

Attorney's Docket No.: C0641.50055US00

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

Registrant: Claire Fabrics (1996), Inc.
Registration No.: 2,719,827
Date Registered: May 27, 2003
Mark: CLAIRE'S DESKTOP CATALOG

76206411

CBI DISTRIBUTING CORP.,)
Petitioner,)
v.)
Claire Fabrics (1996), Inc.)
Registrant.)

Cancellation No.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §2.197

The undersigned hereby certifies that this document and enclosures are being placed in the United States mail with first-class postage attached, addressed to Trademark Trial and Appeal Board, U.S. Patent and Trademark Office, P.O. Box 1451, Alexandria, VA 22313-1451, on the 30th day of December, 2005.

Kate Emerson
Kate Emerson

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Sir:

Transmitted herewith are the following documents:

- Petition for Cancellation (in duplicate)
- Return Receipt Postcard

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (617) 646-8000, Boston, Massachusetts.

A check in the amount of \$300.00 is enclosed. If an additional fee is required, it may be charged to the account of the undersigned, Deposit Account No. 23/2825. A duplicate of this sheet is enclosed.

Respectfully submitted,
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xNDDx



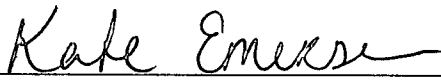
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Kate Emerson

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
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Alexandria, VA 22313-1451

PETITION FOR CANCELLATION

Sir:

This Petition for Cancellation relates to Registration No. 2,719,827 for CLAIRE'S DESKTOP CATALOG, for wholesale and online retail store services featuring home and decorating products and furnishings, in International Class 35; registered on May 27, 2003.

According to the electronic records of the United States Patent and Trademark Office, the record

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owner of this registration is Claire Fabrics (1996), Inc. (hereinafter "Registrant"), a Canadian corporation, having an address at 5750 Royalmount, Montreal, Quebec H4P 1K5, Canada.

CBI Distributing Corp. and its various related corporations (hereinafter "Petitioner"), a corporation of Delaware, having a corporate address at 1209 Orange Street, Corporation Trust Center, Wilmington, Delaware 19801, believes it will be damaged by the continued registration of the mark CLAIRE'S DESKTOP CATALOG and hereby seeks cancellation of registration of the same.

The grounds for this petition for cancellation are as follows:

1. Petitioner has made extensive and substantially exclusive use in interstate commerce of the mark CLAIRE'S in connection with numerous goods and services including wholesale and online retail store services featuring home and decorating products and furnishings, since long prior to the earliest date upon which Registrant may rely and therefore has established common law rights to the mark.

2. In addition to the common law rights established in the mark CLAIRE'S for numerous goods and services including wholesale and online retail store services featuring home and decorating products and furnishings, Petitioner has used CLAIRE'S, inter alia, as a mark and name for an extensive line of disparate goods, retail and online services throughout the United States and is the owner of numerous United States trademark registrations and applications for CLAIRE'S in block letter and stylized letters, as well as CLAIRE'S with a variety of suffix elements or in combination with other terms and designs, for such goods and services ("CLAIRE'S marks").

3. Registrations and applications to register marks owned by Petitioner include:

MARK	SERIAL/REG. NO.	GOODS/SERVICES	FIRST USE
CLAIRE'S	S.N. 78/149,323 Filed 07/31/02	cosmetics and toiletry products, jewelry, stationery products, automobile accessories, removable tattoos, clothing and clothing accessories, hair goods in the nature of barrettes, hair ties, hair decorations, hair claws, combs and brushes, pillow cases, cell phone holders, furniture, accessories in the nature of switch plate covers, doorknob hangers, touch lamps, night lights, and inflatable furniture, incense, incense holders with incense, incense sticks and cones, candles, and air fresheners, containers for trinkets and coins	October 1992
CLAIRE'S	S.N. 78/149,317 Filed 07/31/02	retail store services dealing in notions, cosmetics, jewelry, stationery products, hair goods, clothing accessories and the like primarily for women and girls	October 1992
CLAIRE'S and Design	Reg. 2,623,039	retail store services dealing in men and women's jewelry, wallets, key chains, sunglasses, removable tattoos, hats, notions, clothing, women's clothing, women's clothing accessories, namely handkerchiefs, scarves, jewelry, hair bands, hair goods, cosmetics and perfumes	1994
CLAIRELING	Reg. 2,415,403	retail stores services featuring men's, women's and children's clothing, accessories, jewelry, wallets, key chains, sunglasses, removable tattoos, notions, accessories, perfumes, hair goods and handkerchiefs	March 26, 1999
CLAIRE'S	Reg. 1,929,317	eardrops for application on pierced ears	August 31, 1993
CLAIRE'S BOUTIQUES	Reg. 1,514,045	retail store services for the sale of ladies' accessories	December 31, 1973
CLAIRE'S	Reg. 1,925,359	jewelry, namely earrings, necklaces, rings, bracelets, ornamental pins and hair ornaments	June 20, 1993
CLAIRE'S ETC.	Reg. 2,065,959	retail store services dealing in men's and women's jewelry, wallets, key chains, sunglasses, removable tattoos, hats, notions, clothing, women's clothing and accessories, perfumes, hair goods and handkerchiefs	July 4, 1996
CLAIRE'S ACCESSORIES	Reg. 1,956,047	retail store services featuring ladies' accessories	September 1994

