

ESTTA Tracking number: **ESTTA553281**Filing date: **08/09/2013**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	Google Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1600 Amphitheatre Parkway Mountain View, CA 94043 UNITED STATES		

Attorney information	Margret M. Caruso Quinn Emanuel Urquhart & Sullivan LLP 555 Twin Dolphin Dr. 5th Fl. Redwood Shores, CA 94065 UNITED STATES margretcaruso@quinnemanuel.com, brettarnold@quinnemanuel.com, sherrinvanetta@quinnemanuel.com Phone:650-801-5000
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Registration Subject to Cancellation

Registration No	3500783	Registration date	09/16/2008
Registrant	PARTS.COM, LLC 510 S. CONGRESS AVE. SUITE 202 AUSTIN, TX 78704 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1999/03/30 First Use In Commerce: 1999/03/30 All goods and services in the class are cancelled, namely: Marketing services, namely, providing informational web pages designed to generate sales traffic via hyperlinks to other web sites; promoting the goods and services of others by providing hypertext links to the websites of others; providing a website which features advertisements for the goods and services of others on a global computer network; providing on-line directory information services also featuring hyperlinks to other websites; online auction services
Class 042. First Use: 1999/03/30 First Use In Commerce: 1999/03/30 All goods and services in the class are cancelled, namely: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks; data mining via global computer networks; computer services, namely, creating indexes of information, sites and other information resources via global computer networks

Grounds for Cancellation

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)
Related Proceedings	Parts.com, LLC v. Google Inc., 13-cv-1074-JLS-WMC (S.D. Cal. filed May 6, 2013)

Attachments	Petition to Cancel and Exhibit A.pdf(1366683 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 USPS Express Mail Post Office to Addressee on this date.

Signature	/Brett J. Arnold/
Name	Brett J. Arnold
Date	08/09/2013

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

In the Matter of Registration No. 3,500,783
Registered Sept. 16, 2008
Mark: PARTS.COM

GOOGLE INC.,

Petitioner,

-against-

PARTS.COM, LLC,

Respondent.

Cancellation No. _____

PETITION TO CANCEL

TO THE COMMISSIONER FOR TRADEMARKS:

Petitioner Google Inc. believes it is, and will continue to be, damaged by the existence of Registration Number 3,500,783 for the mark PARTS.COM and hereby petitions to cancel the same pursuant to Sections 14(3) and 45 of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. §§ 1064(3), 1127.

1. Google Inc. (“Google”) is a Delaware corporation with its principal place of business located at 1600 Amphitheatre Parkway, Mountain View, California 94043.

2. According to Registration Number 3,500,783, Respondent Parts.com, LLC (“Parts.com”) is a Delaware limited liability company located at 510 S. Congress Ave. Suite 202, Austin, Texas 78704. On information and belief, Parts.com’s principal place of business is 2196 Carmel Valley Road, 3rd Floor, Del Mar, California 92014.

3. On information and belief, Respondent Parts.com is the owner of the internet website “www.parts.com” and is primarily engaged in the business of operating that website as an online retail source for automotive replacement parts, accessories, and catalogues.

4. Respondent Parts.com is currently listed as the owner of the above-named Registration No. 3,500,783 for the designation PARTS.COM in connection with “marketing services” and “computer services” in International Classes 35 and 42 (the “Registration”). The Registration was issued on September 16, 2008.

5. The Registration states that it was originally issued to an entity named Intelligentz Corporation, a Delaware Corporation located at 115 E. 5th Street, Suite 200, Austin, Texas 78701.

6. In the Registration, Intelligentz Corporation alleged that it first used the PARTS.COM designation in U.S. commerce in connection with marketing and computer services on March 30, 1999.

7. The registered mark PARTS.COM is a generic term for the marketing and computer services offered by Respondent Parts.com and every other competitor engaged in such business. Respondent’s registered mark does not function to identify Respondent’s goods and services and distinguish them from the goods and services offered by others. Instead, it is the category or genus of which the goods and services of Respondent and its competitors are the species.

8. The mark PARTS.COM also has not acquired distinctiveness and therefore does not function to identify Respondent’s goods and services and distinguish them from the goods and services offered by others.

9. Petitioner Google is being damaged and will likely continue to be damaged by registration of this generic and non-distinctive term. On May 6, 2013, Respondent Parts.com sued Petitioner Google in the United States District Court for the Southern District of California, 13-CV-1074-JLS-WMC (the “District Court action”) alleging that Google has engaged in unauthorized use of the Registration constituting false designation of origin, unfair competition, and trademark infringement and dilution in violation of the Lanham Act and California state law. A true and correct copy of the Complaint from the District Court action as retrieved from PACER is attached as Exhibit A.

10. In the District Court action, Parts.com has claimed that as a result of Google’s alleged use of the Registration, Parts.com has lost online sales of automotive parts and accessories in excess of \$2 million per year and that Google is liable for this amount. Parts.com has also sought additional relief, including a trebling of its alleged damages, an accounting of Google’s alleged profits from use of the Registration, and punitive damages, along with costs, fees, and interest. If the Registration were cancelled, Google would not be subject to this potential liability.

11. Cancellation of the Registration should be granted on the grounds that the Registration is generic and therefore unprotectable pursuant to the Lanham Trademark Act, 15 U.S.C. §§ 1052(e) & (f), 15 U.S.C. § 1064(3), and 15 U.S.C. § 1065(4).

12. In the alternative, cancellation of the Registration should be granted on the grounds it is merely descriptive and lacking acquired distinctive as required by Sections 2(e) and 2(f) of the Lanham Trademark Act, 15 U.S.C. §§ 1052(e) & (f).

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