

ESTTA Tracking number: **ESTTA552969**

Filing date: **08/08/2013**

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	Oroleon, LLC		
Entity	limited liability company	Citizenship	wyoming
Address	60 EAST SIMPSON AVENUE JACKSON,, WY 83001 UNITED STATES		

Correspondence information	Catherine Cary Cary Law Center, PC PO Box 763 San Francisco, CA 94104 UNITED STATES info@catherinecary.com Phone:888-647-9418
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Registration Subject to Cancellation

Registration No	3822499	Registration date	07/20/2010
Registrant	BEYOND EN-LINEA, LLC SUITE 850 200 SW FIRST AVENUE FORT LAUDERDALE, FL 33301 UNITED STATES		

Goods/Services Subject to Cancellation

<p>Class 009. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: Computer software for use in database management; computer software for uploading, manipulating, and enhancing digital content, documents, photographs, images, video, and audio; computer software for linking metadata tags with photographic and other media files to enable search engine retrieval and database software collections of files and their on-line sharing, and for linking metadata tags with web pages visited, to create links which users can maintain for themselves and share with on-line groups and website tagging</p>
<p>Class 035. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: Providing an online directory information service featuring information regarding, and in the nature of, sports, classifieds, virtual community, social networking, photo sharing, and transmission of photographic images; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet</p>
<p>Class 038. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of sports; providing multiple user access to information, audio, and video via websites, online forums, chat rooms, automatic mailing list servers, and blogs over the Internet</p>
<p>Class 039. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: Electronic storage of media objects and</p>

other digital content including text, documents, photographs, images, video, and audio
Class 041. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: Education and entertainment services, namely, providing a website featuring audio clips, video clips, film clips, photographs, other multimedia materials, and information related to sports, sporting and recreational events and activities; weblogs featuring information related to sports, sporting and recreational events and activities
Class 042. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: Computer services, namely, Providing a website with a virtual Internet community for sports participants and enthusiasts, which allows computer users to upload, exchange and share audio and video logs, and photos; Computer services, namely, hosting online web facilities for others to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications network
Class 045. First Use: 2009/11/02 First Use In Commerce: 2009/11/02 All goods and services in the class are cancelled, namely: Internet based introduction and social networking services

Grounds for Cancellation

Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Related Proceedings	Petitioner filed an appeal to the Trademark Trial and Appeal Board the refusal to register the mark "Mazimo Magic" in Application Serial No. 85499110
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85499110	Application Date	12/19/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MAZIMO MAGIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 038. First use: First Use: 2004/08/13 First Use In Commerce: 2004/08/13 Telecommunication services, namely, providing online facilities for real-time interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices on topics of general interest; Providing email and instant messaging services; Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; Providing an online community forum for transmission of messages among registered users to share information, text, photos, audio and video content, their likes and dislikes, to get feedback, to form virtual communities, and to engage in social networking</p> <p>Class 045. First use: First Use: 2004/08/13 First Use In Commerce: 2004/08/13 Providing a website on the internet for the purpose of social networking for general interest purposes</p>		

Attachments	InRe3822499PetitionCancel.pdf(172822 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	/cac/
Name	Catherine Cary
Date	08/08/2013

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

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6 ***In re* Registration No. 3,822,499**
7 **Registered Jul. 20, 2010**
8 **For: MAZIMOU**

Cancellation No.: _____

9 OROLEON, LLC

PETITION FOR CANCELLATION

10 Petitioner,

11 vs.

12 BEYOND EN-LINEA, LLC
13 , a Florida Limited Liability Company,

14 Registrant.

15
16 UNITED STATES PATENT AND TRADEMARK OFFICE
17 Trademark Trial and Appeal Board
18 P. O. Box 1451
19 Alexandra, Virginia 22313-1451

20 Dear Madam/Sir:

21 Oroleon, LLC (“Petitioner”), a limited liability company duly organized under the laws of
22 the State of Wyoming, 60 East AST Simpson Avenue, Jackson, Wyoming 83001, has been
23 and believes it will be damaged by the continued registration of Trademark Registration No.
24 3,822,499 issued by the U.S. Patent and Trademark Office (“PTO”) on Jul. 20, 2010 for the
25 trademark MAZIMOU (the “Mark”), which was registered by Respondent Beyond En-
26 Linea, LLC, a Florida limited liability company (“Registrant”). Petitioner hereby petitions
27 to cancel registration of the Mark. To the best of Petitioner’s knowledge, the principal
28 address and registered agent at 10011 SW 60 Street, Miami, Florida 33173.

