

ESTTA Tracking number: **ESTTA468262**

Filing date: **04/20/2012**

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	Paramount International Export, Ltd.		
Entity	company limited by shares	Citizenship	Cayman Islands
Address	11444 W. Olympic Blvd. Los Angeles, CA 90064 UNITED STATES		

Attorney information	Danielle Criona Roll Law Group P.C. 11444 W. Olympic Blvd. Los Angeles, CA 90064 UNITED STATES dcriona@roll.com, takerman@roll.com, mrivera@roll.com Phone:(310) 966-8771		
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Registration Subject to Cancellation

Registration No	4089929	Registration date	01/24/2012
Registrant	Rota Germanium Mineral Water, LLC Rota Resort & Country Club P.O. Box 938 Rota, 96951 MP		

Goods/Services Subject to Cancellation

Class 032. First Use: 2010/08/30 First Use In Commerce: 2010/08/30 All goods and services in the class are cancelled, namely: Bottled drinking water containing Germanium
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Grounds for Cancellation

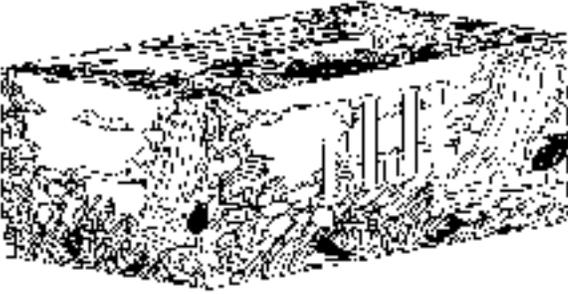
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2703620	Application Date	11/10/2000
Registration Date	04/08/2003	Foreign Priority Date	NONE
Word Mark	FIJI		

Design Mark	FIJI		
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1997/05/16 First Use In Commerce: 1997/05/17 NATURAL, SPRING AND ARTESIAN WATER FOR DRINKING		

U.S. Registration No.	2164851	Application Date	10/29/1996
Registration Date	06/09/1998	Foreign Priority Date	NONE
Word Mark	FIJI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1997/02/15 First Use In Commerce: 1997/06/01 natural, spring, and artesian water for drinking		

U.S. Registration No.	2703802	Application Date	06/19/2001
Registration Date	04/08/2003	Foreign Priority Date	NONE
Word Mark	FIJI		
Design Mark			
Description of Mark	The mark consists of the term "FIJI" and designs of tropical flowers, foliage and waterfalls placed on the packaging for the goods. The actual shape of the container is not claimed as part of the mark and appears in dotted lines.		
Goods/Services	Class 032. First use: First Use: 1997/05/17 First Use In Commerce: 1997/05/17 NATURAL, SPRING AND ARTESIAN WATER FOR DRINKING		

U.S. Registration No.	2714973	Application Date	11/10/2000
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Registration Date	05/13/2003	Foreign Priority Date	NONE
Word Mark	FIJI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1997/05/16 First Use In Commerce: 1997/05/17 NATURAL, SPRING AND ARTESIAN WATER FOR DRINKING		

U.S. Registration No.	3282520	Application Date	09/22/2005
Registration Date	08/21/2007	Foreign Priority Date	NONE
Word Mark	FIJI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 1997/05/17 First Use In Commerce: 1997/05/17 Drinking Water; Natural Artesian Water		

U.S. Registration No.	3285644	Application Date	09/13/2005
Registration Date	08/28/2007	Foreign Priority Date	NONE
Word Mark	FIJI		

Design Mark	
Description of Mark	The mark consists of a label placed on the front of a bottle and a label placed on the back of a bottle. The design on the front label consists of the stylized word FIJI and a stylized rendering of a hibiscus flower surrounded by foliage. The design on the back label consists of palm tree fronds, which faces the interior of the bottle. When the two designs are viewed together from the front, they form a complete scene. The bottle cap and bottle configuration are shown in dotted lines and are not claimed as a part of the mark.
Goods/Services	Class 032. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 drinking water; natural artesian water for drinking

