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

Proceeding	92044522
Party	Defendant SNOWIZARD HOLDINGS, INC. SNOWIZARD HOLDINGS, INC. 101 RIVER ROAD JEFFERSON, LA 70121
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Attachments	98876.14.Answer.pdf (11 pages)

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

Southern Snow Manufacturing, Inc.
v
SnoWizard Holdings, Inc.

Cancellation Proceeding No. 92044522
Serial #: 78248640 Registration #: 2901592
Atty. Docket No. T04017US (98876.14)

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ANSWER

Box TTAB No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

Registrant, SnoWizard Holdings, Inc., makes its answer to the Petition for Cancellation as follows:

1. The allegations in paragraph 1 are admitted in part - SnoWizard does not sell syrups.

2. The allegations in paragraph 2 are admitted.

3. The allegations in paragraph 3 are denied. The petitioner has stated in paragraph 3 of its Ground for Cancellation that there are three significant suppliers of flavor concentrates and syrups in the New Orleans, Louisiana area. SnoWizard, Eisenmann Products Company, and themselves. To the contrary, there are many more including National Fruit Flavor, Kiko Foods, G & M Fountain Supplies, and Parasol Flavors for a total of seven.

Unlike all of these other flavor companies in the New Orleans area, SnoWizard is the only manufacturer that formulates and manufacturers its flavor concentrates from scratch, using raw chemical and flavoring materials to create a flavoring. All of the other flavor companies simply purchase their flavor concentrates from a flavor house, (a company employing flavorists and chemists that formulate and create and manufacture flavorings) and mix the purchased flavor concentrates with water, colorings, preservatives and other ingredients, into a diluted concentrate. SnoWizard is the only company that employs a flavorist, who creates, formulates and manufactures its own flavorings.

SnoWizard's Orchid Cream Vanilla® flavor concentrate is not just plain vanilla with added milk and coloring. It is a complex formulation of several years of research, development and refinement. A snoball shop vendor cannot recreate the flavor of the product by mixing any combination of their flavoring concentrates together. The color is also unique, and has been specifically formulated to stand out among all others, to be recognized and associated with the product name. The color also cannot be recreated by the mixing of any combinations of flavorings, or store bought colorings. None of the other flavor companies have any products that replicate or even come close to the flavor and color of SnoWizard's Orchid Cream Vanilla® flavor concentrate.

Since 1998, SnoWizard has advertised, marketed and sold the flavoring concentrate Orchid Cream Vanilla® to its customers (the public). Over the last seven years, as more snoball shops and their customers became familiar with the unique flavor and color of the product, Orchid Cream Vanilla® flavor concentrate has gained recognition and increased its sales. This results in SnoWizard's competitors receiving increased requests for Orchid Cream Vanilla® flavor concentrate. Our competitors do not want to lose the sales of Orchid Cream Vanilla® flavor concentrate as they may lose the sales on additional flavor concentrate that the customer wants to order at the same time.

It is common for many snoball business owners to shop from more than one supplier. Some business owners may purchase all of their products from one single supplier, while many others purchase from 2, 3, or even more suppliers. This can be due to many reasons including pricing, shipping costs, customer service, and the taste of their individual flavoring concentrates.

There is also a considerable changeover in business ownership with the average ownership of a shaved ice business being approximately 3.5 years, according to SnoWizard's records. As new operators telephone in to re-order flavor concentrates, they sometimes order a particular flavor concentrate from a supplier who doesn't offer that flavor. SnoWizard regularly receives telephone orders for flavors that our competitors manufacture, but that we don't. If we receive a considerable number of requests for a flavor that we do not offer, and one that our competitors may or may not offer, we then consider manufacturing the flavor to accommodate the requests of our customers.

Many shaved ice business owners also check on their competitors' businesses, to see what new products that they are offering. Customers of shaved ice businesses may order a particular flavor not served at one shop, that they ordered at another. As the business owner learns of these new flavors through the numerous requests of his customers, and desires to add the flavor to his menu, he will inquire from his supplier/s about purchasing the flavor.

Sales of a flavoring concentrate named Orchid Cream Vanilla by Southern Snow and other shaved ice flavor suppliers will cause confusion in the market place.

The Plum Street snoball shop does not sell any Orchid Cream Vanilla concentrate or syrup to the public.

Since 1980, when Ronald R. Sciortino began working full time with SnoWizard, Orchid Cream Vanilla was one of many recipes that he instructed customers on how to make. Instructions were given to customers verbally, as well as in print. Since 1980, SnoWizard has offered its customers a "recipe sheet," listing various regular and cream flavor concoctions. Orchid Cream Vanilla was one of those recipes at least as early as 1980.

