

ESTTA Tracking number: **ESTTA1068507**

Filing date: **07/15/2020**

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	Orda USA, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1451 W. KNOX STREET TORRANCE, CA 90501 UNITED STATES		
Attorney information	BEN NATTER HAUG PARTNERS LLP 745 FIFTH AVENUE NEW YORK, NY 10151 UNITED STATES Primary Email: bnatter@haugpartners.com Secondary Email(s): jsblendorio@haugpartners.com, docket@haugpartners.com 212-588-0800		
Docket Number			

**Registration Subject to Cancellation**

Registration No.	5464697	Registration date	05/08/2018
Registrant	Asmodee North America, Inc. LEGAL DEPARTMENT 1995 WEST COUNTY ROAD B2 ROSEVILLE, MN 55113 UNITED STATES		

**Goods/Services Subject to Cancellation**


Class 028. First Use: 2012/08/01 First Use In Commerce: 2012/08/01 All goods and services in the class are subject to cancellation, namely: Equipment sold as a unit for playing board games; Equipment sold as a unit for playing card games; Board games; Card games; Parlour games; Tabletop games
--

**Grounds for Cancellation**

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


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

U.S. Application No.	88933431	Application Date	05/26/2020
----------------------	----------	------------------	------------

Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SMALL WORLD TOYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1974/03/23 First Use In Commerce: 1974/03/23 Toys; board games; toy kits; books; children's activity sets; educational toys;sports equipment; retail store servicesfeaturing toys and products for children		

U.S. Registration No.	1383504	Application Date	11/28/1984
Registration Date	02/18/1986	Foreign Priority Date	NONE
Word Mark	SMALL WORLD TOYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1975/09/00 First Use In Commerce: 1975/09/00 TOYS, GAMES AND PLAYTHINGS, NAMELY, DOLLS, DOLL HOUSE FURNITURE, [ TRAINS, ] STUFFED TOYS, [ KITES, ] AIRPLANES, MECHANICAL TOYS, BATTERY-OPERATED TOYS, PLASTIC AND VINYL TOYS, WOODEN TOYS, FELT TOYS, MAGNETIC TOYS, LATEX SQUEEZE TOYS, WIND-UP POWERED TOYS, REMOTE CONTROL TOYS, MUSICAL TOYS AND INSTRUMENTS, TOY CLOCKS, [ TOY WEAVING LOOMS, ] TOY ABACUSES, TOY CARS AND BOATS, TOPS, [ STEAM ENGINE MODELS, MICROSCOPES, ] TELESCOPES, KALEIDOSCOPES, INFLATABLE TOYS, [ SWIM FINS, SWIM MASKS, SNORKELS, ] WATER SQUIRTING TOYS, BALLS, TOY PAILS AND SHOVELS, TOY EGGS, RATTLES, TOY ANIMALS, TOY TEA SETS, BALLOON PASTE USED TO MAKE BALLOONS ORPLASTIC BUBBLES, BUBBLE WAND AND SOLUTION FOR BUBBLES, TOY APPARATUS FOR TEMPORARILY RECEIVING WRITTEN IMPRESSIONS, EQUIPMENT SOLD AS A UNIT FOR PLAYING ELECTRONIC GAMES, CLAY MODELING KITS FOR HOBBYCRAFT USE,[ KITS OF BEADS FOR ASSEMBLY INTO TOY JEWELRY, ] KITS CONSISTING OF PLAYBOARDS AND VINYL DIE-CUT FIGURES, BABY'S AND CHILDREN'S MULTIPLE ACTIVITY TOYS, TOY BUILDINGS, SCIENCE KITS, HOBBY CRAFT KITS CONSISTING OF WOOD OR PLASTIC FOR ASSEMBLING INTO TOYS AND EQUIPMENT SOLD AS A UNIT FOR PLAYING DOMINOES, BACKGAMMON, RUMMY, CHESS AND CHECKERS		

U.S. Registration No.	1268062	Application Date	09/29/1980
-----------------------	---------	------------------	------------

