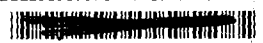


f: 30  
TTAB

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

In the Matter of Registration No. 2,569,302  
Mark: TAIYO EDGE in class 28  
Date of Issue: May 14, 2002

In the Matter of Registration No. 2,595,700  
Mark: TAIYO EDGE and design in class 28  
Date of Issue: July 16, 2002



01-02-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #70

**Taiyo Kogyo Co., Ltd.,  
Petitioner,**

v.

**Tilbor Marketing and Development, Inc.  
Registrant.**

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

03 JAN -8 AM 9:30

Box TTAB Fee  
Assistant Commissioner of Trademarks,  
2900 Crystal Drive  
Arlington, VA 22202-3513

**CONSOLIDATED PETITION FOR CANCELLATION**

Taiyo Kogyo Co., Ltd., a corporation organized and existing under the laws of Japan, located and doing business at No. 1-23-17, Higashiyotsugi, Katsushika-Ku, Tokyo 124-0014, Japan, ("Petitioner") believes it will be damaged by Registration No. 2,569,302, for TAIYO EDGE, for toys, namely, toy vehicles, radio controlled toy vehicles and toy robots, and plush toys; playsets for dolls and action figures; board games; and toy model hobby craft kits, namely, model cars, model planes, model boats and model trains, in class 28, owned by Tilbor Marketing and Development, Inc. ("Registrant"), and accordingly petitions to cancel the registration of the mark TAIYO EDGE; or in the alternative, requests that ownership of the subject registration be transferred to Petitioner as the rightful owner of the mark, pursuant to 15 U.S.C. §1068, and/or

01/06/2003 SWILSON 00000067 2569302

01 FC:6401

600.00 OP

DD

Article 6 *septies* of the International Convention of Paris for the Protection of Industrial Property.

Furthermore, Petitioner believes it will be damaged by Registration No. 2,595,700, for TAIYO EDGE and design, for toys, namely, toy vehicles, dolls, robots, board games, action figures and plush toys; playsets, namely, toy vehicle playsets, electric car racing sets, model cars, model planes, model boats, model trains and toy model hobby craft kits; radio controlled toys, namely, radio controlled toy vehicles and toy robots, in class 28, owned by Registrant, and accordingly petitions to cancel the registration of the mark TAIYO EDGE and design; or in the alternative, requests that ownership of the subject registration be transferred to Petitioner as the rightful owner of the mark, pursuant to 15 U.S.C. §1068, and/or Article 6 *septies* of the International Convention of Paris for the Protection of Industrial Property.

This consolidated Petition to Cancel is appropriate as Petitioner's claims against each of the Registrant's subject registrations involve common questions of law and fact.

As grounds for cancellation, Petitioner alleges that:

1. Petitioner has used the trademarks and/or trade names "TAIYO KOGYO" and/or "TAIYO" (collectively the "TAIYO marks") in Japan in connection with its business of designing, manufacturing, selling and/or importing toys since at least 1956.

2. In addition, since at least 1985, a date long prior to any rights of Registrant in the marks TAIYO EDGE and/or TAIYO EDGE and design, Petitioner has continuously used the TAIYO marks in the United States in connection with its business of designing, manufacturing, selling and/or importing toys, including but not limited to toy vehicles, robots, action figures, electric car racing sets, model cars, model planes, model boats, model trains and radio controlled toy vehicles and toy robots, and other related goods in class 28.

3. Petitioner has continuously used and promoted the TAIYO marks in connection with its business of designing, manufacturing, selling and/or importing toys since its adoption and first use of its marks in the United States. Such use and promotion by Petitioner includes, but is not limited to, placement of the TAIYO marks on the packaging of goods in class 28, which are sold to consumers.

4. By reason of such activities related to goods in class 28, and of the advertising and promotional activities relating to the same, the TAIYO marks have become widely and favorably known to the public in conjunction with Petitioner's goods and business. As a result, said marks have acquired great and valuable goodwill symbolized and appurtenant thereto.

5. The TAIYO marks are strong marks, not descriptive nor suggestive of said goods in class 28.

6. Upon information and belief, at the time of adoption of the marks TAIYO EDGE and/or TAIYO EDGE and design by Registrant, Registrant had knowledge of Petitioner's use of the TAIYO marks. Specifically, in approximately 1999, Petitioner entered into an agreement with Registrant, whereby Registrant would act as Petitioner's United States distributor of its toy products.

