

ESTTA Tracking number: **ESTTA363860**

Filing date: **08/18/2010**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Triumbari Corporation		
Entity	Corporation	Citizenship	Canada
Address	2150 Steeles Avenue East Brampton, L6T1A7 CANADA		

Attorney information	Camille M. Miller Cozen O'Connor 1900 Market Street IP Department Philadelphia, PA 19103 UNITED STATES cmiller@cozen.com Phone:2156657273
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**Registration Subject to Cancellation**

Registration No	3323848	Registration date	10/30/2007
Registrant	Norton, Joseph J. Suite 4 7743 Grand River Brighton, MI 48114 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 032. First Use: 1997/01/03 First Use In Commerce: 1997/01/03 All goods and services in the class are cancelled, namely: fruit flavored beverages
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**Grounds for Cancellation**

The mark comprises matter that, as a whole, is functional	Trademark Act section 2(e)(5)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Petition for Cancellation.pdf ( 11 pages )(375667 bytes )
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**Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Camille M. Miller/
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Name	Camille M. Miller
Date	08/18/2010

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

Triumbari Corporation	)	
	)	Cancellation No.
Petitioner,	)	
	)	U.S. Reg. No. 3,323,848
v.	)	
	)	
Joseph J. Norton	)	
	)	
Registrant.	)	
	)	

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**PETITION FOR CANCELLATION**

Triumbari Corporation, a company incorporated under the laws of the Province of Ontario, Canada ("Petitioner"), believes that it will be damaged by the continued registration of the appearance of a three dimensional configuration of a bottle shown in U.S. Trademark Registration No.3,323,848 ("Bottle Design"), as registered by Joseph J. Norton ("Registrant") and hereby petitions to cancel same. As grounds of cancellation, it is alleged that:

**Introduction**

1. Petitioner seeks cancellation of the registration of the Bottle Design on the grounds: a) that most aspects to its design are dictated by function; b) the design is not inherently distinctive nor has it acquired secondary meaning; and c) Registrant committed fraud upon the Trademark Office in that he made misrepresentations of material facts to the Examining Attorney about the functionality of the Bottle Design.

2. Petitioner has standing to bring this proceeding and will be damaged if the registration is not cancelled because: a) the registration of the Bottle Design improperly gives the Registrant presumptive exclusive rights to a functional and non-distinctive design that should be

available for all bottle manufacturers, including Petitioner, to use; and b) Registrant and his related company have brought a civil action against Great Lakes Bottling Company (“Great Lakes”), one of Petitioner’s customers, that is based, in part, on a claim that bottles manufactured by Petitioner infringe Registrant’s purported trademark rights in the Bottle Design and have obtained an injunction relating to the Bottle Design. Petitioner intends to challenge the injunction and seek a declaration that Registrant’s registration is invalid in the action (“Civil Action”). Registrant filed his Report on the Filing or Determination of an Action Regarding a Patent or Trademark on March 5, 2010, which clearly identifies Registration No. 3,323,848, the same registration at issue in this Cancellation Petition. We have attached the Report hereto as Exhibit A.

**The Parties**

3. Petitioner is a manufacturer of various bottles. Great Lakes has been purchasing stock beverage bottles from Petitioner for several years in 8 ounce, 10 ounce, 16.9 ounce, 20 ounce, 24 ounce, 1 liter and 1.5 liter sizes. The beverage bottle at issue in the Civil Action, and which is purportedly protected by U.S. Trademark Registration No. 3,323,848, is Petitioner’s 10 ounce stock bottle. Petitioner has been selling bottles similar to this stock beverage bottle since at least 1996 and has been selling the bottle at issue for many years.

4. Registrant, through his related company Bug Juice Brands, Inc., is a manufacturer and marketer of BUG JUICE® brand fruit flavored children’s beverages.

5. Registrant applied for the registration on December 23, 2004 and obtained U.S. Trademark Registration No. 3,323,848 on October 30, 2007.

### **The Bottle Design**

6. The Bottle Design is a design purporting to consist of the use of the wording BUG JUICE in connection with the appearance of a bottle as depicted below:



7. The description the Bottle Design in the Registration is as follows:

The mark consists of the three-dimensional configuration of a bottle containing the goods with the bottle being rounded at the top below the circular cap and the wording bug juice engraved into this upper section of the bottle. The middle section of the bottle is narrower than the top and the bottom sections. The bottom section of the bottle is also rounded and the same width as the top section. The bottom of the bottle is indented into the bottle.

*See Certificate of Registration attached hereto as Exhibit B.*

8. In order to maintain its registration, Registrant must demonstrate that the Bottle Design is both non-functional and distinctive.