U.S. Registration No.	3385371	Application Date	09/13/2005
Registration Date	02/19/2008	Foreign Priority Date	NONE
Word Mark	FIJI		
Design Mark			
Description of Mark	The mark consists of the word FIJI centered in the top third of the mark, a stylized design of a hibiscus flower surrounded by foliage appears at the bottom right hand part of the mark, and palm tree fronds emanate from the top right hand and the bottom right hand corner of the mark. The word FIJI and the hibiscus flower surrounded by foliage are on the front label of the bottle upon which the mark appears, and the palm tree fronds are on the back label of the bottle which is transparent, causing the two labels to be viewed together as one mark.		
Goods/Services	Class 032. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 Drinking Water; Bottled Natural Artesian Water		

U.S. Registration No.	3381795	Application Date	11/29/2005
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	FIJI		

Design Mark	
Description of Mark	The mark consists of a stylized rendering of palm tree fronds and the word portion of the mark, FIJI.
Goods/Services	Class 032. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 Drinking Water; Bottled Natural Artesian Water

U.S. Registration No.	3282513	Application Date	09/13/2005
Registration Date	08/21/2007	Foreign Priority Date	NONE
Word Mark	FIJI		
Design Mark			
Description of Mark	The mark consists of a stylized rendering of a hibiscus flower surrounded by foilage, above which appears the word portion of the mark, FIJI.		
Goods/Services	Class 032. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 Drinking Water; Natural Artesian Water		

U.S. Registration No.	2911918	Application Date	11/10/2000
Registration Date	12/21/2004	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a configuration of a bottle and cap. The bottle and cap are depicted in solid lines and are part of the mark.
Goods/Services	Class 032. First use: First Use: 1997/05/16 First Use In Commerce: 1997/05/17 NATURAL, SPRING AND ARTESIAN WATER FOR DRINKING

U.S. Registration No.	2286974	Application Date	06/23/1997
Registration Date	10/19/1999	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of designs shown on labels on the front and back of the bottle. The design on the front label consists of tropical flowers and foliage. The design on the back label consists of a waterfall which faces the interior of the bottle. When the designs are viewed together from the front, they form a complete scene. The bottle, cap and labels are depicted in dotted lines to show placement only and are not part of the mark.		
Goods/Services	Class 032. First use: First Use: 1997/05/16 First Use In Commerce: 1997/05/17 natural spring and artesian water for drinking		

Attachments	76162278#TMSN.gif (1 page)(bytes) 76273662#TMSN.gif (1 page)(bytes) 76162280#TMSN.gif (1 page)(bytes) 78718517#TMSN.jpeg (1 page)(bytes) 78712270#TMSN.jpeg (1 page)(bytes) 78712329#TMSN.jpeg (1 page)(bytes) 78762941#TMSN.jpeg (1 page)(bytes) 78712299#TMSN.jpeg (1 page)(bytes) 76162286#TMSN.gif (1 page)(bytes) 75313250#TMSN.gif (1 page)(bytes) Petition to Cancel.pdf (10 pages)(1648020 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	/s/ Danielle M. Criona /s/
Name	Danielle Criona
Date	04/20/2012

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

In the Matter of Registration No. 4,089,929: NATURAL GERMANIUM WATER FROM
ROTA ROTA GERMANIUM WATER FROM ANCIENT VOLCANIC ISLAND & Design
Registration Date: January 24, 2012

PARAMOUNT INTERNATIONAL)
EXPORT, LTD.,)

Petitioner,)

v.)

) Cancellation No. _____

ROTA GERMANIUM MINERAL)
WATER, LLC,)

Registrant.)
_____)

PETITION TO CANCEL

Paramount International Export, Ltd., a company located and doing business at 11444 West Olympic Boulevard, Los Angeles, California 90064, on behalf of itself and its affiliates, related companies and licensees (collectively, “Petitioner”), believes it will be damaged by the maintenance of NATURAL GERMANIUM WATER FROM ROTA ROTA GERMANIUM WATER FROM ANCIENT VOLCANIC ISLAND & Design, Registration No. 4,089,929, (the “Rota Design Registration” or “Rota Design Mark”) in International Class 32 for “bottled water containing Germanium” (“Registrant’s Goods”) owned by Rota Germanium Mineral Water, LLC (“Registrant”) on the Principal Register, and hereby petitions to cancel the same.

