

ESTTA Tracking number: **ESTTA698426**

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

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Trader Joe's Company		
Entity	Corporation	Citizenship	California
Address	800 South Shamrock Avenue Monrovia, CA 91016 UNITED STATES		

Attorney information	Brian M. Berliner O'Melveny & Myers LLP 400 South Hope Street, 18th Floor Los Angeles, CA 90071 UNITED STATES bberliner@omm.com, jkoehler@omm.com, jraphael@omm.com, tbyron@omm.com, aechemy@omm.com Phone:213-430-6000
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Registration Subject to Cancellation

Registration No	3850126	Registration date	09/21/2010
International Registration No.	NONE	International Registration Date	NONE
Registrant	Downright Healthy Foods L.P. 555 Steeprock Drive Toronto, M5H 3Y2 CANADA		

Goods/Services Subject to Cancellation

<p>Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Dairy based beverages; edible nuts, namely, candied nuts, shelled nuts, roasted nuts and processed nuts; processed salted, unsalted and flavored nuts; processed edible seeds; processed pumpkin and sunflower seeds; dried fruit, dried fruit mixes, dried fruit and nut mixes, and fruit chips; trail mixes containing dried fruits, seeds and nuts; preserved fruits; sugared fruits, namely, crystallized fruit and candied fruits; dried prunes, dates, raisins and coconut; glazed fruits, glazed cherries, jams and jellies; soup mixes; condiments, namely, pepper oil; sauces, namely, cranberry sauce; spreads, namely, cheese spreads, fruit-based spreads, hummus; dips, namely, bean dip, dairy-based dip, and snack dip; snack foods, namely, potato chips; baking goods, namely, fruit-based fillings for cakes and pies; unflavored and unsweetened gelatins; frozen entrees consisting primarily of meat, fish, poultry or vegetables; frozen vegetarian entrees; frozen fruits and vegetables; edible oils for human consumption; lentils; pulses; pickled fruits and vegetables; peanut butter and nut butters; soy-based foods, namely, soy-based chips, soy-based food bars, soy-based snack food</p>
<p>Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Coffee, coffee beans; coffee, espresso and cappuccino mixes containing coffee powder; loose and bagged black, green and herbal teas; chocolate covered nuts; confectionery, namely, chocolate and candy; spices and seasonings; condiments, namely, pepper sauce, ketchup, mustard, mayonnaise, relish; sauces, namely, chili sauce,</p>

hot sauce, dipping sauces, barbeque sauces, pizza sauce, fish sauce, tomato sauce, teriyaki sauce, soy sauce, tamari sauce, tartar sauce, steak sauce, andready-made sauces; vinegar, salsa; uncooked pasta and noodles, including egg noodles; salad dressings, oil based salad dressings; spreads, namely, cocoa spreads and spreads containing chocolate and nuts; snack foods, namely, puffed corn snacks, sesame sticks, crackers, wafers, cheese flavored puffs, corn-based snacks,pretzels, cookies, biscuits, tortilla chips and corn chips; croutons; baking goods, namely, cake mixes, muffin mixes, brownie mixes, pastry mixes, chocolate chips, peanut butter confectionery chips, candy mints, baking powder, baking soda,crust mixes for pies, fruit jelly powders, graham cracker crumbs, corn starch, vanilla extract used as a flavoring, yeast, cocoa powder, flours, and white, brown and raw sugar and sugar substitutes; baking goods, namely, candy cake decorations; syrups, namely, corn syrups, maplesyrups, pancake syrups, chocolate syrups; extracts, namely, natural and artificial extracts used as a flavoring; flavored and sweetened gelatins; marshmal-lows;popped and popping corn of various flavors, microwaveable popcorn, seasonings for popcorn; frozen entrees consisting primarily of pasta or rice; processed grains; processed cereals; rolled oats and oatmeal; wheat germ; rice; peanut brittle; honey; and graham crumbs

Class 031. First Use: 0 First Use In Commerce: 0
All goods and services in the class are cancelled, namely: Edible nuts, namely, fresh nuts, raw nuts and unprocessed nuts; unprocessed edible seeds; unprocessed grains

