

ESTTA Tracking number: **ESTTA436889**

Filing date: **10/20/2011**

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	SEACOR Holdings, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2200 Eller Drive P.O. Box 13038 Fort Lauderdale, FL 33316 UNITED STATES		

Attorney information	Elizabeth Goldberg Bryan Cave, LLP 1290 Avenue of the Americas New York, NY 10104 UNITED STATES elizabeth.goldberg@bryancave.com, nyuspto@bryancave.com Phone:212-541-2000
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**Registrations Subject to Cancellation**

Registration No	3868070	Registration date	10/26/2010
Registrant	OAO SOVCOMFLOT BLDG 3A, MOIKA RIVER EMBANKMENT SAINT PETERSBURG, 191186 RUSSIAN FEDERATION		

**Goods/Services Subject to Cancellation**

Class 035. First Use: 2009/01/00 First Use In Commerce: 2009/01/00 All goods and services in the class are cancelled, namely: logistics management in the field of seaborne transportation
Class 037. First Use: 2009/01/00 First Use In Commerce: 2009/01/00 All goods and services in the class are cancelled, namely: maintenance services for maritime transport and/or sea fleets
Class 039. First Use: 2009/01/00 First Use In Commerce: 2009/01/00 All goods and services in the class are cancelled, namely: leasing of ships and seaborne vessels; maritime towage services; providing information in the fields of seaborne transportation and warehousing and storage of goods; vessel and boat chartering services; ship brokerage services; freight transportation services, namely, transporting and delivering the goods and services of others via ships and/or seaborne vessels; warehouse storage services; consulting services in the field of shipping

**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act section 2(d)		
Other	Likely to cause confusion, mistake or deceive under Trademark Act 43(a), 15 U.S.C. 1125(a)		
Registration No	3854379	Registration date	09/28/2010

Registrant	OAO SOVCOMFLOT BLDG 3A, MOIKA RIVER EMBANKMENT SAINT PETERSBURG, 191186 RUSSIAN FEDERATION
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### Goods/Services Subject to Cancellation

Class 035. First Use: 2008/11/00 First Use In Commerce: 2008/11/00 All goods and services in the class are cancelled, namely: logistics management in the field of seaborne transportation
Class 037. First Use: 2008/11/00 First Use In Commerce: 2008/11/00 All goods and services in the class are cancelled, namely: maintenance services for maritime transport and/or sea fleets
Class 039. First Use: 2008/11/00 First Use In Commerce: 2008/11/00 All goods and services in the class are cancelled, namely: leasing of ships and seaborne vessels; maritime towage services; providing information in the fields of seaborne transportation and warehousing and storage of goods; vessel and boat chartering services; ship brokerage services; freight transportation services, namely, transporting and delivering the goods and services of others via ships and/or seaborne vessels; warehouse storage services; consulting services in the field of shipping

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Other	Likely to cause confusion, mistake or deceive under Trademark Act 43(a), 15 U.S.C. 1125(a)		
Registration No	3704538	Registration date	11/03/2009
Registrant	OAO SOVCOMFLOT BLDG 3A, MOIKA RIVER EMBANKMENT SAINT PETERSBURG, 191186 RUSSIAN FEDERATION		

### Goods/Services Subject to Cancellation

Class 035. First Use: 1994/00/00 First Use In Commerce: 1994/00/00 All goods and services in the class are cancelled, namely: logistics management in the field of seaborne transportation
Class 039. First Use: 1994/00/00 First Use In Commerce: 1994/00/00 All goods and services in the class are cancelled, namely: leasing of ships and seaborne vessels; maritime towage services; providing information in the fields of seaborne transportation and warehousing and storage of goods; vessel and boat chartering services; ship brokerage services; freight transportation services, namely, transporting and delivering the goods and services of others via ships and/or seaborne vessels; warehouse storage services; management and maintenance services for maritime transport and/or sea fleets; consulting services in the field of shipping

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Other	Likely to cause confusion, mistake or deceive under Trademark Act 43(a), 15 U.S.C. 1125(a)		
Registration No	3704537	Registration date	11/03/2009
Registrant	OAO SOVCOMFLOT BLDG 3A, MOIKA RIVER EMBANKMENT SAINT PETERSBURG, 191186 RUSSIAN FEDERATION		

