

ESTTA Tracking number: **ESTTA375797**

Filing date: **10/28/2010**

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 parties request to cancel indicated registration.

Petitioner Information

Name	Nordstrom, Inc.		
Entity	Corporation	Citizenship	Washington
Address	1617 Sixth Avenue, Suite 500 Seattle, WA 98101 UNITED STATES		

Name	NIHC, Inc.		
Entity	Corporation	Citizenship	Colorado
Address	701 Southwest Broadway, Fourth Floor Portland, OR 97205 UNITED STATES		

Attorney information	William O. Ferron, Jr. Seed IP Law Group PLLC 701 Fifth Avenue, Suite 5400 Seattle, WA 98104 UNITED STATES billf.docketing@seedip.com, litcal@seedip.com Phone:206-622-4900		
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Registration Subject to Cancellation

Registration No	3717204	Registration date	12/01/2009
Registrant	Holden, Perriann M. 8201 N. Williamson Valley Prescott, AZ 86305 UNITED STATES		


Goods/Services Subject to Cancellation


Class 025. First Use: 2009/02/11 First Use In Commerce: 2009/02/20 All goods and services in the class are cancelled, namely: clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility for holding personal items, driver licenses, currency, coins, cell phones, eye glasses, hand-held electronic devices, calculators, and the like

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Mark was improperly registered because it comprises at least two separate marks that do not make a single commercial impression. 15 USC Â§ 1051(a)(2), In re International Flavors & Fragrances Inc., 183 F.3d 1361 (Fed. Cir. 1999)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3027963	Application Date	09/24/2004
Registration Date	12/13/2005	Foreign Priority Date	NONE
Word Mark	BP. SHOES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 footwear		

U.S. Registration No.	3520658	Application Date	03/09/2006
Registration Date	10/21/2008	Foreign Priority Date	NONE
Word Mark	BP.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/00/00 First Use In Commerce: 1985/00/00 girl's and young women's fashion clothing, namely, jackets, turtlenecks, tank tops, dresses, shorts, overalls, blazers, sweaters, cardigans, coats, sweatshirts, vests, skirts, sweatpants, shirts, lingerie, mock turtlenecks, socks, pants and skorts; and women's footwear		

U.S. Registration No.	3543681	Application Date	03/09/2006
Registration Date	12/09/2008	Foreign Priority Date	NONE

Word Mark	BP.
Design Mark	BP.
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 retail store services and online retail store services featuring girl's and young women's fashion clothing, accessories and footwear

U.S. Registration No.	3624666	Application Date	03/15/2005
Registration Date	05/19/2009	Foreign Priority Date	NONE
Word Mark	BP. PLATINUM		
Design Mark	BP. PLATINUM		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2008/09/30 First Use In Commerce: 2008/09/30 Footwear		

U.S. Application No.	77386737	Application Date	02/01/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BP.		

Design Mark	BP.
Description of Mark	NONE
Goods/Services	Class 018. First use: handbags, wallets, travel bags, key cases, luggage, briefcases; all-purpose bags; cosmetic cases sold empty, vanity cases sold empty

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BP		
Goods/Services	Women's and girls' clothing, footwear and fashion accessories; retail services featuring women's and girls' clothing, footwear and fashion accessories		

Attachments	78489502#TMSN.jpeg (1 page)(bytes) 78833726#TMSN.jpeg (1 page)(bytes) 78833729#TMSN.jpeg (1 page)(bytes) 78587451#TMSN.jpeg (1 page)(bytes) 77386737#TMSN.jpeg (1 page)(bytes) BodPockets-Petition to Cancel.PDF (10 pages)(1148788 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	/William O. Ferron, Jr./
Name	William O. Ferron, Jr.
Date	10/28/2010

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

NORDSTROM, INC. and NIHC, INC.,)
)
 Petitioner,) Cancellation No. _____
)
 v.) Registration No. 3717204
)
 PERRIANN M. HOLDEN,)
)
 Respondent.) Attorney Docket No. 690097.848
)
 _____)

PETITION FOR CANCELLATION

Petitioners Nordstrom, Inc. (“Nordstrom”) and NIHC, Inc. (“NIHC”) hereby request that the Trademark Trial and Appeal Board cancel United States Trademark Registration No. 3717204, issued to Perriann M. Holden on December 1, 2009 for the mark BP BOD POCKETS THE POCKET YOU WEAR and Design for “clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility for holding personal items, driver licenses, currency, coins, cell phones, eye glasses, hand-held electronic devices, calculators, and the like” in International Class 25.

