

Owen, Wickersham & Erickson, P.C.  
455 Market Street, 19th Floor ~ San Francisco, California 94105  
Voice 415/882-3200 ~ Fax 415/882-3232

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**CERTIFICATE OF SERVICE**

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, No. EV 335430074, in an envelope addressed to BOX TTAB, FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 on April 13, 2004. Signed BCD  
B.C. Dunne

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

Registration: No. 2,237,914  
Date of Issue: April 13, 1999  
Mark: MEDIUM BLUE (Pantone No. 314C)



04-13-2004  
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

MACFARMS OF HAWAII, LLC, )  
 )  
 Petitioner, )  
 )  
 vs. )  
 )  
 MAUNA LOA MACADAMIA NUT )  
 CORPORATION, )  
 )  
 Registrant. )  
 \_\_\_\_\_ )

**PETITION FOR CANCELLATION**

Petitioner, MACFARMS OF HAWAII, LLC ("MacFarms"), a Delaware limited liability company, having its principal place of business at 1828 C Street, Sacramento, California 95814, believes that it is, and will continue to be, damaged by Registration No. 2,237,914 and petitions to cancel such registration.

**BACKGROUND FACTS**

As grounds for this petition, it is alleged that:  
1. Registration No. 2,237,914 ("Registration") for the mark MEDIUM BLUE

1 (Pantone No. 314C) was issued to Registrant on April 13, 1999.

2 2. The Registration states that Registrant's dates of first use and first use in  
3 commerce were February 2, 1976 in connection with dried fruits and/or processed macadamia  
4 nuts in Class 29.

5 3. Upon information and belief, Registrant is a Delaware corporation with its  
6 principal place of business in Irvine, California.

7 4. MacFarms is the owner by assignment of (i) Registration No. 1,299,014, issued  
8 October 2, 1984, for a composite label mark including a medium color blue identical or  
9 substantially similar to Pantone Process Cyan C and (ii) the common law rights to such mark. A  
10 copy of the composite mark covered by the 014 Registration is attached as Exhibit A.

11 5. The 014 Registration claims dates of first use and first use in commerce of at least  
12 as early as 1982.

13 6. MacFarms and its predecessor-in-interest have used its composite label mark in  
14 the original form and in the form depicted in Exhibit B from at least 1982 to the present in  
15 connection with processed macadamia nuts.

16 7. Upon information and belief, sometime after 1982, without the consent of  
17 MacFarms, Registrant began using labels containing Pantone No. 314C medium blue on its  
18 processed macadamia nuts.

19 8. Upon information and belief, Registrant was aware of MacFarms' use of medium  
20 blue in its labels for processed macadamia nuts at the time Registrant adopted and began using  
21 Pantone No. 314C medium blue.

22 9. Both MacFarms and the Registrant use their respective colors blue on the same or  
23 related goods, e.g., processed macadamia nuts.

24 10. MacFarms has sold its macadamia nuts bearing labels containing its composite  
25 mark through retail outlets and membership clubs, such as COSTCO.

26 11. Upon information and belief, Registrant sells its macadamia nuts bearing labels  
27  
28

1 containing Pantone 314C medium blue through retail stores.

2 12. Upon information and belief, the ultimate consumers of the macadamia nuts sold  
3 by MacFarms and the Registrant are the same, *i.e.*, consumers.

4 13. Beginning in June, 2003, Registrant has written cease and desist letters to  
5 MacFarms alleging that MacFarms' use of its composite labels containing medium blue infringes  
6 Registrant's registered mark for Pantone No. 314C Blue.

7 14. On or about December 24, 2003, Registrant filed Civil Action No. 03 CIV 10223  
8 in the Southern District of New York ("Civil Action") alleging infringement by MacFarms of  
9 Registrant's registered mark, Pantone No. 314C Blue.

10 15. The Civil Action subsequently was dismissed without prejudice by Registrant  
11 based on an agreement in principle to settle the dispute between MacFarms and Registrant.  
12 However, as of the date of this Petition, settlement discussions have become deadlocked and may  
13 end without agreement, at which time, Registrant will sue MacFarms again based on the  
14 Registration.

15  
16 CLAIMS FOR CANCELLATION

17  
18 In the event that the Board finds a likelihood of confusion between MacFarms' use and  
19 registration of its composite label mark containing medium blue and Registrant's use and  
20 registration of Pantone No. 314C Blue, MacFarms requests cancellation of the Registration for  
21 the following reasons:

22 COUNT I

23 1. Upon information and belief, MacFarms has priority of use based on its date of  
24 first use and date of first use in commerce at least as early as 1982 for its composite label mark.

25  
26 COUNT II

27 1. MacFarms' 014 Registration is incontestible.

28

1            2.        Therefore, Registrant cannot attack MacFarms' 014 Registration based on alleged  
2 priority of use.

