

TTPB

In the U.S. Patent and Trademark Office
Trademark Trials and Appeals Board

Bridge International Company
Opposer,
vs.
John E. K. Clay
Applicant

In Re Amended Opposition No. 91155904
Serial No. 75647943

**ANSWER OF APPLICANT TO OPPOSER'S
AMENDED NOTICE OF OPPOSITION**

Assistant Commissioner for Trademarks
Trademark Trials and Appeals Board
2900 Crystal Drive
Arlington, VA 22202-3513



01-11-2005
U.S. Patent & TMO/TM Mail Rcpt Dt. #66

Applicant's Answer to Amended Notice of Opposition

In response to the Notice of Amended Opposition pursuant to an Order Allowing Amended Opposition filed Dec 21, 2004, the applicant, John E. K. Clay answers the Amended Opposition identified above as follows:

1. In response to the allegations of paragraph 1 of the Notice, applicant admits that Applicant is an individual and is a resident of the State of California.
2. In response to the allegations of paragraph 2, the Applicant admits the allegations except that he denies the Debtor was an entity unrelated to Applicant as, among other things, applicant was doing business with the alleged Debtor prior to the Debtor's bankruptcy.

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3. In response to the allegations of paragraph 3, of the Notice, the Applicant denies that the Debtor's Bankruptcy Estate transferred assets to Windsor Confections, Inc, and avers that some assets were transferred to John Clay and to the CAF including the name and mark, SAN FRANCISCO CHOCOLATE COMPANY. Applicant also avers that the payments for the Bankruptcy Estate Assets were made in two checks or other forms of payment and that the payment was from Applicant and not Windsor Confections.
 4. In response to the allegations of paragraph 4, Applicant admits that Windsor Confections, Inc. was incorporated as alleged.
 5. In response to the allegations of paragraph 5 of the Notice, Applicant admits the *Official Gazette* shows what is published in it.
 6. In response to the allegations of paragraph 6, Applicant admits the allegations of this paragraph.
 7. In response to the allegations of paragraph 7, the Applicant is without knowledge or information sufficient to form a belief as to the truth of averments in said paragraph and therefore denies the allegations of paragraph 7. Applicant avers that, based on discovery to date, the date of use alleged in this paragraph has no factual basis and is not correct.
 8. In response to the allegations of paragraph 8, the Applicant is without knowledge or information sufficient to form a belief as to the truth of averments in said paragraph and therefore denies the allegations of paragraph 8.

1 9. In response to those allegations of paragraph 9 regarding similarity, Applicant
2 admits that Opposer's mark is likely to cause confusion and that Opposer's
3 mark is very similar to Applicant's prior and continuously used mark. Applicant
4 denies that Applicant's mark is "also deceptively similar," but avers that
5 Opposer's later used mark is deceptively similar.

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7 10. In response to the allegations of paragraph 10, the Applicant denies the
8 allegations of paragraph 10 except to the extent that Applicant believes that
9 registration of Opposer's mark is likely to cause confusion with Applicant's
10 prior used mark.

11 **ANSWER TO FIRST CLAIM OF OPPOSITION**

12 11. In response to the allegations of paragraph 11, Applicant realleges his
13 responses to Paragraphs 1-10 herein.

14 12. In response to the allegations of paragraph 12 the Allegations of
15 Abandonment contained in Paragraph 12 are denied.

16 13. In response to the allegations of paragraph 13 all the Allegations contained in
17 Paragraph 13 are denied.

18 a. See Exhibits 1- 14 attached to the Original Answer to Opposition.

19 Applicant avers that it is not sufficient to allege or prove that Opposer
20 did not find Applicant's mark SAN FRANCISCO CHOCOLATE
21 COMPANY. Applicant states further:
22

23 b. Because Opposer alleges it does not find use does not show non use.

24 Opposer asserted in its original Opposition that they found one
25 reference on the internet, and that is a reference to a certain line of

1 chocolate "truffles" included in a TEA tasting website. Applicant avers
2 that Applicant's goods are not primarily sold or advertised on the
3 Internet but through trade shows, printed catalogues and personal
4 contact with Applicant and his employees, sales reps and the use of
5 other non electronic media. Typically chocolatiers gather at trade
6 shows. Applicant may in the future advertise on the internet and
7 reserves rights to any Domain Names similar to its trademark SAN
8 FRANCISCO CHOCOLATE COMPANY.

9
10 c. Applicant avers that he has attended candy trade shows. Applicant
11 also avers based on information and belief, that Opposer is not a
12 *maker* of chocolates but is a mere re-packager of chocolate maker's
13 basic chocolate "kellets" and does not make any chocolates but uses
14 the raw kellets directly from their manufacturer.

