

ESTTA Tracking number: **ESTTA802340**

Filing date: **02/18/2017**

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	Floor and Decor Outlets of America, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2233 Lake Park Drive Smyrna, GA 30080 UNITED STATES		

Attorney information	Paul S. Owens Paul Owens & Associates P.O. Box 15310 Atlanta, GA 30333 UNITED STATES psowens@bellsouth.net Phone:404-370-9800		
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Registration Subject to Cancellation

Registration No	4108437	Registration date	03/06/2012
Registrant	Millennium Weavers LLC 3331 Box Drive Dalton, GA 30720 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2011/08/02 First Use In Commerce: 2011/08/02 All goods and services in the class are cancelled, namely: On-line retail store services featuring soft flooring, namely, carpets and rugs
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Grounds for Cancellation

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

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	4309117	Application Date	08/13/2012
Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	FLOOR & DECOR		
Design Mark	FLOOR & DECOR		

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2009/05/00 First Use In Commerce: 2009/05/00 retail and on-line store services featuring flooring and wallcovering materials and related home-improvement accessories

U.S. Registration No.	3110827	Application Date	07/14/2003
Registration Date	07/04/2006	Foreign Priority Date	NONE

Word Mark	FLOOR & DECOR
Design Mark	FLOOR & DECOR

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2001/05/18 First Use In Commerce: 2001/11/01 RETAIL STORE SERVICES FEATURING FLOORING MATERIALS AND RELATED HOME-IMPROVEMENT ACCESSORIES

U.S. Registration No.	4514307	Application Date	09/06/2013
Registration Date	04/15/2014	Foreign Priority Date	NONE

Word Mark	FLOOR & DECOR
Design Mark	FLOOR & DECOR

Description of Mark	The mark consists of the words "floor" and "decor" in black letters with an ampersand in white on a red background between the words.
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Goods/Services	Class 035. First use: First Use: 2011/10/00 First Use In Commerce: 2011/10/00 retail store services featuring flooring, wallcoverings, and related home-improvement accessories
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U.S. Registration No.	3848810	Application Date	09/02/2009
Registration Date	09/14/2010	Foreign Priority Date	NONE

Word Mark	FLOOR & DECOR
Design Mark	FLOOR & DECOR

Description of Mark	The mark consists of the words "FLOOR" and "DECOR" in black letters on a white background; to the right of these words is an ampersand in white on a red background.
Goods/Services	Class 035. First use: First Use: 2009/05/31 First Use In Commerce: 2009/05/31 retail store services featuring flooring materials and related home-improvement accessories; online retail store services featuring flooring materials and related home-improvement accessories

U.S. Registration No.	3102586	Application Date	07/14/2003
Registration Date	06/13/2006	Foreign Priority Date	NONE

Word Mark	FLOOR & DECOR
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Description of Mark	NONE
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Goods/Services	Class 035. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 RETAIL STORE SERVICES FEATURING FLOORING MATERIALS AND RELATED HOME IMPROVEMENTS ACCESSORIES
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U.S. Registration No.	4583757	Application Date	12/17/2013
Registration Date	08/12/2014	Foreign Priority Date	NONE

Word Mark	FLOOR & DECOR
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Description of Mark	The mark consists of the words "FLOOR" and "DECOR" in red letters stacked on top of each other with an ampersand the full height of the stacked words in white on a red background to the right of the words.
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Goods/Services	Class 035. First use: First Use: 2005/10/01 First Use In Commerce: 2005/10/01 retail store services featuring flooring and wallcovering materials and related-home-improvement accessories
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Attachments	85702181#TMSN.png(bytes) 76529310#TMSN.png(bytes) 86058145#TMSN.png(bytes) 77818768#TMSN.png(bytes)
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Signature	/paul s. owens/
Name	Paul S. Owens
Date	02/18/2017

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

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In the Matter of Trademark Reg. No.:
4,108,437

For the Mark: DECOR THE FLOOR

Registration date: March 6, 2012

FLOOR AND DECOR OUTLETS OF
AMERICA, INC.,

Petitioner,

v.

Cancellation No. _____

MILLENNIUM WEAVERS LLC,

Respondent.

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PETITION FOR CANCELLATION

1. Petitioner, Floor and Decor Outlets of America, Inc. (“Petitioner”), a corporation duly organized and existing under the laws of the state of Delaware and having a principal place of business at 2233 Lake Park Drive, Smyrna, Georgia 30080, believes that it will be damaged by Registration No. 4,108,437 for the mark DECOR THE FLOOR and hereby petitions, in accordance with 37 C.F.R. § 2.111(b), to cancel said registration.

2. Petitioner is the owner of the mark FLOOR & DECOR, which it has used continuously since at least as early as May, 2001 in connection with retail store services and since at least as early as May, 2009 in connection with on-line retail store services.

