

ESTTA Tracking number: **ESTTA297122**

Filing date: **07/23/2009**

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	Carchalk, Inc.		
Entity	Corporation	Citizenship	Texas
Address	P.O. Box 1110 Boerne, TX 78006 UNITED STATES		

Attorney information	Alicia Morris Groos Fulbright & Jaworski L.L.P. 600 Congress Avenue, Suite 2400 Austin, TX 78701 UNITED STATES aotrademark@fulbright.com, cbenson@fulbright.com, agroos@fulbright.com, kpfertner@fulbright.com Phone:512.474.5201		
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Registration Subject to Cancellation

Registration No	2865895	Registration date	07/27/2004
International Registration No.	NONE	International Registration Date	NONE
Registrant	Bluepath Industries Ltd. 15022 - 116 Avenue Edmonton, Alberta, T5M 3T4 CANADA		

Goods/Services Subject to Cancellation

Class 016. All goods and services in the class are cancelled, namely: Non-permanent paint markers
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Grounds for Cancellation

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

U.S. Registration No.	3404397	Application Date	03/01/2007
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	GLASSCHALK		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 002. First use: First Use: 1996/01/20 First Use In Commerce: 1996/03/20 Paints; coatings in the nature of opaque lacquers used on glass, plastic and paper surfaces</p> <p>Class 016. First use: First Use: 1996/01/20 First Use In Commerce: 1996/03/20 Indoor and outdoor temporary paint sponge tip markers; pens; markers</p> <p>Class 020. First use: First Use: 2003/06/01 First Use In Commerce: 2003/06/01 Plastic banners; plastic banner clips; kits comprised of plastic banner, plastic banner clips for hanging banners and pens, sold as a unit</p>

Attachments	77119799#TMSN.jpeg (1 page)(bytes) 20090723155111.pdf (9 pages)(187158 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	/Alicia Morris Groos/
Name	Alicia Morris Groos
Date	07/23/2009

3. Since at least as early as January 20, 1996 and at various other dates, Petitioner has made continuous and extensive use of the GLASSCHALK Mark in connection with Petitioner's Goods. Through Petitioner's use, advertising and promotion of the GLASSCHALK Mark, customers have come to recognize the GLASSCHALK Mark as the exclusive identifier of Petitioner and Petitioner's Goods.

4. Petitioner has sold many millions of dollars of its GLASSCHALK products over the years, and in particular it has sold millions of units of GLASSCHALK markers. Petitioner has grown to be the biggest seller in the market for the type of markers it sells. Petitioner's Goods are distributed across the United States through a variety of channels, including national retail chain or big box stores and via online sales. Petitioner's Goods are highly popular and successful products, and as a result, the GLASSCHALK Mark is well-known to consumers to designate Petitioner's Goods.

5. Through extensive advertising, marketing, and sale of its goods under the GLASSCHALK Mark, Petitioner has built up, at great effort, valuable goodwill symbolized by the GLASSCHALK Mark.

6. As a result of Petitioner's long use and promotion of the GLASSCHALK Mark, Petitioner has acquired valuable common law rights in the GLASSCHALK Mark.

7. The GLASSCHALK Mark is inherently distinctive.

8. Petitioner owns U.S. Trademark Registration No. 3,404,397 for the GLASSCHALK Mark. The registration issued on April 1, 2008 in International Classes 2, 16, and 20. This registration is valid and subsisting. A copy of U.S. Registration No. 3,404,397 is attached as EXHIBIT A. The registration claims use of the GLASSCHALK Mark since at least as early as January 20, 1996 and use in commerce since at least as early as March 20, 1996 for

goods in International Classes 2 and 16. The registration claims use of the GLASSCHALK Mark since at least as early as June 1, 2003 and use in commerce since at least as early as June 1, 2003 for goods in International Class 20.

9. Petitioner's principal and predecessor in interest was also the owner of U.S. Registration No. 2,088,433 for GLASSCHALK for "paint, namely, an opaque coating for glass, plastic, and paper surfaces." The mark was registered on August 12, 1997 and claimed a first use date of January 20, 1996 and first use in commerce date of March 20, 1996. The registration was inadvertently allowed to lapse because the registrant of the mark was acting pro se and did not file the Section 8 Affidavit. The registration was cancelled May 15, 2004. Nevertheless, the GLASSCHALK mark has been in continuous use since 1996.

10. On March 8, 2000, many years after Petitioner first began using the GLASSCHALK mark, Registrant filed U.S. Trademark Application Serial No. 75/938,579 for the mark WINDOW CHALK for "non-permanent paint markers" in International Class 16. That application led to U.S. Registration No. 2,865,895, issued July 27, 2004 (the "'895 Registration").

11. The '895 Registration claims a priority date of December 6, 1999 and an actual filing date of March 8, 2000.

12. The '895 Registration was originally filed on the basis of an intention to use the mark under Section 1(b) and priority based on a foreign application under Section 44(d).

13. The '895 Registration issued on the basis of a foreign registration under Section 44(e). Registrant has claimed no date of first use or date of first use in commerce of the WINDOW CHALK mark.

14. Petitioner's date of first use and date of first use in commerce of the GLASSCHALK Mark for goods in International Classes 2 and 16 long precedes Registrant's priority filing date for the '895 Registration.

15. Petitioner's date of first use and date of first use in commerce of the GLASSCHALK Mark for goods in International Classes 2 and 16 long precedes Registrant's actual application filing date for the '895 Registration.

16. Petitioner's date of first use and date of first use in commerce of the GLASSCHALK Mark for all goods in its Registration No. 3,404,397 long precedes Registrant's registration date for the '895 Registration.

