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

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	Victor Footwear Pty Ltd		
Entity	Proprietary Limited Com- pany	Citizenship	Australia
Address	15 George Young Street Auburn, New South Wales, 2144 AUSTRALIA		

Attorney informa- tion	Barbara A. Friedman Edell Shapiro and Finnan LLC 9801 Washingtonian Blvd. Suite 750 Gaithersburg, MD 20878 UNITED STATES efile@usiplaw.com (301) 424-3640		
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Registration Subject to Cancellation

Registration No.	4518120	Registration date	04/22/2014
Registrant	Johnson, Ron #1 Babbs St. Lucy BARBADOS Email: ron@blueprintcreativestudios.com		


Goods/Services Subject to Cancellation

Class 025. First Use: 2004/12/01 First Use In Commerce: 2013/04/24 All goods and services in the class are subject to cancellation, namely: Jackets; Pants; Shirts; Shoes; Socks; Swimwear; Undergarments

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	79219573	Application Date	09/06/2017
Registration Date	NONE	Foreign Priority Date	03/07/2017
Word Mark	MONGREL BOOTS		
Design Mark			
Description of Mark	The mark consists of a stylised image of a dog's head which is primarily orange and outlined in black and a white eye and teeth and a white spot on the nose. Below this is the wording MONGREL BOOTS in stylised black lettering and surrounded by black brackets.		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Footwear including boots, shoes, slippers, sandals and thongs; socks; soles for-footwear		

Attachments	79219573#TMSN.png(bytes) Mongrel Petition for Cancellation.pdf(145206 bytes)
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Signature	/Barbara A. Friedman/
Name	Barbara A. Friedman
Date	12/12/2018

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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_____)	
Victor Footwear Pty Ltd)	
)	
Petitioner,)	Cancellation No. _____
)	Mark: mongrel
)	Reg. No. 4518120
)	
v.)	
)	
Ron Johnson)	
)	
Registrant.)	
)	
_____)	

PETITION FOR CANCELLATION

Believing it would be damaged by the continued registration of the mark mongrel in International Class 25, Registration No. 4518120, pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064, and through its undersigned attorneys, Petitioner, Victor Footwear Pty Ltd, hereby petitions to cancel the same. As grounds for the Cancellation, Petitioner states as follows:

1. Petitioner is a Proprietary Limited Company organized and existing under the laws of Australia, with a business address of 15 George Young Street, Auburn, New South Wales 2144, Australia.
2. Petitioner manufactures and sells footwear, including, but not limited to, boots, shoes, and socks.

3. Petitioner has sold its MONGREL BOOTS branded products in the U.S. continuously since at least as early as May 2012.

4. Petitioner is the owner of an extension of protection to the U.S. under International Registration No. 1372247, which has been assigned U.S. Trademark Application Serial No. 79219573 (“Petitioner’s Application”). The mark, shown below, comprises a stylized image of a dog’s head primarily in orange, below which is the wording MONGREL BOOTS in brackets (“Petitioner’s Mark”), covering in class 25 “footwear including boots, shoes, slippers, sandals and thongs; socks; soles for footwear” (“Petitioner’s Goods”).



5. In a July 19, 2018 Final Office Action, the USPTO Trademark Examining Attorney assigned to Petitioner’s Application refused registration of Petitioner’s Mark under Section 2(d) of the Trademark Act, in view of Registration No. 4518120 for the mark mongrel, covering “Jackets; Pants; Shirts; Shoes; Socks; Swimwear; Undergarments.” The Examining Attorney found that the two marks were similar and the goods in Registration No. 4518120 were encompassed by the goods set forth in Petitioner’s Application. The Examining Attorney specifically stated that the cited registration covered shoes, as did Petitioner’s Application.

6. As a result of the Examining Attorney’s refusal to register Petitioner’s mark in the aforementioned Final Office Action, Petitioner has been damaged by Reg. No. 4518120.

7. According to the official records of the USPTO, as shown in its TDSR database, the owner of record of Reg. No. 4518120 is an individual citizen and resident of Barbados, one Ron Johnson.

8. Reg. No. 4518120 issued on April 22, 2014 from Application Serial No. 85379711, which had been filed on July 25, 2011 with a section 1(b) basis. On August 14, 2013, the Statement of Use was signed by Mr. Johnson, who declared therein that the mark was in use in commerce on all the goods in the application. The Statement of Use was filed and eventually accepted, following which, Reg. No. 4518120 issued on April 22, 2014.

9. Upon information and belief, and contrary to the assertion in the Statement of Use, neither at the time the Statement of Use was signed, nor at any time thereafter, had the mark in Reg. No. 4518120 been used on any product in the application other than tee shirts.

