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Filing date: **03/29/2024**

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 has filed a petition to cancel the registration indicated below.

Petitioner information

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| Name | O.C. Tanner Company | | |
| Entity | Corporation | Incorporated or registered in | Utah |
| Address | 1930 SOUTH STATE STREET SALT LAKE CITY, UT 84115 UNITED STATES | | |

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| Attorney information | LESTER K. ESSIG RAY QUINNEY & NEBEKER P.C. 36 SOUTH STATE STREET SUITE 1400 SALT LAKE CITY, UT 84111 UNITED STATES Primary email: lessig@rqn.com 8013233320 | | |
| Docket no. | | | |

Registration subject to cancellation

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|--------------------------------|--|---------------------------------|------------|
| Registration no. | 6450786 | Registration date | 08/17/2021 |
| Register | Principal | | |
| International registration no. | NONE | International registration date | NONE |
| Registrant | The a2 Milk Company Limited LEVEL 10, 51 SHORTLAND STREET AUCKLAND 1010 NEW ZEALAND | | |

Goods/services subject to cancellation

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| Class 009. First Use: None First Use In Commerce: None All goods and services in the class are subject to cancellation, namely: Downloadable electronic publications in the nature of books, magazines in the field of nutrition; electronic downloadable publications provided online from databases or the Internet in the nature of books, magazines in the field of nutrition; downloadable computer software applications for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data; computer software for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data |
| Class 038. First Use: None First Use In Commerce: None All goods and services in the class are subject to cancellation, namely: Audio, visual and multimedia transmission services; providing access to electronic and online databases |
| Class 041. First Use: None First Use In Commerce: None All goods and services in the class are subject to cancellation, namely: Providing non-downloadable |


electronic publications in the nature of books, magazines in the field of nutrition; publication of journals, pamphlets, newspapers; publication of magazines; on-line publication of journals, diaries, blogs and forums

Class 042. First Use: None First Use In Commerce: None
 All goods and services in the class are subject to cancellation, namely: Providing online non-downloadable software for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data; design and development of software; hosting computer websites; hosting of databases for others

Grounds for cancellation

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| Priority and likelihood of confusion | Trademark Act Sections 14(1) and 2(d) |
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Marks cited by petitioner as basis for cancellation

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| U.S. registration no. | 2630107 | Application date | 08/24/2000 |
| Register | Principal | | |
| Registration date | 10/08/2002 | Foreign priority date | NONE |
| Word mark | THANKS | | |
| Design mark |  | | |
| Description of mark | NONE | | |
| Goods/services | Class 035. First use: First Use: Jun 1999 First Use In Commerce: Jun 1999 Employee benefits services and incentive awards services for others, and particularly for employers to be used by their employees, for promoting job productivity and quality; promoting to employees for their employers and as a benefit, the goods and services of others, through a card-based discount program and printed promotional materials | | |


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| U.S. registration no. | 3490706 | Application date | 12/30/2004 |
| Register | Principal | | |
| Registration date | 08/19/2008 | Foreign priority date | NONE |
| Word mark | THANKS | | |

