

ESTTA Tracking number: **ESTTA665295**

Filing date: **04/07/2015**

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

Proceeding	91220840
Party	Defendant Big Idea Holdings, LLC
Correspondence Address	ANNE HIARING HOCKING HIARING & SMITH, LLP 101 LUCAS VALLEY RD STE 300 SAN RAFAEL, CA 94903-1795  trademarks@hiaringsmith.com
Submission	Answer and Counterclaim
Filer's Name	Anne Hiaring Hocking
Filer's e-mail	ahocking@donahue.com, rwalker@donahue.com, dschacht@donahue.com
Signature	/Anne Hiaring Hocking/
Date	04/07/2015
Attachments	Organic Girl Answer to Opposition & Counterclaim.PDF(1135525 bytes )

Registration Subject to the filing

Registration No	3427309	Registration date	05/13/2008
Registrant	SCHLOTTERBECK & FOSS COMPANY 117-119 PREBLE STREET PORTLAND, ME 04101 UNITED STATES		
Grounds for filing	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 030. First Use: 1996/10/00 First Use In Commerce: 1996/10/00  
All goods and services in the class are requested, namely: Sauces and marinades



2. On information and belief, Schlotterbeck & Foss Company is a Maine corporation with its principal place of business at 117 Preble Street, Portland, Maine (“**Schlotterbeck**” or “**S&F**”). On information and belief, S&F produces sauces, cooking sauces, condiments, dressings, and toppings under the trade names “Schlotterbeck & Foss” and “S&F.”

3. Schlotterbeck claims to be the owner of U.S. Registration No. 3427309 (the “**S&F’s Registration**”) for the mark GOOD CLEAN FOOD, registered in Class 30 for “sauces and marinades” (the “**S&F Mark**”). S&F’s Registration was originally issued on May 13, 2008 to Kurt Shisler, an individual (“**Shisler**”). Shisler purportedly assigned his entire interest in the mark to S&F on April 28, 2009.

4. On information and belief, on June 4, 2013, S&F filed a Combined Declaration of Use and Incontestability under 15 U.S.C. §§ 1058, 1065 (the “**Statement of Use**”). At the time this Statement of Use was filed, Schlotterbeck had not used the S&F Mark. The specimen submitted with this Statement of Use was the same specimen used in Shisler’s 2007 filing. *See Exhibit A* (specimen from Shisler’s 2007 Petition to Revive Inadvertently Abandoned Trademark Application). This specimen does not have Schlotterbeck’s name on it. *See Exhibit B* (specimen from Schlotterbeck’s 2013 Statement of Use).

5. No products bearing the S&F Mark are included on the product list available on Schlotterbeck’s website. *See Exhibit C* (list of products from S&F’s website). *See, e.g., Our Products, SCHLOTTERBECK & FOSS, <http://www.schlotterbeck-foss.com/our-products/>.*

6. On information and belief, Schlotterbeck has never used the S&F Mark in commerce. On information and belief, Schlotterbeck does not sell any goods under the S&F Mark.

7. Organic Girl is being and will continue to be damaged by the existence of U.S. Registration No. 3427309 for the mark GOOD CLEAN FOOD in International Class 30.

### **ANSWER TO OPPOSITION**

Organic Girl answers the Notice of Opposition filed by S&F as follows:

8. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 1, and on that basis denies them.

9. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 2, and on that basis denies them.

10. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 3, and on that basis denies them.

11. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 4, and on that basis denies them.

12. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 5, and on that basis denies them.

13. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 6, and on that basis denies them.

14. Organic Girl has applied to register the mark ORGANICGIRL GOOD CLEAN FOOD with design elements in International Classes 29, 30, and 32, Application Serial Nos. 86149005, 86149018, and 86148992, respectively. The applications speak for themselves.

15. Organic Girl denies the allegations of Paragraph 8.

16. Organic Girl denies the allegations of Paragraph 9.

17. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 10, and on that basis denies them.

18. Organic Girl denies the allegations of Paragraph 11.

19. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 12, and on that basis denies them.

20. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 13, and on that basis denies them.

21. Organic Girl lacks information or belief upon the subject sufficient to enable it to specifically answer the allegations of Paragraph 14, and on that basis denies them.

22. Organic Girl denies the allegations of Paragraph 15.

23. Organic Girl denies the allegations of Paragraph 16.
24. Organic Girl denies the allegations of Paragraph 17.
25. Organic Girl denies the allegations of Paragraph 18.
26. Organic Girl denies the allegations of Paragraph 19.
27. Organic Girl denies the allegations of Paragraph 20.