Class 032. First Use: 0 First Use In Commerce: 0
All goods and services in the class are cancelled, namely: Non-alcoholic beverages, namely, carbonated beverages, beverages containing fruit juice, low calorie soft drinks, non-alcoholic beverages with tea flavor, fruit juices, fruit drinks, vegetable juices, vegetable drinks, fruit and vegetable juices, fruit and vegetable drinks; beverage powders and crystals, namely, used in the preparation of fruit drinks; colas; sodas in the nature of soda water, and flavored soda water; carbonated and non-carbonated soft drinks; soy-based beverages not being milk substitutes

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Related Proceed-ings	Petition to Cancel Registration No. 3765793
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Attachments	Trader Joe's Petition to Cancel JOE'S TASTY TRAVELS & Design - Reg. No. 3850126.pdf(23702 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Brian M. Berliner/
Name	Brian M. Berliner
Date	09/25/2015

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

IN THE MATTER OF REGISTRATION NO. 3,850,126
for the mark JOE’S TASTY TRAVELS & Design
registered September 21, 2010

TRADER JOE’S COMPANY,)	Cancellation No. _____
)	
Petitioner,)	
v.)	
)	
DOWNRIGHT HEALTHY FOODS L.P.,)	
)	
Registrant.)	
_____)	

PETITION TO CANCEL

Trader Joe’s Company (“Petitioner”) is a California corporation with an address at 800 South Shamrock Avenue, Monrovia, California 91016.

Downright Healthy Foods L.P., a Canadian limited partnership with an address at 555 Steeprock Drive, North York, Ontario Canada M3J2Z6 (“Registrant”), is the owner of record for U.S. Registration No. 3,850,126 (the “Registration”), issued on September 21, 2010, for the mark JOE’S TASTY TRAVELS & Design for the following goods:

International Class 29: Dairy based beverages; edible nuts, namely, candied nuts, shelled nuts, roasted nuts and processed nuts; processed salted, unsalted and flavored nuts; processed edible seeds; processed pumpkin and sunflower seeds; dried fruit, dried fruit mixes, dried fruit and nut mixes, and fruit chips; trail mixes containing dried fruits, seeds and nuts; preserved fruits; sugared fruits, namely, crystallized fruit and candied fruits; dried prunes, dates, raisins and coconut; glazed fruits, glazed cherries, jams and jellies; soup mixes; condiments, namely, pepper oil; sauces, namely, cranberry sauce; spreads, namely, cheese spreads, fruit-based spreads, hummus; dips, namely, bean dip, dairy-based dip, and snack dip; snack foods, namely, potato chips; baking goods, namely, fruit-based fillings for cakes and pies; unflavored and unsweetened gelatins; frozen entrees consisting primarily of meat, fish, poultry or vegetables; frozen vegetarian entrees; frozen fruits and vegetables; edible oils for human consumption; lentils; pulses; pickled fruits and vegetables; peanut butter and nut butters; soy-based foods, namely, soy-based chips, soy-based food bars, soy-based snack food.

International Class 30: Coffee, coffee beans; coffee, espresso and cappuccino mixes containing coffee powder; loose and bagged black, green and herbal teas; chocolate covered nuts; confectionery, namely, chocolate and candy; spices and seasonings; condiments, namely, pepper sauce, ketchup, mustard, mayonnaise, relish; sauces, namely, chili sauce, hot sauce, dipping sauces, barbeque sauces, pizza sauce, fish sauce, tomato sauce, teriyaki sauce, soy sauce, tamari sauce, tartar sauce, steak sauce, and ready-made sauces; vinegar, salsa; uncooked pasta and noodles, including egg noodles; salad dressings, oil based salad dressings; spreads, namely, cocoa spreads and spreads containing chocolate and nuts; snack foods, namely, puffed corn snacks, sesame sticks, crackers, wafers, cheese flavored puffs, corn-based snacks, pretzels, cookies, biscuits, tortilla chips and corn chips; croutons; baking goods, namely, cake mixes, muffin mixes, brownie mixes, pastry mixes, chocolate chips, peanut butter confectionery chips, candy mints, baking powder, baking soda, crust mixes for pies, fruit jelly powders, graham cracker crumbs, corn starch, vanilla extract used as a flavoring, yeast, cocoa powder, flours, and white, brown and raw sugar and sugar substitutes; baking goods, namely, candy cake decorations; syrups, namely, corn syrups, maple syrups, pancake syrups, chocolate syrups; extracts, namely, natural and artificial extracts used as a flavoring; flavored and sweetened gelatins; marshmallows; popped and popping corn of various flavors, microwaveable popcorn, seasonings for popcorn; frozen entrees consisting primarily of pasta or rice; processed grains; processed cereals; rolled oats and oatmeal; wheat germ; rice; peanut brittle; honey; and graham crumbs.

