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

Proceeding	91265715
Party	Plaintiff Xavier University of Louisiana
Correspondence Address	CHESTER G. MOORE, III MCBEE MOORE & VANIK IP, LLC 510 SOUTH MARKET STREET FREDERICK, MD 21701 UNITED STATES Primary Email: cgmoore@mmviplaw.com Secondary Email(s): docketing@mmviplaw.com, cnichols@mmviplaw.com 3014536103
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Brett Stauffer
Filer's email	bstauffer@mmviplaw.com, docketing@mmviplaw.com
Signature	/Brett Stauffer/
Date	11/20/2020
Attachments	2920571-9002 AMENDED Notice of Opposition.pdf(143885 bytes) Exhibit 1.pdf(1025760 bytes) Exhibit 2.pdf(453917 bytes) Exhibit 3.pdf(4997265 bytes) Exhibit 4.pdf(204288 bytes) Exhibit 5.pdf(87166 bytes) Exhibit 6.pdf(211649 bytes) Exhibit 7.pdf(372678 bytes) Exhibit 8.pdf(2356288 bytes) Exhibit 9.pdf(127561 bytes)

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

XAVIER UNIVERSITY OF LOUISIANA,

Opposer,

In re Application Serial No. 88666195
Mark: XULA

v.

Published: September 1, 2020
Opposition No. 91265715

KARINA PRIMELLES,

Applicant.

AMENDED NOTICE OF OPPOSITION

Opposer Xavier University of Louisiana (“Opposer”) believes it will be damaged by registration of the application XULA shown in Trademark Application Serial No. 88666195 (“Applicant’s XULA Application”), filed by Karina Primelles (“Applicant”), an individual, having an address at 11577 Williams Hwy, Grants Pass, OR 97527.

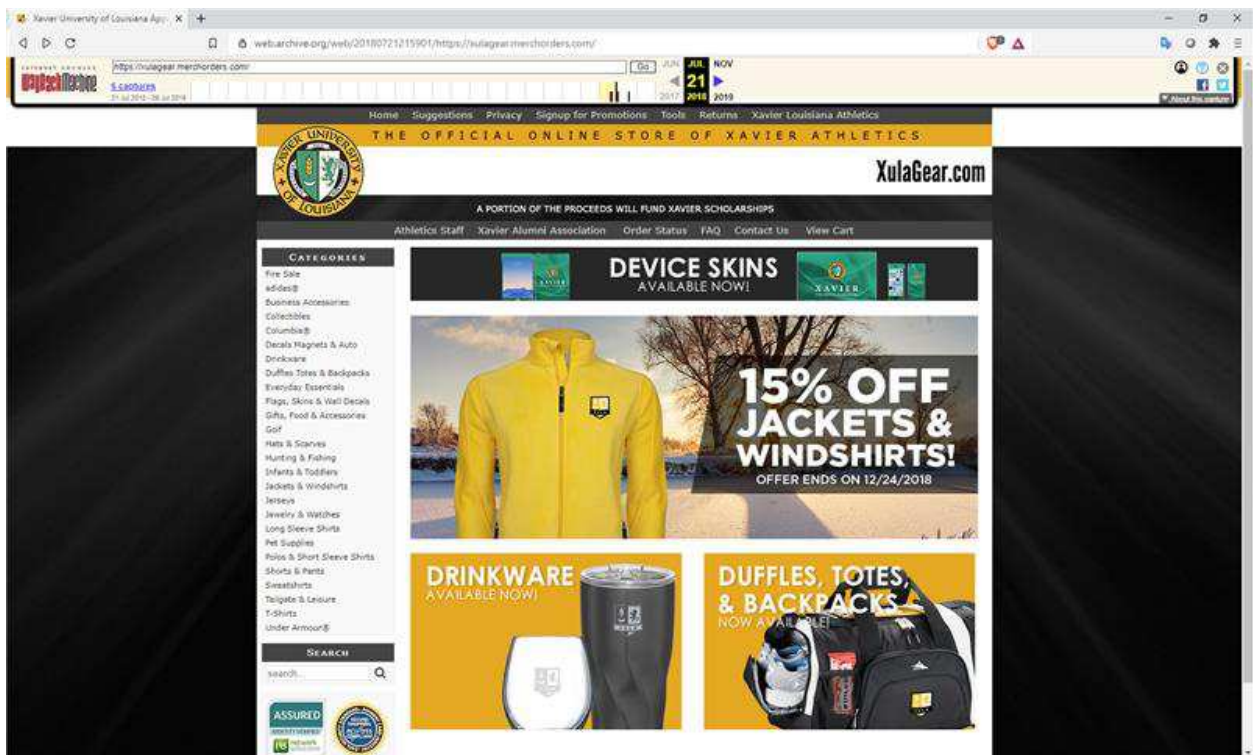
Opposer hereby opposes registration of Applicant’s XULA Application under the provisions of Sections 2(a), 2(d), 13, 38, 43(a) and 43(c) of the Trademark Act of July 5, 1946 (the “Lanham Act”), 15 U.S.C. §§ 1052(a), 1052(d), 1063, 1120, and 1125(c).