### **AFFIRMATIVE DEFENSES TO OPPOSITION**

#### **FIRST AFFIRMATIVE DEFENSE**

##### **(Failure to State a Cause of Action)**

28. Schlotterbeck fails to state a claim upon which relief can be granted.

#### **SECOND AFFIRMATIVE DEFENSE**

##### **(Lack of Standing)**

29. On information and belief, Schlotterbeck lacks standing as it has acquired a registration that was invalid, and has neither sold nor continuously sold goods in commerce under the S&F Mark.

### **COUNTERCLAIM FOR PETITION TO CANCEL REGISTRATION**

#### **I. S&F'S REGISTRATION WAS VOID *AB INITIO* BECAUSE SCHLOTTERBECK DID NOT USE THE MARK IN COMMERCE.**

30. Organic Girl refers to and incorporates by reference each and every allegation contained in Paragraphs 1 to 7 above.

31. On information and belief, Organic Girl alleges that Shisler did not continuously use the S&F Mark in commerce and abandoned the mark.

32. On information and belief, Organic Girl alleges that Shisler was

not using or had not continuously used the S&F Mark in commerce when the mark was registered on the Principal Register in 2008.

33. On information and belief, Organic Girl alleges that Shisler did not have any trademark rights (common law or statutory) in the S&F Mark at the time the S&F Mark was assigned to Schlotterbeck, due to his non-use or abandonment of the mark and his false statements indicating first and continuous use of the mark.

34. On information and belief, Organic Girl alleges that Schlotterbeck is not now using, nor has it ever used, the S&F Mark in commerce.

35. Organic Girl alleges that Schlotterbeck did not acquire and does not now possess any trademark rights (common law or statutory) in the S&F Mark.

36. Therefore, Organic Girl requests that this Petition to Cancel be granted, and that Registration No. 3427309 be cancelled on the grounds that the registration was void *ab initio*. See 15 U.S.C. § 1064(3).

## **II. SCHLOTTERBECK PROCURED AND/OR MAINTAINED THE S&F MARK THROUGH FALSE STATEMENTS.**

37. Organic Girl refers to and incorporates by reference each and every allegation contained in Paragraphs 1 to 7 above.

38. As a separate basis of cancellation, Organic Girl alleges on information and belief that Schlotterbeck was not using the S&F Mark in commerce at the time it filed its Statement of Use.

39. On information and belief, Organic Girl alleges that Schlotterbeck has never sold any goods using the S&F Mark.

40. On information and belief, Organic Girl alleges that Schlotterbeck knowingly claimed to be using the S&F Mark in commerce when in fact it was not.

41. On information and belief, Organic Girl alleges that Schlotterbeck made false, material representations to the Trademark Office when it filed its Statement of Use, which caused the Trademark Office to maintain the registration. On information and belief, Organic Girl alleges that if the Trademark Office had known these facts, the registration would not have been maintained.

42. Therefore, Organic Girl requests that this Petition to Cancel be granted, and that Registration No. 3427309 be cancelled on the grounds of fraud. *See* 15 U.S.C. § 1064(3).

**III. ALTERNATIVELY, S&F'S REGISTRATION IS VOID BECAUSE SCHLOTTERBECK AND/OR SCHISLER ABANDONED THE S&F MARK.**

43. Organic Girl refers to and incorporates by reference each and every allegation contained in Paragraphs 1 to 7 above.

44. As an alternative ground for cancellation, Organic Girl alleges on information and belief that S&F and/or Schisler has abandoned the S&F Mark.

45. On information and belief, Organic Girl alleges that neither S&F nor Schisler continuously sold any goods under the S&F Mark from 1996 to the present, as alleged in the records of the Trademark Office, under oath, and in this Notice of Opposition.

46. On information and belief, Organic Girl alleges that neither S&F nor Schisler is currently selling any goods under the S&F Mark.



47. Therefore, Organic Girl requests that Registration No. 3427309 be cancelled on the grounds that the mark has been abandoned and is no longer in used in commerce in connection with the goods identified in the registration. *See* 15 U.S.C. § 1064(3).

*[Remainder of Page Intentionally Left Blank]*

## CONCLUSION

48. Organic Girl requests that this Opposition be denied and that registration of Application Serial Nos. 86149005, 86149018, and 86148992 for the mark ORGANICGIRL GOOD CLEAN FOOD in International Classes 29, 30, and 32 be granted.

49. Organic Girl further requests that this Petition to Cancel Registration be granted, and that Registration No. 3427309 be cancelled based on non-use, fraud, or, in the alternative, abandonment, pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111.

