

ESTTA Tracking number: **ESTTA643240**

Filing date: **12/08/2014**

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    | Diageo North America, Inc.                            |             |             |
| Entity  | Corporation   | Citizenship | Connecticut |
| Address | 801 Main Avenue<br>Norwalk, CT 06851<br>UNITED STATES |             |             |

|                      |  |  |  |
|----------------------|--|--|--|
| Attorney information | Susan Progoff<br>Dorsey & Whitney LLP<br>51 West 52nd Street<br>New York, NY 10019-6119<br>UNITED STATES<br>ny.trademark@dorsey.com Phone:212.415.9200 |  |  |
|----------------------|--|--|--|

**Registration Subject to Cancellation**

|                                |  |                                 |            |
|--------------------------------|--|---------------------------------|------------|
| Registration No                | 3720977  | Registration date               | 12/08/2009 |
| International Registration No. | NONE   | International Registration Date | NONE       |
| Registrant                     | Fredrik Vikberg<br>GrÅ¶dingevÅ¶gen 26<br>SÅ¶DERTÅ¶LJE, 15270<br>SWEDEN |                                 |            |

**Goods/Services Subject to Cancellation**

|  |
|--|
| Class 003. First Use: 0 First Use In Commerce: 0<br>All goods and services in the class are cancelled, namely: Bleaching preparations for household use; cleaning, polishing, scouring and abrasive preparations for household use; soaps for personal use; perfumery; essential oils for personal use; cosmetics; hair lotions; dentifrices                         |
| Class 018. First Use: 0 First Use In Commerce: 0<br>All goods and services in the class are cancelled, namely: Leather and imitations of leather, and goods made of these materials, namely, trunks, traveling bags and saddlery   |
| Class 025. First Use: 0 First Use In Commerce: 0<br>All goods and services in the class are cancelled, namely: Belts, bathing suits; underwear; infant-wear; jackets; shirts; sweaters; pants;shorts; T-shirts; vests; coats; ties; socks; shoes; athletic shoes; slippers; boots; sandals; hats; caps; head bands; wrist bands (clothing); rainwear; gloves;mittens |
| Class 033. First Use: 0 First Use In Commerce: 0<br>All goods and services in the class are cancelled, namely: Alcoholic beverages except beers  |

**Grounds for Cancellation**

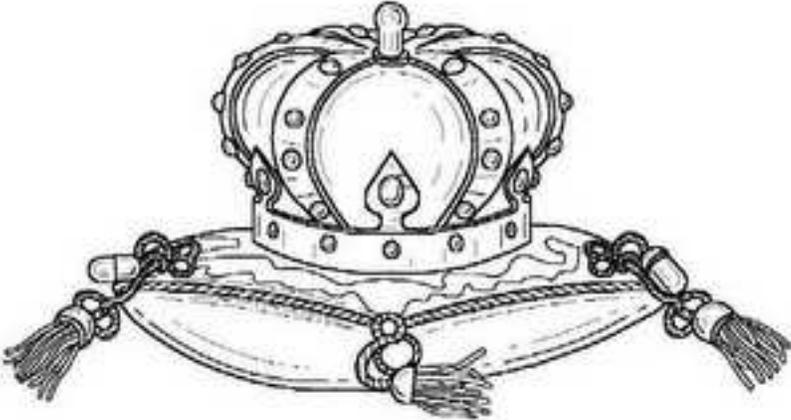
|                                      |                            |
|--------------------------------------|----------------------------|
| Abandonment                          | Trademark Act section 14   |
| Priority and likelihood of confusion | Trademark Act section 2(d) |

|          |                             |
|----------|-----------------------------|
| Dilution | Trademark Act section 43(c) |
|----------|-----------------------------|

