

ESTTA Tracking number: **ESTTA281169**

Filing date: **04/30/2009**

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	Harris Publications, Inc.		
Entity	Corporation	Citizenship	New York
Address	1115 Broadway New York, NY 10010 UNITED STATES		

Attorney information	Oliver R. Chernin McLaughlin & Stern, LLP 260 Madison Avenue New York, NY 10016 UNITED STATES ochernin@mclaughlinstern.com Phone:(212) 448-1100
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Registration Subject to Cancellation

Registration No	3123791	Registration date	08/01/2006
International Registration No.	NONE	International Registration Date	NONE
Registrant	AB SAT 132, avenue du PrÃ©sident Wilson F-93210 SAINT DENIS LA PLAINE FRANCE		

Goods/Services Subject to Cancellation

<p>Class 009. All goods and services in the class are cancelled, namely: MAGNETIC, OPTICAL OR DIGITAL DATA MEDIA FEATURING MOTION PICTURE FILMS, TELEVISION PROGRAMS AND VIDEOS IN THE FIELD OF ADULT ENTERTAINMENT; PRE-RECORDED PHONOGRAPH RECORDS, OPTICAL DISCS, VIDEODISCS, CD-ROM's, AUDIO COMPACT DISCS, MULTI-PURPOSE DIGITAL DISCS, DIGITAL VIDEODISCS, VIDEOCASSETTES, ALL CONTAINING MOTION PICTURE FILMS, TELEVISION PROGRAMS AND VIDEOS IN THE FIELD OF ADULT ENTERTAINMENT; COMPUTER HARDWARE MEMORY CARDS OR CHIP CARDS; MAGNETIC CARDS; MAGNETICALLY ENCODED PRE-PAID TELEPHONE CARDS; APPARATUS FOR SPEECH RECORDING, TRANSMITTING AND REPRODUCING DATA, SOUNDS, TEXTS, FIXED AND/OR ANIMATED IMAGES; RADIO AND TELEVISION SETS; EXPOSED CAMERA FILMS</p>
<p>Class 038. All goods and services in the class are cancelled, namely: COMMUNICATIONS SERVICES PROVIDED VIA COMPUTER TERMINALS TO TRANSMIT RADIO, TELEPHONE AND TELEMATIC COMMUNICATIONS VIA ANY DIGITAL NETWORK, CABLE, MICROWAVE NETWORK AND/OR SATELLITE; PROVIDING ACCESS TO TELECOMMUNICATIONS NETWORKS; ELECTRONIC MAIL SERVICES; ELECTRONIC TRANSMISSION OF MESSAGES, IMAGES AND DATA; SERVICES FOR DOWNLOADING FILMS, VIDEOS, MUSIC, TELEVISION PROGRAMS VIA GLOBAL COMPUTER NETWORKS, NAMELY, VIDEO-ON DEMAND TRANSMISSION SERVICES; TRANSMISSION OF FILMS, OF INTERACTIVE PROGRAMS AND MULTIMEDIA PROGRAMS,</p>

RADIO AND TELEVISION PROGRAMS; BROADCASTING OF RADIO AND TELEVISION PROGRAMS, CABLE TELEVISION TRANSMISSION

Class 041.

All goods and services in the class are cancelled, namely: ENTERTAINMENT SERVICES, NAMELY, PRODUCTION OF RADIO AND TELEVISION PROGRAMMING, PUBLISHING BOOKS AND MAGAZINES; LIBRARY SERVICES; PROVIDING INFORMATION ON FILMS, VIDEOS, CINEMA AND TELEVISION PROGRAMMING VIA SATELLITE TELEVISION, CABLE TELEVISION AND GLOBAL COMPUTER NETWORKS; EDITING AND PUBLISHING OF FILMS, VIDEOS, INTERACTIVE TELEVISION PROGRAMS AND MULTIMEDIA PROGRAMS FOR ENTERTAINMENT AND EDUCATIONAL PURPOSES; EDUCATION SERVICES, NAMELY, TRAINING CLASSES IN THE FIELD OF CULTURAL ACTIVITIES IN THE FIELD OF ART, MUSIC, CINEMA AND THEATRE; RENTAL OF FILMS, VIDEO RECORDINGS, SOUND RECORDINGS, OF RADIO AND TELEVISION SETS

