

ESTTA Tracking number: **ESTTA671592**

Filing date: **05/11/2015**

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

Proceeding	91221291
Party	Defendant Ruchi Soya Industries Limited
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Submission	Answer and Counterclaim
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Date	05/11/2015
Attachments	Answer and Counterclaims 5.11.2015.pdf(26356 bytes)

Registrations Subject to the filing

Registration No	3930669	Registration date	03/15/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	FERRERO S.p.A. Piazzale Pietro Ferrero, 1 ITALY		

Goods/Services Subject to the filing

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: COFFEE, TEA, BREAD, BISCUITS, CAKES, PASTRY AND CONFECTIONERY, NAMELY, CANDY, CAKES, WAFERS, WAFFLES, MUFFINS; EDIBLE ICE-CREAMS; ICE; CHOCOLATE AND CHOCOLATE PRODUCTS, NAMELY, COCOA BASED SPREAD, CHOCOLATE BARS, CHOCOLATE CANDIES; PRALINES, CANDY WITHOUT SUGAR
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Registration No	4192415	Registration date	08/21/2012
International Registration No.	NONE	International Registration Date	NONE
Registrant	FERRERO S.p.A. Piazzale Pietro Ferrero, 1 ITALY		

Goods/Services Subject to the filing

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: COFFEE, TEA, SUGAR, RICE, TAPIOCA, SAGO, SUBSTITUTE OF COFFEE, FLOUR, BREAD, BISCUITS, CAKES, PASTRY AND CONFECTIONARY, NAMELY, CANDY, CAKES, WAFERS, WAFFLES, MUFFINS; EATABLE ICE-

CREAMS; HONEY, TREACLE, YEAST, BAKING POWDER; SALT, MUSTARD, PEPPER, VINEGAR, SAUCES; SPICES; ICE; SPREAD CREAMS, NAMELY, COCOA BASED SPREAD, CHOCOLATE AND CHOCOLATE PRODUCTS, NAMELY, PASTRY FOR CHOCOLATE BEVERAGE, CHOCOLATE PASTRY, CHOCOLATE COVERINGS, CHOCOLATE, PRALINE, CHOCOLATE FOR DECORATIONS OF CHRISTMAS TREE, CHOCOLATE COVERED CANDY CONTAINING ALCOHOLIC BEVERAGE CONTENT; PASTRY, CHEWING GUM, CHEWING GUM WITHOUT SUGAR, CANDIES WITHOUT SUGAR

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

Application Ser. No: 86/184,298
Mark: NUTRELA
International Classes: 29, 30, 32
Applicant: Ruchi Soya Industries Limited
Date of Publication: December 2, 2014

FERRERO S.P.A.,

Opposer,

v.

RUCHI SOYA INDUSTRIES LIMITED,

Applicant.

Opposition No.91221291

Registration No: 3,930,669
Mark: NUTELLA LOVE & DESIGN
International Classes: 30
Owner: Ferro S.p.A
Date of Registration: March 15, 2011

Registration No: 4,192,415
Mark: NUTELLA & DESIGN
International Classes: 30
Owner: Ferro S.p.A
Date of Registration: August 21, 2012

RUCHI SOYA INDUSTRIES LIMITED,

Petitioner,

v.

FERRERO S.P.A.,

Respondent.

**RUCHI SOYA INDUSTRIES LIMITED'S ANSWER AND
COUNTERCLAIMS FOR CANCELLATION**

Applicant, Ruchi Soya Industries Limited (“Ruchi” or Applicant”), by and through its undersigned counsel of record, Lackenbach Siegel, LLP, for its Answer (the “Answer”) to the notice of opposition (the “Opposition”) of opposer, Ferrero S.p.A. (“Ferrero” or “Opposer”), states as follows:

1. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in ¶1 of the Opposition and therefore denies them.

2. Applicant admits the allegations contained in ¶2 of the Opposition to the extent that Opposer is the owner of the United States Trademark Registration Nos. 855,647; 1,296,656; 2,000,985; 3,930,669; and 4,192,415. Applicant denies the remaining allegations contained in ¶2 of the Opposition.

3. Applicant admits the allegations contained in ¶3 of the Opposition to the extent Trademark Registration Nos. 855,647; 1,296,656; and 2,000,985 are incontestable. Applicant further admits the allegations contained in ¶3 of the Opposition to the extent it purports to attach print outs from the U.S. Patent and Trademark Office showing the current status and title of the registration listed in ¶2 of the Opposition. Applicant denies any allegations as to the validity and accuracy of Exhibits A-1 through A-5 attached to the Opposition. Applicant denies the remaining allegations contained in ¶3 of the Opposition.

4. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in ¶4 of the Opposition and therefore denies them.

