

ESTTA Tracking number: **ESTTA1075774**

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	Pirelli Tyre S.p.A.		
Entity	Societa per azione (SpA)	Citizenship	Italy
Address	VIALE PIERO E ALBERTO PIRELLI, 25 MILAN, I-20126 ITALY		
Attorney information	ANDREW D. PRICE AND STEVEN B. POWELL VENABLE LLP P.O. BOX 34385 WASHINGTON, DC 20043-9998 UNITED STATES Primary Email: trademarkdocket@venable.com Secondary Email(s): adprice@venable.com, sbpowell@venable.com, pjwyles@venable.com (202) 344-8156		
Docket Number	140232526635		

**Registration Subject to Cancellation**

Registration No.	6040597	Registration date	04/28/2020
Registrant	Tiger Mountain Industrial 3125 MERCER AVE., STE. 104 BELLINGHAM, WA 98225 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 012. First Use: 2016/03/01 First Use In Commerce: 2016/03/01 All goods and services in the class are subject to cancellation, namely: Wheel Rims
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**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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)

**Marks Cited by Petitioner as Basis for Cancellation**

U.S. Registration	2138923	Application Date	03/03/1997
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No.			
Registration Date	02/24/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1993/00/00 First Use In Commerce: 1993/00/00 tires and wheels for vehicles, inner tubes, rims and parts and fittings for tires, wheels, tubes and rims		

U.S. Registration No.	2138924	Application Date	03/03/1997
Registration Date	02/24/1998	Foreign Priority Date	NONE
Word Mark	SCORPION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1987/07/10 First Use In Commerce: 1987/07/10 tires and wheels for vehicles, inner tubes, rims and parts and fittings for tires, wheels, tubes and rims		

U.S. Registration No.	3352693	Application Date	12/28/2005
Registration Date	12/11/2007	Foreign Priority Date	11/14/2005
Word Mark	SCORPION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 014. First use: First Use: 0 First Use In Commerce: 0  [ Jewelry; belt buckles of precious metals; bracelets of precious metals; brooches; cuff-links; diamonds; earrings; necklaces; pearls; precious metals and their alloys; rings; bracelets, charms; earrings in precious metal or coated therewith; precious stones; horological and chronometric instruments, namely, timepieces, wristwatches, watches, clocks and parts thereof ]</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0  [ Handbags, suitcases, wallets, briefcases, school bags, handbags for men, trunks for travel, leather and imitation leather ]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0  Clothing articles for men, women and children, namely, shirts, blouses, skirts,coats, trousers, pants, vests, jerseys,pajamas, socks and stockings, singlets,corsets, garters, underpants, petticoats, hats, head scarves, neckties, rain-coats, overcoats, greatcoats, bathing suits, sports overalls, wind-resistant jackets, ski pants, belts, fur coats, scarves,gloves, dressing gowns, footwear, not for golf or safety work, namely, shoes, sports shoes, slippers and boots, all of the aforesaid goods to be used in the promotion of tire sales</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0  [ Arcade-type electronic video games, sail boards for board sailing, cases for tennis balls, gut for tennis rackets, rackets for tennis, table tennis balls, table</p>		

	tennis bats, table tennis nets, table tennis paddle cases, table tennis paddles, table tennis rackets, tennis balls, tennis racket strings, basketballs, volley balls, handballs, racketballs, soccer goals, rugby balls, soccer balls, sport balls ]
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Attachments	Petition for Cancellation and Exhibit A - POISON SERIES and Scorpion Design - Aug 18 2020.pdf(151499 bytes )
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Signature	/StevenBPowell/
Name	Steven B. Powell
Date	08/18/2020

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

Pirelli Tyre S.p.A., Petitioner,	)	
	)	
v.	)	Cancellation No. _____
	)	
Tiger Mountain Industrial, Respondent.	)	
	)	
Attorney's Reference: 140232.526635	)	

**PETITION FOR CANCELLATION**

Pirelli Tyre S.p.A. (“Petitioner”), a *società per azioni* duly organized and existing under the laws of Italy, and having an office at Viale Piero e Alberto Pirelli, 25, I-20126 Milan, Italy, believes it is damaged by the existence of US Registration No. 6,040,597 (“Registration”) for the mark POISON SERIES and Design (“Mark”), shown below.



