

ESTTA Tracking number: **ESTTA526755**

Filing date: **03/14/2013**

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

Proceeding	92055738
Party	Plaintiff J J Holand Limited
Correspondence Address	KEITH MURRAY MCCULLOCH J J HOLLAND LIMITED 87/171 WIRELESS ROAD, PATHUMWAN BANGKOK, 10330 THAILAND
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Keith Murray McCulloch
Filer's e-mail	mccullochkm@gmail.com, lstraube@gmail.com
Signature	/Keith Murray McCulloch/
Date	03/14/2013
Attachments	JJH Motion with Amended Petition ESTTA corrected.pdf (18 pages)(209388 bytes)

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

J J HOLAND LIMITED,	:	
	:	
Petitioner,	:	Cancellation No. 92055738
	:	
v.	:	
	:	
POTOMAC TOBACCO COMPANY, LTD.	:	Registration No. 3,418,779
	:	
Registrant.	:	Registration No. 3,409,520

Motion Pursuant to Board’s Decision of February 12, 2013- Corrected

Petitioner submits this corrected version of this Motion with attachment and requests the Board and Registrant disregard the file uploaded to ESTTA earlier today which had incorrect pages. A copy with the incorrect pages as uploaded to ESTTA is now copied to Registrant.

Pursuant to Trademark Trial and Appeal Board’s Decision dated February 12, JJH as Petitioner has been allowed THIRTY DAYS from the mailing date of the order – stated on the order as February 12, 2003, but mailed and postmarked by the US Postal Service on February 13, 2013 – to file an amended complaint that complies with Trademark Rule 2.112(a). In addition the TTAB decision stated that JJH must read and understand Rule 11 of the Federal Rules of Civil Procedure made applicable to this proceeding by Trademark Rule 2.116 prior to filing any amended pleading.

JJH notes that its submissions in response to the Respondent’s Motion were not considered by the Board, despite the Petitioner submitting and the USPTO receiving on August 9, 2012, a request for waiver of the due date for submission with a good faith explanation together with a copy of the original Response, thus giving the TTAB (and Respondent) the Response on August 9, 2012, as properly stamped and recorded by the USPTO. Petitioner’s original response, while mailed on July 30, 2012, inexplicably was not received by the TTAB until August 20, 2012. The Board did not recognize the much earlier August 9, 2012 date as properly stamped on the submission. Trademark Rule 1.197 and 1.198 do not appear to have a provision to deal with the Board not affording recognition to the dates documents are received and stamped by the USPTO.

Because the Board did not consider the Petitioner's Response or the Petitioner's Request for Waiver, the Board did not take note that Petitioner has affirmatively stated that it never received service of the Respondent's Motion to Strike which Respondent was required to serve upon Petitioner under Trademark Rule 2.119. Petitioner provided no proof of mailing or delivery to the Board in its August 22, 2012 response to Petitioner's submission and the Board has made any enquiry. While the Board noted that Respondent, in its submission of August 22, 2012 argued that there was no Certificate of Mailing (just a Certificate of Service) on the Petitioner's submission of its response, the Board did not mention that there was no Certificate of Mailing with Respondent's Motion to Strike either, at least in the ESTTA version, Respondent having never received the service from Respondent.

Petitioner moves under the circumstances that the decision of the Board should be set aside and Respondent's Motion to Strike should be dismissed for failure to provide service to Petitioner.

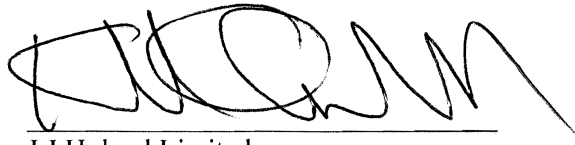
Given the observations in the Board's Decision in analyzing the Petitioner's Complaint and finding need for amendment, the Petitioner nevertheless recognizes it must amend the Complaint to address identified deficiencies in the pleadings and to remove certain elements to comply with the applicable Rules and the Board's substantive instructions regarding the elements of pleading.