1 The grounds for this cancellation follow:

2 **I. Petitioner Meets All Required Elements for the Requested Cancellation.**

3 A. A successful Petition for Cancellation must plead and prove two elements:
4 that Petitioner has standing to file the Petition to Cancel in that it believes it is likely to be
5 harmed by continued registration, and valid grounds that the registration of the Mark should
6 be cancelled. T.B.M.P. § 309.03(a)(2); T.B.M.P. § 309.03(b). For a Petition that is filed
7 within the first five years of the disputed Registration, valid grounds for cancellation include
8 abandonment and any ground that would have prevented registration in the first place.
9 Trademark Act Section 14, and *International Order of Job's Daughters v. Lindeburg & Co.*,
10 727 F.2d 1087, 220 U.S.P.Q. 1017 (Fed. Cir. 1984).

11
12 B. Petitioner believes that the mark MAZIMOU has been abandoned.

13 C. Petitioner's belief in the risk of harm is well-founded: Registrant's ownership
14 of the Mark has already damaged Petitioner because it was cited by the PTO Examining
15 Attorney as grounds to block Petitioner's registration of the mark MAZIMO MAGIC.
16 Petitioner's Trademark Registration Application was refused registration by an Examining
17 Attorney at the PTO in a Final Office Action dated November 14, 2012 on the grounds of
18 likelihood of confusion with Registrant's registration of the MAZIMOU mark. Furthermore,
19 a request for reconsideration was also denied on May 29, 2013 pursuant to 37 C.F.R.
20 §2.64(b); and TMEP §§715.03(a)(2)(B), (a)(2)(E), 715.04(a). Thus, the refusal has been
21 made final, and is maintained and continues to be final.

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24 C. The continued registration of an abandoned mark as well as a confusingly
25 similar mark will further damage Petitioner within the meaning of Section 14 of the Lanham
26 Act for it will prevent Petitioner from registering their mark MAZIMO MAGIC.

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II. Petitioner Seeks Cancellation due to Abandonment

A. It was indicated to Petitioner that the Beyond En-Linea, LLC is no longer using the Mark MAZIMOU, nor doing business. Furthermore, the attorney of record for the Mark indicated that his client or contact with Beyond En-Linea, LLC is no longer part of the business.

B. Petitioner also confirmed with the Secretary of State for Florida that the limited liability company, Beyond En-Linea, LLC is no longer active. See Exhibits 000 and 001

C. Petitioner saw, prior to contact with Beyond En-Linea, LLC, previous examples that the Mark seemed to be abandoned. Petitioner saw that the website, www.mazimou.com, did not seem to provide entirely the goods or services it was registered for. Video content seemed to be only items posted and no noticeable way to contact the website owners. See Exhibits 002 through 005.

III. Petitioner is the Senior User in Commerce of the Mark MAZIMO MAGIC, and Invested in its Considerable Good Will.

A. Since at least as early as Aug. 13, 2004, Petitioner, by virtue of its licensors and predecessors in interest, has continuously used in interstate commerce the trademark MAZIMO MAGIC for and in connection with the goods/services applied for in it application, namely: Telecommunication services, namely, providing online facilities for real-time interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices on topics of general interest; Providing email and instant messaging services; Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest;

1 Providing an online community forum for transmission of messages among registered users
2 to share information, text, photos, audio and video content, their likes and dislikes, to get
3 feedback, to form virtual communities, and to engage in social networking; and Providing a
4 website on the internet for the purpose of social networking for general interest purposes.

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6 B. The Mark MAZIMOU registration covers the following description:

7 Computer software for use in database management; computer software for uploading,
8 manipulating, and enhancing digital content, documents, photographs, images, video, and
9 audio; computer software for linking metadata tags with photographic and other media files
10 to enable search engine retrieval and database software collections of files and their on-line
11 sharing, and for linking metadata tags with web pages visited, to create links which users
12 can maintain for themselves and share with on-line groups and website tagging; Providing
13 an online directory information service featuring information regarding, and in the nature of,
14 sports, classifieds, virtual community, social networking, photo sharing, and transmission of
15 photographic images; advertising and information distribution services, namely, providing
16 classified advertising space via the global computer network; promoting the goods and
17 services of others over the Internet; providing on-line chat rooms and electronic bulletin
18 boards for transmission of messages among users in the field of sports; providing multiple
19 user access to information, audio, and video via websites, online forums, chat rooms,
20 automatic mailing list servers, and blogs over the Internet; Electronic storage of media
21 objects and other digital content including text, documents, photographs, images, video, and
22 audio; Education and entertainment services, namely, providing a website featuring audio
23 clips, video clips, film clips, photographs, other multimedia materials, and information
24 related to sports, sporting and recreational events and activities; weblogs featuring
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1 information related to sports, sporting and recreational events and activities; Computer
2 services, namely, Providing a website with a virtual Internet community for sports
3 participants and enthusiasts, which allows computer users to upload, exchange and share
4 audio and video logs, and photos; Computer services, namely, hosting online web facilities
5 for others to enable uploading, posting, showing, displaying, tagging, blogging, sharing or
6 otherwise providing electronic media or information over the Internet or other
7 communications network; and Internet based introduction and social networking services.
8

