

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

In re Registration No. 2892216 / 76143542
Registered October 12, 2004

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PIONEER KABUSHIKI KAISHA ata	:	
PIONEER CORPORATION	:	
	:	
Petitioner,	:	Cancellation No. _____
	:	
-against-	:	
	:	
PIONEER LICENSING SERVICES INC.,	:	
	:	
Registrant.	:	
-----X	:	

To: TTAB

PETITION FOR CANCELLATION

Petitioner, a corporation organized and existing under the laws of Japan, located at 4-1, Meguro 1-Chome, Meguro-ku, Tokyo 153-8654, Japan, believes that it will be damaged by the continued registration of U.S. Reg. No. 2892216 for the mark PIONEER SERVICES P SINCE 1932 & Design in Classes 35 and 36, issued on October 12, 2004 to Pioneer Licensing Services, Inc. ("Registrant"), and hereby petitions to cancel the same. As grounds therefor, Petitioner alleges as follows:

**COUNT 1 – INVALIDITY/FRAUD DUE TO LACK OF
USE AT THE TIME OF FILING FOR CLASS 35 SERVICES**

1. Petitioner is the owner of the famous mark PIONEER for consumer electronic products. Petitioner intends to expand the use of its famous mark PIONEER in the U.S. to "retail store services and on-line retail store services, both featuring consumer electronic products," so that it can sell its PIONEER consumer electronic products in

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its own stores and in its own e-commerce website. Petitioner owns an application for PIONEER for those services, Serial No. 78/781,566.

2. The examining attorney has cited, as a bar, against that application, the registration at issue in this proceeding, Reg. No. 2892216, and specifically the Class 35 services in that registration, "retail store services featuring general consumer goods." The examining attorney's Office Action says that this blocking citation is justified "because retail store services featuring general consumer goods may include consumer electronic equipment." It also says:

"Since the identification of the registrant's services is very broad, it is presumed that the registration includes all services of the type described, including those in the applicant's more specific identification, that they move in all normal channels of trade and that they are available to all potential customers" (page two of March 14, 2006 Office Action).

In addition, the examining attorney cites the pending application of respondent for the mark PIONEER SERVICES, SN 78/773667, for the same services, "retail store services featuring general consumer goods," in Class 35.

3. Both the pending application for PIONEER SERVICES and the registration at issue also include Class 36 financial services, that is, "consumer loan services; consumer credit counseling."
4. Upon information and belief, respondent is not in the business of operating retail store services featuring a variety of consumer goods. Upon information and belief, respondent does not operate retail stores at all in the conventional sense. Rather, respondent operates consumer loan offices in or adjacent to U.S. military bases, in which it offers consumer loans and credit counseling to soldiers and their families.

5. Upon information and belief, respondent claimed use of the mark for Class 35 retail store services based on activities conducted at such retail loan offices.
6. Upon information and belief, those loan offices are not authorized, under their agreements with the federal government agency that controls commercial activities on military bases, to operate conventional retail stores in competition with the post exchange retail stores on the same military bases. Rather, under those agreements, the respondent is authorized only to operate consumer loan offices.
7. Upon information and belief, to the extent that the respondent might sell a small handful of tangible products in its loan offices, that activity is completely ancillary to the services rendered at those loan offices, such as the sale of a book entitled "Personal Finance For Military Families." This book tells soldiers and their families how to manage their finances, including how best to use the consumer loan services and consumer credit counseling services offered by the respondent.
8. Respondent operates a website under the domain name www.pioneershopping.com, which offers descriptions of its "products" and "services." All the "products" offered on that website are actually financial services, such as various types of loans and mortgages. The various "services" on the website are various types of financial services, such as debt consolidation, financial education, credit reports, credit analysis, investment counseling, provision of a retail discount card for third-party stores, auto insurance, income tax preparation, and the like.
9. Upon information and belief, the website contains an e-commerce shopping section, with an online catalogue. The online catalogue contains precisely one conventional, tangible product for sale, the book entitled "Personal Finance for Military Families."