15 d. Applicant avers that Opposer in his deposition JUNE 21, 2004 testified
16 that Opposer does not believe Applicant's mark was abandoned and
17 that Opposer has eliminated his claim of Abandonment:

18 i. "Page 112: Line 21 A. At this time I believe there may not have been
19 22 an abandonment."

20 e. Applicant denies the mark San Francisco Chocolate Company was
21 abandoned.

22
23 **ANSWER TO SECOND CLAIM OF OPPOSITION**

24 14. In response to the allegations of paragraph 14 the Applicant realleges his
25 responses to Paragraphs 1-13 herein.

1 15. In response to the allegations of paragraphs 15 and 16, Applicant denies that
2 Windsor purchased all the assets of the Bankruptcy sale mentioned herein
3 but admits the quoted portion of the Bill of Sale says what it is quoted to say
4 but is taken out of context and that the "Cash Receipts and Disbursements
5 Record" which was produced as SFCC00017 in discovery shows that the
6 payment for the Assets of SAN FRANCISCO CHOCOLATE COMPANY Inc in
7 the Bankruptcy Estate were made in two parts, \$2000 from "Overbid of
8 1/11/99" and from Windsor.

9
10 16. In response to the allegations of paragraph 16, Applicant denies the
11 allegations of Paragraph 16. Applicant avers that he was at the time a direct
12 payee to the Bankruptcy Estate, founder and funds supplier of Windsor and
13 50% shareholder of Windsor. Applicant was assigned the mark SAN
14 FRANCISCO CHOCOLATE COMPANY by Timothy Mulgrew, 50%
15 shareholder in Windsor, effective as of prior to the Application so that
16 Applicant was and still is owner of all rights title and interest to the Mark.

17 17. In response to the allegations of paragraph 17, Applicant denies all the
18 allegations of this Paragraph.

19 18. In response to the allegations of paragraph 18, Applicant denies all the
20 allegations of this Paragraph.

21
22 **ANSWER TO THIRD CLAIM OF OPPOSITION**

23 19. In response to the allegations of paragraph 19, the Applicant realleges his
24 responses to paragraphs 1 through 18 herein.

1 20. In response to the allegations of paragraph 20 the Applicant denies all these
2 allegations.

3 **ANSWER TO FOURTH CLAIM OF OPPOSITION**

4 21. In response to the allegations of paragraph 21 the Applicant realleges his
5 responses to Paragraphs 1-20 herein.

6 22. In response to the allegations of paragraph 22 the Applicant denies all these
7 allegations.

8 23. In response to the allegations of paragraph 23 the Applicant denies all these
9 allegations and denies that, even if any of them are found to be true, they
10 would have no bearing on the validity of the Application, of the Mark SAN
11 FRANCISCO CHOCOLATE COMPANY or its use.

12 24. In response to the allegations of paragraph 24 the Applicant denies all these
13 allegations.

14 25. In response to the allegations of paragraph 25 the Applicant denies all these
15 allegations.

16 **ANSWER TO FIFTH CLAIM OF OPPOSITION**

17 26. In response to the allegations of paragraph 26 the Applicant realleges his
18 responses to paragraphs 1-25 herein.

19 27. In response to the allegations of paragraph 27, Applicant admits that the
20 original Application was filed as an intent to use applicant and that this was
21 done by himself without legal help, so that applicant believed that his filing as
22 such was a statement that he intended to continue to use the mark SAN
23 FRANCISCO CHOCOLATE COMPANY as it was used and for similar goods,
24
25

1 not that he actually intended to start using the mark SAN FRANCISCO
2 CHOCOLATE COMPANY in the future.

3 28. In response to the allegations of paragraph 28 the Applicant denies all these
4 allegations.

5 29. In response to the allegations of paragraph 29 the Applicant denies all these
6 allegations.

7 **ANSWER TO SIXTH CLAIM OF OPPOSITION**

8 30. In response to the allegations of paragraph 30 the Applicant realleges his
9 responses to paragraphs 1-29 herein.

10 31. In response to the allegations of paragraph 31 the Applicant denies all these
11 allegations.

12 32. In response to the allegations of paragraph 32 the Applicant denies all these
13 allegations.

14 33. In response to the allegations of paragraph 33 the Applicant denies all these
15 allegations.

16 **ANSWER TO SEVENTH CLAIM OF OPPOSITION**

17 34. In response to the allegations of paragraph 34 the Applicant realleges his
18 responses to paragraphs 1-33 herein.