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2105347	Application Date	10/10/1996
Registration Date	10/14/1997	Foreign Priority Date	NONE
Word Mark	XXL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1997/03/07 First Use In Commerce: 1997/03/07 magazines published periodically, dealing with hip hop music, and matters relating to the hip hop genre		

U.S. Application No.	77532770	Application Date	07/28/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	XXL		
Design Mark			
Description of Mark	The mark consists of the white letters "XXL" on a red rectangular background.		
Goods/Services	Class 016. First use: First Use: 1997/03/07 First Use In Commerce: 1997/03/07 Magazines featuring hip hop music and matters relating to the hip hop genre		

U.S. Application No.	77534825	Application Date	07/30/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	XXL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1998/06/12 First Use In Commerce: 1998/06/12 Providing on-line publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre		

U.S. Application No.	77534849	Application Date	07/30/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	XXL		
Design Mark			
Description of Mark	The mark consists of the white letters "XXL" on a red rectangular background.		
Goods/Services	Class 041. First use: First Use: 1998/06/12 First Use In Commerce: 1998/06/12 Providing on-line publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre		

Attachments	77532770#TMSN.jpeg (1 page)(bytes) 77534825#TMSN.jpeg (1 page)(bytes) 77534849#TMSN.jpeg (1 page)(bytes) PETITION.pdf (12 pages)(1111110 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	/Oliver R. Chernin/
Name	Oliver R. Chernin
Date	04/30/2009

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

Harris Publications, Inc.	:	
	:	:Registration No.: 3,123,791
Petitioner	:	:Mark: XXL (stylized)
v.	:	:Registered: August 1, 2006
	:	
AB SAT	:	
	:	
Respondent	:	Cancellation No. _____

PETITION FOR CANCELLATION

April 30, 2009

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

Harris Publications, Inc., (hereinafter "Petitioner"), a New York corporation, having a principal place of business at 1115 Broadway, New York, New York 10010, believes that it is or will be damaged by the above-identified Registration No. 3,123,791, registered to AB SAT (hereinafter "Respondent"), upon information and belief, a company organized under the laws of France, having a principal place of business at 132, avenue du Président Wilson, F-93210 Saint Denis La Plaine, France, and hereby petitions to cancel the same.

Description of Respondent's registration: Filed on July 6, 2004 for the mark **XXL (stylized)** under Section 66 of the Trademark Act; registered on August 1, 2006 on the Principal Register in connection with the following goods and services:

International Class 009:

magnetic, optical or digital data media featuring motion picture films, television programs and videos in the field of adult entertainment; pre-recorded phonograph records, optical discs, videodiscs, cd-rom's, audio compact discs, multi-purpose digital

discs, digital videodiscs, videocassettes, all containing motion picture films, television programs and videos in the field of adult entertainment; computer hardware memory cards or chip cards; magnetic cards; magnetically encoded pre-paid telephone cards; apparatus for speech recording, transmitting and reproducing data, sounds, texts, fixed and/or animated images; radio and television sets; exposed camera films

International Class 038:

communications services provided via computer terminals to transmit radio, telephone and telematic communications via any digital network, cable, microwave network and/or satellite; providing access to telecommunications networks; electronic mail services; electronic transmission of messages, images and data; services for downloading films, videos, music, television programs via global computer networks, namely, video-on demand transmission services; transmission of films, of interactive programs and multimedia programs, radio and television programs; broadcasting of radio and television programs, cable television transmission

International Class 041:

entertainment services, namely, production of radio and television programming, publishing books and magazines; library services; providing information on films, videos, cinema and television programming via satellite television, cable television and global computer networks; editing and publishing of films, videos, interactive television programs and multimedia programs for entertainment and educational purposes; education services, namely, training classes in the field of cultural activities in the field of art, music, cinema and theatre; rental of films, video recordings, sound recordings, of radio and television sets

Respondent has not claimed any date of first use first use in commerce of the mark.