3. Petitioner is the owner of the following U.S. trademark registrations:

<u>MARK</u>	<u>REG. NO.</u>	<u>SERVICES</u>
FLOOR & DECOR	4,309,117	retail and on-line store services featuring flooring, wallcoverings, and related home-improvement accessories.
FLOOR & DECOR	3,110,827	retail store services featuring flooring materials and related home-improvement accessories.
FLOOR & DECOR and Design	4,514,307	retail store services featuring flooring, wallcoverings, and related home-improvement accessories.
FLOOR & DECOR and Design	3,848,810	retail store services featuring flooring materials and related home-improvement accessories; online retail store services featuring flooring materials and related home-improvement accessories.
FLOOR & DECOR and Design	3,102,586	retail store services featuring flooring materials and related home-improvement accessories.
FLOOR & DECOR and Design	4,583,757	retail store services featuring flooring and wallcovering materials and related home-improvement accessories.

4. Each of the registrations identified in paragraph 3 constitutes prima facie evidence of the validity of the registered mark, and of Petitioner’s exclusive right to use the registered mark in commerce in connection with the services in the registrations and are constructive notice of Petitioner’s ownership of the mark.

5. In addition, Petitioner’s Registration Nos. 3,110,827, 3,848,810, and 3,102,586 have become incontestable under 15 U.S.C. §1065, and thus the registrations are conclusive evidence of the validity of the registered marks, of the registration of the marks, of Petitioner’s ownership of the marks, and of Petitioner’s exclusive right to use the registered marks in commerce for the services in the registrations.

6. Respondent, Millennium Weavers LLC (“Respondent”), is a Georgia limited liability company with a place of business at 3331 Box Drive, Dalton, Georgia 30720.

7. On March 6, 2012 Registration No. 4,108,437 was issued to Respondent for the mark DECOR THE FLOOR for use in connection with “on-line retail store services featuring soft flooring, namely, carpets and rugs.” Respondent claimed August 2, 2011 as the dates of first use of the mark in connection with the registered services.

8. Petitioner’s rights in the FLOOR & DECOR mark were established long prior to Respondent’s Registration No. 4,108,437 and long prior to Respondent’s dates of first use.

9. Petitioner has expended considerable effort and expense in promoting its FLOOR & DECOR mark, with the result that consumers have come to know, rely upon, and recognize Petitioner’s services under its FLOOR & DECOR mark, and consequently, Petitioner has established an exceedingly valuable goodwill in its FLOOR & DECOR mark.

10. If Respondent is permitted to retain Registration No. 4,108,437, a cloud will be placed on Petitioner’s title in and to its FLOOR & DECOR mark and on its right to enjoy the free and exclusive use thereof in connection with its services, all to the injury of Petitioner.

COUNT I
ABANDONMENT

11. Petitioner hereby incorporates by reference and re-alleges each and every allegation set forth in paragraphs 1-10.

12. Upon information and belief, Respondent has abandoned its DECOR THE FLOOR mark shown in Respondent’s Registration No. 4,108,437.

13. Upon information and belief, Respondent is not currently using its DECOR THE FLOOR mark in connection with “on-line retail store services featuring soft flooring, namely, carpets and rugs.”

14. Upon information and belief, Respondent’s use of its DECOR THE FLOOR mark has been discontinued with an intent not to resume use.

15. Upon information and belief, Respondent has not used its DECOR THE FLOOR mark for three (3) consecutive years prior to the date of this Petition to Cancel.

16. In view of Respondent's non-use and abandonment of its DECOR THE FLOOR mark as shown in Registration No. 4,108,437, Respondent is not entitled to continued registration of the mark pursuant to Section 14(c) of the Lanham Act, 15 U.S.C. §1064(c), and Respondent's registration should be cancelled.

COUNT II
LIKELIHOOD OF CONFUSION

17. Petitioner hereby incorporates by reference and re-alleges each and every allegation set forth in paragraphs 1-10.

18. Respondent's DECOR THE FLOOR mark so resembles Petitioner's FLOOR & DECOR mark as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Respondent's services are associated with or approved, endorsed, affiliated, authorized or sponsored by Petitioner.

19. In view of the similarity of the respective marks, the identical or highly related channels of trade, the identical or highly related services offered by the parties under their respective marks, and Petitioner's prior rights in its FLOOR & DECOR mark, Respondent is not entitled to continued registration of its DECOR THE FLOOR mark as shown in Registration No. 4,108,437 pursuant to Section 2(d) of the Lanham Act, and such registration should be cancelled.

WHEREFORE, Petitioner respectfully requests prays that judgment be entered cancelling Registration No. 4,108,437, and for such other and further relief as to the Board seems just.

Dated: February 18, 2017

Respectfully submitted,

/paul s. owens/

Paul S. Owens, Esq.
Attorney for Petitioner—Floor and Decor
Outlets of America, Inc.

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Atlanta, GA 30333-0310

Tel: (404) 370-9800

E-mail: psowens@bellsouth.net

CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of February 2017, a true and correct copy of the foregoing document was served upon Respondent by mailing copies via U.S. First Class Mail, postage prepaid, to:

Millennium Weavers LLC
3331 Box Drive
Dalton, GA 30720

/paul s. owens/