SnoWizard regularly formulates and offers new flavor concentrate to its customers, generally releasing two to three new flavors annually. In 1998, SnoWizard released several new flavor concentrates, one of which was Orchid Cream Vanilla® flavor concentrate. This was made public to our customers through our monthly newsletter that was published in May 1998. The product was also prominently displayed in the retail showroom for a period of three years, along with other newly released flavors. Prior to this date, Orchid Cream Vanilla® flavor concentrate was not manufactured, sold or offered by any other flavor manufacturer. A review of all competitive companies published literature showed that no other entity offered the product for sale, or even offered literature or instructions on how to make Orchid Cream Vanilla® flavor concentrate.

4. The allegations in paragraph 4 are admitted.

5. The allegations in paragraph 5 are admitted.

6. The allegations in paragraph 6 are admitted.

7. The allegations in paragraph 7 are admitted. However, these articles often contain inaccuracies and are hearsay; Registrant objects to the use of any newspaper or magazine articles in this proceeding.

8. The allegations in paragraph 8 are admitted.

9. The allegations in the first sentence of paragraph 9 are denied for lack of sufficient information to justify a belief. The allegations in the second sentence of paragraph 9 appear to be correct (it appears that Donna Black did execute such an affidavit).

10. The allegations in paragraph 10 are admitted.

11. The allegations in paragraph 11 are denied for lack of sufficient information to justify a belief.

12. The allegations in paragraph 12 are admitted.

13. The allegations in paragraph 13 are admitted.

14. The allegations in the first sentence of paragraph 14 are denied for lack of sufficient information to justify a belief. The allegations in the second sentence of paragraph 14 are denied.

15. The allegations in paragraph 15 are admitted. However, these articles often contain inaccuracies and are hearsay; Registrant objects to the use of any newspaper or magazine articles in this proceeding. In particular, while Petitioner accurately repeated what the article stated, Registrant believes that the statement that "syrup ... is imported from Williams'-Plum Street stand in New Orleans" is inaccurate, as in July 1988 SnoWizard was supplying flavoring concentrates to both Williams' Plum Street stand and to the Snowball Stand mentioned in that article.

16. The allegations in paragraph 16 are admitted.

17. The allegations in the first sentence of paragraph 17 are admitted. The allegations in the second sentence of paragraph 17 are admitted in part - SnoWizard owns two federal registrations for SnoWizard, including Reg. No. 2544216 for ice shaving machines. The allegations in the third sentence paragraph 17 are denied. In 1982, SnoWizard Manufacturing Company received a trademark registration (No. 1199306) for the name "Sno-Wizard". It was discovered in 2002 that the trademark registration had expired. Patent and trademark attorneys representing SnoWizard Holdings, Inc. at that time, filed for a new trademark for the same name, rather than renewing the expired mark. Thus, at the time that Appendix E was printed, SnoWizard believed that its mark was registered, and thus used the registration symbol. The allegations in the fourth sentence of paragraph 17 are admitted in part - when SnoWizard originally filed for the trademark registration, the date of first use given on the application was at least as early as June 1, 1999. However, in light of the recent challenge to SnoWizard's

trademark registration, an intensive research of the company records was conducted and shows that it was actually earlier than first reported. The date of first use, or sale, of the flavoring concentrate bearing the name Orchid Cream Vanilla®, was in May of 1998. Copies of the front pages of the company newsletter and customer invoice (with some information redacted) are attached as Exhibits 1 and 2 to verify the date of first use.

Further, Petitioner should be well aware that SnoWizard has been a registered mark of SnoWizard, as petitioner's president was present during, and called to testified as a witness in, a lawsuit in federal court in the 1980s between registrant and the Eisenmann Products Company. Testimony was given and documents presented to show that Sno-Wizard was a registered trademark of SnoWizard Manufacturing.

18. The allegations in paragraph 18 are denied for lack of sufficient information to justify a belief (Registrant cannot admit or deny what Petitioner believes or upon what Petitioner bases its beliefs). However, Petitioner's belief is incorrect. Even if Petitioner's belief were correct, it is irrelevant - Petitioner's use began after Registrant filed its application to register the mark in question.

19. The allegations in paragraph 19 are admitted.

20. The allegations in paragraph 20 are admitted.

21. The allegations in paragraph 21 are denied for lack of sufficient information to justify a belief.

22. The allegations in paragraph 22 are admitted. The relevant market for the goods sold under the registered mark is composed primarily of owners of snowball shops.

