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Filing date: **06/13/2016**

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

Proceeding	92062380
Party	Plaintiff D.B.C. Corporation
Correspondence Address	CARLA C CALCAGNO CALCAGNO LAW 1250 24TH STREET NW , SUITE 300 WSASHINGTON, DC 20037 UNITED STATES cccalcagno@gmail.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Carla C. Calcagno
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Signature	/Carla C. Calcagno/
Date	06/13/2016
Attachments	Petitioner Motion to Amend Consolidate Petitions For Cancellation.pdf(43548 bytes) EXHIBIT E CONSOLIDATED AMENDED PETITION FOR CANCELLATION 92062379 and 92062380.pdf(73413 bytes) CLEAN CONSOLIDATED AMENDED PETITION FOR CANCELLATION Reg.pdf(218139 bytes) REDLINE CONSOLIDATED AMENDED PETITION FOR CANCELLATION Reg.pdf(218597 bytes)

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

D.B.C. Corporation,)	
)	
Petitioner)	
)	
v.)	Cancellation Nos.: 92062379
)	and 92062380
Nucita Venezolana C.A.,)	
)	
Defendant)	

PETITIONER'S MOTION AMEND

Pursuant to Trademark Rule 2.107 (37 CFR. § 2.107) and Rule 15(a) of the Federal Rules of Civil Procedure, Petitioner moves the Board for leave to amend its Petitions for Cancellation to (1) add ownership of Petitioner's newly issued Registration, No. 4,895,036; and (2) to correct one typographical error.

The proposed Amended Petition for Cancellation is attached hereto.

1. MOTIONS FOR LEAVE TO AMEND SHALL BE GRANTED FREELY.

Federal Rule 15(a) states as follows: "[A] party may amend the party's pleading.. .by leave of court ...; and leave shall be freely given when justice so requires." See TBMP § 507.02.

In interpreting this provision, the Board has been liberal in granting leave to amend pleadings at any stage of the proceedings, but especially pretrial, when justice so requires, provided the proposed amendment would not violate settled law or be prejudicial to the rights of the adverse party. See e.g. International Finance Corp. v. Braco Co., 64 USPQ2d 1597 (TTAB 2002); Polaris Industries v. DC Comics, 59 USPQ2d 1789 (TTAB 2001); Boral Ltd. v. FMC Corp., 59 USPQ2d 1701 (TTAB

2001); and *Commodore Electronics Ltd. v. CMB Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). See e.g. *United States Olympic Committee v. O-M Bread, Inc.*, 26 USPQ2d 1221 (TTAB 1993) (motion granted where proceeding was still in pre-trial stage and discovery had been extended); *Focus 21 International, Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion granted where motion was filed prior to the opening of plaintiffs testimony period); and *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (motion granted in the interest of justice and any prejudice was overcome by the reopening the discovery period for the benefit of the non-moving party).

Here, the motion is filed pre-trial. And justice would be served by permitting all the parties' claims to be considered in one case. Further, Respondent will not be unduly prejudiced by this motion. As all the conditions of Rule 15 are met, this Motion should be granted.

II. PETITIONER'S REGISTRATION NO. 4895036 WAS NOT ISSUED WHEN THE PETITIONS FOR CANCELLATION WERE FILED AND THE REMAINING AMENDMENT IS INTENDED TO CONFORM THE PETITIONS TO FACTS NOT IN DISPUTE.

A. Registration No. 4,895,036

At the time the Petitions For Cancellation were filed, Petitioner's Registration No. 4,895,036 for CRÈME DE PIROULINE was still pending as an application. Thus, Petitioner pleaded this mark solely as Application Serial Number 86/666,835. On February 2, 2016, Application Serial No. 86/666,835 issued as a registration.

Respondent cannot be prejudiced by this amendment, as Petitioner pleaded the pending application when it filed the Petitions. Thus, Respondent knew or should have known that Petitioner would amend the Petitions when the registration issued.

The Board regularly grants leave to amend to plead a registration issued to the Plaintiff after the original complaint's filing. *VanDyne Cotty Inc v. Wear-guard Corp* 926 F2d 1156, 17 USPQ2d 1866, 1867 (Fed Cir 1991); *Cudahy Co v August Packing Co.* 206 USPQ 759 (TTAB 1979). Petitioner respectfully requests that the Board act consistently with this precedent in this case.

