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Docket No. 29WH-165355

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

<i>In re Matter of Reg. No. 3,334,633 for the mark PRIMA FRUTTA</i>	Cancellation No. _____
Gerawan Farming, Inc., Petitioner,	PETITION FOR CANCELLATION
vs.	
A. Sambado & Son, Inc., Registrant.	11/20/2012 SWILSON1 00000021 505691 3334633 01 FC:6401 300.00 DA

TO: Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

178800307

Petitioner Gerawan Farming, Inc., a California corporation having its principal place of business at 15749 E. Ventura Ave., Sanger, California 93657 ("Petitioner"), believes that it will be harmed by the continued registration of the mark PRIMA FRUTTA, as shown in U.S. Registration No. 3,334,633 (the "Registration"), and hereby seeks its cancellation on the following grounds:

1. Petitioner owns trademark registrations for the marks PRIMA in Class 31 (Reg. No. 1,441,378), PRIMA & Design in Class 31 (Reg. No. 3,592,505), PRIMA in Class 31 (Reg. No. 3,866,359), PRIMA SWEET PERSONALLY SELECTED in Class 31 (Reg. No. 1,585,993), PRIMA SWEET & Design in Class 31 (Reg. No. 3,871,978), PRIMA in Class 20 (Reg. No. 3,789,495), PRIMA & Design in Class 20 (Reg. No. 3,789,494), PRIMATRAK in Class 35 (Reg. No. 3,089,808), PRIMATRAK & Design in Class 35 (Reg. No. 3,089,809), and PRIMAREADY READY TO EAT & Design in Class 31 (Reg. No. 3,833,518), (hereinafter collectively referred to as "the PRIMA Marks"), and all other rights associated therewith for the goods and services offered under the PRIMA Marks (the "PRIMA Goods"). Attached



hereto as **Exhibit A** are true and correct copies of Petitioner's registrations for the PRIMA Marks. Petitioner's PRIMA Marks are a family of marks, often used together in promotional materials, among other things.

2. On November 13, 2007, Registrant A. Sambado & Son, Inc., a California corporation having its place of business at 8077 N. Tully Road, Linden, California 95236 ("Registrant"), was issued the Registration of PRIMA FRUTTA for use with fresh fruits; fresh vegetables in Class 31. In such Registration, Registrant claims a date of first use of May 26, 1975. The application that issued the Registration was filed on January 26, 2006.

3. Petitioner first used the mark PRIMA in Class 31 for fresh fruits, namely, table grapes, peaches, plums, nectarines, and apricots at least as early as 1970. Such dates precede the dates of first use claimed by Registrant in the Registration.

4. As noted above, Petitioner is the owner of other PRIMA formative trademarks, e.g., PRIMA SWEET & Design, PRIMA SWEET PERSONALLY SELECTED, PRIMAREADY READY TO EAT & Design, PRIMA TRAK, and PRIMA TRAK & Design, which form the family of PRIMA Marks owned by Petitioner.

5. The goods sold, and services offered, under the PRIMA Marks have been favorably received and are otherwise recognized by the consuming public. Petitioner has cultivated significant goodwill in its PRIMA Marks.

6. On information and belief, Registrant has never used PRIMA FRUTTA for fresh vegetables, or is not currently using the mark for fresh vegetables. On information and belief, the only fresh fruits for which Registrant uses the mark PRIMA FRUTTA are apples and cherries.

FIRST BASIS FOR CANCELLATION – Likelihood of Confusion

7. The continued registration of the mark PRIMA FRUTTA would cause a likelihood of confusion, mistake, or deception as to the source, association, origin, affiliation, endorsement, or sponsorship of Registrant's PRIMA FRUTTA goods with Petitioner and Petitioner's PRIMA Marks.

SECOND BASIS FOR CANCELLATION – Likelihood of Dilution

8. The PRIMA Marks are inherently distinctive and have acquired secondary meaning by extensive, continuous, and substantially exclusive use by Petitioner. The PRIMA Marks are famous and distinctive within the meaning of the Federal Trademark Dilution Act. Registrant began use of PRIMA FRUTTA after the PRIMA mark became famous, and filed its application to register PRIMA FRUTTA after the PRIMA mark became famous.