19 35. In response to the allegations of paragraph 35 the Applicant denies all these
20 allegations. Applicant avers that the mark SAN FRANCISCO CHOCOLATE
21 COMPANY has been deemed distinctive by the PTO Examiner for his mark
22 and that these allegations are of no effect on the mark SAN FRANCISCO
23 CHOCOLATE COMPANY under Section 2(f) or any other statute or rule.
24
25

1 36. In response to the allegations of paragraph 36 the Applicant denies the
2 allegations of this paragraph, and avers that these allegations are of no effect
3 on the Applicant's Mark.

4 37. In response to the allegations of paragraph 37 the Applicant denies the
5 allegations of this paragraph.

6 38. In response to the allegations of paragraph 38 the Applicant denies the
7 allegations of this paragraph. Applicant admits only that Oakland is not in the
8 City of San Francisco.

9 39. In response to the allegations of paragraph 39 the Applicant denies the
10 allegations of this paragraph.
11

12 **II. Affirmative Defenses**

13 **In further answer to the Notice the applicant asserts that:**
14

- 15 1. The Opposer has failed to allege grounds sufficient to establish its **standing**
16 to maintain the present Amended Opposition. Opposer fails to allege in its
17 application that it owns the mark No. 76/309490, and therefore may not state
18 this claim as to its mark.
- 19 2. There is no infringement by Applicant and it is Opposer that infringes
20 Applicant's mark by Opposer's knowing use of a similar mark.
- 21 3. Applicant's mark, THE SAN FRANCISCO CHOCOLATE COMPANY has long
22 standing Prior Use and Continuing Use Rights. There has been no
23 abandonment of the Applicant's mark. Exhibit References are to the
24 Applicant's Original Answer to Opposition and are incorporated herein by this
25 reference:

- 1 a. The mark San Francisco Chocolate Co. has been used since the
2 1980's on information and belief, on various types of chocolate and
3 candies. To celebrate this, Applicant's company created Exhibit 1 and
4 2 that show the recent new antique - looking original logo for the mark
5 used in 2002 on a special 2002 "cheese box" for candies for use by the
6 California Autism Foundation on "The Cable Car Collection" for fund
7 raising charity use.
8
9 b. Applicant has produced many specialty candies, seasonal confections
10 and specially designed candies, such as special Christmas and
11 Valentines issues. See Exhibit 3, advertising and showing photos of
12 (as a catalog page) Valentines candies from the 1980s, Exhibit 4
13 showing a 2002 collection of Valentines chocolates and Exhibit 5
14 showing a 1980s Christmas collection of snowmen, Santas and other
15 decorative chocolates.
16
17 c. The mark is used for chocolates sold by the piece in fancy shops,
18 hotels and wholesale to restaurants and hotels for use on dessert trays
19 and displays such as Exhibit 14.
20
21 d. Applicant's mark has been found to be distinctive by virtue of the
22 completely redesigned line of fancy chocolates in a "Boxed Truffle
23 Collection" in use since 1993. Attached is Exhibit 6 showing
24 advertising illustrating this line and its packaging that were submitted to
25 the P.T.O. examiner in prosecution of Applicant's mark.

- 1 e. Truffles were sold in the mid - 1990s in various collections as shown in
2 Exhibit 7 with teddy bears, truffles, fruit medallions and other fine
3 candies.
- 4 f. Exhibits 8 and 9 show use of the mark SAN FRANCISCO
5 CHOCOLATE COMPANY for Halloween/Thanksgiving (8) and Easter
6 collections (9) from the 1980s.
- 7 g. Exhibit 10 is a new box design for a shipped and currently release
8 chocolate for a "San Francisco Brick Road" scheduled for release this
9 year and in 2004 and employing the "1929" logo.
- 10 h. Exhibits 11 and 12 are other designs for the new "San Francisco Brick
11 Road" product employing the "1929" logo.
- 12 i. Exhibit 13 is another design mockup for the "Cable Car Collection"
13 intended to benefit charities for fund raising.

14
15 4. Distinctiveness: The Applicant for the mark SAN FRANCISCO CHOCOLATE
16 COMPANY avers that his mark is distinctive under Section 2 (f), and has
17 been used for more than five (5) years indeed since at least as early as 1982,
18 and on information and belief since the 1980s. It has acquired strong and
19 enforceable rights at least as early as the date of first use, in its markets.
20 Thus, enforceable rights in this mark are created by continuing uses over at
21 least the past five years satisfactory in nature and extent to establish in the
22 opinion of the Applicant's P.T.O. examiner, the distinctiveness of the mark as
23 shown by the prior current and future uses of the mark on boxes of
24 chocolates and specialty items.
25

