

ESTTA Tracking number: **ESTTA661920**

Filing date: **03/19/2015**

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

Proceeding	92060856
Party	Defendant Sotea, LLC
Correspondence Address	SOTEA LLC N5441 BRODER ROAD SHAWANO, WI 54166 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Christopher Snyder
Filer's e-mail	csnyder@epiphanylaw.com, sfitzwilliam@epiphanylaw.com
Signature	/css/
Date	03/19/2015
Attachments	Answer to Petition and Counterclaim.pdf(29626 bytes)

Registration Subject to the filing

Registration No	4544757	Registration date	06/03/2014
Registrant	MacKellar, Michelle 102 Beverly Boulevard Fayetteville, PA 17222 UNITED STATES		

Goods/Services Subject to the filing

Class 032. First Use: 2013/01/23 First Use In Commerce: 2014/01/23
All goods and services in the class are requested, namely: Soft drinks flavored with tea

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

In the matter of Registration #: 4474949
Mark: Sotea

Registration Date: January 28, 2014

MICHELLE MACKELLAR)	
)	
Petitioner,)	
)	
v.)	
)	Cancellation No. 92060856
SOTEA, LLC)	
)	
Registrant.)	
)	

**REGISTRANT’S ANSWER AND AFFIRMATIVE DEFENSES TO PETITION TO
CANCEL AND COUNTERCLAIM**

ANSWER

Registrant, Sotea, LLC, by and through its undersigned counsel, hereby responds to the petition to cancel as follows:

Any allegations not specifically admitted are hereby denied. The unnumbered introductory sentence is denied.

1. Paragraph 1 of the Petition to Cancel is admitted.
2. The data contained in the Petitioner’s March 27, 23 application speaks for itself.
3. Paragraph 3 of the Petition to Cancel is denied. No “So T” mark was ever registered by the Petitioner or by anyone else. During the course of the registration, the mark was amended such that “So So T” is the word mark that was ultimately registered to the Petitioner.
4. Paragraph 4 of the Petition to Cancel is admitted.

5. Paragraph 5 of the Petition to Cancel is admitted.
6. Paragraph 6 of the Petition to Cancel is denied. Registrant admits that March 27, 2013 was earlier in time than June 19, 2013. However, Registrant denies that Petitioner has any right to priority over Registrant with respect to any registered marks.
7. Paragraph 7 of the Petition to Cancel is denied. Registrant further affirmatively alleges that Petitioner does not have a “So T” mark, as alleged by Petitioner.
8. Paragraph 8 of the Petition to Cancel is denied.

AFFIRMATIVE DEFENSES

In further answer to the Petition to Cancel, Registrant asserts that:

9. Petitioner’s Petition to Cancel fails to state a claim upon which relief can be granted and, in particular, fails to state legally sufficient grounds for granting the Petition to Cancel.
10. Registrant’s use of its mark will not mistakenly be thought by the public to derive from the same source as Petitioner’s goods, nor will such use be thought by the public to be a use by Petitioner or with Petitioner’s authorization or approval.
11. Registrant’s mark in its entirety is sufficiently distinctively different from Petitioner’s mark to avoid confusion, deception or mistake as to the source or sponsorship or association of Registrant’s goods.
12. Registrant’s mark, when used on Registrant’s goods, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Registrant with Petitioner, or as to the origin, sponsorship, or approval of Registrant’s marks by Petitioner.

13. Petitioner is estopped from enforcing the pleaded mark Registration No. 4,544,757 under the equitable doctrine of unclean hands because the pleaded mark was obtained fraudulently, deceitfully and/or by misrepresentation such that Petitioner should be denied relief herein.

COUNTERCLAIM

Registrant, Sotea, LLC, by and through its undersigned counsel, hereby counterclaims against the Petitioner because it believes it will be damaged by Registration No. 4,544,757, for the mark “So So T” and hereby petitions to cancel said registration in its entirety.

14. Registrant repeats and realleges each and every allegation set forth in the preceding paragraphs as if set forth herein. Registrant hereby seeks cancellation of Registration No. 4,544,757 because this registration was obtained fraudulently.

15. During the prosecution of Registration No. 4,544,757, Petitioner submitted a specimen and a statement of use.

16. Along with the statement of use, Petitioner, through counsel, submitted a declaration acknowledging that “willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the form or any resulting registration.”

17. The statement of use stated that “the mark is in use in commerce on or in connection with all goods or services listed in the application or Notice of Allowance or as subsequently modified for this specific class.”

18. The statement of use further stated that “the mark was first used by the applicant, or the applicant's related company, licensee, or predecessor in interest at least as

early as 01/23/2013, and first used in commerce at least as early as 01/23/2014, and is now in use in such commerce. The applicant is submitting one specimen for the class showing the mark as used in commerce on or in connection with any item in the class, consisting of a(n) digitally photographed bottle.”

19. The specimen is contained in the applicant’s file and is a public record.
20. The specimen is, on its face, highly suspect and does not even contain the word mark “So So T.” The specimen does not appear as though it was actually in use in commerce.
21. Upon information and belief, the Petitioner’s mark was not in use in commerce on or before January 23, 2014, as stated in the statement of use.
22. Petitioner’s specimen consisted of a digitally photographed, plastic bottle.
23. However, on February 16, 2015, more than a year after the alleged first use, Petitioner wrote, via email, and informed potential customers that she was transforming the product into plastic bottles but that those bottles were not yet available.
24. Upon information and belief, Petitioner’s submitted specimen was a fabrication and was not in use in commerce at the time.
25. Registrant has been and will continue to be damaged by the issuance and existence of invalid Registration No. 4,544,757. Registrant has invested significant time and resources towards commercializing products to be sold under the Sotea mark. Registrant is further damaged by having to expend legal fees and its time in order to defend its mark in the present opposition to Petitioner’s invalid

registration. Thus, Petitioner's invalid procurement of the pleaded Registration No. 4,544,757 has proximately caused damage to Registrant.

ADDITIONAL DEFENSES AND COUNTERCLAIMS

26. Registrant hereby reserves the right to assert additional defenses and/or counterclaims based upon information learned or obtained through discovery.

WHEREFORE, Registrant prays for judgment as follows:

- (a) that the Petition to Cancel be dismissed with prejudice;
- (b) that Registration No. 4,544,757 be cancelled; and
- (c) for an award of its attorney fees and expenses incurred in this matter.

Respectfully submitted this 19th day of March, 2015.

EPIPHANY LAW, LLC
Attorneys for Sotea, LLC

By: /s/ Christopher S. Snyder
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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing Answer, Affirmative Defenses, and Counterclaim in Cancellation No. 92060856 to be served upon:

Attorney Daniel C. Marotta
1878 Victory Boulevard
Staten Island, NY 10314
dan@gabormarottalaw.com

By electronic mail and by placing the same in an envelope, properly sealed and addressed, with postage prepaid and depositing the same with the United States Postal Service on this 19th day of March, 2015.

/s/ Christopher S. Snyder _____

Christopher S. Snyder
Attorney for Sotea, LLC