

ESTTA Tracking number: **ESTTA539595**

Filing date: **05/23/2013**

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	Doris Hosiery Mills Ltd.		
Entity	Company	Citizenship	Canada
Address	3701 Jarry East Montreal, Quebec, H1Z2G1 CANADA		

Attorney information	Erica D. Klein Kramer Levin Naftalis & Frankel LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES KLtrademark@kramerlevin.com Phone:212.715.9205		
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Registration Subject to Cancellation

Registration No	3715694	Registration date	11/24/2009
Registrant	Maidenform, Inc. 154 Avenue E Bayonne, NJ 07002 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2006/11/00 First Use In Commerce: 2007/07/00 All goods and services in the class are cancelled, namely: Foundation garments; panties; underwear; briefs; body briefers; body suits; shapewear, namely, girdles and camisoles; women's intimate apparel, namely, women's undergarments, lingerie, bustiers, bandeaux, corsets, corselettes, panti-girdles and slips

Grounds for Cancellation

Abandonment	Trademark Act section 14
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Attachments	Petition for Cancellation.pdf(91220 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	/Erica D. Klein/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Doris Hosiery Mills Ltd., :
 :
 Petitioner, : Cancellation No.:
 :
 v. : Registration No. 3,715,694
 Maidenform, Inc., :
 :
 Respondent. :
-----X

PETITION FOR CANCELLATION

Petitioner Doris Hosiery Mills Ltd. (“Petitioner”) believes that it will be damaged by the continued registration of the mark UNDERCONTROL as listed in U.S. Reg. No. 3,715,694, and hereby petitions to cancel such registration on the following grounds:

I. PARTIES

1. Petitioner is a Canada corporation located at 3701 Jarry East, Montreal, Quebec, Canada H1Z2G1.
2. On information and belief, Maidenform, Inc. (“Respondent”) is a New York corporation located at 154 Avenue E, Bayonne, New Jersey 07002.

II. BACKGROUND

3. On May 23, 2013, Petitioner filed Application Serial No. 85/940,941 (“Petitioner’s Application”) to register the mark UNDER CONTROL BY SECRET (“Petitioner’s Mark”) for “clothing, namely leggings, hosiery, lingerie, underwear, undergarments, exercise wear and loungewear” in Class 25 (“Petitioner’s Goods”). A true copy of receipt of filing for Petitioner’s Application is attached hereto as Exhibit A.

4. On information and belief, Respondent is the owner of U.S. Registration No. 3,715,694 (“Respondent’s Registration”), filed February 9, 2007 and registered November 24, 2009 for the mark UNDERCONTROL (“Respondent’s Mark”) for “foundation garments; panties, underwear; briefs; body briefers; body suits; shapewear, namely, girdles and camisoles; women’s intimate apparel, namely, women’s undergarments, lingerie, bustiers, bandeaux, corsets, corselettes, anti-girdles and slips” in Class 25 (“Respondent’s Goods”).
5. Petitioner has a bona fide intent to use Petitioner’s Mark in connection with Petitioner’s Goods.
6. Petitioner has a reasonable belief that registration of Petitioner’s Mark will be refused because of Respondent’s Registration.

III. GROUNDS FOR CANCELLATION: ABANDONMENT

7. On information and belief, all use of Respondent’s Mark on or in connection with Respondent’s Goods has been discontinued for a period of at least three (3) years, with an intent by Respondent not to resume such use.
8. Petitioner is unable to find any evidence of sales of current product sold under Respondent’s Mark in United States commerce for at least the last three (3) years.
9. Due to nonuse in the United States, Respondent’s Mark covered by Respondent’s Registration has become abandoned with respect to Respondent’s Goods.
10. Respondent’s Mark is comprised of the one, combined word UNDERCONTROL, and Petitioner’s Mark is comprised of the two separate words UNDER CONTROL BY SECRET, wherein SECRET is a source identifier utilized by Petitioner.

