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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	J&MPP, LLC		
Entity	limited liability company	Citizenship	Missouri
Address	2778 US-67 Florissant, MO 63033 UNITED STATES		

Attorney information	Mallory L. Fisk Summers Compton Wells LLC 8909 Ladue Road St. Louis, MO 63124 UNITED STATES mfisk@scw.law, aherenda@scw.law 3149914999
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Registration Subject to Cancellation

Registration No.	5813367	Registration date	07/23/2019
Registrant	DKE and Sons Enterprises LLC 2533 S Brentwood Blvd Saint Louis, MO 63144 UNITED STATES		

Goods/Services Subject to Cancellation

Class 043. First Use: 2011/07/03 First Use In Commerce: 2011/07/03 All goods and services in the class are subject to cancellation, namely: Bar services; Restaurant services

Grounds for Cancellation

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)

Related Proceedings	DKE and Sons Enterprises LLC v. J&MPP LLC (4:19-cv- 03277) District Court, E.D. Missouri
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Attachments	Petition to Cancel FIELD BOX.pdf(91737 bytes) Exhibit A.pdf(917820 bytes)
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Signature	/Mallory L. Fisk/
Name	Mallory L. Fisk
Date	01/15/2020

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

In re Registration of:

Registrant: DKE and Sons Enterprises LLC
Reg. No.: 5,813,367
Mark: FIELD BOX
Reg. Date: July 23, 2019

J&MPP, LLC,)	
Petitioner,)	
v.)	
)	Cancellation No.
DKE and Sons Enterprises LLC,)	
Registrant.)	
)	

PETITION FOR CANCELLATION

Petitioner is J&MPP, LLC, a Missouri limited liability company, located at 2778 US-67, Florissant, MO 63033 ("Petitioner"). Petitioner believes that it is and will continue to be damaged by Registration No. 5,813,367 for the mark "FIELD BOX" (the "Mark"), issued on July 23, 2019 to DKE and Sons Enterprises LLC, a Missouri limited liability company, located at 2533 S Brentwood Blvd., St. Louis, MO 63144 ("Registrant"), and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges as follows, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

1. Petitioner has been, and currently is, engaged in the business of providing bar and restaurant services under the mark FIELD BOX NORTH ("Petitioner's Mark") and has the rights to the same pursuant to that certain Purchase and Sale Agreement dated as of February 1, 2018 between Petitioner and Field Box In North County, LLC.

2. Field Box In North County, LLC is an affiliate or subsidiary of DKE Enterprise, LLC, which began using the Mark in connection with bar and restaurant services at least as early as 2011, and is the owner of the Mark (the "Owner").

3. On January 11, 2019, Registrant filed an application with the U.S. Patent and Trademark Office under section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a) to register the Mark in connection with bar services and restaurant services in International Class 043, Serial No. 88/259,002 (the "Application").

4. On February 15, 2019, after Registrant submitted its Application with the United States Patent and Trademark Offices, Registrant claims to have purchased certain rights to the Mark pursuant to a Purchase and Sale Agreement between the Owner and Field Box St. Peters, LLC, an affiliate of Registrant (the "Agreement", attached hereto as Exhibit "A").

5. On November 5, 2019, Registrant sent Petitioner a Cease and Desist letter alleging likelihood of confusion between the Mark and Petitioner's use of FIELD BOX NORTH.

COUNT I: Invalid And Void Application – Registrant Not Lawful Owner

6. Petitioner repeats and realleges paragraphs 1 through 5 above.

7. Registrant's Application averred declarations under oath that Registrant was the owner of the Mark, that "no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive," that "the allegations and other factual contentions made above have evidentiary support".

8. Based in part on the information supplied in the Application by Registrant and its attorney, including these declarations, the Mark was registered on July 23, 2019 and received a Registration No. 5,813,367 (the "Registration").

9. Pursuant to TMEP §1201.02(b), an application based on use in commerce under 15 U.S.C. §1051(a) must be filed by the party who owns the mark on the application filing date. If

the applicant does not own the mark on the application filing date, the application is *void*. 37 C.F.R. §2.71(d).

10. Petitioner undertook an investigation to evaluate Registrant's ownership of the Mark, and obtained a copy of Agreement, where Registrant purports to have purchased the rights to the Mark from the Owner.