The grounds asserted by Petitioners for cancellation are as follows:

1. Nordstrom is a nationwide clothing retailer with department stores, Internet sales and catalog sales throughout the United States. Nordstrom is engaged in the marketing and sale of a wide variety of men’s, women’s and children’s clothing, footwear, handbags and accessories in interstate commerce.

2. NIHC is a wholly-owned subsidiary of Nordstrom.
3. Commencing at least as early as 1985, Nordstrom adopted and has used the mark “BP” and variations of that mark (“BP Marks”) in interstate commerce in the United States as a trademark in connection with young women’s clothing, footwear and fashion accessories and for retail services featuring those products.
4. Nordstrom applied for and received U.S. Trademark Registration No. 3027963 for the mark BP. SHOES for “footwear” in International Class 25. The registration is valid and subsisting and is now owned by NIHC and exclusively licensed to Nordstrom.
5. Nordstrom applied for and received U.S. Trademark Registration No. 3520658 for the mark BP. for “girl’s and young women’s fashion clothing, namely, jackets, turtlenecks, tank tops, dresses, shorts, overalls, blazers, sweaters, cardigans, coats, sweatshirts, vests, skirts, sweatpants, shirts, lingerie, mock turtlenecks, socks, pants and skorts; and women’s footwear” in International Class 25. The registration is valid and subsisting.
6. Nordstrom applied for and received U.S. Trademark Registration No. 3543681 for the mark BP. for “retail store services and online retail store services featuring girl’s and young women’s fashion clothing, accessories and footwear” in International Class 35. The registration is valid and subsisting.
7. Nordstrom applied for and received U.S. Trademark Registration No. 3624666 for the mark BP. PLATINUM for “footwear” in International Class 25. The registration is valid and subsisting.
8. Nordstrom is also the owner of allowed U.S. Trademark Application Serial No. 77386737 for BP., with a priority filing date of February 1, 2008, for “handbags, wallets, travel bags, key cases, luggage, briefcases; all-purpose bags; cosmetic cases sold empty, vanity cases sold empty” in International Class 18.

9. Petitioners Nordstrom and NIHC are hereafter jointly referred to as “Nordstrom.”

10. Since commencing use of the BP Marks as described above, Nordstrom has generated substantial revenue from the sale of “BP” goods and the provision of BP services in the United States, including sales through Nordstrom’s online retail store. Additionally, Nordstrom has expended substantial sums of money, time and effort in advertising, promoting and popularizing the BP Marks in the United States.

11. As a result of such use of the BP Marks, and the advertising and promotion of the BP retail services and BP-branded apparel and footwear, the BP Marks have become well known in the United States and are recognized as identifying the high-quality services and goods of Nordstrom, especially among purchasers of women’s fashion apparel and accessories. Thus, the BP Marks and associated goodwill are valuable assets of Nordstrom.

12. Respondent’s mark consists of the term “BP” in a rectangular logo form (hereafter “BP Logo”) followed by “bod pockets” and “THE POCKET YOU WEAR” in separate text. “THE POCKET YOU WEAR” and “bod pockets” are descriptive terms that have been disclaimed by Respondent. The BP Logo is prominently placed at the beginning of the mark and displayed in a different font than “bod pockets” or “THE POCKET YOU WEAR.”