23. The allegations in paragraph 23 are denied.

24. The allegations in paragraph 24 are denied for lack of sufficient information to justify a belief (Registrant cannot admit or deny what Petitioner wishes).

25. The allegations in paragraph 25 are denied.

26. The allegations in paragraph 26 are denied. The registration only prevents others from using the name for flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections. Registrant does not challenge the right of Plum Street Snowballs to continue to use Orchid Cream Vanilla as a designation for a flavor for snowballs. However, even if, as it appears, Plum Street Snowballs has for many years used Orchid Cream

Vanilla as a designation for a flavor for snowballs, and did so before Registrant first used Orchid Cream Vanilla® as a trademark for flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections, Plum Street Snowballs has used its Orchid Cream Vanilla designation in a very limited geographical region, and for goods which are different from those in the present registration. Registrant was the first to use Orchid Cream Vanilla® for flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections. Registrant properly registered its trademark for Orchid Cream Vanilla® for flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections. Petitioner is attacking Registrant's registration not because Petitioner is alleging that it used the mark prior to Registrant on the goods for which the mark is registered; rather, Petitioner is attacking Registrant's registration because Petitioner has been infringing Registrant's trademark rights and apparently would like to continue to do so.

27. Following is more information about the background of SnoBalls and "Cream" flavors.

Mr. George J. Ortolano and his wife, Josie M. Ortolano, operated a grocery store in the uptown area in the city of New Orleans in the year 1936. Looking to generate additional income, George J. Ortolano noticed another store in the area doing a brisk business selling snow cones during the summer. He decided to add snow cones at his store, however, wanted to offer a finer ice than that associated with the crunchy snow cone. He wanted an ice similar to that which was produced using a hand shaver on a block of ice. He subsequently invented a motorized ice shaver that he named the Snow Wizard Snow Ball machine. His Snow Wizard machine was designed to quickly and efficiently shave blocks of ice used in a household icebox, into fine, fluffy snow.

Josie Ortolano had a sweet tooth, and an affliction for putting evaporated milk in just about everything; coffee, tapioca, oatmeal, and many other foods. She mixed up creamy flavors for their snowballs using evaporated milk. When Mr. Ortolano began manufacturing and selling his newly donned "SnoWizard SnoBall" machine, Mrs. Ortolano taught their customers how to make cream flavors for "SnoBalls" by adding evaporated milk to the regular flavors. Over the years, Mrs. Ortolano became known as the "Queen of Cream" for the numerous cream flavor concoctions that she created such as Grasshopper, Pink Lady, Chocolate Moo Moo, Wedding

Cake, and many more. These recipes were freely given to and used by SnoWizard customers, and were later used by other industry suppliers who offered them to their customers.

Mr. William's who opened William's SnoBall's was one of Mr. & Mrs. Ortolano's first customers, and purchased a Snow Wizard machine and flavorings from SnoWizard in the 1940's to open his snowball stand. Mrs. Ortolano taught Mr. Williams how to mix his regular flavorings, and also the various cream flavors as she had done for herself, and other customers.

The Ready-to-Use (RTU) Orchid Vanilla Cream flavor served by Plum Street SnoBalls, as well as a few other snoball shoppes in the city of New Orleans, is not a flavor that is purchased from a snoball supplier, but rather a name given to the regular flavor "Vanilla" that when mixed with simple syrup and evaporated milk, is called Vanilla Cream. When additional red and blue color is added to Vanilla Cream flavor, it can be called "Orchid" Vanilla Cream" or any other desired name.

The Orchid Cream Vanilla® flavor concentrate manufactured by SnoWizard is a flavoring concentrate, and not a ready-to-use syrup that is poured onto shaved ice. It also contains no milk or cream and milk or cream is not needed or required to make the concentrate into a ready-to-use product, or to give the product its name. Orchid Cream Vanilla® flavor concentrate is a unique tasting, and uniquely colored flavor concentrate that has been formulated to be mixed with nothing more than simple syrup to make it a ready-to-use flavor. The taste of SnoWizard's Orchid Cream Vanilla® flavor concentrate is also unique. It is not just vanilla with added color. Its formula is very complex, and would be very difficult, if not impossible, for other flavor manufacturers to duplicate. Its unique color is not found in any other manufacturer's flavor concentrates, RTU flavors, or other food products on the market. Snoball shops cannot replicate its flavor by simply mixing a combination of flavorings together, or by added cream to a flavor. The color is so unique, that when many customers visit a snoball shoppe and see the product, will order it because of the color alone.

