

TTAB

UNITED STATES PATENT AND TRADEMARK
OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: February 3, 2004

Paul Frank Industries, Inc.

711 West 17th Street, Suite J1
Costa Mesa, CA 92627

75,498,789
Cancellation No. 92042849
Reg. No. 2325420

Arnie Krause
Five Y Clothing, Inc.
9500 N.W. 108th Avenue
Miami, FL 33178



02-17-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

Five Y Clothing, Inc.

V.

Paul Frank Industries, Inc.

Torri Rodgers, Legal Assistant

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the

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Trademark Trial and Appeal Board Manual of Procedure (TBMP), are available at www.uspto.gov.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open: **February 23, 2004**

Discovery period to close: **August 21, 2004**

30-day testimony period for party
in position of plaintiff to close: **November 19, 2004**

30-day testimony period for party
in position of defendant to close: **January 18, 2005**

15-day rebuttal testimony period
for plaintiff to close: **March 04, 2005**

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may

be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

TTAB

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

FIVE Y CLOTHING, INC.,

Petitioner,

vs.

PAUL FRANK INDUSTRIES, INC.,

Respondent.

CANCELLATION No.:

REGISTRATION No.: 2,325,420

MARK: DESIGN (to wit, Monkey Head)

DATE OF ISSUANCE: 7 March 2000

CLASSES: 18 and 25



12-19-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

Honorable Commissioner of Patents and Trademarks
Assistant Comm. For Trademarks
2900 Crystal Drive
Arlington, VA 22202
Box TTAB-FEE

PETITION FOR CANCELLATION

Petitioner, FIVE Y CLOTHING, INC. ("Petitioner"), a Florida corporation, located and doing business at 9500 N.W. 108th Avenue, Miami, Florida 33178, believes that it is, or will be, damaged by United States Trademark Registration No. 2,325,420, held by the Respondent, PAUL FRANK INDUSTRIES, INC. ("Respondent"), and hereby respectfully petitions the Trademark Trial and Appeal Board ("TTAB") of the United States Patent and Trademark Office ("USPTO") to cancel same in Class 25 (only).

Description of Respondent's Registration: Filed on June 8, 1998, for the Trademark, DESIGN (to wit, Head of a Monkey), registered on March 7, 2000, Reg. No. 2,325,420 (the "420 Registration") on the Principal Register, in International

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Classes 18 and 25, for *inter alia*, clothing, claiming a first use date of November 1, 1995 and a first use in commerce date of November 1, 1995. (See Exhibit "A" attached hereto and made a part hereof.)

As and for Petitioner's grounds for the instant Petition for Cancellation, it hereby is alleged that:

1. Petitioner has standing to petition to cancel in that it is likely to be damaged by the said '420 Registration in the Class hereinabove cited.

2. There are valid grounds why the said '420 Registration should no longer continue to be registered by USPTO in Class 25.

3. The Petitioner is likely to be damaged by continuance of the said '420 Registration in Class 25, in that, among other things, the mark is not incontestable, the parties' respective marks at issue are not confusing; the mark lacks secondary meaning and Respondent is violating antitrust law.

4. In addition, and among other things, Respondent has commenced a Federal Court action for alleged trademark infringement against Petitioner and others, based upon the '420 Registration here at issue.

5. Essentially for the reasons hereinbelow stated, Petitioner hereby respectfully contends that the Respondent's alleged trademark does not function to identify the Respondent's clothing goods and to distinguish them from the clothing goods of others.

6. Thus, the trademark reflected in the '420 Registration here at issue no

longer has any trademark significance to the consuming public.

7. The Respondent's '420 Registration, DESIGN (Monkey Head), should, thus, be cancelled.

RESPONDENT'S MARK IS NOT INCONTESTABLE

8. Respondent's mark has not become incontestable and, thus, the Registration is only *prima facie* evidence of Respondent's right to use the mark.

9. The Lanham Act clearly specifies that this evidentiary effect "shall not preclude an opposing party from proving any legal or equitable defense or defect which might have been asserted if such mark had not been registered." See Title 15, U.S. Code §1115(a).

10. Thus, the validity of the mark, and the '420 Registration, may be collaterally attacked by a defendant charged with infringement.

11. Any common law defense may be raised to attack the validity of the mark.

12. Any equitable defense may be interposed; e.g., estoppel, laches, and unclean hands.

13. A party also may raise any of the Section 2 (Title 15, U.S. Code §1052) bars to registration of a mark on the Principal Register.

