

ESTTA Tracking number: **ESTTA877441**

Filing date: **02/14/2018**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Naked Brand Group, Inc.		
Entity	Corporation	Citizenship	Nevada
Address	311 S. Division Street Carson City, NV 89703 UNITED STATES		
Attorney information	Michael J. Leonard Fox Rothschild LLP 997 Lenox Drive, Bldg. 3 Lawrenceville, NJ 08648-2311 UNITED STATES Email: ipdocket@foxrothschild.com, mleonard@foxrothschild.com		

Registration Subject to Cancellation

Registration No.	5401689	Registration date	02/13/2018
Registrant	MeCommerce, Inc. 350 Rhode Island St. Ste 360 San Francisco, CA 94103 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2017/08/14 First Use In Commerce: 2017/08/14 All goods and services in the class are subject to cancellation, namely: Bras; Lingerie; Panties; Undergarments; Underwear
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Related Proceedings	US Opposition No. ESTTA877438
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3669650	Application Date	10/23/1998
Registration Date	08/18/2009	Foreign Priority Date	NONE
Word Mark	NAKED		

Design Mark	<h1>NAKED</h1>
Description of Mark	NONE
Goods/Services	<p>Class 025. First use: First Use: 1998/06/01 First Use In Commerce: 2009/05/09 [MEN'S CLOTHING, namely, CAPS;] T-SHIRTS, TOPS, [TANK TOPS, JACKETS, PANTS, TROUSERS, JEANS, SHORTS;] LOUNGEWEAR, [ROBES, BATHROBES,] PAJAMAS, BOXER SHORTS, UNDERGARMENTS, [SWIMWEAR, BATHING TRUNKS; WOMEN'S CLOTHING, NAMELY, CAPS; T-SHIRTS,] TANK TOPS, [CROP TOPS, BLOUSES, DRESSES, SKIRTS, PANTS, JEANS, COATS,] LINGERIE, BRAS, [UNDERGARMENTS, UNDERGARMENT THONGS, BUSTIERS, CORSETS,] CAMISOLES, CHEMISES, NIGHTGOWNS, PEIGNOIRSETS, TEDDIES, PAJAMAS, ROBES, BATHROBES, [SWIMWEAR, BATHING SUITS, BEACH THONGS]</p>

Attachments	75568492#TMSN.png(bytes) NAKED-5 Petition for Cancellation.pdf(14678 bytes)
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Signature	/mjl/
Name	Michael J. Leonard
Date	02/14/2018

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In re: Registration No. 5401689
Registered 13 February 2018

NAKED BRAND GROUP, INC.

Petitioner,

-against-

MECOMMERCE, INC. DBA THIRDLOVE

Respondent.

Cancellation No.:

PETITION FOR CANCELLATION

Petitioner Naked Brand Group, Inc. (“Petitioner”), a Nevada corporation, believes that it is or will be damaged by the continued registration of Registration No. 5,401,689 for NAKED-5 (“the ’893 Registration”) and hereby petitions to cancel the same. As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner is the owner of U.S. Registration No. 3,669,650 for the mark NAKED, covering goods described as “t-shirts, tops, loungewear, pajamas, boxer shorts, undergarments, tank tops, lingerie, bras, camisoles, chemises, nightgowns, peignoir sets, teddies, pajamas, robes, bathrobes,” in International Class 025 (collectively “Petitioner’s Goods”).

2. Petitioner’s U.S. Registration No. 3,669,650 is incontestable and entitled to a constructive date of first use of 23 March 1998.

3. The foregoing Registration is not limited by channels of trade or classes of purchasers. Petitioner’s Registration is valid, subsisting and is *prima facie* evidence of the

validity of the registered Mark set forth therein, and Petitioner's exclusive right to use the registered Mark set forth therein in connection with the goods specified in the registration.

4. Through Petitioner's continuous use of its NAKED mark in connection with Petitioner's Goods, the NAKED mark has become well known to the general consuming public of Petitioner's Goods.

5. In correspondence dated 14 February 2017, Respondent was placed on notice of Petitioner's rights in and to the NAKED mark.

6. Notwithstanding Petitioner's superior prior rights in the NAKED mark in connection with Petitioner's Goods, on 18 August 2017, Respondent filed an application for registration of the mark NAKED-5 in connection with goods described as "Bras; Lingerie; Panties; Undergarments; Underwear" based on Respondent's claim of a 14 August 2017 date of first use in commerce. Respondent's application, Serial No. 87/574345 (the '345 Application") issued as the Registration No. 5,401,689 on 13 February 2018.

7. In support of the '345 Application, Respondent's Founder, David Spector, signed a declaration attesting to the following:

- To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.

- To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

8. At the time Respondent filed the '345 Application and at all times during the prosecution of the same, Respondent knew of Petitioner's prior use of the NAKED mark.

9. Since its initial use of the NAKED Mark, Petitioner has made a substantial investment in advertising, promoting and selling Petitioner's Goods under its NAKED Mark. Petitioner has extensively used, advertised, promoted, offered, and sold Petitioner's Goods to the public through various channels of trade in commerce, including the internet. Petitioner's customers and the public in general know and recognize Petitioner's NAKED Mark and associate same with Petitioner and/or Petitioner's Goods. Petitioner has built extensive notoriety and goodwill in connection with the offering of goods under Petitioner's NAKED Mark.

10. Petitioner will rely upon its ownership of its federal trademark registration for the mark NAKED and the common law rights it has obtained through its prior and continuous use of its NAKED Mark in commerce throughout the United States dating back to at least as early as June of 1998.

11. Respondent's NAKED-5 mark fully incorporates Petitioner's NAKED Mark, and is likely to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Petitioner and its reputation.

12. Respondent's filing date of 18 August 2017 is subsequent to the filing and registration date of Petitioner's NAKED Registration as set forth above.

13. Respondent's claimed 14 August 2017 date of first use for its NAKED-5 mark is subsequent to Petitioner's date of first use of its NAKED mark.

14. Petitioner's and Respondent's Goods are identical and are offered through the same channels of trade and purchased and used by the same class of purchasers. Respondent's Goods are not limited and are thus, presumed to travel in the same channels of trade, including those utilized for Petitioner's Goods, to the same class(es) of consumers.

15. The inclusion of the "-5" term in conjunction with the NAKED term to form Respondent's composite NAKED-5 mark is insufficient to avoid confusion, mistake or wrongful association between the respective parties' marks, especially given the fact that Respondent's Goods are identical to those of Petitioner.

16. Petitioner's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Respondent's Goods sold, offered for sale, and marketed under Respondent's NAKED-5 mark and misled into believing that such Goods are produced, distributed, offered, sold, or are in some way associated with Petitioner, to the damage and detriment of Petitioner and its reputation.

17. Petitioner will be damaged by Respondent's continued registration of the NAKED-5 mark as set forth in Registration No. 5,401,689 in that Respondent's mark is confusingly similar to Petitioner's NAKED Mark and is allegedly used in connection with Goods identical to, and/or closely related to Petitioner's Goods.

18. Respondent's continued registration of the NAKED-5 mark is contrary to 15 U.S.C. § 1052 and will violate and diminish the prior and superior rights of Petitioner to its NAKED Mark.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be sustained in favor of Petitioner and that Registration No. 5,401,689 be cancelled.

Respectfully submitted,

Date: 14 February 2018

By: s/michael leonard/
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Christopher D. Olszyk, Jr.

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*Attorneys for Petitioner
Naked Brand Group Inc.*

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Petition for Cancellation was served on Respondent this 14th day of February 2018 by sending same via e-mail to:

Kent M. Walker
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By: /michael leonard./