

ESTTA Tracking number: **ESTTA1012580**

Filing date: **10/31/2019**

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	The Trustees of Columbia University in the City of New York		
Entity	Not-for-profit educational Inst.	Citizenship	New York
Address	450 Riverside Drive New York, NY 10027 UNITED STATES		

Attorney information	Robert W. Clarida Reitler Kailas & Rosenblatt LLC 885 Third Avenue 20th Floor New York, NY 10022 UNITED STATES rclarida@reitlerlaw.com, esantana@reitlerlaw.com 212-209-3044		
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Registration Subject to Cancellation

Registration No.	5877427	Registration date	10/08/2019
Registrant	ENCYCLOPAEDIA IRANICA FOUNDATION INC. 2472 Broadway, Suite 237 New York, NY 10025 UNITED STATES		

Goods/Services Subject to Cancellation

Class 016. First Use: 2003/12/17 First Use In Commerce: 2003/12/17 All goods and services in the class are subject to cancellation, namely: Printed publications, namely, books, articles, book reviews and encyclopedias in the field of Iranian civilization, history and culture in the Middle East, theCaucasus, Central Asia and the Indian subcontinent
Class 041. First Use: 2009/00/00 First Use In Commerce: 2009/00/00 All goods and services in the class are subject to cancellation, namely: Providing online publications in the nature of online books, articles and encyclopedias in the field of Iranian civilization, history and culture in the MiddleEast, the Caucasus, Central Asia and the Indian subcontinent; providing online reviews of books in the field of Iraniancivilization, history and culture in the Middle East, the Caucasus, Central Asia and the Indian subcontinent; providinginformation in the field of Iranian history
Class 042. First Use: 2009/00/00 First Use In Commerce: 2009/00/00 All goods and services in the class are subject to cancellation, namely: Providing an online research tool in the nature of an online search platform toallow users to research Iranian civilizations, history and culture in the Middle East, the Caucasus, Central Asia and the Indian subcontinent
Class 045. First Use: 2009/00/00 First Use In Commerce: 2009/00/00 All goods and services in the class are subject to cancellation, namely: Providing information in the

field of Iranian culture in the Middle East, Caucasus, Central Asia and the Indian subcontinent

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1
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/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Encyclopedia Iranica		
Goods/Services	printed publications, namely, books, articles, book reviews and encyclopedias in the field of Iranian civilization, history and culture in the Middle East.		

Attachments	Encyclopaedia Iranica Petition for Cancellation.pdf(478095 bytes)
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Signature	/Robert W. Clarida/
Name	Robert W. clarida
Date	10/31/2019

- “Providing an online research tool in the nature of an online search platform to allow users to research Iranian civilizations, history and culture in the Middle East, the Caucasus, Central Asia and the Indian subcontinent.” (Class 42)
- “Providing information in the field of Iranian culture in the Middle East, Caucasus, Central Asia and the Indian subcontinent.” (Class 45)

(collectively, the “*Mark’s Goods and Services*”).

The Trustees of Columbia University in the City of New York (“*Petitioner*”), is a not-for-profit tax exempt educational institution organized and subsisting under the laws of the State of New York. Historian Ehsan Yarshater (“*Prof. Yarshater*”) began to teach at Columbia in 1958, first as a Visiting Associate Professor from 1958-1960 and then as the Hagop Kevorkian Professor of Iranian Studies from 1960 until his retirement as a professor in 1999. Prof. Yarshater became the director of the Center for Iranian Studies at Columbia University, (the “*Center*”) in 1969. The Center is not a separate legal entity but is a part of Columbia, which not only provides the facilities but also maintenance and utility costs free of charge and provides institutional support for the Center’s administrative activities.

In 1979, Prof. Yarshater begin work on the Encyclopedia Iranica (the “*Work*”), an ongoing scholarly resource on Persian and Iranian history which has become the Center’s most prominent publication and is internationally regarded as the most comprehensive account of several millennia of Iranian history, language and culture in the Middle East, the Indian subcontinent and Central Asia. The Work was first published in 1982. Columbia is the owner of the copyright in the Work under its copyright policy. Attached hereto as **Exhibit A** is a copy of the cover page of the Work displaying the mark ENCYCLOPEDIA IRANICA and the publication date in 1982. Columbia has continuously published the Work from that time until the present.

Petitioner believes that it has and will continue to be damaged by the Registration and hereby petitions for the Registration’s cancellation. The continued presence of the Registration

on the federal trademark register constitutes an obstacle to Petitioner's ability to continue use of its ENCYCLOPAEDIA IRANICA mark in the Work, and on the Work's covers and marketing materials. The Registration, thus, is causing injury and damage to Petitioner, and Petitioner has standing to challenge it.

The grounds for cancellations are as follows:

COUNT I – The Trademark is Void for Prior Use of the Mark – Trademark Act § 2(d)

1. “It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Sengoku Works Ltd. V. RMC Int’l. Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996).

2. The Work, entitled ENCYCLOPEDIA IRANICA, was first published in 1982. Such date is several decades prior to Registrant's purported date of first use of December 17, 2003 for the Mark, and indeed predates the existence of Registrant, which was not established until 1990.

