

ESTTA Tracking number: **ESTTA672317**

Filing date: **05/14/2015**

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 parties request to cancel indicated registration.

**Petitioner Information**

Name	Vice Media LLC		
Entity	Corporation	Citizenship	Delaware
Address	90 North 11th Street Brooklyn, NY 11211 UNITED STATES		

Name	Vice Media Canada Inc.		
Entity	Corporation	Citizenship	Canada
Address	127B King Street Montreal, QC H3C2P2 CANADA		

Attorney information	Kimberly B. Herman Sullivan & Worcester LLP One Post Office Square Boston, MA 02109 UNITED STATES kherman@sandw.com, trademark@sandw.com, mpalmisciano@sandw.com, lrobins@sandw.com Phone:617-338-2943		
----------------------	--	--	--

**Registration Subject to Cancellation**

Registration No	3053079	Registration date	01/31/2006
Registrant	Harounian, Kaveh 1500 South Los Angeles Street, # 5 Los Angeles, CA 90015 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 025. First Use: 1994/09/01 First Use In Commerce: 1994/09/01 All goods and services in the class are cancelled, namely: Clothing for men, women, and children, namely, shirts, T-shirts, sport shirts, polo shirts, sweatshirts, sweaters, jerseys, sport coats, pants, jeans, jogging suits, hats, and caps
---

**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	Petition for Cancellation-Vice Media v. Kaveh Harounian(B1874074).PDF(23891 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 First Class Mail on this date.

Signature	/Kimberly B. Herman/
Name	Kimberly B. Herman
Date	05/14/2015

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

In re Registration of:

Registrant: : Kaveh Harounian  
Reg. No. : 3,053,079  
Mark : VICE  
Reg. Date : January 31, 2006

---

VICE MEDIA LLC and VICE MEDIA )  
CANADA INC. )  
Petitioners )  
v. )  
KAVEH HAROUNIAN )  
Registrant/Respondent )

---

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

**PETITION FOR CANCELLATION**

Petitioners Vice Media LLC, a Delaware corporation having a principal place of business at 90 North 11<sup>th</sup> Street, Brooklyn, New York 11211, and Vice Media Canada Inc., a corporation of Canada, having its principal place of business at 127B King Street, Montreal, Quebec H3C2P2 (“Petitioners”), believe that they are damaged by Registration No. 3,053,079 (“079 Registration”) and hereby petition to cancel the same under the provisions of 15 U.S.C. §1064(3). As grounds for cancellation, Petitioners assert with knowledge as to their own affairs and upon information and belief for all other allegations:

1. Petitioners are sister companies and well-known media companies in North American and throughout the world. Petitioners’ products and services include, but are not limited to, event, print, music, online, television, and feature film divisions that operate in over 35 countries.

2. Petitioner, Vice Media Canada Inc. owns the following United States Trademark Registrations and Applications comprised in whole or in part of the word “Vice” (the “VICE MARKS”):

<u>Mark</u>	<u>Registration/Application No.</u>	<u>Registration/Application Date</u>	<u>Class(es)</u>
VICE	2,312,005	January 25, 2000	16
VICE	3,499,169	September 9, 2008	9
VICE	3,687,609	September 22, 2009	43
VICE	3,464,386	July 8, 2008	45
VICE	3,612,483	April 28, 2009	41
VICE	3,391,928	March 4, 2008	35
VICE	3,324,340	October 30, 2007	16
VICE	3,339,714	November 20, 2007	38
VICE (Stylized)	4,652,423	December 9, 2014	9
VICE (Stylized)	4,662,671	December 30, 2014	16
VICE (Stylized)	4,649,171	December 2, 2014	35
VICE (Stylized)	4,625,063	October 21, 2014	38
VICE (Stylized)	4,625,064	October 21, 2014	45
VICE (Stylized)	86/264,850	April 29, 2014	43
VICE (Stylized)	4,662,675	December 30, 2014	41
VICE FILMS	86/513,963	January 26, 2015	41
VICELAND	86/615,884	April 30, 2015	9, 38, 41

3. Petitioner, Vice Media LLC is a U.S. LLC and uses the VICE MARKS in the United States pursuant to intercompany agreements with Vice Media Canada, Inc. and the parent company of Petitioners, Vice Holding Inc.

