

ESTTA Tracking number: **ESTTA845086**

Filing date: **09/11/2017**

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	APPLE INC.		
Entity	Corporation	Citizenship	California
Address	1 Infinite Loop Cupertino, CA 95014 UNITED STATES		

Attorney information	Dale Cendali, Esq. Kirkland & Ellis LLP 601 Lexington Avenue New York, NY 10022 UNITED STATES Email: dale.cendali@kirkland.com, mary.mazzello@kirkland.com, trademarks@kirkland.com Phone: (212) 446-4800
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### Registration Subject to Cancellation

Registration No.	4712559	Registration date	03/31/2015
Registrant	EMONSTER K.K. 1-1-39 HIROO SHIBUYA-KU EBISU PRIME SQUARE TOWER 1F MBE-310 TOKYO, 150-0012 JAPAN		

### Goods/Services Subject to Cancellation

Class 009. First Use: 2014/07/22 First Use In Commerce: 2014/07/22 All goods and services in the class are subject to cancellation, namely: Computer application software for mobile and cellular phones and handheld computers, namely, software for use in animating, processing, and transmitting images
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### Grounds for Cancellation

Registrant not rightful owner of mark for identified goods or services	Trademark Act Sections 14(1) and 1
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Attachments	ANIMOJI petition to cancel U.S. registration Apple v emonster.pdf(31365 bytes ) ANIMOJI RN 4712559 Petition to Cancel Exhibit A.pdf(84473 bytes ) ANIMOJI RN 4712559 Petition to Cancel Exhibit B.pdf(67164 bytes )
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	ANIMOJI RN 4712559 Petition to Cancel Exhibit C.pdf(150523 bytes )
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Signature	/Dale Cendali/
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Name	Dale Cendali
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Date	09/11/2017
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration of EMONSTER K.K.

Mark: ANIMOJI  
Reg. No.: 4,712,559

APPLE INC.	:	
	:	
	:	
Petitioner,	:	
	:	
v.	:	CANCELLATION NO. _____
	:	
EMONSTER K.K.	:	
	:	
Registrant.	:	

PETITION FOR CANCELLATION

EMONSTER K.K., a company organized under the laws of Japan, with an address at 1-1-39 Hiroo Shibuya-ku, Ebisu Prime Square Tower 1F MBE-310, Tokyo Japan 150-0012 (“Registrant”), is listed in the records of the U.S. Patent and Trademark Office (“USPTO”) as the registrant of U.S. Registration No. 4,712,559 (the “Registration”) of ANIMOJI (the “Mark”), issued on March 31, 2015, for “computer application software for mobile and cellular phones and handheld computers, namely, software for use in animating, processing, and transmitting images” in International Class 9.

APPLE INC., a California corporation with an address at 1 Infinite Loop, Cupertino, California 95014 (“Apple”), believes it will be damaged by the continued registration of the Mark and, through its authorized attorneys, hereby petitions to cancel the Registration.

The grounds for cancellation are as follows:

**COUNT I**  
**THE REGISTRATION IS VOID *AB INITIO***

1. Apple is the world-famous designer, producer, and marketer of consumer electronics, computer software, and other products, including the enormously successful iPhone device, which helped popularize the use of “emoji” designs in electronic messaging.

2. Apple seeks to cancel the Registration under Section 1 of the Trademark Act because the Registration is void *ab initio* as the applicant for the Mark did not, and could not, own the Mark at the time it filed the application.

3. On August 20, 2014 (the “Filing Date”), an entity identified as EMONSTER, INC., a Washington corporation, filed application Serial No. 86/372,709 (the “EMONSTER Application”) to register the Mark with the USPTO. The EMONSTER Application was filed under Section 1(a) of the Trademark Act for the goods “computer application software for mobile and cellular phones and handheld computers, namely, software for use in animating, processing, and transmitting images” in Class 9. The EMONSTER Application was signed by Enrique Bonansea, who was identified as the President of EMONSTER, INC.