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| Design mark | <h1>THANKS</h1> |
| Description of mark | NONE |
| Goods/services | <p>Class 014. First use: First Use: Dec 9, 2007 First Use In Commerce: Dec 9, 2007 Trophies made of precious metal and their alloys or coated therewith, awards made of precious metals and their alloys or coated therewith, namely, jewelry, charms, pendants, necklaces, bracelets, earrings, rings, medallions, brooches, watches, luggage tags, and desk trophies; and plaques made of precious metal and their alloys or coated therewith</p> <p>Class 016. First use: First Use: Oct 1, 2005 First Use In Commerce: Oct 1, 2005 Paper gift tags, paper gift labels and name tags; stickers, envelopes, gift wrap, gift wrapping paper, tissue paper, cardboard gift boxes, cardboard boxes, cardboard containers, paper gift bags, and paper ribbons and bows for gift wrapping; gift selection brochures, and printed guides for officers and managers in the field of online order placement; and engravings</p> <p>Class 021. First use: First Use: Dec 18, 2007 First Use In Commerce: Dec 18, 2007 Crystal and glassware articles, namely, vases, dishes, bowls; hollowware, namely, vases, dishes and bowls, figures, figurines, statues, statuettes, sculptures, trophies, desk trophies, awards made of crystal or glass, cups and crystal or glass treat dishes</p> <p>Class 035. First use: First Use: Oct 1, 2005 First Use In Commerce: Oct 1, 2005 Retail and wholesale computerized and online ordering services, telephone ordering services, mail order services, and catalog services featuring recognition awards and gifts, achievement awards and gifts, productivity awards and gifts, performance awards and gifts, quality work awards and gifts, sales awards and gifts, customer satisfaction awards and gifts, safety awards and gifts, incentive awards and gifts, motivational awards and gifts, service awards and gifts, special occasion awards and gifts, special event awards and gifts, birthday gifts, holiday gifts, seasonal gifts, other awards and gifts, certificates, recognition certificates, achievement certificates, productivity certificates, performance certificates, quality work certificates, sales certificates, customer satisfaction certificates, safety certificates, incentive certificates, motivational certificates, service certificates, special occasion certificates, special event certificates, gift certificates, electronic certificates, gift tags, gift labels, award tags, award labels, award cards, recognition cards, name tags, stickers, envelopes, gift wrap, gift wrapping paper, tissue paper, gift boxes, cardboard boxes, cardboard containers, gift bags, ribbons, bows, gift selection brochures, recipient award selection brochures, printed guides, printed kits for officers and managers, crystal and glassware vases, crystal and glassware dishes, crystal and glassware bowls, crystal and glass hollowware, crystal and glassware figures, crystal and glassware figurines, crystal and glassware statues, crystal and glassware statuettes, crystal and glassware sculptures, crystal and glassware plaques, crystal and glassware awards, crystal and glassware trophies, crystal and glassware engravings, jewelry, fine jewelry, rings, precious stones, watches, corporate emblems, corporate symbols, writing instruments, active accessories, sports accessories, clocks, electronics, office accessories, home accessories, plaques, fine gifts, merchandise, travel, and other items, for employees, officers, executives, retirees, relatives, friends, associates, service providers, those who have achieved, those who have excelled, and others</p> |

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| U.S. registration | 7012774 | Application date | 09/25/2019 |
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| no. | | | |
| Register | Principal | | |
| Registration date | 03/28/2023 | Foreign priority date | NONE |
| Word mark | THANKS | | |
| Design mark | <h1>THANKS</h1> | | |
| Description of mark | NONE | | |
| Goods/services | <p>Class 035. First use: First Use: Oct 1, 2005 First Use In Commerce: Oct 1, 2005 Advertising services, namely, promoting the electronic gift cards and e-gift cards of others for use by employees in recognition of employee services, excluding the banking and financial services industry; promoting the goods and services of others by means of providing employees with electronic gift cards, e-gift cards, money cards, electronic money cards, and electronic vouchers in recognition of employee services, excluding the banking and financial services industry; promoting the goods and services of others by means of an interactive website for the use of electronic gift cards, e-gift cards, money cards, electronic money cards, and electronic vouchers by employees in recognition of employee services, excluding the banking and financial services industry; providing recognition and reward programs, incentive award programs and gift programs for employees through the distribution of electronic gift cards, e-gift cards, money cards, electronic money cards, and electronic vouchers for the purpose of recognizing, promoting and rewarding employee performance, excluding the banking and financial services industry</p> | | |

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| U.S. registration no. | 6719526 | Application date | 05/06/2020 |
| Register | Principal | | |
| Registration date | 05/03/2022 | Foreign priority date | NONE |
| Word mark | THANKS | | |

