

ESTTA Tracking number: **ESTTA620435**

Filing date: **08/08/2014**

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	Brand Developers Ltd.		
Entity	Ltd	Citizenship	New Zealand
Address	519-521 Lake Road, Takapuna Auckland, 0622 NEW ZEALAND		

Attorney information	Dana B. Robinson TechLaw LLP P.O. Box 1416 La Jolla, CA 92038 UNITED STATES dana@techlawllp.com, kayla@techlawllp.com, jess@techlawllp.com Phone:7024602223
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Registration Subject to Cancellation

Registration No	3388992	Registration date	02/26/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	Thin Lizzy Limited Prager & Fenton, Midway House London, EC4A 1LT UNITED KINGDOM		

Goods/Services Subject to Cancellation

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Articles of clothing, namely, shirts, sweat-shirts, pants, trousers, shorts, tank tops, [cloth bibs, skirts, blouses, dresses, suspenders,] sweaters, athletic uniforms, warm-up suits, [jogging suits, swimwear,] scarves, [dressing gowns, boxer shorts,] socks, T-shirts, [sleepwear, pyjamas, wrist bands, head bands, ties, robes;] articles of outer clothing, specifically, jackets, [coats, raincoats, rainwear, snowsuits; articles of underclothing, specifically, underwear, lingerie; footwear, specifically, shoes, boots, sneakers, sandals, booties, slippers, slipper socks;] headgear, specifically, hats, caps, [sun visors; masquerade and Halloween costumes and masks sold in connection therewith;] articles of clothing for babies and toddlers, namely, shirts, T-shirts, shorts [, jackets, socks and dresses]

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

Attachments	Thin Lizzy Petition for Cancellation.pdf(108942 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	/Dana B. Robinson/
Name	Dana B. Robinson
Date	08/08/2014

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

Brand Developers Ltd.)	
)	
A New Zealand Company)	
)	Cancellation No.:
Petitioner,)	
)	
v.)	
)	Registration No.: 3388992
Thin Lizzy Limited)	Date of Issue: February 26, 2008
)	
A United Kingdom Company)	
)	
Respondent)	
_____)	

PETITION FOR CANCELLATION

Petitioner, Brand Developers Ltd, a New Zealand Company, having an address at 519-521 Lake Road Takapuna Auckland New Zealand, 0622 (“Petitioner”), believes that it will be damaged by the continued registration of the mark THIN LIZZY (Reg. No. 3388992) in Class 25, originally registered on the Principal Register for “Articles of clothing, namely, shirts, sweatshirts, pants, trousers, shorts, tank tops, cloth bibs, skirts, blouses, dresses, suspenders, sweaters, athletic uniforms, warm-up suits, jogging suits, swimwear, scarves, dressing gowns, boxer shorts, socks, T-shirts, sleepwear, pyjamas, wrist bands, head bands, ties, robes; articles of outer clothing, specifically, jackets, coats, raincoats, rainwear, snowsuits; articles of underclothing, specifically, underwear, lingerie; footwear, specifically, shoes, boots, sneakers, sandals, booties, slippers, slipper socks; headgear, specifically, hats, caps, sun visors; masquerade and Halloween costumes and masks sold in connection therewith; articles of

clothing for babies and toddlers, namely, shirts, T-shirts, shorts, jackets, socks and dresses,” and currently registered on the Principal Register for “Articles of clothing, namely, shirts, sweatshirts, pants, trousers, shorts, tank tops, sweaters, athletic uniforms, warm-up suits, scarves, socks, T-shirts, articles of outer clothing, specifically, jackets, headgear, specifically, hats, caps, articles of clothing for babies and toddlers, namely, shirts, T-shirts, shorts.” Petitioner hereby petitions to cancel the registration of the mark THIN LIZZY (Reg. No. 3388992).

To the best of Petitioner’s knowledge, the name and address of the current owner of the registration is: Thin Lizzy Ltd, having a business address at Prager & Fenton, Midway House, 27-29 Cursitor Street, London EC4A 1LT United Kingdom (“Respondent”).

As grounds for cancellation, it is alleged that:

1. Petitioner has applied for a Principal Registration for THIN LIZZY (Serial No. 85839938) in Class 3 for make-up.
2. Petitioner’s above referenced application was refused based upon the Respondent’s registration for THIN LIZZY (Reg. No. 3388992) in Class 25 (“Respondent’s Mark”).
3. Respondent filed the trademark application for Respondent’s Mark with the United States Patent and Trademark Office (“USPTO”) on June 5, 2006, under Section 44(d), in Classes 9, 16, 25, 28 and 41.
4. An applicant filing a trademark application under Section 44(d) must have either (a) a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application, or (b) use in commerce on or in connection with the goods or services listed in the application. 15 U.S.C. 1126(d)(2); Trademark Manual of Examining Procedure § 1003 (2007).

5. Upon information and belief, when Respondent filed its trademark application for Respondent's Mark, Respondent neither had (a) a bona fide intention to use Respondent's Mark in commerce on all the goods listed in Class 25, nor (b) use of Respondent's Mark in commerce on all the goods listed in Class 25. However, in Respondent's trademark application, Respondent declared it had a bona fide intent to use and/or use of Respondent's Mark in commerce.

