

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

BIRDS EYE FOODS LLC,)	
)	ANSWER TO NOTICE OF OPPOSITION;
Opposer,)	COUNTERCLAIM FOR
)	CANCELLATION; CERTIFICATE OF
v.)	SERVICE
)	
HAWAIIAN CHIP COMPANY LLC,)	Opposition No.
)	Application Serial No. 86869172
Applicant.)	Mark: HAWAIIAN CHIP COMPANY &
)	DESIGN

ANSWER TO NOTICE OF OPPOSITION

HAWAIIAN CHIP COMPANY LLC (**Applicant**), through its undersigned counsel, answers the Opposition filed herein by BIRDS EYE FOODS LLC (**Opposer**).

Regarding the first unnumbered paragraph of the Opposition, Applicant denies that Petitioner has been or will be damaged by Application Serial No. 86869172 (**Application**) and also denies that Applicant’s mark “HAWAIIAN CHIP COMPANY & DESIGN” (**Mark**) is likely to cause confusion with respect to Opposer’s mark, “HAWAIIAN” (*USPTO Registration No. 3697408*) (**Opposer Mark**).

Additionally, in the Counterclaim below, Applicant respectfully requests the Opposer Mark registration be cancelled based on Opposer’s deceptively misdescriptive use of the Opposer Mark.

Specifically, Applicant answers the Notice of Opposition as follows:

1. Paragraphs 1-3: Applicant has insufficient knowledge to be able to admit or deny such allegations, and therefore denies the allegations.



2. Paragraph 4: Applicant responds that the referenced registration (*Registration No. 3697408*) speaks for itself and Applicant denies the allegations to the extent they are legal conclusions.

3. Paragraph 5: Applicant admits that it seeks registration on the Principal Register of the mark “HAWAIIAN CHIP COMPANY & DESIGN” for “potato chips made from sweet potatoes; vegetable chips” in International Class 29, with January 1, 2000 as the first date of the mark’s use in commerce (at latest) and denies the remainder of the paragraph.

4. Paragraph 6: Applicant has insufficient knowledge to be able to admit or deny the allegations regarding Opposer’s use of the referenced mark, denies the allegations to the extent they are legal conclusions, and denies that Opposer acquired or otherwise possesses any distinctive rights in the word “HAWAIIAN.”

5. Paragraph 7: Applicant denies the allegations.

FIRST AFFIRMATIVE DEFENSE

6. Opposer does not have any title or any rights upon which the registration of the Application could place a cloud, and accordingly, Opposer will not be damaged or harmed by the registration of Application Serial No. 86869172.

SECOND AFFIRMATIVE DEFENSE

7. Opposer’s mark is geographically misdescriptive and misleading.

THIRD AFFIRMATIVE DEFENSE

8. One or more of Opposer’s claims fail to state a claim upon which relief may be granted.

FOURTH AFFIRMATIVE DEFENSE

9. There is no likelihood of confusion.

FIFTH AFFIRMATIVE DEFENSE

10. One or more of Opposer's claims are barred by the equitable defenses of laches, acquiescence, waiver, or estoppel.

SIXTH AFFIRMATIVE DEFENSE

11. Applicant hereby gives notice that it may rely on any other defenses that may become available or appear proper during discovery, and hereby reserves its right to amend this Answer to assert any such defenses.

REQUESTED RELIEF

Applicant requests that Opposer's Opposition be denied and that Application Serial No. 86869172 proceed to registration on the Principal register.

