

ESTTA Tracking number: **ESTTA471840**

Filing date: **05/10/2012**

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	U.S.A. Famous Original Ray's Licensing Corp.		
Entity	Corporation	Citizenship	New York
Address	133 Randolph Street Brooklyn, NY 11237 UNITED STATES		

Attorney information	Jonathan C. Sullivan Ruskin Moscou Faltischek, P.C. 1425 RXR Plaza Uniondale, NY 11556 UNITED STATES jsullivan@rmfpc.com Phone:(516) 663-6600		
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Registrations Subject to Cancellation

Registration No	4001654	Registration date	07/26/2011
Registrant	Papa Ray's Pizza 1, Inc. 21 Star Lane South Barrington, IL 60010 UNITED STATES		

Goods/Services Subject to Cancellation

Class 043. First Use: 2010/03/15 First Use In Commerce: 2010/03/15 All goods and services in the class are cancelled, namely: Restaurant

Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)		
False suggestion of a connection	Trademark Act section 2(a)		
Priority and likelihood of confusion	Trademark Act section 2(d)		
Registration No	4001655	Registration date	07/26/2011
Registrant	Papa Ray's Pizza 1, Inc. 21 Star Lane South Barrington, IL 60010 UNITED STATES		

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Priority and likelihood of confusion	Trademark Act section 2(d)


Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2196832	Application Date	07/14/1994
Registration Date	10/20/1998	Foreign Priority Date	NONE
Word Mark	RAY'S PIZZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 restaurant services		

U.S. Registration No.	2196830	Application Date	06/24/1994
Registration Date	10/20/1998	Foreign Priority Date	NONE
Word Mark	FAMOUS RAY'S PIZZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 restaurant services		

U.S. Registration No.	1918484	Application Date	08/18/1986
Registration Date	09/12/1995	Foreign Priority Date	NONE
Word Mark	FAMOUS ORIGINAL RAY'S PIZZA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 RESTAURANT SERVICES		

U.S. Registration No.	1918483	Application Date	08/18/1986
Registration Date	09/12/1995	Foreign Priority Date	NONE
Word Mark	FAMOUS ORIGINAL RAY'S PIZZA EST. 1964		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1964/00/00 First Use In Commerce: 1964/00/00 RESTAURANT SERVICES

U.S. Registration No.	3675202	Application Date	06/13/2008
Registration Date	09/01/2009	Foreign Priority Date	NONE

Word Mark	RAY'S FAMOUS ORIGINAL RAY'S PIZZA
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Design Mark	
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Description of Mark	The mark consists of the literal elements "RAY'S FAMOUS ORIGINAL RAY'S PIZZA" and associated design. The first word "RAY'S" appears in the color white and is integrated into the design of an opened topped crown. The crown appears primarily in the color red, with seven jewels along its top appearing in the colors white and red and its bottom portion appearing in the color green with a white edge. The words at "FAMOUS ORIGINAL" appear in the color green and the words "RAY'S PIZZA" appear in the color red, bordered by white and outlined in green.
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Goods/Services	Class 025. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 Clothing, namely, T-shirts, polo shirts; hats and caps Class 043. First use: First Use: 1979/01/01 First Use In Commerce: 1979/01/01 Restaurant services
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Attachments	73615252#TMSN.gif (1 page)(bytes) 77498814#TMSN.jpeg (1 page)(bytes) Cancellation Petition.pdf (6 pages)(192077 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	/Jonathan C. Sullivan/
Name	Jonathan C. Sullivan
Date	05/10/2012

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

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U.S.A. FAMOUS ORIGINAL RAY'S LICENSING
CORP.,

Petitioner,

-against-

PAPA RAY'S PIZZA 1, INC.,

Registrant.

Cancellation No.:

Marks: **PAPA RAY'S PIZZA &
WINGS; PAPA RAY'S PIZZA
& WINGS YOUR
NEIGHBORHOOD PLACE**

Reg. Nos. 4001654 and 4001655

Reg. Date: July 26, 2011

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In the matter of trademark Registration Nos. 4001654 and 4001655 for PAPA RAY'S PIZZA & WINGS and PAPA RAY'S PIZZA & WINGS YOUR NEIGHBORHOOD PLACE for restaurant services ("Registrant's Services") in International Class 43, issued to Papa Ray's Pizza 1, Inc. ("Registrant") on July 26, 2011, U.S.A. Famous Original Ray's Licensing Corp. ("Petitioner"), a corporation organized and existing under the laws of the State of New York, located and doing business at 133 Randolph Street, Brooklyn, New York, will be damaged by the continued registration of both PAPA RAY'S PIZZA & WINGS and PAPA RAY'S PIZZA & WINGS YOUR NEIGHBORHOOD PLACE ("Registrant's Marks") and hereby petitions to cancel said registrations pursuant to 15 U.S.C. § 1064 (Trademark Act of 1946, § 14).

As grounds of cancellation, it is alleged that:

1. U.S. Registration Nos. 4001654 and 4001655 were issued on July 26, 2011 to Papa Ray's Pizza 1, Inc.
2. Upon information and belief, Registrant is an Illinois corporation having a business address at 21 Star Lane South, Barrington, Illinois 60010.

