

ESTTA Tracking number: **ESTTA1110938**

Filing date: **01/28/2021**

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	Mariano Films, LLC		
Entity	limited liability company	Citizenship	New Jersey
Address	824 NEWARK AVENUE MANVILLE, NJ 08835 UNITED STATES		
Attorney information	STEPHEN L. BAKER BAKER AND RANNELLS PA 92 EAST MAIN STREET SUITE 302 SOMERVILLE, NJ 08876 UNITED STATES Primary Email: officeactions@br-tmlaw.com Secondary Email(s): K.Hnasko@br-tmlaw.com, s.baker@br-tmlaw.com, s.cesaro@br-tmlaw.com, jmr@br-tmlaw.com 9087225640		
Docket Number			

Registration Subject to Cancellation

Registration No.	5853948	Registration date	09/10/2019
International Registration No.	NONE	International Registration Date	NONE
Registrant	Photo MV Limited 9 OFFORD ROAD LONDON N1 1DJ UNITED KINGDOM		

Goods/Services Subject to Cancellation

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Downloadable image files containing photographs and artworks; Downloadable multimedia files containing videos relating to photography, photo shoots, fashion and entertainment; Recorded electronic data carriers featuring videos and images
Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Photographs; Posters; Printed images being photographs; Art prints
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Photography services; Video production and editing services; Providing a website featuring non-downloadable videos and image

files in the field of photography,photo shoots, fashion and entertainment

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Abandonment	Trademark Act Section 14(3)
Other	No bona fide intent to use the mark in commerce

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	88905834	Application Date	05/07/2020
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MARIANO FILMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2007/11/01 First Use In Commerce: 2007/11/01 Distribution of television programming to cable television systems; Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring drama, comedy, reality and variety content; Entertainment services, namely, providing ongoing television programs in the field of drama, comedy, reality and variety via a global computer network; Entertainment services, namely, providing podcasts in the field of musical performances, musical videos, related film clips, photographs, and other multimedia materials; Entertainment services, namely, providing webcasts in the field of musical performances, musical videos, related film clips, photographs, and other multimedia materials; Entertainment, namely, a continuing drama, comedy, reality and variety show broadcast over television, satellite, audio, and video media; Film distribution; Motion picture film production; Production and distribution of independent motion pictures; Production and distribution of motion pictures; Production and distribution of television shows and movies; Production of video discs and tapes; Provision of non-downloadable films and movies via a video-on-demand service		

Attachments	Petition to cancel with confusion non use and revised 1.28.pdf(120106 bytes)
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Signature	/Stephen L. Baker/
Name	Stephen L. Baker
Date	01/28/2021

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

Mariano Films, LLC,

Cancellation No. .

Petitioner,

Mark: MARIANO VIVANCO

v.

Reg. No. 5853948

Photo MV Limited,

Issued: September 10, 2019

Registrant.

PETITION FOR CANCELLATION
PURSUANT TO 15 U.S.C. § 1063

In the matter of Trademark Reg. No. 5853948 for the mark MARIANO VIVANCO (“Registrant’s Mark”) for:

IC 009. US 021 023 026 036 038. G & S: Downloadable image files containing photographs and artworks; Downloadable multimedia files containing videos relating to photography, photo shoots, fashion and entertainment; Recorded electronic data carriers featuring videos and images

IC 016. US 002 005 022 023 029 037 038 050. G & S: Photographs; Posters; Printed images being photographs; Art prints

IC 041. US 100 101 107. G & S: Photography services; Video production and editing services; Providing a website featuring non-downloadable videos and image files in the field of photography, photo shoots, fashion and entertainment

(“Registrant’s Services”), registered to Registrant on September 10, 2019, Petitioner a limited liability company organized and existing under the laws of New Jersey, located and doing business at 824 Newark Avenue, Manville, NJ 08835, believes it will be damaged by continued registration of Trademark Reg. No. 5853948 (“Registrant’s Registration”) and hereby petitions to cancel same pursuant to 15 U.S.C. §1064 (Trademark Act of 1946, §14). As grounds thereof, Petitioner alleges the following,

alleges on knowledge as to its own acts and otherwise on information and belief and as grounds for cancellation as follows:

