

ESTTA Tracking number: **ESTTA236307**

Filing date: **09/12/2008**

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

Proceeding	92047662
Party	Plaintiff The Colonial Williamsburg Foundation
Correspondence Address	Edward T. White Hunton & Williams P.O. Box 109 Raleigh, NC 27602 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Edward T. White
Filer's e-mail	HWRATM@hunton.com
Signature	/Edward T. White/
Date	09/12/2008
Attachments	Williamsburg Store.com Plaintiffs Brief Executed.pdf (22 pages)(2798657 bytes) Williamsburg Store.com Plaintiffs Brief Exhibits.pdf (11 pages)(489279 bytes)

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Cancellation No. 92047662

In the Matter of Registration No. 2,726,455

Mark: THE WILLIAMSBURGSTORE.COM

THE COLONIAL WILLIAMSBURG)	
FOUNDATION,)	
)	
Petitioner,)	
)	
v.)	
)	
WILLIAMSBURG STORE, INC.)	
)	
Registrant.)	

PETITIONER'S MAIN BRIEF

Petitioner, The Colonial Williamsburg Foundation, through its undersigned counsel, submits this brief pursuant to 37 C.F.R. §§2.128, *et seq.*, and T.B.M.P. §§801, *et seq.*, in support of its Petition for Cancellation to the Trademark Trial and Appeal Board (“the Board”) regarding the registered mark THE WILLIAMSBURGSTORE.COM, the subject of U.S. Registration No. 2,726,455, based on a likelihood of confusion with Petitioner’s Marks, and abandonment of Registrant’s mark.

I. Introduction

Petitioner seeks cancellation of the mark THE WILLIAMSBURGSTORE.COM, owned in the name of The Williamsburg Store, Inc. Not only does Registrant’s mark create a likelihood of confusion with Petitioner’s Marks, THE WILLIAMSBURGSTORE.COM mark has been abandoned. Petitioner respectfully requests that Registrant’s mark be cancelled.

II. Description of the Record.

The record includes the following documents:

1. Petitioner's Petition for Cancellation, dated June 1, 2007
2. Notice and Trial Dates Issued by the Board, dated June 15, 2007.
3. Registrant's Answer, dated July 25, 2007
4. Notice from the Board Notifying Defendant of Failure to Include Proof of Service, dated August 17, 2007
5. Plaintiff's Notice of Reliance, dated March 31, 2008

III. Background Information Regarding Petitioner and Its Products and Services.

Petitioner is the owner of several registered marks using WILLIAMSBURG to designate a host of products and services. Petitioner's Marks include the following 70 Marks, which consist of or contain the word WILLIAMSBURG:

Mark	Registration No.	Registration Date	Goods or Services
COLONIAL WILLIAMSBURG	1,385,520	3/4/86	Retail Household Furnishings and Accessories, Gifts and Souvenir Store Services, in International Class 42
COLONIAL WILLIAMSBURG	1,382,716	2/11/86	Arranging and Conducting Tours, in International Class 39
COLONIAL WILLIAMSBURG	1,382,802	2/11/86	Hotel and Restaurant Services, in International Class 42
COLONIAL WILLIAMSBURG	1,382,737	2/11/86	Presenting Musical Concerts, Recitals and Festivals, Theatrical Productions and Motion Pictures; Providing Golf, Swimming, Tennis, Lawn Bowling and Croquet Services; Educational Services, Namely, Conducting Seminars and Classes in the Fields of Early American History, Crafts and Gardens, in International Class 41
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHHT and Design	3,044,341	1/17/06	Woven Wood Baskets, in International Class 21
COLONIAL WILLIAMSBURG HISTORIC TRADES	2,991,653	6/9/05	Wood Barrels, in International Class 20; Wood Buckets, in International Class 21

Mark	Registration No.	Registration Date	Goods or Services
CWHT and Design			
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,937,723	4/5/05	Fireplace Inserts, Namely, Andirons, in International Class 11; Non-Electric Candlesticks and Candelabums Not of Precious Metal, in International Class 21
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,937,724	4/5/05	Shoes and Slippers, in International Class 25
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,943,734	4/26/05	Hinges and Nails of Wrought Iron, in International Class 6; Hand-Operated Food Choppers Made of Wrought Iron With a Wooden Handle, in International Class 8
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,943,735	4/26/05	Hand Tools for Woodworking, Namely, S Hooks, Knives, Bench Dogs, Braces and Holdfasts, in International Class 8
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,963,197	6/21/05	Wooden Wheelbarrows, in International Class 12
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,941,777	4/19/05	Trade Silver Indian Jewelry, in International Class 14
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,951,518	5/17/05	Paper Products, Namely, Printed Art Reproductions, Namely in the Nature of 18 th and 19 th Century Newspapers, Periodicals, Single Publications, Novelettes and Advertising, in International Class 16
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,943,732	4/26/05	Furniture, in International Class 20
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	3,012,934	11/08/05	Cooking Utensils, Namely, Wrought Iron Hand Operated Food Choppers and Knives, in International Class 8; Cooking Utensils, Namely, Serving Spoons, Spoons Made of Steel Used for Stirring and Tasting Food in Deep Pots, Trivets, Frying Pan, in