As grounds for opposition, Opposer alleges that:

1. Opposer is a private university organized under the laws of the state of Louisiana, with a principal place of business at 1 Drexel Drive, New Orleans, LA 70125. Opposer owns and operates an accredited university awarding bachelor’s, master’s, and doctoral degrees since 1925.

2. For many years, and long before October 23, 2019, the filing date of Applicant's intent-to-use application, Opposer has used the XULA marks and variations thereof (collectively, the "XULA Mark") in connection with goods and services associated with the university.
3. Opposer invested millions of dollars in development and operation of the university, offering courses since 1925, and is the nation's only Catholic Historically Black College and University (HCBU).
4. Opposer has invested significant resources in selling a line of goods, including bags, wallets, bearing the XULA Mark since at least 2010. *See* Exhibits 1–4.
5. Opposer owns common law rights in the XULA Mark listed on Exhibits 1-4 attached hereto to the extent not already fully set out in the referenced exhibits, the common law marks listed in the ESTTA Cover Sheet for the filing of the Notice of Opposition, all of which have priority over the applied-for mark and are incorporated herein by reference. Opposer has used the XULA Mark in commerce since at least 2010 as shown in Exhibits 1–4 and below in a July 2, 2018 screen shot.
6. Opposer's XULA Marks are used in a wide variety of fonts and colors, and are not in general limited in appearance, although appearance may be an additional feature of certain marks.
7. The adversely affected common law XULA Mark is used in connection with goods and/or services in the form of duffles, wallets, ID holders, totes, and backpacks (sold empty). The common law marks referenced herein are valid and subsisting, in full force and effect, and constitute *prima facie* and/or conclusive evidence of Opposer's exclusive right to use the marks in commerce in connection with the goods and services specified in the registration.

8. During the longstanding, widespread and continuous use of the XULA Mark, Opposer and its alumni and donors have expended considerable time, effort, and money in advertising and publicizing the sale of goods and services bearing the XULA Mark.
9. Opposer as well as its authorized agents and/or licensees have sold and/or offered for sale goods and services bearing the XULA Mark in a trading area of broad geographical scope encompassing the United States, including its territories.
10. Opposer as well as its authorized agents and/or licensees have sold and offered for sale goods and services bearing the XULA Mark in numerous channels of trade, including but not limited to web-based sales and a university bookstore, as shown in the July 2, 2018 screen shot:



11. The XULA Mark is symbolic of the extensive goodwill and consumer recognition that Opposer has established through substantial expenditures of time, effort and other resources

in the advertising and promotion of the goods and services Opposer sells and offers for sale under the XULA Mark.

