

ESTTA Tracking number: **ESTTA211930**

Filing date: **05/15/2008**

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 requests to cancel indicated registration.

Petitioner Information

| | | | |
|---------|--------------------------------------------------------------------------------|-------------|---------------|
| Name | Shawn W Woodrum | | |
| Entity | Individual | Citizenship | UNITED STATES |
| Address | 116 North Court Street P.O. Box 1549 Buena Vista, CO 81211 UNITED STATES | | |

| | | | |
|----------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|--|
| Correspondence information | Shawn W Woodrum Owner/Sole Proprietor Floyds Barber Shop 116 North Court Street P.O. Box 1549 Buena Vista, CO 81211 UNITED STATES wetlands@chaffeeco.net Phone:719-395-3274 | | |
|----------------------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|--|--|

Registrations Subject to Cancellation

| | | | |
|-----------------|---------------------------------------------------------------------------------------|-------------------|------------|
| Registration No | 2749894 | Registration date | 08/12/2003 |
| Registrant | FLOYD'S 99 HOLDINGS, LLC 4333 CHEROKEE STREET DENVER, CO 80216 UNITED STATES | | |

Goods/Services Subject to Cancellation

| |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Class 044. First Use: 2001/02/20 First Use In Commerce: 2001/02/20 All goods and services in the class are cancelled, namely: Barber Shop and Beauty and Hairdressing Salon Services |
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Grounds for Cancellation

| | | | |
|-------------------------------------------------|---------------------------------------------------------------------------------------|-------------------|------------|
| Deceptiveness | Trademark Act section 2(a) | | |
| False suggestion of a connection | Trademark Act section 2(a) | | |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) | | |
| Priority and likelihood of confusion | Trademark Act section 2(d) | | |
| Registration No | 3063720 | Registration date | 02/28/2006 |
| Registrant | Floyd's 99 Holdings, LLC 4333 Cherokee Street Denver, CO 80216 UNITED STATES | | |

Goods/Services Subject to Cancellation

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|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
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| |
|----------------|
| Salon Services |
|----------------|

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| Priority and likelihood of confusion | Trademark Act section 2(d) |

Mark Cited by Petitioner as Basis for Cancellation

| | | | |
|---------------------------------------|---------------------------------------------------------------------------------------|------------------|------|
| U.S. Application/ Registration No. | NONE | Application Date | NONE |
| Registration Date | NONE | | |
| Word Mark | FLOYD'S BARBER SHOP | | |
| Goods/Services | International Class 44 Barber/Beauty/Hair Styling and Related Cosmetology Services | | |

| | |
|-------------|-----------------------------------------------------------------------------|
| Attachments | Floyds Barber Shop Petiton for Cancellation.pdf (4 pages)(1288449 bytes) |
|-------------|-----------------------------------------------------------------------------|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

| | |
|-----------|--------------------|
| Signature | /Shawn W. Woodrum/ |
| Name | Shawn W Woodrum |
| Date | 05/15/2008 |

1 Services" in International Class 44 (U.S. Class 100 and 101) and both Registrations stating a date of first use as of
2 February 20, 2001, and petitions to cancel same.