On May 18, 2016, Respondent's counsel sent the undersigned an email providing his written consent to this Motion, which Petitioner had requested long prior to that email. A true and accurate copy of that portion of the email relating to this Amendment is set forth below:

From: Justin R. Young [<mailto:jyoung@dineff.com>]
Sent: Wednesday, May 18, 2016 5:09 PM
To: cccalcagno@gmail.com; trademarks@canopyparalegal.com
Cc: 'Carla Calcagno'; sent@dineff.com
Subject: Cancellation Proceedings Nos. 92062379 and 92062380 - Our Ref.: OT1148US30 & OT1147US3

Dear Carla:

I am writing in relation to the above referenced cases.

1. As you may recall, I had inquired earlier if your clients were willing to consent to the consolidation of the proceedings and you had indicated that your clients will consent to and file the consolidation provide that my clients consented to tan amendment of the petitions to plead in the issuance of DBC mark CREME DE PIROULINE. I hereby confirm that my clients do consent to the amendment and consolidation of the petitions. In view of this, please let me know if you want to file a consented motion to amend and consolidate the petitions or if you prefer to proceed differently.

.....

As this consent was received less than two business days before the undersigned (and opposing counsel) left for INTA and one week prior to the undersigned counsel moving her offices, the undersigned notified Respondent's prior counsel that the Motion would be filed after both counsel returned.

Meantime on May 20, 2016, the undersigned received a Notice of Appearance from alleged new counsel for Respondent that did not bear proof of service on either prior counsel or the Registrant.

On May 27, 2016, the prior counsel first advised he knew nothing about the change of counsel and then after checking with his client confirmed that it had just received instructions that it no longer represented the Respondent.

On that same date, the undersigned sent an email to both prior and current counsel for Respondent advising them that the undersigned intended to represent to the Board that Respondent had consented to this portion of the Motion (and other matters) unless new counsel advised otherwise. No response to that email was received.

Since then, Petitioner has tried to arrange a call with new counsel to confirm their continuing consent to this Motion, but has been unable to reach opposing counsel. It is believed that Respondent still consents to this Amendment, and the undersigned will endeavor to confirm this, but so far no direct communication has been established. The parties will notify the Board just as soon as Petitioner speaks with Respondent's new counsel regarding this Motion.

B. CHANGE OF PLEADED ENTRY DATE OF PRIOR JUDGMENT AGAINST RESPONDENT

This is not the first dispute between the parties relating to Respondent's attempted registration of marks confusingly similar to Petitioner's PIROU formative marks, including PIROULINE.

As stated previously, Petitioner pleads ownership of registrations and prior use of a well-known series of PIROU formative marks, including the marks PIROULINE and CRÈME DE PIROULINE for rolled wafers. Despite these prior rights and registrations, prior to the cases now at bar, Respondent registered the mark PIRULIN,

On June 4, 2013, Petitioner filed a cancellation proceeding against that registration based on Petitioner's prior and superior rights in its PIROULINE mark based on Section 2(d) of the Lanham Act. The Board entered judgment in that case against Respondent on March 4, 2015. See, TTABVUE Cancellation No. 92057303, Docket No. 21.

Well after receiving this judgment on March 4, 2015, Respondent filed to register the PIRUCREAM marks presently at issue for the same goods previously at issue.

Inadvertently, when averring this prior judgment in the present cases, Petitioner plead this prior judgment date as March 5, 2015, rather than March 4. See, paragraph 50 of the Petitions for Cancellation, Docket Entries 1 in Cancellation Nos. 92062379 and 92062380. It is believed that solely because of this typographical error, Respondent denied Allegation 50 in its entirety. Allowing Petitioner to correct this typographical error will simply conform this case to the evidence and should narrow the issues for trial. Respondent cannot be prejudiced by this Amendment as it clearly was on notice of the correct entry of judgment date when it answered the Petitions.

Wherefore, Petitioner respectfully requests that the Board issue an order granting Petitioner's Motion to Amend and setting a date for Respondent to file its Answer thereto.

