

ESTTA Tracking number: **ESTTA897908**

Filing date: **05/18/2018**

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	CAO DAI TAY NINH TEMPLES OF TEXAS		
Entity	Corporation	Citizenship	Texas
Address	5535 W Ledbetter Dr Dallas, TX 75236 UNITED STATES		

Attorney information	David C. Voss, Jr. VOSS, SILVERMAN & BRAYBROOKE LLP Marina Towers 4640 Admiralty Way, Suite 800 Marina del Rey, CA 90292 UNITED STATES Email: dave@vsbllp.com Phone: 310.306.0515		
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Registrations Subject to Cancellation

Registration No.	4683061	Registration date	02/03/2015
Registrant	CaoDai Overseas Missionary, Incorporated 10200 Bolsa Avenue, Space 99 Westminster, CA 92683 UNITED STATES		

Goods/Services Subject to Cancellation

Class 045. First Use: 1926/10/07 First Use In Commerce: 1999/03/27 All goods and services in the class are subject to cancellation, namely: Providing a website featuring information about religious belief systems; religious services, namely, prayer meetings and masses; charitable outreach services, namely, providing counseling services in the field of religion; Caodai ministryservices
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)		
The mark is merely descriptive	Trademark Act Sections 14(1) and 2(e)(1)		
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1		
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute	Trademark Act Sections 14(3) and 2(a)		
Disparaging	Trademark Act Sections 14(3) and 2(a)		
Registration No.	4683062	Registration date	02/03/2015

Registrant	CaoDai Overseas Missionary, Incorporated 10200 Bolsa Avenue, Space 99 Westminster, CA 92683 UNITED STATES
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Goods/Services Subject to Cancellation

Class 041. First Use: 1926/10/07 First Use In Commerce: 1946/09/10 All goods and services in the class are subject to cancellation, namely: Organizing and conducting lectures, classes, workshops and seminars about the Caodai religion; educational services, namely, conducting seminars, conferences and workshops in the field of the Caodai religion and distribution of course material in connection therewith
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
The mark is merely descriptive	Trademark Act Sections 14(1) and 2(e)(1)
Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute	Trademark Act Sections 14(3) and 2(a)
Disparaging	Trademark Act Sections 14(3) and 2(a)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DAI DAO TAM KY PHO DO Â# TOA THANH TAY NINH		
Goods/Services	Providing a website featuring information about religious belief systems; religious services, namely, prayer meetings and masses; charitable outreach services, namely, providing counseling services in the field of religion; Caodai ministry services.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DAI DAO TAM KY PHO DO Â# TOA THANH TAY NINH		
Goods/Services	Organizing and conducting lectures, classes, workshops and seminars about the Caodai religion; educational services, namely, conducting seminars, conferences and workshops in the field of the Caodai religion and distribution of course material in connection therewith.		

Attachments	Petition to Cancel Pleading.pdf(110432 bytes)
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Signature	/david c. voss, jr./
Name	David C. Voss, Jr.
Date	05/18/2018

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

<p>In re Registration No. 4683061 for the design plus words, letter and/or numbers mark DAI DAO TAM KY PHO DO TOA THANH TAY NINH in Intl. Cl. 045.</p> <p>In re Registration No. 4683062 for the design plus words, letter and/or numbers mark DAI DAO TAM KY PHO DO TOA THANH TAY NINH in Intl. Cl. 041.</p> <p>CAO DAI TAY NINH TEMPLES OF TEXAS</p> <p>Petitioner,</p> <p>vs.</p> <p>CAODAI OVERSEAS MISSIONARY, INCORPORATED</p> <p>Registrant.</p>	<p>Cancellation No. _____</p> <p>PETITION FOR CANCELLATION</p>
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ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Commissioner:

**PETITION FOR CANCELLATION
OF U.S. REGISTRATION NOS. 4683061 AND 4683062**

1. Petitioner Cao Dai Tay Ninh Temples of Texas, a Texas non-profit corporation, having a place of business at 5535 W Ledbetter Dr, Dallas, TX 75236

(hereinafter “Petitioner”), believes that it has been damaged and will continue to be damaged by the following marks that were registered on the Supplemental Register:

- DAI DAO TAM KY PHO DO TOA THANH TAY NINH (English translation: “THE GREAT WAY OF THE THIRD UNIVERSAL SALVATION TAY NINH HOLY SEE”), U.S. Reg. No. 4683061 (the “‘061 Registration”), registered on February 3, 2015
- DAI DAO TAM KY PHO DO TOA THANH TAY NINH (English translation: “THE GREAT WAY OF THE THIRD UNIVERSAL SALVATION TAY NINH HOLY SEE”), U.S. Reg. No. 4683062 (the “‘062 Registration”), registered on February 3, 2015 (the ‘061 Registration and ‘062 Registration are collectively referred to as the “DAI DAO Marks”).

