

ESTTA Tracking number: **ESTTA980248**

Filing date: **06/12/2019**

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	New Image Global, Inc.		
Entity	Corporation	Citizenship	California
Address	3002 Dow Ave., #108 Tustin, CA 92780 UNITED STATES		

Attorney information	Christopher Q. Pham Johnson & Pham, LLP 6355 Topanga Canyon Blvd., Ste. 326 Woodland Hills, CA 91367 UNITED STATES cpham@johnsonpham.com, mchaney@johnsonpham.com (818) 888-7540
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**Registration Subject to Cancellation**

Registration No.	4632589	Registration date	11/04/2014
Registrant	INTERNATIONAL ODDITIES, INC Suite 163 927 Deep Valley Drive Rolling Hills, CA 90274 UNITED STATES		

**Goods/Services Subject to Cancellation**


Class 034. First Use: 2010/03/12 First Use In Commerce: 2014/06/08 All goods and services in the class are subject to cancellation, namely: HERBS FOR SMOKING; ASHTRAYS; CIGARETTE CASES; LIGHTERS FOR SMOKERS NOT OF PRECIOUS METAL NOT FOR AUTOMOBILES; CIGARETTEROLLING PAPERS; CIGARETTE ROLLING MACHINES; CIGAR CASES; MATCH BOXES
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**Grounds for Cancellation**

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Abandonment	Trademark Act Section 14(3)

**Mark Cited by Petitioner as Basis for Cancellation**

U.S. Application No.	88286542	Application Date	02/01/2019
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BLACK MAMBA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2012/10/08 First Use In Commerce: 2012/10/08 "Roll your own" tobacco products, namely, cigarillo and cigar wraps and tubes		

Attachments	88286542#TMSN.png( bytes ) 2019-06-12_Petition For Cancellation_Final.pdf(600083 bytes )
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Signature	/Christopher Q. Pham/
Name	Christopher Q. Pham
Date	06/12/2019

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

NEW IMAGE GLOBAL, INC., a California Corporation,

Petitioner,

v.

INTERNATIONAL ODDITIES, INC., a California Corporation,

Respondent.

In re Trademark Registration No.: 4,632,589

Mark: BLACK MAMBA

Registered: November 4, 2014

Cancellation Petition No.: \_\_\_\_\_

Respondent's Address(es):

International Oddities, Inc.

927 Deep Valley Drive, Suite 163

Rolling Hills, CA 90274

Respondent's Correspondent's Address(es):

Mark B. Mizrahi

2785 Pacific Coast Hwy. # E801

Torrance, CA 90505

Email: info@internationaloddities.com

**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 BLACK MAMBA marked products. Presently, Petitioner pursues the following BLACK MAMBA application now pending before the United States Patent and Trademark Office ("USPTO"):

<b><u>App. No.:</u></b>	<b><u>Trademark:</u></b>	<b><u>Date of First Use at Least as Of:</u></b>	<b><u>Class and Goods Description:</u></b>
88/286542 (the "542" mark or application)	BLACK MAMBA	October 8, 2012	International Class 34: " 'Roll your own' tobacco products, namely, cigarillo and cigar wraps and tubes"

2. To the best of Petitioner's knowledge, the name and address of the current owner

of the mark BLACK MAMBA, having the USPTO Registration No.: 4,632,589 in International Class 034, for “HERBS FOR SMOKING; ASHTRAYS; CIGARETTE CASES; LIGHTERS FOR SMOKERS NOT OF PRECIOUS METAL NOT FOR AUTOMOBILES; CIGARETTE ROLLING PAPERS; CIGARETTE ROLLING MACHINES; CIGAR CASES; MATCH BOXES” and with a claimed June 8, 2014, date of first use in commerce (the “589” mark or registration), and March 12, 2010 “intent-to-use” application filing date, is INTERNATIONAL ODDITIES, INC., a California Corporation located at 927 Deep Valley Dr., #163, Rolling Hills, California 90274 (“Respondent”).