Mark	Registration No.	Registration Date	Goods or Services
			International Class 21
COLONIAL WILLIAMSBURG HISTORIC TRADES CWHT and Design	2,943,733	4/26/05	Hairpieces, in International Class 26
WILLIAMSBURG	2,893,481	10/12/04	Metal hardware, namely, gate straps, hinges and latches, in International Class 6; Non-metal gates and fences, in International Class 19
WILLIAMSBURG	2,727,739	6/17/03	Architectural house plans and design drawings, in International Class 16
WILLIAMSBURG	2,625,351	9/24/02	Artificial flower arrangements, in International Class 26; Live flower arrangements, in International Class 31
WILLIAMSBURG	2,316,393	2/8/00	Stainless steel flatware, namely, table knives, forks, spoons, ladles, pie services, butter spreaders, and cheese spreaders, in International Class 8
WILLIAMSBURG	2,284,708	10/12/99	Bedspreads, comforters, bed sheets, pillow cases, shams, duvets, coverlets, dust ruffles, throws, draperies, fabric valences, shower curtains, table clothes, not of paper, textile placemats, textile napkins, and round table cloths not of paper, in International Class 24
WILLIAMSBURG	1,743,171	12/29/92	Pillows, in International Class 20
WILLIAMSBURG	1,605,501	7/10/90	Calendars, in International Class 16
WILLIAMSBURG	1,311,107	12/25/84	Reproductions and Adaptations of Antique Moldings, in International Class 19
WILLIAMSBURG	1,292,412	8/28/84	Rugs and Carpets, in International Class 27
WILLIAMSBURG	1,080,718	1/3/78	Toilet Soap, in International Class 3; Candles, in International Class 4; Chimney Hooks, in International Class 6; Electrified Lamps, in International Class 11; Fifes, in International Class 15; Note Paper, in International Class 16; Upholstery Leather, in International Class 18; Cookware, in International Class 21;

Mark	Registration No.	Registration Date	Goods or Services
			Towels, in International Class 24; Embroidery Kits, in International Class 26; Kits for Making Toy Replicas of Buildings, in International Class 18; Plant Materials, i.e., Potpourri Fragrance, in International Class 31; Ash Trays, in International Class 34
WILLIAMSBURG	784,506	2/2/65	Bedspreads, in International Class 24
WILLIAMSBURG	705,009	9/27/60	Needlepoint Foundations (That Is, Fabric Base With Partially Worked Needlepoint Design, for Completion by the Buyer), in International Class 26
WILLIAMSBURG	704,987	9/27/60	Maps and Pictorial Prints, in International Class 16
WILLIAMSBURG	704,958	9/27/60	Glassware for Table and Bar Use; and Miscellaneous Glassware Including Pitchers, Jugs, Decanters, Bottles, Rummors, Beakers, Muddlers, Vases, and Hurricane Candle Chimneys or Shades, in International Class 21
WILLIAMSBURG	704,949	9/27/60	China and Pottery Tableware, and Decorative and Miscellaneous Pieces of China and Pottery Including Vases, Jardinieres, Jugs, Trays and Candlesticks, in International Class 21
WILLIAMSBURG	706,631	11/1/60	Ladies' Costume Jewelry; Flat and Hollow Tableware Made of Precious Metal, including But Not Limited to Eating and Serving Utensils; and Decanter Labels and Candlesticks of Precious Metal, in International Classes 8 and 14
WILLIAMSBURG	704,947	9/27/60	Sundials and Clocks, in International Class 14
WILLIAMSBURG	704,936	9/27/60	Table Utensils, in International Class 8
WILLIAMSBURG	704,837	9/27/60	Pewter Flatware and Hollow Ware, Generally for Table and Desk Use, in International Classes 8 and 21
WILLIAMSBURG	682,904	8/4/59	Wallpaper and Writing Paper, in

Mark	Registration No.	Registration Date	Goods or Services
			International Classes 16 and 27
WILLIAMSBURG	682,243	7/21/59	Decorative Textile Fabric Piece Goods, in International Class 24
WILLIAMSBURG	682,850	8/4/59	Door Lock Sets (Including Lock Case, Keeper, Door Knobs or Handles, Key Plate (Optional), and Keys), in International Class 6
WILLIAMSBURG	682,566	7/28/59	Household Lighting Fixtures, and Candlesticks, Candelabras and Candleholders, in International Class 11
WILLIAMSBURG	682,413	7/28/59	Household Accessories of Metal (Including Paper Weights, Paper Clips, Book Ends, Door Stops, Door Knockers, Trivets, Hostess Bells, Smokers' Pipe Tamperers, Candle Snuffers, Corkscrews, Andirons, Firebacks, Fireplace Fenders, and Fireplace Tools), in International Class 8, 11, 16, 21 and 34
WILLIAMSBURG	678,080	5/5/59	Household Furniture-Namely, Furniture for Living Rooms, Dining Rooms, Libraries, Game Rooms, Hall and Bedrooms, in International Class 20
WILLIAMSBURG	682,089	7/21/59	Paints, in International Class 2
WILLIAMSBURG AT HOME	2,924,387	2/1/05	Retail Store Services Featuring Home Furnishings, in International Class 35
WILLIAMSBURG BOOKSELLERS	2,725,377	6/10/03	Retail store services, featuring general and special interest books on topics related to Colonial Williamsburg, namely, history, art, architecture, gardening, archeology, museums, decorative arts, antiques decorating; video tapes, compact discs, DVDs, cassette tapes on topics related to Colonial Williamsburg, namely, history art, architecture, gardening, archeology, museums, decorative arts, antiques, decorating; stationery, blank books, notecards, bookmarks, in International Class 35
WILLIAMSBURG	2,732,965	7/1/03	Retail store services featuring

