

ESTTA Tracking number: **ESTTA823682**

Filing date: **05/30/2017**

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	Shangrila Private Limited		
Entity	Company	Citizenship	Pakistan
Address	293/16 Block-3 B.Y.J.C.H.S. Bahadurabad, Karachi, 74800 PAKISTAN		

Attorney information	Christopher J. Schulte Merchant & Gould P.C. 80 South Eighth St. Suite 3200 Minneapolis, MN 55402 UNITED STATES cschulte@merchantgould.com, lnguyen@merchantgould.com, jschmidt@merchantgould.com, dockmpls@merchantgould.com Phone:612-332-5300
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Registration Subject to Cancellation

Registration No	4863313	Registration date	12/01/2015
Registrant	ALON DAVID TABIBI 5805 WHITE OAK AVE UNIT #16065 ENCINO, CA 91416 UNITED STATES		

Goods/Services Subject to Cancellation


Class 032. First Use: 2015/01/06 First Use In Commerce: 2015/01/06 All goods and services in the class are cancelled, namely: Fruit drinks; Fruit drinks and fruit juices; Fruit drinks and juices; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice concentrates; Fruit nectars

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Other	Registration was and is void ab initio pursuant to Section 1 of the Trademark Act, 15 U.S.C. § 1051 and as set forth in T.M.E.P. § 1201.06(a)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	87454844	Application Date	05/18/2017
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	FRUITI-O		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2012/12/00 First Use In Commerce: 2012/12/00 Fruit drinks and juices		

Attachments	87454844#TMSN.png(bytes) Petition for Cancellation - FRUITI-O.pdf(290354 bytes)
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Signature	/Christopher J. Schulte/
Name	Christopher J. Schulte
Date	05/30/2017

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

_____)	
Shangrila Private Limited,)	
)	Cancellation No. _____
Petitioner,)	
)	Mark: FRUITI-O
v.)	Reg. No.: 4,863,313
)	Filing Date: June 1, 2015
Alon David Tabibi,)	Reg. Date: December 1, 2015
)	
Registrant.)	
_____)	

PETITION FOR CANCELLATION

1. Shangrila Private Limited, a company organized under the laws of Pakistan with a principal place of business at 293/16 Block-3 B.Y.J.C.H.S., Bahadurabad, Karachi, Pakistan (hereinafter “Petitioner”), believes it is damaged by registration of the FRUITI-O mark shown in Registration No. 4,863,313 (“the ’313 Registration”), registered December 1, 2015 (“the FRUITI-O Registration”), owned by Alon David Tabibi (hereinafter “Registrant”), and hereby petitions to cancel the registration. The grounds for cancellation are as follows:

2. Registrant is the owner of the ’313 Registration for the FRUITI-O mark on the Principal Register for “Fruit drinks; Fruit drinks and fruit juices; Fruit drinks and juices; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice concentrates; Fruit nectars,” in International Class 32.

3. Petitioner owns pending Application No. 87/454,844 for the mark FRUITI-O for “Fruit drinks and juices” (“Petitioner’s Goods”) in International Class 32. A printout of the current status and title of Petitioner’s FRUITI-O application from the USPTO's Trademark Status & Document Retrieval (TSDR) database is attached as Exhibit A.

4. Petitioner has used the FRUITI-O mark in the United States since at least as early as December 2012.

5. Since December 2012, Petitioner has sold and/or imported Petitioner's Goods into the United States under the FRUITI-O mark. Petitioner has sold, through various distributors, Petitioner's Goods throughout the United States.

6. Petitioner has priority over the '313 Registration. Petitioner has used the FRUITI-O mark in the United States prior to January 1, 2015, Registrant's alleged date of first use. Petitioner has used, marketed and offered throughout the United States under the common law all of Petitioner's Goods prior to January 1, 2015, Registrant's alleged date of first use.

7. Petitioner and Registrant previously had a manufacturer-distributor relationship from around September 2014 through May 2016 (hereinafter the "Distributorship Period"). During the Distributorship Period, Petitioner and Registrant agreed that Registrant would serve as the exclusive distributor for Petitioner of Petitioner's Goods sold under the mark FRUITI-O in Mexico and the states of California, Arizona, Nevada, Oregon, Hawaii, New Mexico, and Texas in the United States.

