

TTAB

UNITED STATES PATENT AND TRADEMARK
OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: July 27, 2006

MISTER DONUT OF AMERICA, INC.
89 PROVIDENCE HIGHWAY
WESTWOOD, MA 02090

Cancellation No. 92046084
Reg. No. 833808, 1084143,
1084144, 2362262, 2366396,
858691, 859016, 1120124

BRETT M. TOLPIN
WELSH & KATZ, LTD.
120 SOUTH RIVERSIDE PLAZA 22ND FLOOR
CHICAGO, IL 60606

RIVER WEST BRANDS, LLC

V.

MISTER DONUT OF AMERICA, INC.

Shelley Jamison, Legal Assistant

A petition, a copy of which is attached, has been filed to cancel the above-identified registration.

Proceedings will be conducted in accordance with the Trademark Rules of Practice.

ANSWER IS DUE FORTY DAYS after the mailing date hereof.
(See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68



08-10-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #3C

Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available at www.uspto.gov/web/offices/dcom/ttab/.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open:	August 16, 2006
Discovery period to close:	February 12, 2007
30-day testimony period for party in position of plaintiff to close:	May 13, 2007
30-day testimony period for party in position of defendant to close:	July 12, 2007
15-day rebuttal testimony period for plaintiff to close:	August 26, 2007

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "*Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board*," 1235 TMOG 68 (June 20, 2000). The notice is available at

<http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

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

In the Matter of U.S. Reg. Nos.
0,833,808, 1,084,143, 1,084,144,
2,362,262, 2,366,396; 0,858,691,
0,859,016 and 1,120,124

Cancellation No.

Marks: MISTER DONUT (word mark)
MISTER DONUT (stylized)
MISTER DONUT & Design

River West Brands, LLC,

Petitioner,

vs.

DD IP Holder LLC,

Registrant.

NOTICE OF CANCELLATION OF DD IP HOLDER LLC'S REGISTRATIONS

TO: Box TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

07/13/2006 GTHOMAS2 00000069 230920 0833808
01 FC:6401 5700.00 DA

Identification of Petitioner:
River West Brands LLC
a Delaware Limited Liability Company
141 West Jackson Boulevard
Suite 3620
Chicago, IL 60604

1. The above-identified Petitioner believes that it is or will be damaged by Respondents U.S. Trademark Registration Nos. 0,833,808, 1,084,143, 1,084,144, 2,362,262, 2,366,396; 0,858,691, 0,859,016 and 1,120,124 which were filed originally by Mister Donut of America, Inc, a Delaware Corporation, and are now owned by DD IP Holder, LLC, a Delaware Limited Liability Company.

2. Petitioner received an Office Action from the U.S. Trademark Office refusing registration under §2(d) of the Lanham Act for its U.S. Ser. No. 78/786,676 for the mark MISTER DONUT (word only) based on likelihood of confusion with U.S. Trademark Reg. Nos. 0,833,808, 1,084,143, 1,084,144, 2,362,262 and 2,366,396 owned by the Respondent. Existence of the registrations is preventing U.S. Ser. No. 78/786,676 from advancing to registration.

3. Petitioner reasonably expects to receive a first Office Action from the U.S. Trademark Office refusing registration for Petitioner's U.S. Ser. No. 78/827,276 (MISTER DONUT and design) based on likelihood of confusion with U.S. Reg. Nos. 0,833,808, 1,084,143, 1,084,144, 2,362,262 and 2,366,396 under § 2(d) of the Act. Additional references Petitioner believes will be cited by the Examining Attorney under § 2(d) of the Act are U.S Reg. Nos. 0,858,691, 0,859,016 and 1,120,124 for the same design mark. It is Petitioner's belief that these three registrations will prevent Petitioner's U.S. Ser. No. 78/827,276 from advancing to registration.

