

ESTTA Tracking number: **ESTTA1077221**

Filing date: **08/24/2020**

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	Mast-Jaegermeister US, Inc.		
Entity	Corporation	Citizenship	New York
Address	10 BANK STREET SUITE 900 WHITE PLAINS, NY 10606 UNITED STATES		
Attorney information	KATRIN LEWERTOFF FERDINAND IP, LLC 1221 POST ROAD EAST SUITE 302 WESTPORT, CT 06880 UNITED STATES Primary Email: klewertoff@fiplawgroup.com Secondary Email(s): jferdinand@fiplawgroup.com, amalbin@fiplawgroup.com, lauras@fiplawgroup.com 2035574224		
Docket Number	JAG096USL		

Registration Subject to Cancellation

Registration No.	3011867	Registration date	11/01/2005
Registrant	ALFWEAR INC. 1635 SOUTH 5070 WEST SUITE C SALT LAKE CITY, UT 84104 UNITED STATES		

Goods/Services Subject to Cancellation

Class 033. First Use: 2004/07/29 First Use In Commerce: 2004/07/29 All goods and services in the class are subject to cancellation, namely: WINE

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
Deceptiveness	Trademark Act Sections 14(3) and 2(a)

Related Proceedings	91256015, 92070074, 92071897, 92071907, 92071953
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Attachments	JAG096USL KUEHL IC 33 petition to cancel 08242020.pdf(158156 bytes)
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Signature	/KL/
Name	Katrin Lewertoff
Date	08/24/2020

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

Mast-Jaegermeister US, Inc.,

Petitioner,

v.

Alfwear Inc.,

Respondent.

Cancellation No. _____

Mark: KÜHL

Reg. No.: 3011867

Int. Class: 33

PETITION FOR CANCELLATION

Petitioner Mast-Jaegermeister US, Inc., a New York corporation with a principal place of business at 10 Bank Street, Suite 900, White Plains, NY, 10606 (hereinafter “Petitioner”), believes that Registration No. 3011867 for the alleged mark KÜHL for “wine” in International Class 33 is invalid and that the alleged mark has been abandoned, and Petitioner is and will be damaged by the continued existence of the registration. Therefore, Petitioner hereby petitions to cancel this registration pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. §1064.

As grounds for cancellation, Petitioner alleges as follows:

1. Respondent’s alleged KÜHL trademark (the “KÜHL Mark”) is registered for alleged use in connection with “wine” in International Class 33.
2. Respondent was assigned this registration by way of assignment dated June 3, 2019, recorded on June 7, 2019, under Reel/Frame 006664/0663. Respondent did not obtain the registration with a bona fide intent to use it in commerce in connection with any product, but to expand the universe of marks it holds on “kühl,” to attempt to monopolize the

common German word “kühl,” which literally means “cool” or cold,”¹, and use this registration as a grounds to manufacture customer confusion in a pending trademark infringement action in the United States District Court for the District of Utah Central Division, Case No. 2:17-cv-936. However, Respondent may not appropriate descriptive language through trademark registration. *See M.B.H. Enters. v. Woky, Inc.*, 633 F.2d 50, 55 (7th Cir. 1980) (the court said the owner of a registered mark “may not appropriate to itself common English slang terms and thus prevent others from using such phrases in their descriptive sense”); *Blau Plumbing, Inc. v. S.O.S. Fix-It, Inc.*, 781 F.2d 604, 609-10 (7th Cir. 1986) (“[Plaintiff] cannot appropriate the English language, and by doing so render a competitor inarticulate.”); *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 951 (7th Cir. 1992) (“...no one should be able to appropriate descriptive language through trademark registration.”)

3. Upon information and belief, Respondent, since the June 2019 assignment, has not obtained a license from the State of Utah to manufacture or distribute wine, has not licensed the rights to the KÜHL Mark for wine to a third-party wine maker, and has not used in connection with, or placed its alleged KÜHL Mark on “wine” in Class 33, or containers, or on tags or labels affixed to the registered goods, and sold or transported any of the registered goods in commerce. Indeed, without the requisite licensure, Respondent is unable to do so.