9. The continued registration of the mark PRIMA FRUTTA is likely to dilute the PRIMA Marks.

THIRD BASIS FOR CANCELLATION – Fraud on the Office

10. Registrant fraudulently procured its registration of PRIMA FRUTTA for “fresh vegetables” because at the time that it filed its application and signed the corresponding declaration under penalty of perjury, Registrant knew that it had only used the mark for cherries and apples and not any type of vegetables. Registrant intended to deceive the Office; it knew that its application misrepresented the goods on which it had used the PRIMA FRUTTA mark and that the Office would be misled into believing that the application was true. The Office reasonably relied on Registrant’s misrepresentation, as evidenced by its issuance of a registration to Registrant for all of the goods included in Registrant’s fraudulent application.

FOURTH BASIS FOR CANCELLATION – Abandonment

11. Even if Registrant at one time used PRIMA FRUTTA for fresh vegetables, it is no longer using the mark for any fresh vegetables. Registrant ceased use of PRIMA FRUTTA for fresh vegetables and does not intend to resume use of the mark for such products in the reasonably foreseeable future.

FIFTH BASIS FOR CANCELLATION – Cancellation under Section 18

12. Registrant has obtained an unrestricted registration of PRIMA FRUTTA for “fresh fruits”, when Registrant only sells “fresh cherries” and “fresh apples” under the

mark. Registrant's unrestricted broad registration of PRIMA FRUTTA for "fresh fruits" covers the fresh fruit sold by Petitioner under the PRIMA Marks, and Petitioner has priority of use over Registrant.

13. The continued registration of the mark PRIMA FRUTTA for fresh fruits arguably provides Registrant with broader rights than Petitioner, when Petitioner is the senior user of the PRIMA Marks.

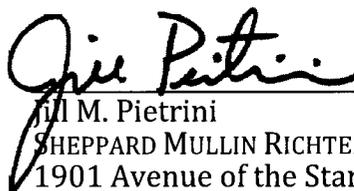
DAMAGE CAUSED TO PETITIONER

14. Petitioner is damaged by the continued registration of the mark shown in the Registration, in that such registration gives Registrant a *prima facie* exclusive right to the use of PRIMA FRUTTA for "fresh fruits and fresh vegetables", despite the likelihood of confusion, mistake, or deception and likelihood of dilution described above; despite the likelihood of dilution; despite the fraud on the Office; despite the abandonment of the mark for fresh vegetables; and despite that Registrant only uses the mark for "fresh cherries" and "fresh apples", yet has obtained a broad registration covering all "fresh fruits", including those sold by Petitioner, the senior user, under the PRIMA Marks.

WHEREFORE, Petitioner prays that this Cancellation be sustained in favor of Petitioner and that the Registration be canceled in whole, or in part to delete "fresh vegetables" and to restrict "fresh fruits" to "fresh cherries and fresh apples".

Please charge the requisite \$300 filing fee (and any additional amounts) to Petitioner's counsel's **Deposit Account No. 50-5691**. A duplicate copy of this Petition for Cancellation is submitted herewith for that purpose.

Respectfully submitted,



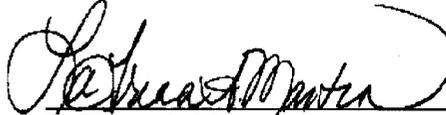
Jill M. Pietrini
SHEPPARD MULLIN RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, California 90067-6017
(310) 228-3700

Attorneys for Petitioner Gerawan Farming, Inc.

Dated: November 13, 2012

CERTIFICATE OF MAILING

I hereby certify that this Petition for Cancellation is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to: Commissioner for Trademarks, Attn: Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this 13th day of November, 2012.


LaTrina A. Martin

CERTIFICATE OF SERVICE

I hereby certify that this Petition for Cancellation is being deposited with the United States Postal Service, postage prepaid, first class mail, in an envelope addressed to: A. Sambado & Son, Inc., 8077 N. Tully Road, Linden, California 95236, on this 13th day of November, 2012.


