

ESTTA Tracking number: **ESTTA1253491**

Filing date: **12/12/2022**

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	Funkshion Productions		
Entity	Limited liability company	Citizenship	Florida
Address	161 CRANDON BLVD., #419 KEY BISCAWAYNE, FL 33149 UNITED STATES		

Attorney information	JAIME RICH VINING FRIEDLAND VINING, P.A. 9100 S. DADELAND BLVD., SUITE 1620 MIAMI, FL 33156 UNITED STATES Primary email: trademarks@friedlandvining.com Secondary email(s): JRV@friedlandvining.com, DKF@friedlandvining.com 305-777-1721		
Docket no.			

Registration subject to cancellation

Registration no.	6914634	Registration date	11/29/2022
Register	Supplemental		
Registrant	DCSW Group MOHAMED UZAIR 3855 LA PLAYA BLVD MIAMI, FL 33139 UNITED STATES		

Goods/services subject to cancellation

Class 041. First Use: Oct 31, 2020 First Use In Commerce: Oct 31, 2020 All goods and services in the class are subject to cancellation, namely: Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content


Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 23(a) and 2(d)
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Marks cited by petitioner as basis for cancellation

U.S. registration no.	5888123	Application date	04/14/2018
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Register	Principal		
Registration date	10/22/2019	Foreign priority date	NONE
Word mark	SWIM FASHION WEEK		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Jun 1, 2008 First Use In Commerce: Jun 1, 2008 Entertainment in the nature of fashion shows		

U.S. application no.	90743813	Application date	05/30/2021
Register	Principal		
Registration date	NONE	Foreign priority date	NONE
Word mark	MIAMI SWIM FASHION WEEK		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Mar 18, 2008 First Use In Commerce: Mar 18, 2008 Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; Entertainment services in the nature of development, creation, production, distribution, and post-production of fashion shows and presentations; Entertainment in the nature of fashion shows		

U.S. application no.	90744864	Application date	05/31/2021
Register	Principal		
Registration date	NONE	Foreign priority date	NONE
Word mark	MIAMI SWIM WEEK		
Design mark			
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Mar 1, 2009 First Use In Commerce: Mar 1, 2009 Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; Entertainment in the nature of fashion shows		

Attachments	90743813#TMSN.png(bytes) PET - Petition to Cancel MIAMI SWIM WEEK - AS FILED.pdf(2306772 bytes)
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Signature	/Jaime Rich Vining/
Name	Jaime Rich Vining
Date	12/12/2022

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

FUNKSHION PRODUCTIONS,

Petitioner,

v.

DCSW GROUP,

Registrant.

Cancellation No.: _____
Registration No.: 6,914,634
Registration Date: November 29, 2022
Mark: MIAMI SWIM WEEK

PETITION TO CANCEL

Pursuant to 15 U.S.C. § 1064(3) and TBMP § 307.02, Petitioner Funkshion Productions (“Petitioner”), a Florida limited liability company located at 161 Crandon Blvd., #419, Key Biscayne, FL 33149, is and will be damaged by Registration No. 6,914,634 (the “634 Reg.”) and hereby petitions to cancel same.

As grounds for this Petition, Petitioner alleges as follows:

1. Since 2002, Petitioner has emerged as one of the most celebrated experiential event production companies in Miami and the premier destination for brands and retailers to converge. Petitioner specializes in innovative fashion show and fashion presentation concept, production and execution. Petitioner has garnered a reputation in the fashion industry for consistently executing projects at the highest levels.

2. Petitioner owns, among others, U.S. Trademark Reg. No. 5,888,123 for the mark **SWIM FASHION WEEK®**, registered in connection with “Entertainment in the nature of fashion shows,” in International Class 41. Petitioner has continuously and

substantially exclusively used the **SWIM FASHION WEEK®** mark in commerce since at least as early as June 1, 2008.

