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7 Attorneys for Defendant/Counterclaimant
YOMEGA CORP. and Defendant TOYS “R” US – DELAWARE, INC.,
8 erroneously sued as TOYS “R” US, INC.

9 **UNITED STATES DISTRICT COURT**
10 **EASTERN DISTRICT OF CALIFORNIA**

11 HELLS ANGELS MOTORCYCLE
12 CORPORATION,

13 Plaintiff,

14 vs.

15 YOMEGA CORPORATION;
16 TOYS “R” US, INC.; and
DOES 1 through 20,

17 Defendants.

Case No. 2:12-cv-02541-MCE-AC

**COUNTERCLAIM FOR
CANCELLATION OF
TRADEMARK REGISTRATIONS**

DEMAND FOR JURY TRIAL

18
19 YOMEGA CORPORATION,

20 Counterclaimant,

21 vs.

22 HELLS ANGELS MOTORCYCLE
CORPORATION, and
23 ROES 1 through 10.

24 Counter-Defendant.

25 Counterclaimant Yomega Corp. (Yomega”) as and for its Counterclaim in
26 this action against Plaintiff/Counter-Defendant Hells Angeles Motorcycle
27 Corporation (“Hells Angels”), alleges and avers as follows:
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JURISDICTION

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2 1. This is an action for cancellation of a federal trademark registration
3 under the laws of the United States. This Court has jurisdiction pursuant to
4 15 U.S.C. §§ 1119 and 1121(a) and 28 U.S.C. §§ 1331 and 1338(a) in that this
5 case arises under the laws of the United States pursuant to the Lanham Act,
6 15 U.S.C. §§ 1051 *et seq.*

7 2. Venue is proper in this judicial district under 28 U.S.C. § 1391(b)(c)
8 because, on information and belief, Hells Angels does substantial business in and is
9 subject to personal jurisdiction in this judicial district.

10 3. Yomega is a corporation organized and existing under the laws of the
11 State of Massachusetts with offices at 1950 Fall River Avenue, Seekonk,
12 Massachusetts, 02771. Yomega is a manufacturer and seller of yo-yos.

13 4. Hells Angels is, on information and belief, a corporation organized and
14 existing under the laws of the State of California and the registrant of record for the
15 following trademark registrations: HAMC Death Head design mark, Registration
16 No. 3,311,550 and HAMC Death Head design mark, Registration No. 3,666,916.

17 5. Yomega hereby counterclaims seeking the cancellation of
18 (1) Registration No. 3,311,550 issued to Hells Angels for the HAMC Death Head
19 design mark; and (2) Registration No. 3,666,916 issued to Hells Angels for the
20 mark HAMC Death Head design.

FIRST CLAIM FOR RELIEF

Cancellation of Registration No. 3,311,550 pursuant to 15 U.S.C. 1064

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23 6. Hells Angels is registrant of record for the HAMC Death Head design
24 mark, Registration, No. 3,311,550.

25 7. Yomega is informed and believes, and on that basis alleges, that
26 Hells Angels obtained registration of the HAMC Death Head design mark,
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1 Registration, No. 3,311,550, for use in connection with the following goods and
2 services: Clocks, pins and rings.

3 8. Yomega is informed and believes, and on that basis alleges, that
4 Registration No. 3,311,550 was obtained fraudulently in that the formal application
5 papers filed by Hells Angels contained Hells Angels' affirmative statement that
6 Hells Angels had a good-faith intent to use the HAMC Death Head design mark,
7 Registration No. 3,311,550 in connection with the goods and services listed in
8 Paragraph 7 herein. Yomega is informed and believes, and on that basis alleges,
9 that Hells Angels has not ever used, does not presently use, or never planned to use
10 the HAMC Death Head design mark, Registration, No. 3,311,550 in connection
11 with all of the goods and services identified in Paragraph 7 herein. Said statement
12 was made of an authorized agent of Hells Angels with the knowledge and belief
13 said statement was false. Said false statement was made with the intent to induce
14 authorized agents of the United States Patent and Trademark Office to grant said
15 registration, and, reasonably relying on the truth of said false statements, the
16 United States Patent and Trademark Office did, in fact, grant such registration.

