

ESTTA Tracking number: **ESTTA504775**

Filing date: **11/09/2012**

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	Overstock.com, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	6350 South 3000 East Salt Lake City, UT 84121 UNITED STATES		

Attorney information	Alan J. Howarth Clayton, Howarth & Cannon, P.C. P.O. Box 1909 Sandy, UT 84091 UNITED STATES docketclerk@chcpat.com, ahowarth@chcpat.com, jserassio@chcpat.com Phone:8012555335
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Registration Subject to Cancellation

Registration No	4239522	Registration date	11/06/2012
Registrant	Palmer, Tapp 1005 Barfield Street Daniel Island, SC 29492 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2012/01/01 First Use In Commerce: 2012/01/01 All goods and services in the class are cancelled, namely: Retail discount store services in the field of general consumer merchandise, grocery items, housewares, clothing, toys, furniture, electronics, TV's, paper products, cleaning products, pet products, lawn and garden products, and patio furniture

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2939764	Application Date	09/29/2003
Registration Date	04/12/2005	Foreign Priority Date	NONE
Word Mark	OVERSTOCK.COM		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 035. First use: First Use: 1999/10/19 First Use In Commerce: 1999/10/19 On-line wholesale and retail store services featuring general consumer merchandise, namely, clothing, shoes, bath and body products, jewelry, electronics, cookware, housewares, appliances, furniture, linens, pillows, decorative accessories, office furniture and accessories, toys, games, sporting goods, tools, outdoor lawn and garden equipment, pet supplies and paper products

Attachments	Petition to Cancel.pdf (7 pages)(100281 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Alan J. Howarth/
Name	Alan J. Howarth
Date	11/09/2012

ALAN J. HOWARTH
WESLEY M. LANG
CLAYTON, HOWARTH & CANNON, P.C.
P.O. Box 1909
Sandy, Utah 84091-1909
Telephone: (801) 255-5335
Facsimile: (801) 255-5338

Attorneys for Petitioner OVERSTOCK.COM, INC.

Mark: BIG BOX OVERSTOCKS
U.S. Trademark Registration Number: 4,239,522
Registration Date: November 6, 2012

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

OVERSTOCK.COM, INC.,)	
)	
Petitioner,)	
)	PETITION TO CANCEL
v.)	
)	
TAPP PALMER,)	Cancellation No. _____
)	
Respondent.)	

PETITION TO CANCEL

As grounds for cancelling U.S. Trademark Registration No. 4,239,522, it is alleged that:

PARTIES

1. OVERSTOCK.COM, INC. is a Delaware corporation having a business address of 6350 South 3000 East, Salt Lake City, Utah 84121, Utah (hereinafter referred to as "Petitioner").
2. Upon information and belief, and according to the Trademark Electronic Search System ("TESS") maintained by the United States Trademark Office, Respondent Tapp Palmer is an individual having a place of business located at 1005 Barfield Street, Daniel Island, South Carolina 29492. Respondent is the registered owner of U.S. Trademark Registration No. 4,239,522

for the mark “BIG BOX OVERSTOCKS” registered on November 6, 2012, claiming use in connection with “Retail discount store services in the field of general consumer merchandise, grocery items, housewares, clothing, toys, furniture, electronics, TV’s, paper products, cleaning products, pet products, lawn and garden products, and patio furniture” in International Class 35, which mark Respondent allegedly first used in commerce in January of 2012.

3. Petitioner is the owner of U.S. Trademark Registration No. 2,939,764 (hereinafter referred to as “Petitioner’s registration” or “the ‘764 registration”), filed September 29, 2003, for the mark OVERSTOCK.COM for use in connection with, among other things, “On-line wholesale and retail store services featuring general merchandise, namely, clothing, shoes, bath and body products, jewelry, electronics, cookware, housewares, appliances, furniture, linens, pillow, decorative accessories, office, furniture and accessories, toys, games, sporting goods, tools, outdoor lawn and garden equipment, pet and accessories, toys, games, sporting goods, tools, outdoor lawn and garden equipment, pet supplies and paper products,” which mark Petitioner first used in commerce on October 19, 1999. A printout of Petitioner’s registration from the TESS database is attached hereto as Exhibit A.

**FIRST CLAIM FOR RELIEF
(Likelihood of Confusion)**

Petitioner hereby incorporates its allegations contained in paragraphs 1 through 3 above and further alleges as follows.