Dated June 9, 2016

Respectfully submitted,

By: /Carla C. Calcagno/
Carla C Calcagno, Esq.
Janet G Ricciuti, Esq.
Calcagno Law PLLC
2101 L Street, N.W.
Suite 400
Washington, D.C. 20037
Telephone: (202) 466-0544

CERTIFICATE OF SERVICE

I hereby certify that pursuant to Trademark Rule 2.119(d), a true copy of the foregoing:

PETITIONER'S MOTION TO AMEND PETITIONS FOR CANCELLATION

was served this 13th day of June on Registrant's counsel of record at the address identified in the records of the United States Patent and Trademark Office, via first class mail, postage prepaid, to:

Chris Sanchelima
SANCHELIMA &
ASSOCIATES PA
234 SW LEJEUNE
ROAD MIAMI, FL
33134

with a courtesy copy by email to chris@sanchelima.com

/Carla C. Calcagno/

EXHIBIT E



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TSDR

ASSIGN Status

TTAB Status

(Use the "Back" button of the Internet Browser to return to TESS)

CRÈME DE PIROULINE

Word Mark	CRÈME DE PIROULINE
Translations	The English translation of "CRÈME DE" in the mark is "cream of".
Goods and Services	IC 030. US 046. G & S: cookies and wafers. FIRST USE: 19900000. USED IN ANOTHER FORM The mark was first used anywhere in a different form other than that sought to be registered at least as early as 00/00/1980. FIRST USE IN COMMERCE: 19900000
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86666835
Filing Date	June 18, 2015
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	November 17, 2015
Registration Number	4895036
Registration Date	February 2, 2016
Owner	(REGISTRANT) D. B. C. Corporation DBA DeBeukelaer Corp. CORPORATION MISSISSIPPI 228 Industrial Drive North Madison MISSISSIPPI 39110

Attorney of Record Barbara A. Friedman
Prior Registrations 1296629;1297882;4671081
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CRÈME" APART FROM THE MARK AS SHOWN
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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

_____)	Cancellation Nos. 92062379 and _
D.B.C. Corporation,)	92062380
)	
Petitioner,)	Marks: PIRUCREAM and
)	PIRUCREAM Stylized
v.)	
)	Reg. Nos.: 4732479 and 4732480
Nucita Venezolana C.A.,)	
)	
Respondent.)	
_____)	

PETITION FOR CANCELLATION

Petitioner, D.B.C. Corporation, a Mississippi corporation with a business address of 228 Industrial Drive North, Madison, Mississippi 39110, believes it is being damaged by the continued registration of the mark PIRUCREAM in Standard Characters and Stylized From (“hereafter “PIRUCREAM”), Registration Nos. 4732479 and 4732480, in class 30 covering “cookies”, issued to a Venezuelan company, Nucita Venezolana C.A. (hereinafter, “Respondent” or “Nucita”). These registrations were filed on November 11, 2013 based on intention to use. Statements of use were filed on February 12, 2015, claiming a first use and first use in commerce date of December 2014. These registrations issued on May 5, 2015 (hereafter Respondent’s registration”) Petitioner requests cancellation of the same.

As grounds for this Petition, Petitioner alleges as follows:

1. Petitioner is an internationally renowned baker and manufacturer of baked goods. Through its predecessors in interest, Petitioner has manufactured and produced cookies, biscuits, and wafers for over 150 years.

2. Since at least as early as 1979, Petitioner, through its predecessors in interest, has manufactured, distributed and sold internationally, *inter alia*, confectionary products consisting of a rolled wafer, with and without cr me and chocolate fillings. Petitioner's rolled wafer is displayed below



3. Internationally, since at least as early as 1979, Petitioner has sold these confectionary products under the mark PIROULINE, as well as under variations of the mark PIROULINE.

4. Since at least 1981, and well prior to both Respondent's filing date and first use of the mark PIRUCREAM, Petitioner, through its predecessors in interest, has extensively and continuously used, advertised and promoted its confectionary products under a family

of PIROU formative marks. This family consists of the root PIROU coupled with another recognizable word. These marks include PIROULINE, CRÈME DE PIROULINE, PIROULUXE, PIROUCRISP, and PIROUTWIST (hereafter the PIROULINE family of marks).

5. As set forth below, the first use dates of each of Petitioner’s PIROULINE family of marks long precedes Respondent’s filing and alleged first use date of the mark PIRUCREAM.

6. Since at least as early as 1981, Petitioner, through its predecessors in interest, has extensively used, advertised and promoted its PIROULINE and PIROULUXE brand confections throughout the United States.

7. Since at least as early as 1990, Petitioner has extensively used, advertised and promoted its CRÈME DE PIROULINE brand confections throughout the United States.

8. Since at least as early as 2009, Petitioner has extensively used, advertised and promoted its PIROUCRISP brand confections throughout the United States.

9. Since at least as early as 2011, Petitioner has extensively used, advertised and promoted its PIROUTWIST brand confections throughout the United States.

10. Petitioner owns the following U.S. Registrations for its PIROULINE family of marks (“hereafter Petitioner’s registrations”).

