

ESTTA Tracking number: **ESTTA380843**

Filing date: **11/29/2010**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Andre-Boudin Bakeries, Inc.		
Entity	Corporation	Citizenship	California
Address	221 Main Street, Suite 1250 San Francisco, CA 94105 UNITED STATES		

Attorney information	Karen S. Frank Coblentz, Patch, Duffy & Bass, LLP One Ferry Building, Suite 200 San Francisco, CA 94111 UNITED STATES tm@cpdb.com, ksf@cpdb.com Phone:(415)391-4800		
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Registrations Subject to Cancellation

Registration No	1500039	Registration date	08/09/1988
Registrant	HOSTESS BRANDS, INC. SUITE 600, 6031 CONNECTION DRIVE IRVING, TX 75039 UNITED STATES		

Goods/Services Subject to Cancellation

Class 030. First Use: 1973/12/31 First Use In Commerce: 1973/12/31 All goods and services in the class are cancelled, namely: BREAD
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Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)		
Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods	Uruguay Round Agreements Act section 2(9)		
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Abandonment	Trademark Act section 14		
Registration No	1848412	Registration date	08/02/1994
Registrant	HOSTESS BRANDS, INC. SUITE 600, 6031 CONNECTION DRIVE IRVING, TX 75039 UNITED STATES		

Goods/Services Subject to Cancellation

Class 030. First Use: 1992/07/13 First Use In Commerce: 1993/04/13 All goods and services in the class are cancelled, namely: bread
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Grounds for Cancellation

Deceptiveness	Trademark Act section 2(a)
Geographic indication which, if used on or in connection with wine or spirits, identifies a place other than the origin of the goods	Uruguay Round Agreements Act section 2(9)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	PetitiontoCancel_Hostess.PDF (7 pages)(411819 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/ksf/
Name	Karen S. Frank
Date	11/29/2010

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

3)	Trademark Registrations:
4	ANDRE-BOUDIN BAKERIES, INC.)	Mark: THE ORIGINAL SAN FRANCISCO
5)	SOURDOUGH SINCE 1856 and Design
6	Petitioner,)	Registration No: 1,500,039
7)	Registration Date: August 9, 1988
8	v.)	
9)	Mark: AUTHENTIC SAN FRANCISCO
10	HOSTESS BRANDS, INC.)	SOURDOUGH SINCE 1856 and Design
11)	Registration No.: 1,848,412
12	Registrant.)	Registration Date: August 2, 1994

13 **PETITION TO CANCEL**

14 Andre-Boudin Bakeries, Inc., a California corporation with an address of 221 Main Street,
15 San Francisco, CA 94105 ("Petitioner"), believes that it is or will be damaged by Registration
16 Nos. 1,500,039 and 1,848,412 (the "Registrations") and hereby petitions to cancel the same. In
17 support of its Petition to Cancel, Petitioner alleges the following:

18 1. On December 23, 1985, Respondent's predecessor in interest filed Application
19 Serial No. 73/574,602 in the United States Patent and Trademark Office ("PTO") to register THE
20 ORIGINAL SAN FRANCISCO SOURDOUGH SINCE 1856 ("Respondent's ORIGINAL
21 Mark") in Class 30 for bread, based on use in commerce since at least as early as December 31,
22 1973.

23 2. As evidence of use of Respondent's ORIGINAL Mark, Respondent's predecessor
24 submitted a photograph of packaging for Parisian-brand sourdough bread, produced in San
25 Francisco, with Respondent's ORIGINAL Mark on the packaging.
26

27 3. Respondent's ORIGINAL Mark registered on August 9, 1988.
28

1 4. On May 24, 1993, Respondent's predecessor in interest filed Application Serial No.
2 74/393,660 in the United States Patent and Trademark Office ("PTO") to register AUTHENTIC
3 SAN FRANCISCO SOURDOUGH SINCE 1856 ("Respondent's AUTHENTIC Mark ") in Class
4 30 for bread, based on use in commerce since at least as early as April 13, 1993.

5 5. As evidence of use of Respondent's AUTHENTIC Mark, Respondent's predecessor
6 submitted a photograph of packaging for Parisian-brand sourdough bread, produced in San
7 Francisco, with Respondent's AUTHENTIC Mark on the packaging.

8 6. On February 17, 1994, Respondent's predecessor in interest filed a Declaration of
9 Continued Use of Respondent's ORIGINAL Mark under Section 8 of the Lanham Act. As
10 evidence of the continued use of Respondent's ORIGINAL Mark, Respondent's predecessor
11 submitted a photograph of packaging for Parisian-brand sourdough bread, produced in San
12 Francisco, with Respondent's ORIGINAL Mark on the packaging.

13 7. Respondent's AUTHENTIC Mark registered on August 2, 1994.

14 8. On August 26, 1999, Respondent filed a Declaration of Continued Use for
15 Respondent's AUTHENTIC Mark under Section 8 of the Lanham Act. As evidence of the
16 continued use of Respondent's AUTHENTIC Mark, Respondent submitted a photograph of
17 packaging for Parisian-brand sourdough bread, produced in San Francisco, with Respondent's
18 AUTHENTIC Mark on the packaging.