Petitioner, however, notes that a small portion of the items the Board identified as unnecessary are in Petitioner's view relevant, in that they assist in forming the Petitioner's knowledge and belief relevant to key parts of the Petition. While Petitioner has deleted most items in some part, it is believed more appropriate to consolidate the information to connect it to the knowledge and belief so as to avoid a later complaint that the Petition lacks sufficient factual support or is merely making conclusory allegations.

Petitioner submits herewith an Amended Petition to Cancel as instructed by the Board. Under the circumstances with the heavy requirement of the Board's Decision, Petitioner requests it be granted

further leave to amend if there should there be a resulting need to plead additional facts or elements after
Petitioner's amendment pursuant to the Board's decision.

Respectfully submitted,



J J Holand Limited

By: Keith Murray McCulloch
Authorized Officer and Representative
87/171, Wireless Road
Pathumwan
Bangkok 10330
THAILAND

Date: March 14, 2013

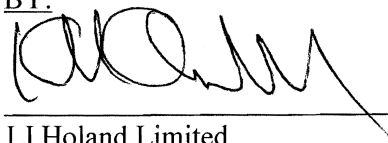
Certificate of Service and Certificate of Mailing

I hereby certify that a true and complete copy of the foregoing Motion Pursuant to Board's Decision of February 12, 2013 with attached Amended Consolidated Petition to Cancel has been filed with the USPTO by transmission using the Board's ESTTA Electronic Filing System on March 14, 2013.

I hereby certify that a true and complete copy of the foregoing Motion Pursuant to Board's Decision of February 12, 2013 with attached Amended Consolidated Petition to Cancel has been served on Potomac Tobacco Company Ltd by mailing said copy on March 14, 2013, via US First Class Mail to its attorney of record in this matter at the address of record:

Jennison & Shultz, P.C.,
2001 Jefferson Davis Hwy
Suite 1102
Arlington, VA 22202.

BY:



J J Holand Limited
By : Keith Murray McCulloch
Authorized Officer and Representative
87/171, Wireless Road
Pathumwan
Bangkok 10330
THAILAND

March 14, 2013

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

In the matter of trademark Registration No. 3409520
For the mark YES
Date registered: April 8, 2008

In the matter of trademark Registration No. 3418779
For the mark YES INTERNATIONAL
Date registered: April 29, 2008

J J HOLLAND LIMITED,	:	
	:	
Petitioner,	:	Cancellation No. 92055738
	:	
v.	:	
	:	
POTOMAC TOBACCO COMPANY, LTD.	:	
	:	
Registrant.	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Amended Consolidated Petition to Cancel

J J Holand Limited, a British Virgin Islands corporation, having its registered address at International Trust Building, Wickhams Cay 1, Road Town, Tortola, British Virgin Islands, and an administration office at 87/171 Wireless Road, Pathumwan, Bangkok 10330, Thailand ('JJH') to which administrative office address all correspondence should be sent, believes that it is or will be damaged by the above identified registrations, and pursuant to 15 U.S.C. §1064 *et seq.* and 37 C.F.R. §2.11 *et seq.*, petitions to cancel the same.

The Registrant, Potomac Tobacco Company Ltd., is a British Virgin Islands corporation, with a registered address at The Creque Building, P.O. Box 116, Road Town, Tortola, British Virgin Islands ('Potomac'). Potomac has appointed its US attorneys at the law firm of Jennison & Shultz, P.C. at 2001 Jefferson Davis Highway, Suite 1107, Arlington, Virginia 22202, as their attorneys ('Jennison') in these proceedings.

The grounds for cancellation are as follows:

1. JJH is inter alia in the business of the marketing, sale and distribution of consumer products, including cigarettes.
2. JJH has invested a great deal of time and money in developing and promoting its business and the professional quality of goods bearing its trademarks, and is continuing to spend substantial time and money in organizing and developing its business and promoting its goods and trademarks.
3. JJH has filed a trademark application for YES in International Class 34, on intent-to-use basis, for cigarettes and matches on October 14, 2011 and received application serial number 85447339, amending the drawing to YES! on May 31, 2012 (“JJH’s Current YES! Application”)
4. JJH’s said application 85447339 was further made in light of its common law rights having used the said mark in U.S. Commerce in 2003-2006 and having had the US registration previously for YES! – Registration No. 2,813,328 (“JJH’s First YES! Registration”) - and a significant investment in the mark.
5. JJH has received an Office Action dated February 11, 2012 from the USPTO Examining Attorney refusing registration of its application Serial No. 85447339 due to two registrations held by Potomac, namely registration numbers 3409520 and 3418779. Accordingly, JJH is damaged by Potomac’s marks remaining in the Principle Registry.
6. JJH’s First YES! Registration was applied for on intent-to-use basis on February 22, 2000 (“JJH’s First YES! Application”). JJH filed its statement of use, citing its date of first use on May 29, 2003, and the application matured to registration on February 10, 2004.
7. Potomac on July 31, 2001, filed its intent-to-use basis application (15 U.S.C. §1051(b)) for registration of the mark, YES (application 76-292,227) in the same International Class 34, for “tobacco, cigarettes, and cigars; matches” (‘Potomac’s YES Application’).

8. On information and belief, at the time of the filing Potomac's YES Application on July 31, 2001, Potomac knew or should have known of JJH's First YES! Application, it having been applied for in February 2000 and Published on December 5, 2000.
9. On information and belief, at the time of the filing Potomac's YES Application on July 31, 2001, Potomac lacked a genuine intent to use the YES mark in Commerce on or in connection with tobacco or cigars. Despite being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such false statements may jeopardize the validity of the application or any resulting registration, Potomac nevertheless knowingly and willfully falsely averred that it had the intent to use the mark on or in connection with those goods. On information and belief, Potomac did so with the intent to deceive the USPTO.
10. On September 18, 2001, the USPTO issued an Office Action suspending Potomac's YES Application on the basis of likelihood of confusion with the then pending JJH's First YES! Application.
11. On information and belief, Potomac never disputed the likelihood of confusion between the two marks as cited by the Examining Attorney in the Office Action.
12. On October 9, 2002, nearly a year after the USPTO issued its Office Action citing JJH's First YES! Application as a potential bar to Potomac's YES Application and five months after Potomac received the notice of suspension of its YES Application – Potomac, filed another §1051(b) Intent-to-use basis application with the USPTO, Application Serial No. 76/459,015 (which matured into Reg. No. 3,418,779), this time seeking to register the mark 'YES INTERNATIONAL & Design' for "tobacco, cigarettes, and cigars; matches ('Potomac's YES INTERNATIONAL Application').
13. On information and belief, despite being aware of JJH's First YES! Application, and despite being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such false statements may jeopardize

- the validity of the application or any resulting registration, Potomac nevertheless averred in its YES INTERNATIONAL application that no other person had the right to use the mark in commerce, either in identical form or in such near resemblance as to be likely to cause confusion. 15 U.S.C. §1051 (b)(D).
14. On information and belief, at the time of the filing Potomac's YES International Application on October 9, 2002, Potomac lacked a genuine intent to use the YES International mark on or in connection with tobacco or cigars. Despite being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such false statements may jeopardize the validity of the application or any resulting registration, Potomac nevertheless knowingly and willfully falsely averred that it had the intent to use the mark on or in connection with those goods. On information and belief, Potomac did so with the intent to deceive the USPTO.
 15. Potomac was notified by the examining attorney on February 27, 2003 of JJH's First YES! Application and a finding of likelihood of confusion between the two applications' respective marks, and on October 1, 2003 a Letter of Suspension was mailed, suspending Potomac's YES INTERNATIONAL Application pending final registration of JJH's First YES! Application.
 16. On information and belief, Potomac never disputed the likelihood of confusion between the two marks referred to in the Office Actions.
 17. The Registration of JJH's First YES! Application was then made on the Principal Register on February 10, 2004, Registration Number (2813328).
 18. JJH was notified on March 19, 2004 by the TTAB of a Petition filed by Potomac to cancel the registration of JJH's First YES! Mark (Cancellation Petition No. 92043112). Potomac's Petition was prepared and submitted by its current counsel, Ms. Shultz of Jennison, with Mr. John N. Jennison and Mr. Carl E. Jennison as co-counsel from Jennison.