MARK	Registration No.	Filing Date	Issuance Date
PIROULINE	1296629	December 4, 1981	September 18, 1984

PIROULUXE	1297882	December 4, 1981	September 25, 1984
PIROUTWIST	4103090	December 16, 2010	February 21, 2012
PIROUCRISP	4671081	June 5, 2014	January 13, 2015

11. True and accurate copies of Registration Numbers 1296629, 1297882, 4103090 and 4671081 as obtained from the USPTO Database showing the current and accurate title and status of these registrations are attached hereto as Exhibit A-D.

12. Each of Petitioner's registrations listed in TABLE 1 above is valid and subsisting and, pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065, Registration Nos. 1296629 and 1297882 have become incontestable.

13. The filing dates listed in TABLE 1 above are each prior to the November 11, 2013 filing date and December 2014 first use dates alleged in Reg. No. 4732479 for the marks PIRUCREAM.

14. In addition to these registrations, Petitioner owns a pending U.S. registration for CRÈME DE PIROULINE, Registration No. 4,895,036, filed June 18, 2015, and issued as a registration on February 2, 2016. A copy of a printout of the Registration Certificate from the TESS Database for that Registration is attached as Exhibit E.

15. Since well prior to Respondent's filing and first use of the mark PIRUCREAM, Petitioner has used, advertised and promoted the members of its PIROU family of marks together in such a way that the public associates not only the individual marks, but the

aforementioned common characteristic of the family, with Petitioner, as indicative of a common origin of the goods.

16. As a result of its extensive and continuous and exclusive use of the PIROULINE family of marks, and the quality of its products, Petitioner's PIROULINE family of marks, both individually and collectively, have acquired extensive fame, renown and recognition in the United States market.

17. Despite Petitioner's prior rights, on November 11, 2013, Respondent, Nucita Venezolana C.A., filed two applications to register marks consisting of or including the term PIRUCREAM. These are: (1) Application Serial No. 86115244 for the mark PIRUCREAM in Stylized Form for "Cookies"; and (2) Application Serial No. 86115230 for the mark PIRUCREAM in Standard Characters for "Cookies" (hereafter "Respondent's Registrations" or "the PIRUCREAM Marks").

18. When filed on November 11, 2013, Application Serial Nos. 86115244 and 86115230 each were based on a bona fide intention to use the mark in commerce

19. On February 12, 2015, in each of Application Serial Nos. 86115244 and 86115230, Respondent filed a Statement of Use, claiming a date of first use and of first use in commerce of December 2014. Exhibit F is a true and accurate copy of the Specimen filed in both Applications.

20. Exhibit F contains a true and accurate depiction of Respondent's packaging for its product sold under the PIRUCREAM Marks in the United States.

21. The Respondent's packaging as shown in Exhibit F, reproduced here below, contains a true and accurate depiction of Respondent's product as sold and offered in the United States under the mark PIRUCREAM.



22. Respondent's product is an imitation of or closely related to Petitioner's PIROULINE and CRÈME DE PIROULINE confectionary products. Both Respondent and Petitioner offer rolled wafers. Both Respondent and Petitioner offer rolled wafers filled with a chocolate flavored cream.

23. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM, anywhere, is no earlier than December 1, 2014.

24. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM, in commerce with the United States, is no earlier than December 1, 2014.

25. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM anywhere is no earlier than December 1, 2013.

26. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM in commerce with the United States is no earlier than December 1, 2013.

27. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROULINE.

28. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROULUXE.

29. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROUTWIST.

30. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROUCRISP.

31. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROULINE.

32. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROULUXE.

33. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROUTWIST.

34. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROUCRISP.

35. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark CRÈME DE PIROULINE.

36. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROULINE.

37. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROULUXE.

38. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROUTWIST.

39. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROUCRISP.

40. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark CRÈME DE PIROULINE.

41. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner, prior to the filing dates of Respondent's Registrations.

42. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner's claim of right to PIROULINE, prior to the filing dates of Respondent's Registrations.

43. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner's claim of right to CRÈME DE PIROULINE prior to the filing dates of Respondent's Registrations.

44. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner's family of PIROU marks, prior to the filing dates of Respondent's Registrations.

45. On May 7, 2009, Respondent filed Application Serial Number 77731071, under Section 1(b) of the Lanham Act, seeking to register the mark PIRULIN in Stylized Form for "cookies filled with chocolate cream". That application matured to Registration No. 4049693 in 2011.

