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

Proceeding	92060599
Party	Defendant Thomas Clark
Correspondence Address	THOMAS CLARK 1571 CHESTNUT ST SAN FRANCISCO, CA 94123 UNITED STATES
Submission	Answer
Filer's Name	Kuscha Hatami
Filer's e-mail	hatami@legaledgelaw.com
Signature	/Kuscha Hatami/
Date	02/13/2015
Attachments	2. Turnkey Answer.pdf(138710 bytes)

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

<p>Turn-Key Vacation Rentals, Inc.</p> <p style="text-align:center">Petitioner,</p> <p style="text-align:center">v.</p> <p>Thomas Clark</p> <p style="text-align:center">Registrant.</p>	<p>Cancellation No. 92060599</p> <p>Mark(s): TURNKEY</p> <p>Reg. No. 4340236</p> <p>Reg. Date: May 21, 2013</p>
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**REGISTRANT’S ANSWER TO PETITIONER’S
PETITION FOR CANCELLATION**

Registrant Thomas Clark (hereinafter “Registrant” or “Clark”) through his undersigned attorney(s), submits his Answer and Affirmative Defenses to the Petition for Cancellation (“Cancellation” or “Petition”) filed by Turn-Key Vacation Rentals, Inc., (hereinafter “Petitioner”) dated December 24, 2014 as follows:

In response to the grounds for cancellation enumerated in Petitioner’s Electronic System for Trademark Trials and Appeals (“ESTTA”) Petition for Cancellation, Registrant denies that there are any grounds to sustain the Cancellation and denies that Petitioner owns any trademark(s) sufficient to constitute a basis for this opposition.

In response to the unnumbered introductory paragraph, Registrant denies that Petitioner will be damaged by the continued registration of U.S. Registration No. 4340236.

1. In response to paragraph 1, Registrant responds that he lacks sufficient knowledge or information to form a belief as to the truth of the allegations in

- paragraph 1 and, therefore, denies each and every allegation in paragraph 1 of the Cancellation.
2. In response to paragraph 2, Registrant responds that he lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 2 and, therefore, denies each and every allegation in paragraph 2 of the Cancellation.
 3. In response to paragraph 3, Registrant responds that he lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 3 and, therefore, denies each and every allegation in paragraph 3 of the Cancellation.
 4. In response to paragraph 4, Registrant responds that he lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 4 and, therefore, denies each and every allegation in paragraph 4 of the Cancellation.
 5. In response to paragraph 5, Registrant responds that he lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 5 and, therefore, denies each and every allegation in paragraph 5 of the Cancellation.
 6. In responses to paragraph 6, Registrant denies each and every allegation contained in paragraph 6 of the Cancellation.
 7. In response to paragraph 7, Registrant responds that he lacks sufficient knowledge or information to form a belief as to the truth of the allegations in

- paragraph 7 and, therefore, denies each and every allegation in paragraph 7 of the Cancellation.
8. In response to paragraph 8, Registrant admits the allegations in paragraph 8 of the Cancellation.
 9. In response to paragraph 9, Registrant admits that he is an individual. Except as expressly admitted, Registrant denies each and every remaining allegation in paragraph 9 of the Cancellation.
 10. In response to paragraph 10, Registrant admits that he is a resident of California. Except as expressly admitted, Registrant lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegation(s) in paragraph 10 and, therefore, denies each and every remaining allegation in paragraph 10 of the Cancellation.
 11. In response to paragraph 11, Registrant admits that he is a non-active attorney with some experience working with Internet based companies which may include identifying, registering, and marketing Internet businesses and domain names. Except as expressly admitted, Registrant denies each and every remaining allegation in paragraph 11 of the Cancellation.
 12. In response to paragraph 12, Registrant responds that he admits that he has some experience building and marketing Internet businesses, which may include using domain names as the name and trademark of the business. Except as expressly admitted, Registrant denies each and every remaining allegation in paragraph 12 of the Cancellation.