11. Respondent's Goods and Petitioner's Goods contain certain arguably similar items, such as underwear and lingerie.
12. While Petitioner reserves its rights to argue that registration of Petitioner's Mark should be granted despite the existence of Respondent's Mark, Petitioner believes that Respondent's Mark has been abandoned, and should duly be removed from the PTO Register.
13. Petitioner would be damaged by the continued existence of Respondent's Registration, because Petitioner reasonably believes that unless Respondent's Registration is removed from the PTO Register, Respondent's Registration would serve as an obstacle to the registration of Petitioner's Application.

WHEREFORE, Petitioner respectfully requests cancellation of U.S. Registration No. 3,715,694 for the mark UNDERCONTROL.

This Petition is being filed electronically with the Board, and is being served on Respondent at the correspondence address of record with the PTO. Proof of Service is attached hereto.

Dated: New York, NY
May 23, 2013

Respectfully submitted,

KRAMER LEVIN NAFTALIS
& FRANKEL LLP



By: Erica D. Klein
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, NY 10036
Telephone: (212) 715-9205
Fax: (212) 715-8000
KLTrademark@kramerlevin.com

Attorneys for Petitioner Doris Hosiery
Mills Ltd.

CERTIFICATE OF SERVICE

I hereby certify that on May 23, I caused one true and correct copy of the foregoing PETITION FOR CANCELLATION and accompanying exhibit to be served by first class mail upon Respondent Maidenform Inc. by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Respondent's address of record:

Maidenform, Inc.
154 Avenue E
Bayonne, NJ 07002

Date: May 23, 2013



Erica D. Klein

EXHIBIT A

Ramos, Tania C.

From: Haniff, Patrick
Sent: Thursday, May 23, 2013 3:37 PM
To: Ramos, Tania C.
Subject: FW: 163945-00006 Serial number 85940941: Received Your Trademark/Service Mark Application, Principal Register

From: TEAS@uspto.gov [mailto:TEAS@uspto.gov]
Sent: Thursday, May 23, 2013 3:24 PM
To: KL Trademark Incoming; Klein, Erica; Butnick, Francesca C.
Subject: 163945-00006 Serial number 85940941: Received Your Trademark/Service Mark Application, Principal Register

1. **YOUR MARK:** UNDER CONTROL BY SECRET (Standard Characters, mark.jpg)
The literal element of the mark consists of UNDER CONTROL BY SECRET.
The mark consists of standard characters, without claim to any particular font, style, size, or color.
2. **YOUR SERIAL NUMBER:** We have received your U.S. Trademark Application and assigned serial number '85940941' to your submission. A summary of your application data is provided at the bottom of this message and serves as your official filing receipt. Please keep a copy of this information for your records. All correspondence concerning the application should reference your assigned serial number.
Please read all of the important information below. Not every mark is registrable with the USPTO and we do not refund the application filing fee(s) if a registration does not ultimately issue.
3. **RECEIVING E-MAIL COMMUNICATIONS/FILING DOCUMENTS ON-LINE:** If you have authorized receipt of correspondence by e-mail, please make sure that your server will accept USPTO e-mail and not treat it as SPAM. If you have not authorized communication by e-mail, please do so at any time by using the "Change of Correspondence Address" form, available at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>. If you must submit correspondence to us, please use the Trademark Electronic Application System (TEAS) forms, available at <http://www.uspto.gov/trademarks/teas/index.jsp>.
4. **KEEP YOUR ADDRESS CURRENT IN USPTO RECORDS:** We do not extend filing deadlines due to a failure to receive USPTO mailings/e-mailings. You must update the correspondence and/or owner's address if a postal address and/or e-mail address changes, using the form(s) available at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.
5. **WARNING ABOUT UNSOLICITED COMMUNICATIONS:** You may receive trademark-related communications from private companies not associated with the USPTO. These communications frequently display customer-specific information, including your USPTO serial number or registration number and owner name, and request fees for trademark-related services, such as monitoring, listings in international publications, and document filing. None of the companies offering these services are affiliated with the USPTO or any other federal agency. All official correspondence will be from the "United States Patent and Trademark Office" in Alexandria, VA, and if by e-mail, specifically from the domain "@uspto.gov." Please consult the "Warning" page on the Trademarks section of the USPTO's website for further information about unsolicited communications and to view representative examples of them. For general information on filing and maintenance requirements for trademark applications and registrations, including fees required by law, please consult

www.uspto.gov, contact the TrademarkAssistanceCenter@uspto.gov or telephone 1-800-786-9199.

