

ESTTA Tracking number: **ESTTA559199**

Filing date: **09/12/2013**

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	Rec Pool and Spa LLC		
Entity	Limited Liability Company	Citizenship	Florida
Address	708 West Oakland Park Boulevard Wilton Manors, FL 33311 UNITED STATES		

Attorney information	Miriam Richter Richter Trademarks 2301 Wilton Manors, Suite 3 Wilton Manors, FL 33305 UNITED STATES mrichter@RichterTrademarks.com Phone:954-977-4711
----------------------	--

**Registration Subject to Cancellation**

Registration No	3556235	Registration date	01/06/2009
Registrant	REC WAREHOUSE, LLC 75 14TH STREET NE UNIT 4260 ATLANTA, GA 30309 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 035. First Use: 2003/07/31 First Use In Commerce: 2003/09/08 All goods and services in the class are cancelled, namely: Retail store services featuring above-ground swimming pools, portable spas, billiard tables, swimming pool supplies, tanning beds, patio furniture, and related items
--

**Grounds for Cancellation**

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Petition for Cancellation with exhibit.pdf(890485 bytes )
-------------	---

**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	/Miriam Richter/
-----------	------------------

Name	Miriam Richter
Date	09/12/2013

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

REC POOL AND SPA LLC	§	Cancellation No. _____
a Florida Limited Liability Company	§	
	§	In the matter of:
Petitioner	§	
	§	Registration No.: 3,556,235
v.	§	Mark: REC WAREHOUSE
	§	Registered on January 6, 2009
REC WAREHOUSE, LLC a Florida	§	
Limited Liability Company	§	
	§	
Registrant		

**PETITION FOR CANCELLATION**

The Petitioner REC POOL AND SPA LLC, a Florida Limited Liability Company, (Rec Pool & Spa) by and through its undersigned counsel, hereby files this Petition for Cancellation of registration number 3,556,235 ('235) for the mark REC WAREHOUSE in International Class 035 for retail store services featuring above-ground swimming pools, portable spas, billiard tables, swimming pool supplies, tanning beds, patio furniture, and related items, owned by Registrant REC WAREHOUSE, LLC, (Rec Warehouse), a Florida Limited Liability Company, and states as follows:

1. Petitioner Rec Pool & Spa is in the business of selling recreational above-ground pools and spas and related goods and services.
2. Upon information and belief, Registrant is in the business of selling above-ground swimming pools, portable spas, billiard tables, swimming pool supplies, tanning beds, patio furniture, and related items.
3. On July 10, 2013, Rec Warehouse sent a Cease & Desist demand to Petitioner and claimed ownership and infringement of the '235 mark as well as registration 2,896,450 for REC WAREHOUSE on the Supplemental Register.
4. The '235 mark for the stylized words REC WAREHOUSE states that "NO CLAIM IS

MADE TO THE EXCLUSIVE RIGHT TO USE 'WAREHOUSE' APART FROM THE MARK AS SHOWN."

5. Registrant's '235 mark for REC WAREHOUSE was registered as a Principal - 2(f) mark, providing prima facie evidence that the mark, in its entirety, is merely descriptive.

6. "Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), provides that "proof of substantially exclusive and continuous use" of a designation "as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made" may be accepted as prima facie evidence that the mark has acquired distinctiveness as used with the applicant's goods or services in commerce. See also 37 C.F.R. §2.41(b)." T.M.E.P. §1212.05 (emphasis added).

7. Registrant's specimen of record as used to demonstrate its assertion of acquired distinctiveness based on five years' use in commerce was insufficient to show acquired distinctiveness because the mark is highly descriptive of the services. *In re Kalmbach Publ'g Co.*, 14 U.S.P.Q.2d 1490 (T.T.A.B. 1989); *In re Gray Inc.*, 3 U.S.P.Q.2d 1558, 1559 (T.T.A.B. 1987); TMEP §1212.05(a).

8. Additionally, no evidence was presented to support Registrant's assertion of substantially exclusive use for five years as claimed in its application.