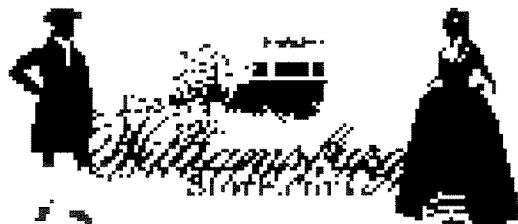
Mark	Registration No.	Registration Date	Goods or Services
BOOKSELLERS & Design			general and special interest books on topics related to Colonial Williamsburg, namely, history, art, architecture, gardening, archeology, museums, decorative arts, antiques decorating, video tapes, compact discs, DVDs, cassette tapes on topics related to Colonial Williamsburg, namely, history, art, architecture, gardening, archeology, museums, decorative arts, antiques, decorating; stationery, blank books, notecards, bookmarks, in International Class 35
WILLIAMSBURG COLLECTION	2,780,034	11/4/03	Catalogs of architectural house plans and design drawings, in International Class 16
WILLIAMSBURG INN	3,017,751	11/22/05	Providing Recreation Facilities, Namely, Golf Courses, Swimming Pools, Tennis Courts, Lawn Croquet, Lawn Bowling; Fitness Services, Namely, Providing Exercise Room, Group Exercise Studio, and Personal Trainer Services; Entertainment Services Featuring Live Music and Dancing Events, in International Class 41; Hotel and Restaurant Services, in International Class 43
WILLIAMSBURG MARKETPLACE	2,732,964	7/1/03	Retail store services featuring logo apparel, souvenirs, collectibles, gifts, specialty food products, toys, games, stationery and other paper products, in International Class 35
WILLIAMSBURG MARKETPLACE & Design	2,725,378	6/10/03	Retail store services featuring logo apparel, souvenirs, collectibles, gifts, specialty food products, toys, games, stationery and other paper products, in International Class 35
WILLIAMSBURG RESTORATION INC 4 CW XX and Design	399,815	2/2/43	Tables, Desks, Cabinets for Bric-A-Brac and Books, Chairs, Sofas, Candle Stands, Hanging Shelves, Mirrors, Stools, Beds, Sideboards, Garden Benches, Chests, Highboys, and Lowboys, in International Class 20

Mark	Registration No.	Registration Date	Goods or Services
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,244	7/21/59	Decorative Textile Fabric Piece Goods, in International Class 24
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,849	8/4/59	Door Lock Sets (Including Lock Case, Keeper, Door Knobs and Handles, Key Plate (Optional), and Keys), in International Class 6
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,412	7/28/59	Household Accessories of Metal (Including Paper Weights, Paper Clips, Book Ends, Door Stops, Door Knockers, Smokers' Pipe Tamperers, Candle Snuffers, Corkscrews, and Irons, Firebacks, Fireplace Fenders, and Fireplace Tools), in International Classes 8, 11, 16, 21 and 34
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,565	7/28/59	Household Lighting Fixtures, and Candlesticks, Candelabras and Candleholders, in International Class 11
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,605	10/11/60	Maps and Pictorial Prints, in International Class 16
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,577	10/11/60	Glassware for Table and Bar Use; and Miscellaneous Glassware Including Pitchers, Jugs, Decanters, Bottles, Rummors, Beakers, Muddlers, Vases, and Hurricane Candle Chimneys or Shades, in International Class 21
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,569	10/11/60	China and Pottery Tableware, and Decorative and Miscellaneous Pieces of China and Pottery Including Vases, Jardinieres, Jugs, Trays, and Candlesticks, in International Class 21
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,534	10/11/60	Table Utensils, in International Class 8
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,445	10/11/60	Pewter Flatware and Hollow Ware, Generally for Table and Desk Use, in International Classes 8 and 21
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,010	9/27/60	Needlepoint Foundations (That Is, Fabric Base With Partially Worked Needlepoint Design, for Completion

Mark	Registration No.	Registration Date	Goods or Services
			by the Buyer), in International Class 26
WILLIAMSBURG RESTORATION 4 CW XX and Design	705,563	10/11/60	Sundials and Clocks, in International Class 14
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,849	8/4/59	Door lock sets (including lock case, keeper, door knobs or handles, key plate (optional), and keys), in International Class 6
WILLIAMSBURG RESTORATION 4 CW XX and Design	1,076,805	11/8/77	Household accessories of metal, namely, shoe horns and hinges, in International Class 6; Household containers and receptacles, namely, tea caddies, jewel boxes, serving trays, and ceramic household accessories, namely, tiles, flower holders, bricks, inkwells, bird houses, mugs, planters, cookware, jars, bowls, pitchers, serving dishes, and shakers, in International class 21; Embroidery kits containing fabric base, yarn and instructions, in International Class 26; Boards for checkers and chess, in International Class 28
WILLIAMSBURG RESTORATION 4 CW XX and Design	784,507	2/2/65	Bedspreads, in International Class 24
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,903	8/4/59	Wallpaper and Writing Paper, in International Classes 16 and 27
WILLIAMSBURG RESTORATION 4 CW XX and Design	665,074	7/29/58	Household Furniture-Namely, Furniture for Living Rooms, Dining Rooms, Libraries, Game Rooms, Halls, and Bedrooms, in International Class 20
WILLIAMSBURG RESTORATION 4 CW XX and Design	682,244	7/21/59	Decorative textile fabric piece goods, in International Class 24
WILLIAMSBURG RESTORATION 4 CW XX and Design	678,747	5/19/59	Paints, in International Class 2
WILLIAMSBURG RESTORATION 4	1,289,144	8/7/84	Rugs and Carpets, in International Class 27

