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

Proceeding no.	92073334
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**In the Matter of Registration No. 5,829,055**

**Mark: GOLDEN EAGLE**

Great Knives Manufacture Co., Ltd. :

:

Petitioner, :

:

v. :

Cancellation No. 92073334

:

Universal Sewing Supply, Inc. :

:

Respondent. :

:

:

:

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**PETITIONER'S TRIAL BRIEF**

Dated: September 25, 2022

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## **I. PRELIMINARY STATEMENT**

Fraud in the procurement of a trademark registration can be difficult to prove -- but not on the stark facts of this case. Respondent Universal Sewing Supply, Inc. sells industrial sewing related equipment, supplies, and parts. Petitioner Great Knives Manufacture Co., Ltd. is an original equipment manufacturer of, among thousands of other products, hundreds of cutting implements including thread-cutting nippers and scissors sold since the early 1980s in the United States under Petitioner's GOLDEN EAGLE brand.

Respondent well knew that Petitioner's GOLDEN EAGLE nippers and scissors were sold in the United States for many years by Petitioner's primary US distributor, Superior Sewing Machine & Supply LLC in New York City ("SSMS"). Philip Samuels, the Chief Executive Officer of Respondent and Lonny Schwartz, the President of SSMS, are personal friends and were close business associates for many years. Notwithstanding Respondent's knowledge of SSMS's long-time US sales of Petitioner's GOLDEN EAGLE nippers and scissors, Respondent in 2019 registered Petitioner's mark GOLDEN EAGLE for the identical goods in Respondent's own name.

Mr. Schwartz learned of Respondent's fraudulent registration of Petitioner's GOLDEN EAGLE mark when a customer of SSMS received notice from Amazon.com that the customer's sales listings of Petitioner's authentic GOLDEN EAGLE products purchased from SSMS were being removed from Amazon.com due to a trademark complaint submitted by Respondent. Mr. Schwartz confronted Mr. Samuels and told him that Respondent's registration of Petitioner's GOLDEN EAGLE mark was wrongful, as were Respondent's actions in demanding that Amazon.com take down sales listings for Petitioner's GOLDEN EAGLE products. Mr.

Schwartz was rebuffed with comments by Mr. Samuels to the effect that Chinese companies took unfair advantage of US companies, and turnabout was fair play.

These startling facts, clearly established by the evidence of record, require cancellation of Respondent's Registration Number 5,829,055 on multiple grounds: fraud, likelihood of confusion, and non-ownership.

## **II. STATEMENT OF THE ISSUES**

1. Did Respondent procure Registration No. 5,829,055 for the mark GOLDEN EAGLE through fraud?
2. Is there a likelihood of confusion between the parties' identical marks for identical goods?
3. Was Respondent the owner of the trademark GOLDEN EAGLE at the time that it applied to register that mark?

## **III. DESCRIPTION OF THE RECORD**

### **A. Petitioner's Evidence**

In addition to the pleadings and the file history of Respondent's Registration No. 5,829,055 that is the subject of this proceeding, Petitioner's record evidence consists of the following:

1. Petitioner's Testimony Declaration of Lonny Schwartz 15 TTABVUE ("Schwartz Decl.") and accompanying Confidential Exhibits 16 TTABVUE and 17 TTABVUE;
2. Notice of Reliance on Excerpts of the Discovery Deposition of Philip Samuels ("Samuels Depo") 18 TTABVUE and Confidential Transcript and Exhibits thereto 17 TTABVUE;
3. Petitioner's Notice of Reliance on Official Records, consisting of TSDR pages pertaining to Respondent's Reg. No. 6037272 for the mark SILVER STAR, 19 TTABVUE.

4. Petitioner's Testimony Declaration of its President Chung Ying (Eric) Tsai ("Tsai Decl.") 27 TTABVUE (redacted public version) and Confidential version 28 TTABVUE;
5. Petitioner's Rebuttal Testimony Declaration of Lonny Schwartz 40 TTABVUE.