9. Registrant also owns registration No. 2,896,450 ('450) for the standard character mark of the words REC WAREHOUSE registered on the Supplemental Register in international class 035 for "Retail store services featuring above-ground swimming pools, portable spas, billiard tables, swimming pool supplies, tanning beds, patio furniture, and related items." As such, Registrant acknowledges that the term *rec warehouse* is, at most, merely descriptive.

10. Upon information and belief, Registrant's '235 and '450 marks were simply an update

and abbreviation of Registrant's prior marks, registration number 1,938,568 ('568) and registration number 2,667,935 ('935).<sup>1</sup>

11. Registrant's cancelled '935 mark for RECREATIONAL FACTORY WAREHOUSE was approved for the principle register on a 2(F) basis and disclaimed the term *factory warehouse*.

12. Registrant's '568 mark for RECREATIONAL FACTORY WAREHOUSE and design disclaimed all the words in the term *recreational factory warehouse*.

13. The word *rec* is an abbreviation of the word *recreation* or *recreational* when used on or in connection with the goods and services recited in registration No. 3556235.<sup>2</sup> An abbreviation of a generic name which still conveys to the buyer the original generic connotation of the abbreviated name, is still "generic." *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 U.S.P.Q. 215 (C.C.P.A. 1978).

14. On information and belief, the primary significance of the word *rec* among consumers and the trade is as a generic or common designation for the goods as recited in registration '235, namely pool and spa products, billiard tables, etc., and is incapable of distinguishing Registrant's goods from those of others, including the Petitioner.

15. It has been previously determined that the word *warehouse* is "used generically to denote a particular type or genus of retail store." *Mil-Mar Shoe Co. V. Shonac Corp.*, 37 U.S.P.Q.2d 1633, 1638 (7<sup>th</sup> Cir. 1996).

16. Registrant itself uses the word *recreational* on the home page of its website, *recwarehouse.com*, to describe the products and/or services provided by the store. Exhibit 1.

17. When the proponent of trademark status itself uses the term as a generic name, it is

---

<sup>1</sup> Both of these registrations were owned by Leisure Bay Industries, Inc., the Registrant's predecessor in interest.

<sup>2</sup> DICTIONARY.COM (Aug. 10, 2013), <http://dictionary.reference.com/browse/rec?s=t>.

strong evidence of genericness. *In re Sports Tigers*, 213 U.S.P.Q. 670, 1982 WL 52014 (T.T.A.B. 1982).

18. The term *rec* is generic for the purposes of the goods and services sold by both the Petitioner and the Registrant.

19. Petitioner has a valid and legal right to use the generic reference *rec* in connection with sale of its recreational pools, spas, and related products and services.

20. Registrant's mark prevents Petitioner from describing the characteristics of its products and therefore, Registrant's mark is damaging, and will continue to damage and injure Petitioner.

21. Petitioner is also damaged by Registrant's mark because such registration supports statutory rights for the Registrant that allows Registrant to have an unfair competitive advantage over Petitioner.

22. In view of the foregoing, allowing the continued registration of the '235 mark for REC WAREHOUSE is and will continue to be damaging to Petitioner within the meaning of 15 U.S.C. §1064.

WHEREFORE, Petitioner Rec Pool & Spa respectfully requests that this cancellation be sustained in favor of Petitioner and Registration No. 3,556,235 be cancelled.

Respectfully submitted,

MIRIAM RICHTER, ATTORNEY AT LAW, P.L.  
ATTORNEY FOR PETITIONER  
2301 WILTON DRIVE, SUITE 3  
WILTON MANORS, FLORIDA 33305  
TELEPHONE: 954-977-4711  
FACSIMILE: 954-977-4717  
EMAIL: MRICHTER@RICHTERTRADEMARKS.COM

DATED: September 12, 2013

/s/ Miriam Richter, Esq.  
MIRIAM RICHTER  
FLORIDA BAR NO. 44831  
JOSEPH M. BUCHBINDER  
FLORIDA BAR NO. 86733



We Sell Fun for LESS!!!

HOME

SHOPPING CART

SIGN IN

REGISTER

CONTACT US

QUICK SEARCH

GO!