13. In response to paragraph 13, Registrant admits the allegations in paragraph 13 of the Cancellation.
14. In response to paragraph 14, Registrant admits the allegations in paragraph 14 of the Cancellation.
15. In responses to paragraph 15, Registrant denies each and every allegation contained in paragraph 15 of the Cancellation.
16. In response to paragraph 16, Registrant admits the allegations in paragraph 16 of the Cancellation.
17. In response to paragraph 17, Registrant admits that an email chain between Registrant and Petitioner on September 5, 2012 reflect the allegations in paragraph 17 of the Cancellation.
18. In response to paragraph 18, Registrant admits that the records of the TSDR of the USPTO reflect the allegations in paragraph 18 of the Cancellation.
19. In response to paragraph 19, Registrant admits that the records of the TSDR of the USPTO reflect the allegations in paragraph 19 of the Cancellation.
20. In responses to paragraph 20, Registrant denies each and every allegation contained in paragraph 20 of the Cancellation. Registrant further submits that merely owning a domain name and a corporate entity filed with the California Secretary of State does not, in itself, give constructive notice, to 3rd parties, that the domain name and corporate entity owner are claiming trademark rights in a specific Mark, nor are they sufficient to claim trademark rights in a specific Mark. Therefore, Registrant did not and could not have known that Petitioner claimed any rights in the TURNKEY Mark, either at common law or otherwise.

21. In responses to paragraph 21, Registrant denies each and every allegation contained in paragraph 21 of the Cancellation. Registrant further submits that merely owning a domain name does not provide actual notice, to 3rd parties, of the owner's use or intended use of a specific trademark. Therefore, Registrant did not and could not have known that Petitioner claimed any rights in the TURNKEY Mark, either at common law or otherwise.
22. In response to paragraph 22, Registrant responds that he admits that he is a non-active attorney with some experience in Internet businesses and registering domain names. Except as expressly admitted, Registrant denies each and every remaining allegation in paragraph 22 of the Cancellation.
23. In response to paragraph 23, Registrant responds that he admits that he is a non-active attorney with some experience in marketing Internet related businesses. Except as expressly admitted, Registrant denies each and every remaining allegation in paragraph 23 of the Cancellation.
24. In responses to paragraph 24, Registrant denies each and every allegation contained in paragraph 24 of the Cancellation.
25. In responses to paragraph 25, Registrant denies each and every allegation contained in paragraph 25 of the Cancellation.
26. In responses to paragraph 26, Registrant denies each and every allegation contained in paragraph 26 of the Cancellation.
27. In responses to paragraph 27, Registrant admits that TURNKEY is the only element in his Mark and therefore the dominant element. Except as

expressly admitted, Registrant denies each and every remaining allegation in paragraph 27 of the Cancellation.

28. In responses to paragraph 28, Registrant denies each and every allegation contained in paragraph 28 of the Cancellation.

29. In response to paragraph 29, Registrant admits that the records of the TSDR of the USPTO reflect that Registrant offers “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 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 International Class 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 International Class 037, and that Petitioner offers “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 International Class 036. Except as

- expressly admitted, Registrant denies each and every remaining allegation in paragraph 29 of the Cancellation.
30. In response to paragraph 30, Registrant admits the allegations in paragraph 30 of the Cancellation.
24. Registrant respectfully informs the Board that Petitioner has erroneously numbered paragraph 31 as paragraph 24. In responses to the erroneously numbered paragraph 24, Registrant denies each and every allegation contained in the erroneously numbered paragraph 24 of the Cancellation.
25. Registrant respectfully informs the Board that Petitioner has erroneously numbered paragraph 32 as paragraph 25. In responses to the erroneously numbered paragraph 25, Registrant denies each and every allegation contained in the erroneously numbered paragraph 25 of the Cancellation.
31. In responses to paragraph 31, Registrant denies each and every allegation contained in paragraph 31 of the Cancellation. Registrant further submits that the ownership of a corporate entity does not establish rights and/or ownership of a trademark either at common law or otherwise.
32. In responses to paragraph 32, Registrant denies each and every allegation contained in paragraph 32 of the Cancellation.
33. In responses to paragraph 33, Registrant admits that he is a non-active attorney with some experience in building and marketing Internet businesses, which may use domain names as the name and trademark of a business. Except as expressly admitted, Registrant denies each and every remaining allegation in paragraph 33 of the Cancellation.

