Iranian Company that manufactures and distributes food products including, but not limited to, rice and tea products.

21. A substantial portion of Petitioner's rice and tea products are marketed and sold under the "GOLESTAN" trademark in numerous countries all over the world.

22. Therefore, Petitioner is the rightful owner of the "GOLESTAN" mark in numerous countries all over the world for including, but not limited to, rice and tea products.

23. Currently, Petitioner is ramping up its efforts and has a bona fide intention to expand its marketing, sales, and distribution of all such products into the United States market.

24. As such, Petitioner intends to register its trademarks, including "GOLESTAN," in the United States for all goods sold under its respective marks.

25. In performing its due diligence prior to obtaining such registrations in the United States, Petitioner engaged counsel to perform a search and clearance of its trademark, "GOLESTAN," among others.

26. During the course of its investigations, counsel discovered that Respondent had filed for and obtained registrations for the trademark, "GOLESTAN," for rice and tea products (United States Registration Numbers 4,153,539 and 3,915,265).

27. Petitioner and its counsel reviewed the Trademark Status & Document Retrieval database for the Registrations and their related applications.

28. Alarming, Petitioner discovered, and is thereby informed, believes, and thereupon alleges, that Respondent submitted pictures of Petitioner's own product as its specimens of use for the Registrations.

29. Therefore, based upon Petitioner's investigations and findings, it is entirely clear that Respondent committed multiple frauds against the United States Patent and Trademark Office in the procurement of the Registrations and during the prosecution of its applications for registration.

30. Namely, Respondent falsely represented that it was the rightful owner of the marks in the Registrations, that it actually used the mark in Registration No. 4,153,549 in commerce prior to the filing of the use-based application, that Respondent had a bona fide intention to use the mark in Registration No. 3,915,265 with rice and/or tea products at the time of filing its application, and most egregiously, that the specimen which it submitted for the Registrations was of its own products.

31. As such, Registrant has purposefully used the marks to misrepresent the source of its goods, and to create a false suggestion of a connection of its Registrations with Petitioner.

32. Currently, Petitioner has a bona fide intention to use the "GOLESTAN" mark in the United States for, *inter alia*, rice and tea products, has recently filed an intent-to-use application to register "GOLESTAN" for the same (Application Serial No. 86366133), and therefore believes the registration of its mark(s) will be refused because of Respondent's Registrations.

33. Nevertheless, Petitioner has prior use of the mark in connection with all such goods, and therefore, there is a likelihood of confusion between Petitioner's mark and the Registrations.

34. Consequently, Petitioner will be unquestionably damaged if the Registrations are not cancelled.

35. What is more, the USPTO and Petitioner have been defrauded by Respondent's conduct because Respondent's materially false representations cannot under any circumstance be considered honest mistakes, erroneous conceptions of rights, negligent omissions, or to have occurred through inadvertence; rather, Respondent's conduct was knowing, intentional, wanton, and performed with a willful intent to deceive.

36. Therefore, the Registrations should be cancelled in their entirety.

### **CONCLUSION**

37. Based upon the foregoing, Respondent committed multiple frauds in the procurement of its Registrations: Respondent did not have a bona fide use of the mark in Registration No. 4,153,549 in commerce prior to the filing of the use-based application; Respondent did not have a bona fide intention to use the mark in Registration No. 3,915,265 with the rice and/or tea products as of the filing date; and, Respondent is not, was not at the time of the filing of its applications for registration, nor has it ever been at any time, the rightful owner of the Registrations and/or the marks contained therein.

38. Furthermore, in filing its specimens of use, Respondent submitted pictures of Petitioner's product claiming it as their own.

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39. Therefore, Petitioner prays that the Trademark Trial and Appeal Board cancel United States Trademark Registration Numbers 4,153,549 and 3,915,265 in their entireties.

Respectfully submitted,

/s/Sepehr Daghighian, Esq.

Sepehr Daghighian, Esq.

August 14, 2014

**Law Offices of Sepehr Daghighian, P.C.**

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**CERTIFICATE OF SERVICE**

I am a Member of the Bar of California, not a Party in the Action, and I hereby certify that I caused to be served on Attorneys for Opposer a true and correct copy of each of the foregoing documents:

**PETITION FOR CANCELLATION**

was served on **August 14, 2014** by U.S. First Class Mail with postage prepaid, in an envelope addressed to:

Mahalaxmi Exports FZE  
Sh. Zayed Road  
708, 7<sup>th</sup> Floor, Fairmont Hotel Tower  
Dubai  
UNITED ARAB EMIRATES

Adam E. Schwartz  
Schwartz Intellectual Property Law, PLLC  
244 5th Avenue, Suite 2157  
New York, New York 10001-7604  
UNITED STATES

I declare under the penalties of perjury of the United States that the foregoing is true and correct.

Executed on **August 14, 2014** at Beverly Hills, California.

/s/Kevin Yaghoubzadeh  
Kevin Yaghoubzadeh