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| Design mark |  |
| Description of mark | <p>The mark consists of a stylized smiley face design with two eyes and a mouth as part of a circular sun with nine radiating points with the word "THANKS" in a stylized font in lower case to the right of the smiley face design.</p> |
| Goods/services | <p>Class 036. First use: First Use: Aug 31, 2019 First Use In Commerce: Aug 31, 2019</p> <p>Electronic incentive compensation cards for employees in recognition of employee services and to encourage productivity, namely, issuance of electronic cards of others for employees in recognition of employee services and to encourage productivity that can be redeemed for goods and services of participating retailers, excluding the banking and financial services industry; downloadable electronic incentive compensation cards of others for employees in recognition of employee services and to encourage productivity which may be redeemed for goods and services of others, excluding the banking and financial services industry; providing incentive programs for employees in recognition of employee services and to encourage productivity through the distribution of electronic incentive compensation cards of others and electronic incentive compensation vouchers of others, excluding the banking and financial services industry; and issuing electronic incentive compensation cards of others and electronic incentive compensation vouchers of others for use by employees in recognition of employee services and to encourage productivity, excluding the banking and financial services industry</p> |

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| Attachments | <p>76116218#TMSN.png(bytes) 78980371#TMSN.png(bytes) 88630975#TMSN.png(bytes) 88904123#TMSN.png(bytes) THANK YOU a2 Cancellation.pdf(146733 bytes)</p> |
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| Signature | /Lester K. Essig/ |
| Name | Lester K. Essig |
| Date | 03/29/2024 |

publications in the nature of books, magazines in the field of nutrition; publication of journals, pamphlets, newspapers; publication of magazines; on-line publication of journals, diaries, blogs and forums” in International Class 41, and “providing online non-downloadable software for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data; design and development of software; hosting computer websites; hosting of databases for others” in International Class 42 (“Registration”) as issued to and owned by The a2 Milk Company Limited, believed to be a limited liability company formed in New Zealand with an address at Level 10, 51 Shortland Street, Auckland 1010, New Zealand (hereinafter “Registrant”). Petitioner hereby requests cancellation of the Registration for all International Classes with the exception of International Classes 16 and 29.

As grounds for cancellation it is alleged that:

1. Petitioner has been actively engaged in providing computer software and software applications and online non-downloadable software for use in database management and electronic storage of data including for mobile applications, computers and electronic devices, providing access to electronic and online databases, providing online blogs, designing and developing software, hosting computer websites, hosting databases for others, providing incentive awards, rewards and other goods, and related services and goods (collectively “Petitioner Services”), for years, and is currently engaged in said business.

2. Petitioner has also been actively engaged in providing closely related services and goods including (a) providing software and software applications, and providing software as a service (SAAS) services, online non-downloadable cloud-based software, and a website featuring online non-downloadable software, for redeeming goods, merchandise and services, for using cards to redeem goods, merchandise and services, for incentive awards programs and awards, for use in connection with retail computerized and online ordering services and telephone ordering services, including for employees,

employee recognition and recognition services, for database management and electronic storage of data, and more; (b) providing bots and software as a service relating to employers, employees, employee incentive award programs, employee productivity, performance, recognition, motivation and morale, employee information and data, database management and electronic storage of data, and more; and (c) providing other services and goods, including for employers, employees and others, including database management and electronic storage of data, and more, for years, and is currently engaged in said business (“Petitioner Related Services”).

3. Based on information and belief, Registrant is engaged in providing downloadable computer software and software applications and online non-downloadable software for use in database management and electronic storage of data including for mobile phones, portable media players and handheld computers, providing access to electronic and online databases, providing online publications of blogs, forums and more, designing and developing software, hosting computer websites, hosting databases for others, providing goods, and other services and goods (collectively “Registrant Services”), having entered the business in connection with its mark much more recently than Petitioner.

4. Petitioner has acquired extensive common law rights in the THANKS mark in the United States as a service mark and trademark and is the exclusive owner of the mark. Petitioner, acting on its own behalf and otherwise, has actively and continuously used the THANKS mark in the United States since on or before 2005 through the present. It has used its mark in connection with providing computer software and software applications and online non-downloadable software for use in database management and electronic storage of data including for mobile applications, computers and electronic devices, providing access to electronic and online databases, providing online blogs, designing and developing software, hosting computer websites, hosting databases for others, providing incentive awards, rewards and other goods, and related services and goods. Petitioner, through its predecessor, has actively and continuously used the THANKS mark in the United States since on or before 1999 through

the present. It has used its mark in connection with providing database management and storage of data, and providing access to databases, in connection with employee incentive award programs and to promote employee productivity, performance, recognition and morale, and providing other services and goods. Petitioner's use of its THANKS mark extends throughout the United States and beyond. Its THANKS mark, services and goods are highly regarded among customers, employers, employees, individuals and businesses.

