

ESTTA Tracking number: **ESTTA667361**

Filing date: **04/17/2015**

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	South Cone, Inc.		
Entity	Corporation	Citizenship	California
Address	5935 Darwin Court Carlsbad, CA 92008 UNITED STATES		

Attorney information	Brooks R. Bruneau FisherBroyles, LLP 100 Overlook Center Second Floor Princeton, NJ 08540 UNITED STATES brooks.bruneau@fisherbroyles.com, docketing@fisherbroyles.com, denise.mcculloch@fisherbroyles.com Phone:609 454-6772
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Registration Subject to Cancellation

Registration No	1980328	Registration date	06/18/1996
Registrant	THE THREE SONS, INC. 902 10TH STREET MILFORD, IA 51351 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 1985/01/01 First Use In Commerce: 1985/01/01 All goods and services in the class are cancelled, namely: clothing; namely, T-shirts, sweatshirts, and sweat pants

Grounds for Cancellation

Abandonment	Trademark Act section 14
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Attachments	South Cone v The Three Sons Cancellation fnl.pdf(106058 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	/brooks r. bruneau/
Name	Brooks R. Bruneau

Date	04/17/2015
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SOUTH CONE, INC.,	:	Cancellation No.:
	:	
Petitioner	:	Registration No.: 1980328
	:	
v.	:	Registration Date: June 18, 1996
	:	
	:	Mark: PHANTOMS
	:	Class: 25
THE THREE SONS, INC.	:	
	:	
Respondent.	:	
	:	
_____	:	

PETITION FOR PARTIAL CANCELLATION

In the matter of U.S. Registration No. 1980328 for the mark PHANTOMS, registered on June 18, 1996 for “clothing; namely, t-shirts, sweatshirts and sweatpants” (hereinafter “Clothing Items”) and owned by The Three Sons, Inc. (hereinafter Respondent).

South Cone, Inc., a corporation of the State of California, with as business address of 5935 Darwin Court, Carlsbad, California 92008 believes it is being damages by the above identified registration and pursuant to 37 C.F.R. §2.111 and 15 U.S.C. §1068, hereby Petitions for Partial Cancellation of that registration on the following grounds:

1. South Cone, Inc. is the owner of United States Trademark Application Serial No. 86188283 for the mark PHANTOM sought to be registered in connection with sandals in Class 25.

2. Registration for PHANTOM by South Cone, Inc. has been refused by the Examining Attorney citing U.S. Registration No. 1980328 for PHANTOMS under Trademark Act Section 2(d).

3. Upon investigation, Respondent does not sell any sandals or any footwear in connection with its PHANTOMS trademark.

4. Investigation has further revealed that all use of PHANTOMS with Respondent's Clothing Items includes the fictitious "University of Okoboji" name or the "Okoboji" geographic name.

5. The term "Phantom" is the subject of multiple United States Trademark Registrations in Class 25 [not including footwear] and accordingly the term must be considered diluted for such goods. In fact the Examiner also cited Registration No. 4000148 for "Phantom" registered in connection with jackets in class 25 as an additional barrier under Trademark Act Section 2(d), which acts as another example of that dilution. Nonetheless, the Examining Attorney for Petitioner's PHANTOM trademark "sandals" application has maintained concern there might be a likelihood of confusion with the PHANTOMS mark registered in connection with Clothing Items.

6. Accordingly, South Cone, Inc. will be damaged by the continued maintenance on the Principal Register of U.S. Registration 1980328 with its current identification of goods that does not accurately identify the goods specified in that registration or identify how the mark is being used in U.S. commerce.

7. The following restriction expressly identifying the nature of the goods being sold and how the mark is used with those goods:

Clothing, excluding sandals, flip flops and footwear, namely t-shirts, sweatshirts and sweatpants that include the fictitious University of

Okoboji name or the Okoboji geographic name used with the mark.
(Cass 25)

will accurately identify the actual use of the PHANTOMS trademark in U.S. Commerce for the goods listed in Registration No. 1980328 and will avoid an erroneous finding of likelihood of confusion with regard to South Cone, Inc.'s PHANTOM trademark application for sandals.

WHEREFORE, pursuant to Trademark Act Section 15 U.S.C. § 1068, Petitioner, South Cone, Inc., requests that Registration No. 1980328 be partially cancelled so the identification of goods expressly limits the goods and restricts the registration as “clothing, excluding sandals, flip flops and footwear, namely, t-shirts, sweatshirts, and sweatpants that include the fictitious University of Okoboji name or the Okoboji geographic name used with the mark” in the records of the U.S. Trademark Office Principal Register.

Respectfully submitted:

SOUTH CONE, INC.

Date: April 17, 2015

BY: /Brooks R. Bruneau/
Brooks R. Bruneau, Esq.
Attorney for Petitioner
FISHERBROYLES, LLP
100 Overlook Center
Second Floor
Princeton, NJ 08540
Tel: 609-454-6772

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Petition to Cancel was electronically filed with the Trademark Trial and Appeal Board this 17th day of April, 2015.

/Brooks R. Bruneau/
(Signature)

04/17/2015
(Date of Signature)

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Notice for Partial Cancellation of Registration No. 1980328 was served upon Respondent's counsel of record, via First Class Mail, postage prepaid, on this 17th day April, 2015, addressed as follows:

EDMUND J SEASE
MCKEE, VOORHEES & SEASE, PLC
801 GRAND AVE STE 3200
DES MOINES, IOWA 50309-2721

SOUTH CONE, INC.

Date: 04/17/2015

BY: /Brooks R. Bruneau/
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