Marks Cited by Petitioner as Basis for Cancellation

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 635313  | Application Date      | 01/10/1956 |
| Registration Date     | 10/02/1956  | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL   |                       |            |
| Design Mark           |                               |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 033. First use: First Use: 1954/01/11 First Use In Commerce: 1954/01/11 ALCOHOLIC LIQUORS-NAMELY, WHISKEY |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2094877  | Application Date      | 08/15/1996 |
| Registration Date     | 09/09/1997   | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 033. First use: First Use: 1954/01/11 First Use In Commerce: 1954/01/11        |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
|                       | whisky  |                       |            |
| U.S. Registration No. | 2851028   | Application Date      | 07/08/2003 |
| Registration Date     | 06/08/2004  | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 033. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00<br>Alcoholic beverages namely whiskey |                       |            |
| U.S. Registration No. | 2879432   | Application Date      | 07/08/2003 |
| Registration Date     | 08/31/2004  | Foreign Priority Date | NONE       |
| Word Mark             | NONE  |                       |            |
| Design Mark           |                                  |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 033. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00<br>Alcoholic beverages namely whiskey |                       |            |
| U.S. Registration No. | 3020295   | Application Date      | 08/18/2004 |
| Registration Date     | 11/29/2005  | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL   |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         |   |
| Description of Mark | The mark consists of a bottle design with a label design.  |
| Goods/Services      | Class 033. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 Alcoholic beverages, namely, distilled spirits |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3096261  | Application Date      | 03/29/2002 |
| Registration Date     | 05/23/2006   | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 025. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 Articles of clothing, namely, jackets, caps, pullovers, shirts, T-shirts |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3234379  | Application Date      | 08/18/2004 |
| Registration Date     | 04/24/2007   | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | The mark consists of the stylized wordsCROWN ROYAL.                                  |                       |            |

|                |  |
|----------------|--|
| Goods/Services | Class 025. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00<br>Articles of clothing, namely, jackets, wind resistant jackets, leather jackets, boxer , shirts, golf shirts, polo shirts, knit shirts, tank tops, pants, sleepwear, sweat-shirts, T-shirts, caps, baseball caps, visors, bandanas, hats, aprons, footwear, namely, sandals and flip-flops |
|----------------|--|

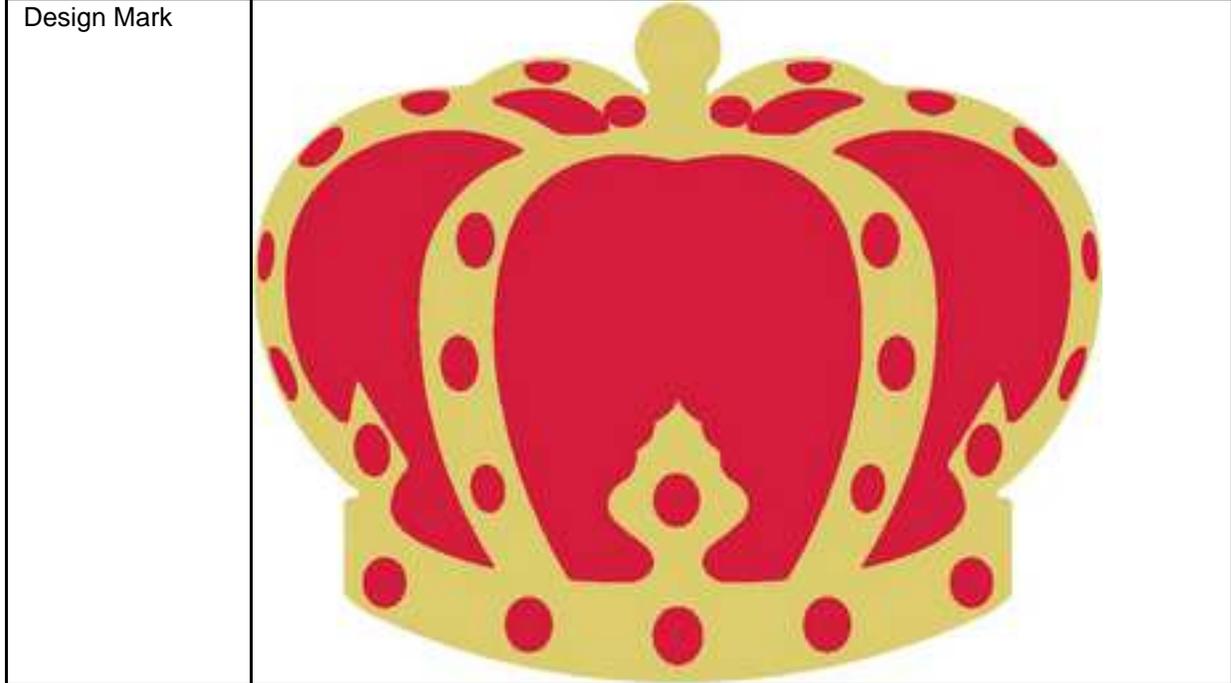
|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3291893  | Application Date      | 10/17/2005 |
| Registration Date     | 09/11/2007   | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL XR   |                       |            |
| Design Mark           |                                    |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 033. First use: First Use: 2006/06/30 First Use In Commerce: 2006/06/30<br>Alcoholic beverages, namely, whisky |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3314727  | Application Date      | 06/28/2006 |
| Registration Date     | 10/16/2007   | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL EXTRA XR RARE  |                       |            |
| Design Mark           |  |                       |            |
| Description of        | NONE   |                       |            |

