

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

CME

Mailed: February 17, 2016

Cancellation No. 92061150

Fashion TV Programmgesellschaft mbH

v.

Fashion Television International S.A.

By the Trademark Trial and Appeal Board:

On March 25, 2015, Petitioner filed a petition to cancel Respondent's Registration No. 2945407 for the mark depicted below for "broadcasting programs via a global computer network" and "production and distribution of television programs; and entertainment services in the nature of an ongoing series of television programs concerning commentary, news, history and personalities in the fields of fashion, design trends, photography, art, architecture, music, pop culture, and dance":¹



¹ Issued May 3, 2005.

The registration was technically cancelled on May 4, 2015² based on Respondent's failure to file a declaration of use or excusable nonuse pursuant to Section 8 of the Trademark Act and to renew the registration pursuant to Section 9 of the Trademark Act. Accordingly, on January 14, 2016, the Board issued an order (the "Show Cause Order") allowing Respondent twenty days to show cause why such cancellation should not be deemed to be the equivalent of cancellation by the request of Respondent without the consent of Petitioner, and should not result in entry of judgment against Respondent.

This case now comes up on Respondent's response to the Show Cause Order, filed January 18, 2016.

Trademark Rule 2.134(b) provides that the owner of a trademark registration who has permitted a registration that is the subject of a cancellation proceeding to become cancelled may, "show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent...." If Respondent submits a showing that the cancellation or expiration was the result of an inadvertence or mistake, judgment will not be entered against it. *See C.H. Guenther & Son, Inc. v. Whitewing Ranch Co.*, 8 USPQ2d 1450, 1452 (TTAB 1988) (finding good cause to discharge show cause order where "respondent indicated that 'the failure to renew the subject registration was

² The USPTO did not take the ministerial function of entering the cancellation into the USPTO database until December 4, 2015, but the registration technically expired on the day after its tenth anniversary – May 4, 2015. *Cf. Land O Lakes, Inc. v. Hugunin*, 88 USPQ2d 1957, 1959 (TTAB 2008).

unintentional.”); *Abraham’s Seed v. John One Ten*, 1 USPQ2d 1230, 1232 (TTAB 1986); *see also* TBMP § 602.02(b) (2015).

In response to the Show Cause Order, Respondent asserts that its “failure to file the Declaration of Use and the Application for Renewal was a result of an honest mistake on the part of Respondent’s attorneys.” Response, ¶ 2. More specifically, Respondent explains that: (1) in August 2015, “all legal and trademark-related matters” were transferred to a brand-management organization, *id.* at ¶ 3; (2) the “handover process” was “problematic as Respondent conducts commercial operations in various parts of the world and a large amount of cases needed to be transferred from several different law firms,” *id.* at ¶ 4; (3) “to cope with the influx of work resulting from the handover” Respondent’s brand-management organization “began to hire a completely new legal team which came into being on September 6, 2015,” *id.* at ¶ 5; (4) Respondent’s new legal team “failed to detect that the trademark at issue in this [cancellation] proceeding was part of their portfolio and had an urgent deadline approaching” and Respondent’s previous attorneys did not provide “any indication of the upcoming deadline,” *id.* at ¶ 7; (5) on January 1, 2016, upon learning that the mark was cancelled, “an in depth search was immediately carried out” and the “discrepancies in [the brand-management team’s] records were then discovered,” *id.* at ¶ 9; and (6) Respondent’s brand-management team has “implemented new controls and procedures to ensure that no such oversight is ever repeated.” *Id.* at ¶ 10.

In view of the foregoing, the Board finds that Respondent's failure to file a declaration pursuant to Section 8 of the Trademark Act and to renew the involved registration pursuant to Section 9 of the Trademark Act was the result of inadvertence and mistake. Accordingly, the Show Cause Order is **DISCHARGED**.

Petitioner is allowed until **THIRTY DAYS** from the mailing date of this order to inform the Board whether it wishes to: (1) go forward with the cancellation proceeding to determine the merits of Petitioner's claims; or (2) have the proceeding dismissed, *without* prejudice, as moot because the involved registration has been cancelled. *See* TBMP § 535.

Proceedings otherwise remain suspended.
