

ESTTA Tracking number: **ESTTA698234**

Filing date: **09/25/2015**

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

Proceeding	91221978
Party	Defendant Royal Greenland A/S
Correspondence Address	BASSAM N IBRAHIM BUCHANAN INGERSOLL & ROONEY PC 1737 KING STREET, SUITE 500 ALEXANDRIA, VA 22314 UNITED STATES bassam.ibrahim@bipc.com
Submission	Answer and Counterclaim
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Signature	/Bassam N. Ibrahim/
Date	09/25/2015
Attachments	Answer to NOO and Counterclaim for Cancellation.pdf(380961 bytes )

**Registration Subject to the filing**

Registration No	4203136	Registration date	09/04/2012
Registrant	LT Overseas North America, Inc. 11130 Warland Drive Cypress, CA 90630 UNITED STATES		

**Goods/Services Subject to the filing**

<p>Class 029. First Use: 2005/02/13 First Use In Commerce: 2005/02/13 All goods and services in the class are requested, namely: Meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, milk powder, evaporated milk, sterilized milk, whipping cream, fermented milk beverages, cultured milk drinks containing lactic acid, yogurt, fermented milk; edible oils and fats</p>
<p>Class 030. First Use: 1989/12/06 First Use In Commerce: 1989/12/06 All goods and services in the class are requested, namely: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour; preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice; bread, pastry; confectionery, namely, chocolates, candies, gumdrops, mints, caramels, toffees, chewing gum, frozen confectionery; ices, honey, treacle; yeast; [ baking powder; ] salt, mustard; vinegar, condiments, namely, sauces; spices; ice</p>

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

LT Overseas North America, Inc.	)	
	)	
Opposer,	)	
	)	
v.	)	
	)	Opposition No. 91221978
Royal Greenland A/S	)	
	)	
Applicant.	)	
	)	

**ANSWER TO NOTICE OF OPPOSITION  
AND COUNTERCLAIM FOR CANCELLATION**

Applicant Royal Greenland A/S (“Applicant”) hereby responds to the allegations in LT Overseas North America, Inc. (“Opposer”) Notice of Opposition as follows:

To the extent a response is required to the introductory paragraph, Applicant lacks sufficient information to form a belief as to the allegations in Paragraph 1, and therefore denies the same.

1. Applicant denies that Opposer has been using or has registered a “ROYAL family of marks.” Applicant lacks sufficient information to form a belief as to the remaining allegations in Paragraph 1, and therefore denies the same.

2. Denied.

3. Applicant denies that Opposer is the owner of the United States Trademark Registration No. 1683914. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the application for United States Trademark Registration No. 1683914 was filed on May 2, 1991 and registered on April 21, 1992. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 3, and therefore denies the same.

4. Applicant denies that Opposer is the owner of the Trademark Registration No. 1982351. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the application for United States Trademark Registration No. 1982351 was filed on May 11, 1995 and registered on June 25, 1996. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 4, and therefore denies the same.

5. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the application for United States Trademark Registration No. 3174620 was filed on February 18, 2005 and registered on November 21, 2006. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 5, and therefore denies the same.

6. Applicant denies that Opposer is the owner of the United States Trademark Registration No. 2066393. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the application for United States Trademark Registration No. 2066393 was filed on October 25, 1995 and registered on June 3, 1997. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 6, and therefore denies the same.

7. Applicant denies that Opposer is the owner of the United States Trademark Registration No. 3990952. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the application for United States Trademark Registration No. 3990952 was filed on March 30, 2010 and registered on July 5, 2011. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 7, and therefore denies the same.

8. Applicant admits that the TSDR Electronic Database of the USPTO reflects that Opposer is the owner of United States Trademark Registration No. 4226560 and that the application for United States Trademark Registration No. 4226560 was filed on March 3, 2011 and registered on October 16, 2012. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 8, and therefore denies the same.

9. Applicant admits that the TSDR Electronic Database of the USPTO reflects that Opposer is the owner of United States Trademark Registration No. 4203136 and that the application for United States Trademark Registration No. 4203136 was filed on April 11, 2011 and registered on September 4, 2012. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 9, and therefore denies the same.

10. Applicant admits that the TSDR Electronic Database of the USPTO reflects that Opposer is the owner of United States Trademark Registration No. 4306093 and that the application for United States Trademark Registration No. 4306093 was filed on September 22, 2011 and registered on March 19, 2013. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 10, and therefore denies the same.

11. Denied.

12. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the registrations identified in Paragraph 3, 4, 5, 6, 7, 8, 9 and 10 are unrevoked and uncanceled. Applicant denies the remaining allegations in Paragraph 12.

13. Applicant admits that the TSDR Electronic Database of the USPTO reflects that the filing dates for the registrations identified in Paragraph 3, 4, 5, 6, 7, 8, 9 and 10 precede the filing date of the Application, as defined by Opposer in the Notice of Opposition. Applicant lacks sufficient information to form a belief as to the other allegations in Paragraph 13, and therefore denies the same.

