

ESTTA Tracking number: **ESTTA1029421**

Filing date: **01/16/2020**

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	Cricut, Inc.		
Entity	Corporation	Citizenship	Utah
Address	10855 South River Front Parkway Suite 300 South Jordan, UT 84095 UNITED STATES		

Attorney information	Paul J. Reilly Baker Botts L.L.P. 2001 Ross Avenue Suite 900 Dallas, TX 75201-2900 UNITED STATES paul.reilly@bakerbotts.com, tyler.beas@bakerbotts.com, john.mitchell@bakerbotts.com, cecily.porterfield@bakerbotts.com, nytm- dpt@bakerbotts.com 214.953.6500
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Registrations Subject to Cancellation

Registration No.	5920511	Registration date	11/26/2019
Registrant	XIAOXIN CHEN No.415,Building 74,Nanpin Li LiuSha West Street,Puning Guangdong, 515300 CHINA Email: dmtm2019@outlook.com		

Goods/Services Subject to Cancellation

Class 007. First Use: 2019/04/16 First Use In Commerce: 2019/04/16 All goods and services in the class are subject to cancellation, namely: 3D printers; 3D printing pens; Automatic industrial labeling machines for applying labels to containers and bottles; Cutting machines; Embossing machines; Engraving machines; Laser engraving machines; Machine tools, namely, powered machines for cutting or shaping or finishing metals or other materials; Machines and machine tools for the cutting and forming of materials; Offset printing presses; Rotary steam presses, portable, for fabrics; Sewing machines; Stamping presses; Automatic stamping machines; Computerized engraving machines; Electric clothing pressing machines; Electric clothing pressing machines for commercial dry cleaning and laundry purposes including shirt press, collar and cuff press, utility press, legger press, drapery press, pants topper, mushroom topper and puff iron; Hair clipping machines for animals; Industrial paper cutting machines; Industrial inkjet printing machines; Laser machines for cutting, marking, and engraving fabric designed for installation directly above embroidery machines; Machine parts, namely, blades; Machines, namely, heat transfer presses; Ply-
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wood clipping machines

Grounds for Cancellation

Priority and likelihood of confusion		Trademark Act Sections 14(1) and 2(d)	
Registration No.	5920512	Registration date	11/26/2019
Registrant	XIAOXIN CHEN No.415,Building 74,Nanpin Li LiuSha West Street,Puning Guangdong, 515300 CHINA Email: dmtm2019@outlook.com		


Goods/Services Subject to Cancellation


Class 008. First Use: 2019/04/17 First Use In Commerce: 2019/04/17 All goods and services in the class are subject to cancellation, namely: Ceramic knives; Engraving needles; Flatirons; Goffering irons; Hand-operated riveting tools; Hobby knives; Scissors; Shears; Table knives, forks and spoons of plastic; Tweezers; Utility knives; Abrading tools; Electric irons; Hand tools, namely, graving tools; Hand tools, namely, engravers; Hand-operated cutting tools; Hand-operated cutting tools, namely, safety cutters; Hand-operated press machines for paper making, book binding, embossing and relief and intaglio printing; Manually-operated basket presses
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Grounds for Cancellation

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

U.S. Registration No.	5701019	Application Date	03/13/2018
Registration Date	03/19/2019	Foreign Priority Date	NONE
Word Mark	CRICUT EASYPRESS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 2017/08/01 First Use In Commerce: 2017/08/22 Electronic heated ceramic plate for transferring non-porous paper or plastic-coated stencils, namely, iron-on appliques and patches onto fabric and textiles		
U.S. Application No.	88715017	Application Date	12/04/2019

Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EASYPRESS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 2017/08/01 First Use In Commerce: 2017/08/22 Electronic heated ceramic plate for transferring non-porous paper or plastic-coated stencils, namely, iron-on appliques and patches onto fabric and textiles Class 020. First use: First Use: 2017/06/09 First Use In Commerce: 2018/03/20 Insulation mats for absorbing heat and protecting work surfaces		

Attachments	87832599#TMSN.png(bytes) 88715017#TMSN.png(bytes) Petition to Cancel - NICAPA EASYPRESS Reg. Nos. 5920511 and 5920512.pdf(32410 bytes)
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Signature	/Paul J. Reilly/
Name	Paul J. Reilly
Date	01/16/2020

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

In the Matter of Trademark Reg. No. 5,920,511
Mark: NICAPA EASYPRESS
Owner: Xiaoxin Chen
Filed: May 16, 2019
Registered: November 26, 2019

In the Matter of Trademark Reg. No. 5,920,512
Mark: NICAPA EASYPRESS
Owner: Xiaoxin Chen
Filed: May 16, 2019
Registered: November 26, 2019

Cricut, Inc.,	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. _____
	:	
Xiaoxin Chen,	:	
	:	
Respondent.	:	

PETITION TO CANCEL

Petitioner Cricut, Inc., a Utah corporation, having an address of 10855 South River Front Pkwy, Suite 300, South Jordan, Utah 84095 (hereinafter “Cricut” or “Petitioner”) believes that it has been, is being and will continue to be damaged by Registration Nos. 5,920,511 and 5,920,512 purportedly in the name of Xiaoxin Chen, a Chinese national allegedly having an address at No. 415, Building 74, Nanpin Li, LiuSha West Street, Puning, Guangdong, China 515300 (hereinafter “Registrant or Respondent”), and hereby petitions for cancellation of these registrations.