34. In responses to paragraph 34, Registrant denies each and every allegation contained in paragraph 34 of the Cancellation.
35. In responses to paragraph 35, Registrant denies each and every allegation contained in paragraph 35 of the Cancellation.
36. In response to paragraph 36, Registrant admits the allegations in paragraph 36 of the Cancellation.
37. In responses to paragraph 37, Registrant denies each and every allegation contained in paragraph 37 of the Cancellation.
38. In responses to paragraph 38, Registrant denies each and every allegation contained in paragraph 38 of the Cancellation.
39. In responses to paragraph 39 Registrant denies each and every allegation contained in paragraph 39 of the Cancellation.

AFFIRMATIVE DEFENSES

By way of further answer, Registrant alleges and asserts the following defenses in response to the allegations contained in the Cancellation. In this regard, Registrant undertakes the burden of proof only as to those defenses that are deemed affirmative defenses by law, regardless of how such defenses are denominated in the instant Answer. Registrant reserves the right to assert other affirmative defenses as this opposition proceeds based on further discovery, legal research, or analysis that may supply additional facts or lend new meaning or clarification to Petitioner's claims that are not apparent on the face of the Cancellation.

FIRST AFFIRMATIVE DEFENSE FAILURE TO STATE A CLAIM

40. Registrant incorporates by reference Paragraphs 1 - 39, inclusive as if fully set forth herein.

41. Petitioner's claims are barred because the Cancellation fails to state a claim upon which relief can be granted

SECOND AFFIRMATIVE DEFENSE
NO INJURY OR DAMAGE

42. Registrant incorporates by reference Paragraphs 1 – 41, inclusive as if fully set forth herein.

43. Petitioner's claims are barred, in whole or in part, because Petitioner has not and will not suffer any injury or damage from the continued registration of U.S. Registration No. 4,340,236 for the Mark TURNKEY.

THIRD AFFIRMATIVE DEFENSE
PRIORITY AND LACK OF LIKELIHOOD OF CONFUSION

44. Registrant incorporates by reference Paragraphs 1 – 43, inclusive as if fully set forth herein.

45. Petitioner admittedly does not own superior common law rights or any registered Mark(s) that would be confused with Registrant's Mark in terms of sight, sound, meaning and commercial impression.

46. Registrant's Mark differs in terms of sight, sound, and meaning from Petitioner's alleged Mark and has a distinct commercial impression from Petitioner's alleged Mark.

47. Registrant's registration of the TURNKEY Mark does not create a likelihood of confusion among consumers that Registrant's goods and/or services are offered, are sponsored by, or are otherwise endorsed by Petitioner. Nor does

Registrant's use or registration of his Mark create the likelihood that consumers will falsely believe that Registrant and Petitioner are affiliated in any way.

FOURTH AFFIRMATIVE DEFENSE
LACK OF ACTUAL CONFUSION

48. Registrant incorporates by reference Paragraphs 1 – 47, inclusive as if fully set forth herein.
49. Registrant filed its TURNKEY Mark in connection with his goods and services in International Classes 035, 036, and 037 on October 25, 2012, registrant was awarded a federal registration on May 21, 2013, and registrant has been using the Mark in interstate commerce since at least as early as November 1, 2012, and has not experienced any confusion with Petitioner or its alleged services, if any. On information and belief, and based on Petitioner's pleadings, Petitioner also has not experienced any actual confusion, notwithstanding Registrant's use in interstate commerce since at least as early as November 1, 2012.

