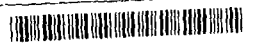


TTAB

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



American Italian Pasta Company)
)
Petitioner,)
)
v.)
)
Homestead, Inc. & New World Pasta)
Company)
)
Respondent)
)
)

Cancellation No. 26,165
Opposition No. 107,599
Opposition No. 110,644

01-21-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #72

I hereby certify that this document is being deposited
with the United States Postal Service as first class mail
in an envelope addressed to the Assistant Commissioner
for Trademarks Box TTAB
2900 Crystal Drive, Arlington, VA 22202-3513, on this
Friday day of January, 2003.
HOVEY WILLIAMS LLP
By [Signature]

BRIEF AS RESPONDENT IN THE COUNTERCLAIMS AND
REPLY BRIEF AS PETITIONER

HOVEY WILLIAMS LLP
Thomas H. Van Hoozer, Reg. No. 32,761
Leslie L. Lawson, Reg. No. P-53,185
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108
Telephone (816) 474-9050

ATTORNEYS FOR PETITIONER

Cal

TABLE OF CONTENTS

I. INTRODUCTION 1

II. PETITIONER’S REPLY TO RESPONDENT’S BRIEF 4

 A. Petitioner has Met the Burden of Proof Required to Demonstrate a Likelihood of Confusion between Petitioner’s Marks and Respondent’s Marks 3

 B. Petitioner’s Marks are Strong and Long Established and thus entitled to a Broader Scope of Protection 6

 C. Doctrine of Foreign Equivalents as Applied to the Issue of Likelihood of Confusion 8

 D. No Evidence of Action Confusion or Intent is required to Demonstrate a Likelihood of Confusion 10

III. COUNTERCLAIMS 12

IV. CONCLUSION 15

TABLE OF AUTHORITIES

Cases

Century 21 Real Estate Corp. v. Century Life of American, 23 USPQ2d 1698 (Fed. Cir. 1992) . 4

Cunningham v. Laser Golf Corporation, 55 USPQ2d 1842 (Fed. Cir. 2000) 4, 12

Federated Foods, Inc. v. Fort Howard Paper Co., 192 USPQ 24 (CCPA 1976) 4

Food Specialty Co., Inc. v. Standard Products Company, Inc. 161 Corp. v. 9

Hasbro, Inc. v. Mattel, Inc., 2002 TTAB LEXIS 272 (TTAB 2002) 10

Hewlett-Packard Company v. Packard Press, Inc., 62USPQ2d 1001 (Fed. Cir. 2002) 4

In re Shell Oil Co., 26 USPQ2d 1687 (Fed. Cir. 1993) 4

In re The Total Quality Group, Inc., 51 USPQ2d 1474 (TTAB 1999) 8

In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939 (TTAB 1993) 6

In re Decombe, 9 USPQ2d 1813, 1814n.2 (TTAB 1988) 6

In re Bissett-Berman Corp., 177 USPQ 528 (CCPA 1973) 12

McDonald’s Corp. v. McClaim, 37 USPQ2d 1274 (TTAB 1995) 11

Massey Junior College, Inc. v. Fashion Institute of Technology, 181 USPQ 272 (CCPA 1974) . 3

Marcas Paper Mills Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981) 6

Miguel Torres S.A. V. Cas Vinicola Gerardo Cesarie S.R.L., 49 USPQ2d 2018 (TTAB 1998) . .
. 9, 10

Myrurgia, S.A. v. Comptoir de La Parfumerie S.A. Ancienne Maison Tschanz,
169 USPQ 587 (CCPA 1971) 9

Niblick Pty. Ltd. v. Kriton Golf Corp., 2001 WL 208762 (TTAB 2001) 5

Octocom Systems Inc. v. Houston Computers Services Inc., 16 USPQ2d 1783 (Fed. Cir. 1990) 5
Seabrook Foods, Inc. v. Barwell Foods Ltd., 192 U.S.P.Q. 797 (TTAB 1976) 11
TBC Corp. v. Holsa, Inc., 44 USPQ2d 1315 (Fed. Cir. 1997) 4

Other Authorities

J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR
COMPETITION § 23:63 (2002) 4
J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR
COMPETITION § 23:36 (2002) 9

TAB

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

American Italian Pasta Company)
(by substitution from Gooch Foods, Inc.))

