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

Proceeding	92050143
Party	Plaintiff Browhaus Pte Ltd
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Date	10/29/2009
Attachments	Browhaus Amended Petition.pdf (11 pages)(350218 bytes)

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

BROWHAUS PTE LTD.,

Petitioner,

v.

BRAUHAUS INCORPORATED,

Respondent.

Cancellation No.
92050143

Registration No.
3,420,788

AMENDED PETITION FOR CANCELLATION

Browhaus Pte Ltd. (“Petitioner”), a private limited company organized under the laws of Singapore, having its corporate offices at 1 Scotts Road #19-04/05, Shaw Center, Singapore 228208, by and through its counsel, hereby amends its Petition for Cancellation as memorialized in the Order of the Trademark Trial and Appeal Board, dated September 30, 2009 (“Order”). The Order granted Respondent’s motion over the continued objection of Petitioner. Notwithstanding the Order, Petitioner continues to believe that it will be damaged by Registration No. 3,420,788 for the mark BRAUHAUS, and hereby amends its petition to cancel said registration.

As grounds in support of its petition to cancel, Petitioner asserts as follows:

1. According to the records of the United States Patent and Trademark Office (“USPTO”), Brauhaus Incorporated (“Respondent”) is the owner of the U.S. Registration No. 3,420,788 for the mark BRAUHAUS for “Beauty salons.”

2. Petitioner is the owner of U.S. Mark Application Serial No. 77/019510, filed on October 12, 2006, for the mark BROWHAUS & Design for “Hygiene and beauty care of human beings; eye brow trimming; eye brow threading; and eyelash perming.”

3. In an Official Action dated February 28, 2007, the USPTO Examining Attorney refused registration for the mark in U.S. Mark Application Serial No. 77/019510, citing, *inter alia*, a potentially conflicting mark in a prior-filed pending application, namely, the then pending U.S. Mark Application Serial No. 78/705848.

4. Without conceding the correctness of that refusal to register, Petitioner requested suspension of U.S. Mark Application Serial No. 77/019510 on March 6, 2007. Petitioner will request the continued suspension of its application in view of the filing of this Petition for Cancellation.

5. On February 11, 2008, Respondent submitted a Request to Divide U.S. Mark Application Serial No. 78/705848.

6. The USPTO issued Respondent a Notice of Divisional Request on March 3, 2008. The request to divide U.S. Mark Application Serial No. 78/705848 was processed as follows:

7. Parent (original) U.S. Mark Application Serial No. 78/705848 contains the following goods: Class 3 For Eyebrow colors; eyebrow pencils; eye makeup; facial makeup; wax for hair removal; cosmetic oils; lipstick; makeup kits comprised of various cosmetics; lip gloss; eyeshadow; Class 5 For Applicator for applying hair growth stimulants containing hair growth stimulant; Class 8 For Tweezers; scissors; and Class 21 For Eyebrow brushes; stencils for applying makeup; applicator sticks for applying cosmetics.

8. Child application, U.S. Mark Application Serial No. 78/979944 contains the following services: Class 44 For Beauty salons.

9. A statement of use was filed on February 11, 2008 for the child application, Serial No. 78/979944.

10. Registration No. 3,420,788 issued from an application filed by Brauhaus Incorporated on September 2, 2005 for Serial No. 78/979944 – the child application. That application included a Declaration by Zoey Van Jones, President & CEO of Brauhaus Incorporated, dated February 3, 2008, verifying that applicant Brauhaus Incorporated, was using the mark BRAUHAUS in interstate commerce for the following services: “Beauty salons.”

CLAIM FOR CANCELLATION OF REGISTRATION FOR FRAUD

11. Petitioner repeats and realleges each and every allegation set forth in paragraphs “1” through “10” above, as if fully set forth herein.

12. On or about October 14, 2009, Petitioner retained the services of a private investigator to investigate the extent of Respondent’s use of the mark BRAUHAUS, and specifically, how the mark was being used.

13. On or about October 21, 2009 Petitioner’s private investigator, after completing its investigation advised Petitioner, *inter alia*, that: (1) in searching the internet at large, there was no indication that Respondent was using the BRAUHAUS mark outside of the State of California; (2) Respondent operates and has always only operated a single salon location based in Pasadena, California; and (3) Respondent does not engage in any business activity outside of the State of California, including any advertising.