FIFTH AFFIRMATIVE DEFENSE
LACK OF STANDING

50. Registrant incorporates by reference Paragraphs 1 – 49, inclusive as if fully set forth herein.
51. Petitioner's claims are barred, in whole or in part, because Petitioner does not have standing in that Petitioner does not have rights, superior or otherwise, sufficient to support this Cancellation.
52. Specifically, and as admitted by Petitioner, Petitioner has been using the Mark in interstate commerce only since October 1, 2014, at least 22 months after Registrant's first use in Interstate commerce. Furthermore, Petitioner has based

its claims entirely on the registration of a domain name, and the filing of its corporate entity. Simply owning a domain name and having registered a corporate entity do not amount to actual nor analogous trademark use.

SIXTH AFFIRMATIVE DEFENSE
LACHES

53. Registrant incorporates by reference Paragraphs 1 – 52, inclusive as if fully set forth herein.
54. Petitioner’s claims are barred, in whole or in part, by the doctrine of laches.
55. Specifically, Petitioner admittedly was aware of Registrant since at least as early as September 5, 2012, and Petitioner did not inform Registrant, until the filing of this Cancellation, that it claimed alleged prior or superior rights in the TURNKEY Mark in connection with real property rental and related services.

SEVENTH AFFIRMATIVE DEFENSE
ACQUIESCENCE

56. Registrant incorporates by reference Paragraphs 1 – 55, inclusive as if fully set forth herein.
57. Petitioner’s claims are barred, in whole or in part, by the doctrine of Acquiescence.
58. Specifically, Petitioner admittedly was aware of Registrant and Registrant’s use or intended use of his TURNKEY Mark since at least as early as September 5, 2012, and Petitioner did not inform Registrant until the filing of this Cancellation that it claimed prior or superior rights in the TURNKEY Mark in

connection with real property rental and related services, or that it was protesting his use of the TURNKEY Mark.

EIGHTH AFFIRMATIVE DEFENSE
INSUFFICIENT PRIOR EXCLUSIVE RIGHTS

59. Registrant incorporates by reference Paragraphs 1 – 58, inclusive as if fully set forth herein.

60. Petitioner’s claims are barred, in whole or in part, because Petitioner cannot establish prior exclusive rights in the United States sufficient to bar Registrant’s continued registration of his TURNKEY Mark.

NINTH AFFIRMATIVE DEFENSE
LACK OF SECONDARY MEANING

61. Registrant incorporates by reference Paragraphs 1 – 60, inclusive as if fully set forth herein.

62. Petitioner’s claims are barred, in whole or in part, by the lack of sufficient secondary meaning in Petitioner’s Mark in question in this matter.

TENTH AFFIRMATIVE DEFENSE
Waiver

63. Registrant incorporates by reference Paragraphs 1 – 62, inclusive as if fully set forth herein.

64. Petitioner’s claims are barred, in whole or in part, by the doctrine of Waiver.

65. Specifically, Petitioner admittedly was aware of Registrant and Registrant’s use or intended use of his TURNKEY Mark since at least as early as September 5, 2012, and Petitioner never attempted to enforce its alleged trademarks rights against Registrant.

ELEVENTH AFFIRMATIVE DEFENSE
ESTOPPEL

66. Registrant incorporates by reference Paragraphs 1 – 65, inclusive as if fully set forth herein.
67. Petitioner’s claims are barred, in whole or in part, by the doctrine of Estoppel.

TWELFTH AFFIRMATIVE DEFENSE
UNCLEAN HANDS – HARASSMENT AND EXTORTION

68. Registrant incorporates by reference Paragraphs 1 – 67, inclusive as if fully set forth herein.
69. Petitioner’s claims are barred, in whole or in part, by the doctrine of unclean hands, in that Petitioner filed this Cancellation for the sole purpose to harass and extort Registrant.

THIRTEENTH AFFIRMATIVE DEFENSE
NO BASIS

70. Registrant incorporates by reference Paragraphs 1 – 69, inclusive as if fully set forth herein.
71. Petitioner has no basis either in law or fact, to cancel Registrant’s registration for the TURNKEY Mark.