6. Upon information and belief, Respondent filed the trademark application for Respondent's Mark knowing it did not have a bona fide intent to use or use of Respondent's Mark in commerce on all the goods listed in Class 25. Respondent did this to intentionally deceive the USPTO so that Respondent's Mark would register.

7. The misrepresentations in Respondent's trademark application, set forth above, were material to Respondent acquiring a registration for Respondent's Mark in Class 25.

8. A Declaration of Use and Incontestability under Sections 8 & 15 is an allegation under oath that the mark has been continuously used on all goods listed in the declaration for five (5) consecutive years after the date of registration. A declaration under Section 8 & 15 cannot include goods that were not actually in use as of the date set forth in the declaration. 15 U.S.C. § 1065(3) (1994); 37 C.F.R. § 2.167; Trademark Manual of Examining Procedure § 1605.04 (2007).

9. Upon information and belief, when Respondent filed the Declaration of Use and Incontestability under Sections 8 & 15 for Respondent's Mark, Respondent did not have continuous use of Respondent's Mark on all the goods listed in Class 25 for five (5) consecutive years after the date of registration. Nonetheless, Respondent declared, "For the remaining goods or services, the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in

commerce on or in connection with these goods or services.”

10. Upon information and belief, Respondent filed the Declaration of Use and Incontestability under Sections 8 & 15 for Respondent’s Mark knowing it did not have continuous use of Respondent’s Mark on all the goods listed in Class 25 for five (5) consecutive years after the date of registration. Respondent did this in order to intentionally deceive the USPTO so that Respondent could maintain its registration for Respondent’s Mark in Class 25.

11. Respondent’s misrepresentations in its Declaration of Use and Incontestability under Sections 8 & 15, set forth above, were material to Respondent maintaining its registration for Respondent’s Mark in Class 25.

12. A trademark registration may be cancelled on the grounds of fraud provided that (1) the applicant/registrant made a false representation to the USPTO; (2) the applicant/registrant had knowledge of the falsity of the representation; (3) the applicant/registrant made the false representation with the intent to deceive the USPTO, and (4) the false representation was material to the registrability of a mark. 15 U.S.C. § 1064; *In re Bose Corp.*, 91 USPQ2d 1938 (Fed. Cir. 2009).

13. In light of the allegations stated in this Cancellation, Petitioner requests that Respondent’s Mark be cancelled on the basis of fraud.

14. Further, upon information and belief, Respondent has not used Respondent’s Mark on all the goods listed in Class 25 in three years, and does not intend to begin or resume use of Respondent’s Mark on all the goods listed in Class 25. Therefore, Respondent has abandoned Respondent’s Mark in Class 25. 15 U.S.C. § 1064. As such, Petitioner requests that Respondent’s Mark be cancelled on the basis of abandonment.

15. Further, upon information and belief, Respondent’s Mark has not been “used in

commerce” (as defined by the Lanham Trade-Mark Act, § 45, 15 U.S.C.A. § 1127) on all the goods in Class 25. In particular, Petitioner alleges that an investigation revealed that Respondent may have never used Respondent’s Mark on the goods in Class 25 commerce, and in fact never had a bona fide intent to use Respondent’s Mark on the goods in Class 25 in commerce. Section 45 requires a *bona fide* sale or transportation of the goods in commerce. *Avakoff v. Southern Pac. Co.*, 765 F.2d 1097, 226 U.S.P.Q. 435 (T.T.A.B. 1985). Therefore, because Respondent had not sold or transported the identified goods in commerce and/or had a bona fide intent to use the Mark in commerce in Class 25, the Registration in Class 25 should be “*void ab initio*”. *Gay Toys, Inc. v. McDonald’s Corp.*, 582 F.2d 1067, 199 U.S.P.Q. 722 (C.C.P.A. 1978), or at a minimum be cancelled for non-use, or fraud.

7. Petitioner will be damaged by the continuance of the registration of Respondent’s Mark because Petitioner has applied to register a mark for THIN LIZZY for use on make-up in Class 3. The continued registration of Respondent’s Mark will impair Petitioner’s ability to register, and avail itself of the protections of a federal trademark registration for its mark THIN LIZZY.

WHEREFORE, the Petitioner prays that Registration No. 3388992 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

The filing fee of \$300 per class this application is enclosed pursuant to CFR §2.11.

Respectfully submitted,

Dated: 8/8/2014

By: /s/ Dana B. Robinson

DANA B. ROBINSON, ESQ.
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Attorney for Petitioner

Certificate of Service

I hereby certify that I have on August 8, 2014, served the foregoing:

Petition for Cancellation

via U.S. mail on the following persons(s):

William C. Wright (Respondent's Attorney of Record with the USPTO)
Epstein Drangel LLP
60 E. 42nd Street, Suite 2410
NEW YORK, NEW YORK 10165
UNITED STATES

By: /s/ Dana B. Robinson

DANA B. ROBINSON
Attorney for Petitioner