50. The filing fee of \$300.00 to petition for cancellation in one class has been submitted electronically with this Answer to Opposition and Petition to Cancel Registration.

Dated: April 7, 2015

By: 

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Anne H. Hocking, Esq.  
Daniel J. Schacht, Esq.  
Robert K. Walker, Esq.  
DONAHUE FITZGERALD LLP  
80 E. Sir Francis Drake Blvd,  
Suite 2M  
Larkspur, CA 94939  
Telephone: (415) 381-4161  
Facsimile: (415) 381-7515  
Email: ahocking@donahue.com  
dschacht@donahue.com  
rwalker@donahue.com

*Attorneys for Applicant and Petitioner  
Big Idea Holdings, LLC*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION AND AFFIRMATIVE DEFENSES; COUNTERCLAIM FOR PETITION TO CANCEL has been served on all parties by mailing said copy on this date, via First Class Mail, postage prepaid pursuant to Trademark Rule 2.119(b)(4), with an e-mail copy provided as a courtesy pursuant to Trademark Rule 2.119(b)(6), to Jeffrey C. Joyce, trademarks@bohanmathers.com.

Dated: April 7, 2015

By: */s/ Elizabeth Kerlake*

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Elizabeth Kerlake  
DONAHUE FITZGERALD LLP  
80 E. Sir Francis Drake Blvd  
Suite 2M  
Larkspur, CA 94939  
Telephone: (415) 381-4161  
Facsimile: (415) 381-7515

*Attorneys for Applicant and Petitioner  
Big Idea Holdings, LLC*

**EXHIBIT A**  
**Specimen from Shisler's 2007 Statement of Use**

Current labels

**RECOMMENDED FISH:**  
halibut, halibut, mahi, grouper, snapper, striped bass, hake, cod, monkfish, tilapia, pompano, swordfish, tuna, roughie.

**Prepares up to 1 1/2 lbs. of fish.**

**EASY DIRECTIONS:** In a skillet, heat sauce to simmer over medium heat. Add fish. Return to simmer; do not boil. Gently reduce heat to medium-low. Gently simmer until done (approx. 10 minutes per inch of thickness). Spoon sauce over fish and serve.

**MICROWAVEABLE**



4 0224-00103-7 1

*Meals have always been an event in my family. That's why I love good food and sharing time at the table.*

*We hand prepare Good Clean Food simmer sauces in our coastal Maine kitchen, carefully combining fresh, authentic ingredients to create flavorful sauces that respect, not overpower seafood. In 15 minutes you'll be serving an exceptional meal.*

*Enjoy!*



Kari Shickel, Founder



Just add fish, simmer and...enjoy!

**ALL NATURAL INGREDIENTS**  
Tomatoes (vine-ripened red tomatoes, water), white wine (contains sulfites), yellow onions, clam broth, celery, spring onions, parsley, olives, capers, extra virgin olive oil, shallots, lemon juice, garlic, rice starch, spices, lemon zest.

**KEEP REFRIGERATED**  
www.goodcleanfood.net

**Nutrition Facts**  
Serving Size about 1/4 cup (57g)  
Servings Per Container about 6

Amount Per Serving		% Daily Value*	
Calories 50		Fat Cal 20	
<b>Total Fat</b>	2.5g		4%
Saturated Fat	0g		0%
<b>Cholesterol</b>	0mg		0%
<b>Sodium</b>	100mg		4%
<b>Total Carbohydrate</b>	4g		1%
<b>Protein</b>	1g		
Vitamins A 15% • Vitamin C 20%			
Calcium 0% • Iron 4%			

\*Percent Daily Values are based on a diet of 2,000 calories a day.

**RECOMMENDED CHICKEN:**  
snapper, mahi, halibut, grouper, striped bass, monkfish, shrimp, swordfish, tuna, roughie, tilapia.

**Prepares up to 1 1/2 lbs. of chicken.**

**EASY DIRECTIONS:** In a skillet, heat sauce to simmer over medium heat. Add fish. Return to simmer, do not boil. Cover and reduce heat to medium-low. Gently simmer until done (approx. 10 minutes per inch of thickness). Spoon sauce over fish and serve.

**MICROWAVEABLE**



7 00224-00202-1 4

*Meals have always been an event in my family. That's why I love good food and sharing time at the table.*

*We hand prepare Good Clean Food simmer sauces in our coastal Maine kitchen, carefully combining fresh, authentic ingredients to create flavorful sauces that respect, not overpower seafood. In 15 minutes you'll be serving an exceptional meal.*

*Enjoy!*



Kari Shickel, Founder



Just add chicken, simmer and...enjoy!

