

ESTTA Tracking number: **ESTTA567984**

Filing date: **10/30/2013**

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 parties request to cancel indicated registration.

Petitioner Information

Name	Dannis Jo Hackney		
Entity	Individual	Citizenship	UNITED STATES
Address	4 River Road Jericho, VT 05465 UNITED STATES		

Name	Bobby D Hackney		
Entity	Individual	Citizenship	UNITED STATES
Address	4 River Road Jericho, VT 05465 UNITED STATES		

Attorney information	Jeffrey E. Jacobson, Esq. The Jacobson Firm, P.C. 347 Fifth Avenue New York, NY 10016 UNITED STATES jeffrey@jacobsonfirm.com Phone:2126832001		
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Registration Subject to Cancellation

Registration No	4287050	Registration date	02/05/2013
Registrant	Perseverance Holdings Ltd. 68021 Crowfoot RPO Calgary, Alberta, CAX T3G3N8 CAX		

Goods/Services Subject to Cancellation


Class 025. First Use: 1985/05/13 First Use In Commerce: 1987/05/25 All goods and services in the class are cancelled, namely: Beanies; Hats; Hooded sweat shirts; Hooded sweatshirts; Jackets; Pants; Shirts;Shorts; Socks; Sweatshirts; T-shirts; Tank tops; Underwear
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Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Related Proceedings	Petition For Cancellation
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3760300	Application Date	05/26/2009
Registration Date	03/16/2010	Foreign Priority Date	NONE
Word Mark	DEATH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1976/09/00 First Use In Commerce: 1976/09/00 Compact discs featuring music; Phonograph records featuring music		

U.S. Registration No.	4225468	Application Date	03/09/2012
Registration Date	10/16/2012	Foreign Priority Date	NONE
Word Mark	DEATH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1975/01/01 First Use In Commerce: 1975/01/01 Entertainment services in the nature of live musical performances		

Attachments	77744974#TMSN.jpeg(bytes) Death-PetitionCancellation.pdf(97672 bytes) 85565417#TMSN.jpeg(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	/Jeffrey E. Jacobson/
Name	Jeffrey E. Jacobson, Esq.
Date	10/30/2013

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

DANNIS JOE HACKNEY and
BOBBY DEAN HACKNEY
Petitioners,

Cancellation No. _____

Mark: DEATH

Reg. No. 4287050 (issued February 5, 2013)

v.

PERSEVERANCE HOLDINGS LTD.

Respondent,

PETITION FOR CANCELLATION

Dannis Joe Hackney and Bobby Dean Hackney aka Death (Musical Performing Act), individuals residing at 4 River Road, Jericho, VT 05465, believe that they are being damaged by the continued registration of the mark DEATH owned by Perseverance Holdings Ltd. (“Registrant”) Registration No. 4287050 and hereby petition to cancel the same.

As grounds for its cancellation, Petitioners allege that, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

Petitioners and its DEATH Mark

1. Petitioners owns all trademark rights associated with the band DEATH who are currently engaged in live performances under this name as well as distribute for sale compact discs and phonograph records containing its works, based on use in

commerce from at least as early as March 16, 2010, with performances as early as 1972.

2. Petitioners are the owners of Registration No. 3760300, which issued on March 16, 2010, for the standard mark DEATH for “Compact discs featuring music; Phonograph records featuring music” and Registration No. 4225468, which issued on October 16, 2012, for the standard mark DEATH for “Entertainment services in the nature of live musical performances”.
3. By virtue of Petitioners’ extensive use in commerce of the DEATH mark for musical recordings, performances, and associated merchandise, including continuous sales of recordings as well as a motion picture that was developed and released regarding the band, Petitioners have developed valuable goodwill in this mark.

Respondent and its DEATH Mark

4. Upon information and belief, Respondent had ceased using the mark for the associated services when the lead singer of their musical performing act Chuck Schuldiner died.
5. Upon information and belief, Respondent ceased using said mark for the associated services.
6. On December 13, 2012 to gain registration, Petitioner filed and executed a declaration for Trademark Application Serial No. 85592357 for the mark DEATH, which matured into Trademark Registration No. 4287050 on February 5, 2013, wherein it claimed that its mark had been in use in United States commerce in connection with all the goods identified in the application, and submitted a specimen that purported to show such use, alleging a date of first use in commerce of May 13, 1985, for

“Beanies; Hats; Hooded sweat shirts; Hooded sweatshirts; Jackets; Pants; Shirts; Shorts; Socks; Sweatshirts; T-shirts; Tank tops; Underwear.”