The Registration was issued on April 28, 2020 (“Registration Date”), resulting from Application Serial No. 88/436,856 (“Application”), which was filed with the US Patent and Trademark Office (“USPTO”) on May 19, 2019 (“Application Filing Date”) in the name of Tiger Mountain Industrial (“Respondent”), a limited liability company organized and existing under the laws of the state of Washington, with a business address of 3125 Mercer Avenue, Suite 104, Bellingham, WA 98225.

Petitioner believes it is damaged by registration of the Mark and hereby petitions for cancellation of the Registration.


As grounds for cancellation, it is alleged that:

1. The Registration is for use of the Mark in connection with “wheel rims” (“Respondent’s Goods”), in International Class 12.

2. The Application was filed on the Application Filing Date on a use-in-commerce basis pursuant to Trademark Act §1(a), 15 U.S.C. § 1051(a), with a claimed date of first use anywhere of March 1, 2016 and a claimed date of first use in US commerce of March 1, 2016.

3. Petitioner is a manufacturer of vehicle tires, vehicle wheels, and related goods.

4. Petitioner owns the following federal trademark registrations:

<b>MARK</b> (collectively, "Petitioner's Marks")	<b>EFFECTIVE                      FILING                      DATE or                      DATE OF                      FIRST USE                      IN US                      COMMERCE</b>	<b>REG. NO.</b> (collectively, "Petitioner's Registrations") and <b>REG. DATE</b>	<b>GOODS</b> (collectively, "Petitioner's Goods")
	Use at least as early as 1993	2,138,923 Reg. Date: Feb. 24, 1998	Tires and wheels for vehicles, inner tubes, rims and parts and fittings for tires, wheels, tubes and rims, in Int'l. Class 12.
<b>SCORPION</b>	Use at least as early as July 10, 1987	2,138,924 Reg. Date: Feb. 24, 1998	Tires and wheels for vehicles, inner tubes, rims and parts and fittings for tires, wheels, tubes and rims, in Int'l. Class 12.
<b>SCORPION</b>	Filing Date: Dec. 28, 2005 Priority Date: Nov. 14, 2005	3,352,693 Reg. Date: Dec. 11, 2007	Clothing articles for men, women and children, namely, shirts, blouses, skirts, coats, trousers, pants, vests, jerseys, pajamas, socks and stockings, singlets, corsets, garters, underpants, petticoats, hats, head scarves, neckties, raincoats, overcoats, greatcoats, bathing suits, sports overalls, wind-resistant jackets,

			ski pants, belts, fur coats, scarves, gloves, dressing gowns, footwear, not for golf or safety work, namely, shoes, sports shoes, slippers and boots, all of the aforesaid goods to be <b>used in the promotion of tire sales</b> , in Int'l. Class 25.
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5. Copies of the certificates of registration for Petitioner's Registrations are attached hereto as Exhibit A.

6. Petitioner's Registrations are valid and subsisting and are *prima facie* evidence of Petitioner's exclusive right to use Petitioner's Marks in US commerce in connection with Petitioner's Goods.

7. Petitioner's Registrations are incontestable.

8. Beginning at least as early as the dates of first use indicated in Petitioner's Registrations and through the present day, continuously and without abandonment, Petitioner has marketed and sold Petitioner's Goods in US commerce in connection with Petitioner's Marks and possesses valuable and enforceable registration-based and common-law rights in Petitioner's Marks in the US.

**Likelihood of Confusion -- 15 U.S.C. § 1052(d)**

Petitioner repeats and reasserts each and every allegation set forth in Paragraphs 1-8.

9. The Application Filing Date is later than the dates of first use of Petitioner's Marks in US commerce in connection with Petitioner's Goods and is also later than the effective filing dates of the applications that matured into Petitioner's Registrations and the registration dates of Petitioner's Registrations.

10. Respondent's purported date of first use anywhere and purported date of first use in US commerce, March 1, 2016, is later than the dates of first use of Petitioner's Marks in US commerce in connection with Petitioner's Goods and is also later than the effective filing dates

of the applications that matured into Petitioner's Registrations and the registration dates of Petitioner's Registrations.