12. As a result of Opposer's regular, extensive and well-publicized use, the XULA Mark is well-known in the United States and is associated exclusively with Opposer and its high quality goods and services, including for example, duffles, wallets, ID holders, totes, and backpacks.
13. Applicant seeks to register a mark whose prominent term is identical to Opposer's XULA Mark. As evidenced by Applicant's ITU trademark application, it is envisioned that the XULA Application is intended to directly compete with duffles, totes, and backpacks bearing the Opposer's XULA Mark.
14. At least by way of the above statements on Applicant's website and promotional materials, Opposer hereby declares that the foregoing statements by Applicant are sufficient evidence of direct and adverse impact to Opposer and its XULA Mark.
15. On October 23, 2019, Applicant filed an application for federal registration of Applicant's XULA Application shown in Application Serial No. 88666195.
16. Applicant has not asserted any earlier priority than October 23, 2019, with respect to any of the goods for which they seek registration.
17. Applicant seeks registration of a mark that contains the literal element Xula in connection with:

International Class 18: Purses; handbags; clutch bags; shoulder bags; travelling bags; tote bags; book bags; backpacks; wallets; all purpose carrying bags; canvas shopping bags; cosmetic bags and pouches, sold empty;

International Class 3: Non-medicated herbal body care products, namely, body oils, salves, body butters, body emulsions and lip balms; Skin and body topical lotions, creams and oils

for cosmetic use; topical, non-medicated moisturizing preparations for the skin for cosmetic use, namely, creams, gels, salves, sprays, powders, and ointments; Skin care products, namely, non-medicated skin serums; Cosmetic herbal nourishing creams; Cosmetic herbal oils for the epidermis; Topical herbal extracts for cosmetic purposes; hemp essential oils; cosmetic bags and pouches sold filled with non-medicated toiletry preparations, namely, body oils, body butters, topical herbal extracts and hemp essential oils; all of the foregoing containing industrial hemp-derived cannabidiol (CBD) containing less than 0.3% THC on a dry weight basis in accordance with the 2018 Farm Bill.

18. Applicant's XULA Application, Application Serial No. 88666195 was published for opposition in the *Official Gazette* on September 1, 2020.
19. This Opposition has been filed within thirty (30) days of publication, *i.e.*, on or before October 1, 2020, therefore, Opposer timely filed this opposition.
20. Opposer's rights to the XULA Mark are superior to those of Applicant.
21. The XULA Mark is well-known and became well-known before the filing date or any use of Applicant's XULA Application.
22. Applicant's application for and any use of Applicant's XULA Application is without the consent, authorization, or license of Opposer.
23. Opposer believes it will be damaged by registration of Applicant's XULA Application under Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the ground that Applicant's use and registration of the subject application will falsely suggest a connection between Applicant and Opposer to the damage of Opposer, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). Indeed, Applicant's XULA mark is identical to Opposer's XULA Mark. The proffered class for the XULA Application sought to be registered is class 018, which is

the same class where Opposer has used the XULA Mark with superior rights. Therefore, it is axiomatic that Opposer will have actual and immediate damage if the XULA Application is permitted to be registered.

24. Opposer believes it will be damaged by registration of Applicant's XULA Application under Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the ground that the subject application so resembles the XULA Marks used by Opposer in the United States as to be likely, when used on or in connection with the services identified in the application for Applicant's XULA Application, to cause confusion, mistake or to deceive consumers, with consequent injury to Opposer and to the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).
25. Opposer believes it will be damaged by registration of Applicant's XULA Application under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because the use and registration of Applicant's XULA Application is likely to dilute the distinctive quality of Opposer's well-known XULA Mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).
26. Opposer believes it will be damaged by registration of Applicant's XULA Application under Section 38 of the Lanham Act, 15 U.S.C. § 1120, because Applicant made knowingly false statements about the translation and pronunciation of the Mark, which were made with the intent to deceive the USPTO. Applicant made a statement that "The wording 'XULA' has no meaning in a foreign language." Exhibit 5-Response to Office Action of July 4, 2020. To the contrary, Applicant asserts that the Mark "XULA" should be pronounced as "(choo-luh) chul•ha chula \'chül ə\'. Exhibit 6—Xula.us webpage providing pronunciation of the mark. The pronunciation of the mark as provided by the Applicant is identical to the Spanish word, "Chula," which means, "cute or beautiful woman". Exhibit 7- Dictionary.com "Chula";