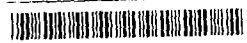
Petitioner,)

v.)

Homestead, Inc. & New World Pasta)
Company)

Respondent)

Cancellation No. 26,165
Opposition No. 107,599
Opposition No. 110,644



01-21-2003

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #72

**BRIEF AS RESPONDENT IN THE COUNTERCLAIMS AND REPLY BRIEF AS
PETITIONER**

I. INTRODUCTION

This brief is submitted on behalf of American Italian Pasta Company as Respondent in the Counterclaims asserted by Homestead, Inc. & New World Pasta Company and as Petitioner/Opposer in reply to the brief submitted by Homestead, Inc. & New World Pasta Company. In the interest of clarity and consistency, American Italian Pasta Company is referred to hereinafter as "Petitioner" and Homestead Inc. & New World Pasta Company is referred to hereinafter as "Respondent."

As stated in Petitioner's brief, American Italian Pasta Company has recently acquired all interest in the pleaded registrations by assignment from Gooch Foods, Inc., the original petitioner in these proceedings. Gooch Foods, Inc. is a wholly-owned subsidiary of Archer-Daniels-Midland Company. Interests of the pleaded registrations were owned solely by the subsidiary, Gooch Foods, Inc. and were

Co

acquired by American Italian Pasta Company through written assignment executed September 30, 2002 from Gooch Foods, Inc. This assignment was submitted to the Trademark Office for recordation on October 4, 2002 and a motion for substitution of parties was filed concurrently with Petitioner's main brief.

Appropriate discovery was undertaken by the parties, but none of the results of discovery have been placed in evidence pursuant to Rule 2.120(3)(i). Therefore, the only evidence in connection with these proceedings are the pleadings and the registrations and applications identified below.

Respondent's Registration and Applications (referred to hereinafter as Respondent's "LA BELLA ROSA marks"):

Mark	Reg. No./ Serial No.	Goods	Filing Date
LA BELLA ROSA BRAND & Design	1,818,079	dry pasta	October 28, 1998
LA BELLA ROSA & Design	75/194,595	dry pasta	November 7, 1996
LA BELLA ROSA	75/368,367	dry pasta	October 6, 1997

Petitioner's Registrations (referred to hereinafter as Petitioner's "LA ROSA marks"):

Mark	Reg. No.	Goods	Filing Date
LA ROSA & Design	313,418	alimentary paste products	January 20, 1934
LA ROSA & Design	389,868	butter, macaroni products, noodles and pastina, a macaroni product cut up in small fanciful shapes	December 26, 1940
LA ROSA (STYLIZED)	623,193	alimentary pastes, pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meat balls in sauce, and sausage links with sauce	February 28, 1955

LA ROSA & Design	651,541	alimentary pastes, pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, and cheese ravioli in sauce, meat balls in sauce, sausage links with sauce, and canned soups	December 17, 1956
LA ROSA & Design	1,390,117	spaghetti, lasagna, macaroni, noodles and bread crumbs	June 5, 1985
LA ROSA	1,396,003	alimentary pastes and bread crumbs	August 28, 1985

II. PETITIONER'S REPLY TO RESPONDENT'S BRIEF

A. Petitioner has Met the Burden of Proof Required to Demonstrate a Likelihood of Confusion between Petitioner's Marks and Respondent's Marks.

In these proceedings, Petitioner has requested that the Board sustain a cancellation and two oppositions of Respondent's LA BELLA ROSA marks based on a likelihood of confusion with Petitioner's LA ROSA marks. In support of its request, Petitioner outlined and discussed all the DuPont factors which are in evidence and thus relevant to the present case. Petitioner has demonstrated by a preponderance of the evidence of record in this case that a likelihood of confusion exists between Petitioner's LA ROSA marks and Respondent's LA BELLA ROSA marks.