The specific grounds for this petition to cancel are as follows:

1. For more than 55 years, Cricut, either itself or through predecessors in interest, has been creating, manufacturing, marketing and selling crafting and do-it-yourself (“DIY”) products and accessories, including die-cutting machines, “smart” cutting machines, electronic cutting machines, crafting tools, heat transfer devices, hand tools, ink, design software, digital images, blades, scoring wheels, pens, mats, and cutting materials such as vinyl, iron-on, paper, fabric, felt, wood, leather, and foil, among other items, throughout the United States and around the globe. Petitioner has many proprietary products and services which it can and does offer its customers including, but not limited to, its heat transfer devices, mats and related goods sold in connection with its mark EASYPRESS and variants.

2. Since at least as early as August 2017, Petitioner created, adopted, and utilized in interstate commerce the inherently distinctive mark EASYPRESS and variants to identify its heat transfer devices, mats and other goods. Only Cricut and its related entities, licensees and affiliates are authorized to manufacture and sell crafting and DIY products and accessories in the United States under or in connection with the mark EASYPRESS and variants.

3. The names and marks EASYPRESS, CRICUT EASYPRESS, and variants have been extensively used by Petitioner in United States interstate commerce in connection with the advertising and promotion of Petitioner’s products on the internet, in trade and consumer publications, and through in-store displays, signage, point of sale materials, and the like. Such names and marks are also prominently presented on Petitioner’s products, advertisements, product packaging, manuals, technical and informational literature, and in other ways customary in the trade. Substantial amounts of time, effort, and money have been expended over the years ensuring that the purchasing public associates such marks exclusively with Cricut. Indeed, over

the past 3 fiscal years, Cricut expended over a million dollars in advertising and promoting goods and services, including under the aforementioned trademarks. Petitioner markets, advertises, promotes and sells its products directly to consumers through its website located at https://cricut.com/en_us/shop/, as well as through on-line retailers such as Amazon and Alibaba. Petitioner also distributes its products to many major crafting retail chains, including Michael's, JOANN Fabrics and Crafts, Hobby Lobby, A.C. Moore, etc., large nationwide big box retailers such as Wal-Mart, Target, Kmart, and Kohl's, among others, and via QVC and HSN.

4. As a result of Cricut's long, continuous and substantially exclusive use, marketing, advertising, and promotion, the name and marks EASYPRESS, CRICUT EASYPRESS and variants have acquired significant recognition in the marketplace throughout the United States by relevant consumers, and possess an extremely favorable reputation with an invaluable amount of goodwill, solely signifying Cricut as the exclusive source of the products identified by these marks. Such commercial strength and consumer exposure is further confirmed by Cricut's domestic sales of products marketed under or in connection with the mark EASYPRESS which have exceeded millions of dollars annually since its first use in 2017 up through and to the present.

5. By virtue of the extensive sales and the substantial sums spent to market, advertise and promote products under the marks EASYPRESS, CRICUT EASYPRESS, and variants, such marks, in addition to being inherently distinctive, have acquired significant commercial strength and strong secondary meaning in the minds of the purchasing public and the business community, and are now highly distinctive, if not famous, and serve uniquely to identify Petitioner's products and Cricut as the source of such products. Through widespread and

favorable public acceptance and recognition, Petitioner's EASYPRESS, CRICUT EASYPRESS, and variant marks have become assets of incalculable value as symbols of Petitioner's products.

6. Cricut has used in interstate commerce, and has established strong common law rights in, its EASYPRESS and CRICUT EASYPRESS marks on or in connection with crafting products and related goods for many years, long prior to the filing date and/or claimed use dates of the marks in the registrations-at-issue.