17 9. Registration No. 3,311,550 was obtained fraudulently in that the
18 formal application papers filed by Hells Angels included a signed declaration that
19 Hells Angels had the bona fide intent to use the HAMC Death Head design mark,
20 Registration, No. 3,311,550 mark in commerce in the U.S. in connection with the
21 goods and services included in the initial designation.

22 10. Said statement was made by an authorized agent of Hells Angels with
23 the intent to induce agents of the United States Patent and Trademark Office to
24 grant said initial designation, and reasonably relying upon the truth of said false
25 statement, the United States Patent and Trademark Office did, in fact, grant such
26 initial designation.

1 11. Hells Angels' representations to the United States Patent and
2 Trademark Office were false.

3 12. Hells Angels knew that the representations were false.

4 13. Hells Angels knowingly made a material misrepresentation to the
5 United States Patent and Trademark Office to procure registration for its
6 HAMC Death Head design mark, Registration, No. 3,311,550.

7 14. Hells Angels intended to deceive the United States Patent and
8 Trademark Office.

9 15. The United States Patent and Trademark relied on the representations
10 when issuing a registration for Hells Angels' HAMC Death Head design mark,
11 Registration, No. 3,311,550.

12 16. The Trademark Office would not have registered Hells Angels'
13 HAMC Death Head design mark, Registration, No. 3,311,550 but for the
14 misrepresentations.

15 17. Hells Angels' actions in the filing of its application to register the
16 HAMC Death Head design mark, Registration, No. 3,311,550 constitute fraud
17 *ab initio*, thereby invalidating Hells Angels' registration for the HAMC Death Head
18 design mark, Registration, No. 3,311,550. Accordingly, Hells Angels' registration
19 for the HAMC Death Head design mark, Registration, No. 3,311,550 should be
20 struck from the register in its entirety.

21 18. Upon information and belief, to the extent there was any use of the
22 HAMC Death Head design mark, Registration, No. 3,311,550 in connection with
23 the sale of the goods and services identified in Paragraph 7 herein, Hells Angels'
24 nonuse of the HAMC Death Head design mark, Registration, No. 3,311,550 with
25 the intent not to resume use has resulted in abandonment of the HAMC Death Head
26 design mark, Registration, No. 3,311,550.

1 19. Upon information and belief, to the extent there was any use of the
2 HAMC Death Head design mark, Registration, No. 3,311,550 in connection with
3 the sale of the goods and services identified in Paragraph 7 herein, Hells Angels
4 course of conduct has caused the mark to lose significance as an indication of
5 source.

6 20. In light of the foregoing allegation, Hells Angeles' HAMC Death Head
7 design mark, Registration, No. 3,311,550, is invalid and should be cancelled.

8 21. In light of the foregoing allegations, Yomega believes that it is being
9 damaged seriously and irreparably by the continuance of the HAMC Death Head
10 design mark, Registration, No. 3,311,550, as Hells Angels is attempting to use this
11 mark to impair Yomega's ability to sell its products.

12 **SECOND CLAIM FOR RELIEF**

13 **Cancellation of Registration No. 3,666,916 pursuant to 15 U.S.C. 1064**

14 22. Hells Angels is the registrant of record for the HAMC Death Head
15 design mark, Registration No. 3,666,916.

16 23. Yomega is informed and believes, and on that basis alleges, that
17 Hells Angels obtained registration of the HAMC Death Head design mark,
18 Registration No. 3,666,916, for use in connection with the following goods and
19 services:

20 Jewelry, jewelry pins, clocks, and watches, earrings, key rings made
21 of precious metal, badges made of precious metal, and chains made
22 of precious metal, books, booklets and newspapers concerning
23 motorcycle clubs, posters, calendars and adhesive labels, shirts,
24 t-shirts, pullovers, jackets, sweaters, sweat pants, trousers, vests, caps
25 with visors, headwear and footwear, belt buckles, ornamental novelty
26 badges, ornamental cloth patches and embroidered patches for
27 clothing, , entertainment services, namely, arranging and conducting
28 concerts, parties, rallies and special events.

