

ESTTA Tracking number: **ESTTA1075679**

Filing date: **08/18/2020**

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	KERING		
Entity	société anonyme (sa)	Citizenship	France
Address	40 RUE DE SÈVRES PARIS, 75007 FRANCE		

Attorney information	STACEY R. HALPERN KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES Primary Email: efiling@knobbe.com (949) 760-0404		
Docket Number	SANREL5.036Z		

Registration Subject to Cancellation

Registration No.	5627699	Registration date	12/11/2018
Registrant	Shanghai Kearing Stationery Co.,Ltd. NO.16 DONGWANGJIAZHAI YINGQIAN VILLAGE ZHUQIAO TOWN PUDONG DISTRICT SHANGHAI, 201202 CHINA		

Goods/Services Subject to Cancellation

Class 009. First Use: 2012/01/01 First Use In Commerce: 2012/01/01 Goods and services in the class that are subject to cancellation: Anti-glare spectacles

Grounds for Cancellation


No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)
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Attachments	Petition to Cancel - SANREL5.036ZTUS.pdf(52194 bytes)
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Signature	/SRH/
Name	Stacey R. Halpern

Date	08/18/2020
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**


KERING,)	Cancellation No.: _____
)	
Petitioner,)	
v.)	
)	
Shanghai Kearing Stationery Co., Ltd.)	
)	Mark:
Respondent.)	Reg. No. 5627699

PETITION FOR CANCELLATION


Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Pursuant to T.B.M.P. § 309.03(c), Petitioner, KERING, believes that it has been and will continue to be damaged by the goods anti-glare spectacles in Class 9 as identified in U.S. Trademark Registration No. 5627699 (“Respondent’s Registration”) for the mark

 and hereby petitions to cancel the same.


A description of Respondent’s Registration is as follows:

Mark	
Filing Date	May 1, 2018
Reg. No.	5627699
Alleged Date of First Use	January 1, 2012

Alleged Date of First Use in Commerce	January 1, 2012
Reg. Date	December 11, 2018
Goods	anti-glare spectacles


As grounds for this Petition, it is alleged that:

1. Upon information and belief, Shanghai Kearing Stationery Co., Ltd., a Chinese private limited company with an address of No.16 Dongwangjiazhai Yingqian Village, Zhuqiao Town, Pudong District, Shanghai, China 201202 (“Respondent”), is the owner of Respondent’s Registration.

2. On or about May 1, 2018, Respondent filed an application for the mark  with the U.S. Patent and Trademark Office (“PTO”) and it was assigned Serial No. 87901492 (“Respondent’s Application”). Respondent’s Application claimed a date of first use of January 1, 2012 and a date of first use in commerce of January 1, 2012 for all goods, including anti-glare spectacles in Class 9.

3. On or about December 11, 2018, Respondent’s Application matured to registration and was assigned Registration No. 5627699.

4. Petitioner designs, manufactures, markets, offers for sale and provides a variety of high-quality luxury, sports and lifestyle products and as related services in connection with its

KERING name and mark, its  mark and various KERING containing marks (collectively, the “KERING Marks”). Among the goods and services provided by Petitioner are eyewear, jewelry, apparel and leather goods and related services (“Kering’s Goods and Services”).

5. On November 18, 2019, Petitioner filed an application for the



mark . This application was assigned Serial No. 88696365 (the “’365 Application”) by the PTO.

7. During the prosecution of the ‘365 Application, Respondent’s Registration was cited by the Examining Attorney based on Section 2(d) of the Trademark Act.

8. In view of the PTO’s refusal of the ‘365 Application based on the goods anti-glare spectacles in Respondent’s Registration, it is alleged that Respondent’s Registration is and continues to damage Petitioner.


9. In view of the PTO’s position that the mark shown in Respondent’s Registration “[t]he dominant wording in the marks are phonetic equivalents, and the marks are highly similar in sound and overall commercial impression. Applicant’s and [Respondent’s anti-glare spectacles in] Class 9 goods are legally identical in part and are related in part,” and the PTO’s refusal of the ‘365 Application based on Respondent’s Registration. Petitioner has been and will continue to be impaired by the continued registration of the mark shown in Respondent’s Registration for the goods anti-glare spectacles.


10. Petitioner has standing to bring the cancellation against Respondent’s Registration as the PTO has refused registration of the ‘365 Application based on the goods anti-glare spectacles in Respondent’s Registration.

11. On May 1, 2018, Respondent submitted in a sworn declaration to the PTO in connection Respondent’s Application which Respondent declared under oath, being warned that willful false statements, and the like, may jeopardize the validity of the application, that “[t]he applicant is using the mark in commerce, or the applicant's related company or licensee is using

the mark in commerce, or the applicant's predecessor in interest used the mark in commerce on or in connection with the identified goods and/or services.” Respondent further declared that the date of first use anywhere was at least as early as January 1, 2012, and the date of first use in commerce was at least as early as January 1, 2012 for all goods listed in Respondent’s Application, including anti-glare spectacles.

12. On information and belief, Respondent was not using the mark on or in connection with each and every good listed in Respondent’s Registration within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. §§1051 and 1127 at the time Respondent filed Respondent’s Application.

13. On information and belief, Respondent was not using the mark  on or in connection with the goods anti-glare spectacles listed in Respondent’s Registration at the time Respondent filed Respondent’s Application within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. §§1051 and 1127 at the time Respondent filed Respondent’s Application.


14. Respondent misrepresented the nature of its use of the  mark because it knew or should have known that it had not used the mark in connection with each and every good recited in Respondent’s Application.