1 **5. Opposer acquiesced, waived its rights and should be estopped,** for years
2 while Applicant's mark was being used, and in bad faith recognized
3 Applicant's mark SAN FRANCISCO CHOCOLATE COMPANY as existing
4 and lulled Applicant by lack of notice to continue to develop its mark SAN
5 FRANCISCO CHOCOLATE FACTORY in passive recognition of Applicant's
6 rights. Opposer at the same time and also acting against Applicant knowingly
7 went forth with uses of the "Factory" mark. Opposer in bad faith conducted
8 and relied on, by its own admission, a mere internet search for uses of
9 Applicant's mark before applying for its mark. It is well known in this industry
10 that traditional chocolate manufacturers have used items like the exhibits
11 attached and made a part hereof and printed media to demonstrate their
12 products and not the internet until recently.

14 a. Opposer states its Date of First Use as 01/13/1997. Thus five (5)
15 years elapsed before it chose to notify or contact Applicant regarding
16 any issues it had with Applicant's mark. Applicant relied to its
17 detriment and continued to use his mark during the years alleged to
18 have caused damage to Opposer. Opposer allowed therefore the
19 passage of the time needed to strengthen its mark, and using it for the
20 same time as needed to make a determination of "distinctiveness"
21 under Section 2 (f). Opposer nevertheless recognized SAN
22 FRANCISCO CHOCOLATE COMPANY as existing and permitted it to
23 continue.
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1 6. Opposer asserts its claims with **Unclean Hands** since it knew of the
2 Applicant's mark, applied for a very similar mark and attempts to push aside
3 this much longer used mark SAN FRANCISCO CHOCOLATE COMPANY by
4 making assertions it does not in good faith have evidence to support.

5 7. **Invalid and Weak Mark:** as the PTO Examiner in 76309733 San Francisco
6 Chocolate Factory is required to disclaim its entire mark "apart from the mark
7 as shown..."

8 a. The Examiner in Opposer's File wrapper from the P.T.O. stated that
9 the mark is "merely descriptive of what it represents, i.e. the nature of
10 Applicant's entity (i.e. a chocolate factory) and the place where the
11 goods originate (i.e. San Francisco.)..." This makes the opposer's
12 mark inherently weak as geographically descriptive. The Examiner
13 also stated, "An applicant may not claim an exclusive right to use a
14 term that would deprive competitors from an apt description of their
15 goods and services."

16 b. The Examiner stated that Opposer's identification of goods is indefinite
17 and suggests the very limited identification of, "chocolate namely solid
18 chocolates in the forms of disks" making Opposer's mark limited as the
19 shape, size and type of candies they produce, **with no mention of**
20 **"Chocolate Cakes"** as Opposer alleges in their Amended Opposition
21 and nowhere else.

22 8. **Invalid and Weak Mark:** Opposer's Application No 76309490 is weak and
23 an invalid trademark.
24
25

1 a. In Exhibit C to the Notice of Amended Opposition the Examiner states
2 in her Action that the mark is Geographically Descriptive under
3 Trademark act § 2(e)(2) and refuses registration. The examiner of
4 Opposer's mark Ser No 76309490 concludes that, "use of the wording
5 CHOCOLATE FACTORY with the term SAN FRANCISCO implies that
6 the primary significance of the mark is geographic..."

7
8 b. Mark No 490 is therefore very weak and as stated in the Examiner's
9 Action, it is limited "for solid chocolates in the form of disks" and no
10 broader. Applicant's mark is for many forms of chocolates. There is no
11 mention of cakes and anything other than disks in Opposer's
12 application or evidence.

13 c. The Opposer's Application fails to allege that Opposer owns the
14 trademark sought to be registered.

15 d. Opposer, on deposition and in document discovery thus far, has no
16 proof of its allegations for any of its asserted "dates of first use."

17 9. Applicant is the Owner of the Mark and Application. Applicant purchased the
18 mark and other assets of the San Francisco Chocolate Company, Inc. in 1999
19 and was at that time 50% owner of all stock in Windsor Confections, Inc. The
20 other 50% shareholder, Timothy Mulgrew, orally and in writing assigned the
21 mark SAN FRANCISCO CHOCOLATE COMPANY to Applicant before he
22 applied for the mark. Applicant was a major funder for Windsor Confections
23 and the purchase or several chocolate related businesses in 1999 and 2000.
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III. Counter-Claims

In further response to the Notice, the applicant asserts the following Counter-Claims:

First Counter-Claim- Infringement

1. Infringement: That Opposer's mark San Francisco Chocolate Factory only recently created causes a likelihood of public confusion.
2. The Applicant's mark has been in use since at least as early as 1982, for chocolates. This use includes seasonal chocolates, special editions and fancy made candies under this mark. On information and belief it is believed that this same company has periods of production from 1929 to the present and thus may be now considered as famous. Applicant is the owner of the mark and the current application.
3. The mark passed review by a P.T.O. Examiner and was found both distinctive and in use for more than 5 years from evidence submitted in furtherance of his Application.