As grounds of this Petition, it is alleged that:

1. Petitioner is the owner of U.S. Trademark Registration No. 2,105,347, for the mark **XXL**, on magazines published periodically, dealing with hip hop music, and matters relating to the hip hop genre, which was registered on the Principal Register on October 14, 1997. Said registration was based on an application filed in the U.S. Patent and Trademark Office on October 10, 1996, which is a date prior to the date of filing of Respondent's application. Said registered mark of Petitioner is valid and subsisting and is conclusive

evidence of Petitioner's exclusive right to use said mark in commerce on the goods specified in said registration. In view of the similarity of the respective marks and the related nature of the goods and/or services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's registered mark, as to be likely to cause confusion, or to cause mistake, or to deceive.

2. Petitioner, since March 7, 1997, has been, and is now, using, in commerce, the mark **XXL** in connection with the publication and sale of a magazine featuring hip hop music and matters relating to the hip hop genre. Said use has been valid and continuous since said date of first use and has not been abandoned. Petitioner's said date of first use is a date prior to the date of filing of Respondent's application. Said mark of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the goods and/or services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

3. Petitioner, since March 7, 1997, has been, and is now, using, in commerce, the mark **XXL (stylized)** in connection with the publication and sale of a magazine featuring hip hop music and matters relating to the hip hop genre. Said use has been valid and continuous since said date of first use and has not been abandoned. Petitioner's said date of first use is a date prior to the date of filing of Respondent's application. Said mark of Petitioner is symbolic of extensive good will and consumer recognition built up by

Petitioner through substantial amounts of time and effort in advertising and promotion.

In view of the similarity of the respective marks and the related nature of the goods and/or services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

4. Petitioner, since June 12, 1998, has been, and is now, using, in commerce, the mark **XXL** in connection with providing on-line publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre. Said use has been valid and continuous since said date of first use and has not been abandoned. Petitioner's said date of first use is a date prior to the date of filing of Respondent's application. Said mark of Petitioner is symbolic of extensive good will and consumer recognition built up by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the goods and/or services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

5. Petitioner, since June 12, 1998, has been, and is now, using, in commerce, the mark **XXL (stylized)** in connection with providing on-line publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre. Said use has been valid and continuous since said date of first use and has not been abandoned. Petitioner's said date of first use is a date prior to the date of filing of Respondent's application. Said mark of Petitioner is symbolic of extensive good will and consumer recognition built up

by Petitioner through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the goods and/or services of the respective parties, it is alleged that Respondent's registered mark so resembles Petitioner's mark previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive.

6. Registration No. 3,123,791, the subject of this Petition to Cancel, was filed on July 6, 2004, for the mark **XXL (stylized)** under Section 66 of the Trademark Act. Applicant has not alleged use of its registered in commerce with the United States. Upon information and belief, July 6, 2004, is the earliest date of constructive use on which Respondent can rely.
7. Petitioner's date of first use of **XXL**, in connection with a magazine, predates Respondent's filing date of its registration of **XXL (stylized)** in connection with the goods and services designated in Registration No. 3,123,791, by over seven years, consequently, priority of use belongs to Petitioner.
8. Petitioner's date of first use of **XXL (stylized)**, in connection with a magazine, predates Respondent's filing date of its registration of **XXL (stylized)** in connection with the goods and services designated in Registration No. 3,123,791, by over seven years, consequently, priority of use belongs to Petitioner.
9. Petitioner's date of first use of **XXL**, in connection with on-line publications in the nature of a magazine, predates Respondent's filing date of its registration of **XXL (stylized)** in connection with the goods and services designated in Registration No. 3,123,791, by over six years, consequently, priority of use belongs to Petitioner.