3. Petitioner is currently and will continue to be damaged by the registration of the 589 mark, and hereby petitions to cancel the registration of the 589 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 smoke-able and tobacco related products. Petitioner wholesales its products to resellers for distribution throughout the United States and internationally. Amongst these products are Petitioner’s BLACK MAMBA marked products.

5. At least as of October 8, 2012, Petitioner has been selling and has been offering for sale, in interstate commerce, products marked BLACK MAMBA consisting of “ ‘Roll your own’ tobacco products, namely, cigarillo and cigar wraps and tubes.”

6. Initially, on October 19, 2012, Petitioner filed an application for registration of a BLACK MAMBA trademark with the USPTO, App. No. 85/759066 (the “066” Application).

7. In response to this application, on August 5, 2013, the Examiner assigned to the 066 Application issued a suspension letter, suspending the 066 Application as a result of

Respondent's own USPTO application for the BLACK MAMBA mark which ultimately matured into the 589 Registration now at issue. The 066 Application was also suspended as a result of a BLACK MAMBA Section 1(b) "intent to use" application filed by a Fantasia Distribution, Inc., USPTO App. No. 85/367939.

8. On November 4, 2014, the USPTO registered Respondent's BLACK MAMBA mark under the 589 Registration. Thereafter, Fantasia Distribution, Inc.'s application for a BLACK MAMBA mark was taken out of suspension, and an office action was issued in relation thereto regarding Section 2(d) confusing similarity with Respondent's BLACK MAMBA mark. Fantasia Distribution, Inc., did not respond to this office action and the application was deemed abandoned on July 22, 2015.

9. Accordingly, on September 29, 2015, Petitioner's 066 Application was taken out of suspension, and an office action was issued thereon regarding Respondent's BLACK MAMBA mark, protected by the 589 Registration, on Section 2(d) "confusing similarity" grounds.

10. Petitioner's 066 Application was ultimately abandoned by Petitioner with good reason: pending the suspension of the 066 Application, Petitioner entered into a licensing agreement with Respondent, in or about August, 2015, wherein Respondent granted Petitioner a perpetual right to use the BLACK MAMBA mark with Petitioner's own products.

11. However, on information and belief, Respondent is no longer in business and is no longer using the BLACK MAMBA mark in commerce. And, Trademark licensees always remain able to challenge the registration of a licensor on the grounds of abandonment, and able to obtain registration of the previously licensed mark on its own behalf.

12. Since at least 2018, Respondent has been in a state of forfeiture with the

California Franchise Tax Board. Under California law, a forfeited business entity has no power, right, or authority to transact any manner of business. Accordingly, as a matter of law, as well as in fact, Respondent has abandoned all uses of its trademarks, including BLACK MAMBA.

13. Moreover, as a further indication that Respondent is no longer in business, Respondent has repeatedly failed to file applications to renew its other USPTO trademark registrations, when due, resulting in their cancellation.

14. Accordingly, on or about February 1, 2019, Petitioner filed the 542 Application for the BLACK MAMBA mark in order to protect Petitioner's rights therein. On or about April 18, 2019, the Examiner assigned to the 542 Application cited Respondent's 589 Registration as grounds for a provisional Section 2(d) "confusing similarity" refusal to register Petitioner's BLACK MAMBA mark. This Petition to Cancel the 589 Registration follows.

#### **COUNT I – ABANDONMENT**

15. In order to obtain and maintain the registration of a trademark before the USPTO, the holder of a trademark registration must establish not only that he or she used the mark before the mark was registered, but also that such use has continued to the present. Respondent has abandoned use of its BLACK MAMBA mark.

16. On information and belief, Respondent is no longer in business and is no longer offering for sale or selling within interstate commerce, any BLACK MAMBA marked products. Further, Respondent's eligibility, power, and authority, to conduct business have been and are currently suspended by the California Franchise Tax Board. Attached hereto, collectively, as Exhibit A are true and correct copies of "Entity Status Letters," dated December 24, 2018, through June 12, 2019, confirming Respondent's continued California Franchise Tax Board suspended status.

