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

Proceeding	91267455
Party	Defendant Albert Uster Imports, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 88/828,983

Published in the *Official Gazette* October 6, 2020

A. SAMBADO & SON, INC.

Opposition No. 91267455

Opposer

ALBERT USTER IMPORTS, INC.

Applicant

APPLICANT'S ANSWER

TO NOTICE OF OPPOSITION AND AFFIRMATIVE PLEADINGS

Applicant, Albert Uster Imports, Inc. (“Applicant”), for its answer to the Notice of Opposition filed by A. Sambado & Son, Inc. (“Opposer”) against application for registration of Albert Uster’s trademark Serial No. 88/828,983 (“FRUTTA PRIMA Mark”), filed March 10, 2020, and published in the Official Gazette of October 6, 2020, pleads and avers as follows:

1. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 1, and therefore, denies the same.
2. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 2, and therefore, denies the same.
3. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 3, and therefore, denies the same.

4. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 4, and therefore, denies the same.

5. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 5, and therefore, denies the same.

6. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 6, and therefore, denies the same.

7. Applicant makes no answer to the allegations of ¶ 7 to the extent those allegations state legal conclusions rather than facts. As to any other factual allegations contained in ¶ 7, Applicant is without sufficient knowledge or information to admit or deny the allegations, and therefore, denies the same.

8. Applicant admits that it seeks to register the FRUTTA PRIMA Mark shown in U.S. Application Serial No. 88/828,983. Applicant denies that the FRUTTA PRIMA Mark is identical to the Opposer's marks. Applicant is without sufficient knowledge or information to admit or deny the remaining allegations of ¶ 8, and therefore, denies the same.

9. Applicant admits that it seeks to register the FRUTTA PRIMA Mark shown in U.S. Application Serial No. 88/828,983, that mark intended to be used for the goods recited within the respective application. Applicant admits that it has not sought the consent or permission of Opposer, as none is required. Applicant is without sufficient knowledge or information to admit or deny the remaining allegations of ¶ 9, and therefore, denies the same

10. Applicant admits the allegations set forth in ¶ 10.

11. Applicant is without sufficient knowledge or information to admit or deny the allegations of ¶ 11, and therefore, denies the same.

12. Applicant denies that its FRUTTA PRIMA Mark is likely to cause confusion, to cause mistake, or to deceive. Applicant denies that its FRUTTA PRIMA Mark conveys the same commercial impression as Opposer's alleged marks. Applicant makes no answer to the allegations of ¶ 12 to the extent those allegations state legal conclusions rather than facts.

13. Applicant denies that registration of its FRUTTA PRIMA Mark is likely to cause confusion, deception and/or mistake among the relevant public. Applicant is without sufficient knowledge or information to admit or deny the remaining allegations of ¶ 13, and therefore, denies the same. Applicant denies that the relevant purchasing public is likely to be confused as to whether the goods bearing the FRUTTA PRIMA Mark emanate from or are in some way approved, licensed, sponsored by, or otherwise connected or affiliated with the Opposer and the Opposer's goods. Applicant is without sufficient knowledge or information to admit or deny the remaining allegations set forth in ¶ 13 and, therefore, denies the same.

14. Applicant denies that Opposer will be damaged or injured by the registration and use of the FRUTTA PRIMA Mark or that Opposer is entitled to any relief requested in the Notice of Opposition. Applicant is without sufficient knowledge or information to admit or deny the remaining allegations of ¶ 14, and therefore, denies the same.

15. Applicant denies that Opposer will be damaged by the registration and use of the FRUTTA PRIMA Mark or that Opposer is entitled to any relief requested in the Notice of Opposition. Applicant is without sufficient knowledge or information to admit or deny the remaining allegations of ¶ 15, and therefore, denies the same.

16. Applicant denies that Opposer will be damaged by the registration and use of the FRUTTA PRIMA Mark or that Opposer is entitled to any relief requested in the Notice of

Opposition. Applicant is without sufficient knowledge or information sufficient to admit or deny the remaining allegations of ¶ 16, and therefore, denies the same.

