

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

IN THE MATTER OF REGISTRATION NO. 2,785,313
REGISTERED ON NOVEMBER 25, 2003

Doug Hainstock,
an Australian Citizen

PROCEEDING NO.: _____

Plaintiff,

v.

IBEX, INC.,
a Japanese corporation

Defendant.

PETITION FOR CANCELLATION

Plaintiff, Doug Hainstock, an individual and Australian citizen, with an address of 247 West Mt. Cotton Rd., Cornubia, Queensland, Australia 4130, believes that he will be damaged by registration of the mark shown in U.S. Registration No. 2,785,313 (“the Registration”), in the name of IBEX, Inc. (“Defendant”), and hereby petitions to cancel the same pursuant to Section 14(3) of the Trademark Act of 1946, as amended. As grounds for cancellation, it is alleged that:

1. Plaintiff is an individual and Australian citizen with an address of 247 West Mt. Cotton Rd., Cornubia, Queensland, Australia 4130.
2. Upon information and belief, Defendant is a corporation organized and existing under the laws of Japan with a principal office address of 3F Tokaido Shibuya Building 1-3-9, Shibuya Ku - Tokyo Japan 150-0002.
3. According to the on-line records of the United States Patent and Trademark Office (“the Office”), Defendant is the owner of record of the Registration for the COUNTER CULTURE mark (“Registered Mark”) for use in connection with “[b]ackpacks” in International Class 18

and “[c]lothing; namely, swimwear, shirts, t-shirts, pants, shorts, skirts, dresses, jackets, belts, hats, caps, and visors” in International Class 25 (the “Registered Goods”) issued on the Principal Register on November 25, 2003 and most recently renewed on December 16, 2013. See the attached Exhibit A, which is a current printout of information from the electronic database records of the Office showing the current status and title of the Registration.

4. Plaintiff seeks to register the COUNTER CULTURE mark for use in connection with the following goods: “[c]lothing, footwear and headgear”, by way of U.S. Application Serial No. 88239195, filed with the Office on December 21, 2018 (the “Application”). See the attached Exhibit B, which is a current printout of information from the electronic database records of the Office showing the current status and title of the Application.
5. By Office Action issued by the Office on March 20, 2019, the USPTO examining attorney refused registration to the mark in the Application on grounds of a “likelihood of confusion” with the Registered Mark under Section 2(d) of the Trademark Act.
6. Upon information and belief, use of the Registered Mark has been discontinued in connection with the Registered Goods with an intent not to resume such use.
7. Upon information and belief, there no longer is an active web site associated with the URL, <http://www.counterculture-j.com/>, which may have been the brand site for the Registered Mark.
8. Further, when a user accesses IBEX’s on-line retail store at <http://ibex-j.co.jp/en/shop/>, the Registered Mark is not listed.
9. As a result of Defendant’s failure to use the Registered Mark with an intent not to resume use, the Registered Mark that is the subject of the Registration has become abandoned for purposes of Section 45 of the Trademark Act.

10. If Defendant is allowed to maintain the Registration herein sought to be cancelled, Plaintiff may be refused registration of its mark that is the subject of the Application, thereby causing damage and injury to Plaintiff. As a result, Plaintiff has standing to file this Petition for Cancellation.

WHEREFORE, Plaintiff respectfully requests that the Cancellation be sustained, and that U.S. Registration No. 2,785,313 be ordered canceled.

Dated: June 5, 2019

RESPECTFULLY SUBMITTED,

Doug Hainstock, Plaintiff

/Tracy L. Deutmeyer/
Tracy L. Deutmeyer
Cynthia A. Moyer
Fredrikson & Byron, P.A.
505 E. Grand Avenue, Suite 200
Des Moines, Iowa 50309-1977
515-242-8923 (phone)
ip@fredlaw.com
tdeutmeyer@fredlaw.com
cmoyer@fredlaw.com
ATTORNEYS FOR PLAINTIFF

Exhibit A

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Mark: COUNTER CULTURE

COUNTER CULTURE

US Serial Number: 76143192

Application Filing Date: Oct. 10, 2000

US Registration Number: 2785313

Registration Date: Nov. 25, 2003

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Dec. 16, 2013

Publication Date: Sep. 02, 2003

Mark Information

Mark Literal Elements: COUNTER CULTURE

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 1861878

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Backpacks

International Class(es): 018 - Primary Class

U.S Class(es): 001, 002, 003, 022, 041

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 01, 1991

Use in Commerce: Jul. 01, 1991

For: Clothing; namely, swimwear, shirts, t-shirts, pants, shorts, skirts, dresses, jackets, belts, hats, caps, and visors