Exhibit 8—“The New Mexican Woman” article published on-line on September 15, 2020 (“Xula (pronounced chula), is a feminine term of endearment...”). This pronunciation was not provided to the USPTO, as evident from the Trademark Examining Attorney who did not search the pronunciation with the “ch-”. Exhibit 9. Therefore, the Mark as pronounced and used by the Applicant has a meaning in the Spanish language. This information should have been disclosed to the USPTO. As a result of Applicant’s fraud on the USPTO, the Mark should be denied registration in accordance with the Lanham Act, 15 U.S.C. § 1063.

WHEREFORE, Opposer believes it will be damaged by registration of Applicant’s XULA Application shown in Application Serial No. 88666195 and respectfully requests that the registration sought by Applicant be refused.

Dated: November 20, 2020

Respectfully submitted,

By: /Chester G. Moore/
Chester G. Moore, Ph.D.
McBee Moore & Vanik IP LLC
510 S. Market Street
Frederick, MD 21701
Tel: 301-453-6100
Fax: 301-476-4851

Attorney for Opposer
Xavier University of Louisiana

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing AMENDED NOTICE OF OPPOSITION has been served upon Ms. Jessica Gonzalez, Bressler Amery & Ross P.C., via email to:

JGonzalez@bressler.com

this 20th day of November, 2020.

By: /Chester G. Moore/
Chester G. Moore

Amended Notice of Opposition

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Exhibit 1



Print area 3w" x 3.65h"



Black



Dark Brown



Hot Pink

CAROLINA SEWN PRODUCTS CORP.

111 Fletcher Commercial Dr, Fletcher, NC 28732-8564 ph: (800) 920-5944 • fax: (888) 716-4950

Order #	Customer Details	Imprint Details
14252	New Orleans, LA 70125 4980 Dixon Street Xavier University Attn: Thad 014 Barnes & Noble Xavier U	Product color: 12 Black, 12 Dk.Brown, 12 Hot Pink Imprint: All Over Emboss Design: XULA and Seal Pre-price: \$12.98 Reorder: n/a
Item		
C186 Leather ID Holder		
Designer		
kwb		
Date		
04/14/10		

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Exhibit 2

XULA

Print area 2" x 3"



Product Dimensions: 16" x 15"

Artist render is an approximation for preproduction viewing only. Imprint may vary slightly in color and size on finished product.

Colors:



Red, White
& Blue



Red & Navy
Check



Blue Plaid



Product Image

Order #		Customer Details		Imprint Details	
31532		New Orleans, LA 70125 4980 Dixon Street Xavier University of Louisiana 014 B&N Xavier University		Imprint: deboss Design: XULA	
Item	C208 Flannel Tote				
Designer	MT				
	Date				
	4.10.12				

Thank you for your order and we look forward to serving you again. Please read this proof thoroughly and check for any errors. We will not be responsible for any errors that are approved on this proof. Refer to imprint details for specific colors. If there are any questions please contact your Customer Service Rep.

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Exhibit 3

ARTWORK PROOF

Artwork# LG1902305

Date: 04/16/2019

School Name: Xavier University of Louisiana

Logo Application Method:

Debossed, 1-location

Product: 700L Nappa Leather ID Holder

Product Colors:

Black **SKU:** 263018974

Brown **SKU:** 263018991

Purple **SKU:** 263019029

Licensing: LEARFIELD

CSR: Rick

Artist: AD

ARTWORK SHOWN AT 100%



Maximum Imprint Area: 3 W x 2 H

Actual Artwork Dimensions: 2.29 W x 2 H

Imprint Color: Debossed



PRODUCT IMAGE PROVIDED FOR EXAMPLE ONLY. ACTUAL SIZE OF ARTWORK MAY DIFFER.