**B. Respondent's Evidence**

Respondent's record evidence consists of the following:

1. Respondent's Notice of Reliance on Additional Portions of Discovery Deposition of Philip Samuels (32 TTABVUE) and redacted public version (39 TTABVUE);
2. Petitioner's Cross-Examination Testimony Deposition of Lonny Schwartz 33 TTABVUE and Exhibits thereto (34-36 TTABVUE);
3. Petitioner's Testimony Declaration of Philip Samuels ("Samuels Decl.") (37 TTABVUE) and Confidential Exhibits thereto (38 TTABVUE).

**IV. FACTS**

1. Petitioner began using the trademark GOLDEN EAGLE in 1978 for an extensive array of knives, blades, cutters, nippers and scissors for cutting thread, sewing machine parts, cutting machines, and other equipment used in the sewing industry. Tsai Decl. at ¶¶ 2, 27 TTABVUE 2-3.

2. Continuously since the early 1980s, Petitioner has been selling its GOLDEN EAGLE branded products into the United States through its authorized distributors. Since at least as early as 1990, Petitioner's primary authorized distributor of GOLDEN EAGLE branded products in the United States has been Superior Sewing Machine & Supply, LLC. *Id.* at ¶¶ 4-6, 27 TTABVUE 3 and Confidential Exhibit Tsai Decl, 28 TTABVUE; Schwartz Decl. at ¶¶ 2,-3 15 TTABVUE 2-3; Confidential Exhibit 1 to Schwartz Decl. 16 TTABVUE.



3. Petitioner’s authorized distributors in the United States sell Petitioner’s GOLDEN EAGLE products to end users, to sellers of industrial sewing machine products, and to other customers in the United States. Tsai Decl. at ¶ 7, 27 TTABVUE 3-4.

4. Respondent’s Registration Number 5829055 for the mark GOLDEN EAGLE lists “1994” as the date of first use anywhere and in United States commerce; Respondent’s President testified that Respondent’s use “could have been as early as 1992, but [in the application] we put 1994.” (Samuels Depo 17 TTABVUE Deposition Transcript Page 25 lines 6-7).

5. The photograph shown below was submitted by Respondent as a use specimen (hereinafter, the “Use Specimen”) with its Application No. 88317119 filed on February 26, 2019, which application matured into Respondent’s Registration Number 5829055 for the mark GOLDEN EAGLE on August 6, 2019:



February 26, 2019 Use Specimen, TSDR p. 1.

6. The photograph comprising the Use Specimen was “probably” by taken Respondent’s President Philip Samuels and was, in any event, taken on Mr. Samuels’ desk. Samuels Depo 17 TTABVUE Deposition Transcript Page 34, lines 1-5.

7. The thread cutters shown in the Use Specimen photograph are actually Petitioner’s GOLDEN EAGLE Model Number TC-805 thread cutters that were repackaged by Respondent or others; or possibly, but less likely, counterfeits of Petitioner’s GOLDEN EAGLE thread cutters that are visually indistinguishable<sup>1</sup> from Petitioner’s GOLDEN EAGLE Model Number TC-805 thread cutters. Tsai Decl. at ¶¶ 8-9, 27 TTABVUE 4.

8. Respondent sells GOLDEN EAGLE-branded thread nippers and scissors that it has purchased from multiple foreign sources over the years, without ever knowing who manufactured those products. Samuels Depo 17 TTABVUE Deposition Transcript Page 21, lines 2-16.

9. Respondent did not seek permission from Petitioner or anyone else before applying to register the mark GOLDEN EAGLE for nippers and scissors. Samuels Depo 17 TTABVUE Deposition Transcript Page 36, lines 10-18.

10. On October 24, 2019, Respondent filed Application Number 88667056 (which ultimately matured into Registration Number 6037272) claiming use in commerce since 1998 by Respondent of the mark SILVER STAR for “electric irons, steam irons.” Notice of Reliance on Official Records, 19 TTABVUE 6.

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<sup>1</sup> Mr. Samuels conceded in his testimony that there was nothing in the Use Specimen image that would identify the source of the GOLDEN EAGLE-branded thread cutters shown in the Use Specimen image. Samuels Depo 17 TTABVUE Deposition Transcript Page 35, lines 4-7.

