

ESTTA Tracking number: **ESTTA688428**

Filing date: **08/07/2015**

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	Kosher Supervision Service, Inc.		
Entity	Corporation	Citizenship	New Jersey
Address	201 The Plaza Teaneck, NJ 07666 UNITED STATES		

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Entity	Corporation	Citizenship	New Jersey
Address	201 The Plaza Teaneck, NJ 07666 UNITED STATES		

Attorney information	Michael R. Friscia McCarter & English, LLP Four Gateway Center, 100 Mulberry Street Newark, NJ 07102-4056 UNITED STATES mfriscia@mccarter.com, crodrigue@mccarter.com, dpopovic@mccarter.com Phone: 973-848-8308		
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Registration Subject to Cancellation

Registration No	3830599	Registration date	08/10/2010
Registrant	Steinberg, Yoel 1823 53rd Street Brooklyn, NY 11204 UNITED STATES		

Goods/Services Subject to Cancellation

Class A. First Use: 2002/11/03 First Use In Commerce: 2009/07/22 All goods and services in the class are cancelled, namely: Meats, cured meats, slaughterhouse products, meat distribution center products, poultry, fish, restaurant menu items; Bakery products, specialty baked goods, packaged baked goods, snacks, vending machines items; Vegetarian products, vegan products, natural or organic food products, ethnic and cultural cuisine items, specialty coffees, vegetables, salads, fruit and decorative fruit arrangements; Milk, Dairy products and cheeses, Ice cream products and frozen deserts
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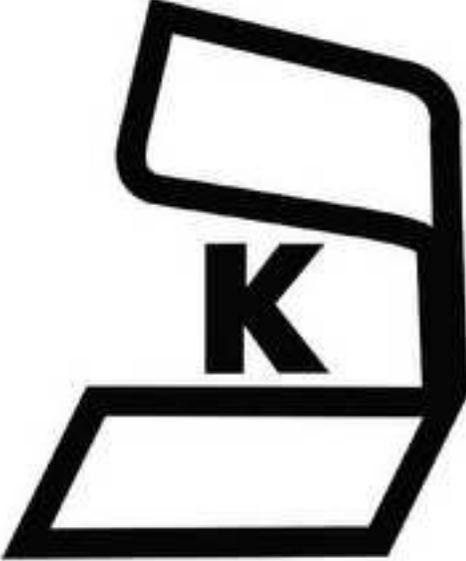
Grounds for Cancellation

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.	927067	Application Date	04/21/1971
Registration Date	01/11/1972	Foreign Priority Date	NONE
Word Mark	K		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class A. First use: First Use: 1971/04/01 First Use In Commerce: 1971/04/01 FOOD		

U.S. Application No.	86713509	Application Date	08/03/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	K		

Design Mark	
Description of Mark	The mark consists of K and the Hebrew letter kof.
Goods/Services	<p>Class A. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00</p> <p>kosher foods, beverages and food products; breath freshening sprays; breath freshening strips; essential oils; capsules for medicines; chemical preparations for pharmaceutical purposes; chemical preparations for medical purposes; chemical preparations for veterinary purposes; drugs for medical purposes; medicines for human purposes; nutritional supplements; vitamin preparations; cleaning, polishing, scouring and abrasive preparations; agricultural chemicals, except fungicides, herbicides, insecticides and parasiticides; artificial sweeteners; bacteriological preparations for acetification; bacteriological preparations other than for medical and veterinary use; biological preparations, other than for medical or veterinary purposes; chemical substances for preserving foodstuffs; chemical reagents, other than for medical or veterinary purposes; chemical preparations for smoking meat; chemical additives for oils; chemicals for the manufacture of pigments; color-brightening chemicals for industrial purposes; emulsifiers; enzyme preparations for the food industry; enzymes for industrial purposes; enzymes for the food industry; filtering preparations for the beverages industry; filtering materials; flocculants; gelatine for industrial purposes; glucose for industrial purposes; glucose for the food industry; gluten for the food industry; gluten for industrial purposes; meat tenderizers for industrial purposes; oil-bleaching chemicals; oil-purifying chemicals; oil-separating chemicals; oils for the preservation of food; pectin for the food industry; preparations for stimulating cooking for industrial purposes; preservatives for pharmaceutical preparations; for the separation of greases; water-purifying chemicals; water-softening preparations</p>
Attachments	<p>72389770#TMSN.png(bytes) 86713509#TMSN.png(bytes) Petition to Cancel.pdf(336013 bytes)</p>

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	/Michael R. Friscia/
Name	Michael R. Friscia
Date	08/07/2015

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

In the Matter of Trademark Registration No.: 3,830,599

For the Mark:



Registration Date: August 10, 2010

KOSHER SUPERVISION SERVICE,)
INC. and KOSHER SUPERVISION)
SERVICES INC.)