10. To the extent that the mark in Reg. No. 4518120 had not been used in commerce on jackets, pants, shoes, socks, swimwear, or undergarments at the time the Statement of Use was signed, these products should not have been included in the Statement of Use, were not properly included therein, and should have been stricken from the Statement of Use before it was filed.

11. The Registrant's sworn statement in the Statement of Use in then Application Serial No. 85379711 that the mark was in use on all the goods in the application was false and, upon information and belief, was made in bad faith, with knowledge of the falsity, or with reckless disregard of the truth, thereof.

12. Said false sworn statement in the filed Statement of Use in then Application Serial No. 85379711 was material to the issuance of Reg. No. 4518120.

13. Upon information and belief, the Facebook social media account for Mongrel Apparel was established in or around October 2008, and displayed tee shirts bearing the name mongrel across the front of the shirts. At this time, posts to this Facebook account indicate that tee shirts were being sold in stores in Barbados. There is no indication at the time that mongrel-branded tee shirts were sold in commerce with the U.S.

14. Upon information and belief, there appear to be no postings whatsoever on the Mongrel Apparel Facebook social media account from December 31, 2008 through August 20, 2014. An August 26, 2014 post to Mongrel Apparel Facebook social media account states “We’ve been away for a long, *long* time, but we’re back . . .”

15. The registrant signed the declaration of use in Application Serial No. 85379711 in support of registration of the mongrel trademark during the very same time period when the Facebook social media account posted that Mongrel Apparel had “been away”.

16. Upon information and belief, if Petitioner had sales of mongrel-branded tee shirts at any time during the pendency of Application Serial No. 85379711, and up through April 10, 2015, such sales of the mongrel-branded tee shirts had not continued.

17. On April 10, 2015, on the Mongrel Apparel Facebook page, the Mongrel Apparel Facebook account posted an announcement about the upcoming “relaunch of Mongrel Apparel, a line of tee shirts . . .” April 27, 2015 is the last dated post on the Mongrel Apparel Facebook page.

18. Upon information and belief, it was during this same operations’ hiatus, that the Registrant signed the declaration of use for the Statement of Use filing.

19. Upon information and belief, Registrant was not actively engaged in the sale of mongrel-branded apparel at the time the Statement of Use was signed and filed.

20. Upon information and belief, if Registrant was selling any mongrel-branded products during this time, such sales were in Barbados, if at all, and not in commerce with the U.S.

21. Upon information and belief, at all times relevant to this proceeding, the mark in Registration No. 4518120 may have been used sporadically, if at all, and on tee shirts only.

22. Upon information and belief, the mark in Registration No. 4518120 was not used on any products sold in commerce for many years between the execution of the Statement of Use, and the present time.

23. Upon information and belief, for many years between the execution of the Statement of Use and the present time, if there were any sales of products bearing the mongrel mark in U.S. commerce, it was sporadic and paltry, and not regular or in the ordinary course of a business.

24. Upon information and belief, for many years between the execution of the Statement of Use and the present time, and at least since late in the year 2015, there has been no use of the mark in Reg. No. 4518120 on class 25 products sold in commerce.

25. Upon information and belief, there is no indication of any intention to resume regular use of the mark in Reg. No. 4518120 in commerce on class 25 products.

26. Upon information and belief, the mongrel mark in Reg. No. 4518120 has been abandoned within the meaning of Section 45 of the U.S. Trademark Act. In view thereof, Reg. No. 4518120 is subject to cancellation.

27. The Examining Attorney prosecuting Petitioner's Application determined that a likelihood of confusion exists between Reg. No. 4518120 and Petitioner's Mark, based in part on his finding that Reg. No. 4518120 covers shoes. However, to the extent that Reg.

No. 4518120 covers shoes, this was an error occasioned by the Registrant's false statement in the sworn Statement of Use regarding use of the Mongrel mark on shoes, when there, in fact, was no such use.

28. If the Examining Attorney is correct in his likelihood of confusion finding, as compared to the Registrant, Petitioner has superior rights to Petitioner's Mark for use on Petitioner's Goods identified in Petitioner's Application. In view thereof, Reg. No. 4518120 is subject to limitation, partial cancellation, or cancellation in total.

WHEREFORE, Applicant requests that judgment be entered against the Registrant, that this Petition for Cancellation be granted, that Reg. No. 4518120 be cancelled, and for other just and appropriate relief as may be appropriate under the circumstances and indicated to restrict or rectify the register.

December 12, 2018



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