As grounds for this cancellation, Petitioner alleges:

1. Since long before the January 9, 2011 priority date in Registrant’s application for

the Rota Design Mark, Petitioner has been extensively marketing, selling and distributing its natural artesian drinking water under the FIJI® mark.

2. Petitioner produces, markets, sells and distributes bottled water products worldwide in connection with its highly distinctive FIJI® brand. Petitioner began bottling, selling and marketing natural artesian mineral water from the Fiji Islands under its FIJI® brand in 1996.

3. Petitioner's use of unique bottle configuration, its distinct color scheme, tropical motif, trademark stylization and transparent "three dimensional" labelling, makes the trade dress created by Petitioner inherently distinctive (the "FIJI Trade Dress"). The elements in the FIJI Trade Dress that make it inherently distinctive include the following:

- a. a bottle design which is clear and transparent to the naked eye;
- b. an outer front label which includes the use of a colorful, tropical motif featuring green tropical foliage in the central portion of the label and bottle (from the consumer's perspective);
- c. an inner back label which includes a depiction of tropical foliage;
- d. prominent use of the four-letter, two-syllable word "FIJI" ; and
- e. a statement on the front label stating it is "From the islands of FIJI®/NATURAL ARTESIAN WATER." Attached hereto as Exhibit A is a true and correct copy of photographs of the FIJI® trademarks and FIJI Trade Dress as used in commerce.

4. With the exception of the addition of the rainwater "drop" on the front label added in 2007, the above-referenced elements of the FIJI Trade Dress have been continuously used in interstate commerce (and worldwide) in connection with Petitioner's bottled water product for many years. In addition to being inherently distinctive, the tropical foliage on the bottle itself, combined with the additional trade dress elements, has acquired a secondary meaning, whereby

the consuming public and those in the trade associate these features with FIJI® as the single source.

5. Petitioner owns and uses numerous trademarks in interstate commerce in connection with its marketing, distribution and sale of artesian water, many of which are registered with the United States Patent and Trademark Office (“USPTO”). Petitioner’s registered trademarks and trade dress are:

- a. the word mark FIJI® for use on natural, spring and artesian water (Registration Nos. 2,703,620 and 2,164,851);
- b. the stylized word mark FIJI® combined with the design of tropical flowers, foliage and water on the packaging of natural, spring and artesian water (Registration Nos. 2,703,802 and 2,714,973);
- c. the stylized mark FIJI® for use on drinking water and natural artesian water (Registration No. 3,282,520);
- d. the design of the stylized word FIJI® and a stylized rendering of a hibiscus flower surrounded by foliage and palm tree fronds for the use on drinking water and natural artesian water for drinking (Registration No. 3,285,644);
- e. the design of the stylized word FIJI® combined with the design of trees, palm tree fronds and flowers for use on drinking water and natural artisan water (Registration No. 3,385,371);
- f. the design of the stylized word FIJI® combined with the design of palm tree fronds, for use on drinking water and natural artisan water (Registration No. 3,381,795);
- g. the design of a hibiscus flower surrounded by foliage, above which appears the stylized word portion of the stylized word FIJI® for use on drinking water and natural artesian water (Registration No. 3,282,513); and
- h. the bottle and cap design for use on natural, spring and artesian water for drinking (Registration Nos. 2,911,918 and 2,286,974). Petitioner also has numerous registered

copyrights in the FIJI bottle labelling

(collectively, the “FIJI® Marks”).

6. Registrant had constructive notice of Petitioner’s rights in its federally registered trademarks under 15 U.S.C. Section 1072 which states “Registration of a mark on the principal register provided by this Act or under the Act of March 3, 1981, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.”