## Goods/Services Subject to Cancellation

Class 035. First Use: 1994/00/00 First Use In Commerce: 1994/00/00 All goods and services in the class are cancelled, namely: logistics management in the field of seaborne transportation
Class 039. First Use: 1994/00/00 First Use In Commerce: 1994/00/00 All goods and services in the class are cancelled, namely: leasing of ships and seaborne vessels; maritime towage services; providing information in the fields of seaborne transportation and warehousing and storage of goods; vessel and boat chartering services; ship brokerage services; freight transportation services, namely, transporting and delivering the goods and services of others via ships and/or seaborne vessels; warehouse storage services; management and maintenance services for maritime transport and/or sea fleets; consulting services in the field of shipping

## Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Other	Likely to cause confusion, mistake or deceive under Trademark Act 43(a), 15 U.S.C. 1125(a)		
Registration No	3794150	Registration date	05/25/2010
Registrant	OAO SOVCOMFLOT BLDG 3A, MOIKA RIVER EMBANKMENT SAINT PETERSBURG, 191186 RUSSIAN FEDERATION		

## Goods/Services Subject to Cancellation

Class 035. First Use: 2008/11/00 First Use In Commerce: 2008/11/00 All goods and services in the class are cancelled, namely: logistics management in the field of seaborne transportation
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## Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)		
Other	Likely to cause confusion, mistake or deceive under Trademark Act 43(a), 15 U.S.C. 1125(a)		
Registration No	3794149	Registration date	05/25/2010
Registrant	OAO SOVCOMFLOT BLDG 3A, MOIKA RIVER EMBANKMENT SAINT PETERSBURG, 191186 RUSSIAN FEDERATION		

## Goods/Services Subject to Cancellation

Class 035. First Use: 2008/11/00 First Use In Commerce: 2008/11/00 All goods and services in the class are cancelled, namely: logistics management in the field of seaborne transportation
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Class 037. First Use: 2008/11/00 First Use In Commerce: 2008/11/00  
All goods and services in the class are cancelled, namely: maintenance services for maritime transport and/or sea fleets

Class 039. First Use: 2008/11/00 First Use In Commerce: 2008/11/00  
All goods and services in the class are cancelled, namely: leasing of ships and seaborne vessels; maritime towage services; providing information in the fields of seaborne transportation and warehousing and storage of goods; vessel and boat chartering services; ship brokerage services; freight transportation services, namely, transporting and delivering the goods and services of others via ships and/or seaborne vessels; warehouse storage services; consulting services in the field of shipping

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Likely to cause confusion, mistake or deceive under Trademark Act 43(a), 15 U.S.C. 1125(a)

### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SCF		
Goods/Services	marine vessels, marine shipping, marine transportation and related informational services and logistics, including, without limitation, the owning, leasing and management of marine vessels, and in connection with terminal and terminal support, ship and engine repair facilities, machine shops, towage and fleeting services, real estate holdings and logistic support services		

Attachments	petition.PDF ( 9 pages )(297222 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	/Elizabeth Goldberg/
Name	Elizabeth Goldberg
Date	10/20/2011

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

- 1) In re Registration No. : 3,868,070  
Mark : SCF NOVOSHIP  
Registration Date : October 26, 2010
  
- 2) In re Registration No. : 3,854,379  
Mark : SCF SOVCOMFLOT  
Registration Date : September 28, 2010
  
- 3) In re Registration No.: 3,704,538  
Mark : SCF  
Registration Date : November 3, 2009
  
- 4) In re Registration No. : 3,704,537  
Mark: : SCF  
Registration Date : November 3, 2009
  
- 5) In re Registration No. : 3,794,150  
Mark : SCF  
Registration Date : May 25, 2010
  
- 6) In re Registration No. : 3,794,149  
Mark: : SCF UNICOM  
Registration Date : May 25, 2010

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: SEACOR Holdings, Inc., : Cancellation No.:  
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: Petitioner, :  
: :  
: v. :  
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: Registrant. :  
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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**CONSOLIDATED PETITION TO CANCEL**

Petitioner SEACOR Holdings, Inc. ("Petitioner" or "SEACOR"), having an address at 2200 Eller Drive, P.O. Box 13038, Fort Lauderdale, FL 33316, will be damaged by the continued registration of the following marks by Registrant OAO Sovcomflot ("Registrant" or "OAO"): (i) U.S. Registration No. 3,868,070 for SCF NOVOSHIP; (ii) U.S. Registration No. 3,854,379 for SCF SOVCOMFLOT; (iii) U.S. Registration No. 3,704,538 for SCF; (iv) U.S. Registration No. 3,704,537 for SCF; (v) U.S. Registration No. 3,794,150 for SCF; and (vi) U.S. Registration No. 3,794,149 for SCF UNICOM (collectively the "OAO Registrations"). The OAO Registrations should be cancelled because SEACOR has priority in and to the SCF trademark based on SEACOR's prior adoption and continuous use of its SCF trademark in interstate commerce, for confusingly similar goods and services to those goods and services identified in the OAO Registrations, since at least 1980 - more than 14 years prior to Registrant OAO's claimed date of first use in commerce.