5. Based on information and belief, Registrant has much more limited common law rights in its THANK YOU a2 mark in the United States, if any, because Registrant's alleged use of the mark and performance of Registrant's Services have been more limited in scope, commencing use much more recently, allegedly on or around December of 2016 or later, allegedly in connection with certain of Registrant's Services as set forth in its federal Registration. Use, if any, by Registrant is much more recent than that of Petitioner, with Registrant's use constituting infringement of Petitioner's THANKS mark. Registrant's Registration and use of the THANK YOU a2 mark are without Petitioner's consent.

6. Petitioner's extensive common law rights in its THANKS service mark and trademark as noted above are more than sufficient to secure cancellation of Registrant's mark and Registration. In this regard, the Lanham Act governing service marks and trademarks in the United States expressly states that registration for a mark shall be refused if it consists of a mark which so resembles "a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the registrant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). See also 15 U.S.C. §§ 1053 and 1063. While Petitioner has extensive federal service mark registrations relating to its services and goods, Petitioner need not rely on its federal registrations in order to prevail. Its prior common law rights are also more than sufficient.

7. In addition to its extensive common law rights, Petitioner has also acquired significant federal registration rights with the United States Patent and Trademark Office for its THANKS mark as a

service mark and trademark in typed drawing form and stylized form on the Principal Register of the United States Patent and Trademark Office, granting it nationwide prior exclusive rights. Its federal registration rights cover many of the same fields of use as those set forth in Registrant's Registration. Petitioner's federal service mark and trademark registrations include the following:

(a) Registration for the word THANKS, identified as registration No. 2630107, as filed on August 24, 2000 and registered on October 8, 2002 in International Class No. 35 in connection with "employee benefits services and incentive awards services for others, and particularly for employers to be used by their employees, for promoting job productivity and quality; promoting to employees for their employers and as a benefit, the services and goods of others, through a card-based discount program and printed promotional materials." Petitioner has provided database management services and electronic storage of data services in connection with the foregoing services.

(b) Registration for the word THANKS, identified as registration No. 3490706, as filed on December 30, 2004 and registered on August 19, 2008 in International Class No. 35, in connection with services as amended consisting of "retail computerized and online ordering services and telephone ordering services featuring recognition awards and gifts, achievement awards and gifts, productivity awards and gifts, performance awards and gifts, quality work awards and gifts, sales awards and gifts, safety awards and gifts, incentive awards and gifts, motivational awards and gifts, service awards and gifts, award cards, recognition cards, and other items, for employees, officers, executives, those who have achieved, those who have excelled, and others." Petitioner has provided database management services and electronic storage of data services in connection with the foregoing services.

(c) Registration for the word THANKS, identified as registration No. 7012774, as filed on September 25, 2019 and registered on March 28, 2023 in International Class No. 35 in connection with "advertising services, namely, promoting the electronic gift cards and e-gift cards of others for use by employees in recognition of employee services, excluding the banking and financial services industry;

promoting the goods and services of others by means of providing employees with electronic gift cards, e-gift cards, money cards, electronic money cards, and electronic vouchers in recognition of employee services, excluding the banking and financial services industry; promoting the goods and services of others by means of an interactive website for the use of electronic gift cards, e-gift cards, money cards, electronic money cards, and electronic vouchers by employees in recognition of employee services, excluding the banking and financial services industry; providing recognition and reward programs, incentive award programs and gift programs for employees through the distribution of electronic gift cards, e-gift cards, money cards, electronic money cards, and electronic vouchers for the purpose of recognizing, promoting and rewarding employee performance, excluding the banking and financial services industry.” Petitioner has provided database management services and electronic storage of data services in connection with the foregoing services.

