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

Proceeding	92060599
Party	Plaintiff Turn-Key Vacation Rentals, Inc.
Correspondence Address	DAVID M ADLER ADLER LAW GROUP 300 SAUNDERS ROAD, SUITE 100 RIVERWOODS, IL 60015 UNITED STATES David@adler-law.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	David M. Adler
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Date	07/30/2015
Attachments	First Amended Pet. for Canc. TURNKEY w exh.pdf(160808 bytes)

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

TURN-KEY VACATION RENTALS, INC.,
a California corporation,

Petitioner,

Cancellation No.

v.

Reg. No. 4340236

THOMAS CLARK,
an individual and resident of California,

Mark: TURNKEY

Respondent.

FIRST AMENDED PETITION FOR CANCELLATION

In the matter of Registration No. 4340236, for the mark “TURNKEY” for “Providing on-line searchable databases for promotion of vacation rental lodgings featuring rental information, namely, property descriptions and images, locations and amenities, availability and rates for vacation rental lodgings; providing a website featuring classified advertisements for temporary lodging by allowing users to post and search postings for booking reservations for vacation rental lodgings and temporary accommodations” in International Class (IC) 035; “Real estate services, namely, rental of vacation homes and lodging; real estate management services for vacation rental real estate, namely, arranging services for guest check in, cleaning services and maintenance services” in IC 036; and “Providing interactive website that facilitates the management of vacation rental real estate maintenance, cleaning and repair services, namely, scheduling local service providers for cleaning and repairs of vacation rental real estate and providing information related thereto” in IC 037, which Application was filed on October 25, 2012 by THOMAS CLARK (“Respondent”) and which was registered on May 21, 2013.

TURN-KEY VACATION RENTALS, INC., a California corporation with offices at 702 Mangrove Street, Suite 103, Chico, CA 95926 (“Petitioner”) believes she will be damaged by registration of the mark, and hereby requests cancellation of same.

The grounds for Cancellation are as follows:

Background.

1. Petitioner has been in the business of vacation rental property management and leasing since March 2011.

2. Petitioner operates her vacation rental property management and leasing business under the trade name and trademark “TURN-KEY VACATION RENTALS.”

3. On July 2, 2011, Petitioner registered the Internet domain name “turnkeyvacationrental.com” through the Internet Registrar 1and1.com.

4. On February 27, 2012, Petitioner adopted the corporate name “TURN-KEY VACATION RENTALS, INC.”

5. On July 16, 2012, Petitioner registered the domain name “turnkeyvacationrentals.com” through the Internet Registrar 1and1.com.

6. Since at least as early as February 27, 2012, Petitioner has used the trademark “TURN-KEY VACATION RENTALS” and has promoted her business using the mark.

7. Petitioner has at least 26 domain names related to “TURN-KEY VACATION RENTALS,” including the domain names “turn-keyvacationrental.com,” “turn-keyvacationrentals.com,” “turn-keyvacationrentalsinc.com,” “turn-keyvr.com,” and “turn-keyvacationrentalsinc.com” that Petitioner registered on May 17, 2013,

8. On December 11, 2014, Petitioner filed Application Serial Number 86477775 to register the mark “TURN-KEY VACATION RENTALS” for “Providing information in the field of real estate via the Internet; Providing real estate listings via the Internet; Real estate management of vacation homes; Real estate services, namely, rental of vacation homes; Real estate services, namely, rental of vacation homes, condominiums, cabins, and villas using pay

per click advertising on a global computer network; Real estate services, namely, vacation home rental management services” in IC 036.

9. On information and belief, Respondent, Thomas Clark, is an individual whose address is 1571 Chestnut St., San Francisco CA, 94123.

10. Petitioner and respondent are both residents of the State of California.

11. On information and belief, Respondent is the founder of an online business named “Turnkey Vacation Rentals.”

12. Respondent’s website, located at “turnkeyvr.com,” lists the following biographical information for Respondent:

“Prior to co-founding TurnKey, T.J. was the President & CEO of Limos.com from 2008-2012. Limos.com became the largest online marketplace for limo/car services and grew more than 50% each year. The Company expanded globally and launched partnerships with Orbitz, Sabre, Concur, Delta Airlines, LiveNation and OpenTable. In 2011 Limos.com was named in Forbes America's Most Promising Companies as the Top Travel Brand. Prior to Limos.com, T.J. was VP of Operations at IAC/InterActiveCorp from 2004-2008. IAC consisted of over 85 internet brands with 20 million visitors per day (8th ranked worldwide), including Expedia, Hotels.com, Ticketmaster, LendingTree and Match.com. He was responsible for IAC teams for technology, software development, procurement and call center/telecommunications. Prior to IAC, T.J. joined the Hotwire.com start-up team in March 2000 as corporate counsel. Hotwire.com became the fourth-ranked U.S. online travel company within 2 years of operations, generating over \$1B in travel bookings. Hotwire was acquired by IAC in 2004.