46. On June 4, 2013, Petitioner filed a petition to cancel Registration No. 4049693 for the mark PIRULIN. The Board assigned this proceeding Cancellation No. 92057303.

47. In Cancellation No. 92057303, Petitioner alleged, among other things, that Respondent's PIRULIN mark was likely to cause confusion with Petitioner's mark PIROULINE, Registration No. 1296629.

48. On September 13, 2013, Dineff Trademark Law Limited entered an appearance on behalf of Respondent in Cancellation No. 92057303. Thereafter, the parties engaged in settlement discussions through their respective counsel.

49. These settlement discussions failed and on September 12, 2014, Petitioner served discovery upon Respondent. Rather than answer the discovery, Respondent's counsel withdrew, stating as follows:

Registrant has expressly instructed counsel for Registrant not to take further actions in this matter on its behalf. As a result, counsel for Registrant is no longer receiving directives from Registrant as to litigation decisions, strategy, and the like required to continue his representation in this matter

50. On March 4, 2015, judgment was entered against Nucita in that proceeding and subsequently Registration No. 4049693 for PIRULIN was cancelled.

51. On November 11, 2015, fully eight months after the TTAB judgment in favor of Petitioner in Cancellation No. 4049693, Respondent – through the same Dineff Trademark Law Limited firm - filed applications to register the PIRUCREAM Marks. These applications' declarations were signed by Laurel Dineff of the Dineff Law firm.

52. Upon information and belief, based on the foregoing allegations, prior to its applications to register the PIRUCREAM Marks, Respondent and Ms. Dineff were fully aware of Petitioner's registrations for the marks listed in TABLE 1, of Petitioner's applications for CRÈME DE PIROULINE and of Petitioner's prior use in the United States of the marks PIROULINE and CRÈME DE PIROULINE.

53. Nucita's adoption, use and registration of the mark PIRUCREAM is in bad faith and is an intentional effort to derive benefit from the well-established goodwill developed by Petitioner in the PIROULINE family of marks, including but not limited to the CRÈME DE PIROULINE and PIROULINE marks, through years of sales, advertising and promotion, and to create confusion and deception in the marketplace.

54. As a competitor in the cookie market and the junior user, Nucita is required to adopt a mark and name that has no resemblance whatsoever to the well-known mark PIROULINE family of marks, including but not limited to the marks CREME DE PIROULINE and PIROULINE.

55. Instead, Nucita has adopted a mark that is similar to, and is a play on several components of the PIROULINE family of marks, in sound, meaning, and connotation.

56. PIRUCREAM is an imitation of the well-known PIROULINE and CRÈME DE PIROULINE marks and Petitioner's well-known family of PIROU marks.

57. Respondent's cookies offered and/or sold under the PIRUCREAM mark are either identical to or closely related to Petitioner's wafers and cookies.

58. On information and belief, Exhibit G is a true and accurate copy of advertising distributed by or on behalf of Nucita in the United States on October 1, 2015 at <https://www.facebook.com/pirucreamusa>.

59. Exhibit G displays cookies in association with the name and mark PIRUCREAM. Instead, these are photographs of Petitioner's PIROULINE confectionary products.

60. PIRUCREAM is so similar to Petitioner's CRÈME DE PIROULINE and PIROULINE marks, that, when applied to identical and closely related goods, there is a likelihood of confusion, mistake or deception, from which damage to Petitioner is inevitable.

61. PIRUCREAM is so similar to Petitioner's PIROULINE family of marks, individually and collectively, that, when applied to Respondent's goods, consumers will likely be confused, mistaken or deceived as to the source of the products, from which damage to Petitioner is inevitable.

62. In that Petitioner's rights in PIROULINE, CRÈME DE PIROULINE and the other "PIROULINE" family of marks are long prior to any date on which Respondent can rely in establishing priority in commerce in the United States, registration of PIRUCREAM should be barred under Section 2(d) of the Lanham Act. Therefore, Registration Nos. 4732479 should not remain on the register, and should be cancelled.

WHEREFORE, Petitioner prays that judgment be entered against Nucita, that this Petition be granted and that Registration No. 4732479 and 4732480 be cancelled.