Registration Date	02/21/1984	Foreign Priority Date	NONE
Word Mark	SMALL WORLD TOYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1974/03/23 First Use In Commerce: 1974/03/25 TOYS AND GAMES-NAMELY, [ DOLLS, DOLL HOUSE FURNITURE, TOPS, TRAINS, STUFFED TOYS, ] WOODEN TOYS, [ FELT TOYS, KITES, MECH- ANICAL TOYS, ] PLASTIC TOYS, [ MAGNETIC TOYOYS, ] TOY MUSICAL IN- STRUMENTS, [ LATEX SQUEEZE TOYS, AND EQUIPMENT SOLD ASA UNIT FR PLAYING DOMINOES, BAKGAMMON, RUMMY, CHESS AND CHECKERS ]		

Attachments	88933431#TMSN.png( bytes ) 73279564#TMSN.png( bytes ) 02002177.PDF(116465 bytes )
-------------	---

Signature	/Jessica Sblendorio/
Name	Jessica Sblendorio
Date	07/15/2020

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

Orda USA, Inc.,	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No.
	:	
Asmodee North America, Inc.,	:	
	:	
Registrant.	:	
	:	

**CANCELLATION PETITION**

Petitioner, Orda USA, Inc., is a Delaware corporation having an address of 1451 W. Knox Street, Torrance, California 90501, believes that it is and will continue to be damaged by Registration No. 5,464,697, pursuant to 15 U.S.C. § 1064 *et seq.* and 37 C.F.R. § 2.111, hereby petitions to cancel the same.

As grounds for cancellation it is alleged that:

1. Petitioner, through its predecessors in interest, has used the SMALL WORLD TOYS mark since at least March 1974 in interstate commerce in connection with toys and retail store services.
2. Petitioner inadvertently allowed registrations for its SMALL WORLD TOYS marks to lapse in the United States.
3. Under its SMALL WORLD TOYS mark, Petitioner offers safe and high-quality toys and other products for children. Since Petitioner commenced use of its mark in intrastate commerce in 1962, Petitioner has achieved considerable goodwill in the United States in

connection with its products sold under the SMALL WORLD TOYS mark and has also extensively advertised its goods under said trademark throughout the United States. By reason of such advertising and long-time sales of Petitioner's goods under the mark, the public has come to recognize the SMALL WORLD TOYS as signifying Petitioner and its goods.

4. Registrant was granted the subject registration, Registration No. 5,464,697, for the mark SMALL WORLD, which encompasses the "SMALL WORLD" portion of Petitioner's SMALL WORLD TOYS mark, on May 8, 2018 for goods in international class 28: "Equipment sold as a unit for playing board games; Equipment sold as a unit for playing card games; Board games; Card games; Parlour games; Tabletop games."

5. Registrant alleges a date of first use for the mark of the subject registration, Registration No. 5,464,697, of August 2012.

6. Based upon Petitioner's prior use of its mark, SMALL WORLD TOYS, Petitioner's rights in the mark are superior to the rights of the Registrant in connection with the related goods in international class 28.

7. Because Registrant's mark encompasses Petitioner's mark and covers a related class of goods, the continued existence of Registrant's mark is likely to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Lanham Act.

8. Continued existence of the subject registration may prevent Petitioner from obtaining trademark protection for its goods and may hinder Petitioner's ability to enforce its trademark registrations.

9. Therefore, continued existence of Registration No. 5,464,697 will cause irreparable harm, injury and damage to Petitioner.

WHEREFORE, Petitioner requests that Registration No. 5,464,697 be cancelled and that

this Petition for Cancellation be sustained in favor of Petitioner.

Dated: New York, NY

July 15, 2020

Respectfully submitted,  
HAUG PARTNERS LLP

By:  /Jessica Sblendorio/ \_\_\_\_\_

Ben Natter, Esq.  
Jessica L. Sblendorio, Esq.  
745 Fifth Avenue  
New York, New York 10151  
Tel: (212) 588-0800

Email: bnatter@haugpartners.com  
jsblendorio@haugpartners.com  
docket@haugpartners.com

*Attorneys for Petitioner*