The standard required to prove a likelihood of confusion in a cancellation or opposition is a "preponderance of the evidence." Massey Junior College, Inc. v. Fashion Institute of Technology, 181 USPQ 272, 274 (CCPA 1974). However, any doubts about the likelihood of confusion between the marks is construed against the newcomer because the newcomer has the opportunity and obligation to

avoid confusion with existing marks. Id. In re Shell Oil Co., 26 USPQ2d 1687, 1691 (Fed. Cir. 1993). Petitioner's mark need not be famous for doubt to be construed against the Respondent. The "rule of doubt" applies to all opposition and cancellation proceedings and is given added weight when the senior user's mark is strong and long established. TBC Corp. v. Holsa, Inc., 44 USPQ2d 1315, 1318 (Fed Cir 1997). See also J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23:63 (2002).

In determining a likelihood of confusion, it is well established that not all of the DuPont factors may be relevant in value or given equal weight by the court in any given case. In re Dixie Rests, Inc., 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). Only factors relevant to the likelihood of confusion issue and addressed by the evidence in the record must be considered. Cunningham v. Laser Golf Corporation, 55 USPQ2d 1842, 1845 (Fed. Cir. 2000). Moreover, it is well established that the Board may focus on two key factors such as similarities between the marks and the similarities between the goods. Hewlett-Packard Company v. Packard Press, Inc., 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); Federated Foods, Inc. v. Fort Howard Paper Co., 192 USPQ 24 (CCPA 1976). When marks appear on virtually identical goods or services, the degree of similarity necessary to support a finding of a likelihood confusion declines. See Century 21 Real Estate Corp. v. Century Life of America, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In the present case, Petitioner has demonstrated by a preponderance of the evidence submitted that there is a likelihood of confusion between its LA ROSA marks and Respondent's LA BELLA ROSA marks. It can be seen from the registrations and applications of the present case that the goods identified in both Petitioner's registrations and Respondent's registration and applications are essentially identical, pasta and related products. It can also be seen by the pleaded registrations and applications, that the

Petitioner's LA ROSA marks and Respondent's LA BELLA ROSA marks are sufficiently similar in sight, sound, connotation and commercial impression as to create a likelihood of confusion. Respondent's brief does not contest the essential identity of the goods.

In addition to the similarity of the marks and goods, Petitioner has presented evidence of other DuPont factors. For example, by the mere fact that the goods are identical, the presumption is that similar channels of trade would be utilized. Moreover, because neither Petitioner's registration or the opposed applications and registrations of Respondent are restricted by channels of trade, it would be error to consider any distinction in channels of trade. Octocom Systems Inc. v. Houston Computers Services Inc., 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). These identical goods would be sold under the same conditions to the same consumers. Petitioner has also asserted that the mark can be presumed to be famous because Petitioner's mark has been in the marketplace for nearly seventy (70) years. In this brief, Respondent has repeatedly stated that Petitioner has referred to evidence not of record. In response to Respondent's improper accusation, Petitioner submits that it can be seen from the face of its pleaded registration, Reg. No. 313,418 that Petitioner's mark was first used on January 20, 1934, the filing date of the registration and that such long use would indicate fame or at least strength.

While the only evidence of record in this proceeding are the pleaded registrations, this Board is not precluded from determining a likelihood of confusion based solely on such evidence. See Niblick Pty. Ltd. v. Kriton Golf Corp., 2001 WL 208762 (TTAB 2001). For example, the Board held there to be a likelihood of confusion between the registered mark NIBLICK for "sports clothing, namely shirts, jackets, pants, rainwear and caps, footwear and golf shoes" and the mark NIB LOCK for "golfing accessories, namely, golf club locks and golf bag locks" based solely of the pleaded registration and the file of the

involved application. Id.