June 9, 2016

/Carla C. Calcagno/
Carla Calcagno
Janet Ricciuti
CALCAGNO LAW PLLC
1250 24th Street N.W. Suite 300
Washington, D.C. 20037
202 466-0544

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that pursuant to Trademark Rule 2.119(d), a true copy of the foregoing CLEAN CONSOLIDATED FIRST AMENDED PETITION FOR CANCELLATION and EXHIBIT E was served this 13th day of June 2016, on the Attorney of Record for Registrant at the address identified in the records of the United States Patent and Trademark Office, via first class mail, postage prepaid, to:

Chris Sanchelima
SANCHELIMA & ASSOCIATES PA
234 SW LEJEUNE ROAD
MIAMI, FL 33134

With a courtesy copy to chris@sanchelima.com

/Carla Calcagno/

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

_____)	Cancellation Nos. 92062379 and _
D.B.C. Corporation,)	92062380
)	
Petitioner,)	Marks: PIRUCREAM and
)	PIRUCREAM Stylized
v.)	
)	Reg. Nos.: 4732479 and 4732480
Nucita Venezolana C.A.,)	
)	
Respondent.)	
_____)	

REDLINE CONSOLIDATED AMENDED PETITION FOR CANCELLATION

Petitioner, D.B.C. Corporation, a Mississippi corporation with a business address of 228 Industrial Drive North, Madison, Mississippi 39110, believes it is being damaged by the continued registration of the mark PIRUCREAM in Standard Characters and Stylized From (“hereafter “PIRUCREAM”), Registration Nos. 4732479 and 4732480, in class 30 covering “cookies”, issued to a Venezuelan company, Nucita Venezolana C.A. (hereinafter, “Respondent” or “Nucita”). These registrations were filed on November 11, 2013 based on intention to use. Statements of use were filed on February 12, 2015, claiming a first use and first use in commerce date of December 2014. These registrations issued on May 5, 2015 (hereafter Respondent’s registration”) Petitioner requests cancellation of the same.

As grounds for this Petition, Petitioner alleges as follows:

1. Petitioner is an internationally renowned baker and manufacturer of baked goods. Through its predecessors in interest, Petitioner has manufactured and produced cookies, biscuits, and wafers for over 150 years.

2. Since at least as early as 1979, Petitioner, through its predecessors in interest, has manufactured, distributed and sold internationally, *inter alia*, confectionary products consisting of a rolled wafer, with and without cr me and chocolate fillings. Petitioner's rolled wafer is displayed below



3. Internationally, since at least as early as 1979, Petitioner has sold these confectionary products under the mark PIROULINE, as well as under variations of the mark PIROULINE.

4. Since at least 1981, and well prior to both Respondent's filing date and first use of the mark PIRUCREAM, Petitioner, through its predecessors in interest, has extensively and continuously used, advertised and promoted its confectionary products under a family

of PIROU formative marks. This family consists of the root PIROU coupled with another recognizable word. These marks include PIROULINE, CRÈME DE PIROULINE, PIROULUXE, PIROUCRISP, and PIROUTWIST (hereafter the PIROULINE family of marks).

5. As set forth below, the first use dates of each of Petitioner’s PIROULINE family of marks long precedes Respondent’s filing and alleged first use date of the mark PIRUCREAM.

6. Since at least as early as 1981, Petitioner, through its predecessors in interest, has extensively used, advertised and promoted its PIROULINE and PIROULUXE brand confections throughout the United States.

7. Since at least as early as 1990, Petitioner has extensively used, advertised and promoted its CRÈME DE PIROULINE brand confections throughout the United States.

8. Since at least as early as 2009, Petitioner has extensively used, advertised and promoted its PIROUCRISP brand confections throughout the United States.

9. Since at least as early as 2011, Petitioner has extensively used, advertised and promoted its PIROUTWIST brand confections throughout the United States.

10. Petitioner owns the following U.S. Registrations for its PIROULINE family of marks (“hereafter Petitioner’s registrations”).

MARK	Registration No.	Filing Date	Issuance Date
PIROULINE	1296629	December 4, 1981	September 18, 1984

PIROULUXE	1297882	December 4, 1981	September 25, 1984
PIROUTWIST	4103090	December 16, 2010	February 21, 2012
PIROUCRISP	4671081	June 5, 2014	January 13, 2015

11. True and accurate copies of Registration Numbers 1296629, 1297882, 4103090 and 4671081 as obtained from the USPTO Database showing the current and accurate title and status of these registrations are attached hereto as Exhibit A-D.

12. Each of Petitioner's registrations listed in TABLE 1 above is valid and subsisting and, pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065, Registration Nos. 1296629 and 1297882 have become incontestable.