7. At the time of filing and executing the Trademark Application, Respondent submitted a sworn statement “that all statement made of his/her own knowledge are true” in connection with the statements contained in the Application.
8. Upon information and belief, Petitioner never used the mark in commerce in United States in connection with each of the goods list on the Registration, including for at least three years prior to Petitioners’ first use date of September 1976.
9. Contrary to Respondent’s sworn statement that the mark was in use for each of the goods identified in the Application, Respondent had not used Respondent’s DEATH mark in connection with all of the goods identified in the Application in United States Commerce as of its claimed first use date of May 13, 1985, as there were never any “beanies”. Respondent also did not intent to resume use of the mark for such goods/services.
10. Respondent was aware that it had not made use of each of the goods identified in the application at the time it executed and submitted the Application.
11. Consequently, Respondent’s Statement that the mark was in use in commerce for all of the goods identified in the Application constituted a knowingly false misrepresentation of material fact by Respondent.
12. By making a false statement that the mark was in use for all of the goods identified in the Application, Respondent committed fraud on the USPTO by making a material false statement about Respondent’s use of the mark in United States commerce for all goods identified in the application, and this false statement was made knowingly with

the intent to deceive the USPTO or in reckless disregard for the truth in order to procure a broader registration than Respondent was otherwise entitled to.

13. Respondent's false statement in procuring a registration constitutes fraud; thereby invalidating the mark in its entirety. Accordingly, Respondent's Registration should be declared void *ab inito*.
14. Furthermore, Petitioner actually started use of this name in 1972. They entered into a recording agreement with Groovesville Productions in 1974. The first phonorecord was released in 1976.

Count One
Abandonment, 15 U.S.C. § 1127

15. Petitioners repeat and reallege each and every allegation set forth in paragraph 1 through 14.
16. Any rights that Respondents had in their DEATH mark was abandoned based upon (a) non-use of the mark for goods/services listed in Registration No. 4287050 for at least three (3) consecutive years and (b) no intent to commence or resume use of the mark for such goods/services.

Count Two
Likelihood Of Confusion, 15 U.S.C. § 1052(d)

17. Petitioners repeat and reallege each and every allegation set forth in paragraph 1 through 16.
18. Petitioners were the first and original musical group called DEATH. Because Respondent abandoned any rights in their DEATH mark, Petitioners still have priority.

19. By virtue of Petitioners' extensive use in commerce of its DEATH mark in the United States, the relevant trade and public have come to associate goods bearing Petitioners' mark, DEATH with Petitioners.
20. Respondent's DEATH mark so resembles Petitioners' DEATH mark as to be likely, when used in connection with Respondent's goods/services, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).
21. If Respondent is permitted to maintain its registration for its DEATH mark for the goods set forth in the registration, confusion of trade and public is likely to result, such confusion resulting in damage and injury to Petitioners.

WHEREFORE, Petitioners believe that they are being and will continue to be damaged by Registration No. 4287050 and request that the Board sustain the Petition for and cancel this registration.

The filing fee has been submitted electronically.

Respectfully Submitted,

Dated: October 30, 2013

By: /Jeffrey E. Jacobson/
Jeffrey E. Jacobson
The Jacobson Firm, P.C.
347 Fifth Avenue, 8th Floor
New York, NY 10016
Telephone: (212) 683-2001
Fax: (212) 645-5038

Attorney for Petitioners
Dannis Joe Hackney and
Bobby Dean Hackney

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing PETITION FOR CANCELLATION was served to the below by first-class mail, postage prepaid on October 30, 2013, to the following addresses of record mentioned:

B. Brett Heavner, Esq.
Finnegan Henderson Farabaow Garret & Dunner, LLP
901 New York Avenue, NW
Washington, DC 20001

Perseverance Holdings Ltd.
68021 Crowfoot RPO
Calgary, Alberta
Canada T3G3N8

/Jeffrey E. Jacobson/
Jeffrey E. Jacobson, Esq.
Attorney For Petitioners