

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

BIRDS EYE FOODS LLC,	)	
	)	<i>AMENDED</i> COUNTERCLAIM FOR
Opposer,	)	CANCELLATION; CERTIFICATE OF
	)	SERVICE
v.	)	
	)	Opposition No. 91231833
HAWAIIAN CHIP COMPANY LLC,	)	Application Serial No. 86869172
	)	Mark: HAWAIIAN CHIP COMPANY &
Applicant.	)	DESIGN
	)	

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**AMENDED COUNTERCLAIM FOR CANCELLATION**

HAWAIIAN CHIP COMPANY LLC, a Hawaii limited liability company, whose mailing address is 1928 Republican St., Honolulu, Hawaii 96819 (**Applicant**), believes it has been and will be damaged by U.S. Trademark Registration No. 3697408 for "HAWAIIAN" (**Opposer's Mark**) in connection with "Potato chips," International Class 29, which issued on October 20, 2009 to BIRDS EYE FOODS, INC., a Delaware limited liability company, whose mailing address is 399 Jefferson Road, Parsippany, New Jersey 07054 (**Opposer**), and hereby petitions to cancel Respondent's Mark. As grounds for the requested cancellation, and in specific response to Opposer's *Motion for Partial Dismissal of the Counterclaim for Cancellation* filed herein on March 6, 2017, Applicant alleges as follows:

1. Opposer's Mark should be cancelled under 15 U.S.C. § 1064 and § 1115(b)(3) and (9) because Opposer's Mark misrepresents the source of its associated goods (via geographic misdescriptiveness) and is generic.



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2. On October 29, 2008, Applicant filed U.S. Trademark Application Serial No. 77603153 for the word/design mark “HAWAIIAN CHIP COMPANY” for “Sweet potato chips and taro chips” in International Class 29 (**Applicant’s Original Mark**).
3. On March 17, 2009, the Applicant’s Original Mark was registered on the supplemental register with a first use in commerce of January 1, 2000 (nine years before Opposer’s Mark was issued) and was issued Registration No. 3,593,506.
4. Petitioner inadvertently did not file an acceptable declaration under Section 8 for Applicant’s Original Mark.
5. Applicant’s Original Mark has become distinctive through Applicant’s substantially exclusive and continuous use of the same in commerce for at least the five years immediately before the date of this statement.
6. Accordingly, on January 8, 2016, Applicant filed U.S. Trademark Application Serial No. 86869172 to register on the Principal Register the word/design mark “HAWAIIAN CHIP COMPANY” (**Applicant’s Mark**) for “Potato chips made from sweet potatoes; Vegetable Chips” (**Applicant’s Goods**) in International Class 29.
7. Applicant’s Mark has been challenged herein by Opposer.
8. In addition to the foregoing marks, on January 14, 2014, Applicant was issued registration on the Principal Register for “HAWAIIAN CHIP COMPANY CAFE” (*USPTO Registration No. 4468026* with a date of first use in commerce of October 1, 2012), for “Grain-based snack foods” (**Applicant’s Café Mark**).
9. To date, Opposer has not challenged Applicant’s Café Mark.

10. Applicant has extensively and continuously used Applicant's Mark in commerce in connection with Applicant's Goods since January 1, 2000 (at latest), generating valuable goodwill as a result.

11. Applicant has continuously marketed, sold, and distributed Applicant's Goods in connection with Applicant's Mark, throughout Hawaii and beyond, through online, local, national and international vendors.

12. Since January 1, 2000 (at latest) Applicant has generated a well-known, respected, and valuable reputation in connection with "HAWAIIAN CHIP COMPANY" through substantial expenditures for marketing and licensing activities, and has maintained high quality in all its goods.

13. Opposer's Mark must be cancelled under 15 U.S.C. § 1115(b)(3) because, in connection with Opposer's Goods, the term "HAWAIIAN" is geographically descriptive and consumers are likely to believe that Opposer's Goods originate in the State of Hawaii.

14. Opposer's Goods do not originate in the State of Hawaii.

15. Opposer's Goods originate in the State of Washington and are not manufactured or produced in Hawaii.

16. Therefore, Opposer's Mark is geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act as applied to Opposer's Goods; "HAWAIIAN" is misdescriptive of the character, quality, function, composition or use of Opposer's Goods.

17. Purchasers are likely to believe that Opposer's Goods are composed of Hawaiian ingredients or possess Hawaiian characteristics.

18. The misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase Opposer's Goods.

19. Purchasers of Opposer's Goods pay a premium for a taste of Hawaii, a bite of paradise—the next best thing to a plane ticket—only to be deceived into buying but another product of the continental corporate conglomerate.

20. "HAWAIIAN" is deceptive under Section 2(a) of the Trademark Act and misleading as to the source of Opposer's Goods under 15 U.S.C. § 1115(b)(3).

21. If Opposer is permitted to retain registration of Opposer's Mark, and thereby the exclusive right to use "HAWAIIAN" in commerce in connection with Opposer's Goods, Opposer could inhibit competition in the marketplace and deceive consumers and damage Applicant, an *actual Hawaiian company*, that has expended considerable sums and effort in promoting its mark "HAWAIIAN CHIP COMPANY."

22. If Opposer is permitted to rely on and/or retain the registration of Opposer's Mark, a cloud will be placed on Applicant's title in and to its mark "HAWAIIAN CHIP COMPANY," and on its right to enjoy the free and exclusive use thereof in connection with the sale of Applicant's Goods, all to the damage and harm of Applicant.

23. Alternatively, Opposer's Mark is generic in that "HAWAIIAN" as used in connection with Opposer's Mark has become synonymous with the "Hawaiian" style of potatoes chips, a typically thicker-cut, bold-flavored chip, that either is, or simulates being, made of non-potatoe starches.

*Continued on next page*

The fee required by 37 C.F.R. § 2.6(a)(16) has been paid prior to the filing of this Amended Counterclaim for Cancellation.

WHEREFORE, Applicant respectfully requests the cancellation of U.S. Trademark Registration No. 3697408 for "HAWAIIAN" issued on October 20, 2009, pursuant to 15 U.S.C. § 1064 and § 1115.

DATED: Honolulu, Hawaii; March 27, 2017.

/s/ Benjamin M. Creps /s/ \_\_\_\_\_  
KEVIN W. HERRING  
BENJAMIN M. CREPS  
Attorneys for Applicant

**CERTIFICATE OF MAILING AND SERVICE**

I hereby certify that *Answer and Counterclaim* filed herein by HAWAIIAN CHIP COMPANY LLC on January 27, 2017, will be deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to:

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451;

and upon Opposer by causing a true and correct copy thereof to be sent via electronic email and subsequently deposited with the United States Postal Service with sufficient postage as First-class mail in an envelope addressed to:

Michael D. Fishman  
Fishman Steward PLLC  
[tmddocketing@fishsteward.com](mailto:tmddocketing@fishsteward.com)  
39533 Woodward Avenue, Suite 140  
Bloomfield Hills, MI 48304  
United States

DATED: Honolulu, Hawaii; March 27, 2017.

/s/ Benjamin M. Creps /s/

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