LaTrina A. Martin

SMRH:407230696.1

Exhibit A

Int. Cl.: 31

Prior U.S. Cl.: 46

United States Patent and Trademark Office **Reg. No. 1,441,378**
Registered June 2, 1987

**TRADEMARK
PRINCIPAL REGISTER**

PRIMA

GERAWAN CO., INC. (CALIFORNIA CORPORATION)
POST OFFICE BOX 1116
REEDLEY, CA 93654

FOR: FRESH FRUITS AND VEGETABLES
NAMESLY, TABLE GRAPES; PEACHES;
PLUMS; NECTARINES; LETTUCE; CAULI-
FLOWER; KIWIS; PERSIMMONS; RAPINI;
BROCCOLI; BOK CHOY; APRICOTS; CANTA-

LOUPE; ESCAROLE; HONEYDEW; CRENSHAW;
RED LEAF; GREEN LEAF; BOSTON;
RED CABBAGE; GREEN CABBAGE; AND
NAPPA, IN CLASS 31 (U.S. CL. 46).
FIRST USE 0-0-1970; IN COMMERCE
0-0-1970.

SER. NO. 529,719, FILED 4-1-1985.

JULIE B. SEYLER, EXAMINING ATTORNEY

Int. Cl.: 31

Prior U.S. Cls.: 1 and 46

United States Patent and Trademark Office

Reg. No. 3,592,505

Registered Mar. 17, 2009

TRADEMARK
PRINCIPAL REGISTER



GERAWAN FARMING INC. (CALIFORNIA CORPORATION)

15749 E. VENTURA AVE.
SANGER, CA 93657

FOR: FRESH FRUIT, IN CLASS 31 (U.S. CLS. 1 AND 46).

FIRST USE 4-10-1985; IN COMMERCE 4-10-1985.

OWNER OF U.S. REG. NOS. 1,441,378, 3,089,808, AND OTHERS.

THE MARK CONSISTS OF THE WORD "PRIMA" STYLIZED WITH A GRAPHIC ELEMENT.

SN 77-339,412, FILED 11-28-2007.

KATHY DE JONGE, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

PRIMA

Reg. No. 3,866,359

Registered Oct. 26, 2010

Int. Cl.: 31

TRADEMARK

PRINCIPAL REGISTER

GERAWAN FARMING, INC. (CALIFORNIA CORPORATION)
15749 E. VENTURA
SANGER, CA 93657

FOR: FRESH FRUITS, IN CLASS 31 (U.S. CLS. 1 AND 46).

FIRST USE 5-12-2009; IN COMMERCE 5-12-2009.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,441,378 AND 3,592,505.

THE ENGLISH TRANSLATION OF "PRIMA" IN THE MARK IS "BEFORE".

SER. NO. 77-735,511, FILED 5-12-2009.

YAT SYE, LEE, EXAMINING ATTORNEY



David J. Kybas

Director of the United States Patent and Trademark Office

Int. Cl.: 31

Prior U.S. Cl.: 46

United States Patent and Trademark Office **Reg. No. 1,585,993**
Registered Mar. 6, 1990

**TRADEMARK
PRINCIPAL REGISTER**

PRIMA SWEET PERSONALLY SELECTED

GERAWAN CO., INC. (CALIFORNIA CORPORATION)
P.O. BOX 366
SANGER, CA 93657

FOR: FRESH GRAPES, PEACHES, NECTARINES, PLUMS AND APRICOTS, IN CLASS 31 (U.S. CL. 46).

FIRST USE 9-9-1987; IN COMMERCE 9-11-1987.

OWNER OF U.S. REG. NO. 1,441,378.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SWEET PERSONALLY SELECTED", APART FROM THE MARK AS SHOWN.

SER. NO. 73-757,333, FILED 10-13-1988.

SHARON R. MARSH, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office



Reg. No. 3,871,978

Registered Nov. 9, 2010

Int. Cl.: 31

TRADEMARK

PRINCIPAL REGISTER

GERAWAN FARMING, INC. (CALIFORNIA CORPORATION)
15749 E. VENTURA
SANGER, CA 93657

FOR: FRESH FRUITS, IN CLASS 31 (U.S. CLS. 1 AND 46).

FIRST USE 5-12-2009; IN COMMERCE 5-12-2009.

OWNER OF U.S. REG. NOS. 1,441,378, 1,585,993, AND 3,592,505.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SWEET", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE STYLIZED WORDS "PRIMA" AND "SWEET" WITHIN AN ELLIPTICAL BORDER, WITH A BACKGROUND OF HORIZONTAL LINES AND A STYLIZED DRAWING OF A PIECE OF FRUIT WITH STEM AND LEAVES.

THE ENGLISH TRANSLATION OF "PRIMA" IN THE MARK IS "BEFORE".