**ALL NATURAL INGREDIENTS**  
Handmade stock (water, fresh fish and chicken, onions, celery, white wine, herbs), plum tomatoes, onions, celery, green peppers, scallions, poblano peppers, unsalted butter, white wine (contains sulfites), parsley, tomato paste, garlic, honey, sea salt, Tabasco® (vinegar, red peppers, salt), rice starch, spices.

**KEEP REFRIGERATED**  
www.goodcleanfood.net

**Nutrition Facts**  
Serving Size about 1/4 cup (57g)  
Servings Per Container about 6

Amount Per Serving		% Daily Value*	
Calories 50		Fat Cal 20	
<b>Total Fat</b>	2.5g		4%
Saturated Fat	0g		0%
<b>Cholesterol</b>	0mg		0%
<b>Sodium</b>	100mg		4%
<b>Total Carbohydrate</b>	4g		1%
<b>Protein</b>	1g		
Vitamins A 15% • Vitamin C 20%			
Calcium 0% • Iron 4%			

\*Percent Daily Values are based on a diet of 2,000 calories a day.



**EXHIBIT B**

**Specimen from Schlotterbeck's 2013 Statement of Use**



Source: <http://tsdr.uspto.gov/documentviewer?caseId=sn76648662&docId=SPE20130605151143#docIndex=3&page=1>





**EXHIBIT C**

**Excerpts from S&F's Website ([www.schlotterbeck-foss.com](http://www.schlotterbeck-foss.com))**



## Our Products

When you have been around as long as we have – since 1866 – you could say we have developed something of a following. In fact, we produce certain signature products that our loyal customers just cannot do without and can't always find on their grocer's shelves. For those devoted fans, no substitutes will do.

That is why we have developed our Select Retail line. Because we value our small-town roots, we want to ensure that those customers who put us where we are today – the premier purveyor of the highest quality specialty foods and flavorings in New England – can turn to us for the products they have come to love, our Mosness salad dressing and classic Vanilla Extract, for example. We receive orders from all over the world, from people who long for a taste of Maine, and who consider S&F part of their family tradition.



## Browse

### Sauces

Caribbean Mango  
Came Asada  
Carolina Gold  
Garlic & Herb  
Garlic Teriyaki  
Ginger Teriyaki  
Honey Buffalo  
Honey Chipotle  
Korean BBQ  
Lemon Dill  
Lemon Pepper  
Maple Chipotle  
Pescado Asado  
Pineapple Jalapeno  
Raspberry Chipotle  
Souraki Marinade  
Stealthouse Marinade  
Sweet Bay BBQ  
Sweet Bourbon  
Tequila Lime  
Teriyaki- Gluten-Free  
Texas BBQ

### Salsas

Chipotle Corn & Chili  
Mango Pineapple  
Texas Caviar  
Three Bean

### Cooking Sauces

Beef Stew  
Cacciatore  
Chipotle Adobo  
Coq Au Vin  
Creole  
Marsala  
Mojo Verde  
Pollo Asada  
Pot Roast  
Pulled Pork  
Red Curry  
Roasted Garlic

### Condiments

Bacon Jam  
Balsamic Roasted Garlic & Onion Jam  
Cocktail Sauce  
Cocktail Sauce, Bloody Mary  
Country Ketchup  
Crab Cake Sauce  
Honey Fig Butter  
Honey Mustard  
Horseradish Aioli  
Horseradish Steak Sauce  
Hot Pepper Butter  
Mango Pepper Sauce  
Mint Jelly  
Mustard Sauce  
Peppercorn Steak Sauce  
Pineapple Ham Glaze  
Remoulade Sauce  
Roasted Garlic Mustard  
Sriracha Chili Sauce  
Sweet Bourbon Mustard  
Sweet Chili Sauce  
Tartar Sauce  
Wicked Good Tatar

### Dressings

Mosness French Dressing

### Toppings

Caramel Topping  
Decadent Fudge



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## Purveyors of Fine Flavors Since 1866

Augustus G. Schlotterbeck and Charles S. Foss founded Schlotterbeck & Foss Company in Portland, Maine in 1866. The company began as a prescription apothecary shop, moving to patented medicines and flavoring extracts. From the horse & buggy days to the present, Schlotterbeck & Foss has earned and maintained a reputation for quality products and fair dealings.

Behind our rich (and delicious) history lies a solid foundation of innovation. While honoring those time-tested recipes that secured our reputation, we keep ourselves open to new trends. We're constantly tasting, sampling and looking for ways to improve and expand our offerings to grow with our customers.