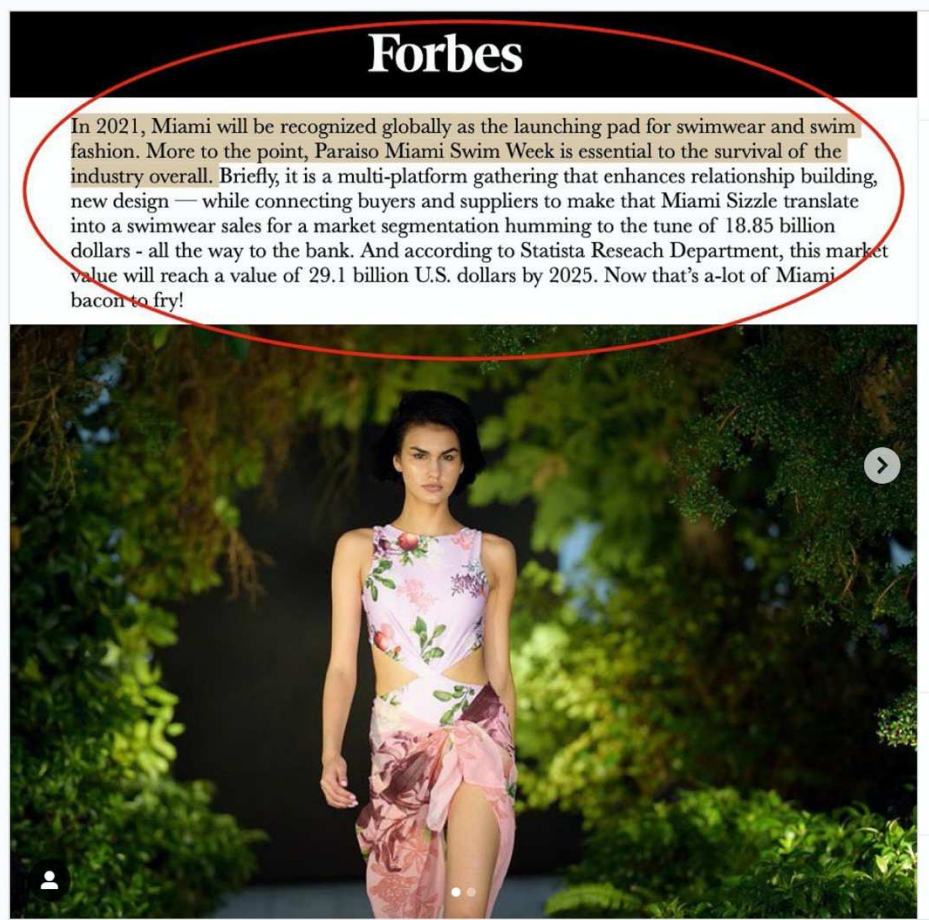
3. Petitioner also owns U.S. Trademark Application Serial Nos. (i) 90/743,813 for **MIAMI SWIM FASHION WEEK**, filed in connection with “Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; Entertainment services in the nature of development, creation, production, distribution, and post-production of fashion shows and presentations; Entertainment in the nature of fashion shows,” in International Class 41; and (ii) 90/744,864 for **MIAMI SWIM WEEK**, filed in connection with “Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content; Entertainment in the nature of fashion shows,” in International Class 41 (the “Applications”)(collectively with **SWIM FASHION WEEK®**, the “**SWIM WEEK Marks**”).

4. Petitioner has continuously and substantially exclusively used the **MIAMI SWIM WEEK** mark in commerce since at least as early as June 1, 2009, and the **MIAMI SWIM FASHION WEEK** mark in commerce since at least as early as January 20, 2015.

5. Petitioner has spent a considerable amount of resources, time, and effort marketing and promoting its **SWIM WEEK Marks** in the fashion industry. Petitioner’s continuous, extensive and substantially exclusive use of the **SWIM WEEK Marks** has resulted in millions of customers worldwide and dollars in revenue. As a result of

Petitioner's extensive use, Petitioner has built up significant recognition and goodwill in the **SWIM WEEK** Marks.

