

ESTTA Tracking number: **ESTTA617615**

Filing date: **07/24/2014**

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

Proceeding	92056497
Party	Plaintiff Gerawan Farming, Inc.
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVENUE OF THE STARS, SUITE 1600 LOS ANGELES, CA 90067-6017 UNITED STATES rhilbert@sheppardmullin.com, jpietrini@sheppardmullin.com, baander-son@sheppardmullin.com
Submission	Answer to Counterclaim
Filer's Name	Jill M. Pietrini
Filer's e-mail	jpietrini@smrh.com, ppost@smrh.com, lmartin@smrh.com, rwalsh@smrh.com, mdanner@smrh.com
Signature	/Jill M. Pietrini/
Date	07/24/2014
Attachments	Gerawan Answer to Counterclaims.pdf(112958 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark: PRIMA FRUTTA
Reg. No. 3,334,633

GERAWAN FARMING, INC.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92-056497
)	
A. SAMBADO & SON, INC.)	PETITIONER GERAWAN FARMING, INC.'S
)	ANSWER TO COUNTERCLAIMS
Registrant.)	
_____)	
)	
AND RELATED COUNTERCLAIM)	
_____)	

Petitioner and Counter-Defendant Gerawan Farming, Inc., a Delaware limited liability company, (“Gerawan”), submits its Answer to the Counterclaim for Cancellation (“Counterclaim”) filed by Registrant and Counterclaimant A. Sambado & Son, Inc. (“Registrant”).

1. Paragraph 28 of the Counterclaim contains no allegations, therefore, no substantive response is required.
2. Gerawan admits the allegations contained in paragraph 29 of the Counterclaim.
3. Gerawan lacks sufficient information to form a belief as to the allegations contained in Paragraph 30 of the Counterclaim, and on that basis denies these allegations.
4. Gerawan lacks sufficient information to form a belief as to the allegations contained in Paragraph 31 of the Counterclaim, and on that basis denies these allegations.

5. Gerawan lacks sufficient information to form a belief as to the allegations contained in Paragraph 32 of the Counterclaim, and on that basis denies these allegations.

6. In response to the allegations in Paragraph 33 of the Counterclaim, Gerawan admits that it is a California corporation with its principal place of business in Sanger, California and that it currently produces fresh fruit and vegetables. Gerawan denies the remaining allegations in Paragraph 33.

7. Gerawan admits the allegations contained in Paragraph 34 of the Counterclaim.

8. In response to Paragraph 35 of the Counterclaim, Gerawan admits that Michael Gerawan is a named inventor of various plant patents. Gerawan denies the remaining allegations in Paragraph 35.

9. Gerawan denies the allegations in Paragraph 36 of the Counterclaim.

10. Gerawan denies the allegations of Paragraph 37 of the Counterclaim.

11. In response to Paragraph 38 of the Counterclaim, Gerawan admits that it filed a malpractice action against its former counsel. Gerawan denies the remaining allegations in Paragraph 38.

**First Counterclaim for Cancellation of Reg. No. 1,441,378 of
PRIMA in Class 31**

12. In response to Paragraph 39 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraphs 28-38.

13. Gerawan denies the allegations in Paragraph 40 of the Counterclaim.

14. Gerawan denies the allegations in Paragraph 41 of the Counterclaim.

**Second Counterclaim for Cancellation of Reg. No. 3,592,505 of
PRIMA (Stylized) in Class 31**

15. In response to Paragraph 42 of the Counterclaim, Gerawan reasserts its responses to Paragraphs 28 to 38.

16. Gerawan denies the allegations in Paragraph 43 of the Counterclaim.

17. In response to Paragraph 44 of the Counterclaim, Gerawan alleges that it has priority over Registrant, and that there is a likelihood of confusion caused by Registrant's junior use of PRIMA FRUTTA.

18. Gerawan denies the allegations in Paragraph 45 of the Counterclaim.

19. Gerawan denies the allegations in Paragraph 46 of the Counterclaim.

20. Gerawan denies the allegations in Paragraph 47 of the Counterclaim.

21. Gerawan denies the allegations in Paragraph 48 of the Counterclaim.

22. Gerawan denies the allegations in Paragraph 49 of the Counterclaim.

Third Counterclaim for Cancellation of Reg. No. 3,866,359 of PRIMA in Class 31

23. In response to Paragraph 50 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraph 28-36.

24. Gerawan denies the allegations in Paragraph 51 of the Counterclaim.

25. In response to Paragraph 52 of the Counterclaim, Gerawan alleges that it has priority over Registrant, and that there is a likelihood of confusion caused by Registrant's junior use of PRIMA FRUTTA.