4. The Registration issued to EMONSTER, INC. on March 31, 2015 (the “Registration Date”).

5. On information and belief, EMONSTER, INC. was incorporated under the laws of the State of Washington on or around July 19, 1999, and Mr. Bonansea was identified as the governor of EMONSTER, INC. A screenshot of the Washington Secretary of State Corporations Division’s records relating to EMONSTER, INC. is attached as **Exhibit A**.

6. On information and belief, EMONSTER, INC.’s corporate charter expired on or around July 31, 2004, and EMONSTER, INC. was dissolved on November 1, 2004. *See* Exhibit A.

7. On November 1, 2004, the Secretary of State of the State of Washington issued a Certificate of Administrative Dissolution of EMONSTER, INC. A copy of the Certificate of Administrative Dissolution is attached as **Exhibit B**.

8. Washington state corporate records have no listing of an entity organized under the laws of the State of Washington with the name EMONSTER, INC. that was in existence as of the Filing Date.

9. On information and belief, EMONSTER, INC. did not exist as of the Filing Date.

10. On information and belief, EMONSTER, INC. did not own the Mark as of the Filing Date.

11. 37 CFR § 2.17 provides that “[a]n application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”

12. The EMONSTER Application was void on account of the fact that EMONSTER, INC. did not exist as of the Filing Date, and therefore did not own the Mark as of the Filing Date.

13. The subsequent attempted assignment of the Mark from EMONSTER, INC. to Registrant does not rectify this fatal flaw.

14. On August 24, 2017, an Assignment dated August 22, 2017 and signed by Enrique Bonansea as President of EMONSTER, INC. on August 23, 2017 was submitted to the USPTO. The Assignment asserts that EMONSTER, INC. is the owner of the Mark and purports to convey to Registrant all of its right, title, and interest in and to the Mark and the Registration (the “Assignment”). A copy of the Assignment is attached as **Exhibit C**.

15. Washington state corporate records have no listing of an entity organized under the laws of the State of Washington with the name EMONSTER, INC., which was in existence when the Assignment was executed.

16. On information and belief, EMONSTER, INC. did not exist as of the Registration Date. Nor did it exist as of the date when the Assignment was executed. On information and belief, it has not existed at any time since November 1, 2004.

17. EMONSTER, INC., thus, did not own the Mark or the Registration as of the date when the Assignment was executed.

18. The Assignment, therefore, was invalid because EMONSTER, INC. did not exist as of the date when the Assignment was executed and was incapable of conveying anything to Registrant. Because the Assignment was invalid, Registrant is not the owner of the Registration.

19. The Registration creates a legal presumption that Registrant has valid and exclusive rights in the Mark for goods identified in the Registration.

20. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration creates.

21. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Apple's intended use of the term "animoji." The Registration, thus, is causing injury and damage to Apple.

**COUNT II**  
**FRAUD ON THE U.S. PATENT AND TRADEMARK OFFICE**

22. Apple seeks to cancel the Registration on the ground that it was obtained as a result of knowingly false statements about the ownership and use of the Mark, which were made with the intent to deceive the USPTO and constitute fraud on the USPTO.

23. EMONSTER, INC. did not exist as of the Filing Date because it was dissolved on or around November 1, 2004. However, in the EMONSTER Application, EMONSTER, INC. falsely claimed to be the owner of the Mark. Consequently, the EMONSTER Application was fraudulent and the Registration is invalid.

24. In the EMONSTER Application, EMONSTER, INC. claimed that the Mark was first used by the applicant or the applicant's related company, licensee, or predecessor in interest at least as early as July 22, 2014, and first used in commerce at least as early as July 22, 2014, and was in use in such commerce as of the filing date.

25. The EMONSTER Application was signed by Enrique Bonansea, who held himself out as the President of EMONSTER, INC. Mr. Bonansea's signature is preceded by the following declaration:

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

26. As of the alleged date of first use of July 22, 2014, EMONSTER, INC. did not exist.

27. As of the Filing Date, EMONSTER, INC. did not exist and, accordingly, had never used the Mark in commerce in connection with any of the goods identified in the Registration.