7. FIJI® water is well known and famous. Since 1996, Petitioner has invested approximately \$72 million in the FIJI® brand. FIJI® brand water has become the best selling imported brand of bottled water in the United States, having sold over 1.1 billion bottles of water in just over a decade. Petitioner also has built substantial goodwill in connection with its FIJI® brand in other countries, including, but not limited to, Fiji, Canada and Australia.

8. To date, Petitioner has expended over \$72 million worldwide in the marketing, advertising, sales and promotion of its FIJI® brand water product making it one of the leaders in the worldwide bottled water industry. Of that amount, more than \$65 million was spent in the United States alone.

9. In fact, just in 2008, Petitioner spent over \$17.6 million marketing and promoting FIJI® brand water in the United States.

10. As a result of extensive marketing, sales and promotional efforts, FIJI® brand water is now the number one selling imported brand of bottled water in the United States and has sold nearly 65 million cases of water in over a decade of existence. The United States is by far the leading market for the sale of FIJI® brand water. Of the 1.1 billion bottles of FIJI® sold worldwide since its inception, over 90% (roughly 1 billion bottles) were sold in the United States. The success of Petitioner is due to both the quality, purity and taste of its water, and to

the highly distinctive, innovative and recognizable water bottle and label design.

11. The FIJI® Marks and FIJI Trade Dress on bottled water is widely recognized as an indicator of Petitioners' high-quality bottled water product.

12. Notwithstanding Petitioner's rights in the FIJI® Marks, and with notice of Petitioner's rights, Rota Germanium Mineral Water, LLC filed an application with the USPTO for the Rota Design Mark on or about January 9, 2011 to be used in connection with "bottled drinking water" in International Class 32. The application received serial number 85/213,625.

13. Registrant's Rota Design Mark registered on the Supplemental Register on January 24, 2012 and received U.S. Registration 4,089,929.

14. Registrant's Rota Design Mark is confusingly similar to the FIJI® Marks identified in paragraph 5 above.

15. Petitioners' first use of the FIJI® Marks and the filing dates of the applications identified in paragraph 5 above are earlier than Registrant's filing date of the Rota Design Mark for registration. Additionally, upon information and belief, Petitioners began using the FIJI® Marks and FIJI Trade Dress in commerce prior to Registrant's use of the Rota Design Mark in commerce.

16. The goods offered for sale and sold by Registrant are nearly identical to those of Petitioner, and are sold in identical trade channels and are marketed and sold to identical classes of consumers who purchase bottled water with an identical level of sophistication and impulsivity.

17. Both Registrant and Petitioner's products are sold within the same trade channels. This allows Registrant to capitalize on and the goodwill created by Petitioner and trade on that goodwill.

18. Petitioner is informed and believes, and based thereon alleges, that Registrant uses the inherently distinctive FIJI® Marks in commerce so as to cause a likelihood of confusion between Registrant's infringing product and the FIJI® product, or to cause mistake, or to deceive the relevant public that Registrant's goods or services are authorized, sponsored or approved by or are affiliated with Petitioner.

19. If Registrant is granted the continued registration of the Rota Design Mark as more fully identified by U.S. Registration No. 4,089,929, it would support statutory rights for Registrant in violation and derogation of Petitioner's prior rights which would be a source of damage to Petitioners.

20. By reason of the foregoing, Registrant will be seriously damaged by the continued registration of Registrant's Rota Mark.

COUNT I – LIKELIHOOD OF CONFUSION

21. Petitioner incorporates its allegations of Paragraphs 1 through 20.

22. Registrant's use of the Rota Design Mark incorporating Petitioner's FIJI Trade Dress elements in connection with Registrant's goods is likely to cause confusion, mistake, or deception in that consumers are likely to believe Registrant's Goods are Petitioner's goods or the goods of a person or entity that is sponsored, authorized or licensed by, or in some other way legitimately connected with Petitioner.

COUNT II – DILUTION

23. Petitioner incorporates its allegations of Paragraphs 1 through 20.

24. Prior to Registrant's priority claim date, Petitioner's FIJI® Marks became distinctive and famous in accordance with 15 U.S.C. § 1125(c).