11. The use specimen submitted by Respondent with its Application Number 88667056 was a photograph of an iron bearing the word “Eunsung,.” *Id.*, 19 TTABVUE 6.

12. Respondent knew that Eunsung was a Korean manufacturer. Samuels Depo 17 TTABVUE Deposition Transcript Page 40, lines 15-19, 25.

13. Respondent did not seek Eunsung’s permission to register the mark SILVER STAR in its own name. Samuels Depo 17 TTABVUE Deposition Transcript Page 41, lines 15-17, 22-23.

14. In the Fall of 2019, Lonny Schwartz, President of Superior Sewing Machine & Supply (“Superior”), a long-time authorized US distributor of Petitioner’s GOLDEN EAGLE products, learned that Respondent had registered the mark GOLDEN EAGLE in Respondent’s own name. Schwartz Decl. at ¶ 5, 15 TTABVUE 3. Mr. Schwartz also learned at that time that Respondent had used its recently-issued registration as a basis for demanding that Amazon.com take down sales listings for Petitioner’s GOLDEN EAGLE products, including at least one listing from a customer of Superior who had purchased Petitioner’s GOLDEN EAGLE products from Superior. *Id.* 15 TTABVUE 3.

15. Also in the Fall of 2019, Mr. Schwartz told Respondent’s President Philip Samuels that Respondent had acted wrongfully in registering Petitioner’s GOLDEN EAGLE mark and also in demanding that Amazon.com take down sales listings for Petitioner’s GOLDEN EAGLE products. *Id.* at ¶ 6, 15 TTABVUE 3.

16. In response, Mr. Samuels acknowledged that he had decided to register the trademark GOLDEN EAGLE in Respondent’s name, even though he knew that Superior had been selling Petitioner’s GOLDEN EAGLE products in the United States for many years. *Id.* at ¶ 7, 15 TTABVUE 3-4. Mr. Samuels explained to Mr. Schwartz, in sum and substance, that

Chinese companies took advantage of US companies and turnabout was fair play. *Id.* at ¶ 7, 15 TTABVUE 4.

**V. ARGUMENT**

**A. Petitioner is Entitled to a Statutory Cause of Action for Cancellation**

15 U.S.C. § 1064 provides in relevant part that a petition to cancel may be filed “by any person who believes that he is or will be damaged” by the registration of a mark. In this case, Respondent used the registration at issue as a basis for demanding that Amazon.com remove sales listings of Petitioner’s GOLDEN EAGLE products. Schwartz Decl. at ¶ 5, 15 TTABVUE 3. Thus, Petitioner has already been demonstrably damaged by Respondent’s registration. Petitioner initiated this proceeding because it is the rightful owner of the mark GOLDEN EAGLE for, *inter alia*, the identical goods distributed by Respondent without authorization under the identical mark. Respondent’s further use and continued registration of the mark GOLDEN EAGLE thus make further damage to Petitioner a virtual certainty and consequently, Petitioner is entitled to a statutory cause of action under 15 U.S.C. § 1064.

**B. First Ground for Cancellation: Fraud (15 U.S.C. § 1064(3))**

Fraud in the procurement of a trademark registration involves “knowingly mak[es] a false, material representation of fact in connection with an application to register . . . with the intent of obtaining . . . a registration to which it is otherwise not entitled.” *Fuji Medical Instruments Mfg. Co., Ltd. v. American Crocodile International Group, Inc.*, 2021 USPQ2d 831(TTAB 2021); *In re Bose Corp.*, 91 USPQ2d 1938, 1939-40 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986).