19. In Potomac's Petition to Cancel JJH's First YES! Registration, the TTAB's *Medinol Ltd.* (id) decision, and the fraud standard under the Lanham Act, together with relevant case law, including but not limited to *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USP2d 1483 (Fed. Cir. 1986) and *In Re: Bose Corporation* (Fed. Cir. 2009) are we believe instantly and inherently intrinsic to JJH's Petition to Cancel. These cases are not merely the law controlling this Petition (albeit that *Medinol Ltd.* 67 USPQ2d 1205 was overruled by the U.S. Court of Appeals for the Federal Circuit), but are particularly relevant and are material facts in that they relate to Potomac's and Jennison's knowledge, obligations and intent in the prosecution and registration of the two registrations in this Cancellation Proceeding. Potomac did not obtain its two registrations merely through the regular application process, but first it had to obtain cancellation of a competitor's, JJH's, previously registered and in-use mark, otherwise its applications would remain suspended until ultimately being cancelled.
20. On information and belief, Potomac used the *Medinol, Ltd.* decision (67 USPQ2d 1205), to clear the way for the registration of its YES and YES INTERNATIONAL applications, which were filed substantially later than JJH's First YES! Application, and could not otherwise be registered.
21. On information and belief, Potomac's two applications filed on an intent-to-use basis (15 U.S.C. §1051(b)) for not only cigarettes in International Class 34, on which they had a genuine intent to use the marks, as they used them in other countries, but also included tobacco, cigars and matches. While matches are a common incidental or supporting good for cigarettes for marketing purposes, as is common practice in the cigarette industry, however using the same mark on cigarettes as well as cigars and tobacco are not.
22. On information and belief, Potomac and its parent company are engaged in manufacture and sale of cigarettes, and do not manufacture and sell cigars and tobacco under either the YES or YES INTERNATIONAL marks while also using the marks on cigarettes.

23. Potomac's paragraphs 3 and 4 of their 2004 Petition to Cancel, with respect to Potomac's YES and YES INTERNATIONAL Applications, respectively, both state
- “The application, which is based on the petitioner's bona fide intention to use the mark in commerce in connection with those products ...”
- The identified products for both the YES and YES INTERNATIONAL applications at the time of application and at the time of filing the Potomac Petition and stated in paragraphs 3 and 4 respectively were “tobacco, cigarettes, and cigars; matches”.
24. On information and belief, Potomac was aware that its applications were false if not from the beginning, then at the latest when it prepared to file the petition to cancel JJH's YES! Trademark in those prior proceedings. While the details of those proceedings may not be disputed here, the inference of knowledge and the actions of Potomac provide insight into the mind of an applicant not always available in a case where fraud in the application or prosecution of a trademark is alleged. Potomac did not correct the material false misrepresentations in either of its applications, which would have been a natural step to take if Potomac had ever believed its applications to be accurate or if Potomac did not intend to deceive the USPTO with respect to its applications.
25. Ultimately, Potomac's Petition for Cancellation was granted by the TTAB on December 14, 2006, with the Commissioner issuing the cancellation of JJH's YES! Registered Mark on December 18, 2006 from the Principal Registry.
26. After the cancellation of JJH's YES! Registered Mark, the suspensions placed on Potomac's marks were lifted and the process to mature registrations was resumed after holds of approximately 5 years and 4 years respectively.
27. On information and belief, Potomac allowed both of the applications to be unsuspending without notifying the USPTO of the false statements in its two applications. See USPTO TDR Files for Yes (Registration 3409520) and Yes International (Registration 3418779).