4. Upon information and belief, Respondent, since the assignment, has not used in connection with, or placed its alleged KÜHL Mark on “wine” in Class 33, on any promotional

¹ *See, e.g.*, <https://dictionary.cambridge.org/us/dictionary/german-english/kuhl> or <https://en.wiktionary.org/wiki/k%C3%BChl> (defining “kühl” as meaning “cold, chilly” and the physical perception of something (objects, weather, body etc.) to have a low temperature).

items or attempted to establish use in commerce or use in the ordinary course of trade through use. Respondent cannot do so because its principal course of trade is the manufacture and retailing of outdoor clothing, not alcoholic beverages.

5. Upon information and belief, Respondent or the previous owner has not used the alleged KÜHL Mark for the registered goods in Class 33 for at least 3 consecutive years, constituting abandonment of the Mark under 15 U.S.C. §1064.

6. If Respondent or the previous owner ever used the alleged KÜHL Mark in connection with “wine” in Class 33, Respondent has abandoned the alleged KÜHL Mark for the registered goods in Class 33. And, based on Respondent’s failure to obtain licenses to manufacture or distribute wine, or enter into a license agreement with an existing wine maker, Respondent has no intent to resume use of the alleged KÜHL Mark in connection with these goods.

7. Upon information and belief, Respondent has not obtained a Certificate of Label Approval (COLA) for a KÜHL wine product.

8. Upon information and belief, under 15 U.S.C. §1052(a), KÜHL is deceptive in connection with “wine” because the goods do not have the described characteristics of “cool” or “cold,” or bring about the described results of “cooling,” the relevant public would purchase/purchases the products for the described adjectives, and the misdescription is a material factor that may be considered in purchasing decisions.

9. Alternatively, KÜHL is deceptively misdescriptive in connection with “wine” because the goods do not have the described characteristic, feature, function, purpose, and use.

10. On August 17, 2017, Respondent filed a complaint for trademark infringement

and dilution with the United States District Court for the District of Utah Central Division, Case No. 2:17-cv-936, alleging that Petitioner's descriptive use of the German word "kühl" in connection with advertising for Petitioner's famous JÄGERMEISTER liqueur infringes and dilutes Respondent's alleged KÜHL Marks on clothing, bottled water and lip balm. In that proceeding, Respondent has alleged the existence of its registration of "kühl" for wine as a basis to argue that Petitioner's use of "kühl" in advertisements for the popular German beverage JÄGERMEISTER will confuse consumers and tarnish Respondent's marks on its clothing and accessories.

11. Petitioner is damaged by the registration of Respondent's alleged KÜHL Mark to the extent that the registration conveys rights in the alleged KÜHL Mark to Respondent. Any such conveyance of rights to Respondent damages Petitioner and others because Petitioner and many other companies currently use "kühl," either as company names or as advertising copy, and several companies own registrations on "kühl" or "kuhl." Examples include Four Peaks Brewing Co.'s "Kühl Beans" beer, 2Kuhl clothing, Kuhl Corp., Friedrich's Kühl Smart Wifi Room Air Conditioner, Kuhl Insurance, Kuhl's Trailer Sales, and Kuhl's Electric & Service. Further, conveyance of rights in "kühl" to Respondent would permit and encourage Respondent to misuse the courts and the USPTO and TTAB to harass other persons and businesses with rights in the mark, or others who fairly use the mark in good faith in a descriptive, non-trademark sense to describe products or services, not identify the source of the products or services. (15 U.S.C. § 1115(b)(4); 15 U.S.C. § 1125(c)(3).) And finally, the registration of the alleged KÜHL Mark enables and empowers Respondent to attempt to foreclose Petitioner and others from using a common, descriptive German word in commerce, thereby curtailing the essential commercial speech rights of Petitioner and numerous other companies.

WHEREFORE, Petitioner requests that Registration No. 3011867 be cancelled, and this Petition for Cancellation be granted in Petitioner's favor.

August 24, 2020

Respectfully submitted,

/KL/

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