10. Petitioner's date of first use of **XXL (stylized)**, in connection with on-line publications in the nature of a magazine, predates Respondent's filing date of its registration of **XXL (stylized)** in connection with the goods and services designated in Registration No. 3,123,791, by over six years, consequently, priority of use belongs to Petitioner.
11. Petitioner filed an application to register the mark **XXL (stylized)** in the Patent and Trademark Office on July 28, 2008, designating the goods as "magazines featuring hip hop music and matters relating to the hip hop genre", said application having been assigned Serial No. 77/532,770.
12. On November 4, 2008, the Patent and Trademark Office issued an Office Action in connection with Petitioner's application Serial No. 77/532,770, refusing registration under Section 2(d) of the Trademark Act in view of Respondent's mark **XXL (stylized)**, the mark of Registration No. 3,123,791, the subject of this Petition.
13. Petitioner filed an application to register the mark **XXL** in the Patent and Trademark Office on July 30, 2008, designating the services as "providing on-line publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre", said application having been assigned Serial No. 77/534,825.
14. On November 5, 2008, the Patent and Trademark Office issued an Office Action in connection with Petitioner's application Serial No. 77/534,825, refusing registration under Section 2(d) of the Trademark Act in view of Respondent's mark **XXL (stylized)**, the mark of Registration No. 3,123,791, the subject of this Petition.
15. Petitioner filed an application to register the mark **XXL (stylized)** in the Patent and Trademark Office on July 30, 2008, designating the services as "providing on-line

publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre”, said application having been assigned Serial No. 77/534,849.

16. On November 5, 2008, the Patent and Trademark Office issued an Office Action in connection with Petitioner’s application Serial No. 77/534,849, refusing registration under Section 2(d) of the Trademark Act in view of Respondent’s mark **XXL (stylized)**, the mark of Registration No. 3,123,791, the subject of this Petition.
17. Petitioner has expanded use of its mark **XXL** into related product and service areas.
18. Petitioner is the owner of U.S. Trademark Registration No. 3,556,703, for the mark **XXL BLOCK TALK**, in connection with the following services:
 - a. International Class 035: Advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing on-line computer databases and on-line searchable databases featuring classified listings and want ads.
 - b. International Class 038: Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; providing email and instant messaging services Internet broadcasting services for music and entertainment related audio and video content, video clips, video clips, video interviews of entertainment personalities; streaming video and audio material on the Internet.
 - c. International Class 041: Providing a website where users can provide reviews and commentary on entertainment and music
 - d. International Class 042: Computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; and computer services in the nature of customized web pages featuring user defined information, personal profiles and information; providing a website for users to upload, download and share users music files
 - e. International Class 045: Internet based dating, introduction and social networking services

19. Said mark **XXL BLOCK TALK** was registered on the Principal Register on January 6, 2009, the registration is valid and subsisting and is *prima facie* evidence of Petitioner's exclusive right to use said mark in commerce in connection with the services specified in said registration.
20. Petitioner has used, in interstate commerce, the marks **XXL** and **XXL BLOCK TALK** since at least as early as October 2, 2007, in connection with the services set forth in paragraph 18 a-e inclusive, herein.
21. Petitioner has applied to register **XXL** marks based on a *bona fide* intent to use the marks in commerce, in connection with downloadable ring tones, graphics, screen images, pictures, banners, animations, games, software applications that allow messages, information, images, sounds or other data to be sent from and received by digital data storage or communication devices, short message service (SMS), emergency message service (EMS), Mobile TV and multi media messaging service (MMS) alerts or applications, voice cards, voice tones and ring back messages via the internet and wireless devices, as follows:
 - a. An application for the mark **XXL**, filed on July 30, 2008, under Serial No. 77/534,862;
 - b. An application for the mark **XXL (stylized)**, filed on July 25, 2008, under Serial No. 77/531,649; and
 - c. An application for the mark **XXL Mobile**, filed on November 13, 2008, under Serial No. 77/613,674.

