ESTTA Tracking number: **ESTTA534564**

Filing date: **04/26/2013**

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	Peach and Lily, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2020 Walnut Street Suite 17D Philadelphia, PA 19103 UNITED STATES		

Attorney information	Lawrence A. Weinstein, Esq. Lowenstein Sandler LLP 65 Livingston Avenue Roseland, NJ 07068-1791 UNITED STATES lstrademark@lowenstein.com Phone:973-597-2500

Registration Subject to Cancellation

Registration No	3731150	Registration date	12/29/2009
Registrant	PRIMA LUNA, INC. 742 Genevieve Street, Suite G Solana Beach, CA 92075 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2007/08/01 First Use In Commerce: 2007/08/01
All goods and services in the class are cancelled, namely: Mail order services featuring clothing, jewelry, accessories, art, gifts and general merchandise; On-line retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Wholesale distributorships featuring clothing, jewelry, accessories, art, gifts and general merchandise

Grounds for Cancellation

Abandonment	Trademark Act section 14

Attachments	LILIPEACH (Petition to Cancel Statement).pdf (14 pages)(150130 bytes)

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	/Lawrence A. Weinstein/

Name	Lawrence A. Weinstein, Esq.
Date	04/26/2013

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

Peach and Lily, Inc.	:	
	:	
v.	:	**Cancellation No. _____**
	:	
Prima Luna, Inc.	:	**In re Registration No. 3731150**
Registrant.	:	

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

PETITION TO CANCEL

In the matter of Trademark Registration No. 3731150, registered on December 29, 2009 for the mark "LILIPEACH" (the "Registrant's Mark") in International Class 35 for "Mail order services featuring clothing, jewelry, accessories, art, gifts and general merchandise; On-line retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Wholesale distributorships featuring clothing, jewelry, accessories, art, gifts and general merchandise."

Petitioner is being and will continue to be damaged by the registration of the Registered Mark, and hereby petitions to cancel the same. As grounds for cancellation, it is alleged that:

1. Peach and Lily, Inc., ("Petitioner"), a Delaware corporation with a principal place of business located 2020 Walnut Street, Suite 17D, Philadelphia, PA 19103, is being and will continue to be damaged by Registrant's Mark, and hereby petitions to cancel the same.

2. Upon information and belief, Registrant is Prima Luna, Inc., with an address of 742 Genevieve Street, Suite G, Solana Beach, CA 92075.

3. Petitioner has filed United States trademark application Serial No. 85803239 for the mark "PEACH AND LILY" (the "Petitioner's Mark") in International Class 35 for use in

connection with "On-line retail store services featuring cosmetics, skin care products, body care products, hair care products, nail care products, soaps, perfumes, fragrances and beauty products." In an Office Action dated April 5, 2013 (a copy of which is attached hereto as Exhibit 1), the Examining Attorney refused registration of Petitioner's "PEACH AND LILY" mark, citing Registrant's Mark as a bar to registration of Petitioner's Mark.

4. Upon information and belief, Registrant previously used Registrant's Mark in connection with mail order services featuring clothing, jewelry, accessories, art, gifts and general merchandise; On-line retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Wholesale distributorships featuring clothing, jewelry, accessories, art, gifts and general merchandise.

5. Upon information and belief, Registrant has ceased using Registrant's Mark.

6. Petitioner has been unable to discover any current use of Registrant's Mark in connection with the aforementioned goods in commerce.

7. Petitioner has been and continues to be damaged by the existence of Registration No. 3731150 for "LILIPEACH" on the Principal Register, in that the registration has been used as a basis for rejecting the application submitted by Petitioner.

WHEREFORE, Petitioner prays that Registrant's Mark, Registration No. 3731150, for "LILIPEACH" be canceled in connection with the goods identified in Class35.

Please charge our Attorneys' Deposit Account No. 501358 for the $300.00 official filing fee. Any additional fees in connection with this cancellation petition may also be charged to this account, and any overpayment may be credited to this account.

Respectfully submitted,

By: LOWENSTEIN SANDLER LLP
65 Livingston Avenue
Roseland, New Jersey 07068
(973) 597-2500

PEACH AND LILY, INC.
Petitioner

By: /Lawrence A. Weinstein/
Lawrence A. Weinstein, Esq.

Dated: April 26, 2013

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing PETITION TO CANCEL was served on Registrant's Attorney of Record at the correspondence address of record, this 26h day of April, 2013, by sending same via first-class mail, postage prepaid to:

Donn K. Harms, Esq.
American Patent & Trademark Law Center
12702 Via Cortina Ste 100
Del Mar, CA 92014-3769

LOWENSTEIN SANDLER LLP
65 Livingston Avenue
Roseland, New Jersey 07068
(973) 597-2500
ATTORNEYS FOR PEACH AND LILY, INC.
Petitioner

By: /Lawrence A. Weinstein/
Lawrence A. Weinstein, Esq.

27553.2
04/26/2013 24650165.01

EXHIBIT 1

To:	PEACH AND LILY, INC. (lstrademark@lowenstein.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85803239 - PEACH AND LILY - 27553.2
Sent:	4/5/2013 5:06:20 PM
Sent As:	ECOM105@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85803239

MARK: PEACH AND LILY

85803239

CLICK HERE TO RESPOND TO THIS LETTER
http://www.uspto.gov/trademarks/teas/response_forms.jsp

CORRESPONDENT ADDRESS:
VANESSA A. IGNACIO, ESQ.
LOWENSTEIN SANDLER PC
65 LIVINGSTON AVE STE 2
ROSELAND, NJ 07068-1791

APPLICANT: PEACH AND LILY, INC.