7. In addition to its prior common law rights in the marks EASYPRESS and CRICUT EASYPRESS and variants, Petitioner is the owner of (1) United States Trademark Application Serial No. 88/715,017 filed on December 4, 2019 for the mark EASYPRESS for "Electronic heated ceramic plate for transferring non-porous paper or plastic-coated stencils, namely, iron-on appliques and patches onto fabric and textiles" in International Class 7 (First Use Date: 8/1/17) (First Use In Commerce Date: 8/22/17), and "Insulation mats for absorbing heat and protecting work surfaces" in International Class 20 (First Use Date: 6/9/17) (First Use in Commerce Date: 3/20/18); and (2) United States Trademark Registration No. 5,701,019 registered on March 19, 2019 for the mark CRICUT EASYPRESS for "Electronic heated ceramic plate for transferring non-porous paper or plastic-coated stencils, namely, iron-on appliques and patches onto fabric and textiles" in International Class 7 (First Use Date: 8/1/17) (First Use in Commerce Date: 8/22/17). Hereinafter, Cricut's foregoing marks, including those registered, applied for and/or used in commerce, are referred to individually and/or collectively as the "EASYPRESS Marks".

8. On information and belief, on May 16, 2019, Respondent filed its application for the alleged trademark NICAPA EASYPRESS (Reg. No. 5,920,511) in connection with "3D printers; 3D printing pens; Automatic industrial labeling machines for applying labels

to containers and bottles; Cutting machines; Embossing machines; Engraving machines; Laser engraving machines; Machine tools, namely, powered machines for cutting or shaping or finishing metals or other materials; Machines and machine tools for the cutting and forming of materials; Offset printing presses; Rotary steam presses, portable, for fabrics; Sewing machines; Stamping presses; Automatic stamping machines; Computerized engraving machines; Electric clothing pressing machines; Electric clothing pressing machines for commercial dry cleaning and laundry purposes including shirt press, collar and cuff press, utility press, legger press, drapery press, pants topper, mushroom topper and puff iron; Hair clipping machines for animals; Industrial paper cutting machines; Industrial inkjet printing machines; Laser machines for cutting, marking, and engraving fabric designed for installation directly above embroidery machines; Machine parts, namely, blades; Machines, namely, heat transfer presses; Plywood clipping machines” in International Class 7, claiming an alleged date of first use of April 16, 2019, and an alleged date of first use in commerce of April 16, 2019. This application was issued a registration on November 26, 2019 under Reg. No. 5,920,511.

9. On information and belief, on May 16, 2019, Respondent filed its application for the alleged trademark NICAPA EASYPRESS (Reg. No. 5,920,512) in connection with “Ceramic knives; Engraving needles; Flat irons; Goffering irons; Hand-operated riveting tools; Hobby knives; Scissors; Shears; Table knives, forks and spoons of plastic; Tweezers; Utility knives; Abrading tools; Electric irons; Hand tools, namely, graving tools; Hand tools, namely, engravers; Hand-operated cutting tools; Hand-operated cutting tools, namely, safety cutters; Hand-operated press machines for paper making, book binding, embossing and relief and intaglio printing; Manually-operated basket presses” in International Class 8, claiming an alleged date of first use of April 17, 2019 , and an alleged date of first use in commerce of April 17,

2019. This application was issued a registration on November 26, 2019 under Reg. No. 5,920,512. Hereinafter, the two above-referenced alleged NICAPA EASYPRESS marks, including as allegedly used in commerce and/or applied for by Respondent, are referred to as the “NICAPA EASYPRESS Marks”.

10. Petitioner’s first use of its EASYPRESS Marks in commerce, since at least as early as August 22, 2017, was long prior to Respondent’s claimed dates of first use, application filing dates or dates of registration for its alleged NICAPA EASYPRESS Marks.

11. On information and belief, Respondent was or should have been, at all times, fully aware of Petitioner’s earlier use in commerce and/or registration of its EASYPRESS Marks prior to Respondent’s adoption and use of the alleged NICAPA EASYPRESS Marks.

12. Registration of Respondent’s alleged NICAPA EASYPRESS Marks, which are the subject of the registrations-at-issue, are barred by the provisions of Section 2(d) of the Trademark Act of 1946 because said marks consist of or comprise marks which so resemble Cricut’s EASYPRESS Marks, in particular, EASYPRESS, which have been in prior use and are also the subject of a prior registration in the United States Patent and Trademark Office, as to be likely, when used and registered in connection with the alleged goods of the Respondent, to cause confusion, mistake or deception.

13. As noted, Cricut has priority over Respondent because Petitioner’s use, application filing dates and/or registration dates for the EASYPRESS Marks, including EASYPRESS and CRICUT EASYPRESS, precede the Respondent’s filing date for its registrations-at-issue, the issuance of its purported registrations and/or any alleged dates of first use in commerce of Respondent’s purported NICAPA EASYPRESS Marks which are the subject of the registrations in this cancellation proceeding.

14. Respondent's alleged NICAPA EASYPRESS Marks, which are the subject of the registrations-at-issue, and Cricut's EASYPRESS Marks are similar. Indeed, Respondent's marks incorporate Cricut's well-known and highly regarded EASYPRESS mark in its entirety and represents a colorable imitation of one or more of Cricut's EASYPRESS Marks.

