

ESTTA Tracking number: **ESTTA928944**

Filing date: **10/16/2018**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	New Image Global, Inc.		
Entity	Corporation	Citizenship	California
Address	3002 Dow Avenue, Suite 108 Tustin, CA 92780 UNITED STATES		

Attorney information	Christopher Q. Pham JOHNSON & PHAM, LLP 6355 Topanga Canyon Boulevard, Suite 326 Woodland Hills, CA 91367 UNITED STATES cpham@johnsonpham.com, jvener@johnsonpham.com (818) 888-7540
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Registration Subject to Cancellation

Registration No.	5530554	Registration date	07/31/2018
Registrant	Blunt Wrap U.S.A., Inc. 629 Village Lane South Mandeville, LA 70471 UNITED STATES Email: BAN@RoyKiesel.com		

Goods/Services Subject to Cancellation

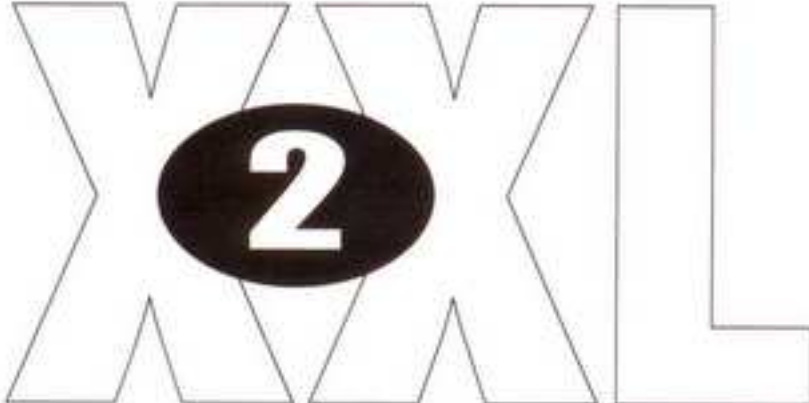
Class 034. First Use: 2016/01/01 First Use In Commerce: 2016/01/01 All goods and services in the class are subject to cancellation, namely: Smokable rolling papers for cigars and cigarillos
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Fraud on the USPTO	Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)


Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	4057940	Application Date	03/25/2009
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Registration Date	11/22/2011	Foreign Priority Date	NONE
Word Mark	XXL 2		
Design Mark			
Description of Mark	The mark consists of the stylized wording "XXL" with a number "2" in an oval.		
Goods/Services	Class 034. First use: First Use: 2009/02/01 First Use In Commerce: 2009/02/01 SMOKING ARTICLES, NAMELY, TOBACCO LEAVES AND FLAVORED TOBACCO LEAVES FOR ROLLING CIGARS, FLAVORED TOBACCO LEAVES IN THEFORM OF A SHEET FOR USE IN ROLLING CIGARS, AND TOBACCO		

U.S. Application No.	87730684	Application Date	12/21/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	XXL 2		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2009/02/01 First Use In Commerce: 2009/02/01 SMOKING ARTICLES, NAMELY, TOBACCO LEAVES AND FLAVORED TOBACCO LEAVES IN THE FORM OF A SHEET FOR USE IN ROLLING CIGARS		

U.S. Application No.	87731168	Application Date	12/21/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	XXL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2009/02/01 First Use In Commerce: 2009/02/01 SMOKING ARTICLES, NAMELY, TOBACCO LEAVES AND FLAVORED TOBACCO LEAVES IN THE FORM OF A SHEET FOR USE IN ROLLING CIGARS

Attachments	77699073#TMSN.png(bytes) 87730684#TMSN.png(bytes) 87731168#TMSN.png(bytes) 2018.10.16_Petition For Cancellation (DOUBLEXL) - Final.pdf(146540 bytes)
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Signature	/Christopher Q. Pham/
Name	Christopher Q. Pham
Date	10/16/2018

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

NEW IMAGE GLOBAL, INC., a California Corporation,

Petitioner,

v.

BLUNT WRAP U.S.A., INC., a Louisiana Corporation,

Respondent.

