

ESTTA Tracking number: **ESTTA125970**

Filing date: **02/20/2007**

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	Alloutof, Inc.		
Entity	Corporation	Citizenship	California
Address	P.O. Box 10446 San Bernardino, CA 92423 UNITED STATES		

Attorney information	Michael Cerrati Patel & Alumit, P.C. 16830 Ventura Blvd. Suite 360 Encino, CA 91436 UNITED STATES michael@patelalumit.com, jalumit@patelalumit.com Phone:818-380-1900
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Registration Subject to Cancellation

Registration No	2611100	Registration date	08/27/2002
Registrant	GGW MARKETING, LLC 1005 APOLLO WAY INCLINE VILLAGE, NV 89451 UNITED STATES		
Goods/Services Subject to Cancellation	Class 025. First Use: 1998/01/03 , First Use In Commerce: 1998/01/03 Goods/Services: clothing, namely, T-shirts, boxer shorts, caps and sweatshirts		

Attachments	BANNED FROM TELEVISION Petition to Cancel.pdf (7 pages)(2191159 bytes)
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Signature	/michael cerrati/
Name	Michael Cerrati
Date	02/20/2007

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Alloutof, Inc.,)
)
Petitioner,)
)
)
v.) Cancellation No. _____
) Registration No. 2,611,100
) Mark: BANNED FROM TELEVISION
GGW Marketing, LLC,) Registration Date: August 27, 2002
)
Respondent.)
)
.....)

PETITION TO CANCEL

Petitioner, Alloutof, Inc., a California corporation, located at P.O. Box 10446, San Bernardino, California 92423 ("Petitioner"), hereby petitions to cancel the registration on the Principal Register of BANNED FROM TELEVISION ("Respondent's Mark" or the "BANNED FROM TELEVISION mark") in connection with all of the goods in Int. Class 25 identified in Registration No. 2,611,100 ("Respondent's Registration"), registered on August 27, 2002, and owned by GGW Marketing, LLC ("Respondent"). Petitioner's applications were refused registration because of Respondent's Registration due to a likelihood of confusion. Respondent's Registration is less than five years (5) old, is not incontestable and is subject to cancellation under Section 2(d) of the Trademark Act as Petitioner has prior rights in a similar mark.

As grounds in support of its Petition to Cancel, Petitioner asserts as follows:

1. On information and belief, Respondent is a limited liability company with a principle place of business at 1005 Apollo Way, Incline Village, Nevada 89451.

2. On September 28, 1998, registrant Joseph Francis filed Application No. 75/560,825 based on Section 1(a) alleging use of the BANNED FROM TELEVISION mark in connection with "clothing, namely, t-shirts, boxer shorts, caps and sweatshirts" in Int. Class 25.

3. On August 27, 2002, the U.S. Patent and Trademark Office issued Registration No. 2,611,100 for BANNED FROM TELEVISION in connection with "clothing, namely, t-shirts, boxer shorts, caps and sweatshirts" in Int. Class 25. The BANNED FROM TELEVISION mark has a constructive use date in commerce of January 3, 1998.

4. On November 21, 2002, registrant Joseph Francis assigned the BANNED FROM TELEVISION mark to Mantra Films, Inc., a California corporation with a principle place of business at 1601 Cloverfield Blvd., Suite 420 South, Santa Monica, California 90404. On November 17, 2003, Mantra Films, Inc. assigned the BANNED FROM TELEVISION mark to Respondent.

5. Since at least as early as November 1992, and continuing to the present, Petitioner has operated retail stores, a mail order service and a wholesale business selling skateboards, snowboards, surfwear, outerwear, shoes and accessories under the distinctive BANNED trademarks, as well as manufacturing and distributing products bearing the BANNED trademarks. In addition, Petitioner has operated a website since January of 1996 for the purpose of advertising, selling and distributing products bearing the BANNED trademarks.