### **The Trade Dress is Functional**

9. The Bottle Design consists of a combination of functional elements arranged in a functional manner.

10. The trade dress identification begins with a “three-dimensional configuration of a bottle containing the goods with the bottle being rounded at the top below the circular cap and the wording BUG JUICE engraved into this upper section of the bottle.”

11. Having the bottle rounded at the top below a circular cap is dictated solely by function, as the user of the bottle, specifically a child, requires a rounded top to drink more easily. Almost all bottles are round at the top below the circular cap.

12. The only arguable non-functional, aesthetic element of the above product packaging description is the wording BUG JUICE engraved into in the upper section of the bottle.

13. The trade dress identification continues with a claim that the “middle section of the bottle is narrower than the top and bottom sections.”

14. This element is dictated solely by function in that the middle section of a bottle must be narrower than the top and bottom sections to permit room for the label. If the middle section of the bottle was not narrower than the top and bottom sections, the label would rub against the other labels when packaged and the label would be consequently damaged. Further, the narrow middle section allows the bottle user to better grip the bottle. Since the users of Registrant’s bottle are children, this functional aspect is even more paramount. As such, a vast majority of bottles, including, but not limited to, water bottles, soda bottles and juice bottles, have a more narrow mid-section.

15. Next, the trade dress identification claims the “bottom section of the bottle is also rounded and the same width as the top section.” A rounded bottom section of a bottle is dictated purely by function as it enables the bottle to stand. Again, most bottles have a rounded bottom. Further, having the same width in the bottom section as the top section with an indented middle makes the bottle more stable for either standing or holding. Having a more stable bottle is even more essential here is the users of Registrant’s bottle are children.

16. Finally, the last claimed trade dress identification is that “the bottom of the bottle is indented into the bottle.” This element is also dictated purely by function which is clearly apparent as a majority of bottles have the bottom of the bottle indented into the bottle.

17. In summary, the only element of the Bottle Design that is nonfunctional is the wording BUG JUICE engraved into the upper section of the bottle.

18. As such, the remaining elements of the Bottle Design are functional and should not have been registered pursuant to Sections 1 and 2(e)(5) of the Lanham Act.

**The Trade Dress is Not Distinctive**

19. The Bottle Design is a product design.

20. The Supreme Court has ruled that product design, like color, can never be inherently distinctive and can only be protected upon a showing of secondary meaning (which is sometimes also referred to as acquired distinctiveness). *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205 (2000) (“*Wal-Mart*”).

21. The Bottle Design cannot continue to be registered unless it has developed secondary meaning.

22. The Bottle Design, and other similar bottle designs, are widely used by other manufacturers and marketers of bottles.

23. Petitioner has sold similar types of bottles since at least 1996.

24. The Bottle Design has not developed secondary meaning.

25. Assuming, in the alternative, that the aforementioned holding of the *Wal-Mart* decision does not apply to the Bottle Design, the design, in any event, could not be considered to be inherently distinctive as it consists of nothing more than a collection of

common, ordinary and functional features that are not arranged in any unique or distinctive manner.

26. Moreover, in the application process, Registrant submitted a survey in an attempt to establish that the term “Bug Juice” had acquired secondary meaning. Registrant did not submit any survey in connection with the Bottle Design. In connection with the Bottle Design, Registrant submitted a false declaration which stated that the Bottle Design had “become distinctive of the identified goods as a result of Registrant’s substantially exclusive and continuous use . . . in interstate commerce . . . .”

27. The Declaration submitted by Registrant is clearly false in that Petitioner has been using a similar bottle design since 1996.

28. The Bottle Design is not distinctive and should not have been registered pursuant to Sections 1 and 2 of the Lanham Act. (15 U.S.C. §§ 1051, 1052).

### **Fraud**

29. Registrant intentionally misrepresented material facts to the Examining Attorney in connection with this Registration and, upon information and belief, had these material facts been accurately represented, it would have caused the Examining Attorney to refuse to approve the Registration for publication.

30. In his response to a February 1, 2006 office action (“Response”), Registrant falsely claimed that his “bottle configuration has been in **exclusive and continuous use in interstate commerce for at least five years preceding the filing date of this application.**” See Response at 3 (emphasis added).

31. Additionally, in a Declaration attached to the Response, Registrant falsely claimed that the Bottle Design has become distinctive as a result of his “**substantially exclusive**



**and continuous use of the mark in interstate commerce.”** *See* Response at Ex. 4 (emphasis added).

32. Both of the above statements are clearly false in that Petitioner has been using a similar bottle design since at least 1996.

33. Upon information and belief, the Examining Attorney relied upon the above-referenced arguments and exhibits of Registrant in approving the Registration for publication.

34. Upon further information and belief, Registrant willfully and deliberately made these false statements of material fact to the Examining Attorney.