CORRESPONDENT'S REFERENCE/DOCKET NO :

27553.2
CORRESPONDENT E-MAIL ADDRESS:
lstrademark@lowenstein.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 4/5/2013

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

- Section 2(d) Refusal – Likelihood of Confusion

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. **3731150**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused, mistaken, or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). In the seminal decision *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the court listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all the factors are necessarily relevant or of equal weight, and any one of the factors may control in a given case, depending upon the evidence of record. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 1355, 98 USPQ2d 1253, 1260 (Fed. Cir. 2011); *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont de Nemours & Co.*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services. *See In re Viterra Inc.*, 671 F.3d 1358, 1361-62, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593, 1595-96 (TTAB 1999); TMEP §§1207.01 *et seq.*

Applicant is seeking registration of the mark PEACH AND LILLY in connection with "on-line retail store services featuring cosmetics, skin care products, body care products, hair care products, nail care products, soaps, perfumes, fragrances and beauty products." The cited registration is for the mark LILIPEACH and covers the services "mail order services featuring clothing, jewelry, accessories, art, gifts and general merchandise; on-line retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; wholesale distributorships featuring clothing, jewelry, accessories, art, gifts and general merchandise."

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Similarity in any one of these elements may be sufficient to find the marks confusingly similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *see In re 1st USA Realty Prof'ls, Inc.* , 84 USPQ2d 1581, 1586 (TTAB 2007); TMEP §1207.01(b).

Applicant's mark PEACH AND LILLY is similar to the registered LILIPEACH mark because they both include the identical words PEACH and LILLY or its phonetic equivalent LILI. Although the words LILLY and PEACH are in the reverse order in the registered mark, the marks as a whole are still confusingly similar. Confusion is likely between two marks consisting of reverse combinations of the same elements if they convey the same meaning or create substantially similar commercial impressions. TMEP §1207.01(b)(vii); *see, e.g., In re Wine Soc'y of Am. Inc.*, 12 USPQ2d 1139, 1142 (TTAB 1989) (holding THE WINE SOCIETY OF AMERICA and design, for "wine club membership services including the supplying of printed materials, sale of wines to members, conducting wine tasting sessions and recommending specific restaurants offering wines sold by applicant," likely to be confused with AMERICAN WINE SOCIETY 1967 and design, for a newsletter, bulletin and journal of interest to

members of the registrant); *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1884 (TTAB 1988) (holding RUST BUSTER, with "RUST" disclaimed, for a rust-penetrating spray lubricant likely to be confused with BUST RUST for a penetrating oil).

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n* , 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

In addition to the similarities between the marks, both the application and registration cover online retail store services. The goods and/or services of the parties need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("[E]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods."); TMEP §1207.01(a)(i).

The respective goods and/or services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods and/or services originate from the same source. *Gen. Mills Inc. v. Fage Dairy Processing Indus.*, 100 USPQ2d 1584, 1597 (TTAB 2012); TMEP §1207.01(a)(i); s*ee On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d at 1086, 56 USPQ2d at 1475; *In re Martin's Famous Pastry Shoppe, Inc.* , 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

The application is very specific in its listing of the particular types of beauty items and accessories that are sold in its online PEACH AND LILLY store. The registration has a more general listing of the types of goods (including jewelry, accessories, art, gifts and general merchandise) sold in its online LILLIPEACH store; however, this wording is broad enough to include the particular items listed in the application. Given that the marks include the same two words, LILLY and PEACH, and they both cover online retail store services, the marks are likely to be encountered by the same consumers in the same channels of trade.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Because of the similarities between the marks and the goods, consumer confusion appears likely and registration is refused under Section 2(d) of the Trademark Act.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by

submitting evidence and arguments in support of registration.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

Applicant is encouraged to telephone or e-mail the assigned trademark examining attorney to resolve the issues raised in this Office action by examiner's amendment. Although a formal response may never be submitted by e-mail, an applicant may communicate informally by phone or e-mail with the trademark examining attorney to agree to a proposed amendment to the application that will immediately place the application in condition for publication for opposition, issuance of a registration, or suspension. *See* TMEP §707.

/Kate DuBray/
Examining Attorney
Law Office 105
(571) 272-4815
katherine.dubray@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

DESIGN MARK

Serial Number
77748045

Status
REGISTERED

Word Mark
LILIPEACH

Standard Character Mark
Yes

Registration Number
3731150

Date Registered
2009/12/29

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
PRIMA LUNA, INC. CORPORATION CALIFORNIA 742 Genevieve Street, Suite G Solana Beach CALIFORNIA 92075

Goods/Services
Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Mail order services featuring clothing, jewelry, accessories, art, gifts and general merchandise; On-line retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Retail store services featuring clothing, jewelry, accessories, art, gifts and general merchandise; Wholesale distributorships featuring clothing, jewelry, accessories, art, gifts and general merchandise. First Use: 2007/08/01. First Use In Commerce: 2007/08/01.

Filing Date
2009/05/29

Examining Attorney
LEE, DEBRA

Attorney of Record
Donn K. Harms

LILIPEACH

To:	PEACH AND LILY, INC. (lstrademark@lowenstein.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85803239 - PEACH AND LILY - 27553.2
Sent:	4/5/2013 5:06:21 PM
Sent As:	ECOM105@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED ON **4/5/2013** FOR U.S. APPLICATION SERIAL NO. 85803239

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **4/5/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see http://www.uspto.gov/trademarks/process/status/responsetime.jsp.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see http://www.uspto.gov/trademarks/basics/abandon.jsp**.**

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.