

ESTTA Tracking number: **ESTTA990572**

Filing date: **07/26/2019**

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	Mast-Jaegermeister US, Inc.		
Entity	Corporation	Citizenship	New York
Address	10 Bank Street Suite 900 White Plains, NY 10606 UNITED STATES		

Attorney information	Katrin Lewertoff Ferdinand IP, LLC 1221 Post Road East Suite 302 Westport, CT 06880 UNITED STATES klewertoff@ferdinandip.com, jferdinand@24iplg.com, amalbin@24iplg.com, lauras@24iplg.com 2035574224		
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Registration Subject to Cancellation

Registration No.	4576371	Registration date	07/29/2014
Registrant	ALFWEAR INC. 4884 South 300 West Murray, UT 84107 UNITED STATES		

Goods/Services Subject to Cancellation

Class 024. First Use: 2014/05/27 First Use In Commerce: 2014/05/27 All goods and services in the class are subject to cancellation, namely: Textile fabrics for the manufacture of clothing
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Grounds for Cancellation

The mark is merely descriptive	Trademark Act Sections 14(1) and 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act Sections 14(1) and 2(e)(1)
No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)
Abandonment	Trademark Act Section 14(3)
Deceptiveness	Trademark Act Sections 14(3) and 2(a)
Other	Upon information and belief, Respondent is not

	currently using Respondent's alleged Mark for the registered Class 24 goods in U.S. commerce and has never used Respondent's Mark for the registered Class 24 goods in U.S. commerce. Moreover, Respondent did not use its alleged Mark on the goods in Class 24 prior to filing the use-based application and Respondent has never had, did not have at the time of filing of its application, and currently does not have, a bona fide intent to use Respondent's Mark in U.S. commerce for any of the registered Class 24 goods, which renders the Registration void ab initio. In addition, the registration for the Class 24 goods should not have issued because Respondent never submitted a proper specimen.
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Related Proceedings	92070074
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Attachments	JAG085USL KUEHL IC 24 petition to cancel.pdf(194113 bytes)
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Signature	/KL/
Name	Katrin Lewertoff
Date	07/26/2019

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

Mast-Jaegermeister US, Inc.,

Petitioner,

v.

Alfwear Inc.,

Respondent.

Cancellation No. _____

Mark: KÜHL

Reg. No.: 4576371

Int. Class: 24

PETITION FOR CANCELLATION

Petitioner Mast-Jaegermeister US, Inc., a New York corporation with a principal place of business at 10 Bank Street, Suite 900, White Plains, NY, 10606 (hereinafter “Petitioner”), believes that it is and will be damaged by the continued existence of Registration No. 4576371 for the alleged mark KÜHL for “textile fabrics for the manufacture of clothing” in International Class 24, and hereby petitions to cancel this registration pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064.

As grounds for cancellation, Petitioner alleges as follows:

1. Respondent’s alleged KÜHL trademark (the “KÜHL Mark”) is registered for use in connection with “textile fabrics for the manufacture of clothing” in International Class 24.

2. Respondent’s application to register its alleged KÜHL Mark was filed based on the alleged use in commerce for “textile fabrics for the manufacture of clothing” in International Class 24 since at least as early as August 1, 2000. In response to an office action, in which the Examiner objected to the submitted specimen for the Class 24 goods, Respondent

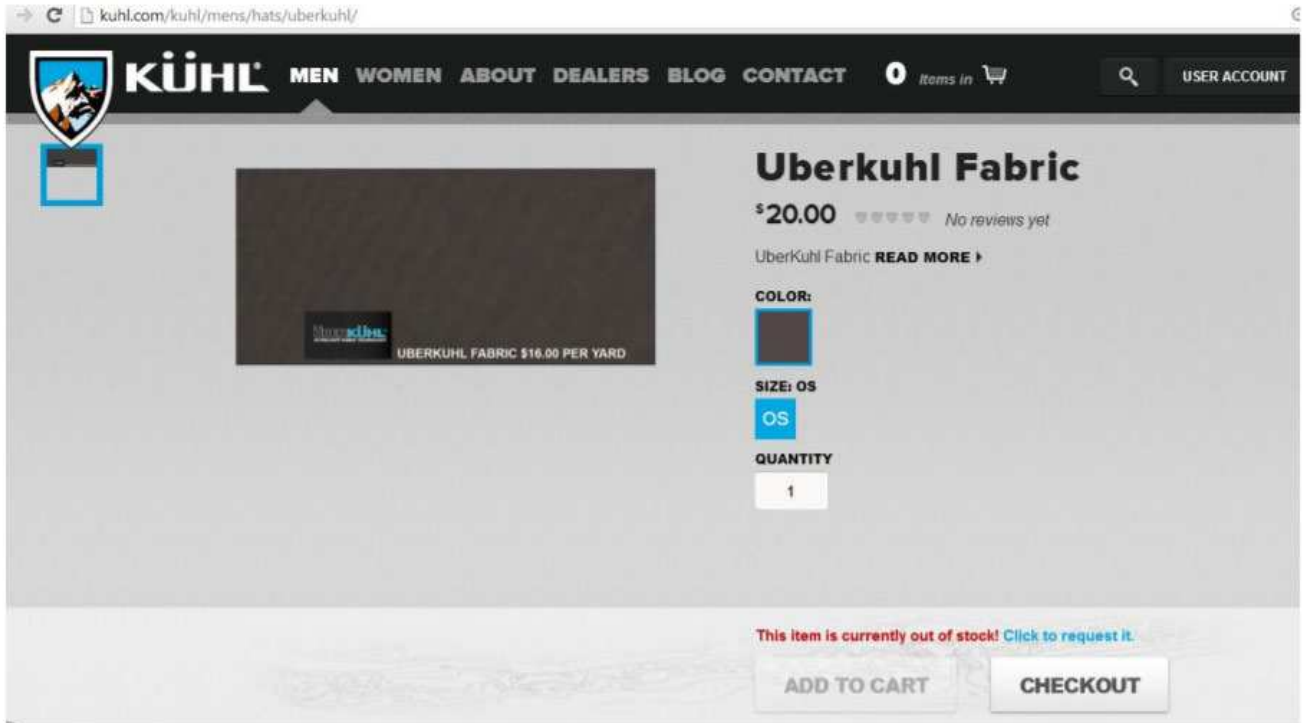
amended the filing basis to intent to use. In a statement of use filed on May 29, 2014, the Respondent submitted a use specimen and indicated the date of first use in commerce for the goods as May 27, 2014.