11. Based in part on clear language of the Agreement dated February 15, 2019 and the results of the investigation, Registrant was not the owner of the Mark as of the date of the Application filing date (January 11, 2019), rendering the Registration void *ab initio*.

12. In the alternative, even if the Application had been timely filed after the Agreement was in effect, the wrong party was *still* described when listing the "owner" in the Application, because the Agreement was between the Owner and Field Box St. Peters, LLC rather than DKE and Sons Enterprises LLC.

13. Per TMEP 12.01.02(c), filing an application in the wrong name of the owner, even if a wholly-owned parent or subsidiary, is a non-correctable error in identifying an application, and renders the application void as filed if the applicant is not the owner of a mark.

14. Accordingly, the failure to properly list the owner of Mark on the Application renders the Registration subject to cancellation pursuant to Section 14(c) of the Lanham Act 15 U.S.C. § 1064(3).

COUNT II: Fraud In The Application – Allegation of Ownership

15. Petitioner repeats and realleges paragraphs 1 through 14 above.

16. Registrant's Application contains a statement that DKE and Sons Enterprises LLC is the owner of the Mark and the standard declaration described in Paragraph 7 above as to the truth of Registrant's statements in the Application.

17. Registrant was not the owner of the Mark as of the date the Application was filed, and Registrant was aware of the fact that it had not yet (purportedly) purchased such rights in and to the Mark at the time of filing, as evidenced by its later execution of the Agreement conveying certain rights to an affiliate, Field Box St. Peters, LLC, over 35 days after the filing date of the Application.

18. Thus, Registrant's declarations in the Application describing the Registrants as owner of the Mark were false factual statements made to the United States Patent and Trademark Office.

19. Further, such misrepresentations were material to the validity of the Registration, as the Mark would not have been registered to Registrant had the false factual statements not been made in the Application.

20. Finally, the false statements were made knowingly with a fraudulent intent to deceive the United States Patent and Trademark Office and public at large.

21. Registrant's attorney, Christopher A. Thornton, as the signatory of the Application, further declared and acknowledged under oath that he understood "willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true."

22. Christopher A. Thornton was also the attorney that assisted Registrant with the preparation of the Agreement, which was not signed until *after* the filing of the Application. As a result, Christopher A. Thornton had full knowledge that the Registrant was not the Owner of the

Mark at the time of filing, further demonstrating that the false statements were made knowingly and with an intent to deceive the United States Patent and Trademark Office.

23. Registrant and its counsel did not have a good faith, reasonable basis for believing that Registrant was the owner of the Mark. As an attorney, especially one that holds himself out to counsel on trademark registration matters, Christopher A. Thornton is aware that "reading, understanding, and verifying the accuracy of documents that one signs is critical" (*Nationstar Mortgage LLC v. Ahmad*, 112 U.S.P.Q.2d 1361 (T.T.A.B. 2014)) and thus there is no excuse or justification for his false declarations made on behalf of Registrant.

24. Registrant's false statements as to the owner of the Mark were made knowingly, with an intent to procure registration to which Registrant was not entitled, and Registrant was successful in procuring favorable examination, publication, and registration of the Application and resulting Registration.

COUNT III: Fraud In The Application – Allegation That No Other Person Has the Right to Use the Mark in Commerce.

25. Petitioner repeats and realleges paragraphs 1 through 24 above.

26. Registrant's application averred declarations under oath that that "no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive," and that "the allegations and other factual contentions made above have evidentiary support".

27. Registrant had full knowledge that the Owner, as well as the Owner's licensees, including Petitioner, had the right to use the Mark in commerce and further, that such use by the

Owner and its licensees in connection with identical bar and restaurant services would be likely to cause confusion or mistake or to deceive.

28. Registrant's business relationship since 2011 with the Owner as well as its prior dealings with Petitioner demonstrates that it knew others had the rights to use the Mark in commerce as of the date of the oath made in the Application.

29. Further, Registrant had full knowledge that the Owner had legal rights to the Mark superior to Registrant's.

30. Registrant believed that the Owner's (and its licensee's) use of the Mark would cause a likelihood of confusion with Registrant's use of the Mark, as evidenced by the Cease and Desist letter sent by Registrant (through attorney Christopher A. Thornton, the signatory of the Application) to Petitioner alleging likelihood of confusion between the use of the terms FIELD BOX and FIELD BOX NORTH.