2. Petitioner was originally incorporated in Texas in 1995 under the name of Cao Dai Charity of Texas. It is a descendant of what is known as the 1926 Cao Dai Religion. Since 1995, it has been using the mark “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” in commerce in conjunction with the operation of a church of the 1926 Cao Dai Religion. In its 1997 By-Laws, Petitioner adopted the entire 1965 Constitution of Cao Dai Religion including its official name "Dai Dao Tam Ky Pho Do." Petitioner has been using the “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” mark as part of its official seal.

3. On information and belief, Caodai Overseas Missionary, Incorporated, a California corporation, having a place of business at 10200 Bolsa Avenue, Space 99, Westminster CA 92683 (hereafter “Registrant”) was incorporated on July 19, 2012.

According to California Secretary of State records, Registrant is currently a suspended entity.

4. Registrant registered: (i) the '061 Registration of the DAI DAO Marks in International Class 045 in connection with "providing a website featuring information about religious belief systems; religious services, namely, prayer meetings and masses; charitable outreach services, namely, providing counseling services in the field of religion; Caodai ministry services;" and (ii) the '062 Registration of the DAI DAO Marks in International Class 041 in connection with "organizing and conducting lectures, classes, workshops and seminars about the Caodai religion; educational services, namely, conducting seminars, conferences and workshops in the field of the Caodai religion and distribution of course material in connection therewith."

5. Petitioner believes that it is being damaged and will continue to be damaged by continued registration of the DAI DAO Marks.

6. Petitioner hereby petitions to cancel the DAI DAO Marks under Section 14 of the Trademark Act of 1947, 15 U.S.C. § 1064, and Section 24 of the Trademark Act of 1947, 15 U.S.C. §1092.

FIRST BASIS FOR CANCELLATION
Mark is Merely Descriptive

7. The TTAB is empowered to order cancellation of registered marks that are "merely descriptive" pursuant to 15 U.S.C. §§ 1052(e)(1), 1064.

8. The DAI DAO Marks in the Subject Registrations merely describes the Cao Dai religion that has been in existence since 1926, and encompasses the marks used by numerous other churches in the U.S. and abroad teaching different versions of the Cao Dai religion, including Petitioner. As noted in *In re Abcor Dev. Corp.*, 588 F.2d 811, 813,

200 USPQ 215, 217 (C.C.P.A. 1978), the major reasons for not protecting such descriptive marks are: (1) to prevent the owner of a mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.

9. On information and belief, Petitioner is and will continue to be damaged by continued registration of the DAI DAO Marks because Petitioner could be prohibited from using the “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” in commerce as it has since 1995.

SECOND BASIS FOR CANCELLATION
Registrant Not Rightful Owner of the Mark for Identified Goods or Services

10. The TTAB is empowered to order cancellation of registered marks if another person “has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake” pursuant to 15 U.S.C. §§ 1051(a)(3)(D), 1064.

11. The DAI DAO Marks in the Subject Registrations has been and is currently being used by Petitioner and numerous churches of the Cao Dai religion that have been in existence since 1926, and encompasses the marks used by numerous other churches in the U.S. and abroad teaching different versions of the Cao Dai religion, including Petitioner.

12. On information and belief, Registrant was aware of the numerous other Cao Dai religion churches using the DAI DAO Marks at the time the ‘061 Application and ‘062 Application were filed.

13. On information and belief, Petitioner is and will continue to be damaged by continued registration of the DAI DAO Marks because Petitioner has been using the “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” mark in commerce since 1995 and has the right to continue to use the mark in commerce.

THIRD BASIS FOR CANCELLATION
Priority and Likelihood of Confusion

14. The TTAB is empowered to order cancellation of registered marks if the mark “consists of or comprises a mark which so resembles ... a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive” pursuant to 15 U.S.C. §§ 1052(d), 1064.

15. Petitioner has been using the mark “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” since 1995, is currently using the mark, and has never abandoned the mark. On information and belief, Registrant was incorporated in 2012 and could not have used the DAI DAO Marks prior to such date, which is seventeen (17) years after Petitioner commenced use of the “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” mark in commerce.