SER. NO. 77-735,515, FILED 5-12-2009.

YAT SYE, LEE, EXAMINING ATTORNEY



David J. Kyppas

Director of the United States Patent and Trademark Office

United States of America
United States Patent and Trademark Office

PRIMA

Reg. No. 3,789,495

Registered May 18, 2010

Int. Cl.: 20

TRADEMARK

PRINCIPAL REGISTER

GERAWAN FARMING, INC. (CALIFORNIA CORPORATION)
15749 E. VENTURA AVE.
SANGER, CA 93657

FOR: NON-METAL PALLETS, IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).

FIRST USE 4-29-2009; IN COMMERCE 4-29-2009.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE ENGLISH TRANSLATION OF "PRIMA" IN THE MARK IS BEFORE.

SER. NO. 77-725,531, FILED 4-29-2009.

YAT SYE, LEE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

United States of America
United States Patent and Trademark Office

PRIMA

Reg. No. 3,789,494

GERAWAN FARMING, INC. (CALIFORNIA CORPORATION)
15749 E. VENTURA AVE.
SANGER, CA 93657

Registered May 18, 2010

Int. Cl.: 20

FOR: NON-METAL PALLETS, IN CLASS 20 (U.S. CLS. 2, 13, 22, 25, 32 AND 50).

TRADEMARK

FIRST USE 4-29-2009; IN COMMERCE 4-29-2009.

PRINCIPAL REGISTER

THE MARK CONSISTS OF THE WORD "PRIMA" STYLIZED WITH A GRAPHIC ELEMENT.

THE ENGLISH TRANSLATION OF "PRIMA" IN THE MARK IS BEFORE.

SER. NO. 77-725,393, FILED 4-29-2009.

YAT SYE, LEE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,089,808

Registered May 9, 2006

SERVICE MARK
PRINCIPAL REGISTER

PRIMATRAK

GERAWAN FARMING, INC. (CALIFORNIA CORPORATION)
15749 EAST VENTURA AVENUE
SANGER, CA 93657

FOR: COMPUTER SERVICES, NAMELY PROVIDING AN ONLINE INTERACTIVE DATABASE FOR THE PLANNING AND SCHEDULING OF SHIPMENTS OF COMMODITIES AND FOR THE REPORTING OF SALES AND ACCOUNTING THEREFOR; INFORMATION ON A VARIETY OF TOPICS RELEVANT TO THE PLANNING AND SCHEDULING OF SHIPMENTS OF COMMODITIES, NAMELY ECONOMIC AND COMMODITIES PRODUCTION FORECASTS AND MARKET RESEARCH, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 12-27-2004; IN COMMERCE 12-27-2004.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,441,378 AND 1,585,993.

THE FOREIGN WORDING IN THE MARK TRANSLATES INTO ENGLISH AS FIRST OR BEFORE.

SER. NO. 78-593,884, FILED 3-23-2005.

ANDREA SAUNDERS, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 3,089,809

United States Patent and Trademark Office

Registered May 9, 2006

**SERVICE MARK
PRINCIPAL REGISTER**



GERAWAN FARMING, INC. (CALIFORNIA
CORPORATION)
15749 EAST VENTURA AVENUE
SANGER, CA 93657

FIRST USE 12-27-2004; IN COMMERCE 12-27-2004.

OWNER OF U.S. REG. NOS. 1,441,378 AND
1,585,993.

FOR: COMPUTER SERVICES, NAMELY PROVID-
ING AN ONLINE INTERACTIVE DATABASE FOR
THE PLANNING AND SCHEDULING OF SHIP-
MENTS OF COMMODITIES AND FOR THE RE-
PORTING OF SALES AND ACCOUNTING
THEREFOR; INFORMATION ON A VARIETY OF
TOPICS RELEVANT TO THE PLANNING AND
SCHEDULING OF SHIPMENTS OF COMMODITIES,
NAMELY ECONOMIC AND COMMODITIES PRO-
DUCTION FORECASTS AND MARKET RE-
SEARCH, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

THE FOREIGN WORDING IN THE MARK
TRANSLATES INTO ENGLISH AS FIRST OR BE-
FORE.

SER. NO. 78-593,886, FILED 3-23-2005.

ANDREA SAUNDERS, EXAMINING ATTORNEY