11. On information and belief, Respondent did not – either itself or through Respondent's related company, licensee, or predecessor in interest – use the Mark on or in connection with Respondent's Goods in US commerce or otherwise obtain rights in the Mark before the dates of first use of Petitioner's Marks in US commerce in connection with Petitioner's Goods, before the effective filing dates of the applications that matured into Petitioner's Registrations, or before the registration dates of Petitioner's Registrations.

12. Petitioner's Marks and the Mark are highly similar in appearance, connotation, and commercial impression because the prominent scorpion design element in the Mark is virtually identical and highly similar to the mark that is the subject of Petitioner's US Registration No. 2,138,923 and is also virtually identical and highly similar to the mark SCORPION in standard characters that is the subject of Petitioner's US Registration Nos. 2,138,924 and 3,352,693, on the grounds that the scorpion design element in the Mark is the pictorial equivalent of the word "scorpion."

13. The presence of the wording "POISON SERIES" in the Mark does not prevent a likelihood of confusion with Petitioner's Marks. It instead contributes to a likelihood of confusion because it emphasizes the fact that the Mark depicts a scorpion, as scorpions are commonly known for having poisonous stings.

14. Respondent's Goods and Petitioner's Goods are identical and/or highly related goods that would be offered to the same, substantially similar, and/or overlapping classes of consumers and would be sold in the same channels of trade.

15. Because the Mark is highly similar to Petitioner's Marks, and because Respondent's Goods are highly related to Petitioner's Goods, registration of the Mark is likely to cause confusion, mistake, or deception, in that relevant consumers are likely to believe Respondent's Goods originate from Petitioner or that Respondent's Goods are sponsored, authorized, licensed by, or in some other way legitimately connected with Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), resulting in damage to Petitioner.

**Lack of Bona Fide Use in Commerce -- 15 U.S.C. § 1051(a)**

Petitioner repeats and reasserts each and every allegation set forth in Paragraphs 1-15.

16. The Application was filed on a use-in-commerce basis, pursuant to Trademark Act Section 1(a), 15 U.S.C. §1051(a), alleging use of the Mark in U.S. commerce in connection with Respondent's Goods since March 1, 2016.

17. On information and belief, there was no current bona fide use of the Mark in US commerce in connection with Respondent's Goods as of the Application Filing Date, when the Application was filed on a use-in-commerce basis under Trademark Act § 1(a), 15 U.S.C. § 1051(a).

18. Because the Mark was not in use in US commerce in connection with Respondent's Goods as the Application Filing Date, the Application was void *ab initio*.

19. Because the Application was void *ab initio*, the Registration is void *ab initio* and must be cancelled.

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**WHEREFORE**, Petitioner prays that the Board grant this petition and order that the Registration be cancelled.

Respectfully submitted,

A handwritten signature in blue ink that reads "Steven B. Powell". The signature is written in a cursive style with a large, stylized 'S' and 'P'.

Andrew D. Price  
Steven B. Powell  
**VENABLE LLP**  
Attorneys for Petitioner

# Exhibit A

Copies of Petitioner's  
Certificates of Registration

Int. Cl.: 12

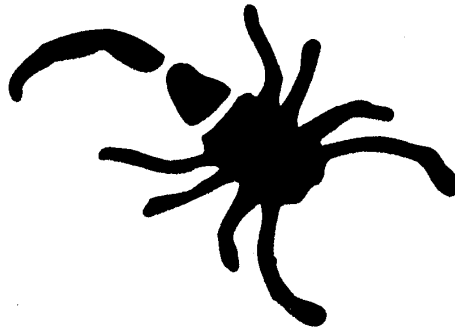
Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44

Reg. No. 2,138,923

**United States Patent and Trademark Office**

Registered Feb. 24, 1998

**TRADEMARK  
PRINCIPAL REGISTER**



PIRELLI COORDINAMENTO PNEUMATICI  
S.P.A. (ITALY CORPORATION)  
VIALE SARCA 222  
MILANO 20126, ITALY

RIMS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35  
AND 44).  
FIRST USE 0-0-1993; IN COMMERCE  
0-0-1993.

SER. NO. 75-250,436, FILED 3-3-1997.