28. On information and belief, prior to USPTO Publication of the YES and YES INTERNATIONAL marks under Potomac's applications, Potomac was sent a Notice of Publication listing the details for publication.
29. On information and belief, Potomac did not respond to either Notice to request the USPTO to remove two of the goods, cigars and tobacco, from the applications prior to Publication, despite knowing that it lacked the required intent to use the mark on said goods.
30. Publication was on June 5, 2007 for YES, listing all four goods.
31. Publication was on April 24, 2007 for YES INTERNATIONAL, listing all four goods.
32. A Notice of Allowance was issued for Potomac's YES INTERNATIONAL application on July 17, 2007. The Notice of Allowance issued for "034 - Tobacco, cigarettes and cigars; matches".
33. A Notice of Allowance was issued for Potomac's YES application on August 28, 2007. The Notice of Allowance issued for "034 - Tobacco, cigarettes and cigars; matches"
34. At this time, Potomac had the legal ability to request extensions of time to allow it to have use on goods which it did not use in Commerce in the first six months after the Notice of Allowance was given, such extensions not exceeding six months each, for a total period up to three years from the date of the Notice of Allowance.
35. Potomac also had the ability to divide its applications, to allow the registrations to mature with respect to the goods it had used the mark on or in connection with, while preserving the other goods, in this case, cigars and tobacco, which it professed having an intent to use it on for so many years, for up to another two and a half years. However, it did not do so.
36. On information and belief, it was not until Potomac's applications were nearing final registration and when Potomac filed its Statements of Use in early January 2008, which occurred during the first 6-month period after issuance of the Notices of Allowance, did Potomac finally admit to the USPTO that it did not intend to use either the YES or YES

- INTERNATIONAL Marks in connection with two of the goods, cigars and tobacco, which had been listed on those applications since July 2001 and October 2002 respectively.
37. Matches, the sole other good which will ultimately remain in Potomac's Registrations, being related and incidental to the use on cigarettes, a fact illustrated by the only product sample accompanying Potomac's YES's Statement of Use, being a picture of 4 packets of matches, which show copy of "20 Class A Cigarettes", with no mention of the content of the package itself, namely matches.
38. In contrast to Potomac's January 2008 Statement of Use submissions claiming use on both cigarettes and matches from January 2004, in March 2004, Potomac, during the prosecution of the two Potomac Applications, still affirmatively stated to the TTAB that it did intend to use the mark on those four goods.
39. Potomac filed its Statement of Use for its YES Application on January 8, 2008, alleging first use in Commerce on January 14, 2004, at the time when Potomac knew JJH was already using its YES! Mark (Reg. 2813328 eventually issued on February 10, 2004).
40. Potomac filed its Statement of Use for the YES INTERNATIONAL application on January 8, 2008. Potomac's Statement of Use alleges first use in commerce on January 14, 2004, on a date and at the time when Potomac knew JJH was already using its YES! Mark (Reg. 2813328 eventually issued on February 10, 2004).
41. Paragraph 14 of Potomac's Petition to Cancel JJH's registered YES! mark (cancellation proceedings 92043112) dated March 19, 2004, boldly proclaims:
- "The continued existence of U.S. Registration No. 2,813,328 casts a cloud upon petitioner's right to continue to use, register and expand the use of its YES and YES INTERNATIONAL trademarks, all to the great injury of Petitioner." [emphasis added].
42. Potomac stated in both of its respective Statements of Use for YES and YES INTERNATIONAL that it believed it was the owner of the mark they sought to register. On information and belief, as Potomac and Jennison knew of and had acknowledged JJH's use of

- the mark YES! on cigarettes and also knew JJH had common law rights in the mark, the knowingly false claim of belief of Potomac's ownership was not made in good faith and was made with the intent to deceive the USPTO. On information and belief, the USPTO relied upon such material false statements.
43. Potomac also stated in both of its respective statements of use for YES and YES INTERNATIONAL "that the trademark is now in use in commerce".
 44. Attached to Potomac's Statement of Use for YES, submitted in January 2008, was a sample of the mark (a photograph of apparently 4 packs of book matches bearing the Mark and also marked "EXCLUSIVE DISTRIBUTORS ORIGINAL TOBACCO 305-259-7000").
 45. On information and belief, the Original Tobacco referred to on Potomac's YES sample was a Florida based company which filed for registration in July 2006 and was dissolved in July 2009. On information and belief, despite being the exclusive distributor for Potomac for YES we found no indication of Original Tobacco obtaining FTC approval for packaging, registering under the Master Settlement Agreement or Florida's Tobacco Settlement Agreement or taking other steps to enable sale of YES cigarettes.
 46. On information and belief, Potomac has not made continuous use of the YES Trademark in Commerce from the date claimed, and did not have active use of the Mark in Commerce at the time of signing the Statement of Use on both products as claimed. As factual support for the foregoing belief, inter alia, we point to the fact that Federal Regulations on cigarettes (one of the two goods on Potomac's YES statement of use) are quite stringent, obtaining approval for sale in the US in Commerce has many requirements, including approval of warning labels on packaging by the FTC. YES was not listed in the June 2008 listing of approved brands issued by the FTC in this regard. Potomac and/or Original Tobacco are not listed in the National Association of Attorneys General's (NAAG) web site as a Participating Manufacturer in the Tobacco Master Settlement Agreement (MSA) or in Florida under their Tobacco Settlement Agreement. Nor have we found Potomac and/or Original Tobacco and

