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

Proceeding	91227188
Party	Defendant Overseas Food Trading Ltd.
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Date	05/11/2016
Attachments	Answer to Trademark Opposition.pdf(288485 bytes )

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

In the Matter of Application of:  
Overseas Food Trading Ltd.  
Serial No. 86695837  
Mark: LE CHEF PÂTISSIER (stylized with design)  
Date Filed: July 16, 2015  
Date Published in *Official Gazette*: February 2, 2016

LE PAFE, INC.,

Opposer,

v.

OVERSEAS FOOD TRADING LTD.,

Applicant.

Opposition No. 91227188

**UNITED STATES PATENT AND TRADEMARK OFFICE**

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES  
TO OPPOSER'S FIRST AMENDED PETITION OF OPPOSITION**

Applicant, Overseas Food Trading Ltd. ("Applicant"), by and through its undersigned attorneys, hereby answers and asserts affirmative defenses to the Notice of Opposition, including the First Amended Petition of Opposition (collectively, the "Opposition"), of Le Pafe, Inc. ("Opposer"). To the extent that a response to the statements in the unnumbered paragraphs of the First Amended Petition of Opposition (the "First Amended Petition") is required, Applicant (i) is without knowledge or information sufficient to form a belief as to the truth of the allegations as to the corporate status and business address of Opposer, and on that ground, denies such allegations; (ii) denies that Opposer will be damaged by Application Serial No. 86695837; (iii) admits that Applicant is a corporation organized and existing under the laws of the State of New Jersey, with an address of 2200 Fletcher Avenue, Fort Lee, NJ 07024, but denies that it is located on the 3<sup>rd</sup> Floor at that address, having re-located to the 7<sup>th</sup> Floor; and (iv) admits that

Application Serial No. 86695837 is for candies; chocolates; chocolate truffles; cookies; cakes; pastries, all of which are in International Class 30, but denies that Applicant's mark is just for a stylized mark including the words LE CHEF PÂTISSIER and denies that it was filed on July 16, 2016, but admits it was filed on July 16, 2015.

Applicant answers and responds to the like-numbered paragraphs of the First Amended Petition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 1 and therefore denies same, except admits that Trademark Registration No. 4888616 was issued on January 19, 2016, by the United States Patent and Trademark Office ("USPTO") to the Opposer for the products listed in Paragraph 1.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 2 and therefore denies same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 3 and therefore denies same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 4 and therefore denies same, except admits that Trademark Registration No. 1791082 was issued on August 31, 1993, by the USPTO to the Opposer for the distributorship services listed in Paragraph 4.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 5 and therefore denies same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 6 and therefore denies same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 7 and therefore denies same, except admits that Trademark Registration No. 4811907 was issued on September 15, 2015, by the USPTO to the Opposer for the distributorship services listed in Paragraph 7.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 8 and therefore denies same.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 9 and therefore denies same.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 10 and therefore denies same, except admits that Trademark Registration No. 3727523 was issued on December 22, 2009, by the USPTO to the Opposer for the products listed in Paragraph 10.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 11 and therefore denies same.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 12 and therefore denies same.

13. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 13 and therefore denies same, except admits that Trademark Registration No. 4874351 was issued on December 22, 2015, by the USPTO to the Opposer for the distributorship services listed in Paragraph 13.

14. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 14 and therefore denies same.

15. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 15 and therefore denies same.

16. The allegations set forth in Paragraph 16 constitute legal conclusions as to which no response is required. To the extent, if any, that a response is required, Applicant denies that its mark is similar to the Opposer's marks because, *inter alia*, (a) Applicant's mark is for a stylized mark with a distinctive logo design (in addition to the word portion) that distinguishes it from Opposer's marks, (b)

even the word portion of Applicant's mark (LE CHEF PÂTISSIER) is distinguishable from Opposer's marks, and (c) the English translation of "Le Chef Pâtissier" is not baker.\*

17. Applicant denies the allegations set forth in Paragraph 17, except admits that the stylized design included in Applicant's mark is of a chef's hat.

18. The allegations set forth in Paragraph 18 constitute legal conclusions as to which no response is required. To the extent, if any, that a response is required, Applicant denies the allegations because, *inter alia*, (a) Applicant's mark and Opposer's marks create different commercial impressions, and (b) Opposer's alleged marks are entitled to a limited scope of protection as they are highly suggestive of the goods/services identified in the pleaded registrations as well as the goods/services with which the marks are actually being used.

19. The allegations set forth in Paragraph 19 constitute legal conclusions as to which no response is required. To the extent, if any, that a response is required, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations that Opposer is the senior and prior user of the Opposer's marks and therefore denies same. Applicant further denies that Opposer would be harmed by the allowance of the Applicant's mark due to consumer confusion, consumer mistake, and/or consumer deception.

20. The allegations set forth in Paragraph 20 constitute legal conclusions as to which no response is required. To the extent, if any, that a response is required, Applicant denies the allegations.

21. The allegations set forth in Paragraph 21 constitute legal conclusions as to which no response is required. To the extent, if any, that a response is required, Applicant denies the allegations that Opposer will likely be damaged by the registration of Applicant's mark pursuant to §2(a) of the Act, 15 U.S.C. §1052(a), or any other provision of the Lanham Act.

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\* Applicant notes that the French word for "baker" is boulanger, not pâtissier. "Pâtissier" means a maker of pastries, cakes and similar products.

**AFFIRMATIVE DEFENSES**

22. As a First Affirmative Defense, Opposer has failed to state a claim against Applicant upon which relief can be granted under §§2(a) and/or 2(d) of the Lanham Act, 15 U.S.C. §§1052(a) and (d).

23. As a Second Affirmative Defense, Opposer's claims are barred based on the doctrine of laches and acquiescence. Applicant is the owner of a prior trademark registration for the word mark LE CHEF PÂTISSIER (in unstylized form), as issued by the USPTO on March 17, 2009, under Registration No. 3589616, for candies; chocolate; chocolate truffles, all of which are in International Class 30. By virtue of the USPTO's March 29, 2015 acceptance of the Section 8 & 15 Affidavits filed by Applicant with respect thereto, that prior registration has become incontestable. Therefore, Opposer is barred from challenging Applicant's stylized and design version of the prior registration for substantially the same goods, namely, candies; chocolates; chocolate truffles; cookies; cakes; pastries, all of which are in International Class 30.

**WHEREFORE**, having fully answered, Applicant prays for judgment against Opposer, dismissing the Opposition with prejudice, permitting Applicant's Application Serial No. 86695837 to proceed to registration, and awarding to Applicant such other and further relief as the Board deems just and proper.

Dated: New York, NY  
May 11, 2016

Respectfully submitted,

WILKAUSLANDER LLP

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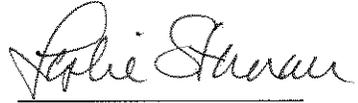
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**CERTIFICATE OF SERVICE**

I hereby certify that on this 11<sup>th</sup> day of May, 2016, a true and complete copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES has been served upon Opposer's attorney of record by depositing the same via First Class Mail, postage prepaid, to the following address:

Kevin M. Welch  
The Law Office of Kevin M. Welch  
P.O. Box 494  
Hermosa Beach, CA 90254

  
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Leslie Steinau