13. Respondent was aware of Petitioner’s prior use of and prior rights in the mark TURN-KEY VACATION RENTALS at least as early as September 5, 2012.

14. On September 5, 2012, Respondent sent email correspondence to Petitioner asking Petitioner if she was interested in selling the domain name “turnkeyvacationrentals.com.” A true and correct copy of the September 5, 2012 email correspondence between Respondent and Petitioner is attached hereto as Exhibit A.

15. On September 5, 2012, Petitioner informed Respondent that the domain name “turnkeyvacationrentals.com.” was not for sale and that Petitioner was pursuing plans to use the domain name “turnkeyvacationrentals.com,” as well as others associated with it.

16. Respondent filed his Intent to Use Application Serial Number 85763978 on October 25, 2012, seeking registration of the mark “TURNKEY” for use in connection with, among other things, “real estate services, namely, rental of vacation homes.”

17. Application Serial Number 85763978 matured into Registration No. 4340236 on May 21, 2013.

18. At the time Respondent filed Application Serial Number 85763978, Respondent had notice of Petitioner’s use of the name TURN-KEY VACATION RENTALS.

19. At the time Respondent filed Application Serial Number 85763978, Respondent had actual notice of Petitioner’s use of the domain name “turnkeyvacationrentals.com.”

20. Since Respondent was unable to purchase the domain name “turnkeyvacationrentals.com” and since Respondent knew that Petitioner was using the name TURN-KEY VACATION RENTALS, Respondent intentionally registered the mark “TURNKEY” in an effort to block Petitioner from being able to register and/or enforce in the TURN-KEY VACATION RENTALS mark.

21. Petitioner now brings this action to cancel Registration #4340236 on the grounds that Petitioner has priority of use of the mark “TURN-KEY VACATION RENTALS,” which is confusingly similar to Respondent’s mark “TURNKEY,” that Respondent willfully and intentionally lied under oath about his right to seek registration of the mark “TURNKEY,” that Respondent willfully and intentionally lied under oath about his right to use the mark “TURNKEY,” that Respondent willfully and intentionally deceived the TTAB about his right to use the mark “TURNKEY,” that Respondent fraudulently obtained Registration #4340236, and

that allowing Respondent to own Registration #4340236 is likely cause confusion, mistake and deception with respect to Petitioner's well established prior use of and rights in the mark for identical services.

Registration #4340236 Will Damage Petitioner.

22. Respondent fraudulently obtained Registration #4340236 to use the mark "TURNKEY" in connection with ""Providing on-line searchable databases for promotion of vacation rental lodgings featuring rental information, namely, property descriptions and images, locations and amenities, availability and rates for vacation rental lodgings; providing a website featuring classified advertisements for temporary lodging by allowing users to post and search postings for booking reservations for vacation rental lodgings and temporary accommodations" in International Class (IC) 035; "Real estate services, namely, rental of vacation homes and lodging; real estate management services for vacation rental real estate, namely, arranging services for guest check in, cleaning services and maintenance services" in IC 036; and "Providing interactive website that facilitates the management of vacation rental real estate maintenance, cleaning and repair services, namely, scheduling local service providers for cleaning and repairs of vacation rental real estate and providing information related thereto" in IC 037."

23. Respondent's mark "TURNKEY" is identical in overall sound, meaning and commercial impression to "TURN-KEY," the dominant portion of Petitioner's trade name, "TURN-KEY VACATION RENTALS."

24. Respondent's mark "TURNKEY" is identical in overall sound, meaning and commercial impression to "TURN-KEY," the dominant portion of Petitioner's trademark "TURN-KEY VACATION RENTALS."

25. Respondent's Class IC 036 services are identical to Petitioner's Class IC 036 services: "Real estate services, namely, rental of vacation homes and lodging."

26. At the time Respondent filed Application Serial Number 85763978, Respondent declared under oath that "[he] believe[d] [himself] to be the owner of the trademark/service mark sought to be registered;" and "to the best of [his] knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

31. At the time Respondent filed Application Serial Number 85763978, Respondent knowingly made false, material misrepresentations of fact with the intent to deceive the USPTO.

32. At the time Respondent filed Application Serial Number 85763978, Respondent knew that the mark was owned and in use by Petitioner and that it had been used by Petitioner prior to Respondent's filing date of October 25, 2102.

33. Respondent knew at the time of filing Application Serial No. 85763978 that Petitioner had adopted and was using the legal business name "TURN-KEY VACATION RENTALS, INC." for her vacation rental property management and leasing business.

34. Respondent knew at the time of filing Application Serial Number 85763978 that the mark was identical, or so nearly identical to Petitioner's mark, that it was likely, when used on or in connection with the services of Respondent, to cause confusion, mistake, or deception.

35. Respondent sought registration of its "TURNKEY" mark to prevent Petitioner from registering "TURN-KEY VACATION RENTALS."

