

ESTTA Tracking number: **ESTTA430595**

Filing date: **09/15/2011**

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	Painful Pleasures, Inc.		
Entity	Corporation	Citizenship	Maryland
Address	7410 Coca Cola Drive Suite 107 Hanover, MD 21076 UNITED STATES		

Attorney information	Noel Egnatios 3499 Heatherwood Dr. El Cajon, CA 92019 UNITED STATES noel.egnatios@gmail.com Phone:6193008062		
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Registration Subject to Cancellation

Registration No	3749131	Registration date	02/16/2010
Registrant	Harvey, James Suite B 5739 Auburn Blvd Sacramento, CA 95841 UNITED STATES		

Goods/Services Subject to Cancellation

Class 044. First Use: 2009/01/00 First Use In Commerce: 2009/01/00 All goods and services in the class are cancelled, namely: Tattooing services

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3462359	Application Date	07/27/2006
Registration Date	07/08/2008	Foreign Priority Date	NONE
Word Mark	PAINFUL PLEASURES		

Design Mark	Painful Pleasures
Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 1999/02/01 First Use In Commerce: 1999/02/01 jewelry

U.S. Application No.	85416243	Application Date	09/07/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PAINFUL PLEASURES		
Design Mark	PAINFUL PLEASURES		
Description of Mark	NONE		
Goods/Services	Class 008. First use: First Use: 2003/02/01 First Use In Commerce: 2003/02/01 body piercing apparatus, body piercing tools, body piercing needles		

U.S. Application No.	85416250	Application Date	09/07/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PAINFUL PLEASURES		

Design Mark	PAINFUL PLEASURES
Description of Mark	NONE
Goods/Services	Class 008. First use: First Use: 2005/01/01 First Use In Commerce: 2005/01/01 Tattoo machines, tattoo machine parts, tattooing supplies, namely, needles, grips, tubs, tips, nipples, grommets, ink

Attachments	78938618#TMSN.jpeg (1 page)(bytes) 85416243#TMSN.jpeg (1 page)(bytes) 85416250#TMSN.jpeg (1 page)(bytes) PAINFUL PLEASURES Cancellation.pdf (7 pages)(507197 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 Overnight Courier on this date.

Signature	/Noel Egnatios/
Name	Noel Egnatios
Date	09/15/2011

**Petition to Cancel Reg. 3,749,131
PAINFUL PLEASURES TATTOO EST. 2009**

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

In the matter of Registration:

Registration No.: 3,749,131
Registered: 02/16/2010
Registrant: James Harvey
Mark: PAINFUL PLEASURES TATTOO EST. 2009 (and Design)

PAINFUL PLEASURES, INC.,)	
)	
Petitioner,)	
)	Cancellation No.
v.)	
)	
JAMES HARVEY,)	
)	
Registrant.)	
_____)	

PETITION FOR CANCELLATION

Petitioner Painful Pleasures, Inc. ("Petitioner"), a Maryland corporation having its principal place of business in Hanover, Maryland, believes that it will be damaged by the continued registration of the mark shown in Registration No. 3,749,131, registered on February 16, 2010 for PAINFUL PLEASURES TATTOO EST. 2009 and Design by James Harvey ("Registrant"), and hereby petitions to cancel same under Section 14 of the United States Trademark Act of 1947, 15 U.S.C. §1064.

As grounds for petition, Petitioner alleges that:

1. Petitioner is a Maryland corporation, having its principal place of business at 7410 Coca Cola Drive, Suite 107, Hanover, Maryland 21076. Petitioner is the world's

**Petition to Cancel Reg. 3,749,131
PAINFUL PLEASURES TATTOO EST. 2009 & Design**

largest distributor, retail seller and wholesaler of body jewelry, body piercing and tattoo supplies and accessories. It has been in business since 1999 and now sells products in over 60 countries, shipping from its five warehouses located in Maryland. Petitioner has a strong reputation for providing quality products to the tattoo and body piercing community within the United States and throughout the world, and takes an active role in the support and promotion of this community.