Mark	Registration No.	Registration Date	Goods or Services
CW XX and Design WILLIAMSBURG RESTORATION 4 CW XX and Design	682,412	7/28/59	Household accessories of metal (including paper weights, paper clips, book ends, door stops, door knockers, smokers' pipe tampers, candle snuffers, corkscrews, andirons, firebacks, fireplace fenders, and fireplace tools), in International Classes 6, 7, 11, 17, 20 and 21

All of these Marks are registered on the Principal Register in the United States Patent and Trademark Office ("USPTO"). Many of these registrations have become incontestable pursuant to Section 15 of the Trademark Act of 1946. 15 U.S.C. §1065. On May 7, 2001, Registrant applied to the USPTO to register the mark THE WILLIAMSBURGSTORE.COM, to promote "Retail shops, featuring gifts, collectibles, notions, furnishings, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork." On June 17, 2003, the USPTO issued a registration certificate for THE WILLIAMSBURG STORE.COM mark, the subject of U.S. Registration No. 2,726,455. *See* Registrant's mark below, also attached as Exhibit A (Copy of Registrant's registration certificate).



On June 28, 2006, Petitioner applied to register the following Marks for the following goods:

a.) WILLIAMSBURG (Serial No. 78/925,618) for “room fragrance, potpourri, scented oils, sachets, scented drawer liners, fragrance diffusers, namely, small vases made of ceramic, scented dried flowers;”

b.) WILLIAMSBURG (Serial No. 77/011,479) for “Christmas tree ornaments;”

c.) WILLIAMSBURG CHRISTMAS (Serial No. 77/011,482) for “Christmas tree ornaments;”

d.) WILLIAMSBURG (Stylized) (Serial No. 78/918,753) for “place mats and table mats not of paper;” and

e.) WILLIAMSBURG (Stylized) (Serial No. 78/918,747) for “coasters not of paper; non-metallic serving trays; mugs; cutting boards; trivets.”

The Examining Attorney has refused registration of each Mark identified above, asserting that these Marks are confusingly similar to Registrant’s THE WILLIAMSBURGSTORE.COM mark.

IV. Argument

A. Registrant Has Demonstrably Abandoned its Mark and Has Made False and Misleading Allegations in Defense of its Registration.

In its Petition for Cancellation, Petitioner alleges numerous facts to establish that Registrant has abandoned its mark. *See* Petitioner’s Petition for Cancellation, p. 15. Registrant responded with false and misleading allegations in its Answer, claiming that, among other things, its mark was in use, and that the business operation associated with the mark was functional. *See* Registrant’s Contest Petition for Cancellation of Trademark, p. 11, 16-17. This alone should be the basis upon which Registrant’s registration is cancelled.

At the time Registrant received and was notified of Petitioner's Petition for Cancellation filed on June 1, 2007, Registrant's corporate existence under the name The Williamsburg Store, Inc. had been automatically terminated by the State Corporation Commission of the Commonwealth of Virginia, as of March 31, 2004. Nevertheless, Registrant sought incorporation in the Commonwealth of Virginia on July 24, 2007, after it had been notified of Petitioner's Petition for Cancellation, for the single and express purpose of being able to assert that it was operating under the The Williamsburg Store, Inc. trade name in its Answer to Petitioner's Petition for Cancellation.

Moreover, as of June 1, 2007, Registrant had not registered the domain name **www.williamsburgstore.com**. However, after Registrant received and was notified of Petitioner's Petition for Cancellation, Registrant inexplicably registered the domain name **www.thewilliamsburgstore.com** on July 20, 2007, for the single and express purpose of being able to assert that it was operating a website and promoting its mark on this website, in its Answer to Petitioner's Petition for Cancellation.

As of June 1, 2007, Registrant was not promoting any products under its registered mark, and Registrant had not sold any products in conjunction with its mark. Moreover, as of June 1, 2007, Registrant had not affixed its registered mark to business cards, letterhead, and signage on its business car, as depicted in Exhibit D to its Contest Petition for Cancellation of Trademark. These actions were clearly undertaken by Registrant after June 1, 2007 for the single and express purpose of being able to claim active promotion of its mark in its Answer to Petitioner's Petition for Cancellation.

Finally, as of June 1, 2007, Registrant had not offered any goods for sale in association with its mark on its website, and potential consumers could not purchase such goods, as Registrant provided no contact or sales information.

In an effort to confirm Registrant's fraudulent actions, Petitioner served discovery on Registrant on January 2, 2008. *See* The Colonial Williamsburg Foundation's First Set of Interrogatories, First Set of Requests for Production of Documents, and First Set of Requests for Admissions to the Williamsburg Store, Inc. ("Petitioner's Discovery Requests"); Registrant did not respond to Petitioner's Discovery Requests, and Petitioner timely filed a Notice of Reliance on March 31, 2008 with the Board. *See* Petitioner's Notice of Reliance, dated March 31, 2008. Under the Federal Rules of Civil Procedure, a matter is deemed admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney. Fed. R. Civ. P. 36(a)(3); *see also* Trademark Trial and Appeal Board Manual of Procedure, §101.02 ("Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure"). The effect of such an admission is that matter admitted under this Rule is conclusively established with the Board. Fed. R. Civ. P. at 36(3)(b).

