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Filing date: **04/25/2022**

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

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|------------------------|---|
| Proceeding no. | 91275073 |
| Party | Defendant Lord and Mann LLC |
| Correspondence address | BRYAN D. PEROFF PEROFF SAUNDERS P.C. 745 5TH AVENUE, SUITE 500 NEW YORK, NY 10151 UNITED STATES Primary email: docket@peroffsaunders.com Secondary email(s): 5ae154a03+matter1372738981@maildrop.clio.com 646-898-2030 |
| Submission | Answer and Counterclaim |
| Filer's name | Bryan Peroff |
| Filer's email | bperoff@peroffsaunders.com, docket@peroffsaunders.com, 5ae154a03+matter1415548577@maildrop.clio.com |
| Signature | /BDP/ |
| Date | 04/25/2022 |
| Attachments | ROYAL v ROYAL NUTS_Answer and CC.pdf(97833 bytes) |

Registration subject to the submission

| | | | |
|------------------|--|-------------------|------------|
| Registration no. | 4203136 | Registration date | 09/04/2012 |
| Register | Principal | | |
| Registrant | LT Overseas North America, Inc. 11130 WARLAND DRIVE CYPRESS, CA 90630 UNITED STATES | | |

Goods/services subject to the submission

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| <p>Class 030. First Use: Dec 6, 1989 First Use In Commerce: Dec 6, 1989 Requested goods and services in the class: [Coffee, tea, cocoa, sugar,] rice, [tapioca, sago, artificial coffee;] flour; preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice [; bread, pastry; confectionery, namely, chocolates, candies, gumdrops,mints, caramels, toffees, chewing gum, frozen confectionery; ices, honey, treacle; yeast;] [baking powder;] [salt, mustard; vinegar, condiments, namely, sauces; spices; ice]</p> |
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Grounds for cancellation

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| Abandonment | Trademark Act Section 14(3) |
| Mark never used in commerce | Trademark Act Section 14(6) |
| Fraud on the USPTO | Trademark Act Section 14(3); In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) |

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

LT OVERSEAS NORTH AMERICA, INC.,

Opposer,

v.

LORD AND MANN LLC,

Applicant.

Opposition No. 91275073

Serial No. 90/554,628

Mark: ROYAL NUTS

**ANSWER TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES AND
COUNTERCLAIM**

1. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in paragraph 1 of the Notice of Opposition, and therefore denies them.

2. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in paragraph 2 of the Notice of Opposition, and therefore denies them

3. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in paragraph 3 of the Notice of Opposition, and therefore denies them.

4. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in paragraph 4 of the Notice of Opposition, and therefore denies them.

5. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in paragraph 5 of the Notice of Opposition, and therefore denies them.

6. Applicant lacks knowledge or information sufficient to form a belief as to the allegations in paragraph 6 of the Notice of Opposition, and therefore denies them.

7. Applicant denies the allegations in paragraph 7 of the Notice of Opposition.

8. Applicant admits that the filing dates of Opposer's registrations preceded the filing date of Applicant's application.

9. Applicant denies the allegations in paragraph 9 of the Notice of Opposition.

10. Applicant admits the allegations in paragraph 10 of the Notice of Opposition.
11. Applicant denies the allegations in paragraph 11 of the Notice of Opposition.
12. Applicant denies the allegations in paragraph 12 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

13. All or part of Opposer's pleaded registrations are invalid and unenforceable because, in claiming use of the marks for goods for which Opposer had not actually used the marks, Opposer committed fraud on the Trademark Office.

14. All or part of Opposer's pleaded registrations are invalid and unenforceable because Opposer has abandoned use of the marks on some or all of the goods or services in the registrations without a bona fide intent to use or resume use of the ROYAL Mark.

15. All or part of Opposer's pleaded registrations are invalid and unenforceable because, at the time of filing, Opposer lacked a bona fide intent to use the applied-for marks on some or all of the goods claimed in the application.

16. All or part of Opposer's pleaded registrations are invalid and unenforceable because of unclean hands in its dealings with the Trademark Office.

17. All or part of Opposer's pleaded registrations are invalid and unenforceable because Opposer had not used the mark on some or all of the goods listed in the registration at the time it filed verified Statements of Use with the USPTO.

18. The Opposition should be dismissed because there is no likelihood of confusion between the pleaded registrations and the applied-for mark when each is used in connection with the goods claimed.