B. Petitioner's Marks are Strong and Long Established and thus entitled to a Broader Scope of Protection.

Respondent improperly asserts in its brief that Petitioner's LA ROSA marks are weak and as such entitled only to limited protection because Petitioner's mark LA ROSA is a surname and because it has a descriptive connotation as applied to Petitioner's pasta products. Respondent, however, has made no offer of evidence to support either assertion, but instead of presenting proper evidence, improperly requests that the Board take judicial notice of both statements. Furthermore, Respondent has improperly based most of its arguments on this contention.

First, Respondent improperly requested that the Board take judicial notice that LA ROSA is merely a surname. The Board may take judicial notice of facts which are not subject to reasonable dispute and which are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. FRE 201. Thus, the Board generally takes judicial notice of only definitions in dictionaries of the English language and in generally recognized technical trade dictionaries. See In re Decombe, 9 USPQ2d, 1813, 1814 n. 2 (TTAB 1988) (citing Marcal Paper Mills Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981)). In order for the board to take judicial notice of a reference, the reference must also be cited. Id.

Whether a mark is primarily merely a surname is subject to reasonable dispute and is not readily determined by sources whose accuracy cannot reasonably be questioned because such a fact cannot be determined from a generally recognized dictionary. Several sources are usually required. For example in the case, In re Hamilton Pharmaceuticals Ltd., 27 USPQ2d 1939, 1940 (TTAB 1993), the Board looked

to evidence such as telephone directories and verifiable resources that rank the commonality of surnames. Id. Moreover, determining whether a term is primarily merely a surname must be resolved on a case by case basis. Id. Absent proof, Respondent cannot merely argue that the mark is a surname and thus weak.

Contrary to Respondent's assertions, the evidence of record in the proceeding demonstrates that Petitioner's marks are strong and long established. Petitioner has acquired six registrations for the mark LA ROSA, all of which are incontestible. Petitioner's first registration was acquired in 1934, thus showing nearly seventy (70) years of use. Furthermore, none of Petitioner's registrations have been obtained through a showing of acquired distinctiveness under Section 2(f) of the Lanham Act, thus demonstrating on the face of the registrations that the LA ROSA marks at issue are not merely a surname. As to any meaning of the Petitioner's marks, the registrations of record, Reg. Nos. 623,193, 651,541, 1,390,117 and 1,396,003 clearly show on the face of the registration that the mark "LA ROSA" means "the rose" in English. Therefore, no other assignment of meaning to the mark would be proper without additional evidence in support.

Respondent has also improperly asserted that Petitioner's marks have a descriptive connotation as applied to Petitioner's pasta products and again improperly requests that the Board take judicial notice that the term "rosa" is a descriptive term used to refer to a type of pasta sauce. In support of such an assertion, Respondent states that an "internet search for the term "rosa sauce" produces hundreds of recipes and menus featuring a rosa sauce" (Respondent's Brief at 5, n. 6.).

Again, the Board may take judicial notice of the facts that are not subject to reasonable dispute and which are capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. FRE 201. Whether a term "rosa" is descriptive of a type of pasta sauce is

subject to reasonable dispute and is not readily determined by sources whose accuracy cannot reasonably be questioned.

Respondent has not made the results of its internet search available as evidence in these proceedings, thus the Board would be unable to determine their reliability. Generally, the Board will not take judicial notice of definitions found only in an online dictionary and not available in printed format, when offered for the first time on appeal. In re The Total Quality Group, Inc., 51 USPQ2d 1474, 1476 (TTAB 1999). In the present situation, however, Respondent is not even requesting the Board take judicial notice of an online dictionary, but is making a bald assertion that such proof exists by alluding to an unverifiable search of the internet not of record.

Contrary to Respondent's assertions, the only meaning which can be accorded to Petitioner's mark is the meaning set forth in evidence. The registrations clearly show that Petitioner's LA ROSA marks, mean "the rose" in English. As such, Petitioner's LA ROSA marks are a unique and arbitrary designation for the goods set forth in the registrations, namely pasta and related products. When the Board disregards Respondent's improper requests and looks to the evidence of record, it is clear that Petitioner's marks are strong and long established.

