

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

TTAB

T. Tucker, Inc.,)	
)	
Petitioner)	
)	
v.)	Cancellation No.
)	
Gelato Massimo Inc.,)	
)	
Registrant)	
)	
)	

PETITION FOR CANCELLATION

T. Tucker, Inc., a California corporation, having a principal place of business at 13222 West Washington Blvd., by and through its undersigned attorneys believes it will be damaged by U.S. Reg. No. 2,868,917 and hereby petitions for cancellation of such registration under 37 C.F.R. Section 2.111(b).

As grounds therefor, it is alleged that:

1. The Registrant has obtained U.S. Trademark Registration No. 2,868,917 on August 3, 2004, for the mark GELATO MASSIMO INC. for use with "frozen confections, Italian ice cream, ice cream, and sorbet." The first use of the mark anywhere by Registrant was January 29, 2003; the first use of the mark in commerce by the Registrant was April 11, 2003.
2. Petitioner has adopted and continuously used the trademark MASSIMO'S DELECTABLES in commerce since at least as early as February, 2000, to the present time in connection with a wide variety of food products in International Class 30, and retail bakery services in International Class 35.

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3. Petitioner has adopted and continuously used the trademark MASSIMO'S GELATO in commerce since at least as early as July, 2002, to the present time in connection with a wide variety of food products, including gelato, in International Class 30, and restaurant services including ice cream parlor services in International Class 43.

4. Petitioner has applied to register its trademark and service mark MASSIMO'S GELATO in the United States Patent and Trademark Office, said applications bearing Ser. Nos. 78/468,301 and 78/468,300.

5. Petitioner has developed extensive goodwill with respect to its trademarks MASSIMO'S DELECTABLES and MASSIMO'S GELATO.

6. Petitioner has spent substantial sums in advertising and promotion of the goods and services, which bear the marks MASSIMO'S DELECTABLES and MASSIMO'S GELATO.

7. By virtue of the excellent quality of its goods and services, and expenditures of considerable sums in promoting such goods and services by advertising, Petitioner has garnered a most valuable reputation for its marks MASSIMO'S DELECTABLES and MASSIMO'S GELATO.

8. The goods on which the Petitioner uses the marks MASSIMO'S DELECTABLES and MASSIMO'S GELATO, namely, a wide variety of food products, in some instances are identical to the goods of the Registrant with respect to its use of GELATO MASSIMO INC. The services with which the Petitioner uses the marks MASSIMO'S DELECTABLES and MASSIMO'S GELATO, namely restaurant and ice cream parlor services, in some instances are identical, and in others highly related to the services of the Registrant with respect to its use of GELATO MASSIMO INC. While Petitioner is aware the Registrant's registration does not identify services, Petitioner contends such services are wholly tied to the offering of the food products, including gelato, that it is worthwhile to provide the Registrant with this information.

9. Purchasers are likely to consider the goods of the Registrant bearing the mark GELATO MASSIMO INC. as emanating from Petitioner and will believe such goods to be those of Petitioner.

10. If the Registrant is permitted to retain the registration sought to be cancelled, a cloud will be placed on Petitioner's title in and to its trademark and service marks MASSIMO'S DELECTABLES and MASSIMO'S GELATO and on its right to enjoy the free and exclusive use thereof in connection with the sale of its goods and services, all to the great injury of Petitioner. Persons familiar with Petitioner's marks would be likely to buy Registrant's goods as and for a good rendered, sold by, or associated with the Petitioner. Any such confusion in trade might result in a loss of sales to the Petitioner.

11. Furthermore, any defect, objection, or fault found with Registrant's goods marketed under its mark would necessarily reflect upon and seriously injure the reputation that the Petitioner has established for its goods and services merchandised under its MASSIMO'S DELECTABLES and MASSIMO'S GELATO marks.

12. If the Registrant is permitted to maintain its registration, the same may be deemed incontestable after five (5) years from the date of the registration, and Registrant would thereby obtain an incontestable right to use of its mark in commerce. The continued existence of such registration casts a cloud upon Petitioner's right to continue to use, register, and expand the use of the marks MASSIMO'S DELECTABLES and MASSIMO'S GELATO . Such registration would thus be a source of damage and injury to the Petitioner.

13. Registrant obtained U.S. Registration No. 2,868,917 fraudulently in that Registrant has not used the mark GELATO MASSIMO INC. with the goods identified in the subject registration in interstate commerce.

14. A duplicate copy of this Petition and the fee required in Section 2.6(1) are enclosed herewith. Wherefore, the Petitioner prays that Registration No. 2,868,917 issued on August 3, 2004 be cancelled.

Please charge any fees, or credit any overpayment to our Deposit Account No. 02-2666.

T. TUCKER, INC.

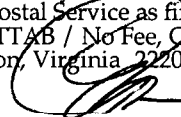
Dated: August 17, 2004

By: 
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
Dax Alvarez
Counsel for Petitioner

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025
(310) 207-3800

CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP: TTAB / No Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on August 17, 2004.


Erika Brenner

August 17, 2004

CERTIFICATE OF SERVICE

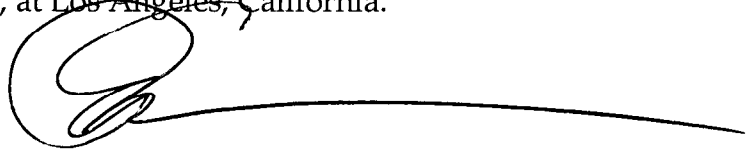
I hereby certify that a true and correct copy of the foregoing document entitled:

PETITION FOR CANCELLATION

was served on counsel for Registrant by first class mail, postage prepaid, in a sealed enveloped addressed as follows:

Warren S. Heit, Esq.
WHITE & CASE LLP
3000 El Camino Real
5 Palo Alto SQ, 10th Floor
Palo Alto, California 94306

Executed on August 17, 2004, at Los Angeles, California.

A handwritten signature in black ink, appearing to be 'Erika Brenner', is written over a horizontal line. The signature is stylized with a large, looping initial 'E'.

Erika Brenner

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