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Yoshida & Company, Ltd.,
Petitioner,

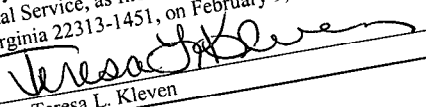
v.
Porter International Co., Ltd.,
Registrant.

)
)
) Cancellation No. _____
)
)
)

Mark: PORTER DASH! and Design
Registration No.: 2,131,161
Docket Number: 14282.8USTA

Due Date: N/A
Registered: January 20, 1998

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Trademarks P.O. Box 1451 Alexandria, Virginia 22313-1451, on February 9, 2005.

By: 
Name: Teresa L. Kleven

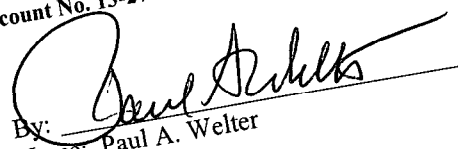
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.8
- Check in the amount of \$300.00 to cover Filing Fee.
- Other: PETITION TO CANCEL (original and one copy).

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By: 
Name: Paul A. Welter
Reg. No.: 20,890
PAWelter/tlk

(CONTESTED MATTER)

TTAB

M&G 14282.8USTA

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

_____)	
Yoshida & Company, Ltd.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	Registration No. 2,131,161
Porter International Co., Ltd.,)	Registered: January 20, 1998
)	
Registrant.)	
_____)	

PETITION TO CANCEL

Yoshida & Company, Ltd. (hereinafter "Petitioner"), is a Japanese corporation having a principal place of business at 17-6 Higashikanda 1-chome Chiyoda-ku, Tokyo, Japan. Petitioner believes that it will be damaged by the continued registration of trademark Registration No. 2,131,161, which has been assigned to Porter International Co., Ltd. (hereinafter "Registrant"), a Taiwanese corporation, located at 2F, No. 86, Sec. 1, Huamei West St., Shi Chiu, Taichung, Taiwan, R.O.C. The grounds for cancellation are as follows:

1. Registrant is the record owner of a registration on the Principal Register, under the provisions of the Trademark Act of 1946, of the mark "PORTER DASH!" and design, Registration No. 2,131,161. The registration of this mark is for the following goods in International Class 18:

Purses, wallets, cosmetic bags sold empty and purses for beauty products sold empty, ladies handbags, baby carriers worn on the body, backpacks, all purpose athletic bags, all purpose sport bags, beach bags, carry-on bags, clutch bags, duffel bags, leather shopping bags, overnight bags, school bags, shoulder bags, textile shopping bags, tote bags, travel bags, garment bags for travel, shoe bags for travel, briefcases, suitcases, luggage, key cases and briefcase-type portfolios

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2. Registrant is the record owner of Registration No. 2,131,161 based upon an assignment from Gallant Industries Co., Ltd.

3. Petitioner has used the marks "PORTER" and design and "PORTER DASH!" and design for a substantial period of time, a period which began long before any priority date which can be claimed by Registrant for the registered mark No. 2,131,161, and Petitioner continues to presently use the mark "PORTER" and design and "PORTER DASH!" and design on travel bags, totes, suitcases, handbags, carry-on bags, purses, and related products and accessories.

4. (a) On December 6, 1988, Petitioner licensed Gallant Industries Co., Ltd. (hereinafter "Gallant"), to use the marks "PORTER" and design, and "PORTER DASH!" and design in the United States on products designed, or to be designed, by Petitioner. In this agreement Petitioner granted Gallant an exclusive license to manufacture, market, and distribute said products in the United States and other countries from the date of execution until December 31, 1991, in return for royalty payments to be made by Gallant.

(b) Petitioner and Gallant entered into subsequent licensing agreements on June 2, 1993, January 30, 1996, and May 31, 2000; wherein all of the agreements extended for a predetermined and fixed period of time, and enabled the Petitioner to control the quality of the products manufactured and distributed by Gallant, and required Gallant to pay royalties for its use of the trademarks and products covered under the license.

(c) Gallant registered Petitioner's trademarks in the United States in order to ensure that Petitioner's trademarks gained full protection; however, Petitioner was the true owner of the marks and the party who exerted control over the nature and quality of the goods on which the mark was used.