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Exhibit 4

JARDINE

Silicone Walletproof

Artwork# SW2076

Date: 12/28/17

School Name: Xavier University

Logo Application Method:

screen printed 1-color

1-location, 1-side

Product: Slim Silicone Card Wallet

Artist:
gabby

INK COLOR: white

Actual Size Art, imprint area: max 1.5" w x 1.5" h



PRODUCT IMAGE PROVIDED FOR EXAMPLE ONLY.
ACTUAL SIZE OF ARTWORK MAY DIFFER.

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Exhibit 5

Common Law Mark XULA Description of Goods & Services

XULA

Used as a service mark to identify a wide range of products sold and licensed by Xavier University. For purposes of this proceeding, Opposer asserts its use of this mark on or in connection with goods classified:

International Class 9: Such goods include, by way of example, computer accessories, chargers

International Class 11: Such goods include, by way of example, flashlights

International Class 14: Such goods include, by way of example, jewelry, watches

International Class 16: Such goods include, by way of example, decals, stickers, pens, stick pads

International Class 18: Such goods include, by way of example, goods include, by way of example, journals, luggage, pet items, and writing pads, duffles, wallets, ID holders, totes, and backpacks

International Class 20: Such goods include, by way of example, chairs, furniture

International Class 21: Such goods include, by way of example, dinnerware, drinkware, home items, and kitchenware

International Class 22: Such goods include, by way of example, tents

International Class 24: Such goods include, by way of example, banners, bedding, blankets, flags, shower curtains, towels, home decorations and window treatments

International Class 25: Such goods include, by way of example, clothing of all types for infants, children, women, and men, including, by way of example, face masks, hats and scarves, jackets, windshirts, bibs, bottoms, footwear, headwear, loungewear, polos and short sleeve shirts, t-shirts, sweatshirts, outerwear, and tops

International Class 28. Such goods include, by way of example, balls, dolls, games, golf items, pet toys, sports bags, and stuffed toys

International Class 30. Such goods include, by way of example, snacks and nuts

XULA

Used as a service mark to identify a wide range of services provided and licensed by Xavier University. For purposes of this proceeding, Opposer asserts its use of this mark on or in connection with services classified:

International Class 35: Such services include, by way of example, retail store services, mail order services, and online retail store services featuring clothing, furniture, toys, sports equipment, housewares, jewelry, prints, decals, and memorabilia; Association services, namely, promoting interests of the alumni of a university

International Class 41: Such services include, by way of example, education and entertainment services, such as conducting classes, seminars, workshops, conferences and exhibitions, symposiums, at the pre-collegiate, undergraduate, graduate, professional levels, conducting, and presenting collegiate athletic events, band and cheerleading performances, dance performances, music performances, and theatrical performances, television, audio, and radio production services, library services, sport teams, and sports teams

International Class 42: Such services include, by way of example, scientific research and development, by way of example, biotechnology laboratories, medical, health, and wellness research

International Class 44: Such services include, by way of example, health care services, namely, providing medical services, and counseling

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Exhibit 6

what is xula?

xula (choo-luh) chul·ha
chula \ 'chül ə \

chill, intelligent, cute, balanced – to
feel good in one's own skin.

Taken from <https://www.xula.us>

Accessed November 19, 2020 (5:09 PM EST)

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Exhibit 7



EDITORIAL ▾



MEANINGS

WORD GAMES

LEARN

WRITING

WORD OF THE DAY

Get access to affordable legal help

[Learn More](#)

Legal protection for your family & business at a price you can afford.