Because Registrant did not respond to Petitioner's Discovery Requests, including its Request for Admissions, Registrant has admitted, and it is conclusively established that: 1.) it does not own or operate, and has never owned or operated under the trademark or tradename THE WILLIAMSBURGSTORE.COM, or WILLIAMSBURGSTORE.COM, a physical retail store anywhere in the United States; 2.) Petitioner filed a Petition for Cancellation of Registrant's mark on June 1, 2007; 3.) the corporate existence of The Williamsburg Store, Inc. was terminated on March 31, 2004 by the State Corporation Commission of the Commonwealth of

Virginia; 4.) Williamsburg Store, Inc. was incorporated in the Commonwealth of Virginia after June 1, 2007, on July 24, 2007, and Registrant sought such incorporation with full knowledge of the Petition for Cancellation of THE WILLIAMSBURGSTORE.COM mark, filed by Petitioner; 5.) the registered domain name **www.thewilliamsburgstore.com** was registered after June 1, 2007, with knowledge of the Petition for Cancellation of the THE WILLIAMSBURGSTORE.COM mark; 6.) the script used in the word “Williamsburg” on Registrant’s website is a well-recognized symbol associated with Petitioner, and Registrant received no authorization to display the word WILLIAMSBURG in the script used on Registrant’s website; 7.) Registrant’s website contains the phrase “Coming Soon!” and that at no time prior to January 2, 2008 has there been additional content on this website; *See Exhibit B* (printout from Registrant’s homepage); 8.) at no time has Registrant offered any goods or services for sale on its website, including any gifts, collectibles, notions, furnishings, apparel, toys, books, and other publications, recorded music, handcrafted goods, memorabilia, and artwork; 9.) Registrant has not sold any goods or services under the trademark or trade name THEWILLIAMSBURGSTORE.COM, including any gifts, collectibles, notions, furnishings, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork; 10.) as of January 2, 2008, no customer could purchase any product online through Registrant’s website, and Registrant had not offered for sale or sold any products online through its website; and 11.) as of January 2, 2008, no telephone number, toll free or otherwise, and no other contact information had ever appeared on Registrant’s website, and no product information or information relating to the placement of customer orders had ever appeared on the website. *See Petitioner’s Discovery Requests, p. 6-10.*

Registrant asserts that the nature of its business is “an online business is electronic in nature and all correspondence is meant to be performed online and not by local landline telephone.” *See* Registrant’s Contest Petition for Cancellation of Trademark, p. 11. However, as Registrant’s admissions prove, it has never sold any products under its registered mark in retail stores, or on its website¹. *See* Petitioner’s Discovery Requests, p. 6, 8; *see also* Petitioner’s Notice of Reliance; *see also* Exhibit B. Thus, Registrant’s admissions conclusively establish that it has ceased using its mark to promote the goods identified in its registration certificate, thereby abandoning its mark. Petitioner therefore requests that the Board grant its Petition for Cancellation related to Registrant’s mark.

There is a Likelihood of Confusion Between Petitioner’s and Registrant’s Marks

A. Petitioner’s and Registrant’s Marks Are Highly Similar in Sight, Sound, Meaning, and Commercial Impression

Even if the Board does not agree that Registrant’s mark has been abandoned, Petitioner asserts that Registrant’s mark should be cancelled due to a likelihood of confusion with Petitioner’s Marks. Petitioner’s Marks are WILLIAMSBURG and WILLIAMSBURG CHRISTMAS, and Registrant’s mark is THE WILLIAMSBURGSTORE.COM. While marks are compared in their entirety under a Trademark Act Section 2(d) analysis, one feature of a mark may be recognized as more significant in creating a commercial impression. *See* T.M.E.P. § 1207.01(b) (“When considering the similarity of the marks, ‘all relevant facts pertaining to the appearance and connotation must be considered.’”). As such, greater significance is given to that dominant element when evaluating whether there is a likelihood of consumer confusion between

¹ Incidentally, Registrant’s website, located at the domain name **www.williamsburgstore.com**, as of the date of this brief, still carries the message “Coming Soon!” and does not permit customers to either purchase or gather information about, Registrant’s products.

two highly similar marks. *See In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985) (“for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable”). Here, both Petitioner’s and Registrant’s marks share the same dominant element, WILLIAMSBURG, thereby generating a likelihood of confusion between the respective parties’ marks.

Marks may also be confusingly similar when similar terms or phrases or parts of terms or phrases appear in two highly similar marks. *In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949, 950 (T.T.A.B. 1986.) In this case, Registrant’s mark does not just share a similar element with Petitioner’s Marks, but includes a dominant element that is identical to the dominant element in Petitioner’s Marks. Hence, the marks are confusingly similar in appearance, creating a likelihood of confusion between the two parties’ marks.

Petitioner is extremely well-known, marketing an array of products and services for over 40 years, under 70 registered Marks using the term WILLIAMSBURG. As a result, WILLIAMSBURG has become a successful source indicator, firmly cementing the term as a brand in the minds of consumers. Given Petitioner’s renown and fame, Registrant’s use of the highly similar THE WILLIAMSBURGSTORE.COM mark will confuse consumers into believing that both Petitioner’s and Registrant’s products originate from the same source, thereby generating a likelihood of confusion between the respective parties’ marks. *See In re West Point- Pepperell, Inc.*, 468 F.2d 200, 201, 175 U.S.P.Q. 558, 558-559 (C.C.P.A. 1972) (“The issue under § 2(d) is not whether people will confuse the marks but whether the marks will confuse people; We are therefore of the opinion that § 2(d) precludes the registration here sought