4. Since Petitioner’s initial use of Petitioner’s OVERSTOCK.COM name and mark, Petitioner has used, advertised, produced, and offered its goods, services, stores, and business under and in connection with said name and mark to the public, through various channels of trade, and in commerce, with the result that Petitioner’s customers and the public in general have

come to know and recognize said name and mark of Petitioner and associate them with Petitioner and/or the goods and services produced, advertised, marketed, distributed, and sold directly or indirectly by Petitioner, Petitioner's business and/or stores. Petitioner thus has built up goodwill in connection with the sale of its products and services under Petitioner's OVERSTOCK.COM mark.

5. Respondent's BIG BOX OVERSTOCKS. registered mark is a colorable imitation of, and/or is confusingly similar to, Petitioner's prior and aforesaid OVERSTOCK.COM name and mark.

6. On information and belief, the services provided under the mark sought to be cancelled herein as set forth above (hereafter the "opposed services") are the same, similar and/or related to the goods, services, and business in connection with which Petitioner uses its OVERSTOCK.COM name and mark, and on information and belief, the opposed services are and/or will be sold and/or offered through the same and/or similar channels of trade, and/or to the same general class of purchasers, to the which Petitioner's products, services and business are marketed and/or sold.

7. The continued registration and/or use of the mark sought to be cancelled, is likely to cause confusion, mistake, and/or deceive as to origin, sponsorship, and/or association of Respondents' services to be sold under the mark sought to be cancelled vis-a-vis Petitioner's OVERSTOCK.COM mark, and/or to mislead purchasers of Respondents' and or Petitioner's goods and/or services, and/or the public in general, into believing that Respondents' services emanate from, and/or in some way, directly or indirectly, are associated with Petitioner, and/or Petitioner's OVERSTOCK.COM name and mark, products, services and/or business, or vice versa, to the damage and detriment of Petitioner.

PRAYER FOR RELIEF

WHEREFORE, Petitioner prays that this Petition to cancel U.S. Trademark Registration No. 4,239,522 for the mark "BIG BOX OVERSTOCKS" be granted and judgment be entered in favor of Petitioner.

All correspondence and telephonic communications should be directed to:

Alan J. Howarth
Wesley M. Lang
Attorney Docket No. T12647
CLAYTON, HOWARTH & CANNON, P.C.
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Sandy, Utah 84091-1909
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The Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 50-0836.

DATED this 9th day of November, 2012.

Respectfully submitted,



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Attorneys for Petitioner
Overstock.com, Inc.

AJH/WML/jms

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CERTIFICATE OF SERVICE

I hereby certify that on the 9th day of November, 2012, a true and correct copy of the **PETITION TO CANCEL** was sent by U.S. First Class mail, postage prepaid, in an envelope addressed to:

Tapp Palmer
1005 Barfield Street
Daniel Islang, South Carolina 29492

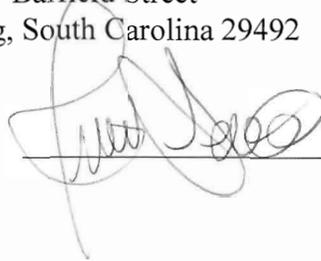


EXHIBIT A

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,939,764

Registered Apr. 12, 2005

**SERVICE MARK
PRINCIPAL REGISTER**

OVERSTOCK.COM

OVERSTOCK.COM, INC. (DELAWARE CORPORATION)
6322 SOUTH 3000 EAST, SUITE 100
SALT LAKE CITY, UT 84121

FOR: ON-LINE WHOLESALE AND RETAIL STORE SERVICES FEATURING GENERAL CONSUMER MERCHANDISE, NAMELY, CLOTHING, SHOES, BATH AND BODY PRODUCTS, JEWELRY, ELECTRONICS, COOKWARE, HOUSEWARES, APPLIANCES, FURNITURE, LINENS, PILLOWS, DECORATIVE ACCESSORIES, OFFICE FURNITURE AND ACCESSORIES, TOYS, GAMES, SPORTING GOODS, TOOLS, OUTDOOR LAWN AND GARDEN

EQUIPMENT, PET SUPPLIES AND PAPER PRODUCTS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-19-1999; IN COMMERCE 10-19-1999.

OWNER OF U.S. REG. NO. 2,503,246.

SEC. 2(F).

SER. NO. 78-306,570, FILED 9-29-2003.

MARK T. MULLEN, EXAMINING ATTORNEY