19 9. On November 3, 2004, Respondent filed a Declaration of Continued Use and
20 Application for Renewal for Respondent's AUTHENTIC Mark under Sections 8 and 9 of the
21 Lanham Act. As evidence of the continued use of Respondent's AUTHENTIC Mark, Respondent
22 submitted a photograph of packaging for Parisian-brand sourdough bread, produced in San
23 Francisco, with Respondent's AUTHENTIC Mark on the packaging.

24 10. Respondent's AUTHENTIC Mark was renewed on February 18, 2005.

1 11. On information and belief, in August 2005, Respondent closed its San Francisco
2 Parisian bakery, ceased manufacturing the Parisian-brand sourdough bread, destroyed the original
3 and authentic San Francisco sourdough mother dough with which the original and authentic
4 Parisian-brand sourdough bread was manufactured, and ceased all use of Respondent's
5 ORIGINAL Mark and Respondent's AUTHENTIC Mark, with no intention to resume use of the
6 Marks.
7

8 12. On June 27, 2008, Respondent filed a Combined Declaration of Use in Commerce
9 Application for Renewal of Registration for Respondent's ORIGINAL Mark under Sections 8 and
10 9 of the Lanham Act. As evidence of the continued use of Respondent's ORIGINAL Mark,
11 Respondent submitted a photograph showing Respondent's ORIGINAL Mark used on a shelf tag
12 with Colombo brand San Francisco Style Sandwich Rolls on the shelf ("Respondent's Current
13 Goods").
14

15 13. On information and belief, Respondent's Current Goods are manufactured in
16 Oakland, California and are not manufactured with original, authentic San Francisco sourdough
17 mother dough.

18 14. Respondent's ORIGINAL Mark was renewed on August 19, 2008.

19 15. Petitioner is the owner of Application Serial No. 77/941,847 for the mark THE
20 ORIGINAL SAN FRANCISCO SOURDOUGH ("Petitioner's Mark"), filed on February 22,
21 2010.
22

23 16. Petitioner has used the mark THE ORIGINAL SAN FRANCISCO SOURDOUGH
24 on and in connection with sourdough bread made from original and authentic San Francisco
25 sourdough mother dough, and produced in San Francisco, in commerce, since at least as early as
26 May 2008 and is now using Petitioner's Mark.
27

28 //

1 **FIRST GROUND FOR RELIEF**

2 Under 15 U.S.C. § 1064(3)

3 17. Petitioner incorporates by reference paragraphs 1 through 16 as if fully set forth
4 herein.

5 18. Respondent's registration for Respondent's ORIGINAL Mark was renewed
6 fraudulently in that, in the formal renewal papers filed by Respondent under declaration,
7 Respondent claimed to be using Respondent's ORIGINAL Mark in connection with its product,
8 Colombo-brand sandwich rolls.
9

10 19. This statement is false in that, on information and belief, the true facts are that
11 Respondent has never used Respondent's ORIGINAL Mark in connection with Colombo-brand
12 sandwich rolls.

13 20. This false statement was made by an authorized agent of Respondent with the
14 knowledge and belief that the statement was false. This false statement was made with the intent
15 to induce authorized agents of the U.S. Patent and Trademark Office to renew the registration for
16 Respondent's ORIGINAL Mark and, reasonably relying upon the truth of the false statements, the
17 U.S. Patent and Trademark Office did, in fact, renew the Registration for Respondent's
18 ORIGINAL Mark.
19

20 21. Petitioner is damaged by said false statement and the Renewal of Respondent's
21 ORIGINAL Mark issued in reliance thereon in that Petitioner has continuously used the mark
22 THE ORIGINAL SAN FRANCISCO SOURDOUGH on and in connection with bread in
23 commerce since at least 2008 and Petitioner's ability to register and continue to use Petitioner's
24 Mark will be impaired by the continued registration of Respondent's ORIGINAL Mark.
25

26 **SECOND GROUND FOR RELIEF**


27 Under 15 U.S.C. § 1052(e)
28

1 29. On information and belief, Respondent abandoned its ORIGINAL Mark and its
2 AUTHENTIC Mark by discontinuing use of the marks upon closure of Respondent's San
3 Francisco-based Parisian bakery, more than 3 years ago, and without an intention to resume the
4 use. Petitioner is likely to be damaged by continuance of Respondent's Registrations in that
5 Petitioner, since at least as early as May 2008 has continuously used Petitioner's Mark on and in
6 connection with bread, and Petitioner's continued use and legal use of Petitioner's Mark will be
7 impaired by the continued registration of the abandoned Respondent's Marks.
8

9 On the foregoing grounds, Petitioner requests that U.S. Registrations Nos. 1,500,039 and
10 1,848,412 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.
11

12 DATED: November 29, 2010

Respectfully submitted,

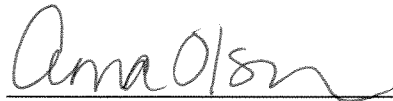
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14 By: 
15 Karen S. Frank
16 Jeffrey G. Knowles
17 Coblenz, Patch, Duffy & Bass LLP
18 Attorneys for Petitioner,
19 Andre-Boudin Bakeries, Inc.
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CERTIFICATE OF SERVICE

I, Anna Olson, certify that on this 29th day of November, 2010 I caused to be mailed by overnight courier a copy of the enclosed "Petition to Cancel" to the following:

Thomas H. Van Hoozer
Hovey Williams LLP
84 Corporate Woods
10801 Mastin Blvd., Suite 1000
Overland Park KS 66210



Anna Olson