

ESTTA Tracking number: **ESTTA949143**

Filing date: **01/22/2019**

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	AWP USA Inc.		
Entity	Corporation	Citizenship	DC
Address	9950 Mayland Drive Richmond, VA 23233 UNITED STATES		

Attorney information	David Ludwig Dunlap Bennett & Ludwig PLLC 211 Church Street, SE Leesburg, VA 20175 UNITED STATES trademarks@dbllawyers.com 7037777319		
----------------------	---	--	--

Registration Subject to Cancellation

Registration No.	5323248	Registration date	10/31/2017
Registrant	Chubb INA Holdings Inc. 436 Walnut Street Philadelphia, PA 19106 UNITED STATES		

Goods/Services Subject to Cancellation


Class 009. First Use: 2016/00/00 First Use In Commerce: 2016/00/00 All goods and services in the class are subject to cancellation, namely: Downloadable mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool
--

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
--------------------------------------	---------------------------------------

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	87901868	Application Date	05/01/2018
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TRAVELSMART		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2013/03/25 First Use In Commerce: 2013/03/25 Downloadable mobile application software for providing information, services and support to travelers, namely, accessing and managing travel insurance policies and filing claims, obtaining travel information and support, geolocation, obtaining country information, translation, obtaining emergency services, medical professional and embassy contact and location information, and making calls to emergency services</p> <p>Class 042. First use: First Use: 2013/03/25 First Use In Commerce: 2013/03/25 Providing temporary use of web-based software for providing information, services and support to travelers, namely, accessing and managing travel insurance policies and filing claims, obtaining travel information and support, geolocation, obtaining country information, translation, obtaining emergency services, medical professional and embassy contact and location information, and making calls to emergency services</p>

Attachments	87901868#TMSN.png(bytes) TravelSmart Petition to Cancel_RJP.pdf(127748 bytes)
-------------	---

Signature	/David Ludwig/
Name	David Ludwig
Date	01/22/2019

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

IN THE MATTER OF Trademark Registration No. 5,323,248

For the mark: CHUBB TRAVEL SMART;

Date of Registration: Oct. 31, 2017

AWP USA INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
CHUBB INA HOLDINGS, INC.,)	
)	
Respondent.)	
_____)	

PETITION TO CANCEL

Pursuant to 15 U.S.C. §§ 1064, 1068, 37 C.F.R. § 2.111(b), and TBMP § 309.03(d), AWP USA Inc. (“Petitioner”), a District of Columbia corporation with its principal place of business at 9950 Mayland Drive, Richmond, VA 23233, believes that it is being and that it will continue to be damaged by United States Trademark Registration No. 5,323,248 for the mark CHUBB TRAVEL SMART currently owned by Chubb INA Holdings Inc. (“Respondent”), a Delaware corporation with its principal place of business at 436 Walnut Street, Philadelphia, PA 19106, and hereby petitions to cancel said registration. Respondent’s Registration is described as follows:

Mark:	CHUBB TRAVEL SMART
Services:	“Downloadable mobile applications for planning trips, receiving travel, weather, medical, safety, health, and security information, receiving security alerts, and currency converter tool” in International Class 009
Filed:	Apr. 10, 2017
Alleged First Use:	2016

Registered: Oct. 31, 2017

As grounds for cancellation, Petitioner alleges that:

1. Petitioner is the owner of U.S. Trademark Serial No. 87/901,868 filed on May 1, 2018 TRAVELSMART in connection with “[d]ownloadable mobile application software for providing information, services and support to travelers, namely, accessing and managing travel insurance policies and filing claims, obtaining travel information and support, geolocation, obtaining country information, translation, obtaining emergency services, medical professional and embassy contact and location information, and making calls to emergency services,” in International Class 009, and “Providing temporary use of web-based software for providing information, services and support to travelers, namely, accessing and managing travel insurance policies and filing claims, obtaining travel information and support, geolocation, obtaining country information, translation, obtaining emergency services, medical professional and embassy contact and location information, and making calls to emergency services,” in International Class 042.