2. Petitioner is the owner of U.S. Trademark Registration No. 3,462,359 for PAINFUL PLEASURES, registered on July 8, 2008 in connection with “jewelry”; as well as U.S. Trademark Applications for goods and services including, relevant here, U.S. Trademark Application Serial No. 85,416,243 for PAINFUL PLEASURES, filed on September 7, 2011 in connection with “[b]ody piercing apparatus, body piercing tools, body piercing needles”, and U.S. Trademark Application Serial No. 85,416,250 for PAINFUL PLEASURES, filed on September 7, 2011 in connection with “[t]attoo machines, tattoo machine parts, tattooing supplies, namely, needles, grips, tubs, tips, nipples, grommets, ink” (together, the “PAINFUL PLEASURES Marks”). Petitioner has continuously used the mark “PAINFUL PLEASURES” in interstate commerce in the United States connection with its business since the launch of Petitioner’s business in 1999 and has established common law rights in this mark from 1999.

3. On information and belief, Registrant is an individual, currently residing in California, doing business under the names James Harvey, James Danger, James Danger Harvey and/or Painful Pleasures James Harvey.

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4. Registration No. 3,749,131 was issued on February 16, 2010 to Registrant for the mark PAINFUL PLEASURES TATTOO EST. 2009 and Design, in connection with “tattooing services” in International Class 44 (“Registrant’s Mark”).

5. Registrant’s Mark is substantially similar to the PAINFUL PLEASURES Marks because it incorporates the entirety of the word mark “PAINFUL PLEASURES” and combines it with the terms “TATTOO” and “EST. 2009”, which were determined by the U.S.P.T.O. to be merely descriptive terms and as such, have been disclaimed from the registration. 15 U.S.C. 1056 (a). The design elements of Registrant’s Mark have no independent meaning or impact on the overall commercial impression of Registrant’s Mark, and do not affect the substantial similarity with Petitioner’s Mark.

6. The services offered under Registrant’s Mark are substantially similar to goods provided by Petitioner. Petitioner sells jewelry used in connection with body piercings, as well as supplies, machines and accessories for body piercing and tattooing. These items are sold to retailers and customers alike through its online retail store located at www.painfulpleasures.com, as well as other outlets such as Ebay, and also to customers through licensed resellers and retail outlets, including tattoo and body piercing shops. The tattooing and body piercing industries are inextricably intertwined and Petitioner serves them both. Tattooing and piercing services are commonly provided at the same location, and body jewelry is regularly sold at these locations as well.

7. On information and belief, Registrant provides tattooing services through a single shop he owns that is located in Sacramento, California. Registrant’s shop operates under the names “PAINFUL PLEASURES TATTOO” and alternatively, “PAINFULL PLEASURES TATTOO AND PIERCING.”

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PAINFUL PLEASURES TATTOO EST. 2009 & Design**

8. On information and belief, Registrant also provides body piercing services and sells body jewelry from his store. Registrant's tattooing services are directed towards and overlap with Petitioner's customers and target market.

9. On information and belief, Registrant selected Registrant's Mark with knowledge of the PAINFUL PLEASURES Marks. Registrant has purchased body jewelry and tattooing supplies from Petitioner on multiple occasions, including in 2009.

10. Petitioner is not affiliated or connected with Registrant or his tattooing services; nor has Petitioner endorsed or sponsored Registrant or his services.

11. There is no issue as to priority of use. Petitioner began using the mark "PAINFUL PLEASURES" in connection with its business at least as early as February 1, 1999, and claims this as the first use date for Registration No. 3,462,359. Conversely, Registrant claims January 2009 as its first use date for Registration No. 3,749,131 for PAINFUL PLEASURES TATTOO EST. 2009 and Design in connection with "tattooing services", and the mark itself belies the accuracy of this date (i.e. "Est. 2009").