19. The Opposition should be dismissed for failure to state a claim upon which relief can be granted.

20. The Notice of Opposition should be dismissed because Opposer will not be damaged by registration of the applied-for mark.

**COUNTERCLAIMS FOR CANCELLATION BASED ON NON-USE, ABANDONMENT
AND FRAUD ON THE USPTO**

Applicant believes that it is and will be damaged by the continued presence on the Principal Register of U.S. Trademark Registration Nos. 4,203,136 (the “ROYAL Mark Registration”) owned by Opposer and hereby petitions to cancel said Registration under the provisions of Section 14 of the Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1064.

As grounds for its Counterclaim, Applicant/Petitioner alleges the following:

1. Opposer/Registrant owns U.S. trademark registration no. 4,203,136 for ROYAL (the “ROYAL Mark”) covering “rice, flour, preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice” in International Class 30.

2. As the subject of this Opposition proceeding, Applicant/Petitioner owns pending federal U.S. trademark application for the word mark “ROYAL NUTS” (the “ROYAL NUTS Mark”), which was filed with the United States Patent and Trademark Office (the “USPTO”) on March 2, 2021, for “roasted nuts; processed nuts; platters consisting of roasted and processed nuts; platters consisting primarily of roasted and processed nuts and other snacks including candy and chocolates” in International Class 29.

3. Applicant/Petitioner files this Counterclaim seeking cancelation of the ROYAL Mark because, upon information and belief and as set forth below, Opposer/Registrant (1) has not used the ROYAL Mark in connection with all of the goods listed in the ROYAL Mark registration, (2) has abandoned its registration for the ROYAL Mark, and (3) has committed fraud on the USPTO by knowingly and falsely claiming commercial use of the ROYAL Mark for certain goods listed in its ROYAL Mark registration, including, “flour” and “preparations made from cereals, namely, corn flour, whole grain oat, corn bran, rice”.

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Non-Use, Abandonment, and Fraud on the USPTO

4. Upon information and belief, based on an internet search and review of Opposer's/Registrant's website, Opposer/Registrant is not using, and has not used in commerce, the ROYAL Mark in connection with all of the goods listed in the ROYAL Mark registrations.

5. Upon information and belief, Opposer/Registrant has not used or has discontinued use of the ROYAL Mark for some of the goods listed in its ROYAL Mark registrations and has no intent to use or resume such use in the United States.

6. Registrant has abandoned the ROYAL Mark within the meaning of Section 45 of the Lanham Act, 15 U.S.C. § 1127, because of Registrant's non-use of the ROYAL Mark in connection with the goods listed in the Registration with no intent to resume such use of the ROYAL Mark.

7. Because Registrant has abandoned its registration of the ROYAL Mark, the Registration is subject to cancellation under Section 14 of the Lanham Act, 15 U.S.C. § 1064.

8. Applicant/Petitioner has been and will be harmed by the continued registration of the ROYAL Mark in that Applicant/Petitioner is using the ROYAL NUTS Mark in commerce in connection with gift food baskets primarily consisting of nuts, candies and chocolates, and Applicant/Petitioner may file additional applications for related goods and services incorporating the words "ROYAL NUTS" which may face similar rejections by the PTO.

9. If Opposer/Registrant is permitted to maintain the ROYAL Mark registration and retain such rights as conferred under the Principal Register of the Lanham Act, Opposer/Registrant will retain unlawful gain and advantage to which Opposer/Registrant is not entitled under the Lanham Act, to the detriment and harm of Applicant/Petitioner, including impairment and injury to Petitioner's rights and filings in and to the ROYAL NUTS Mark.

10. Upon information and belief, Opposer/Registrant committed fraud on the USPTO when it submitted verified statements alleging commercial use of the ROYAL Mark for all of the

goods listed in its trademark applications, registrations and Section 8 & 15 Declarations of Use and Incontestability for each of the ROYAL registrations.

11. By reason of the foregoing, Applicant/Petitioner believes that it is now and will be damaged by the continued presence on the Principal Register of Registration No. 4,203,136 for the ROYAL Mark.

WHEREFORE, Petitioner respectfully requests the Board to sustain this Counterclaim in Opposer/Petitioner's favor and cancel Registration No. 4,203,136.

Dated: April 25, 2022

Respectfully submitted,

PEROFF SAUNDERS, P.C.

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that a copy of the foregoing **ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM** was electronically submitted via ESTTA in accordance with TBMP § 310.01.

/Jill Ippolito/
Jill Ippolito