4. Petitioner's design in U.S. Ser. No. 78/827,276 and the design in Respondent's U.S Reg. Nos. 0,858,691, 0,859,016 and 1,120,124 are identical or nearly identical and appear as follows:



5. Respondent's Reg. No. 833,808 is for MISTER DONUT and Design for restaurant Services in class 42.

6. Respondent's Reg. No. 1,084,143 is for MISTER DONUT (stylized) for restaurant and snack bar services in class 42.

7. Respondent's Reg. No. 1,084,144 is for MISTER DONUT (word only) for fruit fillings, jellies for doughnuts and pastries, vegetable shortening, milk and chocolate milk for consumption on or off the premises in class 29; coffee, tea, hot chocolate, flour, sandwiches, cream (custard) fillings, cookies, doughnuts and pastries for consumption on or off the premises in class 30; non-carbonated and carbonated non-alcoholic soft drinks for consumption on or off the premises in class 32; and rendering technical aid and assistance in the establishment and operation of restaurants and snack bars, restaurant and snack bar services in class 35.

8. Respondent's Reg. No. 2,362,262 is for MISTER DONUT (word only) for restaurant and snack bar services in class 42.

9. Respondent's Reg. No. 2,366,396 is for MISTER DONUT (stylized) for fruit-based fillings and jellies for doughnuts and pastries, vegetable shortening, milk and chocolate milk for consumption on or off the premises in class 29; coffee, tea, hot chocolate, flour, sandwiches; custard based fillings for doughnuts and pastries; cookies; doughnuts and pastries for consumption on or off the premises in class 30; non-carbonated and carbonated non-alcoholic soft drinks for consumption on or off the premises in class 32; and rendering technical aid and assistance in the establishment and operation of restaurants and snack bars in class 35.

10. Respondent's Reg. No. 0,858,691 (design only) is for technical services rendered to restaurant and snack bar operators, such as aiding and negotiating in the arrangement of leases, the location and construction of outlets, the conducting of training courses in restaurant management, the continual supervision of restaurant and snack bar operations and the inspection and control of foods and ingredients of foods and beverages intended for use in restaurants and snack bars in class 35 and restaurant and snack bar services, dealing primarily, but not exclusively, in the sale of doughnuts, coffee, and other non-alcoholic beverages in class 42.

11. Respondent's Reg. No. 0,859,016 (design only) is for coffee, flour, cream and fruit fillings, and jellies for doughnuts, vegetable shortening, ice cream, sandwiches, and doughnuts in class 29 and coffee, flour, cream and fruit fillings, and jellies for doughnuts, vegetable shortening, ice cream, sandwiches, and doughnuts in class 30.

12. Respondent's Reg. No. 1,120,124 (design only) is for fruit fillings, jellies for doughnuts and pastries, and vegetable shortening, for use in the manufacture of bakery goods, and milk and chocolate milk for consumption on or off the premises in class 29; flour and cream and custard fillings for use in the manufacture of bakery goods, and coffee, tea, hot chocolate, sandwiches, doughnuts, and pastries for consumption on or off the premises in class 30; soft drinks for consumption on or off the premises in class 32; and restaurant and snack bar services in class 42.

13. Petitioner has consolidated and combined this Notice of Cancellation of the eight trademark registrations into a single Complaint because claims against each of the DD IP Holder LLC's trademark registrations involve common questions of law and fact. 37 C.F.R. § 2.112(b).

14. The above-identified Petitioner believes that it is, or will be, damaged by the above identified registrations, and hereby petitions to cancel the same.

The grounds for this Cancellation are as follows:

15. On information and belief, Respondent has abandoned U.S. Trademark Registration Nos. 0,833,808, 1,084,143, 1,084,144, 2,362,262, 2,366,396 0,858,691, 0,859,016 and 1,120,124 pursuant to §45 of the Lanham Act by discontinuing use of the mark for a period of three (3) years or more, which is prima facie evidence of abandonment. Petitioner is likely to be damaged by continuance of said registrations in that Petitioner intends use of the same or a similar mark and will be impaired by the continued registrations of said abandoned marks of Respondent.