because of likelihood of confusion or mistake as to the origin of the goods”). This likelihood of consumer confusion is further exacerbated by the fact that Registrant’s mark creates the same commercial impression as Petitioner’s Marks. While Registrant’s mark includes the additional terms THE, STORE, and COM, these are weak and non-distinctive terms that do not serve to distinguish Registrant’s mark from Petitioner’s Marks. That is, the mere addition of a term does not obviate similarity between marks, nor does it resolve a likelihood of confusion under a Trademark Section 2(d) analysis. *In re Chatham Int’l Inc.*, 380 F.3d 1340, 1343, 71 U.S.P.Q.2d 1944, 1946-1947 (Fed. Cir. 2004). In the case of Registrant’s mark, the inclusion of the additional words THE, STORE, and COM, does not serve to diminish the similarity between Petitioner’s and Registrant’s marks, and the likelihood of consumer confusion remains.

B. Registrant Shares Goods, Customers, and Trade Channels with Petitioner.

Registrant claims to market “Retail shops featuring gifts, collectibles, notions, furnishings, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork” under its mark. Petitioner’s products include “room fragrance, potpourri, scented oils, sachets, scented drawer liners, fragrance diffusers, namely, small vases made of ceramic, scented dried flowers; Christmas tree ornaments; place mats and table mats not of paper; and coasters not of paper; non-metallic serving trays; mugs; cutting boards; trivets.” Registrant’s products are related and highly similar to the products marketed by Petitioner under its Marks. The goods and services of parties need not be identical or directly competitive to establish a likelihood of confusion between two parties’ marks, but need only be related; or, the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would lead a consumer to believe that Petitioner’s and Registrant’s products originate from the same source. *See In re Martin's Famous Pastry Shoppe*,

748 F.2d 1565, 1566-1567, 223 U.S.P.Q. 1289, 1290 (Fed. Cir. 1984) (use of complementary products by two parties “provides one leg to the kind of product association that we believe would lead purchasers and consumers to assume a common source in the face of the same marks on such products-and that, after all, is the critical inquiry in these cases”); *see also Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 U.S.P.Q. 476, 480 (C.C.P.A. 1975) (“the law has long protected the legitimate interests of trademark owners and consumers from confusion among noncompetitive, but related, products bearing confusingly similar marks”).

Petitioner’s products are closely related to those of Registrant, as they are all products typically sold in retail gift shops, as are Registrant’s products. Furthermore, all of Petitioner’s products may be categorized as “gifts, collectibles, notions, or furnishings.” Due to the relatedness and similarity of the products offered by both Petitioner and Registrant under highly similar marks, consumers are apt to believe the products of both parties emanate from a single source, thereby creating consumer confusion.

Petitioner markets its products via a series of historic retail stores, to visitors of Colonial Williamsburg. *See Exhibit C* (printouts from Petitioner’s website). Petitioner’s products are marketed as unique items, intended to not only memorialize a person’s visit to Colonial Williamsburg, but also to evoke and firmly establish a positive association between Petitioner’s products and Colonial Williamsburg in the minds of visitors.

Registrant claims to market products that may be categorized by consumers as gifts and souvenirs. A review of Registrant’s website at www.thewilliamsburgstore.com, reveals two individuals, a man and a woman, dressed in “historical” clothing, along with an image of the Governor’s Palace, maintained by Petitioner, in the background. *See Exhibit B*. Through this imagery, it appears Registrant also seeks to promote products to visitors of Colonial

Williamsburg, via retail stores, as described in its federal registration certificate, as well as through its website. Moreover, it appears Registrant is deliberately attempting to create an association between itself and Petitioner, through the stylized presentation of WILLIAMSBURG, and the image of the Governor's Palace, included both in its mark and on its website. *See Exhibit C* (copies from Petitioner's website, demonstrating use of the stylized WILLIAMSBURG Mark, in promoting an array of goods and services). These facts make clear that Registrant and Petitioner promote the same goods, to the same customers, in identical channels of trade, thereby generating a likelihood of confusion between the parties' marks.

C. Registrant and Petitioner Market Low-Cost, Inexpensive Items

Petitioner sells, and Registrant claims to sell, gifts and memorabilia to visitors of Colonial Williamsburg under their respective marks. These items, while possibly retaining a high sentimental value to the purchaser, are ultimately low-cost items. Such items are purchased with less thought and consideration than more costly items. Consumers are likely to make purchasing decisions quickly, and without forethought and planning. Such rapid purchasing by both Petitioner's and Registrant's consumers leaves them vulnerable to consumer confusion when encountering each party's mark. *See Am. Stock Exch., Inc. v. Am. Express Co.*, 207 U.S.P.Q. 356, 365 (T.T.A.B. 1980) (applicant's AMEX mark not confusingly similar to opposer's AMEX mark: "these are services which by their very nature are not purchased on impulse; and we do not believe that persons encountering these services under the mark 'AMEX' would assume that the services were associated in some way with opposer"); *see also Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206, 220 U.S.P.Q. 786, 790 (1st Cir. 1983) ("There is always less likelihood of confusion where goods are expensive and purchased after careful consideration.").

V. **Conclusion.**

For the foregoing reasons, Petitioner respectfully requests that the Board cancel

Registrant's mark, THE WILLIAMSBURGSTORE.COM

Respectfully submitted,

Dated: September 12, 2008

A handwritten signature in cursive script, reading "Edward T. White". The signature is written in dark ink and is positioned above a horizontal line.