Petitioner,)

v.)

YOEL STEINBERG D/B/A)
CUPK KOSHER SUPERVISION)

Respondent.)

CANCELLATION NO.

PETITION FOR CANCELLATION

Kosher Supervision Service, Inc. and Kosher Supervision Services Inc.¹ (collectively, “Petitioner”) believes that it is or will be damaged by U.S. Trademark Registration No. 3,830,599 (the “Registration”) as set forth herein and hereby petitions to cancel the Registration.

As grounds for this Petition, Petitioner alleges that:

1. Petitioner is a corporation of the State of New Jersey with its principal place of business at 201 The Plaza, Teaneck, New Jersey 07666.

¹ Kosher Supervision Service, Inc. and Kosher Supervision Services Inc. are the same entity. Kosher Supervision Services Inc. is the owner name listed on U.S. Registration No. 927,067 but this name contains a typographical error. Petitioner intends to file a request to correct the owner name on U.S. Registration No. 927,067 to Kosher Supervision Service, Inc.

2. Upon information and belief, as set forth in the records of the U.S. Patent and Trademark Office, Yoel Steinberg d/b/a CupK Kosher Supervision (“Respondent”), is the owner of the Registration and has a place of business at 1823 53rd Street, Brooklyn, New York 11204.

3. Petitioner is the owner of U.S. Registration No. 927,067 for the certification mark

K (and Design), , for “food,” in U.S. Class A, which claims a first use date of April 1, 1971.

Petitioner also owns U.S. Application No. 86/713,509 for the certification mark K (and Design),



, for “kosher foods, beverages and food products; breath freshening sprays; breath freshening strips; essential oils; capsules for medicines; chemical preparations for pharmaceutical purposes; chemical preparations for medical purposes; chemical preparations for veterinary purposes; drugs for medical purposes; medicines for human purposes; nutritional supplements; vitamin preparations; cleaning, polishing, scouring and abrasive preparations; agricultural chemicals, except fungicides, herbicides, insecticides and parasiticides; artificial sweeteners; bacteriological preparations for acetification; bacteriological preparations other than for medical and veterinary use; biological preparations, other than for medical or veterinary purposes; chemical substances for preserving foodstuffs; chemical reagents, other than for medical or veterinary purposes; chemical preparations for smoking meat; chemical additives for oils; chemicals for the manufacture of pigments; color-brightening chemicals for industrial purposes; emulsifiers; enzyme preparations for the food industry; enzymes for industrial purposes; enzymes for the food industry; filtering preparations for the beverages industry; filtering materials; flocculants; gelatine for industrial purposes; glucose for industrial purposes; glucose for the food industry; gluten for the food industry; gluten for industrial purposes; meat tenderizers for industrial purposes; oil-bleaching chemicals; oil-purifying chemicals; oil-

separating chemicals; oils for the preservation of food; pectin for the food industry; preparations for stimulating cooking for industrial purposes; preservatives for pharmaceutical preparations; for the separation of greases; water-purifying chemicals; water-softening preparations,” in U.S. Class A, which was filed on August 3, 2015, and which claims a first use date of 1972. Petitioner’s U.S. Registration No. 927,067 and Petitioner’s U.S. Application No. 86/713,509 are collectively referred to herein as “Petitioner’s Marks.”

4. Petitioner’s Marks, which consist of the letter K and the Hebrew letter “kof,” are referred to in spoken language as “Kof K.”

5. Since at least as early as April 1, 1971, Petitioner’s Mark  has been used continuously by third parties authorized by Petitioner to use this mark to certify the Kosher quality of food. Since at least as early as 1972, Petitioner’s Mark  has been used continuously by third parties authorized by Petitioner to use this mark to certify the Kosher quality of food and other products covered by this mark.

6. By reason of third parties’ extensive promotion, advertising and provision of high-quality goods in connection with Petitioner’s Marks for over 40 years, the public and the trade have come to recognize goods offered in connection with Petitioner’s Marks as signifying Petitioner and its stringent standards for certifying that goods meet the highest standards of Kosher law.

7. Notwithstanding Petitioner’s extensive prior rights in Petitioner’s Marks, Respondent, on July 31, 2009, filed an application for the certification mark K (and Design),



, (“Respondent’s Mark”), namely, U.S. Application Serial No. 77/794,539, for “Meats,

cured meats, slaughterhouse products, meat distribution center products, poultry, fish, restaurant menu items; Bakery products, specialty baked goods, packaged baked goods, snacks, vending machines items; Vegetarian products, vegan products, natural or organic food products, ethnic and cultural cuisine items, specialty coffees, vegetables, salads, fruit and decorative fruit arrangements; Milk, Dairy products and cheeses, Ice cream products and frozen deserts,” in U.S. Class A, and obtained the Registration for Respondent’s Mark on the Principal Register on August 10, 2010, which was assigned U.S. Registration No. 3,830,599.

