

ESTTA Tracking number: **ESTTA723498**

Filing date: **01/28/2016**

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	Tart Optical Enterprises LLC		
Entity	limited liability company	Citizenship	California
Address	c/o Loeb & Loeb LLP 10100 Santa Monica Blvd., Suite 2200 Santa Monica, CA 90067 UNITED STATES		

Attorney information	Melanie Howard Loeb & Loeb LLP 10100 Santa Monica Blvd. Suite 2200 Los Angeles, CA 90067 UNITED STATES efilings@loeb.com, mhoward@loeb.com, cmedina@loeb.com Phone:310.282.2000, ext. 2143
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Registration Subject to Cancellation

Registration No	4064083	Registration date	11/29/2011
Registrant	JD Fine & Company 179 Mason Circle Concord, CA 94520 UNITED STATES		

Goods/Services Subject to Cancellation


Class 009. First Use: 2010/11/26 First Use In Commerce: 2010/11/26 All goods and services in the class are cancelled, namely: Sunglasses, eyeglasses, frames for sunglasses and eyeglasses, and cases for sunglasses and eyeglasses
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Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
<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)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	76698748	Application Date	08/03/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TART OPTICAL ENTERPRISES OTE		

Design Mark	
Description of Mark	The mark consists of the words "TART OPTICAL ENTERPRISES" in a stylized font that resembles handwriting, slightly tilted from the bottom left to the top right. The letters "T" in "TART", "O" in "OPTICAL" and "E" in "ENTERPRISES" are uppercase, the rest of the letters are lower case. To the right of the words lies a shield with the letter "OTE" in uppercase, with the letter "T" higher than the letters "O" and "E".
Goods/Services	Class 009. First use: First Use: 2009/04/01 First Use In Commerce: 2009/04/01 Eyewear

U.S. Application No.	77969435	Application Date	03/26/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TART OPTICAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2009/04/01 First Use In Commerce: 2009/04/01 Cases for eyeglasses and sunglasses; Chains for eyeglasses; Eyeglass cords; Eyeglass frames; Eyeglass retaining cords; Frames for spectacles and sunglasses; Optical frames; Spectacle frames		

U.S. Application No.	85063832	Application Date	06/15/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TART		

Design Mark	<h1>TART</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2009/04/01 First Use In Commerce: 2009/04/01 Cases for eyeglasses and sunglasses; Eyeglass cases; Eyeglass cords; Eyeglass frames; Eyeglass retaining cords; Frames for spectacles and sunglasses; Optical frames; Spectacle frames; Spectacles, frames and cases

U.S. Application No.	86890318	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

U.S. Application No.	86890357	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

Attachments	76698748#TMSN.png(bytes) 77969435#TMSN.png(bytes) 85063832#TMSN.png(bytes) Petition for Cancellation.pdf(293664 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	/melaniehoward/
Name	Melanie Howard

Date	01/28/2016
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK AND TRIAL APPEAL BOARD

TART OPTICAL)	Cancellation No. _____
ENTERPRISES LLC, a)	
California limited liability)	Mark: TART
company,)	Reg. No.: 4,064,083
)	Date of Issue: November, 29,
Petitioner,)	2011
)	
vs.)	
)	
JD FINE & COMPANY., a)	
California corporation,)	
)	
Registrant.)	
_____)	

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

PETITION FOR CANCELLATION


Petitioner, Tart Optical Enterprises LLC (“Petitioner”), files this petition to cancel U.S. Reg. No. 4,064,083 for the mark “TART” in the name of JD Fine & Company, with an address at 179 Mason Circle, Concord, CA 94520 (“Registrant”). Petitioner believes that it is and will be damaged by U.S. Reg. No. 4,064,083 and hereby petitions for partial cancellation of same. This Petition For Cancellation is based upon the following grounds:


Petitioner's Famous TART Marks

1. Petitioner is a maker of eyewear. Petitioner's predecessor in interest, Tart Optical Enterprises Inc., was a small but legendary maker of eye frames founded in New York City in the mid 1940's.

2. Among other marks, Petitioner is the owner of the now-famous marks TART, TART OPTICAL, TART OPTICAL ENTERPRISES

(hereinafter, the "TART Marks") and  for eyewear.