28. In the EMONSTER Application, EMONSTER, INC. did not allege or submit any documentary evidence of any related companies or licensees.

29. Thus, as of the Filing Date, neither EMONSTER, INC. nor any related companies or licensees were making use in commerce (as that term is defined in Section 45 of the Trademark Act, 15 U.S.C. § 1127) of the Mark as a mark on any of the goods identified in the Registration.

30. Further, Enrique Bonansea knew EMONSTER, Inc. did not exist and was not using the Mark in commerce as of July 22, 2014 or the Filing Date.

31. As shown in Exhibits A and B, Washington state Secretary of State records list the address of EMONSTER, INC. as “c/o Enrique E. Bonansea.”

32. As shown in Exhibit B, the Secretary of State of the State of Washington mailed Enrique Bonansea a copy of the Certificate of Administrative Dissolution stating that EMONSTER, INC. was dissolved as of November 1, 2004.

33. Enrique Bonansea’s sworn declaration stating that “the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant” was false. This false declaration was made knowingly and with the intent to deceive the USPTO for the purpose of obtaining the Registration.



34. Enrique Bonansea's sworn declaration acknowledges that willful false statements jeopardize the validity of the Registration.

35. The USPTO accepted Enrique Bonansea's sworn declaration and approved the EMONSTER Application for publication, which is a prerequisite to registration. Accordingly, the declaration was material.

36. Enrique Bonansea's sworn declaration was knowingly false, made with the intent to deceive the USPTO and was material to the USPTO's decision to issue the Registration. As a result the Registration is invalid because it was procured through fraud on the USPTO.

37. In addition to the declaration, Mr. Bonansea committed a second act of fraud in executing the Assignment and submitting it to the USPTO.

38. As shown in Exhibit C, on August 23, 2017, Enrique Bonansea signed the Assignment, which purports to convey to Registrant the right, title, and interest of the non-existent entity EMONSTER, INC. in and to the Mark and the Registration.

39. The statement in the Assignment that the non-existent entity EMONSTER, INC. is the owner of the Mark is false. Mr. Bonansea knowingly made this statement with the intent to deceive for the purpose of attempting to maintain the fraudulently procured Registration.

40. The Registration creates a legal presumption that the Registrant has valid and exclusive rights in the Mark for goods identified in the Registration.

41. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration creates.

42. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Apple's intended use of the term "animoji." The Registration, thus, is causing injury and damage to Apple.

WHEREFORE, Apple prays that Registration No. 4,712,559 be canceled.

Respectfully submitted,

Dated: September 11, 2017

*Counsel for Petitioner  
Apple Inc.*

/Dale Cendali/  
Dale Cendali, Esq.  
Kirkland & Ellis LLP  
601 Lexington Avenue  
New York, NY 10022  
Telephone: (212) 446-4800  
Email: dale.cendali@kirkland.com

**Certificate of Service**

I hereby certify that, on September 11, 2017, a true and correct copy of the foregoing Petition for Cancellation has been duly served by sending such copy by email to Adam L.K. Philipp (adam@aeonlaw.com) and Susan L. Stuart (susi@aeonlaw.com) of Aeon Law, PLLC, 506 2<sup>nd</sup> Avenue, Suite 3000, Seattle, Washington 98104.