8. During the Distributorship Period, Petitioner sent to Registrant seven (7) shipments of Petitioner's Goods, totaling more than \$90,000 in Free on Board (FOB) value, to be sold in the United States under the FRUITI-O mark.

9. Petitioner and Registrant did not enter into any agreement for an assignment of ownership of the FRUITI-O mark from Petitioner to Registrant.

10. Petitioner did not consent to or authorize Registrant to file an application with the United States Patent and Trademark Office to register the mark FRUITI-O.

11. Registrant's application to register the FRUITI-O mark on June 1, 2015, was void *ab initio* because Registrant was not the owner of the FRUITI-O mark at the time of filing of the application.

12. The FRUITI-O mark for which Registrant obtained a registration is confusingly similar to the FRUITI-O mark owned by Petitioner. The marks are identical in appearance, sound, connotation and commercial impression.

13. The parties' goods also directly overlap. For example, both parties offer the identical goods, "fruit drinks and juices."

14. In addition to the relatedness of the parties' respective goods, the goods travel through the same channels of trade to the same classes of consumers: members of the general public. Consumers observing Registrant's FRUITI-O mark are likely to mistakenly believe that Petitioner is the source of those goods, or is associated with, affiliated with, or the sponsor of them, and vice versa. Moreover, the likelihood of confusion is increased because Registrant was a former distributor for Petitioner of Petitioner's Goods under the FRUITI-O mark.

COUNT I: U.S. REGISTRATION NO. 4,863,313 IS VOID *AB INITIO* BECAUSE REGISTRANT WAS NOT THE OWNER OF THE FRUITI-O MARK AT THE TIME OF THE APPLICATION FILING

15. Petitioner repeats the allegations of Paragraphs 1-14 of this Petition for Cancellation as if fully set forth herein.

16. Petitioner is the owner of the FRUITI-O mark pursuant to Section 1 of the Trademark Act, 15 U.S.C. § 1051.

17. Registrant served as the exclusive distributor for Petitioner of Petitioner's Goods under the FRUITI-O mark in Mexico and the states of California, Arizona, Nevada, Oregon, Hawaii, New Mexico, and Texas in the United States.

18. As part of Registrant's distributorship agreement with Petitioner, Registrant did not acquire any ownership rights in the FRUITI-O mark.

19. Registrant was not the owner of the FRUITI-O mark in connection with the goods listed in the '313 Registration when Registrant filed an application to register the FRUITI-O mark with the United States Patent and Trademark Office on June 1, 2015.

20. Upon information and belief, the '313 Registration was and is void *ab initio* pursuant to Section 1 of the Trademark Act, 15 U.S.C. § 1051 and as set forth in T.M.E.P. § 1201.06(a).

21. Petitioner is damaged by Registrant's '313 Registration for the mark FRUITI-O, which is in fact owned by Petitioner.

COUNT II: U.S. REGISTRATION NO. 4,863,313 SHOULD BE CANCELLED BECAUSE IT IS LIKELY TO BE CAUSE CONFUSION WITH PETITIONER'S MARK

22. Petitioner repeats the allegations of Paragraphs 1-21 in this Petition for Cancellation as if fully set forth herein.

23. Registrant's FRUITI-O mark is confusingly similar to Petitioner's FRUITI-O mark, and use thereof by Registrant on the goods identified in the registration is likely to cause confusion, mistake or deception that Registrant's goods are those of Petitioner, originate from Petitioner, or are otherwise endorsed, sponsored, affiliated with, associated with, or approved by Petitioner.

24. Petitioner is damaged by the '313 Registration for the mark FRUITI-O. Petitioner enjoys substantial and exclusive goodwill and good reputation in connection with its FRUITI-O mark. This goodwill and reputation is harmed by the use and registration of the mark FRUITI-O by Registrant.

25. Petitioner believes that continued registration of Registrant's FRUITI-O mark will affect Petitioner's ability to register its FRUITI-O mark and will result in damage to Petitioner.