31. Thus, Registrant's declarations in the Application averring that no other persons had the right to use the Mark in commerce as of the date of the Application were false factual statements made to the United States Patent and Trademark Office.

32. Registrant, in failing to disclose these facts to the United States Patent and Trademark Office, intended to procure a registration to which it was not entitled.

33. Further, such misrepresentations were material to the validity of the Registration, as the Mark would not have been registered to Registrant had the false factual statements not been made in the Application.

34. Finally, the false statements were made knowingly with a fraudulent intent to deceive the United States Patent and Trademark Office and public at large.

35. Registrant and its counsel did not have a good faith reasonable basis for believing that Registrant was the only person that had the right to use the Mark in commerce, *especially* considering that the Agreement purporting to convey certain rights to the Mark was not in effect as of the date of the Application.

36. Registrant's false statements as to the owner of the Mark were made knowingly, with an intent to procure registration to which Registrant was not entitled, and Registrant was successful in procuring favorable examination, publication, and registration of the Application and resulting Registration.

37. Based on the foregoing, Petitioner believes and therefore alleges that Registrant willfully made fraudulent misrepresentations in its Application with the intent to deceive the United States Patent and Trademark Office and public at large in contravention of the Lanham Act, the Registration is void *ab initio*, and Registrant has no right to maintain its registration on the Principal Register.

38. If the Registration is not cancelled, it will continue to permit Registrant to retain the presumption of an exclusive right to the FIELD BOX mark, thereby casting a cloud upon Petitioner's right to use its FIELD BOX NORTH mark in the United States. Such continued allowance of Registrant's registration and limitation to Petitioner's right to use its mark is and will continue to be a source of damage and injury to Petitioner and the purchasing public.

WHEREFORE, Petitioner J&MPP, LLC prays that the instant Petition for Cancellation be granted, that Registration No. 5,813,367 be cancelled, and for such other and further relief as is just and proper herein.

Date: January 15, 2020

By: /s/ Mallory L. Fisk
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Exhibit "A"

The Agreement

PURCHASE AND SALE AGREEMENT

This Agreement (hereafter ("Agreement")) is made on this 15th day of February, 2019, by and between DKE Enterprise, LLC d/b/a Field Box, hereinafter designated as Seller, and Field Box St. Peters, LLC, hereinafter designated as Purchaser.

Seller agrees to sell to Purchaser and Purchaser agrees to purchase from Seller the property described in paragraph 1 hereof subject to the following terms and conditions:

1. Description of Property.

(a) The Seller stock in trade owned by Seller on February 15, 2019.

(b) The bar furnishings, furniture, fixtures and equipment, supplies, POS system, liquor stock, and everything in the premises constituting personal property of the Seller as owned by Seller on February 15, 2019.

(c) All right, title, and interest of whatever kind in the business name and service mark FIELD BOX, together with:

- i. the goodwill of the business relating to the products and services on which the mark is used and/or for which it is registered,
- ii. all income, royalties, and damages hereafter due or payable to Seller with respect to the mark, including without limitation, damages, and payments for past or future infringements and misappropriations of the mark, and
- iii. all rights to sue for past, present and future infringement or misappropriations of the mark..

2. Purchase Price. The total purchase price for the sale contemplated under this Agreement shall be \$50,000.00 and shall be apportioned for each of the items of property set forth in paragraph 1 hereof as follows:

(a) Seller stock in trade shall be sold for the purchase price of \$10,000.00.

(b) Seller ownership of the bar furnishings, furniture, fixtures, POS System, office equipment and supplies, and all personal property owned by Seller for the purchase price of \$20,000.00.

(c) Seller right, title and interest of whatever kind in the business name and service mark FIELD BOX and the associated goodwill and rights shall be sold for the price of \$20,000.00.

3. Terms of Payment. The total purchase price determined as provided in paragraph 2 hereof shall be paid by Purchaser as follows:

(a) Deposited in escrow previously herewith with Seller \$0.00.

(b) The balance of said purchase price shall be paid in the following manner: Purchaser shall pay to Seller the amount of \$50,000.00 on February 15, 2019.

4. Risk of Loss. At the time of closing, all property agreed to be sold hereunder shall be delivered to Purchaser in the same condition as at the close of business at 2:00 AM of February 15, 2019.