In re Trademark Registration No.: 5,530,554
Mark: DOUBLEXL

Registered: July 31, 2018
Cancellation Petition No.: _____

Respondent's Address(es):

Blunt Wrap U.S.A., Inc.
629 Village Lane South
Mandeville, LA 70471
Email: BAN@RoyKiesel.com

Respondent's Correspondent's Address(es):

Brett A. North
Garvey Smith Nehrbass & North LLC
3838 N Causeway Blvd., Ste. 3290
Metairie, LA 70002-8350
Email: brettnorth@gsnn.us

PETITION TO CANCEL

1. Petitioner NEW IMAGE GLOBAL, INC., located at 3002 Dow Avenue, #108, Tustin, California 92780 ("Petitioner"), is a longstanding seller and purveyor of tobacco products, including its XXL and XXL 2 marked products. Presently, Petitioner holds the following registrations and applications pending before the United States Patent and Trademark Office ("USPTO"):

<u>Reg. / App. No.:</u>	<u>Trademark:</u>	<u>Date of First Use at Least as Of:</u>	<u>Class and Goods Description:</u>
4,057,940 (the "940" mark or registration)	XXL 2	February 1, 2009	International Class 34: "Smoking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars"
87/731168 (the "168" mark or application)	XXL	February 1, 2009	International Class 34: "Smoking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars"
87/730684 (the "684" mark or application)	XXL 2	February 1, 2009	International Class 34: "Smoking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars"

2. To the best of Petitioner's knowledge, the name and address of the current owner of the mark DOUBLEXL, having the USPTO Registration No.: 5,530,554 in International Class 034, for "[s]mokable rolling papers for cigars and cigarillos," and with a claimed January 1, 2016, date of first use in commerce (the "554" mark or registration), and March 30, 2015 "intent-to-use" application filing date, is BLUNT WRAP U.S.A., INC., a Louisiana Corporation located at 629 Village Lane South, Mandeville, Louisiana 70471 ("Respondent").

3. Petitioner is currently and will continue to be damaged and irreparably harmed by the registration of the 554 mark, and hereby petitions to cancel the registration of the 554 mark, under the provisions of 15 U.S.C. §1064, on the following grounds:

FACTS

4. Petitioner sells and offers for sale a wide variety of smokable and tobacco related products. Petitioner wholesales its products to resellers for distribution throughout the United States and internationally. Amongst these products are Petitioner's XXL and XXL 2 marked products.

5. At least as of February 1, 2009, Petitioner has been selling and offering for sale, in interstate commerce, products marked XXL and XXL 2 consisting of “Smoking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars.”

6. On March 25, 2009, Petitioner filed an application before the USPTO for the registration of an XXL 2 mark, Application No. 77/699073, for “[s]moking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars, in International Class 34. This application ultimately matured into Petitioner’s current 940 registration for the mark XXL 2.

7. However, before this XXL 2 mark (now covered by the 940 registration) was registered, on December 3, 2010, Respondent filed, before the Trademark Trial and Appeal Board (“TTAB”) a Notice of Opposition to the registration of Petitioner’s XXL 2 mark, in the matter entitled *Blunt Wrap U.S.A., Inc. v. New Image Global, Inc.*, Opp. No.: 91197705 (the “Prior Opposition”).

8. Ultimately, on October 1, 2011, Petitioner and Respondent entered into a Trademark License Agreement, pursuant to which the Prior Opposition was withdrawn on October 17, 2011 (“Licensing Agreement”).

9. In pertinent part, under the terms of the Licensing Agreement, Petitioner granted to Respondent a non-exclusive license to use, under various restrictions, an “XXL” mark, pursuant to Petitioner’s rights in its XXL 2 mark, which was at that time pending registration under Application No. 77/699073, and which thereafter matured into the 940 registration.

10. In 2013, Respondent failed to make the contractual royalty payment or comply with the reporting requirement to Petitioner for use of an XXL mark, and seemingly ceased

licensed use of an “XXL” mark.

11. On or about December 21, 2017, Petitioner filed two applications before the USPTO for the marks XXL and XXL 2 (i.e. the 168 and 684 Applications), in International Class 34 for “Smoking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars.”

12. In response to these applications, on April 4, 2018, the assigned USPTO Examiners issued a Suspension Letter and an Office Action, respectively, on the grounds of possible Section 2(d) confusing similarity as a result of Respondent’s prior filed application for a DOUBLEXL trademark in Class 34 for “[s]mokable rolling papers for cigars and cigarillos,” Application Serial No. 86/581411.

13. A review of the March 30, 2015, Application with Serial No. 86/581411 for Respondent’s DOUBLEXL trademark indicates that upon filing said application, Respondent represented to the USPTO, the following, despite Respondent’s knowledge and prior licensing of Petitioner’s XXL 2 registered trademark:

“[A]pplicant is entitled to use the mark in commerce”

“The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.”