2. Petitioner has continuously used its TRAVELSMART in the United States in interstate commerce since at least as early as March 25, 2013.

3. Respondent filed its registration on Apr. 10, 2017 and claimed a date of first use of 2016, almost three years after Petitioner first used its TRAVELSMART mark. Petitioner has clear priority of use.

4. The literal elements of the CHUBB TRAVEL SMART mark are extremely similar to the literal elements of Petitioner’s TRAVELSMART mark.

5. Respondent's services are closely related to the services that Petitioner offers under its TRAVELSMART mark in that both marks are used for providing apps for travelers with travel insurance functionality.

6. Respondent's CHUBB TRAVEL SMART mark so resembles Petitioner's TRAVELSMART mark that it is likely, when used in connection with Respondent's services to cause confusion, mistake, and/or deception as to the source and/or origin of Respondent's services, thereby irreparably damaging Petitioner and Petitioner's goodwill in its TRAVELSMART mark under 15 U.S.C. § 1052(d).

7. Continued registration of Respondent's CHUBB TRAVEL SMART mark is further likely to cause the public to assume erroneously that Respondent or its goods have been authorized, sponsored, or licensed by Petitioner, thereby irreparably damaging Petitioner and Petitioner's goodwill in its TRAVELSMART mark under 15 U.S.C. § 1052(d).

8. Customers familiar with Petitioner's TRAVELSMART mark would be likely to download Respondent's app believing it to be originating from or sponsored by Petitioner.

9. Petitioner is likely to be damaged by continuance of the Registration on these goods because the registered CHUBB TRAVEL SMART mark on these items will remain a cloud on Petitioner's legal right to continue to use, develop, and expand the use of Petitioner's TRAVELSMART Mark.

10. Respondent's goods as identified in its registration move through similar channels of trade to the same general class of purchasers as Petitioner's goods.

11. Given the substantial similarities between the sight, sound, meanings, and commercial impressions of the TRAVELSMART mark and the CHUBB TRAVEL SMART mark, in addition to the identical or substantially similar nature of the goods offered by Petitioner

under the TRAVELSMART mark and the Registrant under the CHUBB TRAVEL SMART mark, the overall commercial impressions of the TRAVELSMART and the CHUBB TRAVEL SMART mark are substantially similar, which erroneously suggests an affiliation between Petitioner and Registrant.

12. Considering Petitioner's priority of use, the similarity of the TRAVELSMART mark and the CHUBB TRAVEL SMART mark, and the identical or substantially similar nature of the parties' respective goods, Petitioner believes that it has been and will likely continue to be damaged by the continued existence of the registration of the CHUBB TRAVEL SMART mark. In particular, the CHUBB TRAVEL SMART mark so resembles the TRAVELSMART mark that the consuming public is likely to be confused, mistaken, or deceived into believing that Registrant's goods originate from Petitioner or are in some way related to, associated with, or sponsored by Petitioner.

13. Accordingly, Petitioner's continued and legal use of the TRAVELSMART mark will be impaired by the continued registration of the CHUBB TRAVEL SMART mark. Registration of the CHUBB TRAVEL SMART mark should therefore be canceled pursuant to the provisions of § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in that the CHUBB TRAVEL SMART mark consists of or comprises a mark which so resembles Petitioner's TRAVELSMART mark in respect to related goods as to be likely to cause the consuming public to be confused, mistaken, or deceived.

WHEREFORE, Petitioner prays that this Petition to Cancel be sustained and granted in favor of Petitioner and that Registration No. 5,323,248 be canceled and removed from the Principal Register.

Dated: January 22, 2019

Respectfully submitted,

AWP USA Inc.

By counsel,

By: /David Ludwig/

David Ludwig

Dunlap Bennett & Ludwig PLLC

211 Church Street, SE

Leesburg, VA 20175

Tel: (703) 777-7319

Fax: (703) 777-3656

dludwig@dbllawyers.com