5. Possession. Possession of the personal property described in paragraph 1 hereof shall be given to Purchaser on February 15, 2019, purchaser shall not acquire any title to or property in the assets of Seller agreed to be sold hereunder until possession has been given to Purchaser in accordance with this paragraph.

6. Proration. The following items shall be prorated:

(a) Utilities as of February 15, 2019;

(b) Personal Property Taxes as of February 15, 2019;

7. Lease Provision. This Agreement is contingent upon the Purchaser executing a new five (5) year Lease Agreement to lease the premises currently occupied by the bar Field Box, located at 4 Main Street, St. Peters, MO 63376 (the "Premises"). It is stipulated and agreed to that DKE Enterprise, LLC, and Michael Kleeschulte shall be released from any and all financial liabilities related to the lease of the Premises. Any Security Deposit paid by DKE Enterprise, LLC and/or Michael Kleeschulte for their lease of the Premises shall be refunded to said party within 30 days of closing.

8. Retail Sales Taxes. Any sales, purchase, or use tax under the law of the State of Missouri or of any county, city, or subdivision thereof which may be payable by reason of the sale of all or any portion of the property under this agreement shall be borne by Seller, and Seller agrees to reimburse Purchaser on demand for any such tax. Seller shall provide Purchaser with all appropriate "No Sales Tax Due" letters from the State of Missouri.

9. Assignment of Business Name and Service Mark. Seller hereby conveys, transfers, and assigns to the Purchaser all of the Seller's right, title, and interest of whatever kind in the business name and service mark FIELD BOX, together with:

a) the goodwill of the business relating to the products and services on which the mark is used and/or for which it is registered,

- b) all income, royalties, and damages hereafter due or payable to Seller with respect to the mark, including without limitation, damages, and payments for past or future infringements and misappropriations of the mark, and
- c) all rights to sue for past, present and future infringement or misappropriations of the mark.

Seller further covenants that it will take all actions that may be necessary for securing, completing, or vesting in the Purchaser full right, title, and interest in the mark and its related property.

10. Warranties of Seller. Purchaser has been afforded full opportunity to examine the personal property to be purchased by the Purchaser hereunder and no representations or warranties whatever with respect thereto are made by Seller except that:

(a) Seller will have at the closing date and will convey to Purchaser good and marketable title to all the personal property agreed to be sold by Seller hereunder free and clear of any lien or encumbrance.

(b) Seller will not be in default on the closing date in any material respect in the performance of any of Seller obligations under any contract or agreement sold to Purchaser hereunder.

(c) There are no existing contracts of employment with individual employees of Seller.

(d) The property agreed to be sold hereunder includes all tangible personal property owned by Seller and used in Seller's business on the closing date except as otherwise expressly provided for herein.

11. Execution of Additional Instruments. Following the closing date Seller will, on request of Purchaser, execute and deliver to Purchaser such further instruments in writing as may be required to complete or evidence the transaction herein provided for, and Purchaser will, on request, execute and deliver like instruments to Seller.

12. Closing Tax Returns, Notices and Reports, Opening Reports. Seller will promptly file all closing returns, notices, and reports of every kind or nature required by the federal, state, county, or municipal governments, or any subdivision thereof, with respect to said property or assets and pay all sums payable in connection therewith.

Purchaser will promptly file all necessary returns, notices, reports, and applications and other matters required with respect to said property and assets by any of said governmental authorities.

13. Binding on Successors, Use of Terms. This Agreement shall inure to the benefit of, and be binding upon, the heirs, administrators, and assigns of each of the parties hereto. Words used in this agreement in the present tense include the future as well as the present; words used in the masculine gender include the feminine and neuter; the singular number includes the plural, and the plural the singular; and the word "person" includes a corporation as well as a natural person.

14. Captions and Paragraph Headings. Captions and paragraph headings used herein are for convenience only and are not a part of this agreement and shall not be used in construing it.


15. Miscellaneous. The parties expressly stipulate that the Purchaser is purchasing the assets of DKE Enterprise, LLC d/b/a Field Box and not the stock or membership interests of the company. Purchaser is not purchasing any portion of any ownership of DKE Enterprise, LLC.

In WITNESS WHEREOF, the parties hereby to have executed this agreement the day and year first above-written.

Seller- DKE Enterprise, LLC


By: Michael Kleeschulte – Mg. Member

Purchaser – Field Box St. Peters, LLC


By: Dustin English – Mg. Member