1 24. Yomega is informed and believes, and on that basis alleges, that
2 Registration No. 3,666,916 was obtained fraudulently in that the formal application
3 papers filed by Hells Angels contained Hells Angels' affirmative statement that
4 Hells Angels had a good faith intent to use the HAMC Death Head design mark,
5 Registration No. 3,666,916 in connection with the goods listed in Paragraph 23
6 herein. Yomega is informed and believes, and on that basis alleges, that
7 Hells Angels has not ever used, does not presently use, or never planned to use the
8 HAMC Death Head design mark, Registration No. 3,666,916 in connection with all
9 of the goods identified in Paragraph 23 herein. Said statement was made of an
10 authorized agent of Hells Angels with the knowledge and belief said statement was
11 false. Said false statement was made with the intent to induce authorized agents of
12 the United States Patent and Trademark Office to grant said registration, and,
13 reasonably relying on the truth of said false statements, the United States Patent and
14 Trademark Office did, in fact, grant such registration.

15 25. Registration No. 3,666,916 was obtained fraudulently in that the
16 formal application papers filed by Hells Angels included a signed declaration that
17 Hells Angels had the bona fide intent to use the HAMC Death Head design mark,
18 Registration No. 3,666,916 in commerce in the U.S. in connection with the goods
19 and services included in the initial designation.

20 26. Said statement was made by an authorized agent of Hells Angels with
21 the intent to induce agents of the United States Patent and Trademark Office to
22 grant said initial designation, and reasonably relying upon the truth of said false
23 statement, the United States Patent and Trademark Office did, in fact, grant such
24 initial designation.

25 27. Hells Angels' representations to the United States Patent and
26 Trademark Office were false.

27 28. Hells Angels knew that the representations were false.
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1 29. Hells Angels knowingly made a material misrepresentation to the
2 United States Patent and Trademark Office to procure registration for Hells Angels'
3 HAMC Death Head design mark, Registration No. 3,666,916.

4 30. Hells Angels intended to deceive the United States Patent and
5 Trademark Office.

6 31. The United States Patent and Trademark relied on the representations
7 when issuing a registration for Hells Angels' HAMC Death Head design mark,
8 Registration No. 3,666,916.

9 32. The Trademark Office would not have registered Hells Angels'
10 HAMC Death Head design mark, Registration No. 3,666,916 but for the
11 misrepresentations.

12 33. Hells Angels' actions in the filing of its application to register the
13 HAMC Death Head design mark, Registration No. 3,666,916 constitute fraud
14 *ab initio*, thereby invalidating Hells Angels' registration for the HAMC Death Head
15 design mark, Registration No. 3,666,916. Accordingly, Hells Angels' registration
16 for the HAMC Death Head design mark, Registration No. 3,666,916 should be
17 struck from the register in its entirety.

18 34. Upon information and belief, to the extent there was any use of the
19 HAMC Death Head design mark, Registration No. 3,666,916 in connection with
20 the sale of the goods and services identified in Paragraph 23 herein, Hells Angels'
21 nonuse of the HAMC Death Head design mark, Registration No. 3,666,916 with the
22 intent not to resume use has resulted in abandonment of the HAMC Death Head
23 design mark, Registration No. 3,666,916.

24 35. Upon information and belief, to the extent there was any use of the
25 HAMC Death Head design mark, Registration No. 3,666,916 in connection with
26 the sale of the goods and services identified in Paragraph 23 herein, Hells Angels'
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1 course of conduct has caused the mark to lose significance as an indication of
2 source.

3 36. In light of the foregoing allegation, Hells Angeles' HAMC Death Head
4 design mark, Registration No. 3,666,916 is invalid and should be cancelled.

5 37. In light of the foregoing allegations, Yomega believes that it is being
6 damaged seriously and irreparably by the continuance of the HAMC Death Head
7 design mark, Registration No. 3,666,916, as Hells Angels is attempting to use this
8 mark to impair Yomega's ability to sell its products.

9 **THIRD CLAIM FOR RELIEF**

10 **Cancellation of Registration No. 3,666,916 based on Fraud in the Procurement**

11 38. Hells Angels is the registrant of record for the HAMC Death Head
12 design mark, Registration No. 3,666,916.