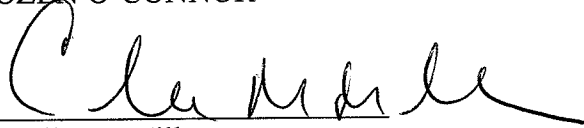
35. Upon information and belief, had the Examining Attorney been made aware of these false statements of material fact, the Examining Attorney would not have approved the Registration for publication.

36. Upon information and belief, Registrant’s submission of these false statements of material fact constitutes fraud on the Trademark Office.

WHEREFORE, Petitioner prays that U.S. Reg. No. 3,323,848 be cancelled and this Cancellation Proceeding be sustained in Petitioner's favor.

Respectfully submitted,

COZEN O'CONNOR

A handwritten signature in cursive script, appearing to read "Camille M. Miller", written over a horizontal line.

Camille M. Miller

Melanie A. Miller

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*Attorneys for Petitioner*

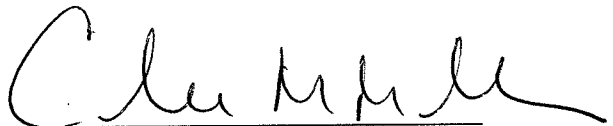
August 18, 2010

**CERTIFICATE OF SERVICE**

I hereby certify that on August 18, 2010 a true and correct copy of the foregoing Petition for Cancellation was served via first-class mail, delivery postage prepaid to at the addresses below:

Virginia R. Richard, Esq.  
Lana C. Marina, Esq.  
WINSTON & STRAWN LLP  
200 Park Avenue  
New York, NY 10166-4193

Joseph J. Norton  
7743 Grand River  
Suite 4  
Brighton, MI 48114

  
Camille M. Miller

AO 120 (Rev. 3/2004)

TO:	<b>REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK</b>
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In Compliance with 35 § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Western District of Michigan on the following  Patents or  Trademarks:

DOCKET NO. 1:10-cv-00229	DATE FILED 3/5/2010	U.S. DISTRICT COURT at Grand Rapids	
PLAINTIFF Bug Juice Brands, Inc., et al		DEFENDANT Great Lakes Bottling Company	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK	
1 3,323,848	Oct. 30, 2007	Norton, Joseph J.	
2 3,455,247	June 24, 2008	Norton, Joseph J.	
3 3,732,786	Dec. 29, 2009	Norton, Joseph J.	
4			
5			

In the above—entitled case, the following patent(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading			
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK		
1				
2				
3				
4				
5				

In the above—entitled case, the following decision has been rendered or judgment issued:

DECISION/JUDGMENT
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CLERK	(BY) DEPUTY CLERK By /s/ Carleen Rather	DATE 3/9/2010
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Copy 1—Upon initiation of action, mail this copy to Commissioner. Copy 2—Upon termination of action, mail this copy to Commissioner  
Copy 2—Upon filing document adding patent(s), mail this copy to Commissioner Copy 4—Case file copy

Exhibit A

Int. Cl.: 32

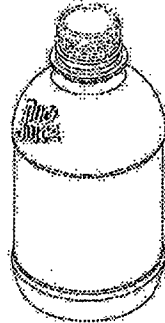
Prior U.S. Cls.: 45, 46 and 48

Reg. No. 3,323,848

**United States Patent and Trademark Office**

Registered Oct. 30, 2007

**TRADEMARK  
PRINCIPAL REGISTER**



NORTON, JOSEPH J. (UNITED STATES INDIVIDUAL)  
SUITE 4  
7743 GRAND RIVER  
BRIGHTON, MI 48114

FOR: FRUIT FLAVORED BEVERAGES, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 1-3-1997; IN COMMERCE 1-3-1997.

OWNER OF U.S. REG. NO. 2,202,350.

THE MARK CONSISTS OF THE THREE-DIMENSIONAL CONFIGURATION OF A BOTTLE CONTAINING THE GOODS WITH THE BOTTLE BEING

ROUNDED AT THE TOP BELOW THE CIRCULAR CAP AND THE WORDING BUG JUICE ENGRAVED INTO THIS UPPER SECTION OF THE BOTTLE. THE MIDDLE SECTION OF THE BOTTLE IS NARROWER THAN THE TOP AND BOTTOM SECTIONS. THE BOTTOM SECTION OF THE BOTTLE IS ALSO ROUNDED AND THE SAME WIDTH AS THE TOP SECTION. THE BOTTOM OF THE BOTTLE IS INDENTED INTO THE BOTTLE.

SEC. 2(F).

SER. NO. 78-537,703, FILED 12-23-2004.

HEATHER THOMPSON, EXAMINING ATTORNEY

*Exhibit B*