3. The common-law trademark rights in the Work are owned by the party or parties whose goodwill was first, and is still, associated with such Work in connection with the goods at issue, namely Petitioner.

4. As a consequence of Petitioner's continuous, substantial and widespread use of the Work, the scholarly community that constitutes the consuming public for the Work have come to know and associate the Work as originating from the Petitioner, such identification and association with Petitioner having occurred long prior to the December 17, 2003 date of first use of Registrant's Mark.

5. The Mark is so confusingly similar in sight and sound to Petitioner's use of the ENCYCLOPEDIA IRANICA mark – in fact they are identical – that there is a substantial likelihood of confusion amongst the relevant consuming public. Moreover, the Registrant's goods are identical to those of Petitioner, making confusion is virtually certain.

6. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration may create.

COUNT II – The Trademark is Void Because the Registrant is not the Owner of the Mark

7. Petitioner incorporates paragraphs 1-6 by reference.

8. In the alternative to the other counts herein, and to the extent the Mark is valid, the Registrant cannot be its owner because the Registrant was not the first individual or entity to use the Mark in commerce.

9. The Work, entitled ENCYCLOPEDIA IRANICA, was first published in 1982. Such date is several decades prior to Registrant's purported date of first use of December 17, 2003 for the Mark, and indeed predates the existence of Registrant, which was not established until 1990.

10. The common-law trademark rights in the Work are owned by the party or parties whose goodwill was first, and is still, associated with such Work in connection with the goods at issue, namely Petitioner.

11. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration may create.

COUNT III – The Trademark is Void for Fraud on the USPTO

12. Petitioner incorporates paragraphs 1-11 by reference.

13. "[T]he obligation which the Lanham Act imposes on an applicant is that he will not make knowingly inaccurate or knowingly misleading statements in the verified declaration forming a part of the application for registration." *Bart Schwartz International Textiles, Ltd. v. The Federal Trade Commission*, 289 F.2d 665, 129 USPQ 258, 260 (CCPA 1961).

14. Petitioner seeks to cancel the Registration on the ground that, on information and belief, it was obtained as a result of knowingly false statements about the ownership and use of the Mark, which were made with the intent to deceive the USPTO and constitute a fraud on the USPTO.

15. The Work has received financial support since its inception in the 1970s, from many significant sponsors, including the National Endowment for the Humanities, which supported it as a "major project" from 1979 to 2016. The Work was also provided with major support from numerous donors including the International Union of Academies, the Iran Heritage Foundation (London), the Semnani Foundation, the Institute of Ismaili Studies (London), and the Les Amies de l'Encyclopedie Iranica (Paris), as well as individual benefactors.

16. As described above, the Work has been known in the scholarly community since its publication in 1982. Petitioner knew about the existence of the Work entitled *Encyclopedia Iranica*, and indeed Registrant's own certificate of incorporation in 1990 states that Registrant's purpose is, *inter alia*, to "promote the cause of the Encyclopaedia Iranica and assure the *continuation* thereof" (emphasis added). The same document names Prof. Yarshater, the founding editor of the Work, as one of the initial directors of Registrant. Registrant therefore could not truthfully state at the time it applied to register the Mark, that "to the best of the signatory's knowledge and belief, no other person, has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive." 15 U.S.C. §1051(a)(3)(A), (a)(3)(D); 37 C.F.R. §2.33(b)(1).

17. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration may create.

WHEREFORE, Petitioner respectfully requests that:

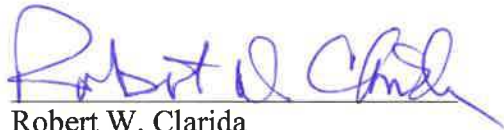
- a) Registrant be required to answer this Petition for Cancellation;
- b) Registration No. 5,877,427 be cancelled in its entirety; and
- c) the Trademark Trial and Appeal Board grant such other relief as it deems just and proper.

Please recognize as attorneys for Petitioner in this proceeding Robert W. Clarida (member of the Bar of the State of New York), Emily A. Santana (member of the Bar of the State of New York and State of New Jersey) and the law firm of Reitler Kailas & Rosenblatt LLC, 885 Third Avenue, 20th Floor, New York, New York 10022. Kindly direct all correspondence to the attention of Robert W. Clarida and Emily A. Santana at the foregoing address.

Dated: October 31, 2019

Respectfully Submitted,

REITLER KAILAS & ROSENBLATT LLC



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*Attorneys for Petitioner
The Trustees of Columbia University in the
City of New York*

EXHIBIT A

Encyclopedia Iranica Work

ENCYCLOPÆDIA
IRANICA

Volume I
ĀB-ANĀĪD

EDITED BY
LESLIE YARSEATER

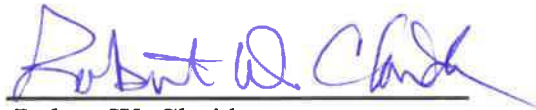


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CERTIFICATE OF SERVICE

The undersigned certifies that a true and complete copy of the foregoing Petitioner for Cancellation has been served by electronic mail upon Registrant by the following counsel of record on this 31st day of October, 2019:

Marylee Jenkins, Esq.
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New York, New York 10019
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Robert W. Clarida