- the YES brand listed as approved as a Non Participating Manufacturer's brand in any of the many US States Attorney General's web sites that we have investigated, including the four states that did not sign the MSA.
47. The Statement of Use for YES INTERNATIONAL was signed on 13 December 2007, and attached thereto was a sample of the mark (a photocopy of apparently 2 packs of cigarettes bearing the Mark).
 48. JJH believes Potomac cannot in good faith claim and is not entitled to claim valid use in Commerce on the YES and YES INTERNATIONAL marks in January 2004 when said trademark applications were at that time validly suspended due to likelihood of confusion with JJH's First YES! Application, which matured into registration the following month – February 2004, and JJH was actively then using the mark and sending cease and desist notices to Potomac, particularly in light of the fact that the alleged use was for the same primary good - cigarettes, and Potomac was well aware of JJH's use of, rights and interests in its YES! Trademark, and of the likelihood of confusion between the marks.
 49. On information and belief, Potomac did not have a valid and truthful Statement of Use justifying the registration of the YES mark when it filed its Statement of Use in January 2008 based on its claim of then current continuous use and its first use, in January 2004 on cigarettes and matches.
 50. On information and belief, Potomac knew that it was knowingly making false, material misrepresentations with the intent to deceive the USPTO when it filed its Statement of Use for YES.
 51. On information and belief, Potomac did not have a valid and truthful Statement of Use justifying the registration of the YES INTERNATIONAL mark when it filed its Statement of Use in January 2008 based on its claim of current continuous use and its first use, in January 2004 on cigarettes and matches.

52. On information and belief, Potomac knew that it was knowingly making false, material misrepresentations with the intent to deceive the USPTO when it filed its Statement of Use for YES INTERNATIONAL.
53. JJH's common law rights in the YES! Trademark and other legal rights are not terminated by the cancellation of its prior registration by the USPTO.
54. Potomac and Jennison knew of JJH's common law rights in the YES! mark arising from JJH's use of the mark which predated the use alleged by Potomac on its two marks. On information and belief, when Potomac in its respective Statements of Use for YES for YES INTERNATIONAL, after being warned that willful false statements and the like so made are punishable by fine or imprisonment, or both and that such willful false statements may jeopardize the validity of the application or any resulting registration, declared that they believe the applicant to be the owner of the trademark sought to be registered without reference to the known ownership rights of JJH, Potomac made both such statements willfully knowing they were false.
55. Potomac and Jennison knew that the prior suspension of the two Potomac applications had been based upon the JJH YES! mark, due to a likelihood of confusion as found by the Examining Attorney, a fact which Potomac did not dispute with either the Examining Attorney or allege in prior proceedings where Potomac could have done so had they felt it was a finding which could be disputed. Potomac and Jennison also knew that the JJH YES! trademark and Potomac's two marks YES, and YES INTERNATIONAL (INTERNATIONAL disclaimed) respectively, were essentially the same or were so similar that not only was there a likelihood of confusion but that actual confusion had already occurred in the market.
56. On information and belief, Potomac and Jennison knew that with JJH's common law rights in the YES! trademark for cigarettes, the prior suspension of the two Potomac applications based on the JJH YES! mark, due to likelihood of confusion, and the actual confusion that