25. Registrant's registration and use of the Rota Design Mark for Registrant's Goods

is likely to cause dilution of Petitioner's famous FIJI® Marks.

WHEREFORE, Petitioner respectfully requests that this petition to cancel be granted and that Registration No. 3,688,578 be canceled.

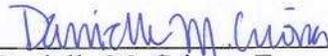
Please debit our Deposit Account No. 502934 for the \$300 filing fee and for any additional necessary fees.

Respectfully Submitted,

Date: April 20, 2012

PARAMOUNT INTERNATIONAL EXPORT,
LTD.

By:



Danielle M. Criona, Esq.

Roll Law Group P.C.

11444 West Olympic Blvd., 10th Floor

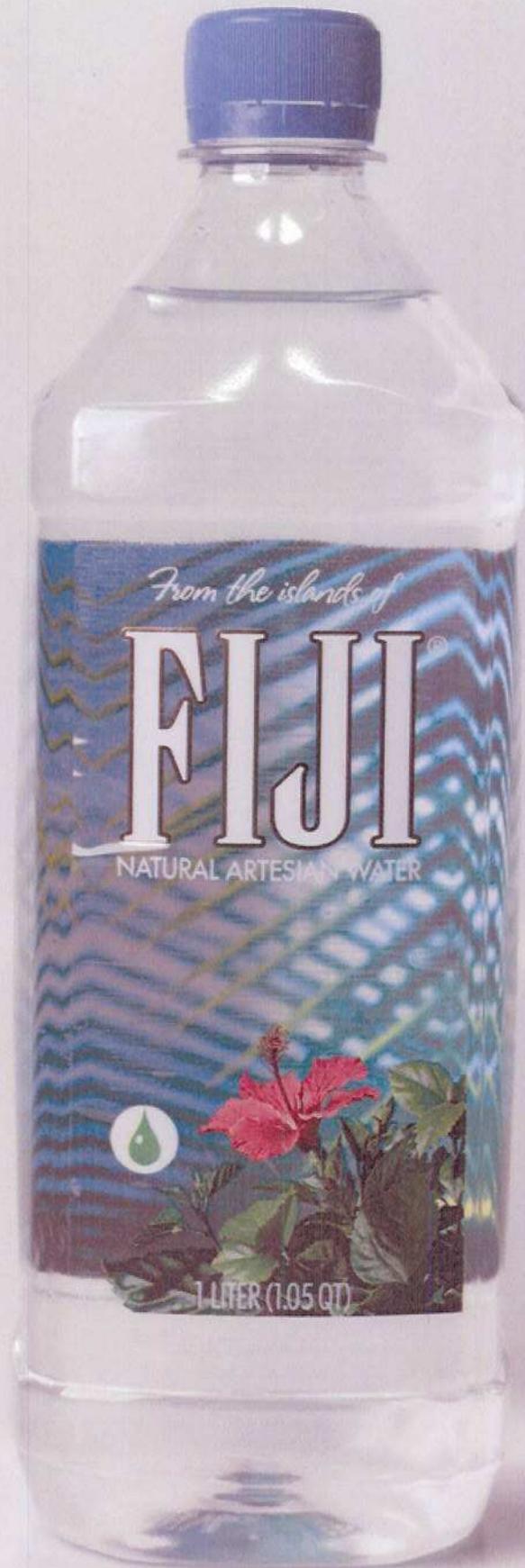
Los Angeles, California 90064

Tel. (310) 966-8771

Fax (310) 966-8810

Attorney for Petitioner

EXHIBIT A



From the islands of

FIJI

NATURAL ARTESIAN WATER



1 LITER (1.05 QT)

CERTIFICATE OF SERVICE

I, Janice Henry, hereby certify that a copy of this PETITION FOR CANCELLATION
has been served upon attorney for Registrant:

Robert T. Torres
LAW OFFICE OF ROBERT T. TORRES
P.O. Box 503758
Planta Drive, Chalan Kiya
Saipan, MP 96950

by first class mail, postage prepaid, on this 20th day of April, 2012.

By: /s/ Janice Henry /s/
Janice Henry
Roll Law Group P.C.
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