14. On the basis of the allegations pled in the immediately preceding paragraphs, at the time of the signing of the Declaration by Ms. Van Jones, the mark BRAUHAUS was not being used in use interstate commerce for some or all of the services later identified in the child

application, Serial No. 78/979944, and Ms. Van Jones and Applicant knew or should have known that said mark was not in use in interstate commerce for some or all of the services.

15. On February 11, 2008, in connection with what would become the child application, Serial No. 78/979944, Respondent submitted a Statement of Use to the USPTO. Respondent's Statement of Use included a statement verifying that the mark BRAUHAUS "was first used by Applicant on or before December 1, 2007 and was first used in *interstate commerce* on or before December 1, 2007, in connection with "Beauty salons" in International Class 44." (Emphasis added.) A copy of Statement of Use and its supporting Declaration is attached hereto as Exhibit A.

16. At the time that Ms. Van Jones made her statements in her Statement of Use and supporting Declaration, Respondent knowingly made a false representation of material fact with the intent to deceive the USPTO which concerned Respondent's use of the BRAUHAUS mark in interstate commerce. Respondent's statement at issue was that the BRAUHAUS mark "was first used by Applicant on or before December 1, 2007 and was first used in *interstate commerce* on or before December 1, 2007, in connection with "Beauty salons" in International Class 44." (Emphasis added.)

17. On the basis of the allegations pled in the preceding paragraphs, the aforementioned statement is fraudulent in that Respondent has never used the mark in interstate commerce.

18. Respondent is a company that provides salon services, including eyebrow shaping, makeup services and bikini waxes. It has knowledge of its sales, or lack thereof, which is imputed to the company and its agents, such as Ms. Van Jones. Thus, Respondent knew that it was not making use of the mark in interstate commerce when it filed Exhibit A. Yet Respondent,

through its authorized representatives at Neal, Gerber and Eisenberg LLP, declared that it was doing so, despite the Declaration's language warning that: "The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that [s]he is properly authorized to execute this Statement of Use on behalf of the Applicant; [s]he believes the Applicant to be the owner of the trademark sought to be registered; and all statements made of his/her own knowledge are true and all statements made upon information and belief are believed to be true."

19. Respondent's Declaration bears Ms. Van Jones hand-written signature as well as its authorized attorneys' name, law firm address and other contact information. Further, Respondent's Declaration does not designate that any statement made in connection with either the Statement of Use or the supporting Declaration was made on information and belief. Thus, Ms. Van Jones declared on behalf of Respondent that the statements were true of her own knowledge. Moreover, Respondent's attorneys, who, upon information and belief, prepared Respondent's Application, Statement of Use and supporting Declaration were aware of the services covered in the application. Accordingly, the statements by Respondent to the USPTO that the mark BRAUHAUS was being used in interstate commerce on February 3, 2008 was both material and false and was relied upon by the USPTO in issuing Registration No. 3,420,788.

20. On information and belief, Respondent knowingly made such provably false material statements with the subjective intent to deceive the USPTO, and/or with the reckless disregard for the statements' truth or falsity, which may be reasonably inferred from the facts set forth above. Such information regarding subjective intent or reckless disregard is within the sole

possession of Respondent and/or its authorized attorneys, and cannot be obtained by Petitioner absent discovery.

21. On information and belief, the verified statement signed by the President and CEO of Brauhaus Incorporated and submitted as part of Application Serial No. 78/705848, which would later be incorporated into the child application, Serial No. 78/979944, contained knowingly false material representations of fact, and therefore constituted fraud in the procurement of Registration No. 3,420,788. As a consequence, Registration No. 3,420,788 in its entirety is void *ab initio*.

22. Thus, Registration No. 3,420,788 should be cancelled in its entirety for fraudulent registration in violation of 15 U.S.C. § 1064(3).

23. Petitioner is likely to be damaged by continuance of said registration covering said services, and Petitioner's use of its mark and its right to registration thereof will be impaired by the continued registration of said mark of Respondent for said services.

**CLAIM FOR CANCELLATION OF REGISTRATION
FOR LACK OF USE AS A MARK PRIOR TO REGISTRATION**

24. Petitioner repeats and realleges each and every allegation set forth in paragraphs "1" through "23" above, as if fully set forth herein.

