

ESTTA Tracking number: **ESTTA633991**

Filing date: **10/20/2014**

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	RAKUTEN, INC.		
Entity	Corporation	Citizenship	JAPAN
Address	4-12-3 HIGASHI SHINAGAWA, SHINAGAWA-KU TOKYO, JAPAN		

Domestic Representative	C. ANDREW IM, ESQ. IM IP LAW PLLC 29 CHASE ROAD #355 SCARSDALE, NY 10583 UNITED STATES docket@imiplaw.com Phone:3475779480
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**Registration Subject to Cancellation**

Registration No	3936303	Registration date	03/29/2011
Registrant	SUPERPOINTS LLC 5112 KITE TRAIL AUSTIN, TX 78730 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 035. First Use: 2008/10/09 First Use In Commerce: 2008/10/09 All goods and services in the class are cancelled, namely: incentive rewards programs to promote the sale of products and services of others via electronic, optical or wireless communications networks
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**Grounds for Cancellation**

Abandonment	Trademark Act section 14
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	PETITION.pdf(106952 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	/C. ANDREW IM/
Name	C. ANDREW IM

Date	10/20/2014
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 3,936,303  
Mark: SUPERPOINTS  
Registered: March 29, 2011

RAKUTEN, INC.

Petitioner,

v.

SUPERPOINTS LLC

Respondent.

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Cancellation No. \_\_\_\_\_

**PETITION FOR CANCELLATION**

Rakuten, Inc. ("Petitioner"), a company organized and existing under the law of Japan with its principal place of business at 4-12-3 Higashi Shinagawa, Shinagawa-ku, Tokyo, Japan, believes that it is and will be damaged by the continued registration of United States Registration No. 3,936,303 of the mark SUPERPOINTS for "incentive rewards programs to promote the sale of products and services of others via electronic, optical or wireless communications networks" in International Class 35, and, pursuant to Section 14(3) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1064(3), hereby petition to cancel said registration in part for International Class 35.

As grounds for its petition, Petitioner alleges:

1. Petitioner is a world's leading Internet service companies, providing a variety of consumer-focused and business-focused services including e-commerce, eBooks and eReading, travel, banking, securities, credit card, e-money, portal and media, online marketing and professional sports. Petitioner also many successful e-commerce websites under the RAKUTEN mark, such as "www.rakuten.com," "www.rakuten.co.jp," and "global.rakuten.com."

2. The Examining Attorney has rejected Petitioner's Application Serial No. 85/841,852 for RAKUTEN SUPER POINTS and Petitioner's Application Serial No.85/891,651



for the design mark on the basis of likelihood of confusion. Currently, both applications are on appeal.

3. Upon information and belief, SUPERPOINTS LLC (herein "Respondent") is a limited liability company organized under the laws of the State of Delaware, having its principal place of business at 5112 Kite Trail, Austin, Texas 78730.

4. On September 3, 2009, Westlake Products, Inc. ("WESTLAKE") having its principal place of business at 7301 Ranch Road 620 N., Ste. 155-182, Austin Texas, 78726 Respondent filed United States Application Serial No. 77/819,528 ("Application '528") to register the mark SUPERPOINTS for computer software for searching and retrieving information, websites, and other resources on computer networks in International Class 9, promotion of the goods and services of others by incentive rewards program via electronic, optical or wireless communications network; charitable services, namely, promotion of charitable services of others by incentive rewards program via electronic, optical or wireless communications networks in International Class 35, computer services, namely, providing search engines for obtaining data via electronic optical or wireless communications networks in International Class 42, based upon WESTLAKE's alleged use of the mark SUPERPOINTS in commerce since at least as early as October 9, 2008.

5. On February 26, 2010, in response to the Office Action of December 8, 2009, WESTLAKE amended its description of goods and services to as follows: computer search engine software in International Class 9, incentive rewards programs to promote the sale of

products and services of others via electronic, optical or wireless communications networks; charitable services, namely, raising money for environmental organizations, humanitarian organizations, and emergency response organizations through an incentive rewards program via electronic, optical or wireless communications networks in International Class 35, computer services, namely, provision of search engines for the internet for obtaining data via electronic, optical or wireless communications networks in International Class 42.

6. Upon information and belief, WESTLAKE failed to respond to the Office Action of May 12, 2010, thereby resulting in partial abandonment of the Application '528. Specifically, the following services were deleted from the Application '528: charitable services, namely, raising money for environmental organizations, humanitarian organizations, and emergency response organizations through an incentive rewards program via electronic, optical or wireless communications networks in International Class 35.

7. On March 29, 2011, WESTLAKE's United States Application Serial No. 77/819,528 to register the mark SUPERPOINTS for computer search engine software in International Class 9, incentive rewards programs to promote the sale of products and services of others via electronic, optical or wireless communications networks in International Class 35, computer services, namely, provision of search engines for the internet for obtaining data via electronic, optical or wireless communications networks in International Class 42, matured into registration and was assigned United States Registration No. 3,936,303.

8. Upon information and belief, on May 12, 2011, WESTLAKE assigned United States Registration No. 3,936,303 to Respondent and the assignment was recorded with United States Patent and Trademark Office on June 17, 2011 at Reel No. 4564 and Frame No. 0534.

**FIRST BASIS FOR CANCELLATION - ABANDONMENT**

9. Upon information and belief, Respondent is not currently offering incentive rewards programs to promote the sale of products and services of others via electronic, optical or wireless communications networks under the SUPERPOINTS mark.

10. Upon information and belief, Respondent intends not to resume bona fide use of the SUPERPOINTS mark in the ordinary course of trade.

11. Respondent has abandoned the "SUPERPOINTS" mark for incentive rewards programs to promote the sale of products and services of others via electronic, optical or wireless communications networks in International Class 35.

**SECOND BASIS FOR CANCELLATION - MERELY DESCRIPTIVE**

12. The term "superpoints" is merely descriptive because it immediately conveys Respondent's services feature a unit for measuring or counting. Specifically, Respondent identifies its services in International Class 35 as "incentive rewards programs to promote the sale of products and services of others via electronic, optical or wireless communications networks," which immediately conveys units for measuring or counting in relation to incentive rewards.

WHEREFORE, Petitioner prays that Registration 3,936,303 be cancelled in part for International Class 35.

The required fee for instituting this proceeding is included herewith. Please charge any deficiency or refund in the filing fee to Deposit Account No. 50-5354.

Please recognize as attorneys for Petitioner in this proceeding C. Andrew Im (members of the Bar of the State of New York), and the law firm of IM IP LAW PLLC. Please address all correspondence regarding this proceeding to C. Andrew Im at IM IP LAW PLLC, 29 Chase Road #355, Scarsdale, New York, 10583.

Dated: October 20, 2014

Respectfully submitted,

IM IP LAW PLLC

/C. Andrew Im/

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*Attorney for Petitioner  
Rakuten, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the above and foregoing Petition for Cancellation was sent by United States First Class Mail, Postage Prepaid, on October 20, 2014 to:

Westlake Products, Inc.  
7301 Ranch Road 620 N, Ste. 155-182  
Austin, Texas 78726

/C. Andrew Im/

C. Andrew Im

Attorney for Petitioner  
Rakuten, Inc.