17. When a California corporation is suspended, the corporation loses all of its rights and privileges and cannot legally operate.

18. Respondent's cessation of business is further apparent from its abandonment of various other trademarks previously used by Respondent, and the subsequent cancellation of USPTO registrations corresponding thereto.

19. For example, on or about April 29, 2016 Respondent's INTERNATIONAL ODDITIES trademark (which is Respondent's name), Reg. No. 3,001,848, was deemed abandoned and cancelled. Indeed, since 2016, at least ten (10) trademark registrations previously held by Respondent have been deemed abandoned and cancelled by the USPTO as result of Respondent's failure to timely seek Section 8 registration renewal applications.

20. To the extent Respondent ever made lawful trademark use of the BLACK MAMBA trademark in connection with the goods listed in the 589 Registration, Respondent has ceased using this mark in connection with the goods and there is no evidence of any intent to resume use of the mark in connection with those goods in U.S. commerce, thereby abandoning the trademark.

21. The products provided by Petitioner in connection with its own mark BLACK MAMBA mark overlap with the products that Respondent previously provided under Respondent's BLACK MAMBA mark, and both Petitioner's and Respondent's respective marks consist of the terms "black mamba."

22. The continued registration of Respondent's BLACK MAMBA mark under Reg. 589 is inconsistent with Respondent's abandonment of its own BLACK MAMBA mark and apparent cessation of business. And, by virtue of Respondent's cessation of business and abandonment of its BLACK MAMBA mark, cancellation of the 589 Registration is warranted

and proper.

## **COUNT II – CONFUSING SIMILARITY/PRIORITY**

23. Petitioner has been using the mark BLACK MAMBA continuously in commerce since at least as early as October 8, 2012, in connection with “ ‘Roll your own’ tobacco products, namely, cigarillo and cigar wraps and tubes.” And Petitioner has continuously used the BLACK MAMBA mark for these purposes since October 8, 2012.

24. By virtue of Petitioner’s extensive use, promotion, and advertising of its BLACK MAMBA marked products, BLACK MAMBA is recognized by the relevant consumers as identifying Petitioner as the source of tobacco products and tobacco related products bearing this mark. Accordingly, Petitioner’s BLACK MAMBA mark is strong and distinctive.

25. On information and belief, some time after October 8, 2012, Respondent abandoned all use of its BLACK MAMBA mark protected by its 589 Registration, with no intent to resume use of the BLACK MAMBA mark. Any resumption of use by Respondent of BLACK MAMBA would, therefore, be junior to Petitioner’s use of BLACK MAMBA. Moreover, Respondent’s abandonment of the BLACK MAMBA mark obviates its March 12, 2010, Section 1(b) priority filing date. And, Respondent’s claimed June 8, 2014 date of actual first use in commerce of the BLACK MAMBA mark post-dates Petitioner’s October 8, 2012 claimed date of first use.

26. The products provided by Petitioner in connection with the BLACK MAMBA mark have been previously found by a USPTO Examiner to overlap with the products that Respondent described in its BLACK MAMBA registration.

27. Any resumed use by Respondent of its BLACK MAMBA 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 Respondent and its products. Further, in a previously issued Office Action, a USPTO Examiner determined that Petitioner and Respondent's BLACK MAMBA marks are confusingly similar.

28. The continued registration of Respondent's BLACK MAMBA mark is inconsistent with Petitioner's superior rights in the BLACK MAMBA mark and will continue to cause damage to Petitioner and Petitioner's rights in its BLACK MAMBA mark. Accordingly, the Respondent's 589 Application should be cancelled.

WHEREFORE, Petitioner requests and prays that U.S. Trademark Registration No.: 4,632,589 for the mark BLACK MAMBA be cancelled and this Petition for Cancellation be sustained in favor of Petitioner.

