

ESTTA Tracking number: **ESTTA775925**

Filing date: **10/11/2016**

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 | HEALTHY SHOWER LLC DBA SONAKI SHOWER SYSTEMS | | |
| Entity | Limited Liability Company | Citizenship | Texas |
| Address | 14121 West HWY 290, Bldg 2 Ste B Austin, TX 78737 UNITED STATES | | |

| | | | |
|----------------------|--|--|--|
| Attorney information | Renee L. Duff Renee L. Duff, P.C. One Chase Road Scarsdale, NY 10708 UNITED STATES tms@rldpc.com Phone:914-723-7418 | | |
|----------------------|--|--|--|

Registration Subject to Cancellation

| | | | |
|-----------------|---|-------------------|------------|
| Registration No | 4928436 | Registration date | 03/29/2016 |
| Registrant | UBS INC CO., LTD. Yeonsu Prugio 3rd Complex Yeonsu-gu, Incheon, 406-818 KOREA, REPUBLIC OF | | |

Goods/Services Subject to Cancellation

Class 011. First Use: 2013/04/17 First Use In Commerce: 2015/10/06
All goods and services in the class are cancelled, namely: Shower filters

Grounds for Cancellation

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|--------------------------------------|---------------------------------------|
| Priority and likelihood of confusion | Trademark Act Sections 14(1) and 2(d) |
|--------------------------------------|---------------------------------------|

Mark Cited by Petitioner as Basis for Cancellation

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|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 87134920 | Application Date | 08/11/2016 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | SONAKI | | |

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|---------------------|--|
| Design Mark | <h1>SONAKI</h1> |
| Description of Mark | NONE |
| Goods/Services | Class 011. First use: First Use: 2004/01/01 First Use In Commerce: 2004/01/01 Shower heads; Water filters |

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|-------------|--|
| Attachments | 87134920#TMSN.png(bytes) SONAKI Cancellation Petition.pdf(57086 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 | /RLD/ |
| Name | Renee L. Duff |
| Date | 10/11/2016 |

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

In the Matter of Trademark Registration:

Reg. No. 4,928,436
Registrant: UBS INC CO., LTD.
Filed: October 29, 2014
Issued: March 29, 2016
Mark: **VITAMAX (SONAKI SHOWER FILTER)**

| | | |
|----------------------------|---|----------------------------|
| _____ |) | |
| HEALTHY SHOWER LLC |) | |
| DBA SONAKI SHOWER SYSTEMS, |) | |
| |) | |
| <i>Petitioner,</i> |) | Cancellation No. _____ |
| |) | |
| v. |) | Registration No. 4,928,436 |
| |) | |
| UBS INC CO., LTD. |) | |
| |) | |
| <i>Respondent.</i> |) | |
| _____ |) | |

PETITION FOR CANCELLATION

Petitioner, Healthy Shower LLC DBA Sonaki Shower Systems, (“Petitioner”), a domestic limited liability company duly organized and existing under the laws of the state of Texas, having a business address located at 14121 West HWY 290, Bldg 2 Ste B Austin, Texas 78737, believing it will be damaged by the continued registration of **VITAMAX (SONAKI SHOWER FILTER)** as a trademark in International Class 011 for “shower filters” (“the Subject

Goods”), as shown in Reg. No. 4,928,436 (“the Cited Registration”), hereby petitions to cancel the Cited Registration pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064.

To the best of Petitioner’s knowledge, the name and address of Registrant is as follows:

UBS INC CO., LTD.
Yeonsu Prugio 3rd Complex
No. 705, 302-dong, 218, Meonugeum-ro
Yeonsu-gu, Incheon REPUBLIC OF KOREA, 406-818

As grounds in support of its petition for cancellation, Petitioner asserts as follows:

1. On October 29, 2014, UBS INC CO., LTD. (“Registrant”) filed an Intent-to-Use application, Serial No. 86438132, to register the mark **VITAMAX (SONAKI SHOWER FILTER)**, for use with "shower filters" in International Class 011.

2. On January 6, 2016, Registrant filed a statement of use, alleging a date of first use of the mark of April 17, 2013 and a date of first use in interstate commerce of October 6, 2015. Registrant also submitted a specimen of use consisting of packaging for the goods.

3. On March 29, 2016, the United States Patent and Trademark Office issued Registrant U.S. Registration No. 4,928,436 for **VITAMAX (SONAKI SHOWER FILTER)**, with "shower filter" disclaimed. The goods covered by the Cited Registration are “shower filters.”