FOR: TIRES AND WHEELS FOR VEHICLES,  
INNER TUBES, RIMS AND PARTS AND FIT-  
TINGS FOR TIRES, WHEELS, TUBES AND

RICHARD A. STRASER, EXAMINING ATTOR-  
NEY

**Int. Cl.: 12**

**Prior U.S. Cls.: 19, 21, 23, 31, 35 and 44**

**Reg. No. 2,138,924**

**United States Patent and Trademark Office**

**Registered Feb. 24, 1998**

**TRADEMARK  
PRINCIPAL REGISTER**

**SCORPION**

PIRELLI COORDINAMENTO PNEUMATICI  
S.P.A. (ITALY CORPORATION)  
VIALE SARCA 222  
MILANO 20126, ITALY

RIMS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35  
AND 44).  
FIRST USE 7-10-1987; IN COMMERCE  
7-10-1987.

SER. NO. 75-250,437, FILED 3-3-1997.

FOR: TIRES AND WHEELS FOR VEHICLES,  
INNER TUBES, RIMS AND PARTS AND FIT-  
TINGS FOR TIRES, WHEELS, TUBES AND

RICHARD A. STRASER, EXAMINING ATTOR-  
NEY

Int. Cls.: 14, 18, 25 and 28

Prior U.S. Cls.: 1, 2, 3, 22, 23, 27, 28, 38, 39, 41 and 50

Reg. No. 3,352,693

United States Patent and Trademark Office

Registered Dec. 11, 2007

TRADEMARK  
PRINCIPAL REGISTER

# SCORPION

PIRELLI TYRE SPA (ITALY SPA)  
VIALE SARCA, 222  
I-20126 MILANO (MI)  
ITALY

FOR: JEWELRY; BELT BUCKLES OF PRECIOUS METALS; BRACELETS OF PRECIOUS METALS; BROOCHES; CUFF-LINKS; DIAMONDS; EARRINGS; NECKLACES; PEARLS; PRECIOUS METALS AND THEIR ALLOYS; RINGS; BRACELETS, CHARMS; EARRINGS IN PRECIOUS METAL OR COATED THEREWITH; PRECIOUS STONES; HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS, NAMELY TIMEPIECES, WRISTWATCHES, WATCHES, CLOCKS AND PARTS THEREOF, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

FOR: HANDBAGS, SUITCASES, WALLETS, BRIEFCASES, SCHOOL BAGS, HANDBAGS FOR MEN, TRUNKS FOR TRAVEL, LEATHER AND IMITATION LEATHER, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FOR: CLOTHING ARTICLES FOR MEN, WOMEN AND CHILDREN, NAMELY, SHIRTS, BLOUSES, SKIRTS, COATS, TROUSERS, PANTS, VESTS, JERSEYS, PAJAMAS, SOCKS AND STOCKINGS, SINGLETTS, CORSETS, GARTERS, UNDERPANTS, PETTICOATS, HATS, HEAD SCARVES, NECKTIES, RAINCOATS, OVERCOATS, GREATCOATS, BATHING SUITS, SPORTS OVERALLS, WIND-RESISTANT JACKETS, SKI PANTS, BELTS, FUR COATS, SCARVES, GLOVES, DRESSING GOWNS, FOOT-

WEAR, NOT FOR GOLF OR SAFETY WORK, NAMELY, SHOES, SPORTS SHOES, SLIPPERS AND BOOTS, ALL OF THE AFORESAID GOODS TO BE USED IN THE PROMOTION OF TIRE SALES, IN CLASS 25 (U.S. CLS. 22 AND 39).

FOR: ARCADE-TYPE ELECTRONIC VIDEO GAMES, SAIL BOARDS FOR BOARD SAILING, CASES FOR TENNIS BALLS, GUT FOR TENNIS RACKETS, RACKETS FOR TENNIS, TABLE TENNIS BALLS, TABLE TENNIS BATS, TABLE TENNIS NETS, TABLE TENNIS PADDLE CASES, TABLE TENNIS PADDLES, TABLE TENNIS RACKETS, TENNIS BALLS, TENNIS RACKET STRINGS, BASKETBALLS, VOLLEY BALLS, HANDBALLS, RACKETBALLS, SOCCER GOALS, RUGBY BALLS, SOCCER BALLS, SPORT BALLS, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY DATE OF 11-14-2005 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION 0908725 DATED 12-28-2005, EXPIRES 12-28-2015.

SER. NO. 79-032,977, FILED 12-28-2005.

CARRIE GENOVESE, EXAMINING ATTORNEY