3. The Registrant's registrations cover the trademarks PAPA RAY'S PIZZA & WINGS and PAPA RAY'S PIZZA & WINGS YOUR NEIGHBORHOOD PLACE for restaurant services in International Class 43.

4. Petitioner is the owner of a family of trademarks incorporating the word RAY's for restaurant services, including the following ("RAY'S Marks" or "Petitioner's Marks"):

- (a) RAY'S PIZZA (U.S. Registration No. 2196832)
- (b) FAMOUS RAY'S PIZZA (U.S. Registration No. 2196830)
- (c) FAMOUS ORIGINAL RAY'S PIZZA (U.S. Registration No. 1918484)
- (d) FAMOUS ORIGINAL RAY'S PIZZA EST. 1964 (logo) (U.S. Registration No. 1918483)
- (e) RAY'S FAMOUS ORIGINAL RAY'S PIZZA (U.S. Registration No. 3675202).

5. Petitioner's Marks have not been canceled, are valid, and are now in full force and effect.

6. Petitioner has successfully exploited the RAY'S Marks for more than forty (40) years achieving substantial commercial success and causing customers and the general public to associate quality restaurant services with the RAY'S Marks.

7. Petitioner has extensively advertised and promoted the RAY'S Marks and made substantial sales of products and services under said marks.

8. Petitioner's use of the of the RAY'S Marks has resulted in the development of valuable good will inuring to the benefit of Petitioner.

9. Petitioner utilizes the RAY'S Marks in connection with, among other things, its restaurants and restaurant services.

10. Petitioner currently owns and operates multiple restaurants that are using the RAY'S Marks in interstate commerce.

11. The RAY'S Marks are distinctive and widely understood to signify the services provided and sold by Petitioner.

12. Registrant's claimed date of first use of Registrant's Marks is March 15, 2010.

13. Petitioner's use of the RAY'S Marks predates Registrant's use of Registrant's Marks by at least forty (40) years.

14. Petitioner has priority of use over Registrant based on Petitioner's prior long standing use of the RAY'S Marks.

15. Petitioner's Marks and Registrant's Marks share the common element RAY'S PIZZA.

16. Registrant's Marks are similar in sight, sound, connotation and commercial impression to Petitioner's Marks.

17. Registrant's restaurant services are identical in nature and otherwise similar and related to the services marketed and sold by Petitioner.

18. Registrant's use and continued registration of Registrant's Marks is likely to and will cause confusion in the marketplace among purchasers and potential purchasers due to the similarity between Petitioner's Marks and Registrant's Marks, and the closely related nature of the services and goods provided by the respective parties, causing damage to Petitioner.

19. Registrant's use and continued registration of Registrant's Marks is likely to and will cause confusion in the marketplace or cause mistake or deception in the trade among purchasers and potential purchasers, causing damage to Petitioner.

20. Registrant's use and continued registration of Registrant's Marks is likely to and will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Registrant's services and goods are those of Petitioner, or are otherwise endorsed, sponsored, licensed or controlled by Petitioner, causing damage to Petitioner.

21. Petitioner has been and will continue to be damaged by the continued use and registration of Registrant's Marks.

22. Registrant's Marks suggests a connection with Petitioner in violation of § 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), to Petitioner's irreparable damage.

23. Registrant's use of Registrant's Marks points uniquely and unmistakably to Petitioner.

24. Consumers that encounter Registrant's Mark will recognize Registrant's Mark as pointing uniquely and unmistakably to Petitioner.

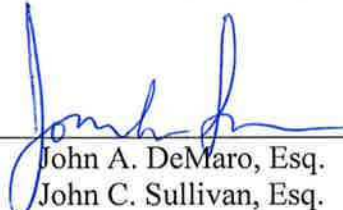
25. Registrant's use and continued registration of Registrant's Mark's will create a false and misleading connection to Petitioner, causing irreparable damage to consumers and Petitioner.

WHEREFORE, Petitioner prays that registration of Reg. Nos. 4001654 and
4001654 be cancelled.

Dated: May 10, 2012

Respectfully submitted for Petitioner

U.S.A. Famous Original Ray's Licensing Corp.

By:  _____

John A. DeMaro, Esq.

John C. Sullivan, Esq.

Thomas A. Telesca, Esq.

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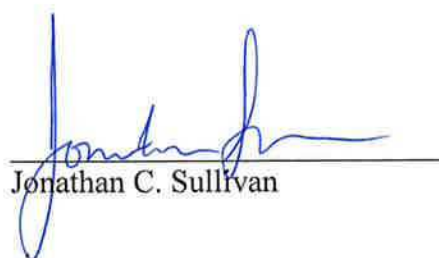
(516) 663-6600

CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of Petitioner's Petition for Cancellation dated May 10, 2012, to be served by first class postage prepared mail by depositing the same with the U.S. Postal Service on this the 10th day of May, 2012 to Registrant at the following address:

Papa Ray's Pizza 1, Inc.
21 Star Lane South,
Barrington, Illinois 60010

Dated: May 10, 2012
Uniondale, New York



Jonathan C. Sullivan

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