14. Denied.

15. Denied.

16. Denied.

#### **AFFIRMATIVE AND OTHER DEFENSES**

1. Opposer has failed to state a claim on which relief may be granted.

2. Opposer lacks standing to oppose registration of Applicant's mark ROYAL GREENLAND.
3. Opposer does not own and cannot assert rights in a "family" of ROYAL marks.
3. Opposer's cited marks are not famous pursuant to 15 U.S.C. §1125(c).
4. Opposer's cited marks are distinguishable from Applicant's mark due to the significant differences in appearance, pronunciation, and commercial impression, as well as the differences in the parties' goods, channels of trade, channels of marketing, and the sophistication of the relevant consumers.
5. Applicant has prior use of the mark in commerce as to the goods at issue.
6. Opposer cannot be damaged by registration of the Opposed Mark because Applicant already owns existing registrations for the same or substantially identical mark for the same or substantially identical goods.
7. Applicant reserves the right to assert any additional affirmative defenses, including those that may be identified during the course of investigation and discovery.

#### **COUNTERCLAIM FOR CANCELLATION**

Applicant Royal Greenland A/S ("Applicant"), a Danish corporation located and doing business at Qasapi 4, Postboks 1073, 3900 Nuuk, Greenland, believes that it will be damaged by the continued registration of Opposer LT Overseas North America, Inc.'s ("Opposer") U.S. Reg. 4,203,136 in Classes 29 and 30, and hereby petitions for cancellation of said registration for the reasons set forth herein.

1. Applicant repeats and realleges each and every allegation set forth in the Answer and Affirmative Defenses as if set forth herein.

2. Applicant is one of the world's leading seafood producers and offers a variety of seafood and convenience products to both retail trade and the food service industry in the United States and throughout the world.

3. Since at least as early as 1960, Applicant and/or its predecessor in interest have been continuously offering seafood products and related goods under the ROYAL GREENLAND mark in the United States.

4. In addition, Applicant is the owner of incontestable U.S. Reg. No. 994,052 for "ROYAL GREENLAND" in connection with "FROZEN SHRIMPS" in Class 29, which claims a date of first use at least as early as August 16, 1969. The application for U.S. Reg. No. 994,052 was filed on July 6, 1973 and registered on September 24, 1974.

5. Applicant is also the owner of incontestable U.S. Reg. No. 1,971,114 for "ROYAL GREENLAND" in connection with "frozen shrimps, frozen cod fillets, frozen cod loins, frozen Greenland halibut fillets, frozen catfish fillets" in Class 29, which claims a date of first use since at least as early as 1960. The application for U.S. Reg. No. 1,971,114 was filed on February 27, 1995 and registered on April 30, 1996.

6. Notwithstanding Applicant's established prior rights in the ROYAL GREENLAND Mark, on September 4, 2012, Opposer obtained U.S. Reg. No. 4,203,136 (the "Petitioned Registration") for the mark ROYAL in connection with "Meat, fish, poultry, and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs, milk; milk products, namely, milk powder, evaporated milk, sterilized milk, whipping cream, fermented milk beverages, cultured milk drinks containing lactic acid, yogurt, fermented milk; edible oils and fats" in Class 29, and "Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour; preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice; bread, pastry; confectionery, namely, chocolates, candies, gumdrops, mints,

caramels, toffees, chewing gum, frozen confectionery; ices, honey, treacle; yeast; [ baking powder; ]<sup>1</sup> salt, mustard; vinegar, condiments, namely, sauces; spices; ice” in.

7. The Petitioned Registration was filed on April 11, 2011. On June 22, 2012, Opposer filed a Statement of Use in connection with the Petitioned Registration, claimed a date of first use of February 13, 2005, for Class 29 and December 6, 1989 for Class 30.

8. In the Notice of Opposition herein, Opposer has asserted rights in the Petitioned Registration.

9. To the extent the Board finds the mark which is the subject of the Petitioned Registration to be confusingly similar to the ROYAL GREENLAND mark opposed through the Notice of Opposition herein, the Petitioned Registration must be cancelled because Applicant’s use of the ROYAL GREENLAND mark and the prior U.S. Reg. Nos. 994,052 and 1,971,114 for the ROYAL GREENLAND mark predate the filing date and claimed first use date of the Petitioned Registration.

10. Furthermore, upon information and belief, Opposer was not using the mark which is the subject of the Petitioned Registration in U.S. commerce in connection with all of the goods identified in therein as of June 22, 2012, when it filed its Statement of Use.

11. Upon information and belief, Opposer has abandoned use of the mark which is the subject of the Petitioned Registration in connection with some or all of the goods identified therein with no intent to resume use.

12. Upon information and belief, Opposer has not used the mark which is the subject of the Petitioned Registration in U.S. commerce in connection with some or all of the goods identified therein for at least three consecutive years.

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<sup>1</sup> Upon information an belief, Opposer stipulated to the deletion of “Baking Powder” from the Petitioned Registration in order to resolve a cancellation proceeding instituted against it.

13. Therefore, for the reasons set forth herein, Applicant believes that it is and will be damaged by the continued registration of the Petitioned Registration.

WHEREFORE, Applicant requests that the Opposition be denied; that Application Serial No. 79/149704 be allowed to register; that Opposer LT Overseas North America, Inc.'s U.S. Reg. No. 4,203,136 be cancelled; and for such further relief as may be proper.

Respectfully submitted,

ROYAL GREENLAND A/S

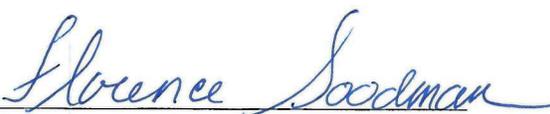
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Date: September 25, 2015

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION was served this 25<sup>th</sup> day of September, 2015 by U.S. mail and electronic mail on:

STEVEN J NATAUPSKY  
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