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Filing date: **12/14/2018**

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	Shatto and Sons, Inc.		
Entity	Corporation	Citizenship	California
Address	696 N. Coast Highway 101 Leucadia, CA 92024 UNITED STATES		

Attorney information	Matthew Miller Law Offices of Matthew Miller 755 Fresca Ct Solana Beach, CA 92075 UNITED STATES matt@millermlaw.com 8587556688
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**Registration Subject to Cancellation**

Registration No.	5023116	Registration date	08/16/2016
Registrant	Leucadia 371 second street encinitas, CA 92024 UNITED STATES Email: aaron@angellift.com		

**Goods/Services Subject to Cancellation**

Class 025. First Use: 2011/01/15 First Use In Commerce: 2012/11/15 All goods and services in the class are subject to cancellation, namely: Button down shirts; Collared shirts; Dress shirts; Hooded sweat shirts; Long-sleeved shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sun protective clothing, namely, rash guards; Sweat shirts; T-shirts
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**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
The mark is primarily geographically deceptively misdescriptive	Trademark Act Sections 14(1) and 2(e)(3)

**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	LEUCADIA
Goods/Services	clothing, namely shirts, sweatshirts, tank tops, dresses, skirts, hats and duffle bags

Attachments	Petition Cancel LEUCADIA Reg.pdf(1504642 bytes )
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Signature	/Matthew Miller/
Name	Matthew Miller
Date	12/14/2018

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

In the matter of Registration No. 5,023,116 issued on August 16, 2016.

SHATTO & SONS, INC.,	:	
	:	
Petitioner,	:	
	:	
v.	:	
	:	
M and M Holdings, LLC,	:	Cancellation No. _____
	:	
Registrant.	:	
	:	

BOX TTAB FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**PETITION FOR CANCELLATION**

In the matter of the registration of the geographic term, LEUCADIA, Registration No. 5,023,116 issued on August 16, 2016 (hereinafter referred to as “Registrant’s Mark”), owned by M and M Holdings, LLC, a Missouri Limited Liability Company with a principal address of 371 Second Street, Encinitas, California 92024 (“Registrant”), which registration covers Button down shirts; Collared shirts; Dress shirts; Hooded sweat shirts; Long-sleeved shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sun protective clothing, namely, rash guards; Sweat shirts; T-shirts in International Class 25. Shatto & Sons, Inc. (hereinafter “Petitioner”), a California corporation with a

principal business address of 696 N. Coast Highway 101, Leucadia, California 92024, believes it is being damaged and will continue to be damaged by such registration and hereby petitions for the cancellation thereof.

1. Leucadia, California, thought to be founded in 1875, is a beach community, with an estimated population of approximately 13,500 people, located within the northern part of Encinitas, San Diego County, California. Leucadia is a popular vacation destination, famous for its beaches and surf breaks.

2. Leucadia, California has appeared in numerous articles in national publications, extoling the virtue of its beaches and unique culture.

3. Leucadia, California has figured prominently in the history of surfing and its importance has remained. One of the earliest surf contests in the continental United States was held in Leucadia, California, drawing some of the biggest names in surfing at the time.

4. Registrant is the owner of United States Trademark Registration No. 5,023,116 for the geographic term LEUCADIA covering Button down shirts; Collared shirts; Dress shirts; Hooded sweat shirts; Long-sleeved shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sun protective clothing, namely, rash guards; Sweat shirts; T-shirts in International Class 25.

5. Registrant has consistently connected its goods with Leucadia, California as a geographic location. Registrant has stated on its website, "Leucadia is a vintage brand, a quiet town, a unique culture and a way of thinking. We are the last unspoiled beach town in Southern California. Unlike any other place along the California coast, Leucadia is the only destination where no one cares what you drive, only what you surf."

Registrant goes on to state on its website, “Leucadia’s 2 miles of beautiful beaches and 7 epic surf breaks are hidden from view if your (sic) driving the California coast. Our seclusion is our secret paradise. Our brand, our style and our quality are second to none, just like our beaches.” See Exhibit A. Registrant includes the following language on a hang tag with its goods, “Forty minutes north of Mexico (Leucadia, California is 40 miles north of the border with Mexico), 50 years back in time and a lifetime away from LA roll 7 epic surf breaks along a 2 mile stretch of sand. A place where burritos are for breakfast and fish are for tacos. Church begins with dawn patrol and ends with a green flash. Surfing isn’t a sport here, it’s a religion.” See Exhibit B.

6. Registrant has consistently communicated to its consumers that Leucadia, California and its goods are fundamentally one and the same. Registrant includes “Since 1875” (the year Leucadia, California is alleged to be founded) on its hang tags which are attached to its goods, inferring that the establishment of the clothing brand is one and the same with the town Leucadia, California. See Exhibit C. Registrant has also applied for LEUCADIA 1875, Serial No. 88/134,148.