5. Applicant admits the allegations contained in ¶5 of the Opposition.

6. Applicant admits the allegations contained in ¶6 of the Opposition.

7. Applicant denies the allegations contained in ¶7 of the Opposition.

8. Applicant admits the allegations contained in ¶8 of the Opposition.
9. Applicant denies the allegations contained in ¶9 of the Opposition.
10. Applicant is without information or knowledge sufficient to form a belief as to the truth of the allegations contained in ¶10 of the Opposition and therefore denies them.
11. Applicant denies the allegations contained in ¶11 of the Opposition.
12. Applicant denies the allegations contained in ¶12 of the Opposition.
13. Applicant denies the allegations contained in ¶13 of the Opposition.
14. Applicant denies the allegations contained in ¶14 of the Opposition.

Affirmative Defenses

1. There is no likelihood of confusion between Opposer's mark and Applicant's mark.
2. Opposer has abandoned certain of its trademarks.
3. Opposer's claims are barred by acquiescence.
4. Opposer's claims are barred by laches.

COUNTERCLAIMS

As grounds for cancellation, Applicant (also referred as "Petitioner") alleges:

1. Petitioner is a corporation organized under the laws of India with a business address of 7/5, South Tukoganj, Nath Mandir Road, 301, Mahakosh House, Indore 452001, India.
2. Upon information and belief, registrant Ferrero S.p.A ("Respondent"), is a corporation organized under the laws of Italy with a business address of Piazzale Pietro Ferrero 1, Alba (Cn), I-12051, Italy.

3. Respondent is the record owner of U.S. Trademark Registration Nos. 3,930,669 and 4,192,415 ("the Registrations").

4. Respondent's Trademark Registration 3,930,669 (the " '669 Registration") is for use of the mark NUTELLA LOVE & DESIGN in connection with "coffee, tea, bread, biscuits, cakes, pastry and confectionery, namely, candy, cakes, wafers, waffles, muffins; edible ice-creams; ice; chocolate and chocolate products, namely, cocoa based spread, chocolate bars, chocolate candies; pralines, candy without sugar" in International Class 30; "advertising; business management; business administration; providing office functions" in international class 35; and "entertainment in the nature of providing on-line computer games; organizing community sporting and cultural events" in International Class 41.

5. Respondent's Trademark Registration 4,192,415 (the " '415 Registration") is for use of the mark NUTELLA & DESIGN in connection with "printed matter, namely, newspapers, photographs, magazines, books, printed periodicals, newsletters, and brochures all in the field of food; book binding material; photographs; stationery; adhesives for stationery or household purposes" in International Class 16; "meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk and milk products excluding ice cream, ice milk and frozen yogurt; edible oils and fats" in International Class 29; "coffee, tea, sugar, rice, tapioca, sago, substitute of coffee, flour, bread, biscuits, cakes, pastry and confectionary, namely, candy, cakes, wafers, waffles, muffins; eatable ice-creams; honey, treacle, yeast, baking powder; salt, mustard, pepper, vinegar, sauces; spices; ice; spread creams, namely, cocoa based spread, chocolate and chocolate products, namely, pastry for chocolate beverage, chocolate pastry, chocolate coverings, chocolate, praline, chocolate for decorations of christmas tree, chocolate covered candy containing alcoholic

beverage content; pastry, chewing gum, chewing gum without sugar, candies without sugar” in International Class 30; “beers; mineral and aerated waters and other non-alcoholic drinks, namely, carbonated beverages; fruit drinks and fruit juices; syrups and syrup substitutes for making beverages” in International Class 32; “alcoholic beverages except beers” in International Class 33; “advertising; business management; business administration; providing office functions” in International Class 35; education and entertainment services provided via the internet, namely, provision of an interactive entertainment website featuring information about food tasting, provision of online non-downloadable video games via a website, organizing community sporting and cultural events, contests and games” in International Class 41; and “services for providing food and drink” in International Class 43.

6. Respondent’s marks NUTELLA LOVE & DESIGN and NUTELLA & DESIGN are now collectively referred to as the “Marks”). Respondents Trademark Registration Nos. 3,930,669 and 4,192,415 are now collectively referred to as the “Registrations.”

7. Petitioner is the owner of U.S. Trademark Application Serial No. 86/184,298 (the Application”).

8. The Application was published in the Official Gazette on December 2, 2014.

9. Respondent filed for an extension of time to oppose the Application.

10. On March 31, 2015, Respondent filed a notice of opposition against the Application and initiated this instant action.

11. Respondent relies upon the Registrations as grounds to oppose the Application.

12. Petitioner will be damaged by the continued existence of the Registrations.

COUNT I
Abandonment of the NUTELLA LOVE & DESIGN Mark

13. Petitioner repeats and realleges the allegations contained in the foregoing paragraphs 1-13 as if fully set forth herein

14. Upon information and belief, Respondent is not currently using the NUTELLA LOVE & DESIGN mark in connection with any of the goods listed in International Class 30 of the '669 Registration.

15. Upon information and belief, Respondent has never used the NUTELLA LOVE & DESIGN mark in connection with any of the goods listed in International Class 30 of the '669 Registration.

16. Upon information and belief, Respondent does not have the intent to use and/or resume use of the NUTELLA LOVE & DESIGN mark in connection with any of the goods listed in International Class 30 of the '669 Registration.