17. Registrant can claim no priority date for its WINDOW CHALK mark which precedes Petitioner's first use date of January 20, 1996 for its GLASSCHALK Mark.

18. Prior to the filing date of Registrant's '895 Registration, Registrant was on constructive notice of the GLASSCHALK Mark by virtue of Registration No. 2,088,433 by Petitioner's principal and predecessor in interest. Registration No. 2,088,433 was valid and subsisting when Registrant filed the application that resulted in the '895 Registration.

19. Registrant's WINDOW CHALK mark is substantially similar and/or virtually identical to Petitioner's GLASSCHALK mark. Both marks end in "CHALK" and start with words that are essentially identical in meaning. "WINDOW" is a synonym of "GLASS." Registrant's WINDOW CHALK mark is substantially similar and/or identical to the GLASSCHALK Mark in appearance, sound, meaning and commercial impression.

20. Registrant's WINDOW CHALK mark is for goods that are substantially similar and/or identical to Petitioner's Goods, particularly Petitioner's Goods in International Class 16, namely, "indoor and outdoor temporary paint sponge-tip markers; pens; markers."

21. Due to the substantially similar and/or identical nature of the products and marks encompassed in the '895 Registration and the GLASSCHALK Mark, customers and prospective customers of the parties are likely to be confused, mistaken, or deceived. Any use and registration of the WINDOW CHALK mark is likely to cause confusion, mistake, or to deceive customers into believing that Registrant's goods under the WINDOW CHALK mark originate from or are in some way sponsored, endorsed, or approved by, or affiliated, connected, or associated with Petitioner or Petitioner's Goods. Cancellation of the '895 Registration is therefore appropriate under 15 U.S.C. § 1052(d).

22. The continued registration of the '895 Registration is especially likely to confuse consumers because the '895 Registration covers highly similar or identical goods—non-permanent markers under Intentional Class 16—to Petitioner's temporary sponge-tip paint markers, pens and markers sold and offered under the GLASSCHALK Mark. Petitioner has used the GLASSCHALK Mark in connection with these goods since at least as early as 1996, well before Registrant filed its application to register WINDOW CHALK or before any priority date the Registrant can claim.

23. Petitioner is not in any way connected with Registrant or any goods offered by Registrant under "WINDOW CHALK."

24. The '895 Registration provides Registrant with at least *prima facie* evidence of its exclusive right to use the mark in connection with the goods listed therein, which is inconsistent with Petitioner's prior rights in the GLASSCHALK Mark. Such Registration is a source of damage and injury to Petitioner.

Petitioner believes that it is being and will continue to be damaged by continued registration of the '895 Registration.

Petitioner requests that this Petition to Cancel be sustained and that the '895 Registration be cancelled in its entirety.

The filing fee in the amount of \$300 as required by 37 C.F.R. § 2.6(a)(16) is submitted. If the amount is insufficient or should an overpayment be included, the Commissioner is authorized to deduct or credit said fees from or to the deposit account of Fulbright & Jaworski L.L.P., Account No.: 50-1212/DANJ:013/AMG.

Respectfully submitted,

Dated: July 23, 2009

By: Alicia Morris Groos
Christopher R. Benson
Alicia Morris Groos
FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(512) 474-5201

ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the PETITION TO CANCEL has been served via First Class Mail to Registrant's attorney of record, correspondent, and domestic representative, at the address below, on this the 23rd day of July, 2009:

Mr. Philip T. Golden
Golden & Associates
P.O. Box 2128
Bellaire, TX 77402-2128

I certify that a true and correct copy of the PETITION TO CANCEL has been sent via First Class Mail to Registrant at the address of record as indicated below, on this the 23rd day of July, 2009:

Bluepath Industries, Ltd.
15022 - 116
Edmonton, Alberta T5M 3 T4
Canada

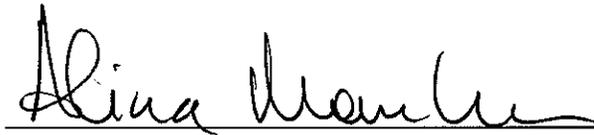


EXHIBIT A

Int. Cls.: 2, 16 and 20

Prior U.S. Cls.: 2, 5, 6, 11, 13, 16, 22, 23, 25, 29, 32, 37,
38 and 50

Reg. No. 3,404,397

Registered Apr. 1, 2008

United States Patent and Trademark Office

**TRADEMARK
PRINCIPAL REGISTER**

GLASSCHALK

CARCHALK, INC. (TEXAS CORPORATION)
P.O. BOX 1110
BOERNE, TX 78006

FOR: PAINTS; COATINGS IN THE NATURE OF
OPAQUE LACQUERS USED ON GLASS, PLASTIC
AND PAPER SURFACES, IN CLASS 2 (U.S. CLS. 6, 11
AND 16).

FIRST USE 1-20-1996; IN COMMERCE 3-20-1996.

FOR: INDOOR AND OUTDOOR TEMPORARY
PAINT SPONGE TIP MARKERS; PENS; MARKERS,
IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 1-20-1996; IN COMMERCE 3-20-1996.

FOR: PLASTIC BANNERS; PLASTIC BANNER
CLIPS; KITS COMPRISED OF PLASTIC BANNER,
PLASTIC BANNER CLIPS FOR HANGING BAN-
NERS AND PENS, SOLD AS A UNIT, IN CLASS 20
(U.S. CLS. 2, 13, 22, 25, 32 AND 50).

FIRST USE 6-1-2003; IN COMMERCE 6-1-2003.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-119,799, FILED 3-1-2007.

PAM WILLIS, EXAMINING ATTORNEY