14. On June 17, 2015, the Examiner assigned to Respondent’s DOUBLEXL application issued an Office Action under Section 2(d) on the grounds that Petitioner’s DOUBLEXL mark is confusingly similar to Petitioner’s registered XXL 2 mark covered by the 904 registration.

15. Namely, the Examiner found that the terms DOUBLEXL and XXL in the respective marks are likely to cause consumer confusion as to the source of the same goods,

because these particular terms convey the same idea, stimulate the same mental reaction, and have the same overall meaning. Thus the marks are overall confusingly similar and impart a similar commercial impression.

16. Further, the DOUBLEXL Examiner found that both Respondent and Petitioner provide tobacco products for consumption and that consumers are likely to encounter Respondent's goods and Petitioner's goods in the same marketplace.

17. Accordingly, the DOUBLEXL Examiner concluded that the DOUBLEXL mark and Petitioner's XXL 2 mark, covered by the 904 registration, are confusingly similar because the marks share similar terms and both are borne upon tobacco products.

18. In Respondent's December 15, 2015 response to the June 17, 2015 DOUBLEXL Office Action, Respondent represented to the Examiner the following in arguing a lack of confusing similarity:

"First, it is respectfully submitted that the Examining Attorney has incorrectly concluded that registration no. 4057940 is for 'XXL' (concluding that 'The Registrant owns the mark XXL . . .'). This is not the case as the cited registration is actually for a stylized form of X-2-XL. The Applicant's mark is for 'DOUBLEXL' which is not similar to Registrant's stylized form of X-2-XL."

"...[I]f any breaking would be done by consumers, the mark would be broken into the parts 'DOUBLE' and 'XL'. This appears to be the breaking up construction that the Examining Attorney has taken - - where the Examining Attorney asks 'Does "double xl" have any meaning with respect to the goods identified?' This type of breaking up would at most end up being considered a double/doubling of XL (or XLXL) which is not confusingly similar to Registrant's stylized form of X-2-XL."

19. Respondent supplied these representations to the Examiner in order to obtain registration of its DOUBLEXL mark knowing full well as a result of the Prior Opposition and the Licensing Agreement that Petitioner's mark covered by the 904 registration is not an "X-2-XL" mark, and that the principal portion of the mark covered by the 904 registration is "XXL." Indeed, the "2" is disclaimed under the registration. Further, Respondent previously licensed the

right to use an “XXL” mark from Petitioner as a result of Petitioner’s rights in its XXL 2 mark covered by the 904 registration.

20. Respondent filed a Statement of Use for the DOUBLEXL mark in March 10, 2018, resulting in the 554 registration, which was issued on July 31, 2018, and which Petitioner now seeks to cancel.

COUNT 1 – CONFUSING SIMILARITY/PRIORITY

21. Petitioner has been using the marks XXL and XXL 2 continuously in commerce since at least as early as February 1, 2009, in connection with “Smoking articles, namely, tobacco leaves and flavored tobacco leaves in the form of a sheet for use in rolling cigars.”

22. By virtue of Petitioner’s extensive use, promotion, and advertising of its XXL and XXL 2 marked products, XXL and XXL 2 are recognized by the relevant consumers as identifying Petitioner as the source of tobacco products and tobacco related products bearing these marks. Accordingly, Petitioner’s XXL and XXL 2 marks are strong and distinctive. Further, Petitioner’s XXL 2 mark covered by the 904 registration has reached incontestability status with the USPTO.

23. On information and belief, Respondent asserts a January 1, 2016 date first use in commerce for the mark DOUBLEXL for “[s]mokable rolling papers for cigars and cigarillos.” Respondent’s Section 1(b) “intent-to-use” application for DOUBLEXL was filed on March 30, 2015.

24. The date of Petitioner’s first use in commerce of the marks XXL and XXL 2 is prior to the filing date of Respondent’s application for DOUBLEXL, and is also prior to Respondent’s date of first use of DOUBLEXL.

25. The products provided by Petitioner in connection with the marks XXL and XXL

2 have been previously found by a USPTO Examiner to overlap with the products that Respondent provides under the mark DOUBLEXL. Indeed, Respondent's and Petitioner's products are identical.

26. On information and belief, Respondent's products are offered broadly to all relevant consumers, including consumers of Petitioner's products. And, on information and belief, Respondent choose the DOUBLEXL mark with the express intent of causing confusion as to the source of Petitioner's and Respondent's products.