4. On August 11, 2016, Petitioner filed a U.S. trademark application under Section 1(a) for Serial No. 87134920 in for the mark **SONAKI** for use in connection with "shower heads; water filters" in International Class 011 ("the Pending Application").

5. Petitioner alleged in the Pending Application that its **SONAKI** mark has been in use for the goods cited as of an alleged first use and first use in commerce date at least as early as January 1, 2004, which is over eleven (11) years before Registrant began using its **VITAMAX (SONAKI SHOWER FILTER)** mark in interstate commerce on October 6, 2015.

6. Petitioner, as the party with priority to use the **SONAKI** mark or anything likely to cause confusion therewith (i.e. **VITAMAX (SONAKI SHOWER FILTER)**) and who is competing for the same consumers as the Registrant, has standing to file this Petition for Cancellation as Petitioner is being injured and will continue to be injured by the Cited Registration.

7. Based on the foregoing, Petitioner asserts the following grounds for cancellation of the Cited Registration:

COUNT I-PRIORITY OF USE

8. Petitioner hereby incorporates by reference Paragraphs 1 through 7 as if fully stated herein.

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9. On information and belief, Registrant does not have any basis for claiming rights in the mark **VITAMAX (SONAKI SHOWER FILTER)** prior to Petitioner's first use and first use in interstate commerce date at least as early as January 1, 2004.

10. Petitioner's date of first use of the **SONAKI** mark, at least as early as January 1, 2004, predates the October 29, 2014 filing date of the **VITAMAX (SONAKI SHOWER FILTER)** mark by more than ten (10) years, and also predates Registrant's alleged date of first use in commerce on October 6, 2015 by more than eleven (11) years.

11. Thus, Petitioner has priority of use of the **SONAKI** mark based on its earlier use in commerce and because Petitioner has prior use, the Cited Registration should be cancelled.

COUNT II-LIKELIHOOD OF CONFUSION

12. Petitioner hereby incorporates by reference Paragraphs 1 through 11 as if fully stated herein.

13. Registrant's mark, **VITAMAX (SONAKI SHOWER FILTER)**, is similar to Petitioner's **SONAKI** mark, and is likely, when applied to Registrant's goods, to cause confusion, mistake, or deception among consumers within the meaning of 15 U.S.C. §1052(d).

14. Registrant's goods ("shower filters") are identical or nearly identical to Petitioner's goods ("shower heads; water filters") such that they would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of consumers.

15. Registrant's use of the mark **VITAMAX (SONAKI SHOWER FILTER)** in connection with its goods is likely to cause confusion, mistake, or deception as to the source of the origin of Registrant's goods in the public, in the trade and others are likely to believe that Registrant's goods are: (a) the same goods as those Petitioner's; or (b) provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Petitioner and/or its goods.

16. If Registrant is permitted to maintain the Cited Registration for the Subject Goods, confusion within the relevant trade and public is likely to result, which will result in damage to Petitioner's business. Such belief of damages by Petitioner is reasonable under the circumstances.

17. Because Registrant has been granted a registration for the Cited Registration on the Principal Register, it has obtained a *prima facie* exclusive right to use the **VITAMAX (SONAKI SHOWER FILTER)** mark which will damage Petitioner's business because Petitioner has been using the **SONAKI** mark in good faith with its goods for over eleven (11) years prior to Registrant's claimed first use date in commerce.

18. Therefore, under Section 2(d), Registrant's use of the mark is likely to cause confusion with Petitioner's use of the **SONAKI** mark and because Petitioner has prior use, the Cited Registration should be cancelled.

WHEREFORE, Petitioner requests that this Petition for Cancellation be sustained and the Cited Registration (U.S. Reg. No. 4,928,436) be cancelled in all respects.

Dated this 11th day of October, 2016.

Respectfully submitted,



By:

Renée L. Duff, Esq.
Attorney for Petitioner, NY bar member

Renée L. Duff, P.C.
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Scarsdale, New York 10583
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Email: tms@rldpc.com

CERTIFICATE OF MAILING AND SERVICE

I certify that on October 11, 2016, a copy of the foregoing PETITION FOR CANCELLATION is being electronically submitted to:

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

I certify that on October 11, 2016, a copy of the foregoing PETITION FOR CANCELLATION is being served via first class mail and submitted electronically to Registrant's

Correspondent/Attorney of Record:

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By:



Renée L. Duff, Esq.
Attorney for Petitioner, NY bar member