International Class 31: Edible nuts, namely, fresh nuts, raw nuts and unprocessed nuts; unprocessed edible seeds; unprocessed grains.

International Class 32: Non-alcoholic beverages, namely, carbonated beverages, beverages containing fruit juice, low calorie soft drinks, non-alcoholic beverages with tea flavor, fruit juices, fruit drinks, vegetable juices, vegetable drinks, fruit and vegetable juices, fruit and vegetable drinks; beverage powders and crystals, namely, used in the preparation of fruit drinks; colas; sodas in the nature of soda water, and flavored soda water; carbonated and non-carbonated soft drinks; soy-based beverages not being milk substitutes.

Petitioner believes it will be damaged the continued existence of the Registration and, through its authorized attorneys, hereby petitions pursuant to 15 U.S.C. § 1064 to cancel or partially cancel the Registration. The grounds for cancellation are as follows:

Ground 1: Void *Ab Initio* for Lack of Bona Fide Intent to Use

1. The Registration is based on application Serial No. 78/925,445 (the “Application”), which was filed pursuant to 15 U.S.C. § 1126(d) based on the Registrant’s Canadian Trademark Registration No. TMA743,305.

2. On July 10, 2006, in connection with the Application, James R. Menker, counsel for Registrant, submitted a sworn declaration to the United States Patent and Trademark Office on behalf of Registrant stating that Registrant had “a bona fide intention to use the mark in commerce on or in connection with the identified goods,” namely:

Non-alcoholic beverages; fruit juices and drinks; vegetable juices and drinks; fruit and vegetable juices and drinks; bottled, carbonated and non carbonated water; coffee; coffee, espresso, and cappuccino mixes; beverage powders; drink crystals; loose and bagged black, green and herbal teas; coffee beans; sodas and colas; carbonated and noncarbonated drinks; dairy based beverages; all types of edible nuts, namely candied nuts, chocolate covered nuts, fresh nuts, raw nuts, unprocessed nuts, shelled nuts, roasted nuts, processed nuts, salted nuts, unsalted nuts, flavoured nuts; edible seeds; pumpkin and sunflower seeds; dried fruits; dried fruit mixes; dried fruit and nut mixes; trail mixes; fruit chips; preserved fruits; sugared fruits; dried prunes, dates, raisins and coconut; glazed fruits; glazed cherries; jams and jellies; confectionery, namely chocolate and candy; spices and seasonings; soup mixes; condiments; sauces; soya sauces; vinegars; various uncooked pastas and noodles; egg noodles; salad dressings; spreads; dips; salsas; snack foods, namely potato chips, puffed corn snacks, sesame sticks, crackers, wafers, cheese puffs, corn based snacks, pretzels, cookies, biscuits, tortilla chips, corn chips; puffed cheese flavoured products; croutons; baking goods, namely cake mixes, muffin mixes, brownie mixes, pastry mixes, baking decorations, chocolate chips and peanut butter chips, candy mints, baking crumbs, baking powder, baking soda, crust mixes, fruit jelly powders, graham crumbs, corn starch, vanilla extract, fruit fillings; syrups; extracts and food colourings for human consumption; flavoured and unflavoured gelatins; yeast; cocoa powder; white, brown, and raw sugar and sugar substitutes; marshmallows; popped and popping corn of various flavours; microwaveable popcorn; seasonings for popcorn; frozen entrees; frozen fruits and vegetables; prepared foods; canned goods; cooking oils; edible oils for human consumption; oil based salad dressings; flours; grains; cereals; lentils; pulses; rolled oats and oatmeal; wheat germ; rices; pickled vegetables and fruits; peanut brittle; peanut butter and other nut butters; honey; soy based products and beverages.

3. Upon information and belief, Registrant lacked a bona fide intention to use the mark JOE’S TASTY TRAVELS & Design in commerce in connection with any of the goods identified in the Application.

