

ESTTA Tracking number: **ESTTA1010069**

Filing date: **10/21/2019**

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	Antonio Puig, S.A.		
Entity	sociedad anonima	Citizenship	Spain
Address	Plaza Europa 46-48 L'Hospitalet de Llobregat Barcelona, 08902 SPAIN		

Attorney information	Brooks R. Bruneau, Esq. FisherBroyles, LLP 100 Overlook Center Second Floor Princeton, NJ 08540 UNITED STATES brooks.bruneau@fisherbroyles.com, docketing@fisherbroyles.com, denise.mcculloch@fisherbroyles.com 609 454-6772		
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Registration Subject to Cancellation

Registration No.	5823990	Registration date	08/06/2019
International Registration No.	NONE	International Registration Date	NONE
Registrant	TRUWORTHS LTD 1 MOSTERT STREET CAPE TOWN SOUTH AFRICA		

Goods/Services Subject to Cancellation

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Clothing and headgear, namely, jackets,pullovers, jumpers, pants, jeans, shirts, shorts, skirts, swim suits, cap peaksand sun visors, sweaters, T-shirts
Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Distribution of advertising material; Franchising, namely, consultation and assistance in business management, organization and promotion; Business administration and office work; Preparing promotional and merchandising material for others; wholesale and retail store services featuring clothing; mail order services featuring clothing; export and import agencies in the field of clothing

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Other	No bona fide intent to use the mark with all goods/services at time of filing the application by the original applicant and at time of assignment by current registrant in violation of section 1(b)

Attachments	EARTHADDICT PETITION TO CANCEL 10 21 19.pdf(147557 bytes)
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Signature	/brooks r. bruneau/
Name	Brooks R. Bruneau
Date	10/21/2019

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

ANTONIO PUIG, S.A.,	:	Cancellation No.:
	:	
Petitioner,	:	Registration No.: 5823990
	:	Registration Date: August 6, 2019
v.	:	Mark: EARTHADDICT
	:	
	:	
	:	
TRUWORTHS LTD.,	:	
	:	
Respondent.	:	
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PETITION FOR CANCELLATION

In the matter of U.S. Registration No. 5823990 for the mark EARTHADDICT, owned by Truworths Ltd. (“Respondent”), a South African Company with a business address of Mostert Street, Cape Town, South Africa, registered in connection with the following goods and services in Classes 25 and 35:

Class 25: Clothing and headgear, namely, jackets, pullovers, jumpers, pants, jeans, shirts, shorts, skirts, swim suits, cap peaks and sun visors, sweaters, T-shirts

Class 35: Distribution of advertising material; Franchising, namely, consultation and assistance in business management, organization and promotion; Business administration and office work; Preparing promotional and merchandising material for others; wholesale and retail store services featuring clothing; mail order services featuring clothing; export and import agencies in the field of clothing.

Petitioner, Antonio Puig, S.A. (“Petitioner”) a sociedad anonima of Spain, with a business address of Plaza Europa, 46-48, L'Hospitalet de Llobregat, E-08902 Barcelona Spain, believes it is being damaged by the continued registration of EARTHADDICT as set forth in Registration No. 5823990, and hereby petitions the Trademark Trial and Appeal Board to cancel said registration.

As grounds for this Petition to Cancel, it is alleged as follows:

1. Petitioner is the owner of U.S. Trademark Application Serial No. 79254631 for the mark “THE EARTH ADDICTS” seeking registration in connection with a variety of perfumery and personal care items, namely, *“Perfumery; essential oils; fragrances for personal use; deodorants for personal use; non-medicinal soaps in liquid, solid or gel form for personal use; non-medicinal after-shave preparations; non-medicinal body care and cleaning preparations; non-medicinal body lotions, milks and creams; non-medicinal skin care preparations; exfoliants.”*

2. On May 2, 2019, Petitioner was served via WIPO with an Office Action advising that if application serial no. 86490107 for EARTHADDICT matures into registration there can be a Trademark Act Section 2(d) refusal, and that application serial No. 86490107 has since matured into registration.

