

ESTTA Tracking number: **ESTTA942877**

Filing date: **12/20/2018**

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	Acacia Fraternity Incorporated		
Entity	Corporation	Citizenship	Illinois
Address	12721 Meeting House Road Carmel, IN 46032 UNITED STATES		

Attorney information	Peter Rosene McBrayer, McGinnis, Leslie & Kirkland PLLC 9300 Shelbyville Rd. Suite 110 Louisville, KY 40222 UNITED STATES jwheat@mmlk.com, prosene@mmlk.com, arivers@mmlk.com 5023275400		
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Registration Subject to Cancellation

Registration No.	4488434	Registration date	02/25/2014
Registrant	ACACIA SWIMWEAR LLC PO Box 1157 Haiku, HI 96708 UNITED STATES		

Additional Registrant Information

Additional registrant information provided by the petitioner	Dana B. Robinson Attorney of Record TECHLAWLLP PO Box 1416 La Jolla, CA 92038-1416 UNITED STATES dana@techlawllp.com no phone number provided
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Goods/Services Subject to Cancellation

Class 025. First Use: 2012/12/31 First Use In Commerce: 2012/12/31 All goods and services in the class are subject to cancellation, namely: Bathing suits; Coverups; Dresses; One piece garment for infants and toddlers; One-piece garments for children; Overalls; Pants; Sarongs; Shirts; Shorts; Tops
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ACACIA		
Goods/Services	Â#JewelryÂ# and Â#Hats; Jackets; Shirts; Sweat pants; Sweat shirts; SweatersÂ#		

Attachments	Acacia Swimwear Petition to Cancel 4835-5470-2722 v.2.pdf(64727 bytes)
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Signature	/PeterJRosene/
Name	Peter J. Rosene
Date	12/20/2018

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

In the matter of Registration No. 4,488,434
Issued: February 25, 2014
Mark: ACACIA

ACACIA FRATERNITY INCORPORATED,

Petitioner,

v.

ACACIA SWIMWEAR LLC,

Registrant

CANCELLATION NO.

PETITION TO CANCEL

Comes the Petitioner, Acacia Fraternity Incorporated, (hereinafter “Acacia Fraternity” or “Petitioner”), and for its Petition to Cancel the Registration of the mark ACACIA owned by Acacia Swimwear LLC (hereinafter “Acacia Swimwear” or “Registrant”), Petitioner submits the following:

1. Petitioner, Acacia Fraternity Incorporated, is an Illinois Corporation, with its principal place of business at 12721 Meeting House Road, Carmel, Indiana 46032.

2. Registrant, Acacia Swimwear LLC is a Hawaii limited liability company. Its correspondence address of record with the PTO in relation to the registration in issue is care of its attorney of record, Dana B. Robinson at TECHLAWLLP, PO Box 1416, La Jolla, California 92038-1416 and counsel’s E-mail address of record is dana@techlawllp.com .

3. The Registration sought to be cancelled in this proceeding relates the mark, ACACIA, registered for “Bathing suits; Coverups; Dresses; One piece garment for infants and

toddlers; One-piece garments for children; Overalls; Pants; Sarongs; Shirts; Shorts; Tops,” namely Registration Number 4,488,434 (the “’434 Registration”) issued on February 25, 2014.

4. In the application that matured into the Registration, which is the subject of this cancellation proceeding, Acacia Swimwear represented to the PTO that the ACACIA mark sought to be registered had been in use in commerce since at least December 31, 2012.

5. Petitioner is the parent organization of a collegiate social fraternity with constituent local chapters located at numerous colleges and universities across the United States and has engaged in such endeavors under the name and mark, ACACIA, continually operated since 1904.

6. Petitioner is the owner of registration of the mark, ACACIA, with the PTO for “indicating membership in a fraternal organization,” namely Registration Number 5,296,006 issued on September 26, 2017.

7. For many decades prior to Registrant’s claimed first use date of December 31, 2012, Acacia Fraternity has continuously used the mark, ACACIA, in commerce for, among other things, jewelry, wearing apparel, and accessories.

8. On or about February 22, 2017, Petitioner filed with the PTO an application to register the mark ACACIA for “Jewelry” and “Hats; Jackets; Shirts; Sweat pants; Sweat shirts; Sweaters,” which application has been assigned Serial Number 87/345,943.

9. In the course of the prosecution of Petitioner’s application to register the mark, ACACIA, the Trademark Examining Attorney cited the ‘434 Registration, the registration which the subject of this cancellation proceeding, as a reference which under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), precludes the registration sought by Petitioner on the ground that the ACACIA mark Petitioner seeks to be register so resembles the ‘434 registered mark as to be likely,

when used on or in connection with Petitioner's goods, to cause confusion, or to cause mistake, or to deceive.

10. By reason of Petitioner's continuous use of the mark sought to be registered dating well prior to Registrant's first use, Petitioner enjoys priority of use.

11. Accordingly, and to the extent there is any likelihood of confusion resulting from use of the registered mark and the Acacia Fraternity mark, Petitioner will be damaged by continued registration of the mark which is the subject of this cancellation proceeding because (a) consumers are likely to purchase Registrant's goods believing them to be the Petitioner's goods, or goods sponsored by or associated with Opposer; (b) any defects in Registrant's goods may be attributed to the Opposer; and (c) continued registration of the mark will provide Registrant the presumptive right to use the mark with its goods. All of these effects of registration will cause injury to Opposer.

WHEREFORE, Petitioner prays that Registration Number 4,488,434 be CANCELLED.

/jackawheat/
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