C. Doctrine of Foreign Equivalents as Applied to the Issue of Likelihood of Confusion.

The doctrine of foreign equivalents is usually applicable to resolve a claim of likelihood of confusion between an English word mark and a foreign word mark. Under this doctrine, foreign words marks are translated into English to determine the similarity of meaning and connotation in order to ascertain confusing similarity with English word marks. *J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23:36 (2002). While this doctrine may be applied between two foreign word marks,

there is legal support that the doctrine of foreign equivalents may not be applicable, and that the comparison should be based on phonetic similarities of the marks to the English-speaking customer. Myrurgia, S.A. v. Comptoir de La Parfumerie S.A. Ancienne Maison Tschanz, 169 USPQ 587 (CCPA 1971) (wherein the Court held the mark SENORITA to be confusingly similar to SI SENOR and SENIORAL). In fact, this Board has looked at both the meaning of the marks in English and the phonetic similarities of the words in the foreign language in deciding whether or not there is a likelihood of confusion. See Miguel Torres S.A. v. Cas Vinicola Gerardo Cesarie S.R.L., 49 USPQ2d 2018 (TTAB 1998)

Regardless of whether or not the Board chooses to apply the doctrine of foreign equivalents to the present situation, there is a likelihood of confusion between Petitioner's LA ROSA marks and Respondent's LA BELLA ROSA marks.

First if the Board chooses to apply to doctrine of equivalents, it can be seen from the registrations and applications at issue in this proceeding that the Petitioner's LA ROSA marks have essentially the same meaning as Respondent's LA BELLA ROSA marks. As can be seen from the registration and applications at issue, the mark LA ROSA means "the rose" in English and the mark LA BELLA ROSA means "the beautiful rose" in English. These marks have the same meaning with the exception that respondent has merely added a modifier to Petitioner's mark. The court has previously held in Food Specialty Co., Inc. v. Standard Products Company, Inc., 161 USPQ. 46 (CCPA 1969) that the mere addition of a similar modifier "pretty" was not sufficient to distinguish Applicant's mark. Specifically, the court held that the mark PRETTY KITTY so resembled KITTY that when both marks were applied to identical goods, cat food, that a likelihood of confusion existed between the two marks. Likewise, the mark THE BEAUTIFUL ROSE so resembles the mark THE ROSE, that a likelihood of confusion exists when both

marks are applied to pasta products.

In a more recent case, this Board held that the addition of a modifier “does not take away from the look, sound or meaning of this previously registered mark” and thus held there to be a likelihood of confusion between the mark CLUES and HIDDEN CLUES, both used in connection with board games and jigsaw puzzles. Hasbro, Inc. v. Mattel, Inc., 2002 TTAB LEXIS 272 (TTAB 2002).

Second, if this Board chooses not to apply the doctrine of foreign equivalents and the marks at issue are viewed as having essentially no meaning to the average English speaking consumer, Petitioner’s LA ROSA marks are still substantially similar in look, sound and commercial impression to Respondent’s LA BELLA ROSA marks. The present situation, is similar to the recent case, Miguel Torres S.A. v Casa Vinicola Gerardo Cesari S.R.L., 49 USPQ2d 2018 (TTAB 1998), in which the Board found that the applicant’s mark DUE TORRI & Design was sufficiently similar in sound and connotation to opposer’s marks TORRES and TRES TORRES, even though the Applicant’s mark was in Spanish and Opposer’s marks were in Italian. The Board noted that the marks would be pronounced the same and that one need not be fluent in Spanish and Italian to see the similar connotations. *Id.* at 2021.

Similar to the TORRES and DUE TORRI marks discussed above, Respondent’s LA BELLA ROSA marks would have the same sound and connotation as Petitioner’s LA ROSA marks to the average consumer. A prospective purchaser would not need to be fluent in Italian to see the substantial similarity.

