

ESTTA Tracking number: **ESTTA594633**

Filing date: **03/25/2014**

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	Electronic Cigarette JUSTFOG Co., Ltd.,		
Entity	Corporation	Citizenship	Republic of Korea
Address	106-2401, 80, Jongam-ro24ga-gil, Seongbuk-gu Seoul, KOREA, REPUBLIC OF		

Attorney information	Yoon S. Ham Lowe Hauptman & Ham 2318 Mill Rd, Suite 1400 Alexandria, VA 22314 UNITED STATES yshgroup@ipfirm.com,jhgreger@ipfirm.com Phone:703-684-1111		
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Registration Subject to Cancellation

Registration No	4486548	Registration date	02/18/2014
Registrant	Blink Imports 1141 Pomona Corona, CA 92882 CANADA		

Goods/Services Subject to Cancellation

Class 034. First Use: 2012/12/02 First Use In Commerce: 2013/01/01 All goods and services in the class are cancelled, namely: Electric cigarettes; Electronic hookahs; Hookah parts, namely, hoses, bowls, mouthpieces, bases; Hookah tobacco; hookah charcoal; Electronic cigarette lighters; Holder for a cigarette pack and lighter; Lighter flints; Cigarette cases; Tobacco grinders; Ashtrays
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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. Application No.	85909862	Application Date	04/19/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	JUSTFOG		

Design Mark	
Description of Mark	The mark consists of wording "JUST" on the first row. The "s" is slanted to the right. The wording "FOG" on the second row in the square.
Goods/Services	Class 034. First use: First Use: 2009/06/26 First Use In Commerce: 2012/11/05 Cigarettes; cigars; cigarillos; tobaccopipes; cigarette cases; cigarette filters; cigarette holders; electric cigarettes; electronic cigarettes; electric cigars; electronic cigars; electric cigarillos; electronic cigarillos; electric tobacco pipes; electronic tobacco pipes; electric cigarettes for use as an alternative to traditional cigarettes; electroniccigarettes for use as an alternative totraditional cigarettes; electric cigarette cases; electronic cigarette cases; cartridges and filters for electric cigarettes; cartridges and filters for electronic cigarettes; electric cigarette holders; electronic cigarette holders; smokers' articles, namely, tobacco boxes, cigarette boxes and cigarillo boxes

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FOG9		
Goods/Services	Electronic Cigarettes		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FOG10		
Goods/Services	Electronic Cigarettes		

Attachments	85909862#TMSN.jpeg(bytes) 3-25-14 Petition -Cancellation- FOGG by Just Fog.pdf(101107 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	/ysh/
Name	Yoon S. Ham
Date	03/25/2014

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

In the matter of U.S. Registration No. 4,486,548

Mark: FOGG

Registration Date: February 18, 2014

Electronic Cigarette JUSTFOG Co., Ltd)	
)	
Petitioner,)	
)	
v,)	Cancellation No.: _____
)	
Blink Imports LLC)	
)	
Registrant)	
)	

PETITION TO CANCEL REGISTRATION

COMES NOW, Petitioner, Electronic Cigarette JUSTFOG Co., Ltd., with a business address at 106-2401,80, Jongam-ro24ga-gil, Seongbuk-gu, Seoul, Korea, and formed under the laws of the Republic of Korea, (hereinafter referred to as “Petitioner” or “Applicant”) believing it is being damaged by Registration Number 4,486,548, petitions to cancel Registration 4,486,548 owned by, Blink Imports LLC , 1141 Pomona Street, Corona, California, 92882 (also referred to as “Respondent or Registrant”).

FACTS

1. Application number 85/856,981 (the '981 application) for the mark FOGG registered Feb 18, 2014, and issued as registration number 4,486,548, and placed on the Supplemental Register (hereinafter referred to as the '548 registration).
2. The '981 application was filed on Feb. 22, 2013, by Registrant Blink Imports.
3. The '981 application matured into the '548 registration covering goods in Class 34 listed as:

Electric cigarettes; Electronic hookahs; Hookah parts, namely, hoses, bowls, mouthpieces, bases; Hookah tobacco; hookah charcoal; Electronic cigarette lighters; Holder for a cigarette pack and lighter; Lighter flints; Cigarette cases; Tobacco grinders; Ashtrays, in Class 34.
4. When filing the '981 application, Registrant asserted the following first use dates for all the above-listed goods

FIRST USE ANYWHERE DATE At least as early as 12/02/2012

FIRST USE IN COMMERCE DATE At least as early as 01/01/2013
5. On information and belief Registrant did not use in interstate commerce the FOGG mark on each and every good listed in the '548 registration.
6. The '548 registration covers the mark FOGG in standard characters.

7. A mark registered in standard characters provides a registrant rights to use a mark in any stylized format without limitation.
8. Applicant is the owner of pending serial number 85/909,862 covering the mark JUST FOG and Design reproduced below (hereinafter referred to as “the ‘862 application”).