26. Gerawan denies the allegations in Paragraph 53 of the Counterclaim.

27. Gerawan denies the allegations in Paragraph 54 of the Counterclaim.

28. Gerawan denies the allegations in Paragraph 55 of the Counterclaim.

29. Gerawan denies the allegations in Paragraph 56 of the Counterclaim.

30. Gerawan denies the allegations in Paragraph 57 of the Counterclaim.

Fourth Counterclaim for Cancellation of Reg. No. 1,585,993 of PRIMA SWEET PERSONALLY SELECTED in Class 31

31. In response to Paragraph 58 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraphs 28 to 36.

32. Gerawan denies the allegations in Paragraph 59 of the Counterclaim.

33. Gerawan denies the allegations in Paragraph 60 of the Counterclaim.

**Fifth Counterclaim for Cancellation of Reg. No. 3,871,978 of
PRIMA SWEET & Design in Class 31**

34. In response to Paragraph 61 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraphs 28 to 36.

35. Gerawan denies the allegations in Paragraph 62 of the Counterclaim.

36. In response to Paragraph 63 of the Counterclaim, Gerawan asserts that it has priority over Registrant and that there is a likelihood of confusion caused by Registrant's junior use of PRIMA FRUTTA.

37. Gerawan denies the allegations in Paragraph 64 of the Counterclaim.

38. Gerawan denies the allegations in Paragraph 65 of the Counterclaim.

39. Gerawan denies the allegations in Paragraph 66 of the Counterclaim.

40. Gerawan denies the allegations in Paragraph 67 of the Counterclaim.

41. Gerawan denies the allegations in Paragraph 68 of the Counterclaim.

**Sixth Counterclaim for Cancellation of Reg. No. 3,833,518 of
PRIMA READY READY TO EAT & Design in Class 31**

42. In response to Paragraph 69 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraphs 28 to 36.

43. Gerawan denies the allegations in Paragraph 70 of the Counterclaim.

44. In response to Paragraph 71 of the Counterclaim, Gerawan asserts that it has priority over Registrant and that there is a likelihood of confusion caused by Registrant's junior use of PRIMA FRUTTA.

45. Gerawan denies the allegations in Paragraph 71 of the Counterclaim.

46. Gerawan denies the allegations in Paragraph 72 of the Counterclaim.

47. Gerawan denies the allegations in Paragraph 73 of the Counterclaim.

48. Gerawan denies the allegations in Paragraph 74 of the Counterclaim.

49. Gerawan denies the allegations in Paragraph 75 of the Counterclaim.

50. Gerawan denies the allegations in Paragraph 76 of the Counterclaim.

**Seventh Counterclaim for Cancellation of Reg. No. 3,789,494 of
PRIMA (Stylized) in Class 20**

51. In response to Paragraph 77 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraphs 28 to 36.

52. In response to Paragraph 78 of the Counterclaim, Gerawan asserts that it has priority over Registrant and that there is a likelihood of confusion caused by Registrant's junior use of PRIMA FRUTTA.

53. Gerawan denies the allegations in Paragraph 79 of the Counterclaim.

54. In response to Paragraph 80 of the Counterclaim, Gerawan asserts that it has priority over Registrant and that there is a likelihood of dilution caused by Registrant's junior use of PRIMA FRUTTA.

55. In response to Paragraph 81 of the Counterclaim, Gerawan reasserts its responses to the allegations in Paragraphs 28 to 36.

**Eighth Counterclaim for Cancellation of Reg. No. 3,789,495 of
PRIMA in Class 20**

56. In response to Paragraph 82 of the Counterclaim, Gerawan asserts that it has priority over Registrant and that there is a likelihood of confusion caused by Registrant's junior use of PRIMA FRUTTA.

57. Gerawan denies the allegations in Paragraph 83 of the Counterclaim.

58. In response to Paragraph 84 of the Counterclaim, Gerawan asserts that it has priority over Registrant and that there is a likelihood of dilution caused by Registrant's junior use of PRIMA FRUTTA.

AFFIRMATIVE DEFENSES

First Affirmative Defense – Failure to State a Claim

59. Registrant has failed to state a claim on which relief can be granted.

Second Affirmative Defense – Priority

60. Gerawan has prior rights in its PRIMA mark over Registrant.

Third Affirmative Defense – Unclean Hands

61. The Counterclaim is barred by the doctrine of unclean hands.

Fourth Affirmative Defense – Waiver

62. The Counterclaim is barred by the doctrine of waiver.

Fifth Affirmative Defense – Acquiescence

63. The Counterclaim is barred by the doctrine of acquiescence.

Sixth Affirmative Defense – Laches

64. The Counterclaim is barred by the doctrine of laches.

Seventh Affirmative Defense – Estoppel

65. The Counterclaim is barred by the doctrine of estoppel.

Eighth Affirmative Defense – Morehouse

66. Registrant's Counterclaims against Gerawan's Reg. Nos. 3,866,359, 3,592,505, 3,871,978, and 3,833,518 are barred by the incontestable registered marks shown in Reg. Nos. 1,441,378 under the Morehouse defense and 1,585,993.

WHEREFORE, Gerawan denies that Registrant is entitled to the relief requested and requests that Registrant's Counterclaim be dismissed with prejudice.

Respectfully submitted,

Dated: July 24, 2014

/Jill M. Pietrini/
Jill M. Pietrini
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6055
310-228-3700

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 24th day of July, 2014.

/LaTrina Martin/
LaTrina Martin

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Thomas A. Dirksen
4607 Lakeview Canyon Road, Suite 117
Westlake Village, CA 91361

on this 24th day of July, 2014.

/LaTrina Martin/
LaTrina Martin

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