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

Proceeding	91243216
Party	Defendant Kelly, Elijah F Kelly and Arlette K. Bright
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Attachments	Counterclaim for Cancellation - Final.pdf(96156 bytes)

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

GLORYBEE NATURAL SWEETNERS, INC.)
DBA GLORYBEE FOODS, INC.)
AN OREGON CORPORATION)
)
Opposer/Counter-Defendant)
)
v.)
)
ELIJAH F. KELLY, AN INDIVIDUAL AND)
ARLETTE K. BRIGHT, AN INDIVIDUAL)
)
Applicants/Counter-Plaintiffs)
_____)

Opposition No. 91243216

COUNTERCLAIM FOR CANCELLATION

Now come Applicants/Counter-Plaintiffs, Elijah F. Kelly and Arlette K. Bright (collectively, “Applicants”), and pursuant to section 313, et seq. of the TBMP, 15 U.S.C. §1064, and other applicable rules, hereby assert their Counterclaim for Cancellation of the trademarks of Opposer/Counter-Defendant, Glorybee Natural Sweeteners, Inc., t/a Glorybee Foods Inc. (“Glorybee” or “Opposer”), and state as follows:

1. Opposer is an Oregon Corporation having its principal place of business in Oregon.
2. Applicants are legal adults residing in Maryland. They have standing to pursue this Counterclaim for Cancellation against Opposer, because continued registration of Opposer’s marks will cause damage and harm to Applicants.

3. This tribunal has subject matter jurisdiction over this case, including this Counterclaim; and has personal jurisdiction over the parties. Venue is proper in this tribunal, in regard to the matters at issue in this Counterclaim.

4. Opposer has filed its Opposition in this case, opposing the registration of Applicants' "Save the BayBees" trademark.

5. Opposer opposes Applicants' trademark and seeks denial of registration of Applicants' mark on the ground that, there is a likelihood of confusion among consumers between Applicants' trademark and Opposer's previously-registered "Save the Bee" (standard characters) trademark, Reg. No. 5,195,355 and its "Save the Bee" design mark, Reg. No. 4,695,164, and that Opposer will be harmed as a result of such confusion.

6. Applicants' have denied Opposer's allegations and claims in this regard.

7. Through this Counterclaim, in further defense of the Opposition, Applicants seek (and petition for) cancellation of Opposers' marks, on grounds that the phrase "save the bee" is generic, lacks distinctiveness, and is widely used in many contexts, including consumer products.

8. Applicants' recent Google searches of the phrases "save the bee" and "save the bees" yielded over four million (4,000,000) results, including use of the phrases (one or both): by Greenpeace for its campaign to protect honey bees; by the Sierra Foundation for a similar initiative; by the Organic Consumers Association; by Nectar sunglasses in connection with the sale of its products; by Moon Valley Organics; by Cascadian Farm on its organic food packaging; by Patagonia in connection with its "Patagonia Provisions" food products; by many other manufacturers of food products containing honey; on a wide variety of clothing and apparel and accessories; in publications; by educational institutions; by bee-keeping vendors and suppliers (e.g. Crown Bees); by the Honeybee Conservancy; by the New York Bee Sanctuary; in

connection with special events; etc. The decline of the honey bee population in the United States is a widely known problem and area of ecological and environmental concern, receiving attention for many years from environmental advocates, scientists, the agriculture industry, governments at the State and local level in particular, educational institutions, and public interest groups. Accordingly, the phrases “save the bee” and “save the bees” are and have been for many years in wide use by all such persons and organizations, in connection with products, programs, events, initiatives, etc. They are widely and commonly used, lack distinctiveness, and are generic.

9. In contrast, a recent Google search by Applicants of their trademarked phrase “Save the BayBees” yielded only nine (9) results, one of which was Applicants’ trademark application, and another of which was Applicants’ trademark itself. The other seven (7) search results had nothing whatsoever to do with honey bees.

10. It is Applicants’ position that the phrase “save the bee” (like “save the bees”) is generic and merely descriptive in nature, lacks distinctiveness, is and has been widely used by thousands of organizations and companies, and should not have trademark protection, either as used in Opposer’s design mark or as a standard character mark. It is Applicants’ position that Opposer’s “save the bee” trademarks as referenced above and in their Notice of Opposition should be cancelled and therefore cannot properly form the basis for any opposition to the registration of Applicants’ distinctive “Save the BayBees” trademark.

11. “It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use

the mark in the sale of goods or services.” *Sengoku Works Ltd. v. RMC Int’l. Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996).

12. The words “save the bee” and “save the bees” were in prior use, extensively, long before Opposer used the phrase and long before registration of Opposer’s design and standard character “save the bee” marks.

13. Opposer’s trademarks do not have and have not acquired “secondary meaning.”

WHEREFORE, Applicants/Counter-Plaintiffs request that Opposer’s above-referenced trademarks be deemed generic and merely descriptive in nature, that they be deemed to lack distinctiveness, that they be deemed invalid based on prior use by others, that they be cancelled by this tribunal pursuant to 15 U.S.C. §1064, that Opposer’s Opposition be denied and dismissed based on cancellation of its marks, and that Applicant/Counter-Plaintiffs be awarded such other and further relief as may be appropriate.

Date: January 28, 2019

Respectfully submitted,

AYRES, JENKINS, GORDY &
ALMAND, P.A.

/s/ Bruce F. Bright
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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing Counterclaim for Cancellation is being served on Opposer on January 28, 2019 via e-mail to counsel for Opposer as follows: ian@dascenzioplw.com.

_____/s/ Bruce F. Bright_____
Bruce F. Bright