13. The filing dates listed in TABLE 1 above are each prior to the November 11, 2013 filing date and December 2014 first use dates alleged in Reg. No. 4732479 for the marks PIRUCREAM.

14. In addition to these registrations, Petitioner owns a pending U.S. [registration application](#) for CRÈME DE PIROULINE, [Registration No. 4,895,036](#)~~Application Serial No. 8666835~~, filed June 18, 2015, [and issued as a registration on February 2, 2016](#). A copy of a printout [of the Registration Certificate](#) from the TESS Database for that [Registration application](#) is attached as Exhibit E.

15. Since well prior to Respondent's filing and first use of the mark PIRUCREAM, Petitioner has used, advertised and promoted the members of its PIROU family of marks together in such a way that the public associates not only the individual marks, but the

aforementioned common characteristic of the family, with Petitioner, as indicative of a common origin of the goods.

16. As a result of its extensive and continuous and exclusive use of the PIROULINE family of marks, and the quality of its products, Petitioner's PIROULINE family of marks, both individually and collectively, have acquired extensive fame, renown and recognition in the United States market.

17. Despite Petitioner's prior rights, on November 11, 2013, Respondent, Nucita Venezolana C.A., filed two applications to register marks consisting of or including the term PIRUCREAM. These are: (1) Application Serial No. 86115244 for the mark PIRUCREAM in Stylized Form for "Cookies"; and (2) Application Serial No. 86115230 for the mark PIRUCREAM in Standard Characters for "Cookies" (hereafter "Respondent's Registrations" or "the PIRUCREAM Marks").

18. When filed on November 11, 2013, Application Serial Nos. 86115244 and 86115230 each were based on a bona fide intention to use the mark in commerce

19. On February 12, 2015, in each of Application Serial Nos. 86115244 and 86115230, Respondent filed a Statement of Use, claiming a date of first use and of first use in commerce of December 2014. Exhibit F is a true and accurate copy of the Specimen filed in both Applications.

20. Exhibit F contains a true and accurate depiction of Respondent's packaging for its product sold under the PIRUCREAM Marks in the United States.

21. The Respondent's packaging as shown in Exhibit F, reproduced here below, contains a true and accurate depiction of Respondent's product as sold and offered in the United States under the mark PIRUCREAM.



22. Respondent's product is an imitation of or closely related to Petitioner's PIROULINE and CRÈME DE PIROULINE confectionary products. Both Respondent and Petitioner offer rolled wafers. Both Respondent and Petitioner offer rolled wafers filled with a chocolate flavored cream.

23. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM, anywhere, is no earlier than December 1, 2014.

24. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM, in commerce with the United States, is no earlier than December 1, 2014.

25. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM anywhere is no earlier than December 1, 2013.

26. Upon information and belief, Respondent's first use of any mark consisting of or including the term PIRUCREAM in commerce with the United States is no earlier than December 1, 2013.

27. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROULINE.

28. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROULUXE.

29. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROUTWIST.

30. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's U.S. registration for PIROUCRISP.

31. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROULINE.

32. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROULUXE.

33. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROUTWIST.

34. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark PIROUCRISP.

35. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products under the mark CRÈME DE PIROULINE.

36. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROULINE.

37. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROULUXE.

38. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROUTWIST.

39. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark PIROUCRISP.

40. Upon information and belief, Respondent did not adopt the mark PIRUCREAM until after it was aware of Petitioner's sale and/or advertising of products in the United States under the mark CRÈME DE PIROULINE.

41. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner, prior to the filing dates of Respondent's Registrations.

42. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner's claim of right to PIROULINE, prior to the filing dates of Respondent's Registrations.

43. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner's claim of right to CRÈME DE PIROULINE prior to the filing dates of Respondent's Registrations.

44. Indeed, as a result of the parties' past and continuing dealings, Nucita was well aware of Petitioner's family of PIROU marks, prior to the filing dates of Respondent's Registrations.

45. On May 7, 2009, Respondent filed Application Serial Number 77731071, under Section 1(b) of the Lanham Act, seeking to register the mark PIRULIN in Stylized Form for "cookies filled with chocolate cream". That application matured to Registration No. 4049693 in 2011.

46. On June 4, 2013, Petitioner filed a petition to cancel Registration No. 4049693 for the mark PIRULIN. The Board assigned this proceeding Cancellation No. 92057303.

47. In Cancellation No. 92057303, Petitioner alleged, among other things, that Respondent's PIRULIN mark was likely to cause confusion with Petitioner's mark PIROULINE, Registration No. 1296629.

