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

Proceeding	92057222
Party	Defendant Chick-N-Joy Systems Limited
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Registrant: Chick-N-Joy Systems Limited Registration No.: 3567736 Registration Date: January 27, 2009 Mark: CHICK-N-JOY _____ Jollibee Foods Corporation, Petitioner, v. Chick-N-Joy Systems Limited Registrant. _____	)	Cancellation No. 92057222

REGISTRANT CHICK-N-JOY'S REPLY BRIEF ADDRESSING MISSTATEMENTS OF FACT AND LAW BY PETITIONER

Registrant Chick-N-Joy Systems Limited ("Chick-N-Joy") is cognizant of the Board's preference that the parties not file reply briefs. Chick-N-Joy, however, feels compelled to file this 4 page Reply Brief to directly respond to misstatements of fact and law by Petitioner Jollibee Foods Corporation ("Jollibee").

A. Jollibee misstates the Abandonment Standard by stating that Chick-N-Joy's intent "does not matter."

Jollibee represents that the law is that when the Board analyzes whether Chick-N-Joy abandoned the mark that Chick-N-Joy's intent "**does not matter**." Jollibee's Response and Reply Brief, page 5. That is incorrect.

The statute itself states that "intent" is an element of proving abandonment. A mark is deemed to be abandoned if "its use has been discontinued with intent not to resume such use." 15 U.S.C. 1127(1). (Emphasis added). The Federal Circuit recognizes two distinct requirements to prove abandonment: nonuse in commerce and **intent not to use**. Exxon Corp. v. Humble Exploration Co., Inc., 695 F.2d 96, 103, n.5 (5th Cir. 1983); Emergency One, Inc. v. Am. FireEagle, Ltd., 228 F.3d 531 (Fed. Cir. 2000) (promotion of brand and business plan which evidenced continued use precluded judgment as a matter of law).

When stating that Chick-N-Joy's intent does not matter, Jollibee cites Imperial Tobacco Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 1582, 14 USPQ2d 1390, 1395 (Fed.Cir.1990). Actually, the Imperial Tobacco Court did analyze whether the registrant had "intent" to use the mark and held that the intent was not present in that case because the evidence was insufficient to excuse nonuse. The Imperial Tobacco Court could not and did not rewrite the "intent" element out of the statute. This is confirmed in a later case where the Federal Circuit cited Imperial Tobacco as **including the intent element**:

> cancellation is proper if a lack of intent to commence use in the United States accompanies the nonuse. See Imperial Tobacco Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 1582, 14 USPQ2d 1390, 1395 Fed.Cir.1990).

Rivard v. Linville, 133 F.3d 1446, 1448 (Fed Cir 1998). (Emphasis added)

Chick-N-Joy's "intent" is an element in an abandonment case. As discussed in Chick-N-Joy's Response to Jollibee's Motion for Summary Judgment and Memorandum of Law in Opposition to the Motion ("Chick-N-Joy's Response"), Chick-N-Joy's acts and conduct shows that Chick-N-Joy had the intent to use the mark since the day of registration moving forward.

B. Jollibee made a false statement when it said Chick-N-Joy provided no supporting evidence showing Chick-N-Joy's intent to use.

Jollibee states that that Chick-N-Joy provided no supporting evidence showing Chick-N-Joy's intent to use. To the contrary, Chick-N-Joy put in evidence a copy of a Chick-N-Joy's customer bag and following is on each bag: "The Chick-N-Joy name, design and related marks are trademarks of Chick-N-Joy Systems Limited." That document is in Exhibit C to Chick-N-Joy's Response.

One reason Chick-N-Joy did not use the trademark in the U.S.A. was its President George Kastanas belief that the U.S. Trademark Certificate of Registration issued on January 27, 2009 provided that Chick-N-Joy did not risk losing the trademark for non-use so long as a declaration of continued use was filed between the fifth and sixth years after the registration date. See Exhibit A, paragraphs 5, 6 and 8 to Chick-N-Joy's Response. That Certificate supplied by Chick-N-Joy is supporting written evidence and it is attached as Exhibit B to Chick-N-Joy's Response.

The Certificate provides that the "First Filing" is a "Declaration of Continued Use (or Excusable Non-use) filed between the fifth and sixth years after the registration date." See Exhibit B to Chick-N-Joy's Response. [January 27, 2015 is six years after the issuance of the Certificate].

C. Jollibee makes the misstatement that for the period of the first three years after the registration that Chick-N-Joy introduced no evidence that Chick-N-Joy intended to use the trademark.

Jollibee states that for the period of the first three years after the registration that Chick-N-Joy introduced no evidence that Chick-N-Joy intended to use the trademark. To the contrary, the evidence is that "since the day of registration" (January 27, 2009),

Chick-N-Joy spent money to have the U.S. trademark placed on every food bag made in the United States. See Exhibit A, paragraphs 19, 20 to Chick-N-Joy's Response and Exhibit C (copy of trademark on customer bag). Those acts cover the entire three year period right after the registration. Those acts are continuing and reoccurring and shed light on Chick-N-Joy's intent to use the mark. Because Chick-N-Joy intended to use the trademark it made substantial efforts and spent money to have the trademarks put on all bags made in the U.S.A.

President George Kastanas had the understanding that Chick-N-Joy did not risk losing the trademark for non-use if a declaration of continued use was filed between the fifth and sixth years after registration. That understanding was caused by the Certificate of Registration which is dated January 27, 2009. See Exhibit A, paragraphs 5, 6 and 8 to Chick-N-Joy's Response. That evidence goes back to January 27, 2009 and thus the evidence of intent to use does cover the first three year after registration- contrary to Jollibee's representation.

CONCLUSION

Jollibee finds it necessary to make misstatements of facts and incorrect statements of law. In effect, Jollibee acknowledges that an application of the actual facts to the correct law shoes that Chick-N-Joy's evidence on intent rebuts the presumption of abandonment. As such, the Board should deny Jollibee's Petition for Abandonment.

Respectfully Submitted,

_/wmm/_____
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CERTIFICATE OF SERVICE

I, William M. Mullineaux, Esquire, hereby certify that on June 25, 2014, a copy of the foregoing Registrant's Chick-N-Joy Reply Brief Addressing Misstatements of Fact and Law was sent by first class mail to counsel for Petitioner at the following address:

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