7. As a result of the distributorship agreement between Registrant and Petitioner, Registrant was acting under obligations and duties of loyalty owed to Petitioner at the time Registrant filed and prosecuted the applications for TAIYO EDGE and/or TAIYO EDGE and design. Accordingly, any use by Petitioner of the marks TAIYO EDGE and/or TAIYO EDGE and design were and are for Registrant's benefit, and Registrant is the true owner of the marks TAIYO EDGE and/or TAIYO EDGE and design.

8. Petitioner did not consent to or grant Registrant permission to exclusively use the marks and/or trade names TAIYO EDGE, TAIYO EDGE and design, and/or TAIYO, alone or in combination with any other terms. Furthermore, Petitioner did not consent to or grant Registrant permission to register the marks TAIYO EDGE, and TAIYO EDGE and design.

9. Registration No. 2,569,302, sought to be cancelled, is for the mark TAIYO EDGE, registered for use on toys, namely, toy vehicles, radio controlled toy vehicles and toy robots, and plush toys; playsets for dolls and action figures; board games; and toy model hobby craft kits, namely, model cars, model planes, model boats and model trains, in class 28. Such goods are closely related, and in some instances, identical, to those designed, manufactured, and/or imported by Petitioner under its trade names. Furthermore, on information and belief, most, if not all, of such goods marketed and/or distributed by Registrant under the mark TAIYO EDGE are manufactured by Petitioner and are marketed and/or distributed by Registrant on behalf of Petitioner pursuant to the distributorship agreement between Registrant and Petitioner.

10. Registration No. 2,595,700, sought to be cancelled, is for the mark TAIYO EDGE and design, registered for use on toys, namely, toy vehicles, dolls, robots, board games, action figures and plush toys; playsets, namely, toy vehicle playsets, electric car racing sets, model cars, model planes, model boats, model trains and toy model hobby craft kits; radio controlled toys, namely, radio controlled toy vehicles and toy robots, in class 28. Such goods are closely related, and in some instances, identical, to those designed, manufactured, and/or imported by Petitioner under its trade names. Furthermore, on information and belief, most, if not all, of such goods marketed and/or distributed by Registrant under the mark TAIYO EDGE and design are manufactured by Petitioner and are marketed and/or distributed by Registrant on behalf of Petitioner pursuant to the distributorship agreement between Registrant and Petitioner.

11. Petitioner has superior and paramount rights in the mark TAIYO, as compared to Registrant since Petitioner has used the TAIYO marks in commerce continuously and for many years prior to any date claimed by or available to Registrant.

12. If not assigned to Petitioner, Registrant's mark TAIYO EDGE is confusingly similar to Petitioner's TAIYO marks with respect to sound, visual appearance, spelling, meaning, connotation, imagery, and commercial impression. Moreover, Registrant's goods named in its registration are virtually identical to goods designed, manufactured, sold, and/or imported into the United States by Petitioner under the TAIYO marks.

13. If not assigned to Petitioner, Registrant's mark TAIYO EDGE and design is confusingly similar to Petitioner's TAIYO marks with respect to sound, visual appearance, spelling, meaning, connotation, imagery, and commercial impression. Moreover, Registrant's goods named in its registration are virtually identical to goods designed, manufactured, and/or imported into the United States by Petitioner under the TAIYO marks.

14. If not assigned to Petitioner, continued registration of the marks TAIYO EDGE and/or TAIYO EDGE and design by Registrant, in conjunction with the named goods in class 28, will cause great and irreparable damage to Petitioner and to Petitioner's goodwill because of the likelihood of creating confusion, mistake, and deception on the part of the public and would cause an erroneous assumption on the part of the public that the goods of Registrant were goods emanating from Petitioner.

15. If not assigned to Petitioner, continued registration of Registration No. 2,569,302 for TAIYO EDGE, for goods in class 28, gives Registrant the improper color of a right to continue its use of such mark, thereby constituting a continuing threat to Petitioner's exclusive right to use the TAIYO marks in association with its business of designing, manufacturing and/or

importing toys, thereby causing serious and irreparable harm to Petitioner's business and to the goodwill of such business symbolized by Petitioner's TAIYO marks.

16. If not assigned to Petitioner, continued registration of Registration No. 2,595,700 for TAIYO EDGE and design, for goods in class 28, gives Registrant the improper color of a right to continue its use of such mark, thereby constituting a continuing threat to Petitioner's exclusive right to use the TAIYO marks in association with its business of designing, manufacturing and/or importing toys, thereby causing serious and irreparable harm to Petitioner's business and to the goodwill of such business symbolized by Petitioner's TAIYO marks.