48. On September 13, 2013, Dineff Trademark Law Limited entered an appearance on behalf of Respondent in Cancellation No. 92057303. Thereafter, the parties engaged in settlement discussions through their respective counsel.

49. These settlement discussions failed and on September 12, 2014, Petitioner served discovery upon Respondent. Rather than answer the discovery, Respondent's counsel withdrew, stating as follows:

Registrant has expressly instructed counsel for Registrant not to take further actions in this matter on its behalf. As a result, counsel for Registrant is no longer receiving directives from Registrant as to litigation decisions, strategy, and the like required to continue his representation in this matter

50. On March ~~5~~⁴, 2015, judgment was entered against Nucita in that proceeding and subsequently Registration No. 4049693 for PIRULIN was cancelled.

51. On November 11, 2015, fully eight months after the TTAB judgment in favor of Petitioner in Cancellation No. 4049693, Respondent – through the same Dineff Trademark Law Limited firm - filed applications to register the PIRUCREAM Marks. These applications' declarations were signed by Laurel Dineff of the Dineff Law firm.

52. Upon information and belief, based on the foregoing allegations, prior to its applications to register the PIRUCREAM Marks, Respondent and Ms. Dineff were fully aware of Petitioner's registrations for the marks listed in TABLE 1, of Petitioner's applications for CRÈME DE PIROULINE and of Petitioner's prior use in the United States of the marks PIROULINE and CRÈME DE PIROULINE.

53. Nucita's adoption, use and registration of the mark PIRUCREAM is in bad faith and is an intentional effort to derive benefit from the well-established goodwill developed by Petitioner in the PIROULINE family of marks, including but not limited to the CRÈME DE PIROULINE and PIROULINE marks, through years of sales, advertising and promotion, and to create confusion and deception in the marketplace.

54. As a competitor in the cookie market and the junior user, Nucita is required to adopt a mark and name that has no resemblance whatsoever to the well-known mark PIROULINE family of marks, including but not limited to the marks CREME DE PIROULINE and PIROULINE.

55. Instead, Nucita has adopted a mark that is similar to, and is a play on several components of the PIROULINE family of marks, in sound, meaning, and connotation.

56. PIRUCREAM is an imitation of the well-known PIROULINE and CRÈME DE PIROULINE marks and Petitioner's well-known family of PIROU marks.

57. Respondent's cookies offered and/or sold under the PIRUCREAM mark are either identical to or closely related to Petitioner's wafers and cookies.

58. On information and belief, Exhibit G is a true and accurate copy of advertising distributed by or on behalf of Nucita in the United States on October 1, 2015 at <https://www.facebook.com/pirucreamusa>.

59. Exhibit G displays cookies in association with the name and mark PIRUCREAM. Instead, these are photographs of Petitioner's PIROULINE confectionary products.

60. PIRUCREAM is so similar to Petitioner's CRÈME DE PIROULINE and PIROULINE marks, that, when applied to identical and closely related goods, there is a likelihood of confusion, mistake or deception, from which damage to Petitioner is inevitable.

61. PIRUCREAM is so similar to Petitioner's PIROULINE family of marks, individually and collectively, that, when applied to Respondent's goods, consumers will likely be confused, mistaken or deceived as to the source of the products, from which damage to Petitioner is inevitable.

62. In that Petitioner's rights in PIROULINE, CRÈME DE PIROULINE and the other "PIROULINE" family of marks are long prior to any date on which Respondent can rely in establishing priority in commerce in the United States, registration of PIRUCREAM should be barred under Section 2(d) of the Lanham Act. Therefore, Registration Nos. 4732479 should not remain on the register, and should be cancelled.

WHEREFORE, Petitioner prays that judgment be entered against Nucita, that this Petition be granted and that Registration No. 4732479 and 4732480 be cancelled.

June 9, 2016

/Carla C. Calcagno/
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Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that pursuant to Trademark Rule 2.119(d), a true copy of the foregoing REDLINE CONSOLIDATED FIRST AMENDED PETITION FOR CANCELLATION and EXHIBIT E was served this 13th day of June 2016, on the Attorney of Record for Registrant at the address identified in the records of the United States Patent and Trademark Office, via first class mail, postage prepaid, to:

Chris Sanchelima
SANCHELIMA & ASSOCIATES PA
234 SW LEJEUNE ROAD
MIAMI, FL 33134

With a courtesy copy to chris@sanchelima.com

/Carla Calcagno/