



TTAB

03-21-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #61

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

In the matter of trademark Registration No. 2590010  
For the mark STAY LIT  
Date registered: July 2, 2002

Santa's Best Craft, LLC,  
  
Petitioner

v.

JLJ Inc,  
  
Registrant.

Cancellation No. 92041707

**AMENDED PETITION TO CANCEL**

Petitioner: Santa's Best Craft, LLC

Business Address: 770 Frontage Road  
Suite 160  
Northfield, IL 60093

Entity Information: Limited liability company organized under the laws of the State of Illinois

To the best of petitioner's knowledge, the name and address of the current owners of the registration are:

JLJ Inc.  
332 Vindale Drive  
Dayton, Ohio 45440-3364

The above-identified petitioner believes that it will be damaged by the above-identified registration, and hereby petitions to cancel the same.

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The grounds for cancellation are as follows:

- Respondent's registered mark consists of a mark which, when applied to the goods of respondent, is merely descriptive in that said mark is an apt and common term used to

describe goods of the nature involved herein. Petitioner, since October, 2001 has been involved in the manufacture and sale of decorative lights which are of a related nature to respondent's goods described in said registration, and which petitioner has a valid and legal right to describe by use of the term registered as a trademark by respondent. Petitioner is likely to be damaged by registration of said term in that the prima facie effect of such registration tends to impair petitioner's right to descriptive use of said term. In view of the above allegations, respondent is not entitled to continue registration of its alleged mark in that respondent is not entitled to exclusive use of said term in commerce on the goods specified and further, that respondent's alleged mark does not function to identify respondent's goods and distinguish them from those offered by others.

2. Petitioner, since October, 2001, has been, and is now, operating under the designation "Stay-On" in the area of Christmas Electric Light Strings. Said use has been valid and continuous since said date of first use and the relevant class of the public has come to associate petitioner with said designation. In view of the similarity of respondent's registered mark with petitioner's designation, and in view of the related nature of the uses therefor, it is alleged by respondent that petitioner's designation consists of and comprises matter which disparages and falsely suggests a connection with respondent.

3. Respondent's alleged registered mark is the common descriptive name of the articles and substances included in respondent's description of goods and has become the generic name of all such goods produced and sold by every competitor engaged in such business. Therefore, petitioner alleges that respondent's registered mark does not function to identify respondent's goods and distinguish them from goods offered by others. Respondent's mark is functional in origin. Petitioner is likely to be damaged by registration of said generic term in that

the evidentiary effect of said registration tends to impair petitioner's right to legal use of said term, in that petitioner for some time has been involved in the manufacture and sale of "Stay-On" electric Christmas light strings which are of related nature to respondent's goods and which petitioner has a valid and legal right to refer to by their common descriptive name.

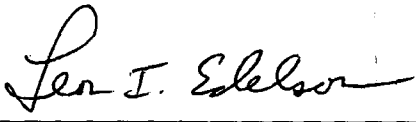
4. Respondent has abandoned said registered mark by creating an assignment in gross of said mark in April, 2002. Petitioner is likely to be damaged by continuance of said registration in that petitioner, since October, 2001, has continuously used the designation "Stay-On" in connection with the manufacture and sale of electric Christmas light strings, and petitioner's continued and legal use of said designation will be impaired by the continued registration of said abandoned mark of respondent.

5. Upon information and belief, Respondent's registration was obtained fraudulently in that the formal application papers filed by respondent under oath or notice of 18 USC 1001 stated Jay Cavender, Inc. was a co-owner of the mark, and said statement was false in that the true facts were that Jay Cavender, Inc. never used the mark, neither applicant was the initial owner or user of said Mark, and said Owners have not controlled the use of said mark. Said statement was made by an authorized agent of respondent with the knowledge and belief that said statement was false. Said false statement was made with the intent to induce authorized agents of U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to respondent. Petitioner was damaged by said false statements and registration issued in reliance thereon in that petitioner, since October, 2001 has continuously used the designation "Stay-On" on electric Christmas light strings, and petitioner's continued and legal use of said mark will be impaired by the continued registration of said mark of respondent.

WHEREFORE, Petitioner prays that Registration No. 2590010 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

Petitioner hereby appoints Levenfeld Pearlstein, a law firm composed of 52 attorneys, all members of the bar of the State of Illinois, and specifically attorneys Leon I. Edelson, Mitchell Bryan, Brendan R. Appel and William C. Clarke, to act as attorneys for Petitioner herein, with full power to prosecute said Petition, to transact all relevant business with the Patent and Trademark Office and in the United State Courts and to receive all official communications in connection with this Petitioner for Cancellation.

SANTA'S BEST CRAFT, L.L.C., Petitioner

By:   
Leon I. Edelson, one of its attorneys

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Attorney Docket No. 30629-46215

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U.S. Patent & TMO/c/TM Mail RcptDt. #61

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

03 APR -7 3:11 PM '03

Registration Number: 2590010

Owners: JLJ Inc.  
332 Vindale Drive  
Dayton, Ohio 45440-3364

Jay Cavender, Inc.  
185 Eleanor Drive  
Springboro, OH 45066

Mark: STAY LIT

Registration Date: July 2, 2002

Box TTAB FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**VIA EXPRESS MAIL NO. EV 024106859 US**

Dear Sir:

Enclosed with this Transmittal Letter (in duplicate) is:

1. Amended Petition to Cancel;
2. Please charge PTO Deposit Account 502035 any prescribed fee; and
3. Receipt Return Postcard.

Respectfully submitted,

Leon I. Edelson  
Levenfeld Pearlstein  
Registration No. 38,863

Date: March 21, 2003

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as Express Mail No. EV 024106859 US in an envelope addressed to Box TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on March 21, 2003.

Leon I. Edelson