

ESTTA Tracking number: **ESTTA762889**

Filing date: **08/05/2016**

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	MCK, Inc.		
Entity	Corporation	Citizenship	ID
Address	466 E CRESTVIEW CT IVINS, UT 84738 UNITED STATES		

Attorney information	Preston C. Regehr TechLaw Ventures, PLLC 3290 West Mayflower Way Lehi, UT 84043 UNITED STATES pto@techlawventures.com, preston.regehr@techlawventures.com Phone:8018543688
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Registration Subject to Cancellation

Registration No	4392415	Registration date	08/27/2013
Registrant	CHATMAN, GERALDINE 3700 HELEN ST. DETROIT, MI 48207 UNITED STATES		

Goods/Services Subject to Cancellation

Class 025. First Use: 2010/03/15 First Use In Commerce: 2012/02/06 All goods and services in the class are cancelled, namely: T-SHIRTS, CAPS, HATS, SCARFS, HEAD BANDS

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Abandonment	Trademark Act Section 14(3)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86676250	Application Date	06/26/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TIE ONE ON		

Design Mark	TIE ONE ON
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1988/12/31 First Use In Commerce: 1988/12/31 Retail store services featuring apparel, namely, neck ties, tie bars, tie tacks, handkerchiefs, pocket squares, and vests; on-line retail store services featuring neck ties, bow ties, tie bars, and tie tacks, cuff links, tie and belt racks, wallets, and handkerchiefs

Attachments	86676250#TMSN.png(bytes) Petition for Cancellation.pdf(40816 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	/Preston C. Regehr/
Name	Preston C. Regehr
Date	08/05/2016

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

In the Matter of Registration No.: 4,392,415
Owned by Geraldine Chatman for the Mark: TIE ONE ON FOR JESUS and Design
Registered: August 27, 2013

MCK, Inc.

Petitioner,

v.

Geraldine Chatman,

Registrant.

Cancellation No.: _____

PETITION FOR CANCELLATION OF REGISTRATION

MCK, Inc. (“Petitioner”), believes that it has been and will continue to be damaged by U.S. Registration No. 4,392,415 which was filed May 28, 2010, on the basis of an intention to use the mark under Act 15 U.S.C. § 1052(b), and registered August 27, 2013 to Geraldine Chatman (the “Registrant”), for the trademark “TIE ONE ON FOR JESUS” with a design of a bowtie, for use with “T-shirts, caps, hats, scarfs, head bands” (“Chatman’s Registration”). Petitioner petitions to cancel Chatman’s Registration under the provisions of 15 U.S.C. §§ 1064 and 1052(d) on grounds of that (i) the registration has been abandoned, and (ii) Chatman’s Registration infringes Petitioner’s prior common law trademark rights.

As grounds for cancellation, Petitioner asserts that:

1. Petitioner is a corporation under the laws of the State of Idaho, having a business address at Suite 7, 1509 South 270 East, St. George, Utah 84790, and is engaged in the business of marketing and selling neck ties and other apparel and accessories (“Petitioner’s Goods”) through a chain of retail stores and through its online websites under its “TIE ONE ON” service mark.

2. Using the mark “TIE ONE ON”, Petitioner, or its predecessors in title and interest, have marketed and sold Petitioner’s Goods online and in retail stores since before the filing of Registrant’s application and before any date of use of the mark in Chatman’s Registration.

3. Petitioner owns, uses, and has continuously used its mark “TIE ONE ON” since at least as early as August 13, 2006, for online retail store services, which feature neck ties, bow ties, tie bars, and tie tacks, cuff links, tie and belt racks, wallets, handkerchiefs, and other goods for sale nationwide and internationally over the Internet.

4. In addition to online sales, Petitioner currently operates three retail stores in Arizona and eight retail stores in Utah, all under Petitioner’s mark “TIE ONE ON”.

5. On June 16, 2016 Petitioner filed with the USPTO an actual use based application assigned Serial No. 86/676,250 for the mark “TIE ONE ON” for use with *“retail store services featuring apparel, namely, neck ties, tie bars, tie tacks, handkerchiefs, pocket squares, and vests; on-line retail store services featuring neck ties, bow ties, tie bars, and tie tacks, cuff links, tie and belt racks, wallets, and handkerchiefs,”* (“Petitioner’s Application”).

6. The USPTO has issued a final refusal to register Petitioner’s Application, citing the Chatman’s Registration as the only bar to registration, under 15 U.S.C. §1052(d). Chatman’s Registration is the only thing that is preventing Petitioner’s Application from being published for opposition, and from registering if the application is not opposed after publication.

I. Abandonment of Chatman’s Registration

7. On information and belief, Registrant has abandoned Chatman’s Registration.

8. On information and belief, Registrant no longer uses the mark “TIE ONE ON FOR JESUS” or any mark or designation that includes “TIE ONE ON”.

9. Petitioner through its counsel wrote to Registrant by letter dated April 6, 2016, but

received no response to that letter. Petitioner's counsel confirmed delivery of that letter to Registrant's address of record in Chatman's Registration. Petitioner's counsel also tried to contact Registrant through email and telephone communication, but was unsuccessful in receiving any acknowledgement or communication from Registrant.

10. On information and belief, Registrant has abandoned its mark "TIE ONE ON FOR JESUS" and Chatman's Registration.

II. Chatman's Registration Infringes Petitioner's Rights

11. Petitioner's rights in its mark "TIE ONE ON" are earlier in time than any right of Registrant in "TIE ONE ON", "TIE ONE ON FOR JESUS", or Chatman's Registration.

12. Chatman's Registration includes in the registered mark all of Petitioner's mark "TIE ONE ON", and those words are the dominant portion of Chatman's Registration.

13. Petition has never licensed the Registrant to use, nor consented to the Registrant's use of, Petitioner's "TIE ONE ON" mark, including as any part of Chatman's Registration.

14. Petitioner's Goods include neck ties as its main product and majority of its sales, and Chatman's Registration includes a design of a necktie, namely, a bowtie.

15. Registrant's goods are presumed to travel in and be sold through all channels of trade, including online sales through the Internet and retail stores.

16. If Chatman's Registration were currently in use by or through the Registrant, such use would cause confusion, mistake, or deception in the minds of the relevant members of the consuming public relative to Petitioner's "TIE ONE ON" mark and Petitioner's Application.

17. The USPTO's final refusal to approve for publication Petitioner's Application because of Chatman's Registration is evidence that Chatman's registration infringes Petitioner's common law trademark rights, including the rights of use of the mark alleged in Petitioner's Application.

18. Petitioner has been and will continue to be damaged by the continued registration, and

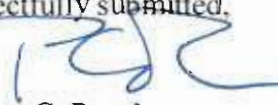
any use or any future use, of Chatman’s Registration, or use of “TIE ONE ON” or “TIE ONE ON FOR JESUS” by Registrant.

19. Petitioner has been and will continue to be damaged by the continued registration of Chatman’s Registration because it prevents Petitioner from registering Petitioner’s Application with the USPTO.

WHEREFORE, Petitioner prays that Chatman’s Registration be cancelled, that the Petition to Cancel be sustained, and that judgment be rendered in favor of Petitioner, and that Petitioner’s Application be approved for publication for opposition.

The filing fee in the amount of \$300 as required by 37 C.F.R. § 2.6(a)(16) is submitted.

Respectfully submitted,



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