9 C. Oroleon, LLC, its licensors, and predecessors in interest have invested
10 considerable effort into maintaining the good will of the MAZIMO MAGIC mark and with
11 the services it provides.

12 D. Petitioner's MAZIMO MAGIC mark is famous and has developed common
13 law rights through Petitioner's continued use in interstate commerce since 2004. Petitioner's
14 MAZIMO MAGIC mark was famous prior to Registrant's adoption of Mark MAZIMOU on
15 Nov. 2, 2009, and had been in continuous use in interstate commerce for nine years, and
16 counting. Furthermore, Petitioner's MAZIMO MAGIC mark was famous and developed
17 common law rights before Registrant's Aug. 13, 2008 filing date for the Registration; again
18 Petitioner's famous MAZIMO MAGIC mark was in continuous use in interstate commerce
19 for six years at the time of Registrant's filing.
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21 D. Finding Petitioner's extensive use of the famous MAZIMO MAGIC mark
22 since 2004, the expenditures in promoting and developing its brand identity, is sufficient
23 evidence to illustrate fame and distinctiveness.
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1 **III. The Marks Are Confusingly Similar.**

2 A. To determine the “likelihood of confusion,” we need to address the
3 following eight factors:

- 4
- 5 • the similarity in the overall impression created by the two marks (including the
6 marks' look, phonetic similarities, and underlying meanings);
 - 7 • the similarities of the goods and services involved (including an examination of
8 the marketing channels for the goods);
 - 9 • the strength of the plaintiff's mark;
 - 10 • any evidence of actual confusion by consumers;
 - 11 • the intent of the defendant in adopting its mark;
 - 12 • the physical proximity of the goods in the retail marketplace;
 - 13 • the degree of care likely to be exercised by the consumer; and
 - 14 • the likelihood of expansion of the product lines.

15 See *Polaroid Corp. v. Polarad Elect. Corp.*, 287 F.2d 492 (2d Cir.), cert. denied, 368
16 U.S. 820 (1961).

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19 B. Similarity of the Marks. The Mark is registered as MAZIMOU. The
20 Trademark Examining Attorney stated that although there are slight differences between the
21 dominant characteristics of the marks, “mazimo” verses “mazimou;” this alone is not
22 enough to avoid confusion between the marks. The case at issue here in connection with
23 the above-referenced factors is that the Registrant’s MAZIMOU mark is in direct conflict
24 with Petitioner’s MAZIMO MAGIC mark. Specifically, the similarity and overall
25 impression of the marks are nearly identical.
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1 B. Relatedness of Goods/Services. The Trademark Examining Attorney for
2 MAZIMO MAGIC application pointed out that the Respondent's registration for the Mark
3 MAZIMOU and in connection with the goods/services was similar to Petitioner's
4 goods/services and thus could be perceived by the consuming public as to coming from a
5 coming source. In sum, the goods/services between the marks at issue here could give rise
6 to the mistaken belief as to a common source.
7

8 C. Likelihood of Expansion of the Product Lines. Oroleon, LLC, and its
9 licensors continue to invest and expand the good will of the MAZIMO MAGIC mark and
10 with the goods/services it provides. Due to the nature of the classes at issue here, it is highly
11 likely that the MAZIMO MAGIC mark goods/services will expand as its reputation grows.
12

13 D. As a result of the similarity between Petitioner's mark and Registrant's Mark
14 and the highly related nature of the goods associated with each party's respective mark,
15 Registrant's mark is likely to cause confusion, mistake or deception in the trade and among
16 purchasers as to the source, origin or sponsorship of the parties' respective goods and
17 services. The use of a trademark in connection with the sale of a good constitutes
18 infringement if it is likely to cause consumer confusion as to the source of those goods or
19 as to the sponsorship or approval of such goods. See, *Polaroid Corp. v. Polarad Elect.*
20 *Corp.*, 287 F.2d 492 (2d Cir.), cert. denied, 368 U.S. 820 (1961). In this particular instance, use
21 of the confusingly similar if not identical mark constitutes an infringing use of Petitioner's
22 MAZIMO MAGIC mark. Such use is a misappropriation of the goodwill Petitioner has
23 established and will unquestionably cause consumer confusion with Petitioner's famous
24 MAZIMO MAGIC mark as to the source and sponsorship of the goods/services at issue.
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1 **V. Registrant's Mark Potential Responses.**

2 A. Petitioner would like to address some of the potential responses that the
3 Registrant may have. In particular a Laches and Waiver defenses.