3. EARTHADDICT registered under Registration No. 5823990 and is now a bar to registration of Petitioner’s THE EARTH ADDICTS Trademark Application Serial No. 79254631, causing damage to Petitioner. Therefore, Petitioner’s response to the Examiner’s option to present arguments in support of registration over the issue of potential conflict with EARTHADDICT is the filing of this Petition and a request for suspension until this case is completed. Accordingly, Petitioner that has standing for this matter.

4. The original Application Serial No. 86490107 for EARTHADDICT, which matured into Registration No. 5823990, was filed by Earth Child Clothing (Waterfront) Pty. Ltd. of Cape Town, South Africa on December 24, 2014.

5. On October 7, 2014 Truworths International Limited announced it had signed a letter of intent to acquire 100% of the shares of Earth Child Clothing (Waterfront) Pty. Ltd.

6. On June 27, 2015, Earth Child Clothing (Waterfront) Pty. Ltd. assigned the EARTHADDICT trademark and Application Serial No. 86490107 to Petitioner, and that assignment was recorded with the United States Trademark Office Assignment Branch on November 4, 2015.

7. Since the December 24, 2014 filing date of U.S. Application Serial No. 86490107 (which matured into Registration No. 5823990), there has been no use of the EARTHADDICT trademark in

connection with the Class 25 goods and Class 35 services listed in that registration, either by the original Applicant or Respondent.

8. Based upon the filing date of Application Serial No. 86490107 (December 24, 2014), there has been nearly five years of non-use of the EARTHADDICT mark in U.S. commerce in connection with the Class 25 goods and Class 35 services listed in the resulting Registration No. 5823990.

9. There is no current use, in U.S. commerce, of the EARTHADDICT trademark by Respondent in connection with the Class 25 goods or Class 35 services listed in Registration No. 5823990, nor any planned use for U.S. commerce.

10. Based upon the date of Assignment of the EARTHADDICT trademark and Application Serial No. 86490107 on June 27, 2015, there is has been over four years of non-use of the EARTHADDICT mark in U.S. commerce in connection with the Class 25 goods and Class 35 services listed in the resulting Registration No. 5823990, nor any planned use for U.S. commerce.

11. Registration No. 5823990 for the mark EARTHADDICT in Classes 25 and 35 has been abandoned by Respondent based upon non-use of the mark in U.S. commerce with no intention to begin use of said mark in U.S. commerce.

12. Additionally, Child Clothing (Waterfront) Pty. Ltd. did not have the requisite bona fide intent to use the EARTHADDICT mark in connection with the listed goods and services in Application Serial No. 86490107 at time of filing that application on December 24, 2014. As such, the resulting Registration No. 5823990 is void ab initio.

13. In the alternative, Respondent, Truworths Ltd., did not have the requisite bona fide intent to use the EARTHADDICT mark in connection with the Class 25 goods and Class 35 services listed in Registration No. 5823990 on June 27, 2015 when it was assigned the EARTHADDICT U.S. Trademark Application Serial No. 86490107, nor did Truworths Ltd. have the requisite bona fide intent to use the EARTHADDICT mark in connection with those goods and services on February 3, 2015 when it recorded

itself as the new owner of record for Application Serial No. 8649010. Accordingly, the subsequent Registration No. 5823990 is void ab initio.

WHEREFORE, Petitioner requests that this petition be granted, and Registration No. 5823990 be cancelled on the grounds of abandonment and/or on the grounds of lack of a bona fide intention to use the mark with all the listed goods and services in the underlying Application Serial No. 86490107 at the time of filing and/or at the time Truworths Ltd. acquired that application or recorded itself as the Applicant with the United States Trademark Office Assignment Branch.

Respectfully submitted:

ANTONIO PUIG, S.A.
Petitioner

Date: October 21, 2019

BY: /Brooks R. Bruneau/
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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Petition to Cancel was electronically filed with the Trademark Trial and Appeal Board this 21st day of October, 2019.

/brooks r. bruneau/

(Signature)

October 21, 2019

(Date of Signature)