On information and belief, Registrant OAO Sovcomflot is an Open Joint Stock Company organized in the Russian Federation, with an address at Building 3A, Moika River Embankment, Saint Petersburg 191186. The OAO Registrations list the correspondent address as Reed Smith, LLP, 1650 Market Street, 2500 One Liberty Place, Philadelphia PA 19103.

Pursuant to 37 C.F.R. 2.112(b), Petitioner files this singled Consolidated Petition against the OAO Registrations as they are all owned by the same Registrant, they all involve marks containing SCF, and there are common issues of law or fact.

As grounds for cancellation, Petitioner SEACOR respectfully alleges as follows:

**SEACOR'S PRIOR ADOPTION AND CONTINUOUS USE  
IN COMMERCE OF ITS SCF TRADEMARK**

1. SEACOR is a multinational public corporation incorporated in Delaware with over five thousand employees. SEACOR operates a wide range of marine shipping and logistics business lines as described in more detail below, in addition to, *inter alia*, aviation services, environmental services, and commodity trading and logistics business lines.

2. SEACOR is the owner of the trademark SCF in connection with marine vessels, marine shipping, marine transportation and related informational services and logistics (the "Goods and Services").

3. SEACOR has continuously used, and continues to use, its SCF trademark in commerce in connection with the Goods and Services since at least as early as 1980.

4. SEACOR's use of its SCF trademark in commerce in connection with the Goods and Services has been valid and continuous since said date of first use and has not been abandoned.

5. SEACOR, through its predecessors, first used the SCF mark in 1980 and continues to use the mark today through its SCF Marine division.

6. The SCF mark has been used by SEACOR (including through its predecessors) in connection with the Goods and Services, including, without limitation, in connection with the owning, leasing and management of marine vessels, and in connection with

terminals and terminal support, ship and engine repair facilities, machine shops, towage and fleeting services, real estate holdings, and logistics support services since 1980.

7. SEACOR and its SCF divisions have operated, and continue to operate, in numerous states and SEACOR conducts business under the SCF mark, servicing clients on a nationwide basis.

**OAD SOVCOMFLOT'S SCF REGISTRATIONS WITH  
THE U.S. PATENT AND TRADEMARK OFFICE**

8. Registrant OAO has registered six (6) marks incorporating SEACOR's SCF trademark:

- (i) SCF SOVCOMFLOT, U.S. Registration No. 3,854,379, filed on November 4, 2008 and registered on September 28, 2010;
- (ii) SCF, U.S. Registration No. 3,794,150, filed on November 4, 2008 and registered on May 25, 2010;
- (iii) SCF UNICOM, U.S. Registration No. 3,794,149, filed on November 4, 2008 and registered on May 25, 2010;
- (iv) SCF, U.S. Registration No. 3,704,538, filed on December 12, 2008 and registered on November 3, 2009;
- (v) SCF, U.S. Registration No. 3,704,537, filed on December 12, 2008 and registered on November 3, 2009; and
- (vi) SCF NOVOSHIP, U.S. Registration No. 3,868,070, filed on November 3, 2008 and registered on October 26, 2010.

The earliest claimed first use for any of the marks covered by the OAO Registrations identified above is 1994.



9. Specifically, the OAO Registrations identified in subparagraphs 8 (i) through (iii) each claim a first use date of November 2008; the OAO Registrations identified in subparagraphs 8 (iv) and (v) each claim a first use date of 1994; and the OAO Registration identified in subparagraph 8 (vi) claims a first use date of January 2009.

10. All of the OAO Registrations cover “logistics management in the field of seaborne transportation” in International Class 35 and “leasing of ships and seaborne vessels; maritime towage services; providing information in the fields of seaborne transportation and warehousing and storage of goods; vessel and boat chartering services; ship brokerage services; freight transportation services, namely, transporting and delivering the goods and services of others via ships and/or seaborne vessels; warehouse storage services; consulting services in the field of shipping” in International Class 39. In addition, the OAO Registrations identified in subparagraphs 9 (i), (ii), (iii) and (vi) cover “maintenance services for maritime transport and/or sea fleets” in International Class 37.

