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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	NIKE, Inc.		
Entity	Corporation	Citizenship	Oregon
Address	One Bowerman Drive Beaverton, OR 97005 UNITED STATES		

Attorney information	Helen Hill Minsker Banner & Witcoff, Ltd. 71 South Wacker Drive, Suite 3600 Chicago, IL 60606 UNITED STATES hminsker@bannerwitcoff.com, aheinze@bannerwitcoff.com, mhouston@bannerwitcoff.com, bwlitdocket@bannerwitcoff.com, bwptotm@bannerwitcoff.com 312-463-5000

Registration Subject to Cancellation

Registration No.	6031142	Registration date	04/07/2020
Registrant	Vans, Inc. 1588 South Coast Drive Costa Mesa, CA 92626 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2017/01/01 First Use In Commerce: 2017/01/01 All goods and services in the class are subject to cancellation, namely: Apparel, namely, bottoms

Grounds for Cancellation

Failure to function as a mark	Trademark Act Sections 14(1) and 1,2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 14(1) and 1,2 and 45; and Section 2(f)

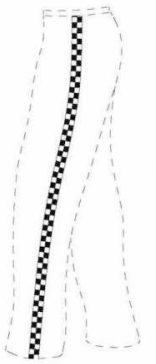
Related Proceedings	91253064 91255583

Attachments	Petition for Cancellation - Registration 6031142.pdf(3569310 bytes)

Signature	/helen hill minsker/

Name	Helen Hill Minsker
Date	04/30/2020

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

In the Matter of Trademark Registrant Vans, Inc. Mark:  Registration No.: 6,031,142 Registered: April 7, 2020	
NIKE, INC., Petitioner, vs. VANS, INC., Registrant.	Cancellation No. _____

PETITION FOR CANCELLATION

Petitioner, NIKE, Inc., an Oregon corporation located at One Bowerman Drive, Beaverton, Oregon 97005 ("Petitioner"), believes it will be damaged by continued registration of the above-identified design (hereinafter "Checkerboard Pattern"), registered on the Supplemental Register by Vans, Inc., a Delaware corporation with an address of record as 1588 South Coast Drive, Costa Mesa, California 92626 ("Registrant"), and petitions to cancel the same.

The grounds for the cancellation are as follows:

PETITIONER AND ITS USE OF CHECKERBOARD DESIGNS
IN CONNECTION WITH APPAREL

1. Petitioner is a leading provider of a broad range of clothing, footwear, accessories, equipment, and other products and services relating to sports, fitness, lifestyle and fashion.

2. Petitioner has long-used checkerboard designs on its apparel products, including checkerboard patterns of various sizes, shapes, and colors placed in various locations on shirts and pants, such as the front, side, back, and inside thereof.

3. Petitioner has sold and continues to sell its apparel products having checkerboard patterns in interstate commerce in the United States since at least the 1980s.

4. For example, Petitioner released a John McEnroe tennis collection in the 1980s that used checkerboard designs inspired by the taxicabs of Mr. McEnroe's hometown. Shown below are examples of Petitioner's various uses of checkerboard designs in connection with the McEnroe collection from the 1980s.

5. Petitioner re-released the McEnroe collection in the early 2000s, using updated materials. Again, the collection featured various checkerboard designs, including on apparel, such as shirts. Shown below are examples of Petitioner's various uses of checkerboard designs from the early 2000s.

6. Petitioner subsequently released additional apparel products featuring checkerboard designs, including, for example, the designs shown below from around 2008.

7. Petitioner's use of checkerboard designs continued into the 2010s. For example, shown below are Petitioner's shirts featuring checkerboard designs from around 2018.

8. Petitioner continues to use checkerboard designs on its products today. For example, Petitioner collaborated with fashion brand Off-White on a soccer collection that uses checkerboard designs in connection with apparel and related advertisements. Shown below are examples of Petitioner's use of checkerboard designs as part of this collection.

9. Shown below are additional examples of Petitioner's various uses of checkerboard designs on apparel from around 2019, including on shorts and pants. Petitioner's use of checkerboard designs on pants includes a checkerboard design running along the outside of the pants and pant legs.

THIRD-PARTY USES OF CHECKERBOARD DESIGNS
<u>IN CONNECTION WITH APPAREL</u>

10. Other entities also commonly use checkerboard designs as ornamentation on apparel, including checkerboard patterns of various sizes, shapes, and colors placed on the front,

side, and back of apparel, including pants.

