

MARK: **BLACK MAMBA**

**APPLICATION NO. 88/286542**  
**Application Filing date: 02/01/2019**

**APPLICANT NEW IMAGE GLOBAL,  
INC.'S RESPONSE TO OFFICE ACTION  
OF 04/18/2019**

**RESPONSE TO OFFICE ACTION**

Applicant New Image Global, Inc. (“New Image”), herein responds to the Office Action of 04/18/2018 for the mark BLACK MAMBA, Serial Number **88/286542** (the “542” Application) and provides the following arguments and evidence:

**I. SUSPENSION OF THE 542 APPLICATION IS WARRANTED**

The Examiner has preliminarily refused registration of New Image’s BLACK MAMBA mark under Section 2(d) on the grounds that a BLACK MAMBA mark held by International Oddities, Inc., and having Registration Number 4,632,589 (the “589” Registration), is confusingly similar to New Image’s BLACK MAMBA mark sought via this 542 Application. In short, International Oddities, Inc., has abandoned use of the BLACK MAMBA mark. And, concurrent with the filing of this Response, New Image has filed a Petition to Cancel International Oddities, Inc.’s 589 Registration. Accordingly, New Image requests suspension of this 542 Application pending the outcome of said Petition to Cancel International Oddities, Inc.’s 589 Registration.

Under 37 C.F.R. §2.67, the Examiner has the discretion to suspend an application “for good and sufficient cause.” *See also* TMEP §716.02. If an “examiner refuses registration under §2(d) of the Trademark Act in view of a mark in a prior registration, the applicant may file a petition to cancel the

registration under 15 U.S.C. § 1064 and, within a proper response period, inform the examining attorney that the petition to cancel has been filed. This will constitute a proper response to the § 2(d) refusal... The examining attorney will then suspend further action until the termination of the cancellation proceeding, if the application is otherwise in condition for approval or final refusal.” TMEP § 716.02(a).

The Examiner has cited the abandoned BLACK MAMBA mark covered by the 589 Registration as Section 2(d) grounds for refusing to register New Image’s BLACK MAMBA mark. New Image has filed, concurrent with the filing of this Response, a Petition for Cancellation against International Oddities, Inc., seeking the cancellation of the 589 Registration. Accordingly, good and sufficient cause exists to suspend this 542 Application for BLACK MAMBA. Therefore, Applicant respectfully requests that this 542 Application for BLACK MAMBA be suspended until the termination of the cancellation proceeding New Image has filed against International Oddities, Inc.’s BLACK MAMBA mark covered by the 589 Registration.

## **II. BLACK MAMBA HAS NO SPECIAL INDUSTRY MEANING**

To permit proper examination of this 542 Application, the Examiner has requested that New Image explain whether the wording in the mark “BLACK MAMBA” has any significance in New Image’s trade or industry or as applied to New Image’s goods and/or services, or if such wording is a “term of art” within New Image’s industry.

New Image is unaware of any significance in New Image’s trade or industry of the mark BLACK MAMBA, as applied to New Image’s goods, or otherwise. Nor, to New Image’s knowledge, is the term BLACK MAMBA a “term of art” in New Image’s industry. The only significance New Image is aware of with respect to the term BLACK MAMBA within New Image’s industry or as applied to New Image’s goods is as a mark belonging to New Image identifying New Image’s goods.

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### **III. AMENDMENT OF DESCRIPTION OF GOODS**

The Examiner has indicated that New Image must correct the punctuation in the identification of goods to clarify the individual items in the list of goods and/or services in the 542 Application. Accordingly, New Image adopts the Examiner's proposed amendment such that the description of goods shall read as follows:

*Class 34: Roll your own tobacco products, namely, cigarillo and cigar wraps and tubes*

### **IV. CONCLUSION**

The Examiner is respectfully requested to consider as sufficient New Image's Response to the Office Action, and to suspend this Application pending the outcome of the Petition to Cancel New Image has concurrently filed against International Oddities, Inc.'s BLACK MAMBA mark registration, as described herein.

Dated: June 12, 2019

Respectfully Submitted,

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