10. Upon information and belief, on the filing date of the use-based application, that matured into the registration at issue, October 10, 2000, the respondent's retail store activities (or, rather, lack of retail store activities) were essentially as described above, with one possible exception. Upon information and belief, the respondent was then offering a prepaid cellular telephone package to its customers at some of its PIONEER SERVICES loan centers. Upon information and belief, as part of offering cellular telephone service, the respondent may have sold an occasional cell phone. Upon information and belief, respondent did not sell cellular phones independent of cell phone service plans and only sold cell phones compatible with the particular cellular phone network in the cellular phone service plan offered by the respondent.
11. Upon information and belief, the specimen of use filed with the application mentions a "prepaid cellular phone package" and no tangible products.
12. Upon information and belief, the respondent's attorney at all times during the prosecution of such application was Lawrence Swain, a shareholder in the firm of Shughart, Thomson & Kilroy P.C. in Overland Park, Kansas. That firm is a large commercial law firm.
13. Mr. Swain's website holds Mr. Swain out as having a "rare combination of Business Law and Intellectual Property expertise" and says that he is a member of the "Intellectual Property" practice group of the firm and a member of the "Patent Trademark and Copyright Law Committee" of the Missouri bar and a frequent speaker on the subject of intellectual property, among other topics. It also describes Mr. Swain as a 1977 graduate of the University of Kansas Law School.

14. An experienced trademark law practitioner, such as Mr. Swain, knew, or certainly should have known, in 2000, that USPTO practice on recitations of services for marks for retail services was as follows. The USPTO required the type of goods sold in retail stores to be identified by general type, such as furniture, drugs or clothing. The USPTO does not accept the vague term “consumer goods” alone to describe the type of goods sold at retail stores. The USPTO might accept the phrase “general consumer goods,” or an equivalent phrase, but its practice was then (and is now) to do so only where the applicant actually sells a wide variety of consumer goods that could not easily be placed in a single category, such as goods sold at a general store, a variety store or convenience store. Conforming to that practice, some approved terms in the on-line database of approved identifications for Class 35 are:

- retail store services featuring a wide variety of consumer goods of others (effective 6/1/01)
- retail variety stores (effective 1/2/97)
- retail convenience stores (effective 1/2/97)

15. Upon information and belief, the word “general” in the context of the Class 35 recitation of services at issue here means “not confined by specialization or careful limitation” (one dictionary definition of the word) and is similar in meaning to the word “general” in “general store,” which is defined in one dictionary as “a retail store located usually in a small or rural community that carries a wide variety of goods including groceries but is not divided into departments.” Upon information and belief, both at the time of filing of the use-based application concerned in 2000 and at the present time, the respondent was not, and is not, using the mark at issue for

services of a general store, variety store, convenience store or any other store selling a wide variety of consumer goods or “general consumer goods.” Rather, on information and belief, through sophisticated counsel, respondent deliberately used overbroad and misleading language in order to claim service mark rights to which it was not entitled and knew it was not entitled. Accordingly, the entire registration is invalid on grounds of fraud. The Class 35 portion of the registration is also invalid for lack of use with the Class 35 services. Consumer goods sold by respondent (if any) were purely ancillary to the provision of other services, such as offering cell phones with cellular telephone service or offering books with financial services (that is, any goods provided were provided as an ordinary part of the provision of non-retail services and were not independent retail store services featuring “general consumer goods”).

COUNT 2 – ABANDONMENT AS TO CLASS 35

16. Upon information and belief, even if the registration at issue was valid and non-fraudulent at the time of issue, respondent has not used the mark for the particular services claimed in Class 35 of the registration, “retail store services featuring general consumer goods.” This is because such language means retail store sales of a wide variety of consumer goods. Respondent also has no intention of resuming such use. On that basis, the registration is abandoned for non-use, as to Class 35.
17. Upon information and belief, respondent has not plans to convert its retail loan stores into convenience stores or other types of stores selling a wide variety of tangible consumer goods, as distinct from loan “products” that are actually financial services.

COUNT 3 – PARTIAL ABANDONMENT

18. To the extent that registration at issue might not be entirely abandoned, due to non-use, the registration has been partially abandoned, in Class 35, due to non-use of the mark for the very broad claimed services. Accordingly, and in line with USPTO identification practice, the Class 35 recitation of retail store services should be modified to indicate the particular types of consumer goods actually sold currently under the mark and that are not merely incidental to non-retail services. For example, if the respondent is actually considered to be selling only books, and the sale of books is not incidental to other services, then the recitation of services in Class 35 should be narrowed to "retail store services featuring general consumer goods, namely, books."

WHEREFORE, Petitioner requests that Registration No. 2892216 be cancelled.

Please charge the cancellation fee in the sum of \$600.00 for two classes to our Deposit Account No. 23-0825.

Dated: New York, New York
July 13, 2006

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

David Ehrlich

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