14. A party may also counterclaim for cancellation of a Registration improperly granted by USPTO.

ABSENCE OF LIKELIHOOD OF CONFUSION

15. There is no likelihood of confusion between Petitioner's apparel designs and the Respondent's mark.

16. The marks and designs themselves are not confusingly similar.

17. The parties' respective clothing goods are not competitive.

18. The parties' respective clothing goods are sold in different channels of trade.

19. The respective clothing goods of the parties are sold to different classes of consumers.

ABSENCE OF SECONDARY MEANING

20. Respondent's mark is not inherently distinctive.

21. Respondent's mark has not attained secondary meaning.

22. Upon information and belief, consumers do not associate Respondent's mark with the Plaintiff alone.

23. With all due respect, USPTO improperly granted the '420 Registration to Respondent.

24. Respondent's '420 Registration is for a design mark; the design at issue is a common animal shape or form, to wit, a monkey head.

25. Respondent is using, or is attempting to use, its alleged mark and the '420 Registration to effectuate a monopoly over the use of monkey designs in apparel.

VIOLATION OF ANTITRUST LAWS

26. The existence of an antitrust violation defeats an incontestable registration under Section 33(b)(7) of the Lanham Act, Title 15 USCS §1115(b)(7), which reads as follows:

The certificate [of trademark registration] shall be conclusive evidence of the registrant's exclusive right to use...except when one of the following defenses or defects is established: ... "(7) That the mark has been or is being used to violate the antitrust laws of the United States." (Emphasis added.)

27. Respondent's mark has been, or is being, used to violate antitrust laws of the United States.

28. Section 2 of the Sherman Act, Title 15, U.S. Code §2, reads as follows:

Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a felony ...(Emphasis added.)

29. Respondent is guilty of attempt to monopolize, due to its predatory practices, coupled with a dangerous probability that monopoly power may result.

30. Respondent's aggressive use and/or enforcement of the alleged trademark here at issue (as reflected in the '420 Registration) is predatory.

31. Respondent's aggressive use and/or enforcement of the trademark here at issue (as reflected in the '420 Registration) is a misuse of Respondent's legal trademark powers in the market.

32. Respondent is misusing a trademark infringement lawsuit in such a way

as to violate antitrust laws.

RESPONDENT'S MISUSE OF THE MARK AND THE '420 REGISTRATION

33. Respondent's improper use of its so-called "Julius" mark and the '420 Registration as a litigation tool is tantamount to bad faith and unfair competition.

34. Respondent has committed tortious interference with Petitioner's contractual relations with retailer K Mart Corporation.

35. Respondent's threats against, and commencement of lawsuit against Petitioner's client-retailer, K Mart Corporation, amounts to tortious interference with Petitioner's contractual relations with K Mart.

POWER OF ATTORNEY


The Petitioner hereby appoints IRA COHEN, ESQUIRE, of SILVER, GARVETT & HENKEL, P.A., a law firm, being a Member of the Bars of the State of Florida and New York, as well as of other Bars, to act as Attorneys for the Petitioner herein, with full power to prosecute the Petition for Cancellation, to transact all relevant business with the United States Patent and Trademark Office and in the United States Courts, to execute legal papers and to receive all official communication in connection with the said Petition for Cancellation.

WHEREFORE, the Petitioner hereby respectfully prays that the instant Petition for Cancellation be sustained in favor of the Petitioner and that United States Trademark Registration No. 2,325,420, DESIGN, for clothing, namely t-shirts, socks, hats, beanies, baseball caps, shoes, floppy hats, jeans, shorts, sweatshirts, and

wovens, namely pajamas, shirts and pants, in Class 25, be cancelled.

Respectfully submitted,

FIVE Y CLOTHING, INC.,
Petitioner


By: 
Name: Arnie Krause
Title: CFO
Date: December 15, 2003

Post Office Address of Petitioner:
9500 N.W. 108th Avenue, Miami, Florida 33178

DECLARATION

I, ARNIE KRAUSE, hereby state and declare that I am the CFO of Five Y Clothing, Inc., the Petitioner corporation; that I am authorizing this Declaration of behalf of said Petitioner; that I have read the foregoing PETITION TO CANCEL; and all statements made as factual therein are true and all statements made upon information and belief are believed to be true; and that said statements were made with the knowledge that willful false statements and the like are: (1) punishable by fine and/or imprisonment under Section 1001 of Title 18 of the United States Code; and (2) may jeopardize the validity of the instant Petition to Cancel.

FIVE Y CLOTHING, INC.,
Petitioner

By: 
Name: Arnie Krause
Title: CFO
Date: December 15, 2003

Post Office Address of Declarant:
9500 N.W. 108th Avenue, Miami, Florida 33178

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SILVER, GARVETT & HENKEL, P.A.