In this case, the preponderance of the evidence – including Respondent’s own extraordinary admissions and statements – amply demonstrates that Respondent knowingly made multiple false, material representations to the Office for the express purpose of deceiving the

Office into issuing a registration to which Respondent was not entitled. Contrary to the sworn representations made in its application that it was the owner of the mark sought to be registered and that it believed that no other person had the right to use the mark in commerce, Respondent admitted: (1) that it did not know who manufactured the GOLDEN EAGLE-branded thread nippers and scissors that Respondent purchased from multiple foreign sources for sale into the United States<sup>2</sup>; (2) that notwithstanding its ignorance of the provenance of the GOLDEN EAGLE-branded nippers and scissors it purchased from multiple foreign sources, Respondent did not seek any clarification or permission, but decided instead to claim for itself the right to assert exclusive ownership rights in the mark.<sup>3</sup> As Respondent's President Mr. Samuels put it during his deposition, "[w]hy would I ask somebody else their permission? That's something for the Federal Government to give me their permission."<sup>4</sup> Respondent also had no qualms about using a photograph of Petitioner's GOLDEN EAGLE products or indistinguishable counterfeits thereof as a use specimen for Respondent's own trademark application for the same mark.<sup>5</sup>

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<sup>2</sup> Samuels Depo 17 TTABVUE Deposition Transcript Page 21, lines 2-25. Mr. Samuels testified that he could not tell whether Respondent had ever purchased Petitioner's GOLDEN EAGLE thread-cutting nippers, did not know whose products Respondent was buying from foreign sources and selling into the United States, and could not distinguish between "knockoffs and imitations" and originals, stating:

"I couldn't tell you who was the manufacture of any of these things. They are all over the place. I have no idea what [are] originals or copies. There are so many copies and knockoffs and imitations of copying what, I don't know . . . We don't recognize any genuine Great Knives product, particularly on [thread] nippers."

Samuels Depo 17 TTABVUE Deposition Transcript Page 21, lines 8-16.

<sup>3</sup> Samuels Depo 17 TTABVUE Deposition Transcript Page 36, lines 1-18.

<sup>4</sup> *Id.* at 17 TTABVUE Deposition Transcript Page 36, lines 14-17.

<sup>5</sup> Tsai Decl. at ¶¶ 8-9, 27 TTABVUE 4. The outrageous nature of Respondent's fraudulent conduct in proffering this use specimen to the Office is not mitigated by the possibility that the products shown in the photograph were counterfeits of Petitioner's products obtained from unknown sources, rather than Petitioner's genuine products.

As if these statements and actions were not sufficient proof of Respondent's fraudulent intent in applying to register Petitioner's GOLDEN EAGLE mark, the record also includes testimony from Lonny Schwartz, the President of Petitioner's long-time authorized distributor Superior Sewing, who is also a longtime friend and close business associate of Respondent's President Mr. Samuels and his family. Schwartz Decl. at ¶ 4, 15 TTABVUE 3.<sup>6</sup> Soon after learning of Respondent's brazen, fraudulent registration of Petitioner's GOLDEN EAGLE mark, Mr. Schwartz told Mr. Samuels that he viewed Respondent's action in registering the mark as wrongful – only to be told by Mr. Samuels that Respondent's conduct in registering Petitioner's GOLDEN EAGLE mark was a justifiable form of retribution, because Respondent believed Petitioner to be a “Chinese”<sup>7</sup> company and other, unrelated Chinese companies took unfair advantage of US companies. *Id.* at ¶ 7, 15 TTABVUE 3-4.

This extraordinary testimony confirms even more clearly that, in Respondent's view, the ends – *i.e.*, the commercial advantages conferred by a federal trademark registration – justify the fraudulent means by which Respondent obtained that registration. The Office certainly relied upon Respondent's willful, material misstatements of fact, and the evidence is clear that misstatements were no accidents or oversights. Respondent's misrepresentations were quite obviously made with the fraudulent intent to deceive the Office into issuing a registration to which Respondent had no entitlement.

Moreover, Respondent's fraudulent conduct in registering Petitioner's mark as its own was no anomaly. Just 79 days after Respondent duped the Office into issuing the GOLDEN

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<sup>6</sup> Asked in his deposition to describe Respondent's business relationship with Mr. Schwartz, Mr. Samuels' testimony was: “It is a close relationship. Lonny Schwartz, we are pretty close. We are pretty close.” Samuels Depo 17 TTABVUE Deposition Transcript Page 54, lines 17-19.

<sup>7</sup> In fact, Petitioner is based in Taiwan, a distinction that evidently did not factor into Mr. Samuels' highly questionable worldview.