(d) Registration for the word THANKS with a logo, identified as registration No. 6719526, as filed on May 6, 2020 and registered on May 3, 2022 in International Class No. 36 in connection with “electronic incentive compensation cards for employees in recognition of employee services and to encourage productivity, namely, issuance of electronic cards of others for employees in recognition of employee services and to encourage productivity that can be redeemed for services and goods of participating retailers, excluding the banking and financial services industry; downloadable electronic incentive compensation cards of others for employees in recognition of employee services and to encourage productivity which may be redeemed for services and goods of others, excluding the banking and financial services industry; providing incentive programs for employees in recognition of employee services and to encourage productivity through the distribution of electronic incentive compensation cards of others and electronic incentive compensation vouchers of others, excluding the banking and financial services industry; and issuing electronic incentive compensation cards of others and electronic incentive compensation vouchers of others for use by employees in recognition of employee services and to

encourage productivity, excluding the banking and financial services industry.” Petitioner has provided database management services and electronic storage of data services in connection with the foregoing services.

8. Based on information and belief, Registrant has but one registration for the THANK YOU a2 mark with the United States Patent and Trademark Office. Registrant’s only registration for said mark in the United States is the subject of the current cancellation proceeding.

9. There is no issue as to priority, with Petitioner’s first use of the THANKS mark in the United States substantially predating Registrant’s first use of the THANK YOU a2 mark by at least seventeen years. Petitioner, acting through its predecessor, first used its THANKS mark in commerce and interstate commerce at least as early as 1999. In 2004 the THANKS mark and registration were assigned to Petitioner by its predecessor for good and valuable consideration, with Petitioner continuing use of the mark thereafter in commerce and interstate commerce, with Petitioner’s use occurring many years before any use or registration by Registrant. Petitioner’s use has included use of the THANKS mark with providing computer software and software applications and online non-downloadable software for use in database management and electronic storage of data including for mobile applications, computers, and electronic devices, providing access to electronic and online databases, providing online blogs, designing and developing software, hosting computer websites, hosting databases for others, providing incentive awards, rewards and other goods, and related services and goods. It has also included use of the THANKS mark with Petitioner’s Related Services. Petitioner’s first use was long before Registrant’s first use giving Petitioner priority.

10. Based on information and belief, Registrant first applied for its Registration of the THANK YOU a2 mark in the United States on December 22, 2016, and allegedly first used its mark in the United States in commerce and interstate commerce no earlier than December of 2016, if at all, as suggested by Registrant’s Certificate of Registration. Registrant’s first filing date and first use date post-

date Petitioner's first filing date and first use date by more than 17 years, giving Petitioner priority.

11. Petitioner has developed substantial goodwill, a most valuable reputation, and a substantial and profitable business identified by its THANKS mark. Customers, including employers and employees, the general public and others throughout the United States have come to know, rely upon, and recognize Petitioner's services and goods including providing computer software and software applications and online non-downloadable software for use in database management and electronic storage of data including for mobile applications, computers and electronic devices, providing access to electronic and online databases, providing online blogs, designing and developing software, hosting computer websites, hosting databases for others, providing incentive awards, rewards and other goods, and related services and goods, and providing Petitioner's Related Services, in connection with its mark. Petitioner on its own behalf and through its predecessor has expended significant money, effort, and personnel resources over a period exceeding 24 years in advertising, promoting, and selling its services and goods in connection with its mark and in developing a reputation for excellence in connection with its services and goods.

12. Registrant's THANK YOU a2 mark, as shown in its Certificate of Registration, is very similar to Petitioner's THANKS mark creating likelihood of confusion. It is very similar in appearance, sound, meaning, and commercial impression. Both marks use precisely the same word as the dominant distinctive feature of their marks, with Registrant using the word THANK and Petitioner using the word THANKS. Likewise, for both marks the word THANK or THANKS comes first, drawing immediate attention to it. The spellings for the word THANK are identical for both marks. Moreover, while Registrant's mark includes the word YOU in the form THANK YOU, the words THANK YOU in combination can have the same meaning as Petitioner's THANKS mark. Numerous online and other dictionaries confirm that the word THANKS means THANK YOU, and vice versa, and thus the meanings of the two marks are very similar. Moreover, Registrant's federal Registration is in typed drawing word

mark form, thus seeking a broad scope of protection as used in any font or print style. As such it overlaps Petitioner's mark, registrations and applications, which are also in typed drawing word mark form granting Petitioner a broad scope of protection. By incorporating the dominant key word element of Petitioner's THANKS mark, namely the word THANKS in the form THANK YOU, and with potentially the same meaning and commercial connotation, and for the same overlapping services, and in overlapping fields of use, with Petitioner having longstanding prior exclusive rights in its mark, it creates likelihood of confusion as to source, origin, sponsorship, approval and/or affiliation.

