

ESTTA Tracking number: **ESTTA624475**

Filing date: **08/29/2014**

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

Proceeding	92059670
Party	Defendant TEAM INTERNATIONAL MARKETING N.V.
Correspondence Address	TEAM INTERNATIONAL MARKETING NV MIDDENHUTLAAN 1 SINT-GENESIUS-RODE, B-1640 BELGIUM
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Paulo A. de Almeida
Filer's e-mail	Paulo@PatelAlmeida.com
Signature	/Paulo A. de Almeida/
Date	08/29/2014
Attachments	MOTION TO DISMISS_KALORIK.pdf(380157 bytes )

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

JMM Lee Properties, LLC,	)	
	)	
Petitioner,	)	Cancellation No. 92059670
	)	Registration No. 3382035
v.	)	Mark: KALORIK (& Design)
	)	
Team International Marketing N.V.,	)	
	)	
Respondent.	)	

**RESPONDENT'S MOTION TO DISMISS**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, Respondent, Team International Marketing N.V. ("Respondent"), respectfully submits this Motion to Dismiss the Petition for Cancellation ("Petition") filed by Petitioner, JMM Lee Properties, LLC ("Petitioner"). The Petition constitutes a compulsory counterclaim in another proceeding (No. 92057196) which was not timely asserted. The compulsory counterclaim cannot now be brought by separate petition. Further, Petitioner has not alleged sufficient facts to state a plausible claim of "fraudulent misuse". Accordingly, the Petition should be dismissed with prejudice.

**BRIEF STATEMENT OF FACTS**

On May 7, 2013, Respondent filed a Petition to Cancel U.S. Registration No. 3890577 for the mark CALORIC, which was assigned Proceeding No. 92057196. In its petition, Respondent pleaded ownership of U.S. Trademark Registration No. 3382035 for the mark KALORIK (& Design) for "Electrical household apparatus, namely, electric

shoe polishers" in International Class 7 and "scales, electrically heated hair-curlers and electric flat irons" in International Class 9. In part based on this pleaded registration, Respondent asserted a claim of priority and likelihood of confusion with the CALORIC registration. In its Answer, Petitioner asserted as an "affirmative defense" that Respondent has engaged in "fraudulent misuse" of the ® symbol:

Petitioner knowingly and willfully misused, and continues to misuse, the ® symbol in connection with Kalorik goods, including those not registered with the Patent and Trademark Office, with the intent to mislead consumers and others into believing that the mark is registered.

Exhibit A, Answer filed in Proceeding No. 92057196, at ¶ 53.

Discovery is set to close in the related proceeding on September 17, 2014. Petitioner did not raise its "fraudulent misuse" defense as a counterclaim in the related proceeding. Instead, Petitioner filed this separate complaint alleging as its *only* claim the *identical* "fraudulent misuse" previously asserted as an "affirmative defense" in the related proceeding. See Petition at 1.

**THE PETITION IS A COMPULSORY COUNTERCLAIM NOT TIMELY  
ASSERTED IN ANOTHER PROCEEDING**

The Board cannot entertain an attack upon the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration. TBMP § 313.01. If the defendant knows the grounds for a counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the answer. If grounds are learned during the course of the proceeding, through discovery or otherwise, the counterclaim must be pleaded promptly after the grounds therefor are learned. TBMP §313.04.

A defendant who fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. In such a case, the separate petition will be dismissed, on motion, on the ground that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that it was not timely asserted." *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986).

Here, Petitioner asserts the *identical* claim of "fraudulent misuse" previously asserted as its "affirmative defense" in the answer filed in Proceeding No. 92057196:

Petitioner knowingly and willfully misused, and continues to misuse, the ® symbol in connection with Kalorik goods, including those not registered with the Patent and Trademark Office, with the intent to mislead consumers and others into believing that the mark is registered.

Answer, Proceeding No. 92057196, at ¶ 53.

The instant Petition contains the exact same language:

Petitioner knowingly and willfully misused, and continues to misuse, the ®symbol in connection with Kalorik goods, including those not registered with the Patent and Trademark Office, with the intent to mislead consumers and others into believing that the mark is registered.  
Petition at ¶ 9.

By alleging "fraudulent misuse" as an affirmative defense, Petitioner clearly knew of the factual basis for its counterclaim upon filing its answer in the related proceeding.

Inasmuch as Petitioner knew about the claim, the claim was compulsory and required to be timely raised with the answer. Petitioner failed to raise the compulsory counterclaim and "cannot now avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel". TBMP §313.04; *See Vitaline, supra*, 891 F.2d

at 273. Accordingly, the Petition should be dismissed on the ground that it consists of a compulsory counterclaim not timely raised in a related proceeding.