D. No Evidence of Action Confusion or Intent is Required to Demonstrate a Likelihood of Confusion.

In its response, Respondent states that Petitioner has produced no evidence of actual confusion or intent. First, with regard to evidence of actual confusion, the test at issue in the present case is one of

“likelihood of confusion” not “actual confusion.” It is well settled that evidence of actual confusion is not a required element in proving that confusion is likely. McDonald’s Corp. v. McClaim, 37 USPQ2d 1274, 1276 (TTAB 1975). As indicated in McDonald’s, neither party is obligated, in a proceeding before the Board to spend the effort and expense to obtain survey evidence and Petitioner does not have a duty to conduct a survey to buttress its likelihood of confusion claims. Actual confusion is not a factor in this case.

In addressing Respondent’s unsupported assertion that there was no actual intent on its part to confuse the public, proof of defendant’s good faith and lack of intention to confuse the public is merely one factor to be considered in weighing the issue of likelihood of confusion. See Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 192 USPQ 797 (TTAB 1976). The fact that Respondent did not intend to cause confusion when it selected its mark is not determinative of the issue of whether confusion is likely, especially in the absence of any evidence supporting the argument. Intent is not a factor in this case.

In addition, Respondent has also asserted that the lack of actual confusion or intent as affirmative defense. Respondent bears the burden of proof when asserting an affirmative defense but has offered no evidence to support either defense.

First, Respondent has not offered any evidence regarding the selection of the marks at issue or any other evidence of the issue of intent. Thus, Respondent’s assertion that it did not intend to cause confusion is unsubstantiated, lacking on evidentiary basis, and should not be considered a factor in determining a likelihood of confusion.

With regard to lack of actual confusion, Respondent has not provided any evidence that no actual confusion exists. The factor of actual confusion or lack thereof is simply not to be considered or analyzed because it is not of record. Cunningham v. Laser Golf Corp., 55 USPQ2d at 1845. “Thus, the obligation

to consider a factor does not arise in a vacuum and only arises if there is evidence of record relating to that factor.” *Id.* Any unawareness of instances of actual confusion is not conclusive that actual confusion did not exist or that there was no likelihood of confusion. See *In re Bissett-Berman Corp.*, 177 USPQ 528, 529 (CCPA 1973).

In conclusion, when one looks only at the evidence of record in this proceeding, it is apparent that there is a likelihood of confusion between Petitioner’s LA ROSA marks and Respondent’s LA BELLA ROSA marks when used on identical products, namely pasta.

III. COUNTERCLAIMS.

In these proceedings, Respondent has asserted counterclaims for the cancellation and partial cancellation of Petitioner’s marks. As stated above, the only evidence offered by either party in connection with these proceeding are the pleadings and registrations and applications relative to these proceedings. In addition, Respondent only addresses Counts III and IV of its counterclaims in its brief in which Respondent requests only a partial cancellation of two (2) registrations. The partial cancellation relates only to specific goods identified in the registrations. Petitioner has already admitted the salient allegations with respect to Counts III and IV with respect to the limited named goods in its answer, and thus agrees to the partial cancellation with respect to those specific identified goods. Petitioner denied the salient allegations regarding Counts I, II and V. Due to lack of evidence and argument by Respondent, this Board should dismiss the remaining counterclaims asserted by Respondent.

In these proceedings, Respondent initiated a counterclaim for cancellation of Petitioner’s registration of the mark LA ROSA & Design, Reg. No. 313,418 for “alimentary paste products” and the registration of the mark LA ROSA & Design, Reg. No. 651,541 for “alimentary pastes, pizza pie mix, and

canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, and cheese ravioli in sauce, meat balls in sauce, sausage links with sauce on the ground that the registrations are invalid because the specimens submitted in support of the registrations evidence use of the mark which is materially different from the marks that were the subject of the original registrations which assertions were denied in Petitioner's answer. However, Respondent has presented no evidence to support such a claim and has made no reference to or argument in support of this claim in its brief. Thus, the Board should dismiss this counterclaim asserted by Respondent.

Second, Respondent has asserted a counterclaim for cancellation of Petitioner's registrations, Reg. Nos. 313,418 and 651,541 on the grounds that Petitioner has abandoned the marks that are the subject of these registrations through non-use because the marks currently in use are materially different from the registered marks. Petitioner denied these allegations in its answer. Again, Respondent has presented no evidence to support such a claim and has made no reference to or argument in support of this claim in its brief. Thus, the Board should dismiss this counterclaim asserted by Respondent.