17. Applicant hereby incorporates its Answers to paragraphs 15 and 16, as set for above, in response to ¶ 17.

FURTHER ANSWER AND AFFIRMATIVE PLEADINGS

First Affirmative Pleading

Applicant denies each and every allegation in the Notice of Opposition except as specifically admitted in this Answer.

Second Affirmative Pleading

Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

Third Affirmative Pleading

There is no likelihood of confusion, mistake, or deception because, *inter alia*, the FRUTTA PRIMA Mark and the alleged trademark of Opposer are not confusingly similar.

Fourth Affirmative Pleading

Applicant's use and registration of the FRUTTA PRIMA Mark as specified in the application will not result in any confusion or likelihood of confusion to the detriment of Opposer. Applicant's FRUTTA PRIMA Mark and the alleged trademark of Opposer are visually distinctive and invoke vastly different images in the average consumer's mind. The Applicant's FRUTTA PRIMA mark is commercially distinguishable from Opposer's in its overall impression. Applicant's FRUTTA PRIMA Mark contains both pictorial and graphic elements paired with a stylized script font that consumers view as a whole when encountering the mark. Neither of Applicant's alleged marks include any pictorial or graphic element. Instead,

Opposer's marks simply include the words "PRIMA FRUTTA" in plain text font or a simple script font.

Fifth Affirmative Pleading

Opposer's registration and common law rights, if any, are entitled to a very narrow scope of protection because there are many FRUTTA and PRIMA formative marks that have been registered by other third-parties in Classes 29, 30, and 31 and the registrations coexist on the register, and the coexisting registrations cover similar goods. Additionally, Opposer's registered "PRIMA FRUTTA" mark coexists in actual use with the uses of many third parties, each using the mark FRUTTA, PRIMA or a FRUTTA, PRIMA -formative mark, for similar goods.

Sixth Affirmative Pleading

There is no likelihood of confusion, mistake, or deception as to the goods' source because Applicant's goods are not related or marketed in a way that would confuse consumers as to their source. Applicant's FRUTTA PRIMA Mark does not cover goods in the same class as the Opposer's and the goods travel through different channels of trade.

Seventh Affirmative Pleading

Applicant's customers are sophisticated culinary arts professionals who are likely to exercise a high degree of care and can distinguish between similar FRUTTA or PRIMA marks.

Eighth Affirmative Pleading

As a result of Applicant's continuous use of the FRUTTA PRIMA Mark since the time of Applicant's adoption thereof, the FRUTTA PRIMA Mark has developed significant goodwill among the consuming public and consumer acceptance of the goods offered by Applicant in conjunction with the FRUTTA PRIMA Mark. Such goodwill and widespread usage have caused

the FRUTTA PRIMA Mark to acquire distinctiveness with respect to Applicant and caused the FRUTTA PRIMA Mark to become a valuable asset of Applicant.

Ninth Affirmative Pleading

Applicant's FRUTTA PRIMA Mark and Opposer's marks have coexisted in the marketplace for almost 20 years with no evidence of actual confusion. Granting registration to Applicant will have no impact on the use of the mark in commerce and will not cause any damage to Opposer.

Tenth Affirmative Pleading

Opposer's claims are barred under the doctrines of waiver, laches, and/or acquiescence. Applicant reserves the right to assert additional affirmative defenses as they may become known through the process of discovery or otherwise in this proceeding.

WHEREFORE, Applicant prays as follows:

- (a) this opposition be dismissed in its entirety; and
- (b) Application Serial No. 88/828,983 be allowed to proceed to registration.

Respectfully Submitted,

ALBERT USTER IMPORTS, INC.

By: /s/ Kristen S. Ruisi

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Dated this 15th day of March 2021

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that the foregoing Answer is being transmitted electronically to the United States Patent and Trademark Office's Trademark Trial and Appeal Board on March 15, 2021.

By: /s/ Kristen S. Ruisi

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record including, without limitation, by email to trademarks@dirksenlaw.com , at Thomas A. Dirksen Law, 4607 Lakeview CANYON Rd., Suite 117, Westlake Village, California 91361, on this 15th day of March 2021.

By: /s/ Kristen S. Ruisi

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