[Advanced Search](#)

OUR PRODUCTS

[Spas & Hot Tubs](#)

[Pool Tables](#)

[Game Room Furniture, Tables & Supplies](#)

[Saunas](#)

[Swimming Pools and Packages](#)

[Replacement Pool Liners](#)

[Pool and Spa Accessories & Equipment](#)

[Winter Pool Covers](#)

[Spa Covers](#)

[Spa Chemicals](#)

[Spa Parts](#)

[Swimming Pool Parts](#)

[Filter Parts](#)

[Clearance!](#)

FEATURED ITEMS



[Skee-ball](#)

\$899.99

**Rec WAREHOUSE NATIONAL TOLL FREE HOTLINE (800) 506 - 5899**

**OR IF YOU LIVE IN THE GREATER ATLANTA AREA**

**NORCROSS**

6440 DAWSON BLVD.  
**(770) 709 - 5760**

**KENNESAW**

2646 GEORGE BUSBEE PKWY.  
**(678) 384 - 5811**

**McDONOUGH**

844 HIGHWAY 20-81  
**(770) 692 - 9730**

## Welcome to Rec Warehouse!



For nearly 40-years Rec Warehouse has been selling high quality home recreational products--Spas & Hot Tubs, Slate Pool Tables, Game Room Equipment & Supplies, Above-Ground Swimming Pools, Infrared Saunas and more!



**In addition, we have a huge selection of parts and accessories.**

Have a question? Don't see exactly what you are looking for? Call our toll free hotline at **(800) 506-5899**

**FINANCING AVAILABLE**

SHOPPING CART (0)

We offer fast and easy financing with a plan for everyone's budget

**Even 0% Interest Same as Cash!**

Call (800) 506-5899 NOW!



[Spas & Hot Tubs \(9\)](#)

We're your hot tub experts & we've got a spa for you!  
Choose from America's top brands & styles.



[Pool Tables \(8\)](#)

America's top brands, styles, and designs! We've got a pool table for you!



[Game Room Furniture, Tables & Supplies \(50\)](#)

Choose from America's top brands! Game Tables, Bars & Barstools, Shuffleboard, Table Tennis, Foosball, Air Powered Hockey, Neon Lights, and more!



[Saunas \(5\)](#)

Top quality Infrared Saunas available in 1, 2, 3, & 4 person models!



[Swimming Pools and Packages \(25\)](#)

No matter your family size, your backyard size, or your budget, we've got a pool for you!



[Replacement Pool Liners \(88\)](#)

Rec Warehouse offers one of the largest selections of high quality replacement above ground pool liners!



[Pool and Spa Accessories & Equipment \(67\)](#)

We carry a wide selection of accessories & equipment for your pool and hot tub!



[Winter Pool Covers \(50\)](#)

Protect your pool during the harsh winter months with a high quality triple layer cover!





[Spa Covers \(1\)](#)

We've got a cover for virtually every spa! Over 1,000 different patterns for most manufacturers or custom made to fit your spas.



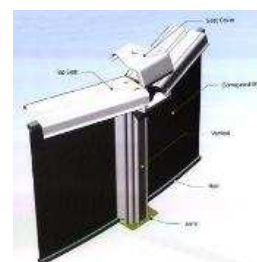
[Spa Chemicals \(23\)](#)

Choose from our wide selection of spa sanitizers & balancing chemicals, as well our popular Spa Frog mineral system!



[Spa Parts \(107\)](#)

We carry a wide array of parts for Leisure Bay, Freestyle, Alps, Strong, DuraSport, Dream Marer and more!



[Swimming Pool Parts \(152\)](#)

We carry a complete line of replacement parts for your above-ground pool!



[Filter Parts \(48\)](#)

Everything you need for your Waterway & BaquaPure filter plus replacement filter elements, vacuum & filter hoses and more!



[Clearance! \(1\)](#)

One-of a kind, closeouts, and More!  
Get additional savings off our already low prices!

If you have any questions, and we mean any questions, or don't see what you are looking for, please grab your phone and give us a call on our **toll free hotline at 800.506.5899**

 [Subscribe](#)

[Terms and Conditions](#) [About Us](#) [Help](#) [Site Map](#)  
Copyright © 2012-2013 Rec Warehouse. All rights reserved.