6. Since launching, Petitioner has garnered local, national and international acclaim and received extensive unsolicited publicity based on the company's success. For example, Petitioner has been the subject of media coverage by *Forbes*, *Harper's Bazaar*, *Cosmopolitan*, *FashionWeekOnline.com*, *Deco Drive*, *Bloom*, *Fashionista*, and *Nylon* among others.



7. Petitioner has also been awarded the Key to the City of Miami Beach, five different proclamations from the City of Miami Beach, Fashion Group International

Award for Swim Week and second one for Lifetime Achievement Award, Beacon Council Creative Award, and MANA Fashion Pioneer Award for Swim Week.

8. According to the electronic records of the United States Patent and Trademark Office (“PTO”), Registrant DCSW Group (“Registrant”), a Florida limited liability company located at 3855 La playa Blvd., Miami, FL 33139, is the record owner of the ‘634 Reg. for the mark MIAMI SWIM WEEK, which registration issued on the Supplemental Register on November 29, 2022.

9. The ‘634 Reg. includes “Entertainment services in the nature of development, creation, production and post-production services of multimedia entertainment content,” in International Class 41.

10. The ‘634 Reg. is not incontestable and is subject to cancellation on the basis of a likelihood of consumer confusion.

11. The PTO Trademark Examining Attorney (“Examiner”) assigned to Petitioner’s Applications has refused registration on the basis that Petitioner’s **MIAMI SWIM FASHION WEEK** and **MIAMI SWIM WEEK** marks are likely to cause confusion with Registrant’s registered MIAMI SWIM WEEK mark.

12. In the ‘634 Reg., Registrant alleges a date of first use of the MIAMI SWIM WEEK mark of October 31, 2020, more than ten years *after* Petitioner’s use of **SWIM WEEK** Marks.

13. Petitioner believes that it is and is likely to continue to be damaged by the continued existence of the ‘634 Reg., in that Petitioner’s use of its **SWIM WEEK** Marks

predates Registrant's first use of the mark that is the subject of the '634 Reg. and Petitioner's Applications have been refused in view of the '634 Reg.

LIKELIHOOD OF CONFUSION

14. Petitioner incorporates by reference paragraphs 1-13 as if fully set forth herein.

15. For over a decade, Petitioner has used its **SWIM WEEK** Marks in respect of its fashion and entertainment services.

16. As a result of Petitioner's widespread use in interstate commerce of its **SWIM WEEK** Marks, Petitioner has acquired extensive goodwill, has developed a high degree of distinctiveness, and is well known as providing the most diverse and creative lifestyle fashion events in the world.

17. Petitioner's use of the **SWIM WEEK** Marks predates any valid use by Registrant of the MIAMI SWIM WEEK mark.

18. Registrant's MIAMI SWIM WEEK mark is confusingly similar to Petitioner's **SWIM WEEK** Marks. The marks are identical or virtually identical in appearance, sound, connotation and commercial impression.

19. The services identified by Registrant's MIAMI SWIM WEEK mark are sufficiently similar to the services identified by Petitioner's **SWIM WEEK** Marks that they are likely to travel or be promoted through the same trade channels and offered to the same class of consumers.

20. Registrant's use of the MIAMI SWIM WEEK mark in connection with the services identified in the '634 Reg. is likely to cause confusion, mistake, or deception as to

the source or origin of Registrant's services, as a result of which the public, trade, and others are likely to believe that Registrant's services are (a) the same as Petitioner's or (b) provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Petitioner and/or its services.

21. Under the provisions of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), Registrant's use of the mark is likely to cause confusion because of Petitioner's prior use of its **SWIM WEEK** Marks and the '634 Reg. should therefore be cancelled.

PRAYER FOR RELIEF

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained and granted in favor of Petitioner and that Registration No. 6,914,634 be cancelled and removed from the Supplemental Register.

Date: December 12, 2022

Respectfully submitted,

FRIEDLAND VINING

/s/Jaime Rich Vining

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