4 B. Laches requires a showing that "(1) [the] delay in filing suit was unreasonable,
5 and (2) [that the Registrant] would suffer prejudice caused by the delay if the suit were to
6 continue." See *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 838 (9th
7 Cir.2002). If the Registrant asserts laches, the Registrant must show that they suffered
8 prejudice as a result of the Petitioner's unreasonable delay in filing the Cancellation Petition.
9 The limitations period for laches starts "from the time the plaintiff knew or should have
10 known about its potential cause of action." See *Tillamook Country Smoker, Inc. v.*
11 *Tillamook County Creamery Ass'n*, 465 F.3d 1102 (9th Cir.2006). Since it seems that the
12 Mark at issue here has been abandoned and that there is a strong likelihood of confusion
13 between the Marks at issue here, this will trump any defense of acquiesce by the Senior User
14 in this case. See *Coach House Restaurant Inc. v. Coach & Six Restaurants, Inc.* 934 F. 2d
15 1551, 19 USPQ 2d 1401 (11th Cir. 1991).

16 C. In order for the Registrant to use the Waiver defense, they must provide
17 evidence of a "clear, decisive and unequivocal" intent by Petitioner to relinquish any of its
18 trademark rights. See *Adidas-America, Inc. v. Payless Shoesource, Inc.*, 546 F.Supp.2d
19 1029, 1074 (2008). Here, it is clear that the Petitioner is policing their Marks and being
20 proactive by filing this petition for cancellation to protect it marks as well as for applying for
21 the registration of its marks.

22 **V. Conclusion.**

23 The continued registration of the mark in the Registration will result in damage to
24

1 Petitioner under the provisions of 15 U.S.C. § 1052(d) and 15 U.S.C. § 1125(c), pursuant to
2 the allegations stated above.

3 The continued registration of the mark in the Registration will cause confusion
4 among consumers as to the separate and distinct sources of Registrant's goods and
5 Petitioner's goods and services and the relationship of Petitioner to Registrant, thereby
6 damaging Petitioner's substantial goodwill in Petitioner's Mark, diluting the value thereof,
7 and resulting in irreparable harm to Petitioner's business and reputation, all to the detriment
8 of Petitioner who has expended considerable sums and effort in promoting Petitioner's Mark.
9


10 WHEREFORE, in accordance with Section 14(1) of the Lanham Act (15 U.S.C.
11 §1064(1)), Petitioner prays that this Petition for Cancellation be granted and that U.S.
12 Trademark Registration No. 3,822,499 in classes 9, 35, 38, 39, 41, 42, and 45 be canceled.
13

14 The required fee of two thousand, one hundred dollars is tendered.

15 A duplicate copy of this Petition for Cancellation is filed herewith.

16 Respectfully submitted,

17
18
19 Dated: August 7, 2013

20 By: 
Catherine Cary
Attorney for Petitioner
Cary Law Center, P.C.
737 Post Street, #131
San Francisco, CA 94104
888-647-9418
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PROOF OF SERVICE

I am a citizen of the United States; I am over 18 years of age; my business address is PO Box 763, San Francisco, CA 94104. I am employed in the County of San Francisco.

I served on August 7, 2013:

PETITION TO CANCEL

on the interested parties, by placing a true and correct copy(ies) thereof in a sealed envelope and served as follows:

First Class Mail. I deposited such envelope(s), addressed to the registered agent at 10011 SW 60 Street, Miami, Florida 33173, with postage thereon fully prepaid in a U.S. mailbox in the County of San Francisco, California.

Personal Service


U.S. Postal Express Mail

UPS Over Night

Facsimile/Email. I caused an electronic copy(ies) of said documents(s) to be transmitted via email.

I declare under penalty of perjury under the laws of the United States that the above is true and correct.

EXECUTED this 7th day of August, 2013 at San Francisco, California.

By: 
Catherine Cary
Attorney for Petitioner
Cary Law Center, P.C.
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San Francisco, CA 94104
And
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And
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