FOURTEENTH AFFIRMATIVE DEFENSE
SOPHISTICATED PURCHASERS

72. Registrant incorporates by reference Paragraphs 1 – 71, inclusive as if fully set forth herein.
73. There is no likelihood of confusion among the relevant purchasing public because the relevant purchasing public consists of highly sophisticated,

discriminating, and experienced consumers who are certain to be able to distinguish Registrant's and Petitioner's respective trademarks, goods, and/or services. As such, there is no likelihood at all that the relevant purchasing public might be confused about the use of the term TURNKEY by Registrant.

74. In addition, there is no likelihood of confusion among the relevant purchasing public because the relevant purchasing public consists of highly sophisticated brand loyal consumers who's brand loyalty is certain to be able to allow them to distinguish Registrant's and Petitioner's respective trademarks, goods, and/or services. As such, there is no likelihood at all that the relevant purchasing public might be confused about the use of the term TURNKEY by Registrant.

FIFTEENTH AFFIRMATIVE DEFENSE
DIFFERING COMMERCIAL IMPRESSIONS

75. Registrant incorporates by reference Paragraphs 1 – 74, inclusive as if fully set forth herein.
76. Registrant's Mark and Petitioner's Mark have very different commercial impressions.

SIXTEENTH AFFIRMATIVE DEFENSE
FAILURE TO POLICE

77. Registrant incorporates by reference Paragraphs 1 – 76, inclusive as if fully set forth herein.
78. Petitioner has failed to adequately maintain, police, or enforce trademark or proprietary rights it may have in its alleged trademark. Specifically, Petitioner admittedly was aware of Registrant and Registrant's use or intended use of his

TURNKEY Mark since at least as early as September 5, 2012, and Petitioner neither informed nor enforced its alleged rights against Registrant until the filing of this Cancellation.

SEVENTEENTH AFFIRMATIVE DEFENSE
STRICT PROOF

79. Registrant incorporates by reference Paragraphs 1 – 78, inclusive as if fully set forth herein.
80. Registrant calls for strict proof of all of the allegations against Registrant.

EIGHTEENTH AFFIRMATIVE DEFENSE
NARROW RIGHTS

81. Registrant incorporates by reference Paragraphs 1 – 80, inclusive as if fully set forth herein.
82. Petitioner’s claims are barred, in whole or in part, because the adoption and use of the terms “TURN” and “KEY” or phonetic or foreign equivalents are widespread in connection with identical and/or substantially related goods or services to those offered by Petitioner. This widespread adoption requires that Petitioner’s claimed Mark be construed narrowly such that Petitioner’s claimed Mark cannot—as a matter of law—form the basis of a likelihood of confusion, mistake, or deception claim against Registrant.

NINETEENTH AFFIRMATIVE DEFENSE

83. Registrant incorporates by reference Paragraphs 1 – 82, inclusive as if fully set forth herein.
84. Registrant reserves the right to assert any and all other affirmative defenses of which Registrant becomes aware during the pendency of this matter.

WHEREFORE, Registrant requests judgment as follows:

1. That the Cancellation be dismissed with prejudice in favor of Registrant;
2. That Registrant be granted further reasonable and appropriate relief.

Dated: February 13, 2015

Respectfully submitted,

/Kuscha Hatami/

Kuscha Hatami, Esq.

1300 Montecito Avenue

No. 20

Mountain View, CA. 94043

Tel. 858.342.9621

Hatami@legaledgelaw.com

Attorney for Registrant

Thomas Clark

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of REGISTRANT'S ANSWER TO PETITIONER'S PETITION FOR CANCELLATION is being served by mailing a copy thereof, postage prepaid, by United States Postal Service addressed to the following individual(s), identified in the Petition for Cancellation as the attorney(s) of record and correspondent(s) on this 13th day of February, 2015:

David M. Adler
Adler Law Group
300 Saunders Road, Suite 100
Riverwoods, IL. 60015

Attorneys for Petitioner

/Kuscha Hatami/
Kuscha Hatami, Esq.
1300 Montecito Avenue
No. 20
Mountain View, CA. 94043
Tel. 858.342.9621
Hatami@legaledgelaw.com
Attorney for Registrant
Thomas Clark