17. If not assigned to Petitioner, under the circumstances detailed herein, the marks TAIYO EDGE and/or TAIYO EDGE and design registered by Registrant has not and could not become distinctive with respect to Registrant's goods within the meaning and requirements of the Trademark Act of 1946, and, therefore, registration of such marks TAIYO EDGE and/or TAIYO EDGE and design to Registrant in Class 28 is not warranted and should be refused.

18. If Registrant is permitted to retain the registrations sought to be cancelled, a cloud will be placed on Petitioner's title in and to the TAIYO marks, and on its right to enjoy the free and exclusive use thereof in connection with the sale of its goods in class 28, all to great injury to Petitioner.

19. Upon information and belief, during the prosecution of the application that issued as Registration No. 2,569,302 for TAIYO EDGE, Registrant improperly stated that it was the owner of the mark and that no one else had the right to use the mark in commerce. Said statement was false in that Registrant was aware the Petitioner has rights to the mark TAIYO, and was made by an officer of Registrant with the knowledge that said statement was false. Said

false statement was made with the intent to induce the U.S. Patent and Trademark Office to grant said registration, and reasonably relying upon the truth of said false statement, the U.S. Patent and Trademark Office did, in fact, grant said registration.

20. Upon information and belief, during the prosecution of the application that issued as Registration No. 2,595,700 for TAIYO EDGE and design Registrant improperly stated that it was the owner of the mark and that no one else had the right to use the mark in commerce. Said statement was false in that Registrant was aware the Petitioner has rights to the mark TAIYO, and was made by an officer of Registrant with the knowledge that said statement was false. Said false statement was made with the intent to induce the U.S. Patent and Trademark Office to grant said registration, and reasonably relying upon the truth of said false statement, the U.S. Patent and Trademark Office did, in fact, grant said registration.

21. Petitioner is the owner of the mark TAIYO in Japan, to which the International Convention of Paris for the Protection of Industrial Property applies. Furthermore, Registrant is an agent of Petitioner, and obtained the registration of TAIYO EDGE without Petitioner's authorization. Accordingly, pursuant to Article 6 *septies* of the Paris Convention, Petitioner is entitled to either demand cancellation of the registration or the assignment in its favor of the registration.

22. Petitioner is the owner of the mark TAIYO in Japan, to which the International Convention of Paris for the Protection of Industrial Property applies. Furthermore, Registrant is an agent of Petitioner, and obtained the registration of TAIYO EDGE and design without Petitioner's authorization. Accordingly, pursuant to Article 6 *septies* of the Paris Convention, Petitioner is entitled to either demand cancellation of the registration or the assignment in its favor of the registration.

WHEREFORE, Petitioner therefore files this Petition to Cancellation and prays that:

1. This Board transfer ownership of Registration No. 2,569,302, registered May 14, 2002, to Petitioner as the true owner of the registration, pursuant to 15 U.S.C. §1068, and/or Article 6 *septies* of the International Convention of Paris for the Protection of Industrial Property; and

2. This Board transfer ownership of Registration No. 2,595,700, registered July 16, 2002, to Petitioner as the true owner of the registration, pursuant to 15 U.S.C. §1068; and/or Article 6 *septies* of the International Convention of Paris for the Protection of Industrial Property; or in the alternative,

3. Registration No. 2,569,302, registered May 14, 2002, be canceled and that this Petition for Cancellation be sustained in favor of Petitioner, if ownership is not transferred to Petitioner as prayed in paragraph 1; and

4. Registration No. 2,595,700, registered July 16, 2002, be canceled and that this Petition for Cancellation be sustained in favor of Petitioner, if ownership is not transferred to Petitioner as prayed in paragraph 2.

On information and belief, Registrant's last known address is:

4707 Van Kleeck Drive  
New Smyrna Beach, FL 32169

The Petition to Cancel fee in the sum of \$600.00 is enclosed.



The Commissioner is hereby authorized to charge any additional fees which may be required or credit any overpayment directly to the account of the undersigned, No. 50-2319 (Order No. 469910-0004).

Respectfully Submitted,

DORSEY & WHITNEY LLP

Date: 12/27/02

By: David J. Brezner  
David J. Brezner, Reg. No. 27,774  
Attorneys for Petitioner  
Taiyo Kogyo Co., Ltd

Four Embarcadero Center, Suite 3400  
San Francisco, California 94111-4187  
Telephone: (415) 781-1989  
TL-36359-95/RBC/DJM  
1099035

"Express Mail" Mailing Label"

Number EV 155323065 US

Date of Deposit: December 30, 2002

I hereby certify that this correspondence, along with two copies, is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Box TTAB Fee, Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

By: Lisa Jeanette