22. Petitioner is likely to be damaged by continuance of said Registration No. 3,123,791,
- a. in that Petitioner's legal use of the mark **XXL** on or in connection with a title for a magazine, will be impaired by the continued registration of **XXL (stylized)** granted to Respondent;
 - b. in that Petitioner's legal use of the mark **XXL (stylized)** on or in connection with a title for a magazine, will be impaired by the continued registration of **XXL (stylized)** granted to Respondent;
 - c. in that Petitioner's legal use of the mark **XXL** on or in connection with providing on-line publications in the nature of a magazine, will be impaired by the continued registration of **XXL (stylized)** granted to Respondent;
 - d. in that Petitioner's legal use of the mark **XXL (stylized)** on or in connection with providing on-line publications in the nature of a magazine, will be impaired by the continued registration of **XXL (stylized)** granted to Respondent;
 - e. in that Petitioner will not be able to obtain a registration for its pending application for the mark **XXL (stylized)**, designating the goods as "magazines featuring hip hop music and matters relating to the hip hop genre", that is the subject of Serial No. 77/532,770;
 - f. in that Petitioner will not be able to obtain a registration for its pending application for the mark **XXL** designating the services as "providing on-line publications in the nature of a magazine in the field of hip hop music

and matters relating to the hip hop genre”, that is the subject of Serial No. 77/534,825;

- g. in that Petitioner will not be able to obtain a registration for its pending application for the mark **XXL (stylized)** designating the services as “providing on-line publications in the nature of a magazine in the field of hip hop music and matters relating to the hip hop genre”, that is the subject of Serial No. 77/534,849; and
- h. in that Petitioner will be restrained from expanding use of its mark **XXL** into areas that are areas of natural expansion.

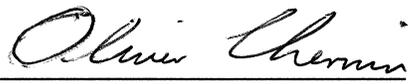
23. By reason of the foregoing, Respondent’s Registration No. 3,123,791 for the mark **XXL (stylized)**, herein petitioned to be canceled, has caused and/or will cause injury and damage to Petitioner and to Petitioner's rights in its trademarks and to the use thereof as described herein.

24. WHEREFORE, Petitioner prays that Registration No. 3,123,791 be canceled and that this Petition for Cancellation be sustained in favor of Petitioner.

Petitioner herein appoints Oliver R. Chernin, Richard E. Halperin and Lauren B. Cramer, each a member of the Bar of the State of New York, whose address is McLaughlin & Stern, LLP, 260 Madison Avenue, New York, NY 10016, its attorneys to prosecute the instant Cancellation Proceeding with full powers of substitution and revocation and to transact all business in the Patent and Trademark Office connected therewith.

Please direct all correspondence to: Oliver R. Chernin, Esq., McLaughlin & Stern, LLP,
260 Madison Avenue, New York, NY 10016, Tel. (212) 448-1100, e-mail
ochernin@mclaughlinstern.com.

Harris Publications, Inc.

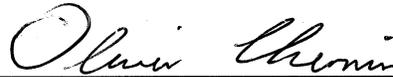
By: 
Oliver R. Chernin
McLaughlin & Stern, LLP
260 Madison Avenue
New York, NY 10016
(212) 448-1100
Attorneys for Petitioner

Dated: April 30, 2009

CERTIFICATE OF SERVICE

I, Oliver R. Chernin, hereby certify that a true and correct copy of the attached PETITION FOR CANCELLATION was mailed by first class mail, postage pre-paid, this 30th day of April, 2009, to registrant AB SAT's designated domestic representative and designated attorney of record, addressed as follows:

Stewart J. Bellus, Esq.
Mary S. Mathew, Esq.
Collard & Roe, P.C.
1077 Northern Blvd.
Roslyn NY 11576



Oliver R. Chernin