Second Counter-Claim - Dilution

1. Dilution by tarnishment under 15 U.S.C. § 1125(c), Applicant avers that the inferior qualities of the only style of chocolates sold under the mark SAN FRANCISCO CHOCOLATE FACTORY are on information and belief, only repackaged kelleets.
2. The mark SAN FRANCISCO CHOCOLATE COMPANY has become famous.
3. The marketing for Opposer's chocolate is causing damage to the long standing use of THE SAN FRANCISCO CHOCOLATE COMPANY mark and Applicant's fine distinctive Belgian Chocolate candies.

1 4. The Opposer's use of the mark SAN FRANCISCO CHOCOLATE FACTORY is
2 diluting, damaging and tarnishing the Applicant's SAN FRANCISCO
3 CHOCOLATE COMPANY trademark.

4 **Third Counter-Claim –Opposer's Descriptive Mark**

- 5 1. Opposer's mark is deceptive or deceptively geographically descriptive under 15
6 U.S.C. § 1052(e)(2), TMEP 1210.05.
- 7 2. The Opposer's Exhibits [C and D] show that the P.T.O. Examiner asks disclaimer
8 of the entire mark essentially. It is a fact that the Opposer is located in San
9 Francisco California and Opposer avers it is a chocolate factory.
- 10 3. Thus its mark is descriptive of its location, unlike Applicant who is located outside
11 of San Francisco, and for this reason Opposer's mark should be denied
12 registration.
13

14 **Relief Requested**

15 1. The applicant asks that this Amended Opposition proceeding be dismissed
16 and that Applicant's registration issue forthwith.

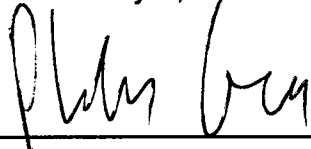
17 2. For the First Counter-Claim, the applicant asks that the Board Finally Reject
18 the application of Opposer for its mark that infringes on the Applicant's mark, and by
19 Opposer's own allegations, their mark is confusingly similar to Applicant's.

20 3. For the Second Counter-Claim, the applicant asks the Board to Finally Reject
21 the application of Opposer and to award Applicant damages and attorney fees.

22 4. For the Third Counter-Claim, the applicant asks the Board to Finally Reject
23 the application of Opposer, and to award Applicant damages and attorney fees.
24
25

1 Respectfully, Philip Green
2 Law Offices of Green & Green

3
4 Dated: January 7, 2005

5 
6 _____

7 Philip Green, Applicant's Attorney
8
9

10
11 **Certificate of Mailing**

12 I hereby certify that this correspondence is being deposited with the Fed Express with
13 sufficient postage as FedEx # **7915 2034 2287** in an envelope addressed to:

14 Assistant Comm'r for Trademarks

15 TTAB

16 Helen Johnson

17 Madison West Bldg.

18 600 Dulany Street

19 Alexandria VA 22314 on January 7, 2005

20 
21 _____

22 Philip Green Attorney for Applicant
23
24
25

1 **Proof of Service**

2 I, HEREBY declare:

3 I am a citizen of the United States, over 18 years of age and not a party to the
4 within action. I am employed in the County of Marin; my business address is Law
5 Offices of Green & Green *Courthouse Square* 1000 Fourth Street, Suite 595 San
6 Rafael, California 94901-3118. On January 7, 2005 I served the within:

7 **Applicant's Answer to Notice of Amended Opposition**

8 on all parties in this action, as addressed below, by causing a true copy thereof to be
9 distributed as follows:

10 Filed with:

11 Attn: Helen Johnson, Legal Assistant,
12 Assistant Commissioner for Trademarks
13 Trademark Trials and Appeals Board
14 2900 Crystal Drive
15 Arlington, VA 22202-3513

16 Served as stated here in on:

17 Ernest G. Bootsma
18 Ater Wynne LLP
19 222 SW Columbia, Suite 1800
20 Portland, Oregon 97201-6618

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24 business. I am aware that on motion of the party served, service is presumed invalid if
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to be delivered to the office of the stated parties.

I declare under penalty of perjury under the laws of the State of California that the
foregoing is true and correct.

Executed on January 7, 2005, at San Rafael, California.

23 
24 _____
25 Philip Green, Law Offices of Green & Green