13 39. Yomega is informed and believes, and on that basis alleges, that
14 Hells Angels obtained registration of the HAMC Death Head design mark,
15 Registration No. 3,666,916, for use in connection with the following goods and
16 services:

17 Jewelry, jewelry pins, clocks, and watches, earrings, key rings made
18 of precious metal, badges made of precious metal, and chains made
19 of precious metal, books, booklets and newspapers concerning
20 motorcycle clubs, posters, calendars and adhesive labels, shirts,
21 t-shirts, pullovers, jackets, sweaters, sweat pants, trousers, vests, caps
22 with visors, headwear and footwear, belt buckles, ornamental novelty
23 badges, ornamental cloth patches and embroidered patches for
clothing, , entertainment services, namely, arranging and conducting
concerts, parties, rallies and special events.

24 40. Hells Angels filed a Madrid Protocol trademark application and it was
25 assigned No. 0971198. The basis for the Madrid Protocol application was a
26 Community Trademark Application. The Madrid Protocol application designed a
27 U.S. trademark application, which was assigned Serial No. 79056457.

1 The U.S. application matured to a United States Trademark Registration,
2 No. 3666916. When filing the Madrid Protocol application based on a Community
3 Trademark application, Hells Angels declared that it (i) was domiciled in the
4 European Union, (ii) was a national of the European Union or (iii) had a real and
5 effective industrial or commercial establishment with the European Union. At the
6 time of such declaration, Hells Angels was not domiciled in the European Union,
7 was not a national of the European Union and did not have a real or effective
8 industrial or commercial establishment with the European Union. Hells Angels
9 fraudulently misrepresented itself to procure a Madrid Protocol registration, and
10 subsequent U.S. trademark registration.

11 41. Said statement was made by an authorized agent of Hells Angels with
12 the intent to induce agents of the United States Patent and Trademark Office to
13 grant said initial designation, and reasonably relying upon the truth of said false
14 statement, the United States Patent and Trademark Office did, in fact, grant such
15 initial designation.

16 42. Hells Angels' representations to the United States Patent and
17 Trademark Office were false.

18 43. Hells Angels knew that the representations were false.

19 44. Hells Angels knowingly made a material misrepresentation to procure
20 registration for Hells Angels' HAMC Death Head design mark, Registration
21 No. 3,666,916.

22 45. Hells Angels intended to deceive the European Community and the
23 United States Patent and Trademark Office.

24 46. The United States Patent and Trademark relied on the representations
25 when issuing a registration for Hells Angels' HAMC Death Head design mark,
26 Registration No. 3,666,916.

1 47. The Trademark Office would not have registered Hells Angels'
2 HAMC Death Head design mark, Registration No. 3,666,916 but for the
3 misrepresentations.

4 48. Hells Angels' actions in the filing of its application to register the
5 HAMC Death Head design mark, Registration No. 3,666,916 constitute fraud in the
6 procurement, thereby invalidating Hells Angels' registration for the HAMC Death
7 Head design mark, Registration No. 3,666,916. Accordingly, Hells Angels'
8 registration for the HAMC Death Head design mark, Registration No. 3,666,916
9 should be struck from the register in its entirety.

10 49. In light of the foregoing allegation, Hells Angeles' HAMC Death Head
11 design mark, Registration No. 3,666,916 is invalid and should be cancelled.

12 50. In light of the foregoing allegations, Yomega believes that it is being
13 damaged seriously and irreparably by the continuance of the HAMC Death Head
14 design mark, Registration No. 3,666,916, as Hells Angels is attempting to use this
15 mark to impair Yomega's ability to sell its products.

16 **PRAYER FOR RELIEF**

17 WHEREFORE, Yomega prays for judgment against Hells Angels as follows:

- 18 1. For an order cancelling U.S. Trademark Registration No. 3,311,550;
- 19 2. For an order cancelling U.S. Trademark Registration No. 3,666,916;
- 20 3. For its reasonable attorneys' fees;
- 21 4. For its costs of suit incurred herein; and
- 22 5. For such other relief as this Court deems just and proper.

23 DATED: December 27, 2012

BUCHALTER NEMER
A Professional Corporation

24
25 By: /s/
26 MATTHEW L. SEROR
27 Attorneys for Defendant/Counterclaimant
28 YOMEGA CORP. and Defendant
TOYS "R" US – DELAWARE, INC.,
erroneously sued as TOYS "R" US, INC.