27. Respondent's DOUBLEXL mark is likely to cause confusion, mistake and/or deception among the consuming public regarding the source, affiliation and/or sponsorship between Petitioner and its products and Registrant and its products. Further, in previously issued Office Actions, USPTO Examiners have determined that DOUBLEXL, on the one hand, and XXL and XXL 2, on the other hand, are confusingly similar such that consumers viewing Registrant's mark are likely to be confused as to source of Respondent's products and to perceive an association between Petitioner and Respondent.

28. The continued registration of Respondent's DOUBLEXL mark is inconsistent with Petitioner's superior rights in Petitioner's XXL and XXL 2 marks and has caused and will continue to cause damage to Petitioner and Petitioner's rights in its XXL and XXL 2 marks. Further, as a result of the License Agreement, any assertion by Respondent denying Petitioner's rights in its XXL 2 and XXL marks are barred as a result of the doctrine of licensee estoppel. Thus, by virtue of Petitioner's superior rights, the contested DOUBLEXL registration is subject to cancellation and should therefore be cancelled.

COUNT 2 – FRAUD ON THE OFFICE

29. Respondent's application for the DOUBLEXL mark makes the representations

that:

“ [A]pplicant is entitled to use the mark in commerce”

“The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.”

30. Respondent made these statements to the USPTO fully aware of Respondent's superior rights in XXL and XXL 2 marks, both as a result of the Prior Opposition and given the Licensing Agreement. Indeed, Respondent has sought the confusingly similar DOUBLEXL registration in an effort to get around Petitioner's superior rights in XXL and XXL 2 and its prior licensing of the use of a XXL mark from Petitioner.

31. Accordingly, on information and belief, Respondent made false statements as to Respondent's purported right to use a DOUBLEXL mark as well as false statements with respect to Respondent's knowledge and beliefs regarding any other party's right to use a mark identical or confusingly similar to Respondent's purported DOUBLEXL.

32. On information and belief, Respondent made these false statements to the USPTO with the intent to procure a registration to which Respondent was not otherwise entitled, and Respondent, in conjunction with further false statements made to the USPTO, was successful in procuring allowance, publication and registration of its DOUBLEXL mark.

33. Respondent made further false statements to the USPTO in response to the Examiner's determination that DOUBLEXL is confusingly similar to XXL 2. Namely, Respondent stated to the Examiner:

“First, it is respectfully submitted that the Examining Attorney has incorrectly concluded that registration no. 4057940 is for ‘XXL’ (concluding that ‘The Registrant owns the mark XXL’). This is not the case as the cited registration is actually for a stylized form of X-2-XL. The Applicant's mark is for ‘DOUBLEXL’ which is not similar to Registrant's stylized form of X-2-XL.”

“...[I]f any breaking would be done by consumers, the mark would be broken into the parts ‘DOUBLE’ and ‘XL’. This appears to be the breaking up construction that the Examining Attorney has taken - - where the Examining Attorney asks ‘Does "double xl" have any meaning with respect to the goods identified?’ This type of breaking up would at most end up being considered a double/doubling of XL (or XLXL) which is not confusingly similar to Registrant's stylized form of X-2-XL.”

34. Respondent supplied these false representations to the Examiner knowing full well, as a result of the Prior Opposition and the Licensing Agreement, that Petitioner’s mark covered by the 904 registration is not an “X-2-XL” mark, and that the principal portion of the mark covered by the 904 registration is “XXL.” Respondent had previously licensed the right to use an “XXL” mark from Petitioner as a result of Petitioner’s rights in its XXL 2 mark covered by the 904 registration.

35. On information and belief, Respondent made these false representations to the USPTO examiner with the intent to deceive the Examiner and in order to procure the registration of Respondent’s DOUBLEXL mark, which was ultimately allowed, published and registered.

36. By virtue of Respondent’s fraudulent statements made to the USPTO by Respondent and the USPTO’s reliance thereon in granting Respondent a registration in the DOUBLEXL mark, the DOUBLEXL mark is subject to cancellation and should therefore be cancelled.

WHEREFORE, Petitioner requests and prays that U.S. Trademark Registration No.: 5,530,554 for the mark DOUBLEXL be cancelled and this Petition for Cancellation be sustained in favor of Petitioner.

Dated: October 16, 2018

Respectfully Submitted,
JOHNSON & PHAM, LLP
By: /Christopher Q. Pham/
Christopher Q. Pham
Attorneys for Applicant
NEW IMAGE GLOBAL, INC.