|                |  |
|----------------|--|
| Mark           |  |
| Goods/Services | Class 033. First use: First Use: 2006/06/30 First Use In Commerce: 2006/06/30 alcoholic beveages, namely, whisky |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3404644    | Application Date      | 06/19/2007 |
| Registration Date     | 04/01/2008 | Foreign Priority Date | NONE       |

|           |      |
|-----------|------|
| Word Mark | NONE |
|-----------|------|



|                     |   |
|---------------------|---|
| Description of Mark | The mark consists of the design of a crown in red and gold. |
|---------------------|---|

|                |   |
|----------------|---|
| Goods/Services | Class 033. First use: First Use: 2006/06/30 First Use In Commerce: 2006/06/30 Alcoholic beverages, namely, whisky |
|----------------|---|

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3506079    | Application Date      | 05/24/2007 |
| Registration Date     | 09/23/2008 | Foreign Priority Date | NONE       |

|           |                         |
|-----------|-------------------------|
| Word Mark | CROWN ROYAL CASK NO. 16 |
|-----------|-------------------------|



|                     |      |
|---------------------|------|
| Description of Mark | NONE |
|---------------------|------|

|                |  |  |  |
|----------------|--|--|--|
| Goods/Services | Class 033. First use: First Use: 2007/09/30 First Use In Commerce: 2007/09/30<br>Alcoholic beverages, namely, whisky |  |  |
|----------------|--|--|--|

|                       |         |                  |            |
|-----------------------|---------|------------------|------------|
| U.S. Registration No. | 3543486 | Application Date | 04/29/2008 |
|-----------------------|---------|------------------|------------|

|                   |            |                       |      |
|-------------------|------------|-----------------------|------|
| Registration Date | 12/09/2008 | Foreign Priority Date | NONE |
|-------------------|------------|-----------------------|------|

|           |      |  |  |
|-----------|------|--|--|
| Word Mark | NONE |  |  |
|-----------|------|--|--|

|             |   |  |  |
|-------------|---|--|--|
| Design Mark |  |  |  |
|-------------|---|--|--|

|                     |      |  |  |
|---------------------|------|--|--|
| Description of Mark | NONE |  |  |
|---------------------|------|--|--|

|                |  |  |  |
|----------------|--|--|--|
| Goods/Services | Class 033. First use: First Use: 2006/06/30 First Use In Commerce: 2006/06/30<br>Alcoholic beverages, namely, whisky |  |  |
|----------------|--|--|--|

|                       |         |                  |            |
|-----------------------|---------|------------------|------------|
| U.S. Registration No. | 3596123 | Application Date | 01/03/2008 |
|-----------------------|---------|------------------|------------|

|                   |            |                       |      |
|-------------------|------------|-----------------------|------|
| Registration Date | 03/24/2009 | Foreign Priority Date | NONE |
|-------------------|------------|-----------------------|------|