EAGLE registration that is the subject of this proceeding, Respondent was back at it again with another manufacturer's brand, fraudulently claiming to own that brand itself. On October 24, 2019, Respondent filed Application Number 88667056 for the mark SILVER STAR for "electric irons, steam irons," which ultimately matured into Registration Number 6037272. Petitioner's Notice of Reliance on Official Records, 19 TTABVUE. The use specimen submitted by Respondent with its Application Number 88667056 was a photograph of an iron conspicuously bearing the designation "Eunsung,"<sup>8</sup> which Respondent knew to be the name of a Korean manufacturer of irons. Samuels Depo 17 TTABVUE Deposition Transcript Page 40, line 25. Respondent did not seek Eunsung's permission to register the mark SILVER STAR in its own name. Samuels Depo 17 TTABVUE Deposition Transcript Page 41, lines 15-17, 22-25. In this instance as well, Respondent took the position that, if it observed the presence of what it assumed to be counterfeit products in the marketplace, then the mark was free for the taking by Respondent, who could proceed to register the mark in its own name in the United States without anyone's permission and then wait to see if anyone sued or objected.<sup>9</sup>

Respondent's "shoot first and ask questions later" approach to registering the trademarks of foreign manufacturers is at odds with the law. It is very well-settled that, even as between a foreign manufacturer and an **exclusive** US distributor – which Respondent is clearly not -- the

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<sup>8</sup> *Id.* 19 TTABVUE 6.

<sup>9</sup> Mr. Samuels' deposition testimony made explicit this deeply flawed rationale for Respondent's actions: "You have to understand. **And this is the same situation as with these GOLDEN EAGLE** [products] These things have all been copied when China opened up. Everything was copied. We registered the mark . . . believing that the first use here in the United States. We have no dispute with Eunsung or SILVER STAR, we have no problems with them, there is nothing in litigation. If they want to question it, they can do it." Samuels Depo 17 TTABVUE Deposition Transcript Page 41, lines 4-12 (emphasis added).

foreign manufacturer is presumed to be the owner of the mark in the United States.<sup>10</sup> There is obviously no evidence of any written or oral agreement between the parties to this case, only a pattern of fraudulent and shameless “land-grab” registrations by Respondent of marks owned by foreign manufacturers. There can be no justifying or excusing Respondent’s egregious fraud, and its ill-gotten Registration No. 5,829,055 should be cancelled.

**C. Second Ground for Cancellation: Priority and Likelihood of Confusion (15 U.S.C. § 1052(d))**

1. Petitioner Has Priority

The uncontroverted evidence of record shows that Petitioner has been selling its GOLDEN EAGLE branded products into the United States through its authorized distributors continuously since the early 1980s and that since at least as early as 1990, Petitioner’s primary authorized distributor of GOLDEN EAGLE branded products in the United States has been Superior Sewing Machine & Supply, LLC. Tsai Decl. at ¶4, 27 TTABVUE 3; Schwartz Decl. at ¶ 2, 15 TTABVUE 2-3.; Confidential Exhibit 1 to Schwartz Decl. 16 TTABVUE.

Respondent’s Registration Number 5829055 for the mark GOLDEN EAGLE lists “1994” as the date of first use anywhere and in United States commerce. Respondent’s President Mr.

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<sup>10</sup> See, e.g., *Roger & Gallet v. Janmarie, Inc.*, 114 USPQ 238 (CCPA 1957); *Global Maschinen GmbH v. Global Banking Systems, Inc.*, 227 USPQ at 867; *In re Eucryl Limited*, 193 USPQ 377 (TTAB 1976); *Bakker v. Steel Nurse of America Inc.*, 176 USPQ 447 (TTAB 1972); *Compania Insular Tabacalera, S. A. v. Camacho Cigars, Inc.*, 167 USPQ 299 (TTAB 1970); *Far-Best Corporation v. Die Casting “ID” Corporation*, 165 USPQ 277 (TTAB 1970); *In re Geo. J. Ball, Inc.*, 153 USPQ 426 (TTAB 1967). This presumption applies specifically “in the absence of an agreement, express or otherwise.” *Bakker v. Steel Nurse of America Inc.*, 176 USPQ at 448. See also, 5 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 29:8, (5th ed. 2021):

In the absence of an agreement determining ownership [between a foreign manufacturer and an exclusive United States distributor], both the courts and the Trademark Board will presume that the manufacturer of goods is the owner of the trademark of those goods. . . . An exclusive U.S. distributor does not acquire ownership of a foreign manufacturer’s mark any more than a wholesaler can acquire ownership of an American manufacturer’s mark, merely through the sale and distribution of goods bearing the manufacturer’s trademark.



