

ESTTA Tracking number: **ESTTA571290**

Filing date: **11/18/2013**

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	Labor Savings Systems, Ltd.		
Entity	Limited liability company	Citizenship	Texas
Address	PO Box 13453 Arlington, TX 76094 UNITED STATES		

Attorney information	Wendy Peterson Not Just Patents LLC PO Box 18716 Minneapolis, MN 55418 UNITED STATES wsp@NJPLS.com Phone:6515007590		
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Registration Subject to Cancellation

Registration No	3451113	Registration date	06/17/2008
Registrant	Prime Industrial design 4691 s. Palacio Way Gold Canyon, AZ 85218 AZERBAIJAN		

Goods/Services Subject to Cancellation

Class 009. First Use: 2007/07/31 First Use In Commerce: 2007/07/31 All goods and services in the class are cancelled, namely: A locator utilizing magnets to find a pre-positioned sensor behind a surface to locate an area or objects behind the surface namely, wires, pull string, plumbing or conduit

Grounds for Cancellation

Genericness	Trademark Act section 23
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Attachments	Petition to Cancel XSPOT RN 3451113.pdf(106943 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	/Wendy Peterson/
Name	Wendy Peterson

Date	11/18/2013
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark Registration No 3451113

For the mark “**XSPOT**”

Registered on June 17, 2008

Labor Savings Systems, Ltd.

vs.

Prime Industrial Design

PETITION TO CANCEL

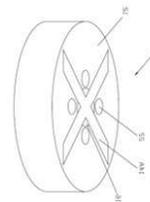
The Petitioner, Labor Savings Systems, Ltd. of PO Box 13453, Arlington, TX 76094, believes that it will continue to be damaged by registration of the mark shown in the above-identified registration, and hereby petitions to cancel the same.

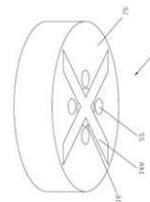
Based upon information and belief, Petitioner avers the following reasons why it will be damaged by the continued registration of the subject mark:

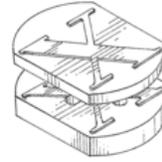
1. This petition is timely under 15 U.S.C. § 1064: A petition to cancel a registered mark may be filed *at any time* if the registered mark becomes the generic name for the goods or services, or a under portion thereof, for which it is registered. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the

test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

2. Petitioner has standing as a competitor of Registrant/Respondent. See TMBP 309.03(b).
Petitioner has designed, manufactured and sold several different instruments used as location devices with a first use in commerce date of June 4, 2007.
3. Petitioner has been in the field of using magnets as a tool and holds many patents in the field of labor saving devices for electricians and technicians wishing to more efficiently pull lines (wires), string, conduit or plumbing including Line Retrieval System US 7156373 with a priority date of April 24, 2003 and an issue date of January 2, 2007.
4. Under Section 1(a) (initially filed under 1(b)) Registrant has registered the word mark XSPOT for IC 009: A locator utilizing magnets to find a pre-positioned sensor behind a surface to locate an area or objects behind the surface namely, wires, pull string, plumbing or conduit with a claimed first use date of July 31, 2007 and a claimed first use in commerce date of July 31, 2007.
5. Registrant has filed a statement of use on March 26, 2008 claiming that the date of first use was July 31, 2007.



6. Registrant has an issued patent (Feb 15, 2011) US 7888927  that claims the subject goods as “a position indicating device and a position locating device.”



USD561051

7. Registrant has an issued (February 8, 2008) design patent that claims the ornamental design of the subject goods as a Two Part Magnetic Sensor which further reinforces that X marks the spot of the sensing of the device.
8. The generic term for Registrant goods are position locators or spot locators.
9. Generic terms are for the use of the public. In this case, because the term XSPOT directly names the most important or central aspect or purpose of certain of Registrant's goods, namely, that the goods are a locator device used to mark the desired spot or location with an X, this term is generic and should be freely available for use by competitors. See, for example, *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970) [CUSTOMBLENDED for gasoline held generic because category of gasoline was blended personally for the motorist]; *In re Helena Rubinstein, Inc.*, 410 F.2d 438, 161 USPQ 606 (CCPA 1969) [PASTEURIZED for face cream held generic]; *In re Central Sprinkler Company*, 49 USPQ2d 1194 (TTAB 1998) [ATTIC for automatic sprinklers for fire protection of attics held generic]; and *In re Reckitt & Colman, North America Inc.*, 18 USPQ2d 1389 (TTAB 1991) [PERMA PRESS for soil and stain removers held generic].
10. The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that genus (category or class) of goods or services? See *In re Reed Elsevier Properties Inc.*, 482 F.3d 1376, 82 USPQ2d 1378, 1380 (Fed. Cir. 2007).
11. The term XSPOT is taken from the well-known idiom "X marks the spot."

12. According to Wikipedia, an X is used to indicate “affirmation (for example in election ballots or in x marks the spot)” and is “also traditionally used on maps to indicate location.”
13. The relevant population, the primary purchaser, realizes that XSPOT means X marks the spot. An article posted on Registrant’s web site is called “X Marks The Spot.” www.xspotproducts.com/.../Xspot_Products_-_CEPro_Editors_Pick.pdf.
14. Registrant assists the purchasing public into reaching the conclusion that X marks the spot and that its goods are spot locators with the ornamental design of the device clearly marked with an X that indicates the desired location, the spot, when the device is in use.
15. Registrant did not make any disclaimers on the application.
16. If either X or SPOT or XSPOT together are determined to be generic, the mark must be cancelled.
17. Evidence from USPTO practice reinforces this generic claim. Evidence shows that it is the prevailing practice to disclaim the word SPOT when used in connection with goods or services dealing with location. Examples include: HOT SPOT KNOLOGY RN 3841228 *Telecommunication services, namely, providing high-speed wireless internet access to end users at specific locations* where HOT SPOT is disclaimed; and MARK



THE SPOT RN 2977128

Golf ball markers, namely, brightly colored

water repellant piece of fabric with a pocket for holding a golf ball or other weight, and used to indicate the location of a played golf ball hit into and lying in the rough after it has been found where MARK THE SPOT is disclaimed (the design portion of the mark is two golf clubs forming an X).

Inasmuch as the continued federal registration for Registrant will harm Petitioner's rights and the public interest in not having generic terms on the register, Petitioner respectfully requests that this registration be cancelled and that the cancellation proceeding is sustained in favor of Petitioner.

Submitted By: /Wendy Peterson /

Date: November 18, 2013

Wendy Peterson, Attorney for Labor Saving Systems, Ltd.
Not Just Patents
PO Box 18716
Minneapolis, MN 55418
wsp@NJPLS.com

CERTIFICATE OF SERVICE

I hereby certify that on November 18, 2013, the foregoing was served upon Registrant by first class mail to:

Prime Industrial Design
4691 S. Palacio Way
Gold Canyon, AZ 85218

Submitted By: /Wendy Peterson/

Date: November 18, 2013

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