**SEACOR’S PRIORITY AND RIGHT TO THE SCF MARK**

11. SEACOR’s first adoption and use of its SCF mark in about 1980 precedes by fourteen (14) years the alleged first use by OAO of the earliest adopted mark identified in the OAO Registrations in 1994, as claimed by OAO in the OAO Registrations.

12. As the senior and prior user of the SCF mark in interstate commerce in connection with the Goods and Services, SEACOR has a valid and legal right to continue to use and register its SCF mark.

13. The parties’ respective goods and services are closely related.

14. SEACOR's SCF mark and the marks identified in the OAO Registrations are either identical or virtually identical as the term SCF comprises the exclusive or dominant portion of the OAO Registrations.

15. As a result of SEACOR's prior and continuous use of the SCF Mark in interstate commerce, SEACOR's SCF mark has become well-known, valuable and strongly associated with SEACOR's business, and has acquired substantial goodwill in the relevant marketplace.

16. OAO's use of the marks identified in the OAO Registrations as applied to the goods and services set forth in the OAO Registrations for such marks is likely to cause confusion in that consumers are likely to believe that such goods and services are sold in association or affiliation with, or under license from, or are approved, endorsed or sponsored by SEACOR, causing SEACOR damage.

17. Any defect, objection to, or fault found with OAO's goods and services sold under the marks identified in the OAO Registrations would necessarily reflect on and seriously injure the reputation that SEACOR has established for the goods and services offered under its SCF mark.

18. SEACOR is being and will continue to be damaged by the OAO Registrations due to the likelihood of confusion resulting from SEACOR's prior use of, and reputation in, its SCF mark for the Goods and Services.

19. SEACOR, therefore, has a specific and personal interest in the OAO Registrations and in the disposition of this matter, beyond any interest shared by the general public, and consequently has the requisite standing to bring and prosecute this Petition.

20. If OAO is permitted to retain the registrations sought to be canceled, a cloud will be placed on SEACOR's title in and to its SCF mark, 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 SEACOR.

**WHEREFORE**, SEACOR respectfully requests that the instant Petition for cancellation be granted and that the U.S. Trademark Registration Nos. 3,868,070; 3,854,379; 3,704,538; 3,704,537; 3,794,150; and 3,794,149 be **CANCELLED**.

SEACOR encloses herewith the required filing fee for a petition for cancellation of \$4,800 for four marks in three classes and an additional two marks in two classes (for a total of six marks), which accompanies this consolidated Petition.

SEACOR hereby appoints Erik W. Kahn, Elizabeth J. Goldberg and Pou-I "Bonnie" Lee, all attorneys and members of the bar of the State of New York, Bryan Cave LLP, with law offices at 1290 Avenue of the Americas, New York, New York 10104, (212) 541-2000, to act as attorneys for SEACOR herein, with full power to prosecute said Petition, to transact all relevant business with the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board and in the United States Courts and to receive all official communications in connection with this Petition.

Dated: New York, New York  
October 20, 2011

Respectfully submitted,

By:

\_\_\_\_\_  
Erik W. Kahn  
Bryan Cave, LLP  
1290 Avenue of the Americas  
New York, New York 10104  
212-541-2000

Attorneys for  
SEACOR Holdings, Inc.

**AFFIDAVIT OF SERVICE**

STATE OF NEW YORK    )  
                                  ) S.S.:  
COUNTY OF NEW YORK )

1.     I, **ELIZABETH GOLDBERG** being duly sworn depose and say that I am not a party to this action, I am over 18 years of age and I reside in Brooklyn, New York.

2. On October 20, 2011, I served the foregoing PETITION FOR CANCELLATION upon the attorney for the Applicant

William J. McNichol, Jr., Esq.  
Reed Smith LLP  
2500 One Liberty Place  
1650 Market Street  
Philadelphia PA 19103

by depositing same, enclosed in a first class postpaid properly addressed wrapper, into an official depository under the exclusive care and custody of the United States Postal Service within New York State

\_\_\_\_\_  
Elizabeth Goldberg`

Sworn to before me this 20<sup>th</sup>  
day of October, 2011.

\_\_\_\_\_  
Notary Public

**JENNIFER L. POMPER**  
Notary Public, State Of New York  
No. 01PO5081963  
Qualified In Suffolk County  
Certificate Filed In New York County  
Commission Expires June 17, 2011