11. Shown below are examples of third-party uses of checkerboard designs in connection with apparel available for sale from retailers and brands such as Macy's, Levi's, Stella McCartney, Rue21, Hollister, Tommy Hilfiger, and others.

Dickies	Levi's
HOLLISTER	HOLLISTER

SAVAGE	VIBES VIBES
Peoples Place	GUESS®

LEVI STRAUSS & CO.
ORIGINAL RIVETED
QUALITY CLOTHING

JURASSIC PARK

	MICKEY
CALVIN KLEIN JEANS	

Quiksilver	
MTV MUSIC TELEVISION	party pants

EDITION

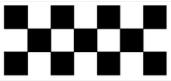
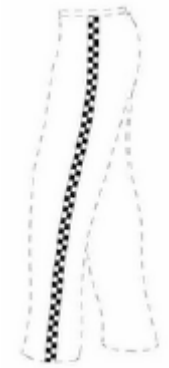
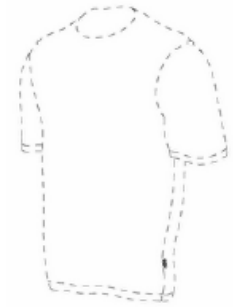
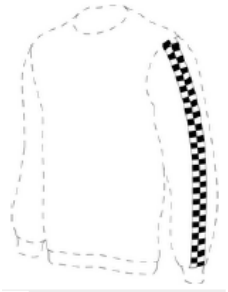
HUSTLE	
	SAVAGE
Savage	

	SANTA CRUZ
7%	

HOLLISTER	
POW!	NASCAR ALL AMERICAN RACING

REGISTRANT'S ATTEMPTS TO REGISTER CHECKERBOARD DESIGNS
IN CONNECTION WITH APPAREL

12. Registrant filed a series of applications in November 2018 seeking to register the checkerboard designs shown below in International Class 25 (the "Checkerboard Applications"), including the application that would register into the subject of this Petition for Cancellation, Application No. 88/206,649, now registered as Registration No. 6,031,142 (the "'142 Registration").

 SN: 88/206,513 ("the '513 Application")	 SN: 88/201,649 ("the '649 Application")	 SN: 88/206,518 ("the '518 Application")	 SN: 88/206,491 ("the '491 Application")	 SN: 88/206,509 ("the '509 Application")

13. Petitioner filed a Notice of Opposition against the '513 Application on December 20, 2019, on the grounds that the design fails to function as a mark and the design is not inherently distinctive and has not acquired distinctiveness, Opposition No. 91253064. Petitioner's opposition is pending. *NIKE, Inc v. Vans, Inc.*, Opp. No. 91253064 (1 TTABVUE).

14. As to the other Checkerboard Applications, the Trademark Examiner issued a first round of Office Actions refusing registration because the applied-for designs are "merely a decorative or ornamental feature" of the goods, and thus, do "not function as a trademark to indicate the source of applicant's clothing and to identify and distinguish applicant's clothing from

others." The Trademark Examiner also identified examples of third parties using a checkerboard pattern on apparel, including some of the examples set forth above.

15. As to the '649 Application that is the subject of this Petition for Cancellation, the Trademark Examiner issued a second Office Action refusing registration of the Checkerboard Pattern on the ground that it "consists of merely ornamental matter common in applicant's industry." Registrant filed a response to the Office Action seeking registration of the Checkerboard Pattern on the Supplemental Register.

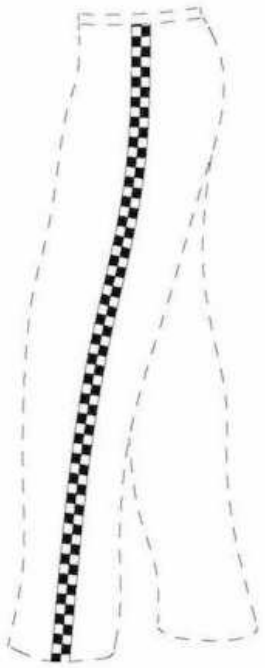
16. As to the '509 Application, the Trademark Examiner issued a second Office Action refusing registration of the applied-for design on the ground that it "consists of merely ornamental matter common in applicant's industry." Registrant filed a response, and the design published for opposition on March 31, 2020. Concurrently with the filing of this Petition for Cancellation, Petitioner filed a Notice of Opposition against the '509 Application on the grounds that the design fails to function as a mark and the design is not inherently distinctive and has not acquired distinctiveness. That Opposition has been assigned Opp. No. 91255583.