9. The word mark JUST FOG is the dominant portion of the mark JUST FOG and Design.
10. As amended during prosecution, the ‘862 application covers the following goods

Cigarettes; cigars; cigarillos; tobacco pipes; cigarette cases; cigarette filters; cigarette holders; electric cigarettes; electronic cigarettes; electric cigars; electronic cigars; electric cigarillos; electronic cigarillos; electric tobacco pipes; electronic tobacco pipes; electric cigarettes for use as an alternative to traditional cigarettes; electronic cigarettes for use as an alternative to traditional cigarettes; electric cigarette cases; electronic cigarette cases; cartridges and filters for electric cigarettes; cartridges and filters for electronic cigarettes; electric cigarette holders; electronic cigarette holders; smokers' articles, namely, tobacco boxes, cigarette boxes and cigarillo boxes in Class 34.

11. The ‘862 application was filed based on intent to use under Section 1(b) and under Section 44(e) relying on Korean Registration No. 0854975, registered on Feb. 8, 2011.

12. The '862 application was filed on April 19, 2013.
13. During prosecution the '862 application was amended to delete the Section 1(b) basis and rely solely on the Section 44(e) basis.
14. Applicant's first use of its JUST FOG and Design mark, on at least one or more of the goods listed in the '862 application, started in U.S. commerce at least as early as November 5, 2012.
15. On information and belief Applicant's common law use rights are senior-in-time to Registrant's earliest use of its FOGG mark as well as earlier than filing date of the '981 application
16. During prosecution of the '862 application, the trademark attorney examining the '862 application cited the then pending '981 application as an earlier filed application, which if matured, could provide a basis for refusal of the '862 application because of a perceived likelihood of confusion under Section 2(d) of the Lanham Act.
17. The '862 application has a filing date subsequent to the '981 application filing date, therefore the Examining Attorney suspended the '862 application, pending the final disposition of the cited '981 application.
18. The '981 application very recently matured to registration on the Supplemental Register, and issued as the '548 registration.

19. Marks approved for registration on the Supplemental Register are not published for possible opposition and instead register after the application is approved.
20. Applicant's first use of its JUST FOG mark in U.S. commerce is earlier in time than the earliest alleged date of first use asserted by Registrant.
21. In addition to using the mark JUST FOG and Design, Applicant also uses FOG9 and FOG10 (FOG-formative marks) as marks on and in connection with electronic cigarettes and related goods as listed in the '862 application. Applicant owns common law rights in its FOG-formative marks.
22. The mark FOGG is very similar to the word mark JUST FOG.
23. The mark FOGG is very similar to Applicant's FOG-formative marks, including but not limited to FOG9 and FOG10.

COUNT I

LIKELIHOOD OF CONFUSION - 15 U.S.C. §1052(d); PRIORITY OF USE

24. All prior allegations are incorporated herein by reference.
25. The goods covered by the '548 registration are similar to the actual goods used by Applicant and the goods are marketed to and used by the same consumers.

26. The goods covered by the '548 registration are identical and/or nearly identical and/or very similar to the goods listed in Applicant's '862 application.
27. The goods covered by the '548 registration are identical and/or nearly identical and/or very similar to the goods Applicant uses in connection with its FOG-formative marks.
28. On information and belief that consumers are likely to be confused that goods offered in connection with the mark as appears in the '548 registration are authorized, sponsored or affiliated with the Applicant where no such authorization or affiliation exists.
29. The USPTO Trademark Attorney examining Applicant's '862 application is of the belief that Applicant's JUST FOG and Design mark and Registrant's FOGG mark are similar in sight, sound, meaning, and the marks travel in similar channels and are marketed to similar consumers, and therefore the two marks are likely to cause confusion among consumers. However, the Trademark Examining Attorney did not make a determination as to priority of use, and only considered which party had the earlier filing date in deciding to suspend the '862 application.
30. On information and belief Applicant has priority of use for its JUST FOG and Design mark over Registrant's FOGG mark.
31. On information and belief, the Trademark Examining Attorney will issue a final refusal against the '862 application upon learning that the '981 application has matured into the '548 registration.

32. Continued use and registration of the mark as appears in the '548 registration is likely to cause confusion as to source, sponsorship and/or affiliation with the Applicant, harming the good will of Applicant's brands including JUST FOG and Design and FOG-formative marks.

33. If the '548 registration is permitted to be maintained on the Supplemental Register, the existence of the registration precludes Applicant from obtaining a registration for its JUST FOG and Design mark, therefore harming Applicant.

WHEREFORE, Petitioner believes that it will be damaged by the continued existence and the perceived rights afforded Registration No. 4,486,548 and prays this Petition for Cancellation be sustained in favor of the Petitioner; that judgment be entered against the Registrant; and U.S Trademark Registration No. 4,486,548 be canceled.

Petitioner submits the applicable filing fee of \$300.00 with this Petition.

Respectfully submitted,

LOWE HAUPTMAN & HAM, LLP.

/Yoon S. Ham/

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March 25, 2014