25. In the above identified Statement of Use and supporting Declaration submitted in connection with Serial No. 78/705848, which would later be divided and for which the child application – Serial No. 78/979944 – would be issued Registration No. 3,420,788, Respondent alleged on or about February 3, 2008 that "[a]pplicant is using the mark in interstate commerce on or in connection with: 'Beauty salons.'"

26. On the basis of the allegations pled in the preceding paragraphs and upon information and belief, Respondent was not as of February 3, 2008, nor is it now using the mark

BRAUHAUS in interstate commerce, such that it is able to satisfy the requirements for trademark registration as set forth in the Lanham Act.

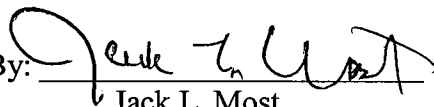
27. In light of the similarity between Petitioner's BROWHAUS & Design mark for "Hygiene and beauty care of human beings; eye brow trimming; eye brow threading; and eyelash perming" and Respondent's BRAUHAUS mark for "Beauty salons", Petitioner will be harmed if Respondent is allowed to continue to maintain its registration despite its lack of use of the mark in interstate commerce.

WHEREFORE, Petitioner prays that Registration No. 3,420,788 be cancelled and this Petition for Cancellation be sustained.

Petitioner has previously paid the \$300.00 filing fee for the petition to cancel.

Respectfully Submitted,

BROWHAUS PTE LTD.

By: 
Jack L. Most

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Attorneys for Petitioner

Joel G. MacMull
Of Counsel
GOETZ FITPATRICK LLP

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Brauhaus Incorporated)
)
 Mark: BRAUHAUS)
)
 Serial No.: 78705848)
)
 Filing Date: September 2, 2005)
)
 International Classes: 03, 05, 08, 21, 44)
)
 Notice of Allowance Mailing Date: August 8, 2006)

STATEMENT OF USE
UNDER 37 CFR 2.88, WITH DECLARATION

Applicant, Brauhaus Incorporated, requests registration of the above-identified mark in the United States Patent and Trademark Office on the Principal register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended). A specimen showing the mark as used in commerce in International Class 44 is submitted with this statement. Applicant is using the mark in interstate commerce on or in connection with: "Beauty salons."

The mark was first used by Applicant on or before December 1, 2007 and was first used in interstate commerce on or before December 1, 2007, in connection with "Beauty salons" in International Class 44.

This Statement of Use is being filed after a Notice of Allowance has issued, and is being submitted together with a Request to Divide. An Extension of Time form was filed online on February 4, 2008.

Payment in the amount of \$100 to cover the requisite fee involved may be extracted from the Neal, Gerber & Eisenberg deposit account, No. 502261.

DECLARATION

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that [s]he is properly authorized to execute this Statement of Use on behalf of the Applicant; [s]he believes the Applicant to be the owner of the trademark sought to be registered; and all statements made of his/her own knowledge are true and all statements made upon information and belief are believed to be true.

Date: 2.3.08

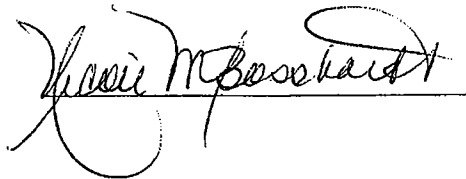
BRAUHAUS INCORPORATED

By: Name: Zoey Van JonesTitle: President/CEO

Lee J. Eulgen
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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313 on the 8th day of February, 2008.



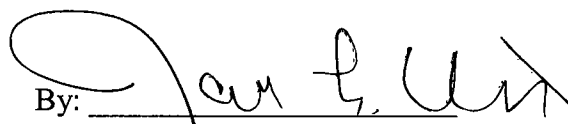
CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 29th day of OCTOBER, 2009, a true copy of the foregoing AMENDED PETITION FOR CANCELLATION was served by first-class mail, postage pre-paid on each the following:

Lee J. Eulgen
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street
Chicago, IL 60602

CERTIFICATE OF ELECTRONIC FILING

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 29th day of October, 2009.

By: 
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Attorney for Petitioner