ATTORNEYS AT LAW

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FAX: (305) 377-8804

November 14, 2003

OF COUNSEL
STEVEN MISHAN

Via Federal Express

Honorable Commissioner of Patents & Trademarks
Assistant Comm. For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
TTAB- FEE

12-19-2003

U.S. Patent & TMO/TM Mail Rcpt Dt #74

Re: **FIVE Y CLOTHING, INC. v. PAUL FRANK INDUSTRIES, INC.;**
INTER PARTES CANCELLATION PROCEEDING BEFORE TTAB OF USPTO

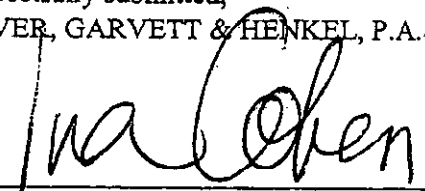
Honorable Sirs:

In connection with the above-referenced *inter partes* proceeding, kindly be informed that the undersigned Attorney represents the legal interests of Petitioner, Five Y Clothing, Inc., of Miami, Florida. Please find enclosed herewith our Cancellation Petition, brought pursuant to the authority of Title 15, U.S. Code, as well as Rule 2.111 *et seq.* of the T.M.R.P.

In addition, and in accordance with applicable rules, we have also enclosed herewith a duplicate original Petition, together with a check in the amount of \$300.00, as and for the official USPTO filing fee (only one (1) Class involved) and an Acknowledgment postcard. Would you be so kind as to assign a docket number for this proceeding, in due course.

The Tribunal's time, consideration of and cooperation in this matter greatly will be appreciated.

Respectfully submitted,
SILVER, GARVETT & HENKEL, P.A.

By: 
IRA COHEN, ESQ.

IC/ns

Enclosures

cc: John D. Guerrini, Esq. (w./enclos.)
Kari VanWambeke, Esq. (w./enclos.)
Arnie Krause, CFO (w./enclos.)

\\Five-Y\CANCELLATION PROCEEDING\CORR\TTAB COVER LETTER.1.wpd

FedEx Express **USA Airbill** Tracking Number **8435 7185 1633**

1 From *Please note end point last* **MIAMI** Sender's FedEx Account Number **1182-5441-4**

Date **11/14/03** Sender's Name **Ira Cohen, Esq.** Phone **(305) 377-8802**

Company **SILVER GARVETT & HENKEL PA**

Address **1110 BRICKELL AVE PH 1**

City **MIAMI** State **FL** ZIP **33131-3139**

2 Your Internal Billing Reference **Friday, 11/14/03**

3 To Recipient's Name **Asst + Comm Jn Trademark** Phone **1**

Company **Wm Comm of Patent & Trademark**

Address **2900 Crystal Dr**

City **Wilmington** State **VA** ZIP **22203-3513**



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OF COUNSEL
STEVEN MISHAN

December 16, 2003

URGENT & IMPORTANT; EXPEDITIOUS HANDLING REQUESTED

Honorable Commissioner of Patents & Trademarks
Assistant Comm. For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
TTAB- FEE

75499789
12-19-2003

U.S. Patent & TMO/TM Mail Rcpt DL #74

Re: **FIVE Y CLOTHING, INC. v. PAUL FRANK INDUSTRIES, INC.;**
INTER PARTES CANCELLATION PROCEEDING BEFORE TTAB OF USPTO

Honorable Sirs:

Over a month ago, we sent a Cancellation Petition, together with the filing fee check of \$300.00 to the TTAB. Delivery was confirmed by Federal Express (see copy of receipt enclosed).

Notwithstanding the foregoing, I was advised by your office, a few days ago, when I inquired regarding the assignment of a case number for this cancellation proceeding, that neither the papers, nor the fee had ever been logged in by your office. Accordingly, we hereby enclose another set of papers, executed in the original, along with a new filing fee check of \$300.00. In the event that the package from November 14, 2003 ever shows up, I assume that you will not open two (2) cancellation proceedings and that the first \$300.00 check will be returned to the undersigned Attorney. (We are going to cancel that check from our office.)

In light of the foregoing, we hereby respectfully request expeditious handling of the enclosed Cancellation Petition. Thank you very much.

The Tribunal's time, consideration of and cooperation in this matter greatly will be appreciated.

Respectfully submitted,

December 16, 2003

Page 2

SILVER, GARVETT & HENKEL, P.A.

By:


IRA COHEN, ESQ.

IC/nsf

Enclosures

cc: John D. Guerrini, Esq. (w./enclos.)
Kari VanWambeke, Esq. (w./enclos.)
Arnie Krause, CFO (w./enclos.)

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