MARK	SERIAL/REG. NO.	GOODS/SERVICES	FIRST USE
CLAIRE'S ACCESSORIES	Reg. 1,946,557	retail store services featuring ladies' clothing accessories and jewelry	September 1994
CLAIRE'S stylized	Reg. 1,890,335	retail store services featuring ladies' clothing accessories and jewelry	October 28, 1992
CLAIRE'S stylized	Reg. 1,891,172	women's belts, stockings and hosiery	June 20, 1993
CLAIRE'S ETC.	Reg. 2,064,149	retail store services dealing in men's and women's jewelry, wallets, key chains, sunglasses, removable tattoos, hats, notions, clothing, women's clothing and accessories, perfumes, hair goods and handkerchiefs	July 4, 1996
CLAIRE'S ACCESSORIES & Design	Reg. 2,294,937	retail stores services dealing with men's and women's jewelry, wallets, key chains, sunglasses, removable tattoos, hats, notions, clothing including women's clothing, perfumes, hair goods and handkerchiefs	September 17, 1996
CLAIRE'S CLUB	Reg. 2,908,191	hair goods, namely, clips, hair bows, ponytail twisters, hair bands, hair claws, snap clips, snap tops, salon clips, bobby pins; artificial flower bridal bouquets	January 2002
CLAIRE'S CLUB	Reg. 2,908,862	cosmetics	January 2002
CLAIRE'S CLUB	Reg. 2,908,863	sunglasses; telephones	January 2002
CLAIRE'S CLUB	Reg. 2,908,864	electric night lights and flashlights	January 2002
CLAIRE'S CLUB	Reg. 2,908,865	tiaras, jewelry, earrings, necklaces, bracelets, and bracelets, necklaces and earrings sold in combination	January 2002
CLAIRE'S CLUB	S.N. 78/975,465 Filed 11/06/03	stationery, namely, notebooks, pens, pencils and organizers; photo albums	Intent-to-Use
CLAIRE'S CLUB	Reg. 2,908,866	bags, namely, backpacks, tote bags and wallets	January 2002
CLAIRE'S CLUB	Reg. 2,908,867	picture frames; mirrors; inflatable chairs; sleeping bags; pillows; non-metal hooks; decorative bead curtains	January 2002
CLAIRE'S CLUB	S.N. 78/975,468 Filed 11/06/03	trash cans; lunch boxes; bath accessories	Intent-to-Use

MARK	SERIAL/REG. NO.	GOODS/SERVICES	FIRST USE
CLAIRE'S CLUB	Reg. 2,908,868	hair goods, namely, bridal veils, floral head wreaths, headbands, head wraps, head scarves; apparel, namely, gloves, boas, footwear; slippers; flip flops; dress up shoes; dresses, capes, baseball hats and caps, visors, cowboy hats, socks belts	January 2002
CLAIRE'S	S.N. 78/975,445 Filed 11/04/03	cosmetics, namely lip gloss wands, lipstick, hair dyes, blush, antiperspirants, perfume balm, powder having reflective qualities for topical application to the skin or hair for cosmetic purposes, bath and body gels, bath and body lotions, nail polish, hair lotions	June 2002
CLAIRE'S	Reg. 2,908,857	cell phone holders and furniture accessories in the nature of switch plate covers	January 1996
CLAIRE'S	Reg. 2,908,858	nightlight and touch lamps	April 2002
CLAIRE'S	S.N. 78/975,448 Filed 11/04/03	jewelry, belly chains, bracelets, toe rings, body clips, ear cuffs, earring holders	Intent-to-Use
CLAIRE'S	Reg. 2,908,859	stationery, notebooks, address books, diaries, temporary tattoos, photo albums	January 2000
CLAIRE'S	Reg. 2,908,860	inflatable furniture, hangers for attaching to doorknobs	January 1997
CLAIRE'S	S.N. 78/975,451 Filed 11/04/03	hairbrushes and hair combs	October 1992
CLAIRE'S	S.N. 78/975,452 Filed 11/04/03	containers made primarily of plastic for holding trinkets and coins	January 2001
CLAIRE'S	Reg. 2,900,024	pillows, pillow cases	January 1997
CLAIRE'S	S.N. 78/975,454 Filed 11/04/03	clothing, namely, socks, hats, gloves, shirts	June 2002
CLAIRE'S	Reg. 2,908,861	hair accessories, namely, barrettes, hair bows, hair ornaments, claw clips, head wraps	September 2000
CLAIRE WEAR	S.N. 78/269,290 Filed 07/01/03	clothing for stuffed toy animals	Intent-to-Use
CLAIRE'S	S.N. 78/269,386 Filed 07/01/03	gift wrap, stationery and greeting cards	Intent-to-Use
CLAIRE'S	S.N. 78/975,382 Filed 03/08/04	issuing gift certificates which may be redeemed for goods	Intent-to-Use