17. As to the '518 Application, the Trademark Examiner issued a second Office Action refusing registration of the applied-for design and maintaining the refusal on the ground that it does not function as a mark. Registrant filed a response. The '518 Application remains in the examination stage as of the filing date of this Petition for Cancellation.

18. As to the '491 Application, the Trademark Examiner issued a second Office Action refusing registration of the applied-for design on the ground that it "consists of merely ornamental matter common in applicant's industry." Registrant filed a response. The Trademark Examiner issued a third Office Action refusing registration of the applied-for design on the same ground. The '491 Application remains in the examination stage as of the filing date of this Petition for Cancellation.

REGISTRANT'S SUPPLEMENTAL REGISTRATION
THAT ISSUED FROM THE '649 APPLICATION

19. The Checkerboard Pattern that is the subject of the '142 Registration registered on the Supplemental Register on April 7, 2020, in connection with "Apparel, namely, bottoms" in International Class 25, is reproduced below.



20. The '142 Registration alleges a date of first use of January 1, 2017.

21. The '142 Registration states: "The mark consists of checkerboard pattern running down the leg of pants, sweatpants, trousers, leggings, capris, or shorts. The dotted outline of the garment is not claimed as part of the mark and is intended only to show the position of the mark."

22. As the Trademark Examiner found in refusing registration of the Checkerboard Pattern on the Principal Register, the Checkerboard Pattern is "common" in Registrant's industry, and "does not function as a trademark to indicate the source of [Registrant's] clothing and to identify and distinguish [Registrant's] clothing from others." The Trademark Examiner also

identified "examples of third parties using a checkerboard pattern in exactly the same manner" as Registrant's Checkerboard Pattern.

23. Additional examples of third parties using a checkerboard pattern in exactly the same or similar manner are set forth in paragraph 11 above.

24. Registrant's attempts to broadly register checkerboard designs in connection with apparel, *e.g.*, the Checkerboard Applications, show its intent to impede the ability of others to use checkerboard designs in connection with apparel.

25. Registration of the Checkerboard Pattern on the Supplemental Register will provide Registrant with a tool that it can wield against others who have used—and continue to use—checkerboard designs.

26. Registration of the Checkerboard Pattern on the Supplemental Register would damage and injure Petitioner by impeding Petitioner's (and the public's) ability to use common design elements that it has long used.

COUNT I

ORNAMENTAL – FAILURE TO FUNCTION AS A MARK

27. Petitioner repeats and realleges paragraphs 1-26.

28. The Checkerboard Pattern is a design element that is purely decorative or purely ornamental when used in connection with apparel, including bottoms, and is not capable of distinguishing goods and services, and thus, does not and cannot, function as a trademark.

29. Consumers do not, and cannot, perceive the Checkerboard Pattern as having any source-identifying significance.

30. The '142 Registration should be cancelled because it is purely decorative or purely ornamental and incapable of distinguishing Registrant's goods from the goods of others, in violation of at least Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127.

COUNT II

NONDISTINCTIVE – INCAPABLE OF ACQUIRING DISTINCTIVENESS

31. Petitioner repeats and realleges paragraphs 1-30.

32. The Checkerboard Pattern is a nondistinctive ornamental design that is incapable of acquiring distinctiveness.

33. Registrant filed the '649 Application as an intent to use application. Registrant later filed an Amendment to Allege Use, which alleged January 1, 2017, as the date of first use in commerce.

34. The '142 Registration should be cancelled because it has not and cannot acquire distinctiveness as required by at least Sections 1, 2, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1127.

CLAIM FOR RELIEF/DAMAGE

35. By reason of the foregoing, Registrant's continued registration of the Checkerboard Pattern will cause injury and damage to Petitioner and its right to use checkerboard designs as described above.

WHEREFORE, Petitioner respectfully prays that the present cancellation be sustained and that the '142 Registration be cancelled.

DEPOSIT ACCOUNT AUTHORIZATION

Please charge the statutory fee of $400 to our firm's deposit account, No. 19-0733. Please also charge any additional fees, or credit any overpayments, to our firm's deposit account, No. 19-0733.

Respectfully submitted,
BANNER & WITCOFF, LTD.
Attorneys for Petitioner

Date: April 30, 2020

By: ___/helen hill minsker/_____

Helen Hill Minsker
Audra C. Eidem Heinze
Kevin Dam
71 South Wacker Drive, Suite 3600
Chicago, Illinois 60606
Telephone: 312-463-5000