4. Registrant is an individual and resident of California, living at 1500 South Los Angeles Street, #5, Los Angeles, California 90015 (the “Registrant”).

5. On October 23, 2003, Registrant filed an application to register the mark VICE (as a standard character mark) under Section 1(a) of the Lanham Act, 15 U.S.C. §1051(a), for “clothing for men, women, and children, namely shirts, T-shirts, sport shirts, polo shirts, sweaters, sweatshirts, sweaters, jerseys, sport coats, pants, jeans, jogging suits, hats, and caps,” and claiming a date of first use of September 1, 1994.

6. On February 23, 2015, Registrant filed with the U.S. Trademark Office a Combined Declaration of Use and Application for Renewal under Sections 8 and 9 in which Registrant claimed that his mark is in use in interstatecommerce in connection with all of the goods listed in the registration.

**First Basis for Cancellation - Abandonment**

7. Registrant claims that he began offering the clothing items listed in the '079 Registration under the mark VICE on September 1, 1994.

8. Registrant does not currently sell any of the clothing items listed in the '079 Registration, and has not sold such items for at least the three years preceding the filing date of this Petition.

9. Registrant intends not to resume bona fide use of the VICE mark in the ordinary course of trade.

10. Registrant has abandoned the "VICE" mark.

**Second Basis for Cancellation - Fraud**

11. On February 23, 2015, Registrant filed with the U.S. Trademark Office a Combined Declaration of Use and Application for Renewal under Sections 8 and 9 which included a sworn declaration signed under penalty of perjury by Registrant.

12. Registrant swore that Registrant was, as of February 23, 2015, using the VICE trademark "in commerce on or in connection with all goods or services listed in the existing registration for this specific class . . .". Such statement was false at the time that it was made.

13. In support of its February 23, 2015 Combined Declaration of Use and Application for Renewal under Sections 8 and 9, Registrant attached a specimen of use consisting of a photograph of a T-shirt, the sale of which had already been discontinued by Registrant.

14. As of February 23, 2015, Registrant was not using the VICE trademark in commerce on any of the items listed in the '079 Registration.

15. As of February 23, 2015, Registrant has not used the VICE trademark in commerce for at least the preceding three years and perhaps longer.

16. Registrant knew that its statement regarding use of the VICE trademark was false at the time such statement was made.

17. Registrant knew that the specimen of use that it submitted on February 23, 2015 was not a current specimen showing Registrant's current use of the VICE trademark at that time.

18. The U.S. Patent and Trademark Office relied upon Registrant's material false statement and false specimen in allowing the renewal of the registration of the VICE mark. The U.S. Patent and Trademark Office would not have allowed Registration No. 3,053,079 to remain valid absent Registrant's knowingly false statement and false specimen.

**WHEREFORE**, Petitioners pray that Registration No. 3,053,079 be cancelled pursuant to 15 U.S.C. §§ 1064(3) because (1) The VICE trademark has been abandoned by Registrant, and (2) the Registration has been maintained via fraudulent representations to the U.S. Patent and Trademark Office.

Respectfully submitted,

VICE MEDIA LLC and VICE MEDIA CANADA INC.

By their attorneys,

Dated: May 14, 2015

/s/ Lawrence R. Robins  
Lawrence R. Robins, Esq.  
Michael S. Palmisciano, Esq.  
SULLIVAN & WORCESTER LLP  
One Post Office Square  
Boston, MA 02109  
Tel: 617.338.2800  
Fax: 617.338.2880  
[lrobins@sandw.com](mailto:lrobins@sandw.com)  
[mpalmisciano@sandw.com](mailto:mpalmisciano@sandw.com)

**CERTIFICATE OF SERVICE**

Pursuant to C.F.R. § 2.11, I hereby certify that a true and correct copy of the foregoing Petition for Cancellation was served, marked first class mail, postage prepaid, on Respondent, at the following address:

William C. Steffin, Esq.  
Steffin Lelkes Azod LLP  
1801 Century Park East, 24th Floor  
Century City, California 90067

/s/ Lawrence R. Robins  
Lawrence R. Robins, Esq.