

ESTTA Tracking number: **ESTTA871760**

Filing date: **01/18/2018**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Chardan Capital Markets LLC		
Entity	limited liability company	Citizenship	New York
Address	17 State Street, Suite 1600 New York, NY 10004 UNITED STATES		

Attorney information	William R. Samuels SCARINCI HOLLENBECK, LLC 3 Park Avenue, 15th Floor New York, NY 10016 UNITED STATES Email: ip@sh-law.com Phone: 2122860747		
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Registration Subject to Cancellation

Registration No.	5343914	Registration date	11/28/2017
Registrant	Cardan Capital Partners LLC Suite 640 100 Saint Paul Street Denver, CO 80206 UNITED STATES		

Goods/Services Subject to Cancellation


Class 036. First Use: 2015/11/06 First Use In Commerce: 2015/11/06 All goods and services in the class are subject to cancellation, namely: Financial services, namely, investment fund transfer and transaction services, investment security services, estate settlement services; wealth management services; investment services, namely, financial asset allocation, cash flow management, investment consultation, and investment management services; trust and estate financial administration services and estate planning consultation; financial risk management consultation; financial advisory and consultancy services; advice relating to investments and wealth management
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	4048647	Application Date	03/18/2011
Registration Date	11/01/2011	Foreign Priority	NONE

		Date	
Word Mark	CHARDAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2004/05/18 First Use In Commerce: 2004/05/18 Financial services, namely, investment banking services, public and private equity financing, financial restructuring, and the trading of financial instruments, securities, shares, equities, options, and other products in the U.S. and overseas markets; information, advisory, consultancy, and research services relating to finance and investments		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	CHARDAN CAPITAL MARKETS		
Goods/Services	, financial services, namely, investment banking services, public and private equity financing, financial restructuring, and the trading of financial instruments, securities, shares, equities, options, and other products in the U.S. and overseas markets; information, advisory, consultancy, and research services relating to finance and investments		

Attachments	85271255#TMSN.png(bytes) Cancellation Reg. No. 5343914 1.17.18.pdf(180354 bytes) Exhibit A.pdf(103317 bytes) Exhibit B.pdf(59182 bytes)
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Signature	/William R. Samuels/
Name	William R. Samuels
Date	01/18/2018

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

Chardan Capital Markets LLC)	
)	Registration No.:
)	5343914
)	
Petitioner,)	Registration Date:
)	November 28, 2017
)	
v.)	Mark:
)	CARDAN CAPITAL
Cardan Capital Partners LLC)	PARTNERS
)	
Registrant)	Cancellation No. _____

PETITION TO CANCEL

Chardan Capital Markets LLC (the “Petitioner”) believes that it is being damaged by the continued registration of U.S. Trademark Registration No. 5343914 (the “CARDAN CAPITAL PARTNERS Registration”) owned by Cardan Capital Partners LLC (the “Registrant”) for the mark CARDAN CAPITAL PARTNERS (the “CARDAN CAPITAL PARTNERS Mark”), and hereby petitions to cancel the same. As grounds for its Petition to Cancel, Petitioner alleges the following.

Chardan Capital Markets LLC and the CHARDAN CAPITAL MARKETS Mark

1. Petitioner is a New York Limited Liability Company having a principal place of business at 17 State Street, Suite 1600, New York, New York 10004.
2. Petitioner has owned, maintained, and developed strong US common law rights in the mark CHARDAN CAPITAL MARKETS (“CHARDAN CAPITAL MARKETS Mark”) for use in providing financial services.

3. Petitioner continuously used the mark CHARDAN CAPITAL MARKETS Mark in interstate commerce since at least as early as 2001 in connection with a number of Class 36 services, namely, financial services, namely, investment banking services, public and private equity financing, financial restructuring, and the trading of financial instruments, securities, shares, equities, options, and other products in the U.S. and overseas markets; information, advisory, consultancy, and research services relating to finance and investments.

4. Upon information and belief, the CHARDAN CAPITAL MARKETS Mark is inherently distinctive with enhanced distinctiveness through extensive use of the mark and promotion of Petitioner's services. Petitioner has established and developed strong proprietary common law trademark rights in the CHARDAN CAPITAL MARKETS Mark on or in connection with financial services, long prior to November 6, 2015, the claimed first use date, and May 31, 2016, the filing date of the CARDAN CAPITAL PARTNERS Registration.

5. When applied to the Registrant's services, the CARDAN CAPITAL PARTNERS Mark is likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Registrant with the CHARDAN CAPITAL MARKETS Mark as to the origin of the goods and services specified in the CARDAN CAPITAL PARTNERS Registration under Section 43(a) of the Lanham Act, as amended 15 U.S.C. §1125(a).

Chardan Capital Markets LLC and the CHARDAN Mark

6. Petitioner is the owner of the word mark CHARDAN in connection with "Financial services, namely, investment banking services, public and private equity financing, financial restructuring, and the trading of financial instruments, securities, shares, equities, options, and other products in the U.S. and overseas markets; information, advisory, consultancy, and research services relating to finance and investments" ("CHARDAN Mark", together with

CHARDAN CAPITAL MARKETS Mark collectively, “Petitioner’s Marks”). Petitioner has been using the CHARDAN Mark in commerce continuously with the identified goods since at least as early as May 18, 2004.

7. Petitioner is the owner of U.S. Registration No. 4048647 for the word mark CHARDAN covering “Financial services, namely, investment banking services, public and private equity financing, financial restructuring, and the trading of financial instruments, securities, shares, equities, options, and other products in the U.S. and overseas markets; information, advisory, consultancy, and research services relating to finance and investments” in International Class 36 with a filing date of March 18, 2011 (“Registration”). The Registration claims a first use date of May 18, 2004, and has a registration date of November 1, 2011. The Registration is valid and subsisting and serves as *prima facie* evidence of the validity of the CHARDAN Mark and of Petitioner’s exclusive right to use this word mark in connection with the services identified in the Registration. A true and correct copy of the USPTO database printout of the Registration is included in the attached **Exhibit A**.