[← chiva](#)[chutiya →](#)

EXAMPLES

ORIGIN

USAGE

TRANSLATIONS DICTIONARY

chula

or mami chula [choo-luh]

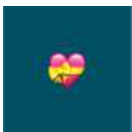
See
Today's
New
Synonym!

WHAT DOES CHULA MEAN?

Chula is Spanish slang for "cute" or "a beautiful woman," often seen in *mami chula* ("hottie").



WHAT'S HOT



Heart With Ribbon emoji



simp

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Exhibit 8

herb
shop

xulita
blog

herbal
index

xula

who we are 🔍 👤 📁 (0)



Sep 15, 2020

The New Mexican Woman

6 min read

Written by Xula

Why the Mexican Woman?

When we talk about women's rights, needs, and desires, Mexican women are often left out of the conversation. Both Latinas and other marginalized groups of women have been overexploited, overworked, and overlooked in modern society.

Xula (pronounced chula), a feminine term of endearment and the namesake of our brand—is a direct response to the absence of Mexican, and other BIPOC people in the cannabis space. With approximately 5.7% of Latinx founders in the industry, Xula was born out of the need to represent and redefine our narratives. Through the reclaiming of marihuana as an indigenous herb, we honor not only what it means to be a Mexican woman, but what it means to be a feminine being in the scope of the cannabis industry.

To be a Mexican woman is as vast, intricate, and as complicated as the universe itself. They are delicate yet tough, brown, black, native, and güera.



photo by Tzvetelina Garneva

Mexican women are ambitious critical thinkers. We are nurturing caregivers. We are bitches, soft-bitches, and angel babes ready to change the gaze of the cannabis industry and the gaze the consumes our bodies.

The criminalization of marihuana has caused a major disruption to our ancestral connection to herbs and plant medicine. Its criminalization has imprisoned Mexicans, Latin Americans, and African descendants for marijuana possession at rates much higher than white people—though they use it at the [same rates](#). The war on drugs has increased our migration population, continuing to divide homes, families, and communities. We say enough is enough and as a culture of Latinx peoples, we intend to use healing herbs to repair our collective trauma, build communities, and spiritually heal ourselves.

The Farse of White Wellness

It is clear that herbal medicine has been used around the world within indigenous communities for a millennial. Herbal forms of healing are not new, it is not trendy, and certainly not exclusively for the white and wealthy.

Wellness and well-being should not be based on European social constructs of beauty. Our wellness is based on herbs, foods, and millennial-

old indigenous rituals of healing.

Indigenous wellness has informed most of what we now know to be the modern holistic health movement. Curanderos, (Spanish: [kuran' dero]) or "Tepatike" in native Náhuatl are traditional healers throughout Latin America. Modern curanderos combine a mixture of traditional indigenous medicinal practices, Catholic rituals, and the ancient influence of African rituals brought to the region by the Latin American slave trade and other forms of pre-colonial migration. The curanderos have been important ushers to powerful types of folk medicine. They have been the ritual healers, women herbalists, doulas, and midwives.

When cannabis arrived to Mexico, it quickly was accepted and adapted as plant medicine by native Mexican communities—appreciated for its value and medicinal potency. Now for generations, we've witnessed cannabis used in topical mixtures rubbed on the chest of sick children, on grandmothers with joint ailments, and mothers with headaches. It's been woven into a well-known tradition passed on from generation to generation.

Yet somehow, we've found ourselves in a hypermasculine society tell us that we're not good enough as we are. We are sold products that tell us be more white, more skinny, and less connected to plant medicine and the natural world. It is a lie that with time has created a hardening. One that has generated a competitive and aggressive dynamic between ourselves and other women.