13. While Petitioner's mark does not include the "a2" at the end of the mark, the "a2" as used in Registrant's mark carries little weight since it is at the very end after two other words, and it is in lower case letters. As a result, it gives the impression that it simply refers back to the THANK YOU word elements, presumably as a reference to the rank or status of the THANK YOU elements as viewed by customers.

14. Many of the services and goods set forth in Registrant's Registration for the THANK YOU a2 mark are the same as, or a subset of or related to, the services and goods offered by Petitioner in connection with its THANKS mark at common law and as set forth in its federal registrations and applications. As noted above, Registrant's services consist of providing downloadable computer software and software applications and online non-downloadable software for use in database management and electronic storage of data including for mobile phones, portable media players and handheld computers, providing access to electronic and online databases, providing online publications of blogs and forums, designing and developing software, hosting computer websites, hosting databases for others, providing goods, and other services and goods. Notably, Petitioner's THANKS mark as used at common law long before Registrant, with use continuing in the present, is used with overlapping services and goods as it relates to those of Registrant, with Petitioner providing computer software and software applications and online non-downloadable software for use in database management and electronic storage of data for

mobile applications, computers, electronic devices and more, providing access to electronic and online databases, providing online blogs, designing and developing software, hosting computer websites, hosting databases for others, providing incentive awards, rewards and other goods, and related services and goods, thus creating likelihood of confusion.

15. Likelihood of confusion is even more certain in the instant case due to the extremely broad description of goods and services forth in Registrant's Registration in the areas of overlap. By way of example, in the instant case the identification of goods and services in classes 9 and 42 of Registrant's Registration expressly covers software, software applications and online non-downloadable software services "for use in database management" and "in electronic storage of data," leaving both open-ended, with no limitations of any type, whether by field of use or otherwise. There are potentially thousands of fields of use for database management and database storage. At the same time, Registrant's website and online materials, and some of its other goods and services identifications in other classes in its Registration, mention only one field of use, namely "the field of nutrition." By retaining a broad universal identification that covers database management and database storage in every conceivable field of use, far beyond Registrant's intended and actual field of use, it directly overlaps Applicant's fields of use and identification of goods and services as set forth in Applicant's application, thereby assuring likelihood of confusion, deception and mistake.

16. Registrant's services as set forth in its Registration as noted above are also the same as or similar or related to Petitioner's Related Services as noted above, further assuring likelihood of confusion. Petitioner's Related Services include (a) providing software as a service (SAAS) services, online non-downloadable cloud-based software, and a website featuring online non-downloadable software, for redeeming goods, merchandise and services, for using cards to redeem goods, merchandise and services, for incentive awards programs and awards, for use in connection with retail computerized and online ordering services and telephone ordering services, including for employees, employee recognition and

recognition services, for use in database management and electronic storage of data, and more; (b) providing bots and software as a service relating to employers, employees, employee incentive award programs, employee productivity, performance, recognition, motivation and morale, employee information and data, database management and electronic storage of data, and more, and; (c) providing other related services and goods, including for employers, employees and others, including database management and electronic storage of data, and more. Nearly all of Petitioner's Related Services entail the use of software providing database management and electronic storage of data functions and services, overlapping Registrant's Registration. Likelihood of confusion, deception or mistake will result.

