

ESTTA Tracking number: **ESTTA714753**

Filing date: **12/15/2015**

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	HostGator.com, LLC		
Entity	limited liability company	Citizenship	Florida
Address	5005 Mitchelldale, Suite #100 Houston, TX 77092 UNITED STATES		

Attorney information	Lindsay M. Rodman Cowan, Liebowitz and Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES trademark@cll.com, lmr@cll.com, rje@cll.com, mlk@cll.com		
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Registration Subject to Cancellation

Registration No	4101505	Registration date	02/21/2012
Registrant	Geek Gator LLC P.O. BOX 1014 Peralta, NM 87042 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2010/11/01 First Use In Commerce: 2011/05/01 All goods and services in the class are cancelled, namely: Creating, designing and maintaining web-sites
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Grounds for Cancellation

Other	Please see attached pleading.
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Attachments	GEEK GATOR Petition to Cancel.pdf(245205 bytes) GEEK GATOR Cancellation Letter to Commissioner.pdf(114890 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	/Lindsay Rodman/
Name	Lindsay M. Rodman

Date	12/15/2015
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 4,101,505
Registration Issued: February 21, 2012
For Mark: GEEK GATOR and Design

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HOSTGATOR.COM, LLC,

Petitioner,

v.

GEEK GATOR LLC,

Registrant.
----- X

Cancellation No.

**PETITION FOR
CANCELLATION**

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Petitioner, HostGator.com, LLC, a Florida limited liability company with an address at 5005 Mitchelldale, Suite #100, Houston, Texas 77092 (“Petitioner”), believes that it will be damaged by the continued registration of the mark GEEK GATOR and Design, shown here:



(“Registrant’s Mark”) for “creating, designing and maintaining web sites” in International Class 42, as shown in Registration No. 4,101,505 (the “Registration”), and hereby petitions to cancel the Registration.

As grounds for cancellation, it is alleged that:

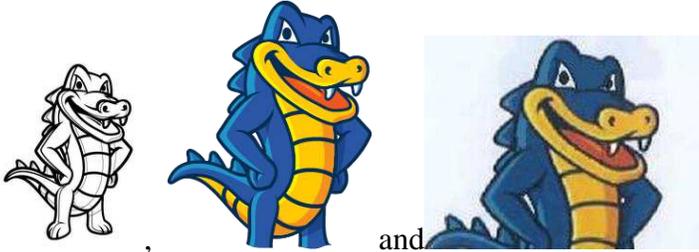
1. Since long prior to November 1, 2010, Registrant’s claimed first use date, Petitioner has used the word mark HOSTGATOR (“Petitioner’s HOSTGATOR Mark”), alone or with other word, letter and/or design elements (collectively, “Petitioner’s HOSTGATOR

Marks”) in connection with a variety of goods and services, including, but not limited to, designing, hosting and maintaining websites; domain name searching services; hosting or providing software (SAAS) or a platform (PAAS) featuring software for others in building, designing, managing and customizing websites and website services, features and functions; computer website design consultation; design, hosting and maintenance of website security services; domain name registration services; and promotional goods relating to the foregoing services.

2. Petitioner owns incontestable United States Registration No. 3,193,860 for Petitioner’s HOSTGATOR Mark covering “design, creation, hosting, maintenance of websites for others; hosting of digital content on the Internet; hosting the web sites of others on a computer server for a global computer network” in International Class 42, which was filed on March 7, 2006 and matured into registration on January 2, 2007, and which claims a first use date of October 22, 2002 (“Petitioner’s HOSTGATOR Registration”).

3. As a result of the rendering and promotion of Petitioner’s services offered in connection with Petitioner’s HOSTGATOR Marks, Petitioner has built up highly valuable goodwill in Petitioner’s HOSTGATOR Marks, and said goodwill has become closely and uniquely identified and associated with Petitioner.

4. Since long prior to November 1, 2010, Registrant’s claimed first use date, Petitioner has extensively used depictions of a distinctive alligator character mark named

Snappy, as depicted here: , alone or with

other word, letter or design elements (“Petitioner’s Gator Design Marks”) in connection with a variety of goods and services, including, but not limited to, designing, hosting and maintaining websites; domain name searching services; hosting or providing software (SAAS) or a platform (PAAS) featuring software for others in building, designing, managing and customizing websites and website services, features and functions; computer website design consultation; design, hosting and maintenance of website security services; domain name registration services; and promotional goods relating to the foregoing services.

5. Since long prior to November 1, 2010, Petitioner has often used Petitioner’s Gator Design Marks in close conjunction with Petitioner’s HOSTGATOR Marks, including, without limitation, as used on Petitioner’s website as shown here:



6. Petitioner has used Petitioner’s Gator Design Marks in various poses and colors and dressed in various apparel, headwear and eyewear to suggest various occupations and



occasions, such as those shown here:



7. Petitioner owns United States Registrations for Petitioner’s Gator Design Marks, namely, Registration No. 4,412,111 covering “design, creation, hosting, and maintenance of websites for others; hosting of digital content on the Internet; hosting the web sites of others on a computer server for a global computer network” in International Class 42, which was filed on August 13, 2012 and matured into registration on October 1, 2013, and which claims a first use date of November 21, 2002, and Registration No. 4,658,867 covering “Electronic mail services; e-mail and website forwarding services; providing multiple user-access to a global computer information network” in International Class 38, “domain name searching services, namely, conducting online computerized searches for the availability of domain names; software as a service (SAAS) services, namely hosting software for use by others in building, designing, managing, customizing and personalizing websites and website services, features, and functions; software as a service (SAAS) services featuring software for use by others in designing, managing, customizing and personalizing websites and websites services, features, and

functions; platform as a service (PAAS) featuring computer software platforms for use by others in building, designing, managing, customizing, and personalizing websites and website services, features, and functions; computer website design consultation; design, hosting, and maintenance of website security services; design, creation, hosting and maintenance of websites of others; hosting of digital content on the internet; hosting the websites of others on a computer server for a global computer network” in International Class 42, and “domain name registration services” in International Class 45, which was filed on April 18, 2014 and matured into registration on December 23, 2014, and which claims a first use date of November 21, 2002 (collectively, “Petitioner’s Gator Design Registrations”).