16. Petitioner intends to use and register the word mark MISTER DONUT for food, beverages, restaurant and snack bar services by virtue of U.S. Ser. No. 78/786,676 filed on January 6, 2006.

17. Petitioner intends to use and register the MISTER DONUT & Design mark for food, beverages, restaurant and snack bar services by virtue of U.S. Ser. No. 78/827,276 filed on March 2, 2006.

18. Concurrent use and registration of the mark by the Respondent and Petitioner is likely to result in irreparable damage to Petitioner's reputation and good will.

19. Petitioner's and Respondent's applications and registrations are for nearly identical marks and identify nearly the same goods and services that the marks are used in connection with.

20. If the Respondent is permitted to retain the registrations sought to be cancelled, a cloud would be placed on Petitioner's title in and to its trademark MISTER DONUT and MISTER DONUT with Design, and on its right to enjoy the free and exclusive use thereof in connection with the sale of its goods and services, all to the great injury of Petitioner.

21. A duplicate Petition for Cancellation is being filed herewith along with the filing fee required pursuant to §2.6(a)(16).

WHEREFORE, Petitioner deems that it is or will be damaged by the continued registration of U.S. Reg. Nos. 0,833,808, 1,084,143, 1,084,144, 2,362,262, 2,366,396, 0,858,691, 0,859,016 and 1,120,124.

The Commissioner is hereby authorized to charge \$5,700 (the filing fee of \$300 for each of the 19 classes) or otherwise the total number of live classes in the above stated registration numbers to Deposit Account No. 23-0920. The Commissioner is authorized to charge any additional fees, which may be required, or credit any overpayment, to Deposit Account No. 23-0920.

The undersigned Petitioner hereby consents and appoints Brett M. Tolpin, Gerald T. Shekleton, John L. Ambrogi and the Attorneys of Welsh & Katz, Ltd. as its duly authorized agents and attorneys in the matter of the Cancellation identified above, to prosecute said Cancellation, to transact all business in the United States Trademark Office and in the United States Courts in connection with this Cancellation, sign

Petitioner's name to all papers, which may hereinafter be filed in connection therewith,
and to receive all communications relating to the same.

Respectfully submitted,



Brett M. Tolpin
Gerald T. Shekleton
John L. Ambrogi
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500
Attorneys for Petitioner

CERTIFICATE OF EXPRESS MAIL

I hereby certify that the foregoing Notice of Cancellation of DD IP Holder LLC's Registrations is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Box TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this date:

07/07/06

Carl Stanley

Express Mail No. EV737705824US

TTAB

WELSH & KATZ, LTD.

Attorneys at Law

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LAURA A. LABEOTS, Ph.D.

DONALD L. WELSH (1928-1998)

* ALSO ADMITTED IN DISTRICT OF COLUMBIA
** ALSO ADMITTED IN ALABAMA

July 7, 2006

Box TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: River West Brands LLC, Petitioner v.
DD IP Holder LLC, Registrant
Cancellation No.: Not Yet Assigned
Our File No. 9416-97737

I hereby certify that this paper is being deposited with the United States Postal Service as Express Mail in an envelope addressed to: Box TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this date:

07/07/06 *Carl Stantey*
Date
Express Mail No. EV737705824US

Dear Sir or Madam:

Enclosed are the following documents:

- 1. Notice of Cancellation of DD IP Holder LLC's Registrations (in duplicate); and
- 2. Postcard.

The Commissioner is hereby authorized to charge any fees, which may be required, or credit any overpayment to Deposit Account No. 23-0920. A duplicate copy of this letter is enclosed.

Very truly yours,

WELSH & KATZ, LTD.

By: *Brett M. Tolpin*
Brett M. Tolpin



07-07-2006

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

United States Patent & Trademark Office

Commissioner for Trademark

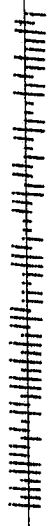
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92046084

MISTER DONUT OF AMERICA, INC.
 89 PROVIDENCE HIGHWAY
 WESTWOOD, MA 01981