8. In its Registration, Respondent asserts a first use date of November 3, 2002, and a first use in commerce date of July 22, 2009.

9. Upon information and belief, Respondent’s Mark is referred to in spoken language as “Cup K,” and the Registration states, “[t]he mark consists of a cup along with the letter ‘K.’”

10. Respondent also owns U.S. Registration No. 3,883,012 for the service mark CupK, for “Inspecting food establishments for the purpose of certifying the kosher quality thereof; Inspecting foods for the purpose of certifying the kosher quality thereof,” in International Class 42. In its registration for this service mark, Respondent asserts a first use date of November 3, 2002, and a first use in commerce date of July 22, 2009.

11. Petitioner’s Marks were first used in April 1971 and 1972. These dates are long prior to the date when Respondent filed its application, and long prior to the date that Respondent alleges Respondent’s Mark was first used. Therefore, at the time Respondent sought to register Respondent’s Mark, Petitioner’s Marks were already in use in the United States.

COUNT ONE

LIKELIHOOD OF CONFUSION

12. Petitioner repeats and realleges each and every allegation set forth in paragraphs 1 through 11.

13. Respondent's Mark is similar in appearance, sound and commercial impression to Petitioner's Marks, particularly in light of the similarity in sound between "Cup K," which is how Respondent's Mark is referred to in spoken language, and "Kof K," which is how Petitioner's Marks are referred to in spoken language.

14. Respondent's Mark is used on or in connection with goods in Class A that are identical or similar to the goods on or in connection with which Petitioner's Marks are used.

15. Goods on or in connection with which Respondent's Mark is used are promoted and sold or offered for sale to the same or similar customers in the same or similar channels of trade as the customers to which and channels of trade in which goods on or in connection with which Petitioner's Marks are used are promoted and sold.

16. In view of the similarity between Petitioner's Marks and Respondent's Mark, the related nature of the goods on or in connection with which the marks of the respective parties are used, and the related nature of the customers and channels of trade for these respective goods, Respondent's Mark so resembles Petitioner's Marks previously registered in the United States and not abandoned, as to be likely to cause confusion, or to cause mistakes and deceive.

17. In fact, actual confusion has already occurred between Respondent's Mark and Petitioner's Marks, due in part to the similarity in sound between "Cup K" and "Kof K."

18. If Respondent is permitted to continue to own the Registration, confusion in the trade resulting in damage and injury to Petitioner will continue to be caused and will result by

reason of the similarity between Respondent's Mark as reflected in the Registration and Petitioner's Marks. Accordingly, consumers will associate Respondent's Kosher certifications, and the goods in connection with which Respondent's Mark is used, with Petitioner's Kosher certifications, and the goods in connection with which Petitioner's Marks are used, and identify Respondent's Kosher certifications as being provided or endorsed by, or otherwise affiliated with, Petitioner.

19. The continued registration of Respondent's Mark would be contrary to Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), and violate or diminish the prior and superior rights of Petitioner in Petitioner's Marks.

20. Petitioner has been damaged by Respondent's Mark and will continue to be damaged if the Registration continues to exist because Respondent, through its Registration, has obtained rights in Respondent's Mark in violation and derogation of Petitioner's established prior rights.

COUNT TWO

DILUTION

21. Petitioner repeats and realleges each and every allegation set forth in paragraphs 1 through 20.

22. In view of the strength and distinctiveness of Petitioner's Marks, the duration and extent of third parties' use and advertising of Petitioner's Marks as authorized by Petitioner, the nationwide use of Petitioner's Marks, and the degree of recognition of Petitioner's Marks, Petitioner's Marks have become famous, and were famous prior to the filing date for Respondent's Mark and prior to Respondent's first use of Respondent's Mark.

23. Respondent's Mark is likely to cause, and will cause, dilution of the distinctive value of Petitioner's Marks under Section 43(c) if the Lanham Act, as amended, 15 U.S.C. § 1125(c).

WHEREFORE, Petitioner prays that Registration No. 3,830,599 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Respectfully submitted,

Dated: August 7, 2015

By:



MICHAEL R. FRISCIA
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4 Gateway Center
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Attorneys for Petitioner

CERTIFICATE OF SERVICE UNDER 37 CFR §§ 2.111

I hereby certify that the foregoing Petition for Cancellation of Registration No. 3,830,599 has been served via first class mail upon the Respondent on August 7, 2015, at the Respondent's address as reflected in the records of the U.S. Patent & Trademark Office, as follows:

Yoel Steinberg
DBA CupK Kosher Supervision
1823 53rd Street
Brooklyn, New York 11204

Date: August 7, 2015

A handwritten signature in blue ink, appearing to read "Sarah R. Quinn", written over a horizontal line.