

In the United States Patent and Trademark Office Before the
Trademark Trial and Appeal Board

In the Matter of Registration No. 2,724,293
Registrant: C. L. Swanson Corporation
Mark: PENITENTIARY PENGUIN
Date of Issue: June 10, 2003

06-19-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

PEI Licensing, Inc.,
Petitioner,

v.

C. L. Swanson Corporation,
Registrant.

BOX TTAB – FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Petition For Cancellation

Petitioner, PEI Licensing, Inc. (hereinafter referred to as "PEI"), a wholly owned subsidiary of Perry Ellis International, Inc., is a corporation organized and existing under the laws of Delaware. PEI has offices located and doing business at 3000 N.W. 107th Ave., Miami, Florida 33172. PEI believes that it will be damaged by Registration No. 2,724,293, and PEI hereby petitions to cancel Registration No. 2,724,293. As grounds therefor, it is alleged that:

1. Registrant, C. L. Swanson Corporation ("Swanson"), is a Wisconsin corporation located and doing business at 4501 Femrite Drive, Madison, WI 53716 .
2. On July 11, 2002, Swanson filed United States Trademark Application Serial No. 78/142972 for the word mark PENITENTIARY PENGUIN in International Classes 025 and 028. On March 18, 2003, Application Serial No. 78/142972 was approved for

06/27/2003 WANDERSO 00000011 2724293 .

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SARAH STEINBAUM
A Professional Association

44 W. Flagler Street
Suite 2175
Miami Florida 33130

T 305-358-7676
F 305-358-6667

registration on the Principal Register. Application Serial No. 78/142972 was issued United States Trademark Registration No. 2,724,293 on the Principal Register on June 10, 2003 for the word PENITENTIARY PENGUIN in International Class 025 for clothing, namely, shirts, t-shirts and sweaters and International Class 028 for toy stuffed animals, plush toys, action figures and play figures. Refer to Exhibit A.

3. Petitioner is the assignee and owner of a family of famous PENGUIN word and design trademarks in International Classes 025 and 028, including but not limited to those listed in Exhibit B.
4. Petitioner has used each of these Registrations continuously since their registration and, in fact, many of the trademarks have become incontestable.
5. Petitioner's PENGUIN Registrations issued before the Registrant's date of first use of its PENITENTIARY PENGUIN mark in April 2001; therefore there is no issue as to priority of use by and between the parties.
6. For over forty years, Petitioner has expended considerable effort and expense in promoting its family of PENGUIN trademarks and the goods sold under such marks, with the result that the purchasing public has come to know, rely upon and recognize the products of Petitioner by such mark. Petitioner has an exceedingly valuable goodwill established in its marks.
7. If the Registrant is permitted to retain the Registration sought to be cancelled, Petitioner will be damaged because: such Registration would likely be confused with Petitioner's registered family of PENGUIN trademarks; and, Registrant's mark would result in dilution

of Petitioner's family of PENGUIN trademarks.

Wherefore, Petitioner, PEI Licensing, Inc. hereby petitions for cancellation of United States
Trademark Registration No. 2,724,293.

Dated: June 17, 2003

Respectfully submitted,

SARAH STEINBAUM, P.A.

By: 

Kim Kolback, Of Counsel

Petitioner, PEI Licensing, Inc.,

44 West Flagler Street, Suite 2175

Miami, FL 33130

Telephone (direct): (305)858-2627

Telefax: (305) 858-8763

Enclosures: \$600.00 Petition Fee
Duplicate Petition for Cancellation

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-06-11 21:22:15 ET

Serial Number: 78142972

Registration Number: 2724293

Mark (words only): PENITENTIARY PENGUIN

Current Status: Registered.

Date of Status: 2003-06-10

Filing Date: 2002-07-11

Registration Date: 2003-06-10

Law Office Assigned: TMO Law Office 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2003-06-10

CURRENT APPLICANT(S)/OWNER(S)

1. C. L. Swanson Corporation

Address:

C. L. Swanson Corporation
4501 Femrite Drive
Madison, WI 53716
United States

State or Country of Incorporation: Wisconsin

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Clothing; namely, shirts, t-shirts, and sweaters

International Class: 025

First Use Date: 2001-04-00

First Use in Commerce Date: 2001-04-00

Basis: 1(a)

EXHIBIT A

Toy stuffed animals, plush toys, action figures and play figures

International Class: 028
First Use Date: 2001-04-00
First Use in Commerce Date: 2001-04-00

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "penguin"

Prior Registration Number(s):

2494712
2500705
2513063
2517916

PROSECUTION HISTORY

2003-06-10 - Registered - Principal Register
2003-03-18 - Published for opposition
2003-02-26 - Notice of publication
2003-01-17 - Approved for Pub - Principal Register (Initial exam)
2003-01-13 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Sverre David Roang (Attorney of record)

SVERRE DAVID ROANG
STROUD, WILLINK & HOWARD, LLC
P.O. BOX 2236
MADISON WI 53701-2236
United States

Registration No. 2,049,331 in International Class 025

Registration No. 673,912 in International Class 025

Registration No. 796,003 in International Class 025

Registration No. 961,376 in International Class 028

Registration No. 1,034,409 in International Class 028

Registration No. 1,116,035 in International Classes 025 and 028

Registration No. 1,569,866 in International Class 025

Registration No. 1,580,093 in International Class 028

Registration No. 1,849,971 in International Class 025

EXHIBIT B

SARAH STEINBAUM
A Professional Association

44 W. Flagler Street, Suite 2175
Miami Florida 33130
T 305-358-7676 F 305-358-6667
ssp.alaw@winstar.mail.com

SARAH STEINBAUM
Attorney At Law • Trial Lawyer

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June 17, 2003

VIA FEDERAL EXPRESS

Assistant Commissioner for Trademarks
Box T.T.A.B – FEE
2900 Crystal Drive
Arlington, VA 22202-3513

RE: Registration No. 2,724,293
Registrant: C. L. Swanson Corporation
Mark: PENITENTIARY PENGUIN
Date of Issue: June 10, 2003

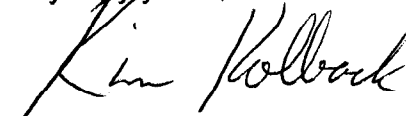
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Dear Sir:

Enclosed please find an original and one copy of a Petition For Cancellation for Two (2) classes of goods in relation to the referenced registration, together with a check in the amount of Six Hundred Dollars and NO/100 (\$600.00).

Please confirm receipt of this filing by date stamping and returning the enclosed duplicate of this letter in the postage-paid return envelop provided herein for your convenience.

Very truly yours,


KIM KOLBACK, ESQ.

KK/acf
Enclosures

cc: Geri Mankoff, Assistant General Counsel

44 W. Flagler Street
Suite 2175
Miami Florida 33130

SARAH STEINBAUM
A Professional Association

Sarah Steinbaum, Esq.
44 West Flagler St.
Suite 2175
Miami, Florida 33130