3. Upon information and belief, Respondent has never used in connection with, or placed its alleged KÜHL Mark on “textile fabrics for the manufacture of clothing” in Class 24, or containers, or on tags or labels affixed to the registered goods, and sold or transported any of the registered goods in commerce.

4. Upon information and belief, there was no bona fide use in commerce of Respondent’s alleged KÜHL Mark for the goods registered in Class 24 prior to the filing of the use-based application.

5. Upon information and belief, Respondent had no bona fide intent to use in commerce the alleged KÜHL Mark when it filed its application to register the mark for the goods in Class 24.

6. The registration for the alleged KÜHL Mark should not have issued because Respondent submitted a specimen that clearly showed that there was no use of the alleged mark at the time the statement of use was filed. Respondent, with its statement of use <http://tsdr.uspto.gov/documentviewer?caseId=sn85615248&docId=SOU20140530150233#docIndex=6&page=1>, submitted a specimen, a “point of sale website for fabric with mark,” that clearly showed that there was no current use of the applied-for mark because the Class 24 goods were not available when the statement of use was filed. The specimen clearly shows that “This item is currently out of stock!”:



In addition, the website printout was not a proper specimen because it did not show use of the applied-for mark.

7. The Registration for the alleged KÜHL Mark for the goods in Class 24 is void ab initio.

8. Upon information and belief, Respondent has no intent to begin use of the KÜHL Mark in connection with “textile fabrics for the manufacture of clothing” in Class 24.

9. Alternatively, if Respondent ever used the alleged KÜHL Mark in connection with “textile fabrics for the manufacture of clothing” in Class 24, Respondent has abandoned the alleged KÜHL Mark for the registered goods in Class 24, and has no intent to resume use of the alleged KÜHL Mark in connection with these goods.

10. Upon information and belief, Respondent has not used the alleged KÜHL Mark for the registered goods in Class 24 for at least 3 consecutive years.

11. Under the doctrine of foreign equivalents, the German word “kühl” means “cool” in English, and German speakers in the U.S. (the relevant public) translate “kühl” from German to English as “cool.” The main association of “kühl” is to “cool” as it relates to temperature, and the term does not reference the colloquial “cool.” The colloquial word “cool” is generally not translated by German speakers. Instead, German speakers use the English word “cool” to express acceptance, approval, and admiration. See <https://dict.leo.org/german-english/cool>.

12. The German word “kühl” is transliterated into and spelled “kuehl” in English. See <https://www.dict.cc/?s=kuehl>.

13. Upon information and belief, KÜHL, which is pronounced by English speakers as “cool,” conveys that the characteristic, feature, function, purpose, and use of the “textile fabrics for the manufacture of clothing” in International Class 24 is to have a cooling effect, be cool to the touch, to keep the body cold, and/or to cool the body.

14. KÜHL is deceptive in connection with the registered goods because the goods do not have the described characteristics or bring about the described results, the relevant public would purchase/purchases the products for the described adjectives, and the misdescription is a material factor that may be considered in purchasing decisions.

15. Alternatively, KÜHL is deceptively misdescriptive in connection with the registered goods because the registered goods do not have the described characteristic, feature, function, purpose, and use.

16. Alternatively, KÜHL is merely descriptive when used in connection with the registered goods because it merely describes the characteristics, qualities, features, functions, purpose, and use of the goods.

17. On August 17, 2017, Respondent filed a complaint for trademark infringement and dilution with the United States District Court for the District of Utah Central Division (2:17cv936 PMW) alleging that Petitioner's descriptive use of the German word "kühl" in connection with advertising for Petitioner's famous JÄGERMEISTER liqueur infringes and dilutes Respondent's alleged KÜHL Mark.

18. On January 2, 2018, a Notice of Suit regarding this lawsuit was submitted to the United States Trademark Office and made of record for the KÜHL registration.

19. Petitioner is damaged by the registration of Respondent's alleged KÜHL Mark to the extent that the registration conveys rights in the alleged KÜHL Mark to Respondent.

WHEREFORE, Petitioner requests that Registration No. 4576447 be cancelled, and this Petition for Cancellation be granted in Petitioner's favor.

July 26, 2019

Respectfully submitted,

/KL/

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