\_\_\_\_\_/Dale Cendali/

# **EXHIBIT A**

**EMONSTER, INC.**

UBI Number	601968473
Category	REG
Profit/Nonprofit	Profit
Active/Inactive	Inactive
State Of Incorporation	WA
WA Filing Date	07/19/1999
Expiration Date	07/31/2004
Inactive Date	11/01/2004
Duration	Perpetual
<b>Registered Agent Information</b>	
Agent Name	ENRIQUE E BONANSEA
Address	1311 NE 70TH ST PO BOX 51094
City	SEATTLE
State	WA
ZIP	981151094

Governing Persons (as defined in RCW 23.95.105 (12) (<http://app.leg.wa.gov/RCW/sup/default.aspx?cite=23.95.105>))

Title	Name
Governor	BONANSEA , ENRIQUE E

# **EXHIBIT B**

UNITED STATES OF AMERICA

The State of



Washington

Secretary of State

I, **Kim Wyman**, Secretary of State of the State of Washington and custodian of its seal, hereby issue this certificate that the attached is a true and correct copy of

CERTIFICATE OF ADMINISTRATIVE DISSOLUTION

of

EMONSTER, INC.

as filed in this office on November 1, 2004.

Date: August 17, 2017



Given under my hand and the Seal of the State of Washington at Olympia, the State Capital

A handwritten signature in black ink that reads "Kim Wyman".

Kim Wyman, Secretary of State

STATE of WASHINGTON



SECRETARY of STATE

Corporation Name:

EMONSTER, INC.  
c/o ENRIQUE E BONANSEA  
1311 NE 70TH ST  
PO BOX 51094  
SEATTLE WA 98115-1094

U.B.I. Number:  
601 968 473

## CERTIFICATE OF ADMINISTRATIVE DISSOLUTION

In accordance with RCW 23B.14.210, the above corporation is hereby administratively  
dissolved as of November 01, 2004.

This action was taken due to the failure of the corporation to file an annual list of  
officers/license renewal within the time set forth by law.

A copy of this certificate is on file in this office:

Corporations Division  
Office of the Secretary of State  
PO Box 40234  
Olympia, Washington 98504-0234  
(360) 753-7115

*Given under my hand and the seal of the State  
of Washington at Olympia, the State Capital.*

Sam Reed, Secretary of State



# **EXHIBIT C**

## TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1  
Stylesheet Version v1.2

ETAS ID: TM440642

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT		
<b>NATURE OF CONVEYANCE:</b>	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
<b>CONVEYING PARTY DATA</b>			
<b>Name</b>	<b>Formerly</b>	<b>Execution Date</b>	<b>Entity Type</b>
EMONSTER, INC.		08/23/2017	Corporation: WASHINGTON
<b>RECEIVING PARTY DATA</b>			
<b>Name:</b>	emonster k.k.		
<b>Street Address:</b>	1-1-39 Hiroo Shibuya-ku		
<b>Internal Address:</b>	Ebisu Prime Square Tower 1F MBE-310		
<b>City:</b>	Tokyo		
<b>State/Country:</b>	JAPAN		
<b>Postal Code:</b>	150-0012		
<b>Entity Type:</b>	Kabushiki Kaisha (K.K.): JAPAN		
<b>PROPERTY NUMBERS Total: 1</b>			
<b>Property Type</b>	<b>Number</b>	<b>Word Mark</b>	
<b>Registration Number:</b>	4712559	ANIMOJI	
<b>CORRESPONDENCE DATA</b>			
<b>Fax Number:</b>	2062172200		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
<b>Phone:</b>	206-217-2200		
<b>Email:</b>	trademarks@aeonlaw.com		
<b>Correspondent Name:</b>	Susan L. Stuart		
<b>Address Line 1:</b>	506 2nd Avenue, Suite 3000		
<b>Address Line 4:</b>	Seattle, WASHINGTON 98104		
<b>NAME OF SUBMITTER:</b>	Susan L. Stuart		
<b>SIGNATURE:</b>	/Susan L. Stuart/		
<b>DATE SIGNED:</b>	08/24/2017		
<b>Total Attachments: 3</b>			
source=SIGNED TM Assignment EMON#page1.tif			
source=SIGNED TM Assignment EMON#page2.tif			
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OP \$40.00 4712559

<b>A S S I G N M E N T</b>
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This Agreement is entered into between the following parties on the 22nd day of August, 2017:

**ASSIGNOR(S):** EMONSTER, INC.

**Located at:** 4616 25th. Ave. NE PMB #247  
Seattle, Washington 98105  
UNITED STATES

**ASSIGNEE:** emonster k.k.

**Located at:** 〒150-0012 Japan  
1-1-39 Hiroo Shibuya-ku, Tokyo  
Ebisu Prime Square Tower  
1F MBE-310  
JAPAN

### **I. Summary**

The Assignor is the owner of the Trademarks, Service Marks, Trade Dress and/or domain names (“Trademarks”), and the goodwill of the business relating to computer application software for mobile and cellular phones and handheld computers, namely, software for use in animating, processing, and transmitting images (“Products”) upon which the Trademarks are used and for which they are registered (“Goodwill”) for the following:

Mark: ANIMOJI  
Serial No.: 86372709  
Filing Date: Aug. 20, 2014  
Reg. No.: 4712559  
Reg. Date: Mar. 31, 2015

The Assignor desires to convey, transfer, assign and deliver to the Assignee all of its right title, and interest in and to the Trademarks, along with the Goodwill.

In consideration for the mutual promises, covenants, and Agreements made below, the parties, intending to be legally bound, agree as follows:

### **II. Assignment**

The Assignor hereby conveys, transfers, assigns and delivers to the Assignee all of its right, title, and interest in and to the Trademarks, together with (1) the Goodwill; (2) all income, royalties, and damages that become due or payable to the Assignor with respect to the Trademarks, including damages and payments for past or future infringements and misappropriations of the Trademarks; and (3) all rights to sue for past, present and future infringements and misappropriations of the Trademarks; in the United States and its territories, and/or in any other country, region, or other territory in which the Trademarks are used and Goodwill exists.

The Assignor further warrants that no share, interest, Assignment or other right to the Trademarks has been transferred, assigned or granted to any other party except as disclosed to the Assignee in the Assignment.

The Assignor further conveys, transfers, assigns, delivers, and contributes to the Assignee all rights in the Trade Dress, labels and designs associated with the Trademarks.

The Assignee further covenants that it will execute all documents, papers, forms, and authorizations and take all other actions that may be necessary for securing, completing or vesting in the Assignee full right, title and interest in the Trademarks.

### **III. General Provisions**

The terms and conditions of this Assignment of Trademark Rights shall be binding on and will inure to the benefit of Assignee, its successors, assigns, heirs devisees, legatees, executors, administrators, trustees, and other legal representatives and will be binding upon Assignor, its successors, assigns, and other legal representatives.

No waiver, amendment, or modification, including those by custom, usage of trade, or course of dealing, of any provision of this Assignment will be effective unless in writing and signed by the party against whom such shall waiver, amendment or modification is sought to be enforced. No waiver by any party of any default in performance by the other party under this Assignment or of any breach of series o breaches by the other party of any of the terms or conditions of this Assignment shall constitute a waiver of any subsequent default in performance under this Assignment or any subsequent breach of any terms or conditions of that Assignment. Performance of any obligation required of a party under this Assignment maybe waived only by a written waiver signed by a duly authorized officer of the other party, that waiver shall be effective only with respect to the specific obligation described in that waiver.

If any provision of this Assignment is found invalid or unenforceable under judicial decree or decision, the remainder shall remain valid and enforceable according to its terms. Without limiting the previously, it is expressly understood and agreed that each and every provision of this Assignment that provides for a limitation of liability, disclaimer of warranties, or exclusion of damages is intended by the parties to be severable and independent of any other provision and to be enforced as such. Further, it is expressly understood and agreed that if any remedy under this Assignment is determined to have failed of its purpose, all other limitations of liability and exclusion of damages set forth in this section shall remain in full force and effect.

Understood, Agreed, and Accepted:

We have carefully reviewed this contract and agree to and accept its terms and conditions. We are executing this Assignment as the Effective Date first written above.

**EMONSTER, INC.**

Aug. 23, 2017  
Date



\_\_\_\_\_  
Enrique Bonansea  
President