Williams SnoBalls and other snoball shoppes in the New Orleans area do not, and are not licensed to, package flavoring concentrate or RTU flavors, and do not sell any packaged products bearing the name of Orchid Cream Vanilla.

SnoWizard Holdings, Inc. filed for, and received, a trademark registration for Orchid Cream Vanilla® for "Flavoring concentrate for non-nutritional purposes, namely, flavoring

concentrate for shaved ice confections." Since 1985, SnoWizard has been the leader in developing new flavorings for the snoball industry. Many of these new flavors introduced by SnoWizard were for generic flavor names such as Pink Champagne, Amaretto, Mango, Tamarind, Clearly Strawberry, Granny Smith Apple and many, many more. Others were unique flavors such as Tiger's Blood, Swiss Almond Coco, White Chocolate & Chips, and Cajun Red Hot. Several years after introducing these new flavors to the market, other suppliers added these same flavorings to their customers, although the taste and color were not like the original flavor developed by SnoWizard. SnoBall vendors may learn of, or taste, these new flavorings immediately, or years after their release. If the concentrate is purchased from one of SnoWizard's competitors, who offers their version of the original flavor created by SnoWizard, then the consumer is not receiving the original flavor that they wanted to purchase.

Applicant respectfully requests that the cancellation proceeding be dismissed with prejudice.

Respectfully submitted,

/smn/_____

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CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being served electronically and/or is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:

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cell 504-250-0147, on June 28, 2005.

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Seth M. Nehrbass

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being filed electronically and/or is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to:
Box TTAB No Fee
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513, on June 28, 2005.

/smn/_____
Seth M. Nehrbass

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Southern Snow Manufacturing, Inc.
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The SnoWizard® Express

SnoWizard is a federally registered trademark. Use of this name or mark is strictly prohibited without the express written permission of SnoWizard Holdings, Inc.

Volume 5, Issue 2 MAY 1998

The SnoWizard Express is a news and information publication provided as a service to the friends and customers of SnoWizard Inc. It is published monthly from April to September. The editors welcome your comments and suggestions any time at 1-888/366-9766.

Happy Mother's Day

All of us at SnoWizard would like to wish all Mother's a very Happy Mother's Day.

May 10, 1998

10, 11, 12, 13 . . . plus, more new flavors!!

In our April newsletter we announced the release of 9 new flavoring extracts. Actually, we had 10 new flavoring extracts ready but forgot to include one in the newsletter. So here is number 10, plus 11, 12

Black Cherry begins our newest release — and the one that we failed to include. This is a true Black Cherry flavor with a full rich, fruity taste. It's also darker in color than our other cherry flavors but *not black* in color.

Spumoni is number two on our list. Spumoni is made up of those same delicious flavors that go into the Italian ice cream. It has a wonderful and unique fruity taste and is medium to dark green in color.

Orchid Cream Vanilla is our next addition and once again shows our expertise in the manufacture of pure vanilla extracts. It has an intense vanilla flavor with flowery aromatics. The color is opaque lavender. In order to obtain the full richness and color intensity of this flavor, we recommend that you serve it as a cream flavor, *premixed* with the milk or cream.

Butter Pecan joins the list with a rich buttery-nut taste. Tan or medium brown in color, this is another flavor, which tastes great when served with cream. It's also a terrific flavor for adding toppings to such as ice cream or whipped cream.

Irish Cream is next in line. This flavor has a strong and rich typical Irish Cream taste. Light brown in color and another concentrate which taste even better when served as a cream flavor.

Last on our list, and the most unusual snoball flavor to date since our development of Tiger's Blood, is ***Dill Pickle.*** Yuck! Believe it or not, we have had more requests for this flavor than you can imagine. Numerous customers have told us that they sell whole dill pickles just to get the juice to pour over snoballs and that their customers love it so much they keep running out of dill pickle juice. This seems to be the latest trend with kids.

Dill Pickle flavoring is made without the use of simple syrup. Simply measure 4 oz of the concentrate into a gallon container and fill with water. Do not use any sugar to sweeten this flavor. The finished product will be watery just like pickle juice. We are currently testing several dry agents that you will be able to add to the finished product to give it a little more body.

While we have completed the development of this flavor, it will not be available until after May 10th as the ingredients to manufacture a large batch will not arrive until then.

Have a great Memorial Day!