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 01, 1991

Use in Commerce: Jul. 01, 1991

Basis Information (Case Level)

Filed Use: Yes
Filed ITU: No
Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently Use: Yes
Currently ITU: No
Currently 44E: No
Currently 66A: No
Currently No Basis: No

Current Owner(s) Information

Owner Name: IBEX, INC.
Owner Address: 3F TOKAIDO SHIBUYA BUILDING 1-3-9
SHIBUYA KU - TOKYO JAPAN 150-0002
Legal Entity Type: CORPORATION
State or Country Where Organized: JAPAN

Attorney/Correspondence Information

Attorney of Record

Attorney Name: DONALD S. GRIER
Attorney Primary Email Address: DSGLAW@MSN.COM
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: DONALD S. GRIER
LAW OFFICE OF DONALD S. GRIER
1800 TIMBER COVE LANE
PRESCOTT, ARIZONA UNITED STATES 86305
Phone: 928-717-2218
Fax: 928-717-0160
Correspondent e-mail: DSGLAW@MSN.COM
Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: DONALD S. GRIER
Phone: 928-717-2218
Domestic Representative e-mail: DSGLAW@MSN.COM
Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Dec. 16, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Dec. 16, 2013	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	69471
Dec. 16, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	69471
Dec. 09, 2013	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	69471
Dec. 16, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	69471
Dec. 09, 2013	TEAS SECTION 8 & 9 RECEIVED	
Dec. 19, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Nov. 25, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	67603
Nov. 25, 2009	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	67603
Nov. 17, 2009	TEAS SECTION 8 & 15 RECEIVED	
Nov. 17, 2009	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Nov. 17, 2009	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Oct. 08, 2008	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Sep. 24, 2008	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jan. 29, 2008	CASE FILE IN TICRS	
Nov. 25, 2003	REGISTERED-PRINCIPAL REGISTER	
Sep. 02, 2003	PUBLISHED FOR OPPOSITION	
Aug. 13, 2003	NOTICE OF PUBLICATION	

Jul. 07, 2003 APPROVED FOR PUB - PRINCIPAL REGISTER
Jun. 09, 2003 CORRESPONDENCE RECEIVED IN LAW OFFICE
Jun. 09, 2003 PAPER RECEIVED
Nov. 21, 2001 LETTER OF SUSPENSION MAILED
Aug. 06, 2001 CORRESPONDENCE RECEIVED IN LAW OFFICE
Apr. 11, 2001 NON-FINAL ACTION MAILED
Apr. 02, 2001 ASSIGNED TO EXAMINER
Mar. 23, 2001 ASSIGNED TO EXAMINER

76851
78432

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Dec. 16, 2013

Assignment Abstract Of Title Information

Summary

Total Assignments: 5

Registrant: CC TRADEMARKS, INC.

Assignment 1 of 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [2841/0404](#)

Pages: 3

Date Recorded: Oct. 07, 2003

Supporting Documents: [assignment-tm-2841-0404.pdf](#)

Assignor

Name: [CC TRADEMARKS, INC.](#)

Execution Date: Oct. 01, 2003

Legal Entity Type: CORPORATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [IPGI INTERNATIONAL, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: CALIFORNIA

Address: 860 VIA DE LA PAZ
SUITE D3C
PACIFIC PALISADES, CALIFORNIA 90272

Correspondent

Correspondent Name: WILLIAM J. SEITER, ESQ.

Correspondent Address: 860 VIA DE LA PAZ
SUITE D3A
PACIFIC PALISAD, CA 90272

Domestic Representative - Not Found

Assignment 2 of 5

Conveyance: SECURITY AGREEMENT

Reel/Frame: [2844/0799](#)

Pages: 6

Date Recorded: Oct. 14, 2003

Supporting Documents: [assignment-tm-2844-0799.pdf](#)

Assignor

Name: [CC TRADEMARKS, INC.](#)

Execution Date: Oct. 01, 2003

Legal Entity Type: CORPORATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [IPGI INTERNATIONAL, INC.](#)

Legal Entity Type: CORPORATION

State or Country No Place Where Organized Found
Where Organized:

Address: 860 VIA DE LA PAZ #D3A
PACIFIC PALISAD, CALIFORNIA 90272

Correspondent

Correspondent Name: WILLIAM J. SEITER

Correspondent Address: 860 VIA DE LA PAZ, SUITE D3C
PACIFIC PALISAD, CA 90272

Domestic Representative - Not Found

Assignment 3 of 5

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [3861/0886](#)