[Counterclaim on following page]

COUNTERCLAIM FOR CANCELLATION

HAWAIIAN CHIP COMPANY LLC, a Hawaii limited liability company, whose mailing address is 1928 Republican St., Honolulu, Hawaii 96819 (**Petitioner**), believes it has been and will be damaged by U.S. Trademark Registration No. 3697408 for "HAWAIIAN" (**Respondent'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 (**Respondent**), and hereby petitions to cancel Respondent's Mark. As grounds for the requested cancellation, Petitioner alleges as follows:

1. On October 29, 2008, Petitioner 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 (**Original Mark**).
2. On March 17, 2009, the Original Mark was registered on the supplemental register with a first use in commerce of January 1, 2000 and was issued Registration No. 3593,506.
3. Petitioner inadvertently did not file an acceptable declaration under Section 8 for the Original Mark.
4. The Original Mark has become distinctive through Petitioner's substantially exclusive and continuous use of the same in commerce for at least the five years immediately before the date of this statement.
5. Accordingly, on January 8, 2016, Petitioner filed U.S. Trademark Application Serial No. 86869172 to register on the Principal Register the word/design mark "HAWAIIAN CHIP COMPANY" (**Petitioner's Mark**) for "Potato chips made from sweet potatoes; Vegetable Chips" (**Petitioner's Goods**) in International Class 29.

6. Petitioner's Mark has been challenged herein by Respondent.
7. In addition to the foregoing marks, on January 14, 2014, Petitioner 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" (**Petitioner's Café Mark**).
8. To date, Respondent has not challenged Petitioner's Café Mark.
9. Petitioner has extensively and continuously used Petitioner's Mark in commerce in connection with Petitioner's Goods since January 1, 2000 (at latest), generating valuable goodwill as a result.
10. Petitioner has continuously marketed, sold, and distributed Petitioner's Goods in connection with Petitioner's Mark, throughout Hawaii and beyond, through online, local, national and international vendors.
11. Since January 1, 2000 (at latest) Petitioner 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.
12. The term "HAWAIIAN" is geographically descriptive and consumers are likely to believe that Respondent's Goods originate in the State of Hawaii.
13. Respondent's goods do not originate in the State of Hawaii.
14. Respondent's goods originate in the State of Washington and are not manufactured or produced in Hawaii.
15. Therefore, Respondent's Mark is geographically deceptively misdescriptive under Section 2(e)(3) of the Trademark Act as applied to Respondent's Goods.

16. "HAWAIIAN" is misdescriptive of the character, quality, function, composition or use of Respondent's Goods.

17. Purchasers are likely to believe that Respondent'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 Respondent's Goods.

19. Purchasers of Respondent'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.

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

22. If Respondent is permitted to rely on and/or retain the registration of Respondent's Mark, a cloud will be placed on Petitioner'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 Petitioner's Goods, all to the damage and harm of Petitioner.

The fee required by 37 C.F.R. § 2.6(a)(16) is being paid simultaneously with the filing of this petition.

WHEREFORE, Petitioner 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.

DATED: Honolulu, Hawaii; January 27, 2017.

/s/ Benjamin M. Creps /s/

KEVIN W. HERRING
BENJAMIN M. CREPS
Attorneys for Applicant

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

BIRDS EYE FOODS LLC,)	
)	CERTIFICATE OF MAILING AND
Opposer,)	SERVICE
)	
v.)	Opposition No.
)	Application Serial No. 86869172
HAWAIIAN CHIP COMPANY LLC,)	
)	Mark: HAWAIIAN CHIP COMPANY &
Applicant.)	DESIGN
)	
)	

CERTIFICATE OF MAILING

I hereby certify that *Answer and Counterclaim* filed herein by HAWAIIAN CHIP COMPANY LLC on January 27, 2017, is being 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

DATED: Honolulu, Hawaii; January 27, 2017.

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

CERTIFICATE OF SERVICE

I hereby certify that I served the *Answer and Counterclaim* filed herein by HAWAIIAN CHIP COMPANY LLC on January 27, 2017, upon Opposer by causing a true and correct copy thereof to be 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
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304
United States

DATED: Honolulu, Hawaii; January 27, 2017.

/s/ Benjamin M. Creps /s/

KEVIN W. HERRING
BENJAMIN M. CREPS
Attorneys for Applicant