17. Thus, upon information and belief, Respondent has abandoned the NUTELLA LOVE & DESIGN mark.

18. Alternatively, upon information and belief, Respondent is not currently using the NUTELLA LOVE & DESIGN mark on or in connection with all of the goods listed in International Class 30 of the '669 Registration.

19. Alternatively, upon information and belief, Respondent has never used the NUTELLA LOVE & DESIGN mark on or in connection with all of the goods listed in International Class 30 of the '669 Registration.

20. Alternatively, upon information and belief, Respondent does not have the intent to use and/or resume use of the NUTELLA LOVE & DESIGN mark on or in connection with all of the goods listed in International Class 30 of the '669 Registration.

21. Alternatively, upon information and belief, Respondent has abandoned the NUTELLA LOVE & DESIGN mark with respect to the goods listed in International Class 30 of the '669 Registration.

22. Petitioner will be damaged by the continued existence of the NUTELLA LOVE & DESIGN Registration.

23. Therefore, Petitioner asserts that the NUTELLA LOVE & DESIGN Registration for the goods listed in International Class 30 should be cancelled pursuant to 15 U.S.C. §§ 1064 and 1119 due to abandonment.

COUNT II
Abandonment of the NUTELLA & DESIGN Mark

24. Petitioner repeats and realleges the allegations contained in the foregoing paragraphs 1-23 as if fully set forth herein.

25. Upon information and belief, Respondent is not currently using the NUTELLA & DESIGN mark in connection with any of the goods listed in International Class 30 of the '415 Registration.

26. Upon information and belief, Respondent has never used the NUTELLA & DESIGN mark in connection with any of the goods listed in International Class 30 of the '415 Registration.

27. Upon information and belief, Respondent does not have the intent to use and/or resume use of the NUTELLA & DESIGN mark in connection with any of the goods listed in International Class 30 of the '415 Registration.

28. Thus, upon information and belief, Respondent has abandoned the NUTELLA & DESIGN mark.

29. Alternatively, upon information and belief, Respondent is not currently using the NUTELLA & DESIGN mark in connection with all of goods listed in International Class 30 of the '415 Registration.

30. Alternatively, upon information and belief, Respondent has never used the NUTELLA & DESIGN mark in connection with all of the goods listed in International Class 30 of the '415 Registration.

31. Alternatively, upon information and belief, Respondent does not have the intent to use and/or resume use of the NUTELLA & DESIGN mark in connection with all of the goods listed in International Class 30 of the '415 Registration.

32. Alternatively, upon information and belief, Respondent has abandoned the NUTELLA & DESIGN mark with respect to the goods listed in International Class 30 of the '415 Registration.

33. Petitioner will be damaged by the continued existence of the NUTELLA & DESIGN Registration.

34. Therefore, Petitioner asserts that the NUTELLA & DESIGN Registration for the goods listed in International Class 30 should be cancelled pursuant to 15 U.S.C. §§ 1064 and 1119 due to abandonment.

COUNT III
Abandonment of the NUTELLA LOVE & DESIGN Mark

35. Petitioner repeats and realleges the allegations contained in the foregoing paragraphs 1-34 as if fully set forth herein.

36. Upon information and belief, Respondent has not used the NUTELLA LOVE & DESIGN mark on any of the goods listed in International Class 30 of the '669 Registration for at least three years, which creates a presumption of abandonment.

37. Alternatively, upon information and belief, Respondent has not used the NUTELLA LOVE & DESIGN mark on or in connection with at least some of the goods listed in International Class 30 of the '669 Registration, which creates the presumption that Respondent has abandoned the NUTELLA LOVE & DESIGN mark with respect to such goods.

38. Upon information and belief, Respondent has no current intention to use the mark NUTELLA LOVE & DESIGN.

39. Petitioner will be damaged by the continued existence of the NUTELLA LOVE & DESIGN Registration.

40. Therefore, Petitioner asserts that the NUTELLA LOVE & DESIGN Registration for the goods listed in International Class 30 should be cancelled pursuant to 15 U.S.C. §§ 1064 and 1119 due to abandonment.

WHEREFORE, Applicant prays for judgment:

- (1) dismissing the Notice of Opposition with prejudice; and
- (2) cancelling U.S. Registrations Nos. 3,930,669 and 4,192,415.

Dated: Scarsdale, New York
May 11, 2015

Respectfully submitted,

LACKENBACH SIEGEL LLP

By: /s/ Robert B. Golden

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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the enclosed RUCHI SOYA INDUSTRIES LIMITED'S ANSWER AND COUNTERCLAIMS FOR CANCELLATION was served on Opposer via U.S. 1st Class Mail, addressed to Opposer's counsel as follows:

E. Anthony Figg
Leo M. Loughlin
ROTHWELL, FIGG, ERNST & MANBECK, PC
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Dated: Scarsdale, New York
May 11, 2015

/s/ Eric A. Menist
Eric Menist