15. As Respondent was not providing the goods anti-glare spectacles in commerce within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. §§1051 and 1127 at the time Respondent filed Respondent’s Application, Respondent’s Application and Respondent’s Registration are void ab initio for such goods.

16. An investigation of Respondent’s website and other web resources connected to Respondent shows no evidence of Respondent having ever provided anti-glare spectacles.

17. The specimen that Respondent submitted in filing Respondent's Application for the Class 9 goods was a photograph of a measuring gauge.

18. On information and belief, in the declaration alleging use of the mark in Respondent's Application was made in bad faith because Respondent knew or should have known that it was not using the mark in connection with the goods anti-glare spectacles, as identified in Respondent's Application.


19. On information and belief, Respondent misrepresented the nature of its use of the mark  because it knew or should have known that it had not used the mark in connection with each and every good recited in Respondent's Application.


20. Respondent submitted Respondent's Application that matured into Respondent's Registration with the original filing basis being use in commerce for all listed goods, including, but not limited to, anti-glare spectacles.


21. In Respondent's Application, Respondent attested, under penalty of perjury, that "[t]he applicant is using the mark in commerce on or in connection with the identified goods/services" and that "the mark was first used by the applicant or the applicant's related company or licensee predecessor in interest at least as early as 01/01/2012, and first used in commerce at least as early as 01/01/2012, and is now in use in such commerce."


22. In Respondent's Application, Respondent also attested that, "[t]he signatory being warned that 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."

23. On September 25, 2018, Respondent's Application was published in the *Official Gazette*.


24. As of the filing date of Respondent's Application, Respondent did not use the  mark in U.S. commerce in connection with all of the goods listed in the application, within the meaning of § 1(a) of the Trademark Act.

25. As of the filing date of Respondent's Application, Respondent did not use the  mark in U.S. commerce in connection with "anti-glare spectacles," within the meaning of § 1(a) of the Trademark Act.

26. Respondent's non-use of the  mark with one or more goods listed in Respondent's used-based application as of the filing date renders Respondent's Application and Respondent's Registration void *ab initio* for such non-used goods.

27. Respondent's non-use of the  mark with anti-glare spectacles listed in Respondent's used-based application as of the filing date renders Respondent's Application and Respondent's Registration void *ab initio* for such goods.

28. Respondent falsely stated in its declaration in support of Respondent's Application that the mark was used "in commerce on or in connection with the goods/services in the application."

29. At the time Respondent filed Respondent's Application, Respondent knew it had not used the  mark in commerce in connection with all of the goods listed in the application, within the meaning of § 1(a) of the Trademark Act.

30. At the time Respondent filed Respondent's Application, Respondent knew that the attestation of use of the ^{KEARING} mark for all of the goods listed in the application was false.

31. At the time Respondent filed Respondent's Application, Respondent knew it had not used the ^{KEARING} mark in commerce in connection with the goods anti-glare spectacles listed in the application, within the meaning of § 1(a) of the Trademark Act.

32. At the time Respondent filed Respondent's Application, Respondent knew that the attestation of use of the ^{KEARING} mark for the goods anti-glare spectacles listed in the application was false.

33. The PTO approved Respondent's Application for publication based on Respondent's false attestation that its statements made in the application were true, including that the mark was in fact in use in connection with all of the goods listed in the application, and the attestation and statements were material to the PTO approving the mark for publication.

34. The PTO approved Respondent's Application for publication based on Respondent's false attestation that its statements made in the application were true, including that the mark was in fact in use in connection with anti-glare spectacles listed in the application, and the attestation and statements were material to the PTO approving the mark for publication.

35. Respondent's Application was approved for publication based on false means and/or by knowingly making a false declaration or representation to the PTO, including a false statement that Respondent used the mark in connection with all of the recited goods, when in fact Respondent had not use the mark in connection with all of the recited goods at the time Respondent filed Respondent's Application.

36. Respondent's Application was approved for publication based on false means and/or by knowingly making a false declaration or representation to the PTO, including a false statement that Respondent used the mark in connection with anti-glare spectacles, when in fact Respondent had not use the mark in connection with such goods at the time Respondent filed Respondent's Application.

37. As a registration is void *ab initio* under Trademark Act Section 1(a) when the mark in the underlying use-based application was not in use in commerce as of the application filing date, Respondent's Application and Respondent's Registration are void *ab initio* in connection with the goods anti-glare spectacles because Respondent falsely stating that it had used the mark identified therein in connection with goods that Respondent had not provided in U.S. commerce as of the filing date of Respondent's Application.

39. In view of the foregoing, Respondent is not entitled to maintain Respondent's Registration for the goods anti-glare spectacles.

40. In view of foregoing Respondent's Registration should be partially cancelled.

41. In view of Respondent's non-use of the mark in Respondent's Application for the goods anti-glare spectacles at the time the application based on actual use of the mark in commerce was filed, Respondent's Registration should be partially cancelled for the goods anti-glare spectacles.

42. Petitioner has and will continue to suffer damage if Respondent maintains Respondent's Registration for the goods anti-glare spectacles as the PTO has refused registration of the '365 Application based on such goods in Respondent's Registration.

43. By reason of all the foregoing, Petitioner is and will continue to be gravely damaged by the continued registration of the mark shown in Respondent's Registration.

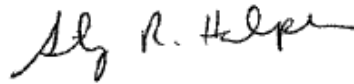
WHEREFORE, Respondent requests that Respondent's Registration be cancelled in

connection with the goods anti-glare spectacles and that this Petition for Cancellation be sustained in favor of Petitioner.

Please charge Deposit Account No. 11-1410 to cover the opposition fee and any additional fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP



Dated: August 18, 2020

By: _____

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