6. **LEGAL EXAMINATION PROCESS:** Your application is now pending examination. In approximately 3 months, your application will be assigned to a USPTO examining attorney for review. The application cannot mature into a registration unless all legal requirements are met, and many applications never satisfy these requirements and therefore never register. The overall process can take up to 18 months.
7. **CHECK STATUS AND REVIEW DOCUMENTS OR YOUR APPLICATION MAY BE UNINTENTIONALLY ABANDONED:** You must check the status and review all documents associated with your application at least every 3-4 months using Trademark Status and Document Retrieval (TSDR), available at <http://tsdr.uspto.gov/>. Promptly e-mail the TrademarkAssistanceCenter@uspto.gov or telephone 1-800-786-9199 (select option #1) if an Office action (letter from the USPTO) or notice has issued for your application that you did not receive or do not understand. Failure to respond timely to any Office action or notice may result in the abandonment of your application, requiring you to pay an additional fee to have your application revived even if you did not receive the Office action or notice.
8. **FILING ERRORS:** If you discover an error in the application data, you must file a Voluntary Amendment at <http://www.uspto.gov/trademarks/teas/miscellaneous.jsp>. Do not submit any proposed amendment to TEAS@uspto.gov, because the TEAS technical support team may not make any data changes. Please wait approximately 7 days after the filing date of your application to submit a Voluntary Amendment in order to allow for initial upload of your application data into the USPTO database. The assigned examining attorney will determine the acceptability of any Voluntary Amendment during examination. Not all errors may be corrected. For example, if you submitted the wrong mark or if the proposed correction would be considered a material alteration to your original filing, it will not be accepted. In this situation, your only recourse would be to file a new application, with a new fee and no refund of your original filing fee.
9. **REQUEST FOR REFUND AND/OR CANCELLATION:** Since your application has already been assigned a serial number, please do not contact TEAS@uspto.gov to request a refund or to cancel the filing. We will only cancel the filing and refund the filing fee if the application does not meet minimum filing requirements. The fee is a processing fee that the USPTO does not refund, even if your mark does not proceed to registration.
In the limited situation where you inadvertently filed identical applications, one immediately after the other, because no confirmation of the first filing was received, please provide both serial numbers to the technical support team at TEAS@uspto.gov.
10. **SelectUSA:** The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The U.S. offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to promote and facilitate business investment. SelectUSA provides information assistance to the international investor community; serves as an ombudsman for existing and potential investors; advocates on behalf of U.S. cities, states, and regions competing for global investment; and counsels U.S. economic development organizations on investment attraction best practices. To learn more about why the United States is the best country in the world to develop technology, manufacture products, deliver services, and grow your business, visit SelectUSA.gov or call +1-202-482-6800.

SUMMARY OF APPLICATION DATA FOLLOWS:

APPLICATION DATA: Trademark/Service Mark Application, Principal Register

The applicant, Doris Hosiery Mills Ltd., a company organized under the laws of Canada, having an address of
3701 Jarry East
Montreal, Quebec H1Z2G1
Canada

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 025: Clothing, namely leggings, hosiery, lingerie, underwear, undergarments, exercise wear and loungewear

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Attorney Information:

Erica D. Klein and Francesca C. Butnick, Peter A. Abruzzese, Kevin M. Moss, Alexandra Gil, Shannon H. Hedvat and the attorneys of Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, New York 10036
United States

The attorney docket/reference number is 163945-00006.

The applicant's current Correspondence Information:

Erica D. Klein
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, New York 10036
212.715.9205(phone)
212.715.8000(fax)
KLtrademark@kramerlevin.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

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. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on

information and belief are believed to be true.

Declaration Signature

Signature: /Erica D. Klein/ Date: 05/23/2013

Signatory's Name: Erica D. Klein

Signatory's Position: Attorney of record, New York bar member

Thank you,

The TEAS support team

Thu May 23 15:24:05 EDT 2013

STAMP: USPTO/BAS-198.182.154.4-20130523152405513072-85940941-

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