3 As grounds for cancellation, it is alleged that:

- 4 1. Petitioner maintains Priority right to the trade mark "Floyd's Barber Shop" as supported in common
5 law by a registered first use date of 1/08/99, pre-dating Respondents' stated first use date of 2-20-2001
6 by more than 13 months. Petitioner secured Colorado Secretary of State trade name registration for
7 "Floyd's Barber Shop" on 8/26/99, as well as a Colorado trade mark registration on 01/24/2001.
- 8 2. Petitioner maintains a long-term bona fide interest in maintaining/expanding his enterprise, and alleges
9 the Respondent's mark containing the prominent use of "Floyd's", verbally or graphically in
10 association with "barber shop" in the context of beauty/cosmetology services & products is deceptively
11 similar/identical to Petitioner's trade mark and trade name as duly-registered in the State of Colorado.
12 Petitioner further alleges "99", "old-school" or other similar modifiers, when used, are intended to
13 circumvent existing registrations, and are not sufficiently distinctive to prevent mistaken confusion
14 with the Petitioner in commercial uses related to beauty & cosmetology. Respondent's attorney has
15 agreed the marks are substantially the same and the services provided by both parties are similar.
- 16 3. Petitioner and Respondent provide identical services, (i.e. beauty/salon/barber/cosmetology services)
17 wherein Respondent's deceptively similar mark falsely suggests a connection or affiliation with the
18 Petitioner where none exists.
- 19 4. Petitioner is likely to be damaged by the continuance of Class 44 of these registrations because
20 Petitioner desires to apply to register the mark "Floyd's Barber Shop" in accordance with the natural
21 growth and progression of business. The continued registration of the Respondent's marks in Class 44
22 will impair Petitioner's ability to register, and further use of the mark "Floyd's Barber Shop".
- 23 5. Petitioner has suffered from confusion in both the order and delivery of beauty supplies from vendors,
24 as well as enduring recent attempts at legal process service intended for the Respondent, attempts to
25 redeem coupons, and requests to obtain corrective services for work not performed by Petitioner.
- 26 6. There is a high likelihood of further confusion arising from the anticipated natural progression and
27 expansion of Petitioner's business interests within Colorado, as well as national/international
28 expansion in the future.

1 7. Respondent began business and maintain head quarters in Colorado. Yet Respondent filed solely for
2 Federal trade mark registration on 8-5-02, fully 18 months after Petitioner's mark "Floyd's Barber
3 Shop" was certified and registered with the Colorado Secretary of State (1-24-01). Respondent (and/or
4 predecessors/owners) failed to maintain standards of good faith and/or accord due diligence sufficient
5 research in filing the original application as dictated in §10.18 (b) .

6 8. On information and belief, Petitioner alleges Respondent/predecessors received prior notification via
7 telephone as well as receiving timely certified US mail regarding Petitioner's bona fide use and
8 registration of the trade name/trade mark on May 7, 2001. Contrary to the principles of truthful
9 declarations and the canon of conduct (§10.20), Respondent/agents knowingly filed applications for
10 the Federal marks without disclosing knowledge of concurrent use, or Petitioner's common law and
11 existing registered trade mark rights. This was done to specifically avoid required notification of
12 interested parties had the concurrent use been acknowledged. Petitioner was effectively excluded from
13 the registration proceedings and alleges the resulting infringement is not innocent. The infringement is
14 the intentional result of sustained efforts to obfuscate Respondents' illegitimate interests in the
15 "Floyd's Barber Shop" mark. Petitioner believes Respondent's actions warrant further scrutiny under
16 the disciplinary rules as well as providing exposure to sanctions and other actionable remedies/relief
17

18 WHEREFORE, the Petitioner prays that Class 44 of Registration Nos. 2,749,894 and 3,063,720 be cancelled,
19 this Petition for Cancellation be sustained in favor of the Petitioner, and further, the Respondents actions in
20 securing these marks receive additional investigation & review.

21
22 The filing fee of \$300 per class for Class 44 of each application having been deposited electronically, in a
23 combined amount of \$600.00.

24 Respectfully submitted.

25 Shawn W. Woodrum

26 Dated this 05/15/2008

27 By: 

28 Shawn W. Woodrum
dba Floyd's Barber Shop
116 North Court Street
P.O. Box 1549
Buena Vista, CO 81211-1549
(719) 395-3274

Certificate of Mailing

I hereby certify that 2 complete and identical copies of this correspondence are being deposited with the United States Postal Service as follows:

1) Express Mail No. EN042967418 US, in an envelope addressed to:

Perkins Coie, LLP
Attn: Garrett M. Tuttle
1899 Wynkoop Street, Ste 700
Denver, CO 80202-1043

AND

2) Express Mail No. EN042967404 US, in an envelope addressed to:

Floyd's 99 Holdings, LLC
Attn: Mitchell Graham, Paul O'Brien, Rob O'Brien, Bill O'Brien
4333 Cherokee Street
Denver, COLORADO 80216

By my hand, on the afternoon of Thursday, May 15, 2008.


Shawn W. Woodrum