16. Registrant’s use of the DAI DAO Marks is likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Registrant’s goods and services are associated with or approved, endorsed, affiliated, authorized or sponsored by Petitioner.

17. On information and belief, Petitioner is and will continue to be damaged by continued registration of the DAI DAO Marks because Petitioner has been using the mark in commerce since 1995 and has the right to continue to use the mark in commerce.

FOURTH BASIS FOR CANCELLATION
False Suggestion of a Connection with Institutions and Beliefs

18. The TTAB is empowered to order cancellation of registered marks if the mark “[c]onsists of or comprises ... matter which may ... falsely suggest a connection with persons, ...institutions, beliefs” pursuant to 15 U.S.C. §§ 1052(a), 1064.

19. Registrant’s DAI DAO Marks are identical to Petitioner’s “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” mark and Registrant’s DAI DAO Marks would be recognized as such, in that it points uniquely and unmistakably to that Cao Dai religious institution. Petitioner is not connected with the activities performed by the Registrant under the DAI DAO Marks, and the fame or reputation of the institution is such that, when the DAI DAO Marks are used with the Registrant’s goods or services, a connection with Petitioner’s institution would be presumed.

20. The words "Pho Do" are translated into English as “Universal Salvation.” Universality is therefore essential to the religion's doctrine. Any attempt by individuals or groups to trademark the religion's name for their proprietary use is viewed as contradictory to the religion's universality. Cao Dai followers therefore view such action as grossly offensive.

21. On information and belief, Petitioner is and will continue to be damaged by continued registration of the DAI DAO Marks because Petitioner has been using the mark in commerce since 1995 and is not connected with the activities of Registrant.

FIFTH CLAIM FOR RELIEF
Mark Disparages or Brings into Contempt or Disrepute

22. The TTAB is empowered to order cancellation of registered marks if the mark “[c]onsists of or comprises ... matter which may disparage ... institutions, beliefs, ... or bring them into contempt, or disrepute” pursuant to 15 U.S.C. §§ 1052(a), 1064.

23. On information and belief, the 1926 Cao Dai religion is viewed as the original Cao Dai Religion, which Petitioner follows. Registrant’s Cao Dai religion is markedly different from Petitioner’s version of the Cao Dai Religion. Both Petitioner and Registrant are using identical marks, the nature of the goods and services are similar, and both are using the marks in the same provision of religious activities under the Cao Dai Religion. Use of the DAI DAO Marks by Registrant is viewed by followers of the 1926 Cao Dai Religion as disparaging to a substantial composite of the followers of the 1926 Cao Dai Religion.

24. On information and belief, Petitioner is and will continue to be damaged by continued registration of the DAI DAO Marks because Petitioner’s followers are disparaged by Registrant’s use of the DAI DAO Marks.

25. WHEREFORE, based on Petitioner’s prior use of the “DAI DAO TAM KY PHO DO – TOA THANH TAY NINH” mark, and based on the reasons stated above, Petitioner hereby prays that this Petition for Cancellation be sustained and the DAI DAO Marks registrations be cancelled.

26. Petitioner hereby appoints David C. Voss, Jr, a member of the California Bar and licensed to practice before the United States Patent and Trademark Office to transact all business in the USPTO and TTAB in connection with this Cancellation Proceeding. Please address all correspondence to: David C. Voss, Jr., VOSS, SILVERMAN & BRAYBROOKE LLP, Marina Towers, 4640, Admiralty Way, Suite

800, Marina del Rey, CA 90292, Email: dave@vsbllp.com. The filing fee for this petition to cancel, in the amount of \$800.00, is hereby electronically transferred with the submission of this Petition for Cancellation. The undersigned, registered agent and attorney of record for Petitioner herein, states that he is authorized to prosecute this petition for cancellation, that he has read and signed the foregoing PETITION FOR CANCELLATION and knows the contents thereof, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of this Petition for Cancellation and any decision resulting therefrom.

Dated: May 18, 2018.

Respectfully Submitted,

By: /s/ David C. Voss, Jr.
David C. Voss, Jr.

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Attorneys for Petitioner

CERTIFICATE OF TRANSMISSION

I hereby certify that on May 18, 2018, the foregoing PETITION FOR CANCELLATION is being electronically filed with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office.

Dated: May 18, 2018.

Respectfully Submitted,

By: /s/ David C. Voss, Jr.
David C. Voss, Esq.