(d) Gallant registered the marks "PORTER" and design (Registration No. 1,602,298), and "PORTER DASH!" and design (Registration No. 2,131,161), under its own name despite the fact that it was not the true owner but rather the exclusive licensee of the marks.

(e) Since Gallant was Petitioner's licensee, all of Gallant's use of the marks, including all use in the United States, inured to Petitioner's benefit, and Gallant held the registrations on these marks under constructive trust for Petitioner's benefit.

(f) Gallant notified Petitioner that it was terminating the licensing arrangement in a letter dated April 4, 2001, and Petitioner demanded the return of its trademarks and the registrations covering such trademarks.

(g) Because Gallant entered into four license agreements with Petitioner for the above-mentioned marks, Gallant is estopped from denying the ownership of such marks and registrations by Petitioner.

5. (a) Gallant and Registrant, while apparently separate entities, have common shareholders and management members, for instance, upon information and belief Ming-Teng Lin acts as both the chairman of Gallant and an auditor for Registrant, his son I-Hsiung Lin acts as a director for both Gallant and Registrant, and a second of his sons, I-Sheng Lin also acts as a director for Registrant; wherein upon information and belief Ming-Teng Lin and his two sons hold a majority of Registrant's shares. Ming-Teng Lin signed the Declaration of Application No 75/095,238, now Registration No. 2,131,161, and also signed the Declaration of Use as President of Gallant Industries Co., Ltd.

(b) Upon information and belief, Gallant and Registrant are related companies in that, neither Registrant nor Gallant own the other, but they are both effectively controlled by the same third party or parties.

(c) Gallant fraudulently assigned the mark "PORTER" and design under Registration No. 1,602,298 to Registrant on February 22, 2002, wherein the Assignment was recorded on March 29, 2002 at Reel/Frame 2474/0528,¹ despite the fact that the Petitioner is the true owner of the registration.

(d) The fraudulent assignment from Gallant to Registrant of Registration No. 1,602,298 corresponding to the mark "PORTER" and design is invalid because Petitioner holds title to the mark fraudulently conveyed to Registrant, and Gallant cannot assign that which it does not own. Moreover, by reason of the common controlling members of Gallant and Registrant, Registrant had knowledge, and was on notice, that the "PORTER" and design mark lawfully belonged to Petitioner at the time Registrant entered into the assignment agreement with Gallant.

(e) Gallant fraudulently assigned the mark "PORTER DASH!" and design under Registration No. 2,131,161, to Registrant on February 22, 2002, wherein the Assignment was recorded on March 29, 2002 at Reel/Frame 2474/0528, despite the fact that the Petitioner is the true owner of the registration.

(f) The fraudulent assignment from Gallant to Registrant of Registration No. 2,131,161 corresponding to the mark "PORTER DASH!" and design is invalid because Petitioner holds title to the mark fraudulently conveyed to Registrant, and Gallant cannot assign that which it does not own. Moreover, by reason of the common controlling members of Gallant and Registrant, Registrant had knowledge, and was on notice, that the "PORTER DASH!" mark lawfully belonged to Petitioner at the time Registrant entered into the assignment agreement with Gallant.

¹ It appears the Assignment was incorrectly recorded as assigning registration number 1,602,289, while it in fact should refer to registration 1,602,298, which corresponds to Petitioner's "PORTER" mark and design.

(g) The attempted assignments, when considered in conjunction with the intimate relationship between Gallant and Registrant, demonstrate an attempt by Registrant to trade upon the goodwill behind Petitioner's "PORTER DASH!" and "PORTER" and design marks.

6. Petitioner is the true and legal owner of Registration No. 1,602,298 corresponding to the mark "PORTER" and design, registered on June 19, 1990, for use on travel articles made from leather and imitation leather namely, shoulder bags, carry-on bags, sports bags for all purposes and luggage in International Class 18, wherein said registration was held by Gallant, and now Registrant, under a constructive trust for the benefit of Petitioner, which trademark is now incontestable, which trademark has been used continuously by Petitioner, either through its own use or that of its licensee, both prior to the priority date of the application for Registration No. 1,602,298, and upon information and belief, prior to any use by Registrant of the mark "PORTER" and design No. 1,602,298.