Douglas W. Kenyon
Robert C. Van Arnam
Edward T. White
Bradley W. Grout
Hunton & Williams
One Hannover Square, Suite 1400
421 Fayetteville Street Mall
Post Office Box 109
Raleigh, North Carolina 27602

Attorneys for Petitioner
The Colonial Williamsburg Foundation

Alphabetical Index of Cited Cases

Am. Stock Exch., Inc. v. Am. Express Co., 207 U.S.P.Q. 356 (T.T.A.B. 1980)

Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc., 718 F.2d 1201, 220 U.S.P.Q. 786 (1st Cir. 1983)

In re Chatham Int'l Inc., 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004)

See In re Martin's Famous Pastry Shoppe, 748 F.2d 1565, 223 U.S.P.Q. 1289 (Fed. Cir. 1984)

In re Nat'l Data Corp., 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985)

In re Phillips Van-Heusen Corp., 228 U.S.P.Q. 949 (T.T.A.B. 1986)

Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 186 U.S.P.Q. 476 (C.C.P.A. 1975)

In re West Point Point-Pepperell, Inc., 468 F.2d 200, 175 U.S.P.Q. 558 (C.C.P.A. 1972)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing PETITIONER'S MAIN BRIEF has been served upon all parties on September 12, 2008, by first-class U.S. Mail, postage prepaid, as follows:

Priscilla G. Shea
Owner, Store Manager
The Williamsburgstore.com
Post Office Box 526
Williamsburg, Virginia 23187-0526

A handwritten signature in cursive script, reading "Edward T. White", written in dark ink.

Edward T. White

EXHIBIT A

Int. Cl.: 35

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

United States Patent and Trademark Office

Reg. No. 2,726,455

Registered June 17, 2003

**SERVICE MARK
PRINCIPAL REGISTER**



**WILLIAMSBURG STORE, INC., THE (VIRGINIA CORPORATION)
POST OFFICE BOX 526
WILLIAMSBURG, VA 231870526**

FOR: RETAIL SHOPS FEATURING GIFTS, COLLECTIBLES, NOTIONS, FURNISHINGS, APPAREL, TOYS, BOOKS AND OTHER PUBLICATIONS, RECORDED MUSIC, HANDCRAFTED GOODS, MEMORABILIA AND ARTWORK, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

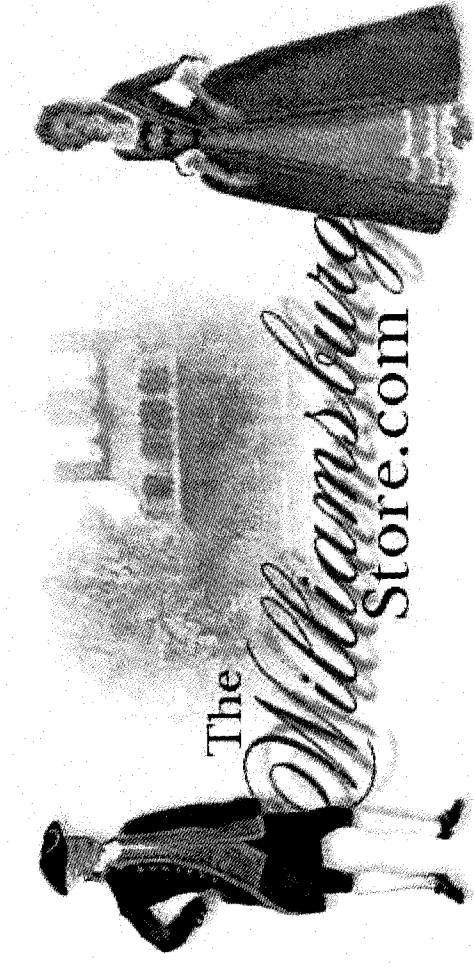
FIRST USE 10-14-1999; IN COMMERCE 10-14-1999.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "WILLIAMSBURGSTORE.COM", APART FROM THE MARK AS SHOWN.

SER. NO. 76-254,660, FILED 5-7-2001.

AMOS T. MATTHEWS, JR., EXAMINING ATTORNEY

EXHIBIT B



Coming Soon!

EXHIBIT C



VISIT : Williamsburg™ Stores

Bring History Home

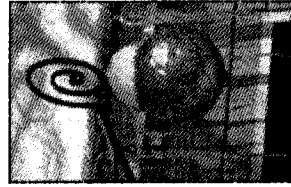
SHOP Williamsburg STORES

What makes our products different? Each one has a story. A story of inspiration, vision, creativity, and tradition—a story you are helping to keep alive in America's hearts and homes. That's because a portion of your purchase supports the Colonial Williamsburg Foundation's award-winning educational programs, like electronic field trips, bringing the American experience to life for millions of young people.

Come explore all we have to offer—and make a little piece of our story part of your own.

Historic Area Shops

Imagine buying gifts at the same stores where Washington and Jefferson once shopped. For an authentic 18th-century shopping experience, look no further than our scenic Historic Area.