3            3.        In addition, given the policy of the Lanham Act to encourage prompt registration  
4 of a mark and the facts that (i) MacFarms was the first to obtain a registration for the color  
5 medium blue and (ii) the 014 Registration is incontestible, Registrant cannot now obtain  
6 registration of a mark which is likely to cause confusion with MacFarms' registered mark.

7                                    COUNT III

8            1.        Upon information and belief, Registrant's Pantone No. 314C Blue, as used on  
9 packaging by Registrant, was not distinctive and/or a source indicator for Registrant's processed  
10 macadamia nuts either on the date of Registrant's application of March 22, 1996, or the date of  
11 registration of April 13, 1999.

12            2.        Therefore, Registrant was not entitled to a registration of its mark Pantone No.  
13 314C Blue under § 2(f) of the Act.  
14

15                                    CONCLUSION

16            MacFarms has been and will continue to be damaged by the existence of Registration  
17 No. 2,237,914 because (i) in the event that there is a likelihood of confusion, the reputation of  
18 MacFarms will be damaged, and (ii) Registrant will continue to threaten and initiate legal  
19 proceedings against MacFarms claiming infringement of Registrant's alleged mark Pantone No.  
20 314C Blue.  
21


22            WHEREFORE, MacFarms requests that Registration No. 2,237,914 be cancelled and this  
23 Petition for Cancellation be sustained in favor of Petitioner MacFarms.

24  
25            A duplicate copy of this Petition and the filing fee in the amount of \$300 are enclosed.

26  
27            Dated: April 13, 2004

   Respectfully submitted,

OWEN, WICKERSHAM & ERICKSON, P.C.

By   
R. Dennis Claessens

455 Market Street, 19th Floor  
San Francisco, California 94105  
(415) 882-3200

Attorneys for Petitioner, MACFARMS OF  
HAWAII, LLC

S:\clients\MACFA\60001\PetitionCanc.wpd

Owen, Wickersham & Erickson, P.C.  
455 Market Street, 19th Floor ~ San Francisco, California 94105  
Voice 415/882-3200 ~ Fax 415/882-3232

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28



MADE IN HAWAII

MACFARMS  
of HAWAII

Macadamias



DRY  
ROASTED

MACFARMS  
of HAWAII

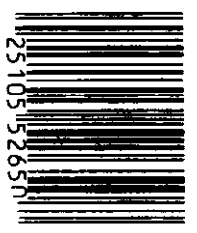
Macadamias



NET WT. 30 OZ.

1.88 LBS / 851 GMS

CONTAINS: DRY ROASTED  
MACADAMIA NUTS, SALT,  
MALTODEXTRIN AND  
CARBOXYMETHYL  
CELLULOSE.  
PACKED FOR  
MACFARMS OF HAWAII, INC.  
CAPTAIN COOK  
HAWAII 96704







# KONA SELECT HARVEST Macadamias



**T**he macadamia nut was named after the philosopher John Macadam. It has an unusually hard shell, so its rich creamy kernel has escaped all but the most discriminating palate until recently. Enjoy their distinctive, smooth, exquisite flavor for yourself. Discover why gourmets describe them as the finest edible nut in the world.



NUTRITION INFORMATION	
PER SERVING	1 OZ
SERVING SIZE	1 OZ
SERVINGS PER CONTAINER	14
CALORIES	190
PROTEIN	3.0g
CARBOHYDRATES	1.8g
POLYUNSATURATED FAT	1.9g
SATURATED FAT	2.8g
FATTY ACID**	15g
CHOLESTEROL**	0mg
SODIUM	140mg
POTASSIUM	80mg

\*INGESTION ON FAT AND CHOLESTEROL CONTENT IS PROVIDED FOR INDIVIDUALS WHO, ON THE ADVICE OF A PHYSICIAN, ARE MODIFYING THEIR TOTAL DIETARY INTAKE OF FAT AND CHOLESTEROL.

PERCENTAGE OF U.S. RECOMMENDED DAILY ALLOWANCES (U.S. RDA)

PROTEIN	4	FROM	2
VITAMIN A	4	VITAMIN B6	6
VITAMIN C	2	PHOSPHORUS	4
THIAMIN	6	IRON	4
NIACIN	6	ZINC	2
COPPER	2	COPPER	4
CALCIUM	2		

\*\*CONTAINS LESS THAN 2 PERCENT OF THE U.S. RDA OF THESE NUTRIENTS.

**INGREDIENTS:**

HAWAIIAN MACADAMIA  
NUT KERNELS,  
SALT.

VACUUM SEALED AND  
PACKED EXCLUSIVELY FOR

THE PRICE COMPANY

P.O. BOX 17091  
SAN DIEGO, CA 92117



P.C. ITEM #21420

NET WT. 14 OZ. • 397g