**THE PETITION DOES NOT STATE A PLAUSIBLE CLAIM FOR RELIEF**

If the Board does not dismiss the Petition as an untimely raised compulsory counterclaim, the Board should find that the alleged facts do not sufficiently state a claim for "fraudulent misuse".

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is . . . a valid ground exists for . . . canceling the subject registration. To survive a motion to dismiss, a complaint must "state a claim to relief that is plausible on its face". TMBP § 503.02; *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1950, 173 L. Ed. 2d 868 (2009) ("[O]nly a complaint that states a plausible claim for relief survives a motion to dismiss"); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 545, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007) ("Asking for plausible grounds does not impose a probability requirement at the pleading stage; it simply calls for enough facts to raise a reasonable expectation that discovery will reveal evidence [to support plaintiff's claims]").

Improper use of the federal registration symbol, ®, that is deliberate and intends to deceive or mislead the public or the USPTO is fraud. TMEP § 906.04; *See Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991).

Here, Petitioner's claim of "fraudulent misuse" is based on the following factual allegations:

- "Respondent knowingly and willfully misused, and continues to misuse, the "®" symbol in connection with KALORIK goods, including those not registered with the Patent and Trademark Office, with the intent to mislead consumers and others into believing that the mark is registered"; *id.* at ¶ 9;
- the CEO of TEAM KALORIK GROUP (a different entity, not Respondent) "offered JMM Lee \$300,000 to purchase Petitioner's rights to the CALORIC mark"; *id.* at ¶ 11;
- Respondent "continues to misuse the registration symbol "®" on goods not registered with the [USPTO]"; *id.* at ¶ 12;
- such misuse "also extends to goods without an active USPTO trademark application, including juicers, water kettles and wine coolers"; *id.* at ¶ 13;
- Respondent "undoubtedly should have known that use of the registration symbol in connection with goods without any form of USPTO filing is in violation of U.S. Trademark law"; *id.* at ¶ 14;
- "Electrically operated KALORIK branded products sold within the United States utilize 110 volt 60 cycle electrical outlets which proprietary to North America";
- "KALORIK branded products sold in Europe must utilize 220 volt 50 cycle electrical outlets which are not compatible with North American outlets; *id.* at ¶ 16; and
- "Internet archives, packaging material and home appliances sold by Team International displayed the registration symbol "®" adjacent to the KALORIK name going back as far as 2008 and as recently as 2014" on goods "includ[ing]

but [not] limited to, toasters, bread makers, coffee makers, grills, waffle makers, blenders, and food processors". *Id.* at ¶ 17.

These facts do not establish a claim that is plausible on its face. Notably, none of the allegations even addresses the goods listed in the registration sought to be cancelled, namely, "Electrical household apparatus, namely, electric shoe polishers" in International Class 7 and "scales, electrically heated hair-curlers and electric flat irons" in International Class 9. Petitioner avers *generally* that Respondent has "misused" the "®" symbol on "goods not registered with the [USPTO]" and specifies among them "juicers, water kettles, wine coolers, toasters, bread makers, coffee makers, grills, waffle makers, blenders, and food processors"; but none of those goods are at issue, and any "misuse" of the symbol on goods outside of those listed in the registration is irrelevant. Simply stated, the registration is not subject to cancellation based on alleged "misuse" of the symbol for goods that have nothing to do with the registration. Nor does Respondent state with particularity *when* the alleged "misuse" occurred (use of "®" for the relevant goods after registration is Respondent's right) or even allege a *single* fact in support of its bald legal conclusion that Respondent had the "intent to mislead consumers and others into believing that the mark is registered". The foregoing facts, even if assumed to be true, do not state a plausible claim of "fraudulent misuse".

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**CONCLUSION**

Based on the foregoing, the Petition for Cancellation should be dismissed with prejudice.

Dated: August 29, 2014

Respectfully Submitted,

By: /Paulo A. de Almeida/  
Paulo A. de Almeida  
Alex D. Patel  
Patel & Almeida, P.C.  
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(818) 380-1900

Attorneys for Respondent,  
Team International Marketing N.V.



**PROOF OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **RESPONDENT'S MOTION TO DISMISS** has been served on JMM Lee Properties, LLC, the owner of Reg. No. 3890577 as listed in the USPTO database, on August 29, 2014, via First Class U.S. Mail, postage prepaid to:

JMM LEE PROPERTIES, LLC  
2807 ANTIGUA DR  
BURBANK, CALIFORNIA 91504-1808  
UNITED STATES

/Paulo A. de Almeida/

Paulo A. de Almeida

# EXHIBIT A

ESTTA Tracking number: **ESTTA544631**

Filing date: **06/24/2013**

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

Proceeding	92057196
Party	Defendant JMM Lee Properties, LLC
Correspondence Address	JMM LEE PROPERTIES LLC 2807 ANTIGUA DRIVE BURBANK, CA 91504-1808 UNITED STATES mlee@thorappliances.com
Submission	Answer
Filer's Name	Michael J Lee
Filer's e-mail	mlee@jmmlee.com
Signature	/Michael J Lee/
Date	06/24/2013
Attachments	CaloricCancelResponse.pdf(236852 bytes )