Golden Ball

Reproductions of precious gemstone rings, earrings, pendants, and charms in sterling silver and 14 karat gold, plus beautifully crafted brass and pewter hollowware. Hand engraving is available on site.
(757) 229-1000



Jump to

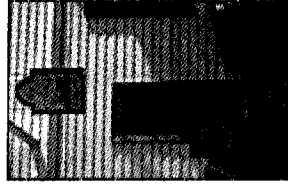
- ❖ Historic Area Shops
- ❖ Merchants Square Shops
- ❖ Visitor Center and Resort Shopping

Related Links

[View map of shopping locations.](#)

Prentis Store

One-of-a-kind items, handmade by our skilled tradespeople using 18th-century tools and techniques. Browse among richly handcrafted leather goods, iron hardware, and reproduction pottery.
(757) 229-1000



The John Greenhow Store

Wrought iron, willow baskets, fine imported porcelain, floorcloths, fabrics, cooper's items, tinware, craftsmen's tools, and other goods similar to those sold by Mr. Greenhow in the 18th century.
(757) 229-1000



Colonial Nursery

Heirloom seeds and plants, herbs, flowers, seasonal greens, wreaths, 18th-century clay flower pots, and bird bottles.
(757) 229-1000



Mary Dickinson Shop

Eighteenth-century fashion in the best of taste: petticoats, short gowns, cloaks, mitts, caps, and beautifully decorated straw hats—all made in Williamsburg. Jewelry and ladies' toiletries as well.
(757) 229-1000



M. Dubois Grocer

The perfect place to find delicacies such as chocolate, sugar, port wine, preserves, and Virginia hams.
(757) 229-1000



Gateway Building

Admissions tickets to all buildings, carriage rides, and evening programs as well as souvenir items.
(757) 229-1000



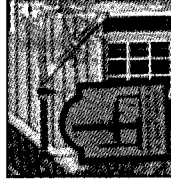
Market Square Stands

An open-air market area selling baked goods and refreshments, toys, hats, pottery, and baskets. Also, rentals of 18th-century costumes for boys and girls and auctions of new goods from Historic Area stores.
(757) 229-1000



McKenzie's Shop

Sweets, coffee, tea, and spices reminiscent of the 18th century.
(757) 229-1000



Post Office

Reproduction prints, maps, leatherbound books, stationery, quill pens, ink, inkwells, and sealing wax. Purchase stamps; letters and postcards hand-canceled with reproduction 18th-century Williamsburg postmark.
(757) 229-1000



Raleigh Tavern Bakery

Gingerbread cakes, ham biscuits, root beer, apple cider, and other treats.
(757) 229-1000



Tarpley's Store

Toys, games, candies, period clothing, hats, and jewelry for children of all ages.
(757) 229-1000



Tickets, Treasures, & Books

Many historical publications, logo apparel, games; guest service items, such as cameras and film; admission tickets to all buildings, carriage rides, evening programs.
(757) 229-1000.

Merchants Square Shops

Located adjacent to the Historic Area is Merchants Square. This retail village was America's first shopping center, and remains a national landmark.



WILLIAMSBURG Craft House

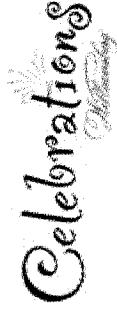
Choose from the full line of WILLIAMSBURG-brand dinnerware, flatware, glassware, beautiful pewter, silver, delft, fine ceramic giftware, folk art, and jewelry. An exclusive selection of personalized gifts, including engraving. The Craft House tradition continues.
(757) 220-7747



WILLIAMSBURG At Home®

Flagship store of WILLIAMSBURG-brand home furnishings and accessories including furniture, bedding, rugs, light fixtures, prints, fabrics, and decorative accessories.

(757) 220-7749



WILLIAMSBURG Celebrations®

Byers' Choice®, Lang, and other classic WILLIAMSBURG-brand collectibles. A full assortment of holiday decorations, seasonal floral arrangements, and garden accessories galore.

(757) 565-8642



Everything WILLIAMSBURG

From T-shirts to tavernware to toys, a broad selection of exclusive Colonial Williamsburg logo products and souvenirs.
(757) 565-8476

Visitor Center and Resort Shopping Opportunities

Gift shops tucked into our resort properties and Visitor Center offer the utmost selection and convenience to our guests.

- WILLIAMSBURG Revolutions

Souvenir central for games, toys, gifts, food, and Colonial Williamsburg logo apparel, as well as costumes.
(757) 229-1000

- WILLIAMSBURG Booksellers

A wide selection of books, CDs, and DVDs on the Revolutionary War and other colonial topics, plus gifts and general-interest publications.

(757) 565-8450

- Williamsburg Lodge Gift Shop

Unique and exclusive items—spanning gifts to home accents—crafted by authentic Virginia artisans. The store regularly hosts artisan appearances, with special displays and signings.

(757) 565-8737

- Regency Shop at the Williamsburg Inn

Exquisite gifts and decorative accessories.

(757) 229-1000

- Williamsburg Woodlands Hotel & Suites Gift Shop

Gifts and souvenirs, logo apparel, and guest service items such as sundries, cameras, and film.

(757) 229-1000

- Colonial Williamsburg Museum Store

Publications, recordings, gifts, and accessories reflecting the museums' collections and exhibits.

(757) 220-7693

- Golden Horseshoe Golf Pro Shop—Gold Course

A wide selection of top golf equipment and Golden Horseshoe logo apparel for ladies and men.

(757) 565-8470

- Golden Horseshoe Golf Pro Shop—Green Course

Golfing essentials include gloves, balls, hats, and basic polo shirts.

(757) 220-7767

Colonial Williamsburg Gift Cards

Looking for the perfect gift? A Colonial Williamsburg Gift Card is always a great choice. Use it to shop at Colonial Williamsburg's Merchants Square, Historic Area, and Visitor Center stores as well as the WILLIAMSBURG catalog. Gift Cards can also be used at other Colonial Williamsburg venues including restaurants, spa, golf, hotels, and ticket offices. Gift-giving doesn't get much better than this.

[Learn More](#)