Cardan Capital Partners LLC and the CARDAN CAPITAL PARTNERS Mark

8. Registrant is a Delaware limited liability company having a principal place of business at 100 Saint Paul Street, Suite 640, Denver, Colorado 80206. Registrant obtained the CARDAN CAPITAL PARTNERS Registration for the CARDAN CAPITAL PARTNERS Mark on November 28, 2017 for “Financial services, namely, investment fund transfer and transaction services, investment security services, estate settlement services; wealth management services; investment services, namely, financial asset allocation, cash flow management, investment consultation, and investment management services; trust and estate financial administration services and estate planning consultation; financial risk management consultation; financial

advisory and consultancy services; advice relating to investments and wealth management” in International Class 36. *See Exhibit B.*

9. Registrant’s Mark, CARDAN CAPITAL PARTNERS, is confusingly similar to Petitioner’s Marks because the marks are confusingly similar in appearance, sound and commercial impression, and because the identified services associated with each mark are similar, if not identical.

10. Petitioner has used the term “CHARDAN” for financial services for almost 11 years prior to any date upon which Registrant may rely.

11. Upon information and belief, Registrant’s services are highly related, if not identical, to the services associated with Petitioner’s Marks.

12. Upon information and belief, the services associated with Registrant’s Mark, CARDAN CAPITAL PARTNERS, and the goods and services associated with Petitioner’s Marks, are advertised and sold to similar, if not identical, consumers and in the same channels of trade.

13. Petitioner believes and alleges that the CARDAN CAPITAL PARTNERS mark, when applied to Registrant’s services, is likely to cause confusion or mistake or to deceive, or will cause confusion or mistake, and will deceive and mislead the trade and purchasing public into believing that Registrant’s services are the services of Petitioner or that Registrant is authorized, licensed, or controlled by the Petitioner, or that Registrant is a subsidiary of, or in some way related to or affiliated with Petitioner. As such, any such use of the CARDAN CAPITAL PARTNERS mark by Applicant would violate Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Petitioner has been and will be harmed by the continued registration of the CARDAN CAPITAL PARTNERS Registration in that Petitioner has a valid and subsisting Registration for

the CHARDAN Mark as well as extensive common law rights in the CHARDAN CAPITAL MARKETS Mark.

15. If the CARDAN CAPITAL PARTNERS Mark remains registered, it will be a source of impairment and injury to Petitioner's rights under the Registration of the CHARDAN Mark and common law rights in the CHARDAN CAPITAL MARKETS Mark.

16. Accordingly, Petitioner will be damaged by the continued registration of Registration No. 5343914, which should be cancelled in its entirety on the grounds that it likely to cause confusion among consumers.

Petitioner reserves all rights to amend this Petition to Cancel.

WHEREFORE, Petitioner prays that Registration No. 5343914 be cancelled with prejudice, that this Petition to Cancel be sustained in Petitioner's favor, and for such other and further relief as the Board deems just and proper.

Date: January 17, 2018

Respectfully Submitted

William R. Samuels

/ William R. Samuels /

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EXHIBIT A

United States of America
United States Patent and Trademark Office

CHARDAN

Reg. No. 4,048,647

Registered Nov. 1, 2011

Int. Cl.: 36

SERVICE MARK

PRINCIPAL REGISTER

CHARDAN CAPITAL MARKETS LLC (NEW YORK LIMITED LIABILITY COMPANY)
17 STATE STREET, SUITE 1600
NEW YORK, NY 10004

FOR: FINANCIAL SERVICES, NAMELY, INVESTMENT BANKING SERVICES, PUBLIC AND PRIVATE EQUITY FINANCING, FINANCIAL RESTRUCTURING, AND THE TRADING OF FINANCIAL INSTRUMENTS, SECURITIES, SHARES, EQUITIES, OPTIONS, AND OTHER PRODUCTS IN THE U.S. AND OVERSEAS MARKETS; INFORMATION, ADVISORY, CONSULTANCY, AND RESEARCH SERVICES RELATING TO FINANCE AND INVESTMENTS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-18-2004; IN COMMERCE 5-18-2004.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE WORDING "CHARDAN" HAS NO MEANING IN A FOREIGN LANGUAGE.

SER. NO. 85-271,255, FILED 3-18-2011.

KIMBERLY FRYE, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

EXHIBIT B

United States of America

United States Patent and Trademark Office

CARDAN CAPITAL PARTNERS

Reg. No. 5,343,914

Registered Nov. 28, 2017

Int. Cl.: 36

Service Mark

Principal Register

Cardan Capital Partners LLC (DELAWARE LIMITED LIABILITY COMPANY)
Suite 640
100 Saint Paul Street
Denver, COLORADO 80206

CLASS 36: Financial services, namely, investment fund transfer and transaction services, investment security services, estate settlement services; wealth management services; investment services, namely, financial asset allocation, cash flow management, investment consultation, and investment management services; trust and estate financial administration services and estate planning consultation; financial risk management consultation; financial advisory and consultancy services; advice relating to investments and wealth management

FIRST USE 11-6-2015; IN COMMERCE 11-6-2015

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown: "CAPITAL PARTNERS"

SER. NO. 87-055,326, FILED 05-31-2016



Joseph Matol

Performing the Functions and Duties of the
Under Secretary of Commerce for
Intellectual Property and Director of the
United States Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*

What and When to File:

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.