

ESTTA Tracking number: **ESTTA793740**

Filing date: **01/09/2017**

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	Faram Holding and Furniture, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	450 Seventh Avenue 36th floor New York, NY 10123 UNITED STATES		

Attorney information	Francesco Di Pietro Moses & Singer LLP 405 Lexington Avenue The Chrysler Building New York, NY 10174 UNITED STATES trademarks@mosessinger.com, fdipietro@mosessinger.com Phone:(212) 554-7800
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Registration Subject to Cancellation

Registration No	3158999	Registration date	10/17/2006
International Registration No.	NONE	International Registration Date	NONE
Registrant	FARAM 1957 S.p.A. Via Schiavonesca, 71 ITALY		

Goods/Services Subject to Cancellation

Class 006. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Metal partitions and adjustable wall panels of metal
Class 019. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Non-metal partitions and adjustable wall panels not of metal
Class 020. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Metal office furniture and non-metal office furniture, namely, seats, chairs, reclining chairs, desks, tables, office cabinets and furniture partitions

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Related Proceed-	3154260, 3154261
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Attachments	3158999FaramHorse.pdf(210033 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 Overnight Courier on this date.

Signature	/Francesco Di Pietro/
Name	Francesco Di Pietro
Date	01/09/2017

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Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Faram Holding and Furniture, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	450 Seventh Avenue, 36 th Floor New York, NY 10123		

Correspondence information	Francesco Di Pietro Moses & Singer LLP 405 Lexington Avenue New York, New York 10174-1299 fdipietro@mosessinger.com Tel: 212-554-7800 Fax: 212-377-6053		
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Registrant Information

Name	Faram 1957 S.p.A.		
Entity	Corporation	Citizenship	Italy
Address	Via Schiavonesca, 71 31040 Giavera del Montello, Treviso, Italy		

Registration Subject to Cancellation

Registration No.	3158999	Registration date	10/17/2006
International Registration No.	0593958	International Registration Date	Unknown
Registrant	Faram 1957 S.P.A.		

Goods/Services Subject to Cancellation

All goods and services in the registration
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re:	§	
	§	
Registration No. 3158999	§	
Mark: FARAM	§	
Dated: October 17, 2006	§	
	§	Cancellation No. _____
FARAM HOLDING AND FURNITURE, INC.,	§	
	§	
Petitioner,	§	
	§	
v.	§	
	§	
FARAM 1957 S.P.A.,	§	
	§	
Registrant.	§	

PETITION FOR CANCELLATION

1. Petitioner is a leading manufacturer and seller of glass partitions and related products in the United States and overseas. Along with the sale of those products, Petitioner also installs said products.
2. Petitioner holds common law rights to the mark FARAM in connection with the aforementioned goods and services (the “Trademark”).
3. Petitioner purchased the Trademark on April 17, 2014, for consideration and pursuant to an Asset Purchase Agreement and Bill of Sale, from a company named FGM Service, Inc. (“FGM”).
4. In turn, FGM had purchased the Trademark on June 27, 2013, for consideration and pursuant to a Trademark Sale Agreement, from Faram S.P.A., the then-registered-owner of the Trademark.

5. Faram 1957 S.P.A. (“Registrant”) falsely claims to be the owner of the Trademark.

6. Registrant knew that the Trademark had been sold to FGM by Faram S.P.A. first and then sold by FGM to Petitioner.

7. Notwithstanding such knowledge, in 2015, Registrant rushed to register the change of ownership of the Trademark with WIPO which, in turn, communicated such change to the USPTO for Registration No. 3,158,999 (the “Registration”).

8. As of the date of this petition, litigation between Petitioner and Registrant is pending in the United States District Court for the Southern District of New York, Case 16-cv-02430 (the “Court Action”). During the Court Action, Petitioner informed Registrant that the Registration was fraudulent.

9. On September 23, 2016, in connection with the Registration, Registrant filed with the USPTO a Declaration of Continued Use/Excusable Nonuse of Mark in Commerce under Section 71 of the Trademark Act (the “Section 71 Declaration”).

10. The Section 71 Declaration was signed not by Registrant, but by Registrant’s attorneys.

11. Registrant alleges that the Section 71 Declaration is based upon a Declaration of Use in Commerce, dated September 8, 2016, signed by Maurizio Adonia, the Chief Executive Officer of Registrant (the “Adonia Declaration”). Upon information and belief, no such Adonia Declaration has been filed with the USPTO.

12. In the Section 71 Declaration, Registrant falsely and fraudulently declared that Registrant was using the Trademark in commerce in the United States, where in fact Registrant was not using the Trademark in commerce.