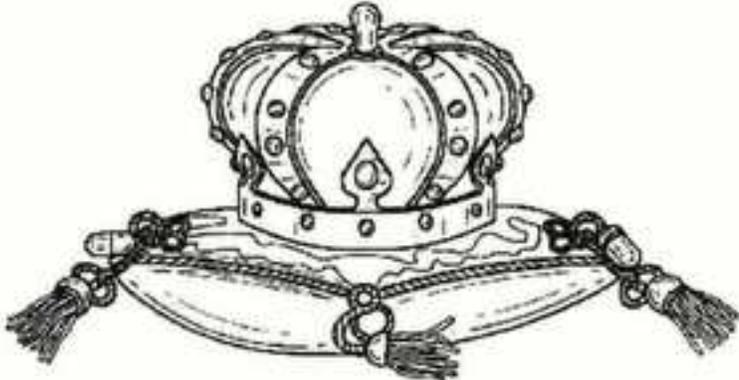
|           |                     |  |  |
|-----------|---------------------|--|--|
| Word Mark | CROWN ROYAL RESERVE |  |  |
|-----------|---------------------|--|--|

|             |  |  |  |
|-------------|--|--|--|
| Design Mark |  |  |  |
|-------------|--|--|--|

|                     |      |  |  |
|---------------------|------|--|--|
| Description of Mark | NONE |  |  |
|---------------------|------|--|--|

|                |   |  |  |
|----------------|---|--|--|
| Goods/Services | Class 033. First use: First Use: 2008/10/00 First Use In Commerce: 2008/10/00 |  |  |
|----------------|---|--|--|

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| Distilled Spirits     |   |                       |            |
| U.S. Registration No. | 3596124   | Application Date      | 01/03/2008 |
| Registration Date     | 03/24/2009  | Foreign Priority Date | NONE       |
| Word Mark             | CROWN ROYAL RESERVE CROWN ROYAL RESERVECRR  |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | The mark consists of the words "CROWN ROYAL RESERVE" along the top and bottom of a circle and the letters "CRR" contained within an inner circle. |                       |            |
| Goods/Services        | Class 033. First use: First Use: 2008/10/00 First Use In Commerce: 2008/10/00 Alcoholic beverages, namely, whisky                                 |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3677830  | Application Date      | 08/18/2004 |
| Registration Date     | 09/01/2009   | Foreign Priority Date | NONE       |
| Word Mark             | NONE   |                       |            |
| Design Mark           |  |                       |            |

|                     |  |
|---------------------|--|
| Description of Mark | The mark consists of a crown and pillowdesign.   |
| Goods/Services      | Class 025. First use: First Use: 2005/10/00 First Use In Commerce: 2005/10/00<br>Articles of clothing, namely, shirts and caps<br>Class 036. First use: First Use: 2005/02/00 First Use In Commerce: 2005/02/00<br>Financial sponsorship of sporting and cultural events |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3703562    | Application Date      | 08/18/2004 |
| Registration Date     | 10/27/2009 | Foreign Priority Date | NONE       |

|           |             |
|-----------|-------------|
| Word Mark | CROWN ROYAL |
|-----------|-------------|

|             |  |
|-------------|--|
| Design Mark |  |
|-------------|--|

|                     |      |
|---------------------|------|
| Description of Mark | NONE |
|---------------------|------|

|                |   |
|----------------|---|
| Goods/Services | Class 025. First use: First Use: 2005/10/00 First Use In Commerce: 2005/10/00<br>Articles of clothing, namely, sweatshirts and hats<br>Class 036. First use: First Use: 2005/02/00 First Use In Commerce: 2005/02/00<br>Financial sponsorship of sporting and cultural events |
|----------------|---|

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4023275    | Application Date      | 09/01/2009 |
| Registration Date     | 09/06/2011 | Foreign Priority Date | NONE       |

|           |                   |
|-----------|-------------------|
| Word Mark | CROWN ROYAL BLACK |
|-----------|-------------------|

|             |  |
|-------------|--|
| Design Mark |  |
|-------------|--|

|                     |   |
|---------------------|---|
| Description of Mark | NONE  |
| Goods/Services      | Class 033. First use: First Use: 2010/03/01 First Use In Commerce: 2010/03/01<br>Alcoholic beverages except beers |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4597345    | Application Date      | 04/16/2014 |
| Registration Date     | 09/02/2014 | Foreign Priority Date | NONE       |

|             |  |
|-------------|--|
| Word Mark   | CROWN ROYAL  |
| Design Mark |  |

|                     |   |
|---------------------|---|
| Description of Mark | NONE  |
| Goods/Services      | Class 033. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00<br>Alcoholic beverages except beers |