8. As a result of the rendering and promotion of Petitioner’s services offered in connection with Petitioner’s Gator Design Marks, Petitioner has built up highly valuable goodwill in Petitioner’s Gator Design Marks, and said goodwill has become closely and uniquely identified and associated with Petitioner.

9. On May 3, 2011, Registrant filed an application to register Registrant’s Mark for “creating, designing and maintaining web sites” in International Class 42, claiming a first use date of November 1, 2010 and a first use in commerce date of May 1, 2011, which matured to Registration No. 4,101,505 on February 21, 2012.

10. Upon information and belief, Registrant did not use Registrant’s Mark for the services covered by the Registration prior to Registrant’s claimed first use date of November 1, 2010.

11. On April 18, 2014, Petitioner filed Application Serial No. 86/256,536 for Petitioner’s HOSTGATOR Mark, which, as amended, covers “domain name searching services, namely, conducting online computerized searches for the availability of domain names; software

as a service (SAAS) services, namely hosting software for use by others in building, designing, managing, customizing and personalizing websites and website services, features, and functions; software as a service (SAAS) services featuring software for use by others in designing, managing, customizing and personalizing websites and websites services, features, and functions; platform as a service (PAAS) featuring computer software platforms for use by others in building, designing, managing, customizing, and personalizing websites and website services, features, and functions; computer website design consultation; design, hosting and maintenance of website security services” in International Class 42, and “domain name registration services” in International Class 45, claiming a first use date of October 22, 2002 (“Petitioner’s Application”).

12. During the examination of Petitioner’s Application, the Trademark Examining Attorney issued an Office Action citing the Registration against Petitioner’s Application pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

13. On August 20, 2015, the Trademark Examining Attorney denied Petitioner’s Request for Reconsideration and finally refused Petitioner’s Application on the basis of the Registration to which this Petition is directed.

14. On August 21, 2015, Petitioner filed an appeal to the refusal of Petitioner’s Application, which appeal is pending before the Trademark Trial and Appeal Board.

15. Petitioner has used Petitioner’s HOSTGATOR Marks in United States commerce since at least as early as October 22, 2002, and has used Petitioner’s Gator Design Marks in United States commerce since at least as November 21, 2002, long prior to Registrant’s claimed first use date of November 1, 2010 and constructive first use date of May 3, 2011.

16. If, as the Trademark Attorney contends, Petitioner's HOSTGATOR Mark so resembles Registrant's Mark as to be likely, when used in connection with the services of Petitioner, to cause confusion, then the Registration should be cancelled because plaintiff has priority of use and/or registration in connection with Petitioner's HOSTGATOR Marks and Petitioner's Gator Design Marks in connection with identical and/or closely related services.

17. Petitioner has been damaged by the continued registration of Registration No. 4,101,505 in that said Registration has been cited as a bar to Petitioner's Application.

WHEREFORE, Petitioner requests that this Petition be granted, and that Registration No. 4,101,505 be cancelled.

Please recognize as attorneys for Petitioners in this proceeding Mary L. Kevlin and Robert J. English (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Dated: New York, New York
December 15, 2015

Respectfully submitted,
COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Petitioners

By: /Lindsay M. Rodman/
Mary L. Kevlin
Robert J. English
Lindsay M. Rodman

1133 Avenue of the Americas
New York, New York 10036
(212)790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on December 15, 2015, I caused a true and correct copy of the foregoing *Petition for Cancellation* to be sent via First Class Mail, postage prepaid, to Registrant Geek Gator LLC, P.O. Box 1014, Peralta, New Mexico 87042.

Dated: New York, New York
December 15, 2015

/Lindsay M. Rodman/
Lindsay M. Rodman



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December 15, 2015

By Electronic Filing

Commissioner for Trademarks
Attn: TTAB
P.O. Box 1451
Alexandria, VA 22313-1451

Re: HostGator.com, LLC,
Petition for Cancellation against
Geek Gator LLC,
Registration for GEEK GATOR and Design
Ref. No. 30615.007

Dear Commissioner:

We enclose a Petition for Cancellation against Registration Number 4,101,505 issued on February 21, 2012. Contemporaneously with the electronic filing of this Notice of Opposition, we are arranging for an electronic payment in the amount of \$300.00 to cover the filing fee.

If the amount received is insufficient and additional fees are required, please charge our Deposit Account No. 03-3415.

Please address all future correspondence to the attention of Mary L. Kevlin of Cowan, Liebowitz & Latman, P.C.

Respectfully submitted,

/Lindsay M. Rodman /
Lindsay M. Rodman

Enclosures

cc: Jane Shih, Esq. (w/encs.)
Mary L. Kevlin, Esq. (w/encs.)