Dated: June 12, 2019

Respectfully Submitted,

JOHNSON & PHAM, LLP

By: /Christopher Q. Pham/  
Christopher Q. Pham  
Attorneys for Applicant  
NEW IMAGE GLOBAL, INC.

# EXHIBIT A



## Entity Status Letter

Date: 12/24/2018

ESL ID: 3967005665

According to our records, the following entity information is true and accurate as of the date of this letter.

Entity ID: 2041557

Entity Name: INTERNATIONAL ODDITIES

- 1. The entity is in good standing with the Franchise Tax Board.
- 2. The entity is **not** in good standing with the Franchise Tax Board.
- 3. The entity is currently exempt from tax under Revenue and Taxation Code (R&TC) Section 23701.
- 4. We do not have current information about the entity.

The above information does not necessarily reflect:

- The entity's status with any other agency of the State of California, or other government agency.
- If the entity's powers, rights, and privileges were suspended or forfeited at any time in the past, or the entity did business in California at a time when it was not qualified or not registered to do business in California:
  - The status or voidability of any contracts made in California by the entity at a time when the entity was suspended or forfeited (R&TC Sections 23304.1, 23304.5, 23305a, 23305.1).
  - For entities revived under R&TC Section 23305b, any time limitations on the revivor or limitation of the functions that can be performed by the entity.

### Internet and Telephone Assistance

Website: [ftb.ca.gov](http://ftb.ca.gov)

Telephone: 800.852.5711 from within the United States  
916.845.6500 from outside the United States

TTY/TDD: 800.822.6268 for persons with hearing or speech impairments



## Entity Status Letter

Date: 3/24/2019

ESL ID: 6851961821

According to our records, the following entity information is true and accurate as of the date of this letter.

Entity ID: 2041557

Entity Name: INTERNATIONAL ODDITIES

- 1. The entity is in good standing with the Franchise Tax Board.
- 2. The entity is **not** in good standing with the Franchise Tax Board.
- 3. The entity is currently exempt from tax under Revenue and Taxation Code (R&TC) Section 23701.
- 4. We do not have current information about the entity.

The above information does not necessarily reflect:

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## Entity Status Letter

Date: 4/24/2019

ESL ID: 3084288957

According to our records, the following entity information is true and accurate as of the date of this letter.

Entity ID: 2041557

Entity Name: INTERNATIONAL ODDITIES

- 1. The entity is in good standing with the Franchise Tax Board.
- 2. The entity is **not** in good standing with the Franchise Tax Board.
- 3. The entity is currently exempt from tax under Revenue and Taxation Code (R&TC) Section 23701.
- 4. We do not have current information about the entity.

The above information does not necessarily reflect:

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## Entity Status Letter

Date: 5/20/2019

ESL ID: 6281732702

According to our records, the following entity information is true and accurate as of the date of this letter.

Entity ID: 2041557

Entity Name: INTERNATIONAL ODDITIES

- 1. The entity is in good standing with the Franchise Tax Board.
- 2. The entity is **not** in good standing with the Franchise Tax Board.
- 3. The entity is currently exempt from tax under Revenue and Taxation Code (R&TC) Section 23701.
- 4. We do not have current information about the entity.

The above information does not necessarily reflect:

- The entity's status with any other agency of the State of California, or other government agency.
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## Entity Status Letter

Date: 6/12/2019

ESL ID: 6948643009

According to our records, the following entity information is true and accurate as of the date of this letter.

Entity ID: 2041557

Entity Name: INTERNATIONAL ODDITIES

- 1. The entity is in good standing with the Franchise Tax Board.
- 2. The entity is **not** in good standing with the Franchise Tax Board.
- 3. The entity is currently exempt from tax under Revenue and Taxation Code (R&TC) Section 23701.
- 4. We do not have current information about the entity.

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