26. Maintaining a federal trademark registration for Registrant's FRUITI-O mark would be contrary to 15 U.S.C. § 1052(d) and would violate or diminish the prior and superior rights of Petitioner in its FRUITI-O mark, causing irreparable damage and injury to Petitioner.

WHEREFORE, Petitioner asks that its Petition for Cancellation be granted and that Registration No. 4,863,313 be cancelled.

Please direct all correspondence to:

Christopher J. Schulte
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910

Petitioner herein appoints Christopher J. Schulte, John A. Clifford, Reg. No. 30,247; Gregory C. Golla; Scott W. Johnston, Reg. No. 39,721; Dana Jozefczyk; Heather J. Kliebenstein; Danielle I. Mattessich; Andrew S. Ehard; William D. Schultz, Linhda Nguyen, and all other attorneys of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

Shangrila Private Limited

By its Attorneys,

Date: May 30, 2017

s//Christopher J. Schulte/
Christopher J. Schulte
Linhda Nguyen
MERCHANT & GOULD P.C.
80 South Eighth Street, Suite 3200
Minneapolis, Minnesota 55402-2215
Telephone: (612) 332-5300

CERTIFICATE OF FILING

I hereby certify that a true and correct copy of the foregoing Petition for Cancellation was filed electronically with the Electronic System for Trademark Trials and Appeals this 30th day of May, 2017.

s/Abigail Krueger/

Abigail Krueger

EXHIBIT A

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TSDR now includes a Post Registration Maintenance Tab. When viewing a Registered mark, users will now find a new 3rd tab providing Post Registration information next to the "Status" and "Document" tabs, below the search text box. The tab will not appear if the mark is not registered.

[Trademark Status & Document Retrieval \(TSDR\)](#) [?](#)[SEARCH](#)[MULTI-SEARCH](#)

US Serial, Registration, or Reference No.

87454844

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[STATUS](#)[DOCUMENTS](#)[Download](#)[Print Preview](#)**Generated on:** This page was generated by TSDR on 2017-05-30 13:51:44 EDT**Mark:** FRUITI-O**FRUITI-O****US Serial Number:** 87454844**Application Filing Date:** May 18, 2017**Filed as TEAS RF:** Yes**Currently TEAS RF:** Yes**Register:** Principal**Mark Type:** Trademark**TM5 Common Status****Descriptor:**

LIVE/APPLICATION/Awaiting Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and has not yet been assigned to an examiner.

Status: New application will be assigned to an examining attorney approximately 3 months after filing date.**Status Date:** May 24, 2017[▼ Mark Information](#)[▲ Collapse All](#)**Mark Literal Elements:** FRUITI-O**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK[▼ Goods and Services](#)**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Fruit drinks and juices

International Class(es): 032 - Primary Class

U.S Class(es): 045, 046, 048

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 2012

Use in Commerce: Dec. 2012

▼ Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

▼ Current Owner(s) Information

Owner Name: Shangrila Private Limited

Owner Address: 293/16 Block-3, B.Y.J.C.H.S.
Bahadurabad, Karachi PAKISTAN

Legal Entity Type: private limited company

**State or Country Where
Organized:** PAKISTAN

▼ Attorney/Correspondence Information

Attorney of Record

Attorney Name: Christopher J. Schulte

Docket Number: 17874.1US01

**Attorney Primary Email
Address:** dockmpls@merchantgould.com

Attorney Email Authorized: Yes

Correspondent

**Correspondent
Name/Address:** CHRISTOPHER J. SCHULTE
MERCHANT & GOULD P.C.
P.O. BOX 2910
MINNEAPOLIS, MINNESOTA UNITED STATES 55402-0910

Phone: 612/332-5300

Fax: 612/332-9081

Correspondent e-mail: dockmpls@merchantgould.com
cschulte@merchantgould.com

**Correspondent e-mail
Authorized:** Yes

Domestic Representative - Not Found

▼ Prosecution History

Date	Description	Proceeding Number
May 24, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	

May 22, 2017

NEW APPLICATION ENTERED IN TRAM

▼ **TM Staff and Location Information**

TM Staff Information - None

File Location

Current Location: NEW APPLICATION PROCESSING

Date in Location: May 24, 2017

▼ **Assignment Abstract Of Title Information - Click to Load**

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