- had already occurred in the market in relation to cigarettes, that if they were to disclose any of those as a caveat to their declarations in the two Statements of Use, that Potomac would not be entitled to registration, and therefore proceeded with such material false statements with the intent to deceive the USPTO in order to obtain registrations to which Potomac was not entitled.
57. On information and belief, Potomac was not entitled to registration of its marks due to the likelihood of confusion with the YES! trademark and common law rights owned by JJH by its prior use of the mark on cigarettes, the same primary good for both applications which Potomac was seeking completion of the registration, which both included Cigarettes and Matches. There is a clear and recognized likelihood of confusion between the three marks.
58. Neither Potomac nor Jennison can claim ignorance, confusion, misunderstanding or the like with respect to the requirements of intent on an-intent-to-use basis application. The facts show that they were fully aware of the relevant requirements under US trademark law and knowingly and with the intent to deceive the USPTO made false representations about the pending applications to support those requirements to the USPTO in the procurement of its registrations and also during the prosecution of Potomac's applications for registration.
59. On information and belief, the TTAB relied upon the false and material declarations of Potomac, both in its applications and the Potomac Petition.
60. Potomac's YES Application matured into a registration on the Principal Register on April 8, 2008, Registration 3,409,520.
61. Potomac's YES INTERNATIONAL Application matured into a registration on the Principal Register on April 29, 2008, Registration 3,418,779.

Separate claims for cancellation based upon abandonment

Notwithstanding the other basis for cancellation of the marks outlined hereinabove, we also submit that the YES and YES INTERNATIONAL marks should be cancelled due to

abandonment. In support therefore, and in addition to the relevant facts set forth hereinabove – especially the fact that neither trademark has approved packaging with the FTC, we further set forth the following:

62. On information and belief, despite claiming use of YES on January 19, 2004 for cigarettes and matches in its January 14, 2008 Statement of Use, and receiving its registration based upon its claimed first use on that date, Potomac has not subsequent to such date made valid and continuous use of the mark YES in Commerce on cigarettes and matches as required.
63. On information and belief, Potomac lacks a bona-fide intention to resume use of the YES mark in Commerce on or in connection with cigarettes and matches.
64. On information and belief, the YES Trademark Registration 3409520 should accordingly now be cancelled due to abandonment.
65. On information and belief, despite claiming use of YES INTERNATIONAL on January 19, 2004 for cigarettes and matches, in its January 14, 2008 Statement of Use, and receiving its registration based upon its claimed first use on that date, Potomac has not subsequent to such date made valid and continuous use of the mark YES INTERNATIONAL in Commerce on cigarettes and matches as required.
66. On information and belief, Potomac lacks a bona-fide intention to resume use of the YES INTERNATIONAL mark on or in connection with cigarettes and matches.
67. On information and belief, the YES INTERNATIONAL Trademark Registration 3418779 should accordingly now be cancelled due to abandonment.
68. Petitioner believes that through discovery and taking of evidence significant additional evidence will be available which will support each of the allegations made on information and belief hereinabove.

CONCLUSION :

69. On information and belief, the continued existence of the subject registrations not only prevent JJH from proceeding with its JJH's Second YES! Trademark Application, but have

and continue to cause JJH serious injury and serious damages. JJH is entitled to full and complete relief, through the striking of Potomac's marks. Based on all of the foregoing, the two Registrations by Potomac should be cancelled and stricken from the USPTO Permanent Registry and thereafter, JJH should be free to proceed with its aforementioned application for its mark.

Wherefore, Petitioner deems that it is or will be damaged by Registration No. 3409520 and Registration No. 3418779, and as the facts and legal issues involved are largely in common justifying a consolidated petition, petitions for cancellation thereof.

In accordance with 37 C.F.R. §2.6(a)(16), the \$600 filing fee for this consolidated amended petition was attached to the original petition dated June 1, 2012.

Respectfully submitted,

J J Holand Limited

A handwritten signature in black ink, appearing to read 'K. Murray McCulloch', written over a horizontal line.

By: Keith Murray McCulloch
Authorized Officer and Representative

Date: March 14, 2013