SnoWizard® will be closed on Monday May 25th in observance of Memorial Day. Now is the time to plan ahead and order early so you do not run short of flavorings and supplies over the holiday weekend. This is generally one of the busiest weekends during the season for snoball sales so you should ***double check*** your inventory to make certain that you haven't overlooked any items. Remember, it won't hurt if you order those items that may seem to be borderline on getting low. Since you're going to use the product anyway, it's better to have it on hand than not to have it and lose a sale

We will be closed on Monday May 25th for Memorial Day.

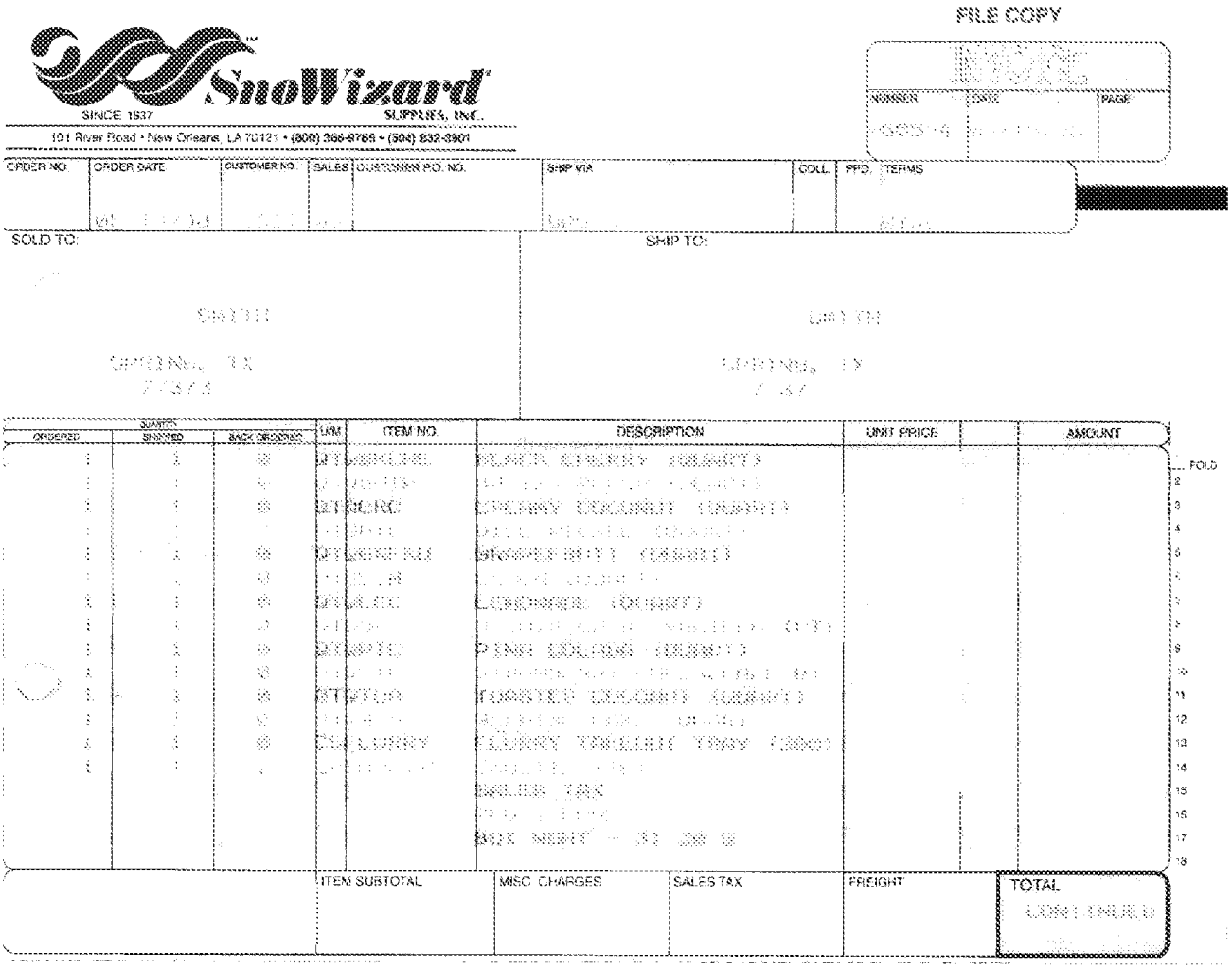
Registrant's Exhibit 1

Southern Snow Manufacturing, Inc.

v

SnoWizard Holdings, Inc.

Cancellation Proceeding No. 92044522



Registrant's Exhibit 2