3. Petitioner has obtained federal registration of its mark  pursuant to U.S. Reg. No. 3,869,604.

4. Petitioner also claims common law rights in the TART Marks and its  mark as well as trade name rights in TART OPTICAL and TART OPTICAL ENTERPRISES.

5. Petitioner, including through its predecessor-in-interest, has spent significant sums of money advertising and promoting its famous TART Marks in the United States and internationally since before Registrant's application filing date or first use date.

6. By virtue of this advertising and promotion of Petitioner's TART Marks, Petitioner has built up and now owns valuable goodwill and consumer recognition which is uniquely symbolized by Petitioner's TART Marks.

7. Evidence of this consumer recognition and goodwill includes the multitude of unsolicited third party press that Petitioner's goods (advertised, marketed and sold under the TART Marks) have received. Attached hereto as Exhibit A is just one such example.

Registrant Committed Fraud In Obtaining Registration Of Its Mark in International Class 9

8. Upon information and belief, Registrant is not using and has not used the mark TART in connection with all of the goods listed in the certificate of registration.

9. Registrant filed its application for TART on June 30, 2006 based upon intent to use the mark in commerce.

10. On November 26, 2010, Registrant filed a Statement of Use for International Class 9 claiming first use in commerce as of that same date. The goods listed in the application in Class 9 as of the filing date of the Statement of Use were "Sunglasses, eyeglasses, frames for sunglasses and eyeglasses, and cases for sunglasses and eyeglasses". Registrant submitted a specimen of use consisting of a photograph of a pair of sunglasses and described by Registrant as "Sunglasses with the mark thereon."

11. Upon information and belief, Registrant is not using and has not used the mark TART in commerce in connection with “Sunglasses, eyeglasses, frames for sunglasses and eyeglasses, and cases for sunglasses and eyeglasses.”

12. Registrant knew or should have known and, on information and belief, did in fact know or believe that its representations in connection with its Statement of Use for International Class 9 were false. Upon information and belief, Registrant intended to induce the U.S. Patent & Trademark Office to rely upon the statements to accept its Statement of Use and permit the TART mark to proceed to registration in International Class 9.

13. The U.S. Patent & Trademark Office reasonably relied upon the misrepresentations of Registrant in accepting the Statement of Use for the mark TART and in issuing the challenged registration to Registrant.

14. Petitioner has been damaged as a proximate result of the U.S. Patent & Trademark Office’s reliance upon the misrepresentations of Registrant and the issuance of the challenged registration.

15. Because the challenged registration was invalidly obtained by virtue of these false and material claims, it should be cancelled, at a minimum, with respect to International Class 9.

Registrant Has Abandoned Its Mark in International Class 9

16. Upon information and belief, Registrant is not using the mark TART in connection with “Sunglasses, eyeglasses, frames for sunglasses and eyeglasses, and cases for sunglasses and eyeglasses.”


17. Upon information and belief, Registrant has not used the mark TART in connection with “Sunglasses, eyeglasses, frames for sunglasses and eyeglasses, and cases for sunglasses and eyeglasses” since at least 2010.

18. Accordingly, Registrant has abandoned the mark TART in connection with “Sunglasses, eyeglasses, frames for sunglasses and eyeglasses, and cases for sunglasses and eyeglasses,” and U.S. Reg. No. 4,064,083 should be cancelled, at a minimum, with respect to International Class 9.

Petitioner Is And Will Be Damaged By Registrant’s Mark

19. Petitioner believes that it is and will be damaged by U.S. Registration No. 4,064,083.

20. Petitioner previously filed the below U.S. Trademark Applications (the “Prior TART Applications”), each of which was refused registration under Section 2(d) based upon Registrant’s Registration No. 4,064,083:

Mark	Filing Date	Claimed First Use Date	Serial No.	Goods
	August 3, 2009	April 1, 2009	76/698,748	Eyewear in International Class 9.
TART OPTICAL	March 26, 2010	April 1, 2009	77/969,435	Cases for eyeglasses and sunglasses; Chains for eyeglasses; Eyeglass cords; Eyeglass frames; Eyeglass retaining cords; Frames for spectacles and sunglasses; Optical frames; Spectacle frames in International Class 9.
TART	June 15, 2010	April 1, 2009	85063832	Cases for eyeglasses and sunglasses; Eyeglass cases; Eyeglass cords; Eyeglass frames; Eyeglass retaining cords; Frames for spectacles and sunglasses; Optical frames; Spectacle frames; Spectacles, frames and cases in International Class 9.