4. Upon information and belief, as of September 25, 2015—over nine years after Registrant filed the Application—Registrant has not used the mark JOE’S TASTY TRAVELS & Design in commerce in connection with any of the goods identified in the Application.

5. Because Registrant lacked a bona fide intention to use the mark JOE’S TASTY TRAVELS & Design at the time Registrant filed the Application, the Registration is void *ab initio*.

Ground 2: Fraud in Procurement of Trademark Registration

6. On July 10, 2006, in connection with the Application, Mr. Menker submitted a sworn declaration to the United States Patent and Trademark Office on behalf of Registrant stating that Registrant had “a bona fide intention to use the mark in commerce on or in connection with the identified goods.”

7. Upon information and belief, Registrant lacked a bona fide intention to use the mark JOE’S TASTY TRAVELS & Design in commerce in connection with any of the goods identified in the Application.

8. Upon information and belief, as of September 25, 2015—over nine years after Registrant filed the Application—Registrant has not used the mark JOE’S TASTY TRAVELS & Design in commerce in connection with any of the goods identified in the Application.

9. Registrant knew or should have known that the statement in the Application that Registrant had a bona fide intention to use the mark in commerce for all of the goods identified in the Application was false or misleading.

10. Registrant's statement in the Application that Registrant had a bona fide intention to use the mark in commerce for all of the goods identified in the Application constituted a knowingly false misrepresentation of material fact with the intent to deceive the United States Patent and Trademark Office.

11. But for the false statement in the Application, the United States Patent and Trademark Office would not have approved the Application for registration for the goods identified in the Registration.

12. Due to Registrant's knowingly false statement in the Application, Registrant committed fraud on the United States Patent and Trademark Office such that the Registration should be cancelled in whole or in part to eliminate all goods about which Registrant made the knowingly false statement.

Ground 3: Abandonment of the Mark

13. Under 15 U.S.C. § 1127, "[n]onuse for three consecutive years shall be prima facie evidence of abandonment" of a mark.

14. Upon information and belief, Registrant does not use in commerce the mark JOE'S TASTY TRAVELS & Design in connection with all of the goods identified in the Registration and has not used the mark in commerce in connection with such goods for at least three years.

15. Upon information and belief, Registrant has no intention to resume (or begin) use of the mark in connection with the goods identified in the Registration.

16. As a result of Registrant's abandonment of the mark JOE'S TASTY TRAVELS & Design for the goods identified in the Registration, Registrant is not entitled to the Registration or to the legal protections that the Registration affords.

17. Due to Registrant's abandonment of the mark, the Registration should be cancelled in whole or in part to eliminate all goods for which Registrant has abandoned use of the mark.

18. For the reasons set forth in this Petition, Registrant is not entitled to the Registration or to the legal protections that the Registration affords.

19. The Registration is likely to cause consumer confusion between Registrant's mark JOE'S TASTY TRAVELS & Design and Petitioner's mark TRADER JOE'S, including U.S. Trademark Registration Nos. 1420628, 1421310, 1421358, 1421383, 1422216, 1424176, 2156879, 2158990, 2160601, 2171157, 4001531, and 4001533.

20. Because the Registration grants the Registrant rights and legal protections to a trademark whose use is likely to cause consumer confusion with Petitioner's mark TRADER JOE'S, the continued existence of the Registration is causing injury and damage to Petitioner.

WHEREFORE Petitioner prays that U.S. Registration No. 3,850,126 be canceled.

The official filing fee is presented herewith. Please charge any additional fees or credit overpayment to Deposit Account No. 50-3548.

Dated: September 25, 2015

Respectfully submitted,

/Brian M. Berliner/

Brian M. Berliner

Attorneys for Petitioner
TRADER JOE'S COMPANY

BRIAN M. BERLINER
JORDAN RAPHAEL
O'MELVENY & MYERS LLP
400 South Hope Street, 18th Floor
Los Angeles, California 90071-2899
Telephone: (213) 430-6000
Facsimile: (213) 430-6407

TIM BYRON
JESSE J. KOEHLER
O'MELVENY & MYERS LLP
Two Embarcadero Center, 28th Floor
San Francisco, California 94111-3823
Telephone: (415) 984-8700
Facsimile: (415) 984-8701

PETITION TO CANCEL
U.S. REGISTRATION NO. 3,850,126

