

ESTTA Tracking number: **ESTTA587362**

Filing date: **02/14/2014**

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 requests to cancel indicated registration.

Petitioner Information

Name	Halibrand Performance Corporation, Inc.		
Entity	Corporation	Citizenship	United States
Address	500 S. Washington Ave. Wellington, KS 67152 UNITED STATES		

Attorney information	Richard J LeJuernne Jr. 3735 SW Wanamaker St. Suite A Topeka, KS 66610 UNITED STATES rlejuernne@gmail.com Phone:(785) 817-3925
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Registrations Subject to Cancellation

Registration No	4279857	Registration date	01/22/2013
Registrant	Durham, Jonathan 6994 El Camino Real, Suite 204 Carlsbad, CA 92009 USX		

Goods/Services Subject to Cancellation

Class 035. First Use: 2012/06/15 First Use In Commerce: 2012/06/15 All goods and services in the class are cancelled, namely: Retail store services featuring automobile parts and accessories

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Priority and likelihood of confusion	Trademark Act section 2(d)		
Registration No	4340201	Registration date	05/21/2013
Registrant	Durham, Jonathan P.O. Box 4372 Culver City, CA 90231 USX		

Goods/Services Subject to Cancellation

Class 035. First Use: 2012/06/15 First Use In Commerce: 2012/06/15 All goods and services in the class are cancelled, namely: Retail store services featuring automobile parts and accessories

Grounds for Cancellation

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Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85915732	Application Date	04/26/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HALIBRAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1948/00/00 First Use In Commerce: 1948/00/00 Land vehicle parts, namely, axles; Vehicle wheel rims; Vehicle wheel rims and structural parts therefor; Vehicle wheels; Wheel rims; Wheel rims; Wheel rims formotor cars; Wheels		

U.S. Registration No.	2456821	Application Date	09/28/1999
Registration Date	06/05/2001	Foreign Priority Date	NONE
Word Mark	HALIBRAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1948/00/00 First Use In Commerce: 1948/00/00 Automobile wheels and parts therefor, and automobile rear axle assemblies		

Attachments	85915732#TMSN.jpeg(bytes) Halibrand Performance Corporation Petition to Cancel 021414.pdf(86187 bytes) 75811466#TMSN.gif(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/rjl/
Name	Richard J LeJuerne Jr.
Date	02/14/2014

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

In the matter of Trademark Registrations

Registrant: Durham, Jonathan

Registration No.: 4,279,857

For the Mark: EQUIPPED BY HALIBRAND ENG. CULVER CITY, CALIF.

Registered on: January 22, 2013

Registrant: Durham, Jonathan

Registration No.: 4,340,201

For the Mark: HALIBRAND

Registered on: May 21, 2013

Halibrand Performance Corporation, Inc.

Petitioner,

v.

Jonathan Durham

Registrant.

Cancellation No. _____

PETITION TO CANCEL

1. Petitioner Halibrand Performance Corporation, Inc. (“Petitioner”), a corporation duly organized and existing under the laws of the State of Kansas and having a principal place of business at 500 S. Washington Ave., Wellington, Kansas 67152, believes that it will be damaged by Registration No. 4,279,857 for the mark EQUIPPED BY HALIBRAND ENG. CULVER CITY, CALIF. (the “EQUIPPED BY HALIBRAND Mark”) and Registration No. 4,340,201 for the mark HALIBRAND (the “HALIBRAND Mark”) and hereby petitions, in accordance with 37 C.F.R. §2.111(b), to cancel said registrations.

2. To the best of Petitioner's knowledge, the name and address of the current registrant of the EQUIPPED BY HALIBRAND Registration and the HALIBRAND Registration is Jonathan Durham ("Respondent"), an individual with an address of 6994 El Camino Real, Suite 204, Carlsbad, California 92009.

3. Petitioner is the owner of the HALIBRAND mark for the manufacture and sale of automobile wheels and parts and automobile rear end assemblies (the "Goods"). The HALIBRAND mark was first used in connection with the Goods in interstate commerce at least as early as 1948 and is now in use in such commerce. The mark HALIBRAND is used applying it to the Goods, to tags and labels applied to the Goods, to containers for the Goods and to displays associated with the Goods.

4. Petitioner is the owner of the EQUIPPED BY HALIBRAND mark for the manufacture and sale of automobile wheels and parts and automobile rear end assemblies (the "Goods"). The EQUIPPED BY HALIBRAND mark was first used in connection with the Goods in interstate commerce at least as early as 1962 and is now used in promotional materials and apparel associated with the Goods.

5. Petitioner is a previous registrant of the HALIBRAND mark; On September 28, 1999, Petitioner filed an application, Serial No. 75/811,466, to register the HALIBRAND mark for automotive wheels and parts therefor, and automotive rear axle assemblies. Petitioner's HALIBRAND mark registered on June 05, 2001. Petitioner's registration cancelled on January 06, 2012 because Petitioner did not file timely a declaration of continued use under Section 8.

6. Despite Petitioner's failure to make a timely declaration of continued use, Petitioner has been, and is now, using the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark in connection with the Goods. Petitioner's use of the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark has been valid and continuous since its date of first use.