CLAIM FOR RELIEF

REGISTRATION NO. 3,749,131 SHOULD BE CANCELLED BECAUSE IT IS CONFUSINGLY SIMILAR TO PETITIONER'S PAINFUL PLEASURES MARKS

12. Petitioner incorporates by reference paragraphs 1 through 11, inclusive, as if fully set forth here.

13. Registrant's Mark, PAINFUL PLEASURES TATTOO EST. 2009 and Design, is highly similar to Petitioner's PAINFUL PLEASURES Marks in appearance, sound, meaning, and commercial impression. Registrant's Mark incorporates Petitioner's Marks in their entirety, the terms "TATTOO" and "EST. 2009" are merely descriptive terms referencing Registrant's business and have been disclaimed from the registration,

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PAINFUL PLEASURES TATTOO EST. 2009 & Design**

and the design elements of Registrant's Mark have no independent meaning or impact on the overall commercial impression of Registrant's Mark or lessen the substantial similarity with Petitioner's Mark.

14. The goods and services offered by each party are closely related. According to the identification of services in the registration, Registrant's Mark is used in connection with "tattooing services." Such services are regularly offered in the same physical locations where Petitioner's jewelry is sold and where Petitioner's tattooing and piercing supplies are used. In fact, on information and belief, Registrant has purchased tattoo supplies from Petitioner in the past, which he has used to provide his tattooing services to consumers. Also on information and belief, Registrant has purchased jewelry from Petitioner, which he has sold to consumers from his shop and used in connection with the provision of body piercing services provided from his shop. Registrant's services are directed to persons within tattoo and body piercing community that comprise Petitioner's customer base. Petitioner is not, however, affiliated or connected with Registrant or his services, nor has Petitioner endorsed or sponsored Registrant or his services.

15. The continued registration of Registrant's Mark will injure Petitioner by causing the public to be confused, mistaken or deceived into believing that the services provided by Registrant are endorsed or sponsored by, or otherwise affiliated with Petitioner. 15 U.S.C. § 1052(d).

16. Due to Petitioner's widespread influence within the tattoo and body piercing industry, consumers familiar with Petitioner's products sold under the PAINFUL

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PLEASURES Marks are likely to misapprehend Registrant's Mark as a mark of Petitioner rather than a mark of Registrant.

17. Petitioner has no control over the nature and quality of the tattooing services offered by Registrant under the PAINFUL PLEASURES TATTOO EST. 2009 and Design Mark, and Petitioner's reputation and goodwill will be damaged, and the value of its PAINFUL PLEASURES Marks jeopardized, all to Petitioner's detriment.

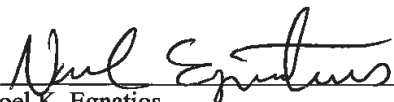
18. Further, any defect, objection or fault found with Registrant's services provided under its Mark would necessarily reflect upon and injure the good reputation that Petitioner has established for the goods and services it offers in connection with the PAINFUL PLEASURES Marks.

19. For the foregoing reasons, the similarity between Registrant's PAINFUL PLEASURES TATTOO EST. 2009 and Design Mark and Petitioner's PAINFUL PLEASURES Marks is likely to cause consumer confusion resulting in damage and injury to Petitioner.

WHEREFORE, Petitioner requests that the present Petition for Cancellation be sustained and Registration No. 3,749,131 be cancelled.

Respectfully submitted,
Noel K. Egnatios

Date: 9-15-11

By: 
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El Cajon, CA 92019
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**Petition to Cancel Reg. 3,749,131
PAINFUL PLEASURES TATTOO EST. 2009 & Design
CERTIFICATE OF SERVICE**

I hereby certify that on September 15, 2011, a true and correct copy of the foregoing **PETITION FOR CANCELLATION** regarding Painful Pleasures, Inc. v. James Harvey, has been served by mailing said copy on September 15, 2011, via overnight courier (FedEx), postage prepaid, addressed to Registrant James Harvey at the U.S.P.T.O. correspondence address of record, namely:

James Harvey
5739 Auburn Blvd., Suite B
Sacramento, CA 95841

Date: September 15, 2011



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