Third, Respondent has asserted a counterclaim for the partial cancellation of Petitioner's registration of the mark, LA ROSA & Design, Reg. No. 389,868. This registration lists the goods as "butter, macaroni products, noodles and pastina, a macaroni product cut up in small fanciful shapes" but the partial cancellation is directed only to the goods identified as "butter" on the grounds of non-use.

Petitioner filed an answer in each proceeding to the counterclaims set forth by Respondent admitting the allegation and thus concedes to the partial cancellation of Registration 389,868 on the basis of non-use of the identified goods, namely "butter." Petitioner thus otherwise maintains the registration of the LA ROSA mark with respect to the remaining goods identified in the registration.

Fourth, Respondent has asserted a counterclaim for the partial cancellation of Petitioner's registration of the mark LA ROSA (STYLIZED), Reg. No. 623,193 for "alimentary pastes, pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meat balls in sauce, and sausage links with sauce" on the grounds of non-use." The partial cancellation claim is only for the goods identified as "pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meatballs in sauce, and sausage links with sauce."

In its answers, Petitioner admitted to the allegation and thus concedes to the partial cancellation of Registration 623,193 on the basis of non-use of the identified goods, namely "pizza pie mix, and canned sauce therefor, canned spaghetti sauces, with meat, without meat, with mushrooms and marinara, ravioli with meat in sauce, meatballs in sauce, and sausage links with sauce." In the absence of any evidence of record other than the salient admissions in the answer, Petitioner thus maintains the registration of the LA ROSA mark for "alimentary pastes."

Last, Respondent has asserted a counterclaim for the cancellation of Petitioner's registration for the mark LA ROSA & Design, Reg. No. 313,418 for "alimentary paste products" for cancellation on the ground that the renewal application for the registration was invalid because the declarant, Richard P. Ross, General Manager did not have authority to execute said Renewal Application these allegations being denied in the Petitioner's answers. However, Respondent has presented no evidence to support such a claim and has made no reference to or argument in support this claim in its brief. Thus, the Board should dismiss the counterclaim asserted by Respondent.

IV. CONCLUSION

For the reasons herein above set forth and based upon the application of the relevant law to the facts in this case it is submitted that counts I, II, and IV of the counterclaims must be dismissed and the cancellation and the oppositions must be sustained.



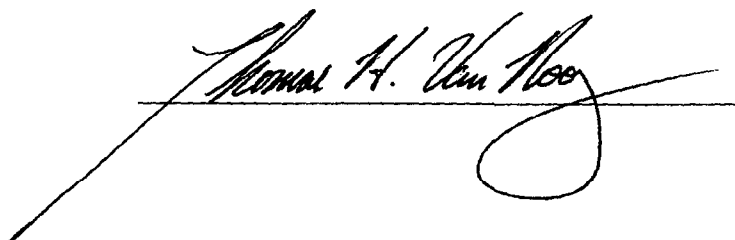
Thomas H. Van Hoozer, Reg. No. 32,761
Leslie L. Lawson, Reg. No. P-53,185
HOVEY WILLIAMS LLP
2405 Grand Boulevard, Suite 400
Kansas City, Missouri 64108-2519
Telephone: (816) 474-9050
Telefacsimile: (816) 474-9057

ATTORNEYS FOR PETITIONER
AMERICAN ITALIAN PASTA COMPANY

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Brief as Respondent in the Counterclaims and Reply Brief as Petitioner was served upon attorneys for Applicant this 15th day of January, 2003 by forwarding a copy via first class mail, postage prepaid, addressed to the following:

Cory M. Amron
William H. Oldach III
Vorys, Sater, Seymour and Pease LLP
1828 L Street, N.W.
Eleventh Floor
Washington, D.C. 20036

A handwritten signature in cursive script, reading "Thomas H. Van Alstyne", is written over a horizontal line. The signature is fluid and extends above and below the line.