Pages: 3

Date Recorded: Sep. 24, 2008

Supporting Documents: [assignment-tm-3861-0886.pdf](#)

Assignor

Name: [CC TRADEMARKS, INC.](#)

Execution Date: Sep. 01, 2008

Legal Entity Type: CORPORATION

State or Country CALIFORNIA
Where Organized:

Assignee

Name: [IPGI INTERNATIONAL, INC.](#)

Legal Entity Type: CORPORATION

State or Country CALIFORNIA
Where Organized:

Address: 860 VIA DE LA PAZ, #D3A
PACIFIC PALISADES, CALIFORNIA 90272

Correspondent

Correspondent Name: DONALD S. GRIER

Correspondent Address: 1098 PINE COUNTRY COURT
PRESCOTT, ARIZONA 86303

Domestic Representative - Not Found

Assignment 4 of 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [3855/0867](#)

Pages: 3

Date Recorded: Sep. 18, 2008

Supporting Documents: [assignment-tm-3855-0867.pdf](#)

Assignor

Name: [IGPI INTERNATIONAL, INC.](#)

Execution Date: Sep. 15, 2008

Legal Entity Type: CORPORATION

State or Country CALIFORNIA
Where Organized:

Assignee

Name: [IPGI, INC.](#)

Legal Entity Type: CORPORATION

State or Country JAPAN
Where Organized:

Address: F-204 HILLSIDE TERRACE
18-8 SARUGAKU-CHO
SHIBUYA-KU, TOKYO, JAPAN

Correspondent

Correspondent Name: DONALD S. GRIER

Correspondent Address: 1098 PINE COUNTRY COURT
PRESCOTT, AZ 89138

Domestic Representative

Domestic Representative Name: DONALD S. GRIER

Domestic Representative Address: 1098 PINE COUNTRY COURT
PRESCOTT, AZ 86303

Assignment 5 of 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4920/0578](#)

Pages: 3

Date Recorded: Dec. 17, 2012

Supporting Documents: [assignment-tm-4920-0578.pdf](#)

Assignor

Name: [IPGI, INC.](#)

Execution Date: Nov. 27, 2012

Legal Entity Type: CORPORATION

State or Country Where Organized: JAPAN

Assignee

Name: [IBEX, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: JAPAN

Address: 3F TOKAIDO SHIBUYA BUILDING 1-3-9
SHIBUYA KU - TOKYO, JAPAN 150-0002

Correspondent

Correspondent Name: DONALD S. GRIER

Correspondent Address: 1800 TIMBER COVE LANE
PRESCOTT, AZ 86305

Domestic Representative

Domestic Representative Name: DONALD S. GRIER

Domestic Representative Address: 1800 TIMBER COVE
PRESCOTT, AZ 86305

Exhibit B

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Mark: COUNTER CULTURE

COUNTER CULTURE

US Serial Number: 88239195

Application Filing Date: Dec. 21, 2018

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Mar. 20, 2019

Mark Information

Mark Literal Elements: COUNTER CULTURE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Foreign Information

Foreign Registration Number: 1871827

Foreign Registration Date: Aug. 08, 2018

Application/Registration Country: Foreign AUSTRALIA

Foreign Expiration Date: Sep. 07, 2027

Goods and Services

Note:

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- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Clothing, footwear and headgear

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(b) 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: Yes

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: Yes

Currently 44E: Yes

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Doug Hainstock

Owner Address: 247 West Mt Cotton Rd
CORNUBIA, QLD 4130
AUSTRALIA

Legal Entity Type: INDIVIDUAL

Citizenship: AUSTRALIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Tracy L. Deutmeyer

Attorney Primary Email Address: ip@fredlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: TRACY L. DEUTMEYER
FREDRIKSON & BYRON, P.A.
505 E. GRAND AVENUE, SUITE 200
DES MOINES, IOWA 50309-1977
UNITED STATES

Phone: 515-242-8923

Correspondent e-mail: ip@fredlaw.com sbell@fredlaw.com tdeutmeyer@fredlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 20, 2019	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 20, 2019	NON-FINAL ACTION E-MAILED	6325
Mar. 20, 2019	NON-FINAL ACTION WRITTEN	74818
Mar. 17, 2019	ASSIGNED TO EXAMINER	74818
Jan. 15, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Dec. 25, 2018	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: KHAN, ASMAT A

Law Office Assigned: LAW OFFICE 114

File Location

Current Location: TMO LAW OFFICE 114 - EXAMINING ATTORNEY ASSIGNED

Date in Location: Mar. 20, 2019