|             |   |
|-------------|---|
| Attachments | 72000448#TMSN.png( bytes )<br>75150924#TMSN.png( bytes )<br>78271318#TMSN.png( bytes )<br>78469755#TMSN.png( bytes )<br>78469725#TMSN.png( bytes )<br>78734777#TMSN.png( bytes )<br>78918439#TMSN.png( bytes )<br>77209845#TMSN.png( bytes )<br>77189749#TMSN.png( bytes )<br>77460263#TMSN.png( bytes )<br>77363689#TMSN.png( bytes )<br>77363692#TMSN.png( bytes )<br>78469767#TMSN.png( bytes )<br>78469717#TMSN.png( bytes )<br>77817194#TMSN.png( bytes )<br>86253615#TMSN.png( bytes )<br>Royal Luxury Petition to Cancel.pdf(84161 bytes ) |
|-------------|---|

### 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 | /sp/          |
| Name      | Susan Progoff |
| Date      | 12/08/2014    |



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

In the Matter of

Registration No. : 3,720,977  
Issue Date : December 8, 2009  
Registrant : Fredrik Vikberg  
Mark : ROYAL LUXURY and Crown Design  
International Classes : 3, 18, 25 and 33

----- x

DIAGEO NORTH AMERICA, INC., :  
Petitioner, : Cancellation No.  
v. :  
FREDRIK VIKBERG, :  
Respondent. :

----- x

**PETITION FOR CANCELLATION**

Petitioner, Diageo North America, Inc. (“Diageo”), believes that it is or will be damaged by, and hereby petitions to cancel, Registration No. 3,720,977 of the designation ROYAL LUXURY and Crown Design for the goods for which it is registered in International Classes 3, 18, 25 and 33.

**COUNT I**

1. Petitioner, Diageo North America, Inc., is a Connecticut corporation having its principal place of business at 801 Main Avenue, Norwalk, Connecticut 06851.

2. Upon information and belief, respondent, Fredrik Vikberg, is an individual who is a citizen of Sweden and has an address at Grödingevägen 26, Södertälje, Sweden 15270.

3. Since long prior to November 3, 2008, the priority date of Registration No. 3,720,977, Diageo has been and now is engaged in the business of advertising, offering for sale, selling and distributing a wide range of alcoholic beverages. Among the beverages that Diageo advertises and sells are CROWN ROYAL whiskies, which are sold in bottles that prominently display the CROWN ROYAL trademark and the Crown Design trademark shown below:



Diageo has also used the CROWN ROYAL and Crown Design trademarks on a wide range of other products, such as, for example, lip balm, bags, backpacks, makeup bags, duffel bags, golf bags, briefcases, messenger bags, tote bags, pouches, umbrellas, jackets, capes, caps, dresses, coats, hats, shirts, sweaters, sweatshirts, bandannas, scarves, belt buckles, headbands, visors, aprons, football jerseys, and basketball jerseys.

4. Upon the introduction of Diageo's products so marked upon the market and continuously thereafter, they became and are now well and favorably known to the public and the trade by the CROWN ROYAL and Crown Design trademarks, which have become famous and are closely and universally associated with Diageo and its products as means by which Diageo's products have become known to the public and their source or origin identified.

5. Diageo is the owner of the following registrations of the CROWN ROYAL and Crown Design trademarks in the United States Patent and Trademark Office:

| <u>Registration No.</u> | <u>Issued</u>   |
|-------------------------|-----------------|
| 635,313                 | October 2, 1956 |

|           |                    |
|-----------|--------------------|
| 2,094,877 | September 9, 1997  |
| 2,851,028 | June 8, 2004       |
| 2,879,432 | August 31, 2004    |
| 3,020,295 | November 29, 2005  |
| 3,096,261 | May 23, 2006       |
| 3,234,379 | April 24, 2007     |
| 3,291,893 | September 11, 2007 |
| 3,314,727 | October 16, 2007   |
| 3,404,644 | April 1, 2008      |
| 3,506,079 | September 23, 2008 |
| 3,543,486 | December 9, 2008   |
| 3,596,123 | March 24, 2009     |
| 3,596,124 | March 24, 2009     |
| 3,677,830 | September 1, 2009  |
| 3,703,562 | October 27, 2009   |
| 4,023,275 | September 6, 2011  |
| 4,597,345 | September 2, 2014  |

These registrations are presently outstanding and validly subsisting. In addition, Registration Nos. 635,313, 2,094,877, 2,851,028, 2,879,432, 3,020,295, 3,096,261, 3,234,379, 3,291,893, 3,314,727, 3,404,644, 3,506,079 and 3,543,486 have become incontestable.