15. Additionally, the products in connection with which Respondent's purported NICAPA EASYPRESS Marks are allegedly used or registered and the goods in connection with which Cricut's EASYPRESS Marks are used, applied for and/or registered are similar, related or complementary, if not identical.

16. The products marketed and sold in connection with the alleged NICAPA EASYPRESS Marks and Cricut's EASYPRESS Marks are provided to the same type of customers for the same purposes through similar if not identical channels of trade, e.g. Amazon. Further, the description of the goods in Respondent's registrations-at-issue for the NICAPA EASYPRESS Marks contains no limitations on marketing channels or customers such that the channels of trade and target markets for Respondent's products will overlap with those for Cricut's products that are marketed and sold in connection with its EASYPRESS Marks.

17. On information and belief, Respondent willfully adopted and registered the purported NICAPA EASYPRESS Marks with the bad faith intent to trade off and unlawfully associate itself and its products with Cricut and the goodwill and strong reputation of Petitioner's EASYPRESS Marks, which would be confusing, misleading and/or deceptive to consumers.

18. Accordingly, Respondent's alleged NICAPA EASYPRESS Marks shown in the registrations-at-issue so resemble Cricut's foregoing and previously used and/or registered EASYPRESS Marks, particularly EASYPRESS and/or CRICUT EASYPRESS, as to be likely to cause confusion, to cause mistake or to deceive with consequent injury to Petitioner. The

likelihood of confusion, mistake or deception that would also arise from concurrent use and registration of the alleged NICAPA EASYPRESS Marks with Cricut's prior use, application and registration of its EASYPRESS Marks is that (a) persons are likely to believe that Respondent's goods have their source or origin in Cricut, or (b) that Respondent, its purported NICAPA EASYPRESS Marks, and its goods are a version of Petitioner's EASYPRESS Marks or are in some way legitimately associated, connected or affiliated with, sponsored, approved, endorsed or licensed by Cricut when, in fact, they are not.

19. Further, Cricut has no control over Respondent's impermissible use and registration of the alleged NICAPA EASYPRESS Marks. If products bearing the purported NICAPA EASYPRESS Marks are unsatisfactory or cause any harm or injury to consumers, Cricut will or is likely to suffer substantial and irreparable harm and damage to its business, reputation and goodwill associated with the EASYPRESS Marks and related products.

20. In view of the foregoing, continued registration of Respondent's alleged NICAPA EASYPRESS Marks are barred by the provisions of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), because said marks consist of or comprise marks which, when used in connection with the alleged goods of Respondent, are likely to cause confusion, mistake or deception. Indeed, Respondent's unauthorized use and/or registration of the alleged NICAPA EASYPRESS Marks has already caused instances of actual confusion in the marketplace with Cricut and its EASYPRESS Marks and related products.

21. Petitioner and Respondent are competitors in the field of crafting products. Cricut has been, is being, and will continue to be damaged by the continued registration of Respondent's alleged NICAPA EASYPRESS Marks because such registrations would support and assist Respondent in the confusing, misleading, and deceptive use of Respondent's alleged

NICAPA EASYPRESS Marks, and would give color of exclusive statutory rights to Respondent in violation and derogation of the prior and superior rights of Cricut.

22. The registrations-at-issue therefore comprise an improper obstacle to Petitioner's right to register, use and enforce its EASYPRESS Marks.

23. Unless Registration Nos. 5,920,511 & 5,920,512 are cancelled, Petitioner's use of its EASYPRESS Marks will be impaired, diminished and/or subject to attack. Cricut will be further damaged since it will be forced to use the EASYPRESS Marks under a threat of interference that is inappropriate.

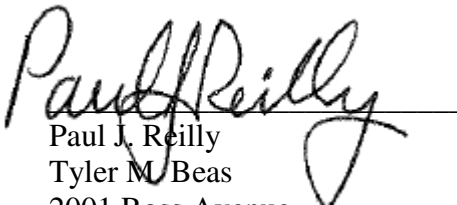
24. By virtue of the foregoing allegations, Petitioner would be, and is being damaged within the meaning of 15 U.S.C. § 1064 as a result of the continued registration of Respondent's alleged NICAPA EASYPRESS Marks in International Classes 7 and 8, which are the subject of United States Registration Nos. 5,920,511 and No. 5,920,512.

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained, that Registration Nos. 5,920,511 & 5,920,512 be cancelled in their entirety, and that the Board grant Petitioner any and all such further and favorable relief as would be just in these circumstances.

Respectfully submitted,

BAKER BOTTS L.L.P.

Date: January 16, 2020

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**ATTORNEYS FOR PETITIONER
CRICUT, INC.**