17. The target marks and customers of the parties are also the same or very similar in some areas, with similar trade channels, to the extent in overlapping fields of use. Both parties use their marks to target customers who are in need of database management and electronic storage of data services utilizing software, software applications and software as a service. Registrant's Registration confirms this point. At multiple places it refers to "software for use in database management" and "for use in electronic storage of data," similar to Petitioner's description of services and goods, suggesting the same target markets. Based on information and belief, both offer their services over the internet and in other ways in the same overlapping geographic area, namely the United States. In addition, on information and belief, both Petitioner and Registrant advertise utilizing some of the same mediums and media. For purposes of this cancellation proceeding, the parties are deemed to operate in immediate geographic proximity. See, e.g., In re Appetito Provisions Co., 3 U.S.P.Q. 2d 1553, 1554 n.4 (TTAB 1987); 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:78, at 23-168.2 (4th ed. 1999).

18. Registrant's THANK YOU a2 mark so resembles Petitioner's THANKS mark, with Petitioner's mark previously used throughout the United States, and with prior registration rights held by Petitioner, as to be likely, when applied to the same or related services and goods of Petitioner, in overlapping geographic territories, and in the same or overlapping fields of use, to cause confusion, or to

cause mistake or to deceive. Confusion, mistake, and/or deception as to the source or origin of the services and goods, and the ownership, sponsorship, approval, affiliation, and related party status of each business, among customers, potential customers, the general public, and others, is likely within the same or overlapping fields of use. Many familiar with Petitioner's mark may purchase and utilize Registrant's services under the false assumption that they were provided by Petitioner. Even if some should notice a difference between the marks, they may believe that Petitioner's mark and Registrant's mark are companion marks, originating from the same source or origin, and that they reflect an affiliation in the same geographic area. Confusion will increase as Registrant expands its services and goods in connection with its mark in interstate commerce in the same or overlapping fields of use. The resulting confusion, mistake, and/or deception will be to the detriment of Petitioner as the prior owner and user of its mark.

19. The United States Patent and Trademark Office has previously determined that Registrant's THANK YOU a2 mark creates likelihood of confusion, deception or mistake as it relates to Petitioner's THANKS mark as used with overlapping services and goods, in the same or overlapping fields of use. The examining attorney for Petitioner's federal service mark application, including application serial number 88904123, concluded there is "likelihood of confusion" due to similarities in the marks and the services and goods as used in the same or overlapping fields of use. As a result, Petitioner's federal application, which was filed after Registrant's application, has been temporarily suspended.

20. Registration and continuing use of Registrant's mark as currently constituted will deprive Petitioner's mark of distinctiveness, blurring identification of Petitioner's mark with its services and goods, and tarnishing Petitioner's goodwill, value, and reputation through association with Registrant's mark, services and goods. Adverse conditions, business failures, defects, or defaults on the part of Registrant's services, goods or business may reflect upon and seriously injure Petitioner's mark, reputation and business.

21. If Registrant is permitted to retain the Registration for which cancellation is sought in its current form with no changes, it will obtain a prima facie exclusive right to use its mark in commerce with its services and goods, its mark will be deemed incontestable five years from the date of registration, and Registrant will thereby obtain an incontestable right to use the mark in commerce. As a consequence, Petitioner's common law and federal registration rights will be impaired and precluded, Registrant will be able to trade on Petitioner's goodwill, confusion, deception and mistake will likely result, and damage and injury could be caused to Petitioner as the prior user and prior registrant of the THANKS mark.

22. Based on the foregoing, continued registration with the United States Patent and Trademark Office of the THANK YOU a2 mark by Registrant as currently constituted would be in violation of Petitioner's rights to the THANKS mark, causing Petitioner substantial damage and injury.

WHEREFORE, Petitioner prays that the Registration held by Registrant identified as No. 6450786 be cancelled for all International Classes with the exception of International Classes 16 and 29, and that this Petition for Cancellation be sustained.

Please recognize Lester K. Essig and Arthur B. Berger, members of the Bar of the State of Utah, and the law firm of Ray Quinney & Nebeker P.C., whose mailing address is 36 South State Street, Suite 1400, Salt Lake City, Utah 84111, with telephone number (801) 532-1500, as attorneys for Petitioner in the above-captioned cancellation. Please address all correspondence to them.

DATED this 29th day of March 2024.

Respectfully submitted,

O. C. TANNER COMPANY

/s/ Lester K. Essig
Lester K. Essig
Arthur B. Berger
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Attorneys for Petitioner

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