4. Petitioner operates in the order of 3,500 stores worldwide, with most of these operated in the United States. Through these thousands of stores located throughout the United States and overseas, Petitioner actively and continuously uses and promotes the CLAIRE'S marks in commerce for a wide range of goods and services including but not limited to retail and online store services, featuring home and decorating products and furnishings since long before the filing date of Registrant's intent-to-use application.

5. Petitioner has offered many lines of products under the CLAIRE'S mark for years. These products are sold in retail establishments and on the internet prominently identified by the mark CLAIRE'S or CLAIRE'S in association with another term. By virtue of Petitioner's active use and promotion of its CLAIRE'S marks, CLAIRE'S has become a formative mark for products of the type sold by Petitioner. Further, the public recognizes that goods and services sold in connection with the CLAIRE'S marks, including in their stores and online, originate with Petitioner and its related companies, and further associate goods whether or not branded by Petitioner. Petitioner has created considerable goodwill in the CLAIRE'S marks.

6. Through Petitioner's extensive use, the CLAIRE'S marks have achieved fame throughout the United States. Such fame was established well prior to the Registrant's filing of its application on January 30, 2001.

7. Notwithstanding Petitioner's ownership, prior rights and use of the CLAIRE'S marks for numerous goods and services, Registrant filed an intent-to-use application on January 30, 2001, under Serial No. 76/206411 for CLAIRE'S DESKTOP CATALOG, which issued into Registration No. 2,719,827, dated May 27, 2003. Registrant's filing date and alleged date of first use are junior to many of Petitioner's numerous uses.

8. Registrant's mark CLAIRE'S DESKTOP CATALOG, as shown in Registration No. 2,719,827 is confusingly similar to Petitioner's CLAIRE'S marks and is intended to be used on identical or substantially similar services to those which Petitioner uses the CLAIRE'S marks.

9. Potential consumers of Registrant's products sold under the CLAIRE'S DESKTOP CATALOG mark are likely to believe that such services originate from or are approved by Petitioner, when in fact, they do not originate with Petitioner and are not approved by Petitioner, causing a likelihood of confusion in the marketplace.

10. Registrant's registration and use of a mark that sounds similar and appears similar to Petitioner's famous CLAIRE'S marks for services that are identical or substantially similar to goods and services that have been sold in association with Petitioner's CLAIRE'S marks would dilute the value of Petitioner's CLAIRE'S marks.

11. Petitioner filed an intent-to-use based trademark application for CLAIRE'S DESKTOP CATALOG under Serial Nos. 76/206,411 on January 30, 2001, for "wholesale and online retail store services featuring home and decorating products and furnishings."

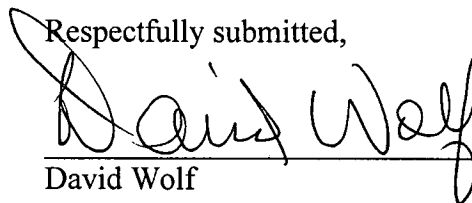
12. The registration that issued to the Registrant has been cited by the Examining Attorney against the registration of Petitioner's trademark application, further evidencing the potential for likelihood of confusion and dilution.

13. The registration that issued to Registrant is preventing Petitioner from registering marks to which it has prior rights, preventing Petitioner from enjoying full rights in its mark, potentially causing confusion among consumers, and potentially causing dilution of Petitioner's famous mark, thereby harming Petitioner. Petitioner will continue to be so harmed unless Registrant's registrations is cancelled.

WHEREFORE Petitioner believes that it will be damaged by Registrant's Registration No. 2,719,827 for , CLAIRE'S DESKTOP CATALOG and prays that this Petition for Cancellation be sustained.

The filing fee for this Petition for Cancellation in the amount of \$300.00 is herewith enclosed. This Petition for Cancellation is submitted in duplicate. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment in connection with this matter to our Deposit Account No. 23/2825.

Respectfully submitted,



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