7. Registrant has marketed its LEUCADIA brand to surf enthusiasts, a consumer intimately aware of Leucadia, California, offering surfing inspired apparel and surfboards. Registrant has also applied for LEUCADIA SURFBOARDS, Serial No. 88/143,087.

8. Petitioner established its business in Leucadia, California in 1975, selling original artwork, clothing and accessories.

9. Petitioner has used the term Leucadia in interstate commerce in the United States continuously since as early as 1975 in connection with the clothing, namely shirts,

sweatshirts, tank tops, dresses, skirts, hats and duffle bags, applying the Leucadia name to the goods in its Leucadia location.

10. Petitioner believes that it will be damaged by the continued registration of Registration No. 5,023,116 for the geographic term Leucadia as it relates to goods in International Class 25 and hereby petitions for cancellation of same on the grounds set forth herein.

#### COUNT I – Geographic Misdescriptive

11. Petitioner repeats and re-alleges each and every allegation set forth in paragraphs 1-10.

12. Upon information and belief Registrant manufactures and sells clothing under the term LEUCADIA which do not originate from Leucadia, California.

13. When used in connection with Registrant's goods, the LEUCADIA mark is primarily a geographically deceptively misdescriptive mark pursuant to Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3).

14. Upon information and belief, the continued registration of the Registration would bestow upon Registrant the right to use a mark which confuses the relevant consumers into mistakenly believing that Registrant's goods originate from Leucadia, California.

15. The Registration should therefore be cancelled in its entirety pursuant to Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3).

#### COUNT II – Likelihood of Confusion

16. Petitioner repeats and re-alleges each and every allegation set forth in paragraphs 1-15.

17. In the alternative, Petitioner argues that Registrant's use of the LEUCADIA mark is likely to cause confusion.

18. Since as early as 1975, almost thirty years before Registrant's filing date, of September 8, 2014, for Registration No. 5,023,116, Petitioner adopted and has continuously used its LEUCADIA mark in connection with shirts, sweatshirts, tank tops, dresses, skirts, hats and duffle bags. Petitioner's LEUCADIA brand is available nationwide.

8. Registrant's Mark so resembles Petitioner's LEUCADIA mark that it is likely to cause confusion, or to cause mistake or deceive within the meaning of Section 2(d) of the Trademark (Landham) Act of 1946, 15 U.S.C. §1052(d); and more particularly, Registrant's Mark and alleged use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that the goods covered by Registration No. 5,023,116 originate with or are affiliated with Petitioner, or otherwise are authorized, licensed or sponsored by Petitioner.

9. By reasons of the foregoing, Petitioner will be gravely damaged by the maintenance of Registration No. 5,023,116 for the mark LEUCADIA, because the continued registration of Registrant's Mark would be in violation of Petitioner's trademark rights.

WHEREFORE, Petitioner believes that it will be damaged by the continued registration of Registrant's LEUCADIA registration and prays that its petition to cancel said registration be sustained and that Registration No. 5,023,116 be cancelled.

This Petition for Cancellation is being filed electronically.

Respectfully submitted,

SHATTO AND SONS, INC.

By: \_\_\_\_\_/Matthew Miller/

Matthew Miller  
Law Offices of Matthew Miller  
755 Fresca Ct.  
Solana Beach, CA 92075  
(858) 755-6688  
Attorney for Petitioner

Dated: December 14, 2018



# EXHIBIT A

## ABOUT LEUCADIA®




Leucadia® is a vintage brand, a quiet town, a unique culture and a way of thinking. We are the last unspoiled beach town in Southern California. Unlike any other place along the California coast, Leucadia is the only destination where no one cares what you drive, only what you surf. If you do drive, you can still park in the dirt and walk tourist free paths through the trees and down to our unspoiled beaches.



Leucadia's 2 miles of beautiful beaches and 7 epic surf breaks are hidden from view if your driving the California coast. Our seclusion is our secret to paradise.

Our brand, our style and our quality are second to none, just like our beaches.

# EXHIBIT B



Forty minutes north of Mexico,  
50 years back in time  
and a lifetime away from LA  
roll 7 epic surf breaks  
along a 2 mile stretch of sand  
known as Leucadia, California.

A place where burritos are for  
breakfast and fish are for tacos.  
Church begins with dawn patrol  
and ends with a green flash.

Surfing isn't a sport here,  
it's a religion.

# EXHIBIT C

WWW.LEUCADIASURF.COM

CALIFORNIA  
*L*  
**LEUCADIA**<sup>®</sup>  
1875  
CLOTHIER

LIMITED EDITION DESIGN

L



60% COTTON /  
40% POLYESTER  
MASHINE WASH COLD  
DRY LOW

MADE IN CHINA