36. Petitioner has priority of use of her "TURN-KEY VACATION RENTALS" mark based on actual use in commerce, or use analogous to trademark use, prior to Respondent's alleged date of first use.

37. Petitioner made actual, or at least analogous, use of the mark “TURN-KEY VACATION RENTALS” at least as early as July 2, 2011 when Petitioner registered the Internet domain name “turnkeyvacationrental.com” through the Internet Registrar 1and1.com, and certainly by February 27, 2012, when Petitioner adopted the corporate name “TURN-KEY VACATION RENTALS, INC.”

38. At the time he filed Application Serial No. 85763978, Respondent declared under oath that he “believe[d] [himself] to be the owner of the trademark/service mark sought to be registered;” and “to the best of [his] knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

39. Respondent committed fraud on the USPTO and obtained his registration through fraud by filing his application to register “TURNKEY” because the statements he made under oath were patently false at the time he made them. Respondent knew Petitioner had prior and superior rights in its “TURN-KEY VACATION RENTALS” mark because he wrote to Petitioner asking her to sell the “turnkeyvacationrentals.com” domain name to him.

40. Respondent made materially false statements to the USPTO with the intent to deceive the USPTO because Respondent intended to procure his “TURNKEY” trademark to prevent Petitioner from registering or enforcing her “TURN-KEY VACATION RENTALS” mark.

41. Registration #3960356 must be cancelled. Respondent committed fraud on the USPTO and obtained his registration through fraud by filing his application to register “TURNKEY” when Respondent knew that Petitioner was already using her mark, that included the word “TURN-KEY.” Respondent’s “TURNKEY” mark is identical in sound, meaning and

commercial impression to “TURN-KEY,” the dominate portion of Petitioner’s mark, “TURN-KEY VACATION RENTALS.” Petitioner has priority of use of the mark and allowing Respondent to own Registration #4340236 creates a substantial likelihood that consumers will be confused by Respondent’s use of the mark TURNKEY in connection with Respondent’s goods resulting in irreparable harm and damage to the Petitioner.

WHEREFORE, Petitioner requests that Respondent’s Registration #4340236 be cancelled or in the alternative, that it be transferred to Petitioner.

Respectfully submitted,

[signed] /david m. adler/
David M. Adler, Esq.
Adler Law Group
300 Saunders Road, Suite 100
Riverwoods, Illinois 60015
Phone: (866) 734-2568
ISBA #6242403

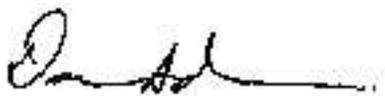
Dated: July 30, 2015

CERTIFICATE OF SERVICE

David M. Adler, an attorney, certifies that pursuant to 28 U.S.C. 1746, under penalties of perjury, he caused a copy of the **FIRST AMENDED PETITION FOR CANCELLATION** to be served upon:

Kuscha Hatami
Counsel for Respondent
PO Box 644
Cupertino, CA 95015

Electronically via the USPTO ESTTA as mutually agreed by the parties and by placing the same in a United States Post Office Box located at 300 Saunders Road, Riverwoods, Illinois, postage prepaid and via Facsimile, this July 30, 2015.



By: _____
David M. Adler, Esq.

David M. Adler, Esq.
Adler Law Group
300 Saunders Road, Suite 100
Riverwoods, Illinois 60015
Phone: (866) 734-2568
ISBA #6242403

From: Bonnie <info@engineed.com>
Subject: Re: Turnkeyvacationrentals.com
Date: September 5, 2012 at 6:39:01 PM PDT
To: TJ Clark <thomasjclark@gmail.com>

ok thx

On Sep 5, 2012, at 5:45 PM, TJ Clark wrote:

Thanks Bonnie - If you ever reconsider please consider me.

Best regards,

T.J.

T.J. Clark | thomasjclark@gmail.com | 415.341.6388

On Wed, Sep 5, 2012 at 5:44 PM, Bonnie <info@engineed.com> wrote:

Thank you for the offer, but it's really not for sale. I have plans for that domain name and the others I have associated with it. Thank you again for the offer.

On Sep 5, 2012, at 5:25 PM, TJ Clark wrote:

Thanks Bonnie -

Would you consider \$2,500?

Best,

T.J.

T.J. Clark | thomasjclark@gmail.com | [415.341.6388](tel:415.341.6388)

On Wed, Sep 5, 2012 at 4:54 PM, Bonnie <info@engineed.com> wrote:

I'm so sorry, it's not for sale. But thank you for contacting me.

On Sep 5, 2012, at 4:26 PM, TJ Clark wrote:

Bonnie -

I am a serious potential buyer of your domain turnkeyvacationrentals.com if you would be willing to sell it. Do you have an asking price?

Best regards,

T.J.

T.J. Clark | thomasjclark@gmail.com

EXHIBIT A