6. Upon information and belief, respondent made no use of the designation ROYAL LUXURY and Crown Design in the United States in connection with any of the goods covered by Registration No. 3,720,977 prior to November 3, 2008, the priority date of respondent's application that issued as Registration 3,720,977, and has made no use of that mark in the United States in connection with any of the goods covered by that registration at any time thereafter.

7. The designation respondent has registered, namely, ROYAL LUXURY and Crown Design, so resembles Diageo's trademarks CROWN ROYAL and Crown Design as to be likely, when applied to respondent's goods, to cause confusion or mistake or to deceive by creating the erroneous impression that respondent's goods originate with or come from Diageo or from the same source as Diageo's goods, or that respondent's goods are authorized by Diageo

or are endorsed by Diageo or are sponsored by Diageo or are connected in some way with Diageo or its CROWN ROYAL products.

8. Respondent's adoption and registration of the designation of ROYAL LUXURY and Crown Design was without license, authorization or permission of Diageo.

9. The grant of a registration of ROYAL LUXURY and Crown Design to respondent is contrary to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and violates and diminishes the prior and superior rights of Diageo in its CROWN ROYAL and Crown Design marks.

10. Diageo has been and continues to be damaged by Registration No. 3,720,977 because respondent has obtained statutory rights in the designation ROYAL LUXURY and Crown Design in violation and derogation of the established prior rights of Diageo.

#### COUNT II

11. Diageo repeats and reavers paragraphs 1 through 10 of the Petition for Cancellation.

12. Since long prior to November 3, 2008, the priority date of respondent's Registration No. 3,720,977, Diageo's CROWN ROYAL and Crown Design trademarks have been and are now famous and distinctive of Diageo and its products.

13. The designation respondent has registered, namely, ROYAL LUXURY and Crown Design, is likely to dilute the distinctive quality of Diageo's famous trademarks CROWN ROYAL and Crown Design by lessening the capacity of Diageo's marks to identify Diageo's goods.

14. The grant of a registration of ROYAL LUXURY and Crown Design to respondent is contrary to Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and violates and

diminishes the prior and superior rights of Diageo in its famous CROWN ROYAL and Crown Design trademarks.

COUNT III

15. Diageo repeats and reavers paragraphs 1 through 14 of the Petition for Cancellation.

16. Upon information and belief, respondent has not used, and has no intent to use, in the United States the designation ROYAL LUXURY and Crown Design in connection with any of the goods covered by Registration No. 3,720, 977.

17. Registration No. 3,720,977 has become abandoned and should be cancelled under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3).

WHEREFORE, Diageo prays that its Petition for Cancellation be granted that that Registration No. 3,720,977 be cancelled.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: December 8, 2014

By                   /sp/                    
Susan Progoff

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New York, New York 10019  
Tel.: (212) 415-9200  
E-mail: [ny.trademark@dorsey.com](mailto:ny.trademark@dorsey.com)

Attorneys for Opposer,  
Diageo North America, Inc.

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

In re:  
Registration No.: 3,720,977  
Issue Date: December 8, 2009  
Registrant: Fredrik Vikberg  
Mark: ROYAL LUXURY and Crown Design  
International Class: 3, 18, 25 and 33

DIAGEO NORTH AMERICA, INC.,

Petitioner,

v.

FREDRIK VIKBERG,

Respondent.

Cancellation No.

**CERTIFICATE OF SERVICE**

I hereby certify the foregoing **PETITION FOR CANCELLATION** has been served upon the Respondent by mailing a true copy thereof by Federal Express with Confirmation Copy by Air Mail, postage prepaid addressed to:

Fredrik Vikberg  
Grödingevägen 26  
Södertälje 15270  
Sweden

On the 8th day of December 2014.

\_\_\_\_\_  
/tek/  
Thomas E. Kearney