7. Petitioner is the true and legal owner of Registration No. 2,131,161 corresponding to the mark "PORTER DASH!" and design registered on January 20, 1998, for use on purses, wallets, cosmetic bags sold empty and purses for beauty products sold empty, ladies handbags, baby carriers worn on the body, backpacks, all purpose athletic bags, all purpose sport bags, beach bags, carry-on bags, clutch bags, duffel bags, leather shopping bags, overnight bags, school bags, shoulder bags, textile shopping bags, tote bags, travel bags, garment bags for travel, shoe bags for travel, briefcases, suitcases, luggage, key cases, and briefcase-type portfolios, in International Class 18, wherein said registration was held by Gallant, and now Registrant, under a constructive trust for the benefit of Petitioner, which trademark is now incontestable, which trademark has been used continuously by Petitioner, either through its own use or that of its

licensee, both prior to the priority date of the application for Registration No. 2,131,161, and upon information and belief, prior to any use by Registrant of the mark "PORTER DASH!" and design No. 2,131,161.

8. Gallant, and/or its counsel of record, committed the following acts of fraud and material representation during the prosecution of the application that led to Registration No. 1,602,298:

(a) applied for registration of the "PORTER" and design mark falsely identifying Gallant as the owner of the mark, instead of naming the true owner, Yoshida & Company, Ltd.;

(b) responded on November 30, 1989 to the Examining Attorney's inquiry regarding the goods being manufactured in Tokyo and statement that "only the owner of a mark may apply for registration" by falsely remarking as follows:

. . . Counsel is informed by the applicant that the Japanese OEM manufacture which manufactured some of the products bearing the instant trademark printed the swing tags and placed "Made in Tokyo" on them. It is quite usual and acceptable for a company to have others manufacture their products and the instant applicant controls the nature and quality of the products by giving instructions to the OEM or manufacturer. In circumstances such as these the manufacturer does not own the mark, but rather simply makes the goods on contract for the owner of the mark and it is counsel's understanding that the manufacturer of these goods does not use the mark as its own.

The remarks made to the Examining Attorney falsely state that the applicant's licensor and true owner of the mark, Yoshida & Company, Ltd., is a "Japanese OEM manufacturer" who does not own or use the mark as its own.

(c) submitted a Declaration under Sections 8 and 15 by Mr. Ming-Teng Lin on January 15, 2004 falsely identifying Gallant Industries Co., Ltd. as the owner of Registration No. 1,602,298 instead of the true owner, Yoshida & Company, Ltd.

(d) submitted a Declaration under Section 8 and Application for Renewal under Section 9 by Mr. Ming-Teng Lin on June 19, 2000 falsely identifying Gallant Industries Co., Ltd. as the owner of Registration No. 1,602,298 instead of the true owner, Yoshida & Company, Ltd.

9. As a result of Petitioner's and its licensee's use of the marks discussed above on its products, and of the advertising, promoting, and marketing conducted by Petitioner and/or its licensee, Petitioner's products and the trademarks included thereon now possess a wide and favorable reputation. Accordingly, the trade and purchasing public have come to know and recognize Petitioner's trademarks as identifying the products of Petitioner exclusively, whereby Petitioner has acquired a valuable goodwill behind its above-identified trademarks.

10. Because the mark "PORTER DASH!" and design used by the Registrant is confusingly similar to Petitioner's mark "PORTER" and design Registration No.1,602,298 (held under a constructive trust for the benefit of Petitioner); and Registrant purportedly uses the mark on goods related to those on which the Petitioner has used its registered marks, and goods which Petitioner may naturally pursue as it further develops and expands use of its mark, Registrant's use of the mark "PORTER DASH!" and design would cause both the trade and purchasers to believe that Registrant's goods originate from the Petitioner or an entity in some way associated with the Petitioner, all to Petitioner's damage.