For us, that means a blend of tradition and technology, taking the best from both worlds. While our manufacturing process has been streamlined through computerization, our cooking is still done in small batches, with the care of handcrafting, to bring out the most vibrant flavors. Our company is housed in a historic building, but our facility glitters with stainless steel pipes, specialty kettles and the latest machinery. We have a broad and diverse distribution base, yet we still pack all of our products by hand.

We measure our success by product quality and living our values: remaining dedicated to a small-batch manufacturing process, in which every employee has a sense of ownership, and using only the finest ingredients. To that end, our fudges are made of the finest Dutch cocoas, our vanillas from the best Madagascar beans, and our coffees from specially roasted beans grown around the world. The fruits and vegetables in our sauces and salsas are the freshest available and, whenever possible, organic. The seasonings and spices we choose for our dressings, grilling sauces, mustards and marinades are all-natural. We believe you can taste the goodness of quality ingredients and careful craftsmanship.



117 Preble Street Portland, ME 04101 • [\(800\) 777-4696](tel:(800)777-4696) FREE • [oenry@schlotterbeck-foss.com](mailto:oenry@schlotterbeck-foss.com)

Source: <http://www.schlotterbeck-foss.com/about-us/>



### Food Service

Schlotterbeck & Foss is New England's oldest food-service manufacturer of condiments, sauces, dressings, salsas and ice-cream-topping ingredients. Today, we still produce in small batches, with the care of handcrafting to bring out the most vibrant flavors. From the horse and buggy days to the present, we have earned and maintained a reputation for quality, local products and great service.

Our Chef Sauces are all-natural, gourmet foods produced from the freshest and finest ingredients available, without preservatives or artificial colors. We also strive to use organic and local Maine produce, when possible. For particular dietary needs, we offer products that are gluten-free, vegan, lactose-free, fat-free, cholesterol-free, or low-sodium – all without sacrificing flavor or function.

For over 100 years, our ice-cream toppings and ingredients have set the industry standard by following one simple rule: use the best ingredients. Our fudges are made with the finest Dutch cocoas, our vanilla contains only the best Madagascar beans, and our coffees have specialty roasted beans grown around the world. We believe you can taste the goodness of our superior ingredients and careful craftsmanship.

Serve our products and discover why our uncompromising dedication to taste, nutrition and quality has made us the favorite of New England food-service suppliers since 1866.

### Browse

#### Sauces

- Caribbean Mango
- Carne Asada
- Carolina Gold BBQ
- Chinese Rib Sauce
- Garlic & Herb
- Garlic Teriyaki
- General Tsao
- Honey Buffalo
- Honey Chipotle
- Pineapple Habanero
- Raspberry Chipotle
- Steakhouse Marinade
- Sweet Bourbon
- Teriyaki- Gluten-Free
- Texas BBQ
- Thai Peanut

#### Condiments

- Honey Mustard
- Sweet Chili Sauce

#### Ice Cream

- Toppings
- Syrups
- Varietates
- Ice Cream & Sherbet Bases
- Flavors & Extracts
- Dairy Syrups

#### Butcher Program

- Butcher Program
- Order Labels
- Tumbler Video

Source: <http://www.schlotterbeck-foss.com/food-service/>



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## Private Label

Since 1866, Schlotterbeck & Foss has been regarded as New England's premier purveyor of the highest quality specialty foods and flavorings. Our Private Label Program ranges from simple, traditional recipes to full-scale development of innovative gourmet product lines for leading all-natural and grocery retailers.

We have a wide array of offerings, including condiments, sauces, dressings and marinades. Our expertise is in developing unique flavor profiles with high-density particulates, such as salsas, chutneys, sauces and fruit spreads. We use only the finest and freshest all-natural ingredients, and no preservatives or artificial colors, which makes your labels refreshingly simple and straightforward. Our cooking is done in small batches, with the care of artisan handcrafting, to bring out the most vibrant flavors and maintain the integrity of our fruits and vegetables.

While all our production is done locally, in Maine, our flavor palate extends around the globe. We are constantly testing recipes and experimenting with ethnic flavors to bring new, exciting products to your shelves. Plus, we also offer distinctive packaging and label development. All you need to do is select the strategy that is right for your private brand, and we will do the rest.

## Browse

- [Chutneys](#)
- [Condiments](#)
- [Dressings](#)
- [Fruit Butter & Jelly](#)
- [Fruit Spreads](#)
- [Salsas](#)
- [Sauces](#)
- [Simmer Sauces](#)
- [Toppings](#)

[www.uspto.gov/trademark](http://www.uspto.gov/trademark)

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