

ESTTA Tracking number: **ESTTA688577**

Filing date: **08/10/2015**

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	Peter Ian Cummings		
Entity	Individual	Citizenship	UNITED STATES
Address	8491 W Sunset Blvd #1 West Hollywood, CA 90069 UNITED STATES		

Correspondence information	Peter Ian Cummings Editor-Publisher XY Magazine 8491 W Sunset Blvd #1 West Hollywood, CA 90069 UNITED STATES future@bmag.us		
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Registration Subject to Cancellation

Registration No	3862466	Registration date	10/19/2010
International Registration No.	NONE	International Registration Date	NONE
Registrant	KOTZ, CHRISTOPH RATHELBECKERWEG 42 ERKRATH, GERMANY		

Goods/Services Subject to Cancellation

Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: PRINTED MATTER, NAMELY, BOOKS, JOURNALS, AND MAGAZINES ALL FEATURING TOPICS OF GENERAL INTEREST TO THE GAY AND LESBIAN COMMUNITY; PRINTED MATTER, NAMELY, NEWSPAPERS, CALENDARS, COOKBOOKS, DAILY PLANNERS, AND GREETING CARDS
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: FILM, VIDEO, AND AUDIO PRODUCTION; PUBLICATION AND ISSUING OF BOOKS, JOURNALS AND MAGAZINES; PHOTOGRAPHY SERVICES

Grounds for Cancellation

Abandonment	Trademark Act section 14
Other	Registrant has asked Petitioner to file this cancellation with Registrant's blessing. Registrant has abandoned and does not intend to use the mark. (However, due to Registrant's disinterest in the mark, distance, and being a non-US per-

	son, Registrant does not wish to deal with the formalities.)
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Attachments	PleadingAll.pdf(275280 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 Facsimile or email (by agreement only) on this date.

Signature	/Peter Ian Cummings/
Name	Peter Ian Cummings
Date	08/10/2015

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

In the matter of Trademark Registration No. 3862466
For the mark: XY-GAY
Date registered: October 19, 2010

PETER IAN CUMMINGS, individual, *PRO SE*
PETITIONER

Publisher, XY Magazine
8491 Sunset Boulevard #1
West Hollywood CA 90069

v.

CHRISTOPH KOTZ, individual,
REGISTRANT

Rathelbeckerweg 42
40699 Erkrath
Germany

PETITION TO CANCEL

I, PETER IAN CUMMINGS, the above-identified Petitioner, believe that I and my business will be damaged by the above-identified registration XY-GAY, Reg. 3862466, and hereby petition TTAB to cancel the same for categories 016 and 041.

The grounds for cancellation are as follows:

1. Petitioner Cummings is the publisher of XY Magazine. He has distributed XY Magazine via bookstores and/or his website since 1996, where it remains on sale today. XY is one of the best-known gay news magazines in the world. Cummings has sold several million copies of XY Magazine and is the senior user of XY Magazine.
2. Registrant Kotz is German and operates a food market, sauna, and other businesses in Germany. Registrant Kotz states in writing (EXHIBIT A) that he wants Petitioner Cummings to get the XY-GAY mark canceled, but due to Registrant's disinterest in the mark, distance, and being a non-US person, Registrant does not wish to deal with the formalities. Petitioner Cummings thus files this petition.
3. In 2010, Registrant Kotz applied for and received registration of the XY-GAY mark with United States Patent and Trademark Office ("USPTO") in six classes including class 016 for "Paper Goods and Printed Matter" and class 041 for, among other things, "Publication and Issuing of Books, Journals, and Magazines." Kotz also registered for a wide range of classes (003, 005, 009, 016, 025, 036, and 041) for XY-GAY which include a broad range of services ranging from cosmetics to pharmaceuticals to films to classical music.

4. Registrant Kotz is not using, has not used, and never intends to use, the mark XY-GAY. Four years after registration, Registrant has not and is not producing books, journals, or magazines under the mark.
5. Registrant Kotz states and confirms said non-use intent and abandonment of the mark in an email to Petitioner Cummings on August 4, 2015 (attached hereto as EXHIBIT A) wherein Registrant Kotz states as follows:

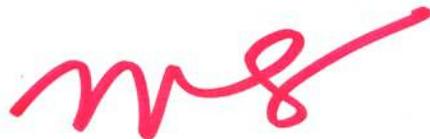
“The trademark XY-GAY is and was not used in US and you can demand that this trademark be deleted. I don’t do any business with this that trademark and I am not interested to keep this alive or anything to do with it. I recommend that you (file for cancellation). ... To cancel the entire the registration will be the finest way to clear that case also for the other people with XY in their brandname.”
6. Registrant Kotz further states that he will raise no objection to the cancellation:

“Just demand that the trademark xy-gay must be deleted, that’s all. The trademark is NOT used in the US and therefore it must be deleted if somebody demand this. And be sure, I will not fight against this.”
7. Registrant Kotz’s XY-GAY mark registered on Oct 19, 2010. Said mark is subject to this cancellation under 15 USC §1064 which allows cancellation petitions: “within five years from date of registration” ; “by any person who believes he will be damaged.”
8. I, Petitioner Peter Ian Cummings, the senior user, am being damaged because on July 16, 2015 (Serial 86588810), USPTO issued me an office action denial of my senior common-law mark “XY MAGAZINE” due to Kotz’s registration.
9. Registrant Kotz’s said mark should be canceled because Registrant has abandoned the mark by (a) reserving the mark and then by its non-use for three consecutive years and (b) by a written intent not to use said mark in future; both of which constitute prima facie evidence of abandonment under 15 USC § 1127 which states:

“A mark shall be deemed “abandoned” if the following occurs: When its use has been discontinued with **intent not to resume** such use. Intent not to resume may be inferred from circumstances. **Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.**

I, Petitioner Peter Ian Cummings, therefore petition for cancellation of Registrant’s XY-GAY Mark 3862466 for class 016 for ("Paper Goods and Printed Matter") and class 041 ("Publication and Issuing of Books, Journals, Magazines, etc").

Respectfully submitted,



Dated: August 10, 2015

PETER IAN CUMMINGS, individual
Publisher, XY Magazine
PETITIONER

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

In the matter of Trademark Registration No. 3862466
For the mark: XY-GAY
Date registered: October 19, 2010

PETER IAN CUMMINGS, individual, ***PRO SE***
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v.

CHRISTOPH KOTZ, individual,
REGISTRANT

Rathelbeckerweg 42
40699 Erkrath
Germany

AFFIDAVIT IN SUPPORT OF EXHIBITS

I, PETER IAN CUMMINGS, hereby attest that Exhibits A and S hereto attached are true and accurate copies of what they on their face purport themselves to be. Executed this 10th day of August 2015 in Washington, DC.



PETER IAN CUMMINGS

CUMMINGS v KOTZ | In the matter of TM Reg 3862466 | EXHIBIT A

On Aug 4, 2015, at 2:36 AM, Christoph Kotz wrote:

Dear Peter,

I don't have any problem that you use XY for your magazine or whatever you like to use it.

Mit freundlichen Grüßen

Christoph Kotz

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On Aug 4, 2015, at 3:50 AM, Christoph Kotz wrote:

Dear Peter,

sure I can help, but unfortunately I will not sign any agreement regarding the xy-gay trademark in US.

You may not know, that the trademark xy-gay is and was not used in US and you can demand that this trademark shall be deleted.

I don't do any business with this that trademark and I am not interested to keep this alive or anything to do with it.

I would recommend that you choose opinion (2)

Cummings wrote:

... OR (2) I would have no other option than to file a lawsuit against you and pursue you permanently to cancel your entire registration ...

To cancel the entire the registration will be the finest way to clear that case also for the other people with XY in there brandname.

Mit freundlichen Grüßen

Christoph Kotz

.

On Aug 4, 2015, at 4:32 AM, Christoph Kotz wrote:

just demand that the trademark xy-gay must be deleted, that's all.
the trademark is NOT used ... and therefore it must be deleted if somebody demand this.

and be sure, I will not fight against this.

that is may not the fastest, but the clearest way to serve your problem.

Mit freundlichen Grüßen

Christoph Kotz

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

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For the mark: XY-GAY
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CERTIFICATION OF SERVICE BY ELECTRONIC TRANSMISSION

WHEREAS: (a) 37 CFR 2.119(b)(6) permits Petitioner to effect service on Registrant by “electronic transmission when mutually agreed upon by the parties”; and (b) Registrant and Petitioner have mutually so agreed (confirmed in **Exhibit S** affixed hereto),

I, PETER IAN CUMMINGS, certify as follows: On August 10, 2015, I sent by e-mail the pleading and exhibit in this case to Registrant Kotz.

I declare under penalty of perjury that the foregoing is true and correct.

Executed on August 10, 2015 at Washington, DC.



PETER IAN CUMMINGS

CUMMINGS v KOTZ | In the matter of TM Reg 3862466 | EXHIBIT S

On Aug 6, 2015, at 11:53 PM, Christoph Kotz wrote:

Hello Peter

yes great thx.

be sure, that I will not hamper that process.

Christoph

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Am 06.08.2015 um 20:35 schrieb Peter Ian Cummings:

Hi Christoph,

O.K. ... I will send the form to the TTAB asking them to cancel it.

I should send you a copy. **Can I send it to you by email?**

thanks
xox
Peter

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On Aug 5, 2015, at 12:25 AM, Christoph Kotz wrote:

keep me update.