6. Petitioner has filed to register the following trademarks with the U.S. Patent and Trademark Office (collectively, the "BANNED Applications" and also, collectively, the "BANNED Marks"):

(a) BANNED (in standard characters), Application No. 78/822,188 filed on February 23, 2006 in connection with "beanies; pants; shirts; sweat shirts; t-shirts" in Int. Class 25;

(b) BANNED and Design, Application No. 78/827,750 filed on March 2, 2006 in connection with "beanies; pants; shirts; sweat shirts; t-shirts" in Int. Class 25;

(c) BANNED (in standard characters), Application No. 78/827,792 filed on March 2, 2006 in connection with "catalog ordering service featuring clothing, apparel, skateboards, surf boards, snowboards, backpack, sunglasses, watches, soap, drinking water, gift cards, skateboarding video, surfing video, snowboarding video, covers for portable and handheld digital electronic devices, sock, shoes, beanie; On-line retail store services featuring clothing, apparel, skateboards, surf boards, snowboards, backpack, sunglasses, watches, soap, drinking water, gift cards, skateboarding video, surfing video, snowboarding video, covers for portable and handheld digital electronic devices, sock, shoes, beanie; Retail shops featuring clothing, apparel, skateboards, surf boards, snowboards, backpack, sunglasses, watches, soap, drinking water, gift cards, skateboarding video, surfing video, snowboarding video, covers for portable and handheld digital electronic devices, sock, shoes, beanie" in Int. Class 35; and

(d) BANNED and Design, Application No. 78/827,739 filed on March 2, 2006 in connection with "catalog ordering service featuring clothing, apparel, skateboards, surf boards, snowboards, backpack, sunglasses, watches, soap, drinking

water, gift cards, skateboarding video, surfing video, snowboarding video, covers for portable and handheld digital electronic devices, sock, shoes, beanie; On-line retail store services featuring clothing, apparel, skateboards, surf boards, snowboards, backpack, sunglasses, watches, soap, drinking water, gift cards, skateboarding video, surfing video, snowboarding video, covers for portable and handheld digital electronic devices, sock, shoes, beanie; Retail shops featuring clothing, apparel, skateboards, surf boards, snowboards, backpack, sunglasses, watches, soap, drinking water, gift cards, skateboarding video, surfing video, snowboarding video, covers for portable and handheld digital electronic devices, sock, shoes, beanie” in Int. Class 35.

7. Petitioner has achieved widespread and substantial sales of goods under the BANNED Marks and marks incorporating the term BANNED. Petitioner’s BANNED Marks are recognized and relied upon by the public as identifying Petitioner’s goods and services, and as distinguishing them from those of competitors.

8. On August 15, 2006, the BANNED Applications were refused registration based on a likelihood of confusion with Respondent’s Mark. Petitioner believes it is harmed by Respondent’s Registration because it prohibits Petitioner from registering the BANNED Marks in connection with the same or related goods and services.

9. Petitioner’s BANNED Marks are similar to Respondent’s Mark because they contain the distinctive phrase “BANNED” used in connection with clothing and other related goods and services, are found in the same or similar marketing channels and appeal to the same or similar consumer base. As such, a likelihood of confusion exists within the meaning of Section 2(d) of the Trademark Act.

10. Petitioner has used the BANNED Marks in connection with Petitioner's goods and services and established common law trademark rights in several states, including that of Respondent as well as the original registrant, long before Respondent's filing date.

11. Petitioner has used the BANNED Marks in connection with Petitioner's goods and services and established common law trademark rights in several states, including that of Respondent as well as the original registrant, long before Respondent's date of first use in commerce.

12. Respondent's Mark is confusingly similar to and so resembles Petitioner's BANNED Marks as to be likely, when applied to Respondent's goods, to cause confusion, mistake and to deceive as to the origin, sponsorship and approval of Respondent's goods and as to the affiliation, connection and association of Respondent and its goods with Petitioner and its goods and services, with consequent injury to Petitioner, to the trade and to the public.

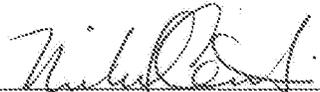
13. By reason of the foregoing, Respondent's Registration should be cancelled pursuant to Section 14 of the Trademark Act.

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained and that Registration No. 2,611,100 be cancelled.

The required fee of three hundred dollars (\$300) is submitted herewith.

Respectfully Submitted,

Dated: February 20, 2007

By 
Michael Cerrati
John Alumit
Patel & Alumit, P.C.
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Encino, CA 91436
(818) 380-1900
Attorneys for Petitioner

PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITION TO CANCEL** has been served on Michael Kerry Burke, Esq., counsel for Respondent on February 20, 2007, via First Class U.S. Mail, postage prepaid to:

Michael Kerry Burke, Esq.
Mantra Films, Inc.
1601 Cloverfield Avenue, Suite 420 South
Santa Monica, CA 90404


Connie Hernandez