13. Prior to September 8, 2016, and prior to the filing of the Section 71 Declaration with the USPTO, Petitioner informed Registrant at least twice and in writing that Registrant was not using the Trademark in commerce.

14. Nevertheless, Registrant filed the Section 71 Declaration knowing its contents to be false and knowing that Registrant was not using the Trademark in commerce.

15. On or about November 22, 2016, in connection with the Registration, Registrant submitted to the USPTO a petition (the "Petition") requesting the Director to grant withdrawal of the Section 71 Declaration and expunge the registration's file history with regard to the same on the ground that the information contained in the Section 71 Declaration and the Adonia Declaration was erroneous.

16. Petitioner has spent and invested sizable sums of money to promote and market goods and services under the Trademark in the U.S. and around the world. Petitioner invested time, capital, skills and labor to build up good will in the Trademark in the U.S.

17. Through Petitioner's presence and their sizable projects in the U.S., consumers and the trade associate the Trademark with Petitioner. Through Petitioner's use of the Trademark, presence and good will in the U.S. marketplace, Petitioner has established a common law rights in the Trademark.

18. Any unauthorized future use by Registrant of the Trademark is likely to cause confusion and mistake among ordinary consumers and the trade as to the source, sponsorship, affiliation, or approval of the goods and services which will be offered by Registrant.

First Basis for Cancellation-Abandonment

19. Registrant is not currently offering good or services under the Trademark, as Registrant has admitted in the Petition.
20. Registrant has never used the Trademark in commerce.
21. Faram S.P.A has not used the Trademark in commerce since at least June 27, 2013.
22. Registrant had no bona fide intention to initiate use of the Trademark in the ordinary course of trade in the United States within the required renewal period to maintain the Registration.
23. Upon information and belief, Faram S.P.A. had no bona bona fide intention to initiate use of the Trademark in the ordinary course of trade in the United States since at least June 27, 2013.
24. As a result of Registrant's failure to use the Trademark in connection with the covered goods and services, Registrant has abandoned any right to the Registration.

Second Basis for Cancellation-Fraud

25. On September 23, 2016, in connection with the Registration, Registrant filed the Section 71 Declaration with the USPTO.
26. The Section 71 Declaration is based upon the Adonia Declaration.
27. In the Adonia Declaration, and consequently in the Section 71 Declaration, Registrant falsely and fraudulently declared that Registrant was using the Trademark in commerce, where in fact Registrant was not using the Trademark in commerce.

28. Prior to September 8, 2016, and prior to the filing of the Section 71 Declaration with the USPTO, Petitioner informed Registrant at least twice and in writing that Registrant was not using the Trademark in commerce.

29. Nevertheless, Registrant filed the Section 71 Declaration knowing its contents to be false and knowing that Registrant was not using the Trademark in commerce.

30. On or about November 22, 2016, in connection with the Trademark, Registrant submitted to the USPTO the Petition requesting the Director to grant withdrawal of the Section 71 Declaration and expunge the registration's file history with regard to the same on the ground that the information contained in the Section 71 Declaration and the Adonia Declaration was erroneous.

31. It is admitted and uncontestable that Registrant are not using the Trademark in commerce on the covered goods and services in the Registration.

32. Registrant has never used the Trademark in commerce.

33. Registrant knew that its statements regarding use of the Trademark were false at the time such statements were made.

34. The USPTO should not rely upon Registrant's material false statements in allowing the continued registration of the Trademark. The USPTO should not allow Registration No. 3,158,999 to remain valid.


WHEREFORE, Petitioner prays that Registration No. 3,158,999 be cancelled pursuant to 15 U.S.C. §§ 1064(3) because: (1) the Trademark has been abandoned by Registrant, and (2) the Registration has been maintained via fraudulent representations to the USPTO.

Dated: January 9, 2017

Respectfully submitted,

MOSES & SINGER LLP

By:



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Fax: 212-377-6053
Attorneys for Petitioner
Faram Holding and Furniture, Inc.

CERTIFICATE OF SERVICE

Pursuant to C.R.F. §2.1.1.1, I hereby certify that on January 9, 2017, a true and correct copy of the foregoing Petition for Cancellation was served, via overnight courier, as follows:

Faram 1957 S.p.A
Via Schiavonesca, 71
31040 Giavera del Montello, Treviso, Italy

AND

Holiday W. Banta
Ice Miller LLP
One American Square, Suite 2900
Indianapolis, IN 46282
Attorneys for Registrant Faram 1957 S.p.A.

Dated: January 9, 2017

MOSES & SINGER LLP

By: 

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New York, New York 10174-1299
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Fax: 212-377-6053
*Attorneys for Petitioner
Faram Holding and Furniture, Inc.*