1. Petitioner is the owner of the mark MARIANO FILMS for services in International Class 041 (the “Petitioner’s Pending Mark”).
2. Petitioner’s Services include but are not limited to Distribution of television programming to cable television systems; Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring drama, comedy, reality and variety content; Entertainment services, namely, providing ongoing television programs in the field of drama, comedy, reality and variety via a global computer network; Entertainment services, namely, providing podcasts in the field of musical performances, musical videos, related film clips, photographs, and other multimedia materials; Entertainment services, namely, providing webcasts in the field of musical performances, musical videos, related film clips, photographs, and other multimedia materials; Entertainment, namely, a continuing drama, comedy, reality and variety show broadcast over television, satellite, audio, and video media; Film distribution; Motion picture film production; Production and distribution of independent motion pictures; Production and distribution of motion pictures; Production and distribution of television shows and movies; Production of video discs and tapes; Provision of non-downloadable films and movies via a video-on-demand service International Class 041 (the “Petitioner’s Pending Services”).

3. On May 7, 2020, Petitioner filed an application to register Petitioner's Pending Mark (MARIANO FILMS) in International Class 041 for Petitioner's Pending Services, which application was assigned Ser. No. 88905834 ("Petitioner's Pending Application").
4. Petitioner's Application was refused registration because of a likelihood of confusion with Registrant's Mark for Registrant's Services.
5. Because Petitioner was refused registration of Petitioner's Pending Application and because Registrant's Mark is identical to Petitioner's and is confusingly similar to Petitioner's Registered Marks, Petitioner has been and will be damaged, such that Petitioner has sufficient standing to bring this action.

COUNT 1

LIKELIHOOD OF CONFUSION

6. Upon information and belief based on the rejection of Petitioner's application by the USPTO, the continued registration of Registrant's Mark to Registrant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Registrant's Goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), all to Petitioner's irreparable damage.

COUNT II

NO BONA FIDE USE OF THE MARK

7. Petitioner repeats and re-alleges paragraphs 1 to 6 above with the same force and effect as if set forth herein at length.
8. Registrant's application is void ab initio as Registrant had no bona fide intent to use of the Registrant's Mark for the entirety of Registrant's Services at the time it filed its application on October 11, 2018
9. Registrant has taken no commercially reasonable steps to begin commercial use of Registrant's Mark either prior to or subsequent to the filing of the Registrant's application.

COUNT III

ABANDONMENT

10. Upon information and belief, to the extent the Registrant ever used Registrant's Mark, the Registrant has abandoned the mark covered by the Registration in classes 009, 016 and/or 041. The Cancellation is, therefore, appropriate under Section 14(3) of the Lanham Act, 15 U.S.C. Section 1064(3).
11. Upon information and belief, to the extent the Registrant ever used Registrant's Mark, Registrant has discontinued use of the mark covered by the Registration for those services specified in in classes 009, 016 and/or 041".

12. Upon further information and belief, to the extent the Registrant ever used Registrant's Mark, Registrant discontinued such use and has no intent to resume use of such mark for the services specified, 009, 016 and/or 041..
13. Upon further information and belief, to the extent the Registrant ever used Registrant's Mark such use may be characterized as minimal, sporadic or nominal and insufficient acquire or maintain trademark rights in the United States .
14. Continued registration for Registrant's Mark to Registrant creates a cloud on Petitioner's rights to use Petitioner's Mark for Petitioner's Goods.
15. Petitioner believes that it is and will be damaged by continued registration of the mark applied for by Registrant.

WHEREFORE, Petitioner prays that the application for registration of Registrant's Mark, Trademark Reg. No. 5853948, issued September 10, 2019 be cancelled in classes 009, 016 and 041 and that this Petition to Cancel be sustained.

Dated: January 28, 2021

Respectfully submitted for Petitioner
Mariano Films, LLC



By:

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served via e-mail upon the correspondent identified by the TSDR, for Registrant, Matt Solmon. at matt@solmoniplaw.com on this 28th day of January, 2021.



Stephen L. Baker