7. On June 15, 2012, Respondent filed an application, Serial No. 85/653,567, to register the EQUIPPED BY HALIBRAND Mark for use with "retail store services featuring automobile parts and accessories" in International Class 035, providing a date

of first use of the mark in interstate commerce of June 15, 2012. Respondent's EQUIPPED BY HALIBRAND Mark registered on January 22, 2013.

8. The Respondent's registered EQUIPPED BY HALIBRAND Mark is identical to the EQUIPPED BY HALIBRAND Mark owned by the Petitioner.

9. On July 3, 2012, Respondent filed an application, Serial No. 85/668,544, to register the mark HALIBRAND for use with "retail store services featuring automobile parts and accessories" in International Class 035, providing a date of first use of the mark in interstate commerce of June 15, 2012. Respondent's HALIBRAND Mark registered the Supplemental Register on May 21, 2013.

10. The Respondent's registered HALIBRAND Mark is identical to the HALIBRAND Mark owned by the Petitioner.

11. Upon information and belief, the Respondent has been misrepresenting himself in the automotive industry as having purchased the Halibrand name with a plan to introduce new products.

12. The Respondent has created a website halibrandengineering.com using the EQUIPPED BY HALIBRAND Mark and listing automotive parts he is not authorized or licensed to sell under the HALIBRAND Mark.

13. Petitioner's HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark is symbolic of extensive goodwill established by the Petitioner, has acquired a high degree of recognition through continued use and expenditures of time, effort and money in advertising and promotion, and serves as a unique identifier of the goods offered by Petitioner.

14. Respondent's services with which it uses the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark, as claimed in Respondent's Applications, offer for sale goods through the same channels of trade and to the same class of purchasers as those of the Petitioner.

COUNT I
FRAUD IN THE PROCUREMENT OF THE REGISTRATIONS

15. Petitioner hereby incorporates by reference and re-alleges each and every allegation set forth in Paragraphs 1 through 14.

16. Respondent obtained both the HALIBRAND Mark and EQUIPPED BY HALIBRAND Mark through fraud upon the USPTO by knowingly making a false, material representation declaring himself as the owner of the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark, declaring that he was entitled to use the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark in commerce, and declaring no knowledge of the Petitioner's ownership of the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark.

17. Pursuant to 15 U.S.C. § 1064(3), Respondent's registrations of the HALIBRAND Mark and EQUIPPED BY HALIBRAND Mark were obtained fraudulently and should be cancelled and declared void ab initio.

COUNT II
PRIORITY AND LIKELIHOOD OF CONFUSION

18. Petitioner hereby incorporates by reference and re-alleges each and every allegation set forth in Paragraphs 1 through 14.

19. Petitioner's use of both HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark pre-date both the Respondent's alleged first use of, and registration of, the HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark, and establish the priority of Petitioner's HALIBRAND Mark and the EQUIPPED BY HALIBRAND Mark.

20. In view of the identical marks, identical channels of trade and the same class of purchasers for the goods and services offered by both Petitioner and Respondent, Petitioner asserts that the Respondent's marks, when used on or in connection with the services and goods of the Respondent, is likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Respondent owns the HALIBRAND Mark and EQUIPPED BY HALIBRAND Mark. Therefore, Respondent's marks should be cancelled pursuant to 15 U.S.C. § 1052(d).

21. Petitioner will be irreparably harmed and financially damaged by the Respondent's registrations, because he is the owner of the HALIBRAND Mark and

EQUIPPED BY HALIBRAND Mark and he believes Respondent's marks will be cited against his pending trademark application as grounds for refusal. Halibrand customers are likely to be confused as to the source or origin of the goods or services provided, and any use of the HALIBRAND Mark and EQUIPPED BY HALIBRAND Mark in connection with the sale of automotive parts, will dilute the distinctive qualities of the Petitioner's mark.

22. For the foregoing reasons, Petitioner respectfully requests that the Petition to Cancel be granted and that the Respondent's Trademark Registrations Nos. 4279857 for the mark EQUIPPED BY HALIBRAND ENG. CULVER CITY, CALIF. and 4340201 for the mark HALIBRAND be cancelled.

RICHARD J. LEJUERRNE JR. (KS #17867)
3735 SW Wanamaker, Ste. A.
Topeka, KS 66610
Telephone: (785) 817-3925

/Richard J. LeJuerrne Jr./

RICHARD J. LEJUERRNE JR.
Attorney for Petitioner
Halibrand Performance Corporation, Inc.

DATED: February 14, 2014

CERTIFICATE OF MAILING

I hereby certify that copies of this filing have been sent using the United States Postal Service with sufficient postage as Priority Mail in envelopes addressed to the Respondent and his attorney at the following addresses:

Jonathan Durham
P.O. Box 4372
Culver City, CA
90231

Kenneth Lynch
6994 El Camino Real, Suite 204
Carlsbad, CA
92009

FEE: Pursuant to 37 CFR 2.6(a)(16), a required fee of \$600.00 is being made simultaneously with the filing of this petition.