11. Because the mark "PORTER DASH!" and design used by the Registrant is confusingly similar to Petitioner's mark "PORTER DASH!" and design No. 2,131,161 (held

under a constructive trust for the benefit of Petitioner); and Registrant purportedly uses the mark on goods related to those on which the Petitioner has used its registered mark, and goods which Petitioner may naturally pursue as it further develops and expands use of its mark, Registrant's use of the mark opposed herein would cause both the trade and purchasers to believe that Registrant's goods originate from the Petitioner or an entity in some way associated with the Petitioner, all to Petitioner's damage.

12. As Petitioner's marks and Registrant's mark are extremely similar, used on related products, marketed towards the same consumers, and sold through the same channels of distribution, the trade and purchasers are likely to believe, and would be justified in believing, that Registrant's use of the mark is authorized or sponsored in some manner by Petitioner, causing damage to Petitioner, its products, and its marks.

13. If Registrant's registration is not cancelled, Registrant would be awarded the prima facie right to exclusive use of the mark on the goods described in the Registration, such that Registrant's mark would cause damage to Petitioner and confusion to the purchasing public who rely upon Petitioner's trademarks to indicate that they are purchasing a reputable product having the high quality they have come to expect from Petitioner's products.

14. Since Registrant's mark is strikingly similar to two of Petitioner's marks, the use or continued registration by Registrant of this mark will:

- (a) be likely to cause confusion or mistake or otherwise deceive customers;
- (b) enable Registrant to unfairly benefit from and take advantage of the goodwill established by Petitioner and the strong reputation earned by Petitioner associated by the purchasing public with Petitioner's trademarks;
- (c) dilute the distinctiveness of Petitioner's trademarks; and

(d) allow Registrant to benefit from the fraudulent assignment of Petitioner's marks;
all to Petitioner's damage.

15. Petitioner is the true owner of the marks "PORTER" and design and "PORTER DASH!" and design and therefore Registrant cannot legally claim or maintain ownership of the "PORTER" and design registration under its own name because it is not, and was not at the time of the assignment thereof by Gallant to Registrant, or thereafter, the rightful owner of the mark.

16. Registrant has abandoned the mark identified in paragraph 1 hereof.

17. Once the licensing arrangement was terminated as set forth in paragraph 4(f) hereof, neither Gallant nor Registrant had the right to use the "PORTER DASH!" and design mark whereby any such use by Gallant or Registrant did not inure to the benefit of Registration No. 2,131,161, and as a result lawful use of the registered mark has been discontinued by Registrant with intent not to resume lawful use of the mark.

18. The registered mark is being used by Registrant so as to misrepresent the source of the goods on or in connection with which the mark is used, because Registrant is not the owner or authorized user of the mark.

WHEREFORE, Petitioner respectfully requests the Board to cancel the registration No. 2,131,161 and sustain this Petition.

The required fee of \$300.00 accompanies the duplicate copies of this Petition to Cancel. Please charge any excess fees to the Deposit Account No. 13-2725 of Petitioner's counsel noted below.

The undersigned hereby appoints Paul A. Welter, Scott W. Johnston, Anna W. Manville, Gregory C. Golla, Allan Kowalchyk and Todd S. Werner, of the firm Merchant & Gould P.C.,

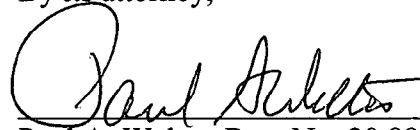
3200 IDS Center, 80 South Eighth Street, Minneapolis, MN, 55402, its attorneys to prosecute this opposition with full power of substitution and revocation, and to transact all business in the Patent and Trademark Office connected herewith.

Please direct all correspondence to the attention of Paul A. Welter, Merchant & Gould P.C., Box 2910, Minneapolis, Minnesota 555402-0910, telephone (612) 332-5300.

RESPECTFULLY SUBMITTED,

YOSHIDA & COMPANY, LTD.

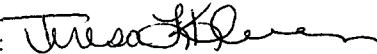
By its attorney,



Paul A. Welter, Reg. No. 20,890
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
612-336-4600

Dated: 2-9-05

CERTIFICATE UNDER 37 CFR 2.197: The undersigned hereby certifies that this correspondence is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on February 9, 2005.

By: 
Name: Teresa L. Kleven