13. To the extent it is not a separate mark, the BP Logo is the dominant portion of Respondent’s mark, as reflected in Respondent’s disclaimers of “the pocket you wear” and “bod pockets,” the size and placement of “BP” within the mark, and the fact that Respondent has used the BP Logo alone to promote her goods, as shown in the printout retrieved from Respondent’s website at www.bodpocketstore.com and attached hereto as Exhibit A. In her use, Respondent places separate “TM” markings after the “bod pockets” and “THE POCKET YOU WEAR” portions of her mark, as seen on

Exhibit A and on the specimen of use filed in support of her registration, a copy of which is included as Exhibit B to this Petition.

14. The goods described in Respondent's registration—*i.e.*, “clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility for holding personal items, driver licenses, currency, coins, cell phones, eye glasses, hand-held electronic devices, calculators, and the like”—are women's fashion accessories. On information and belief, Respondent's goods are marketed and sold or intended to be sold to the same consumers as those to whom Petitioner markets services and goods under the BP Marks—*i.e.*, fashion-conscious women—and Respondent's goods are marketed and offered through the same channels of trade as Petitioner's goods and services, *e.g.*, online retail stores.

15. The goods described in Respondent's registration are so closely related to Petitioner's BP clothing, footwear and fashion accessories that confusion is likely to result if the parties' respective goods and services are marketed and sold under the same or confusingly similar marks.

16. The mark shown in Respondent's registration for the described goods is confusingly and deceptively similar to Petitioner's BP Marks for Petitioner's above-described goods and services, such that the trade and purchasing public will be confused by and deceived into believing that Respondent's goods originate with Petitioner, or are otherwise authorized by, sponsored by, licensed by, affiliated with, or associated with Petitioner.

17. Respondent's mark was improperly registered because it comprises at least two separate marks that do not make a single commercial impression—*i.e.*, the BP Logo, the stylized words “bod pockets” and the stylized words “THE POCKET YOU WEAR.” 15 USC § 1051(a)(2), *In re International Flavors & Fragrances Inc.*, 183 F.3d 1361 (Fed. Cir. 1999). See Exhibit B, specimen of use filed in support of Registration No. 3717204 and Bod Pockets product packages shown on Respondent's website, Exhibit A.

18. Nordstrom will be damaged by the continuance of Registration No. 3717204.

WHEREFORE, Petitioners pray that this Petition for Cancellation be sustained and Registration No. 3717204 be cancelled.

Correspondence Address

Please direct all communications to:

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701 Fifth Avenue, Suite 5400
Seattle, Washington 98104

DATED this 28th day of October, 2010.

Respectfully submitted,
SEED IP Law Group PLLC



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Attorneys for Petitioners
Nordstrom, Inc. and NIHC, Inc.

Certificate of Service

I hereby certify that on this 28th day of October, 2010, the foregoing PETITION FOR CANCELLATION was served upon Respondent by United States first-class mail, postage-prepaid, addressed as follows:

Perriann M. Holden
8201 N. Williamson Valley
Prescott, Arizona 86305

and a copy was served by United States first-class mail, postage-prepaid, upon Respondent's counsel of record, addressed as follows:

Jerry R. Potts, Esq.
Law Office of Jerry R. Potts
3248 Via Ribera
Escondido, California 92029

Annette Baca
Annette Baca

EXHIBIT A

bp bodPockets™

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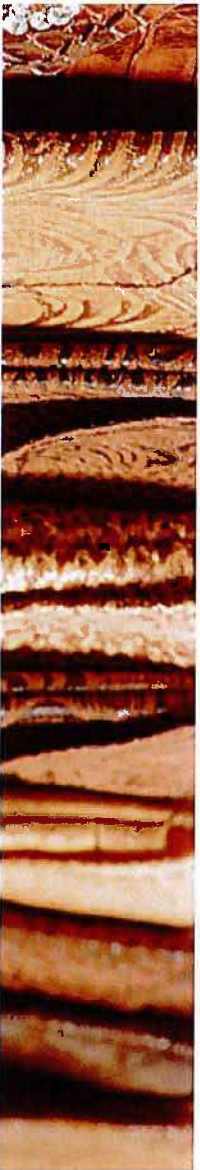
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EXHIBIT B



SPECIMEN

SHIPPING CONTAINER
PHOTO OF

EXHIBIT B