Samuels testified that Respondent's use "could have been as early as 1992, but [in the application] we put 1994." (Samuels Depo 17 TTABVUE Deposition Transcript Page 25 lines 6-7). In his subsequent Testimony Declaration filed with the Board more than a year after his discovery deposition was taken, Mr. Samuels reiterated the 1994 date of first use in commerce of Respondent's purported mark. Samuels Decl. at ¶5, 37 TTABVUE 3. Thus, the uncontroverted evidence of record shows that Petitioner is the senior user of the mark GOLDEN EAGLE for thread-cutting nippers the United States.

2. The Marks and Goods at Issue are Identical, Resulting in an Inevitable Likelihood of Confusion

Likelihood of confusion is analyzed using the relevant factors set forth in *In re E.I. DuPont DeNemours & Co.*, 177 USPQ 563 (CCPA 1973). The most relevant *DuPont* factors in this case are: (i) the similarity of the marks; (ii) the similarity of the goods as described in the application; (iii) the similarity of the trade channels. On the facts of this case, the *DuPont* analysis is straightforward. There is no dispute that Petitioner's GOLDEN EAGLE trademark is identical to the GOLDEN EAGLE mark that is the subject of Respondent's Registration Number 5829055, and consequently this factor heavily favors Petitioner. Moreover, Petitioner's goods are identical to the goods identified in Registration Number 5829055 and so the parties' goods are presumed to travel in the same channels of trade to the same classes of purchasers. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002).

Respondent's continued registration and use of the mark GOLDEN EAGLE for nippers and scissors is therefore likely to, and inevitably will, cause confusion, mistake, and deception and its registration should therefore be cancelled on that basis as well.

**D. Third Ground for Cancellation: Non-Ownership**

The evidence of record shows that Respondent was not the owner of the mark GOLDEN EAGLE when it filed the use-based Application Number 88/317,119, which matured into the subject Registration Number 5,829,055. The authority is clear that “an application filed by one who is not the owner of the mark sought to be registered is a void application.” *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (citing *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982)). *See also, Huang v. Tzu Wei Chen Food Co., Ltd.*, 7 USPQ2d 1335 (Fed. Cir. 1988); *Holiday Inn v. Holiday Inns, Inc.*, 189 USPQ 630, 635 n.6 (CCPA 1976) (“One must be the owner of a mark before it can be registered.”); *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007) (“[i]n a use-based application under Trademark Act Section 1(a), only the owner of the mark may file the application for registration of the mark; if the entity filing the application is not the owner of the mark as of the filing date, the application is void *ab initio*.”); Trademark Rule 2.71(d) (“an application filed in the name of an entity that did not own the mark as of the filing date of the application is void”).

Here, the record is clear that Respondent never owned the mark GOLDEN EAGLE for thread-cutting nippers and scissors. Respondent knew that GOLDEN EAGLE was Petitioner’s mark for the identical products, but chose to apply to register the mark anyway. Therefore, Respondent’s application that matured into Registration Number 5,829,055 was void *ab initio* and should be cancelled on that basis as well.

WHEREFORE, Petitioner prays that this Petition be granted and that Registration No. 5,829,055 be cancelled.

Dated: September 25, 2022

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 25<sup>th</sup> day of September 2022, the foregoing document was served upon Respondent's counsel of record by delivering same via electronic mail to [julie.scheipeter@stinson.com](mailto:julie.scheipeter@stinson.com), [scott.eidson@stinson.com](mailto:scott.eidson@stinson.com).

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