21. Each of the Prior TART Applications had a filing date preceding Registrant's claimed first use date in International Class 9 of November 26, 2010.

22. Each of the Prior TART Applications claimed a date of first use of April 1, 2009, which precedes Registrant's claimed first use date by over a year.

23. Petitioner's common law use of TART OPTICAL ENTERPRISES dates back to February of 2004, which precedes Registrant's claimed first use date by over *six* years.

24. Since at least as early as April 1, 2009, Petitioner has been using one or more of the TART Marks in the TART Applications, on or in connection with the sales of the International Class 9 goods set forth in each TART Application. Petitioner's use of one or more of the TART Marks has been valid

and continuous since at least as early as April 1, 2009, and has not been abandoned.

25. Petitioner’s predecessor in interest began using one or more of the TART Marks *decades* prior to either Registrant’s filing date or claimed date of first use. Registrant is not connected with the activities performed by the Petitioner (nor Petitioner’s predecessor in interest) under the TART Marks.

26. The fame and reputation of the TART Marks, including of Petitioner’s predecessor in interest, is such that, when Registrant’s mark is used with the Registrant’s goods or services, a connection with the TART Marks and Petitioner (and likely Petitioner’s predecessor in interest) would be presumed.

27. In order to protect its rights in its TART marks, Petitioner recently filed the following new applications (collectively, with the Prior TART Applications, “Petitioner’s Applications”):

Mark	Serial No.	Goods
TART	86/890,318	<p>Eyewear; Cases for eyeglasses and sunglasses; Chains for eyeglasses; Eyeglass cords; Eyeglass frames; Eyeglass retaining cords; Frames for spectacles and sunglasses; Optical frames; Spectacle frames in International Class 9.</p> <p>Retail optical store services; Online retail store optical services; Wholesale and retail store services featuring eye care related products and eyewear; Distributorship services in the field of eyewear in International Class 35.</p> <p>Fitting of optical lenses; Optician services; Optometry services in International Class 44.</p>
TART OPTICAL ENTERPRISES	86/890,357	<p>Eyewear; Cases for eyeglasses and sunglasses; Chains for eyeglasses; Eyeglass cords; Eyeglass frames; Eyeglass retaining cords; Frames for spectacles and sunglasses; Optical frames; Spectacle frames in International Class 9.</p>

Mark	Serial No.	Goods
		Retail optical store services; Online retail store optical services; Wholesale and retail store services featuring eye care related products and eyewear; Distributorship services in the field of eyewear in International Class 35. Fitting of optical lenses; Optician services; Optometry services in Class 44.

28. If Registrant’s Registration No. 4,064,083 is cited by the U.S. Patent & Trademark Office as a bar to registration of Petitioner’s newly-filed applications, Petitioner will continue to be damaged.

WHEREFORE, Petitioner prays U.S. Registration No. 4,064,083 be cancelled, or in the alternative, partially cancelled with respect to International Class 9, and that this Petition For Cancellation be sustained in favor of Petitioner.

The filing fee is being submitted with this petition. Please charge any deficiency or credit any overpayment to Deposit Account 12-1820.

Dated: January 28, 2016

Respectfully submitted,

MELANIE HOWARD
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By: 

Melanie Howard
Attorneys for Petitioner, Tart Optical
Enterprises LLC

Exhibit A



CERTIFICATE OF SERVICE AND MAILING

It is hereby certified that a true and correct copy of the foregoing PETITION TO CANCEL is being served upon Registrant by depositing a copy of the same in the U.S. mail, first class postage prepaid, in an envelope addressed to:

JD Fine & Company
179 Mason Circle
Concord, CA 94520

Executed this 28th day of January 2016, at Los Angeles, California.



CANDACE MEDINA