Being a woman can be painful; our menstrual pain, our menopausal pain, joint pain, child-bearing pain, and emotional pain. Through cannabis, we have the ability to ease these pains and stress with other herbs and practices that gives

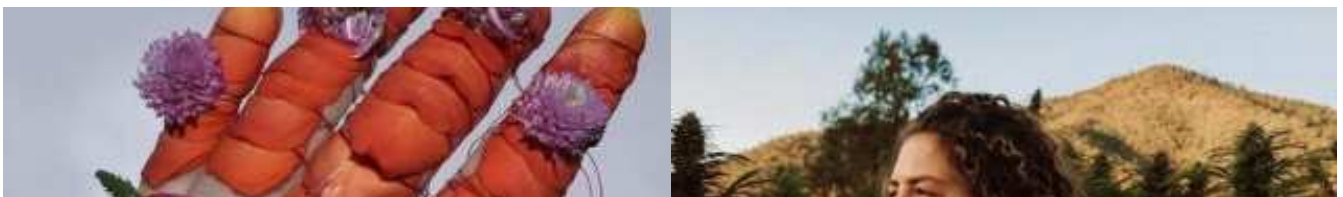
us a chance to return back to a softness, arousing the femininity into life and society.

CBD a Shift to Soft Femininity

If CBD can soften hair, skin, anxious nerves, cramps and adversities to sleep, it can crack open a world of softness in the way we treat our family, friends, children and ourselves. When we feel well and balanced, we can be more compassionate and engaged individuals. Cannabis forces us to slow down, and take a step back to sit with and witness what's important in life. Arriving to a more gentle existence is a gift that men too can embody, desire and express through femininity—encouraging a more balanced yin and yang approach to our lives.

As activists, we commit ourselves to changing the perception of marihuana in Mexico while merging ancestral herbal knowledge with the most advanced scientific developments on the medicinal use of this beloved plant. *Cannabis Sativa's* array of beneficial cannabinoids has created a global shift in the perspective surrounding the way we heal.

The products we create are an ode to the people and practices that have come before us. Despite big pharma and mass colonization, we are in awe of the preservation of this knowledge and our access to global indigenous forms of plant medicine. To this, we are deeply and forever grateful.





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go

search

follow us!



stay up to
date

Your email

sign me up!

reach out!

hola@xula.us

FDA Disclosure

Any product purchased on this site may contain cannabinoids from hemp. The statements made on the Site regarding these products have not been evaluated by the Food and Drug Administration ("FDA"). The efficacy of these products has not been confirmed by FDA-approved research. These products are not intended to diagnose, treat, cure or prevent any disease. All information presented here is not meant as a substitute for or alternative to information from health care practitioners. Please consult your health care professional about potential interactions or other possible complications before using any of our products.

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Exhibit 9

*** User:cmorris2 ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	1	0	1	1	0:01	88666195[SN]
02	98347	N/A	0	0	0:12	*{"sczchkq"}{v1:2}l{v}*[bi,ti] not dead [ld]
03	46123	N/A	0	0	0:11	*{"szx"}{v1:2}l{v}*[bi,ti] not dead [ld]
04	35448	N/A	0	0	0:11	{"szx"}{v1:2}l{v}*[bi,ti] not dead [ld]
05	33885	N/A	0	0	0:10	{"szx"}{v}l{v}*[bi,ti] not dead [ld]
06	21915	N/A	0	0	0:10	{"szx"}{"ou"1:2}l{v}*[bi,ti] not dead [ld]
07	3017	N/A	0	0	0:01	{"szx"}{"ou"1:2}la*[bi,ti] not dead [ld]
08	183	0	183	176	0:22	{"szx"}{"ou"1:2}la{"sz"0:1}[bi,ti] not dead [ld]
09	2	0	2	2	0:01	"xula"[bi,ti]
10	19	10	9	8	0:01	"zula"[bi,ti]
11	5	2	3	3	0:01	"zoola"[bi,ti]
12	2	0	2	2	0:01	"karina primelles"[on]

Session started 4/30/2020 9:01:11 AM
Session finished 4/30/2020 9:12:04 AM
Total search duration 1 minutes 22 seconds
Session duration 10 minutes 53 seconds
Defaut NEAR limit=1ADJ limit=1

Sent to TIGRS as Serial Number: 88666195