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

In the Matter of Registration No: 3890577  
Trademark: Caloric

Team International Marketing N.V.	)	
Petitioner	)	
	)	Cancellation No. 92057196
	)	
v.	)	
	)	
JMM Lee Properties, LLC	)	
Respondent	)	

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

**ANSWER TO PETITION FOR CANCELLATION**

JMM Lee Properties, LLC, a Limited Liability Company organized and existing under the State of California, located at 2807 Antigau Dr., Burbank, CA 91504 (“Respondent”), hereby answers The Petition for Cancellation of Team International Marketing N.V., a corporation of Belgium (“Petitioner”) as follows:

1. The phrase "household and cooking appliances" in paragraph 1 of the Petition for Cancellation is without definition as it relates to the specific goods allegedly sold by Petitioner. Furthermore, the phrase "one of the world's leading providers" in Paragraph 1 appears to be speculation or opinion, and not a statement of fact, and therefore is not appropriate for admission

or denial. Accordingly, Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Petition for Cancellation and, therefore, denies such allegations.

2. The phrase "various household and kitchen appliances" is without definition as it relates to the specific goods allegedly sold by Petitioner under the Kalorik name in paragraph 2 of the Petition for Cancellation. Accordingly, Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2 of the Petition for Cancellation and, therefore, denies such allegations.

3. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Petition for Cancellation and, therefore, denies such allegations.

4. Respondent admits that Petitioner has a registered trademark for Kalorik (Reg. No. 3382035) in connection with "[e]lectrical household apparatus, namely, electric shoe polishers" in International class 07 and "scales, electrically heated hair-curlers and electric flat irons" in International class 09. Respondent also acknowledges that Petitioner has applied for the Kalorik mark (Serial No: 85664850) in connection with the household appliances cited in paragraph 4 of the petition, but does not have a registered trademark for these goods. Respondent is without knowledge or information sufficient to form a belief as to the remaining

allegations made in paragraph 4 of the Petition for Cancellation and, therefore, denies such allegations.

5. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Petition for Cancellation and, therefore, denies such allegations.

6. Respondent admits the allegations in paragraph 6 of the Petition for Cancellation.

7. Respondent admits that it filed an intent to use trademark application on Jul. 29, 2008 (Serial No: 77534035) for "GAS AND ELECTRIC COOKING APPLIANCES, NAMELY, RANGES, MICROWAVE OVENS, BARBEQUE GRILLS, COOKTOPS AND KITCHEN RANGE HOODS" in class 011.

8. Respondent admits the allegations in paragraph 8 of the Petition for Cancellation.

9. Respondent admits the allegations in paragraph 9 of the Petition for Cancellation

10. Respondent admits an application filing date of July 29, 2008 for its Caloric® mark. Respondent is without knowledge or information sufficient to form a belief as to the remaining allegations made in paragraph 10 of the Petition for Cancellation and, therefore, denies such allegations.

11. Respondent denies the allegations contained in paragraph 11 of the Petition for Cancellation.

12. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 12 of the Petition for Cancellation and, therefore, denies such allegations.

13. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 13 of the Petition for Cancellation and, therefore, denies such allegations.

14. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 14 of the Petition for Cancellation and, therefore, denies such allegations.

15. Respondents admits that the registration date of Feb. 12, 2008 for Petitioner's Kalorik registration (Reg. No. 3382035) in connection with "[e]lectrical household apparatus, namely, electric shoe polishers" in International class 07 and "scales, electrically heated hair-curlers and electric flat irons" in International class 09, predates Respondent's filing date of July 29, 2008 for its Caloric® mark (Reg. No: 77534035) for "GAS AND ELECTRIC COOKING APPLIANCES, NAMELY, RANGES, MICROWAVE OVENS, BARBEQUE GRILLS, COOKTOPS AND KITCHEN RANGE HOODS" in class 011. Respondent is without

knowledge or information sufficient to form a belief as to the remaining allegations made in Paragraph 15 of the Petition for Cancellation and, therefore, denies such allegations.

16. The phrase "acquired rights" is without definition in paragraph 16 in the Petition for Cancellation. Accordingly, Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 16 of the Petition for Cancellation and, therefore, denies such allegations.

17. Respondent denies the allegations contained in paragraph 17 of the Petition for Cancellation.

18. Respondent denies the allegations contained in paragraph 18 of the Petition for Cancellation. Petitioner intentionally mischaracterizes the facts related to discussions about the sale of Respondent's Caloric mark to Petitioner. In fact, Petitioner approached Respondent's licensing agent and offered to purchase the Caloric mark.

19. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 19 of the Petition for Cancellation and, therefore, denies such allegations.

20. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 20 of the Petition for Cancellation and, therefore, denies such allegations.



21. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 21 of the Petition for Cancellation and, therefore, denies such allegations.

22. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 22 of the Petition for Cancellation and, therefore, denies such allegations.

23. Respondent denies the allegations contained in paragraph 23 of the Petition for Cancellation.

24. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 24 of the Petition for Cancellation and, therefore, denies such allegations.

25. Respondent repeats and re-avers its answers to paragraphs 1 through 24 above, and incorporates such answers by reference.

26. Respondent denies the allegations contained in paragraph 26 of the Petition for Cancellation.

27. Respondent denies the allegations contained in paragraph 27 of the Petition for Cancellation.

28. Respondent denies the allegations contained in paragraph 28 of the Petition for Cancellation.

29. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 29 of the Petition for Cancellation and, therefore, denies such allegations.

30. Respondent repeats and re-avers its answers to paragraphs 1 through 29 above, and incorporates such answers by reference.

31. Respondent denies the allegations contained in paragraph 31 of the Petition for Cancellation.

32. Respondent denies the allegations contained in paragraph 32 of the Petition for Cancellation.

33. Respondent denies the allegations contained in paragraph 33 of the Petition for Cancellation.

34. Respondent denies the allegations contained in paragraph 34 of the Petition for Cancellation.

35. Respondent denies the allegations contained in paragraph 35 of the Petition for Cancellation.

36. Respondent denies the allegations contained in paragraph 36 of the Petition for Cancellation.

37. Respondent denies the allegations contained in paragraph 37 of the Petition for Cancellation.

38. Respondent denies the allegations contained in paragraph 38 of the Petition for Cancellation.

39. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 39 of the Petition for Cancellation and, therefore, denies such allegations.

**First Affirmative Defense  
[Unclean Hands]**

40. As the first Affirmative Defense, Respondent submits that Petitioner is barred from maintaining this Petition for Cancellation by the equitable doctrine of Unclean Hands.

41. Petitioner is the owner of U.S. Trademark (Reg. No. 3382035) for the mark Kalorik (& Design) in connection with "[e]lectrical household apparatus, namely, electric shoe polishers" in International class 07 and "scales, electrically heated hair-curlers and electric flat irons" in International class 09.

42. Petitioner claims to have marketed and sold its goods under its Kalorik mark to consumers in the United States since May of 2006, including electrical household apparatus, namely electric shoe polishers, in International class 07.

43. Despite Petitioner's claims of widespread marketing and sale of electric shoe polishers in class 07 under the Kalorik trademark since May 2006, Internet archives indicate that Kalorik did not sell shoe polishers until at least early 2012.

44. Listed in the "coming soon" section of Petitioner's Kalorik.com web site from at least September 2008 through at least February 2012 was an electric shoe polisher. Neither the Kalorik.com web site nor the Kalorik catalog lists shoe polishers for sale prior to 2012. The 2012 launch of Petitioner's first shoe polisher product is noticeably later than use dates cited in its Petition for Cancellation and trademark application.

45. On information and belief, Petitioner made knowingly false claims as to its use of the Kalorik mark on shoe polishers in class 07.

46. Assertion of the defense of unclean hands "may result from any imaginable immoral or illegal conduct" *See 3 J. Gilson Trademark Protection and Practice §8.12[13] (1999)*, including such conduct by Petitioner to willfully mislead the United States Patent and Trademark Office ("USPTO") and Respondent in order to fraudulently claim first use of the Kalorik mark under class 07.

**Second Affirmative Defense  
[Laches]**

47. Respondent hereby incorporates by reference the allegations contained in paragraphs 40 through 46 herein.

48. As the second Affirmative Defense, Respondent submits that Petitioner is barred from maintaining this Petition by laches. Specifically, Petitioner delayed asserting its alleged rights to the Kalorik mark for over four (4) years. Petitioner did not oppose Respondent's Caloric® mark (Reg. No: 3890577) during the opposition period beginning Dec 2, 2008, nor did petitioner file an opposition to Respondent's subsequent application for Caloric®, which published for opposition on Aug. 21, 2012.

49. On information and belief, Petitioner knew or should have known of Respondent's senior registration of the Caloric® mark in connection with home appliances including "GAS AND ELECTRIC COOKING APPLIANCES, NAMELY, RANGES, MICROWAVE OVENS, BARBEQUE GRILLS, COOKTOPS AND KITCHEN RANGE HOODS" in class 011. If Petitioner believed that it would be harmed by the registration of Respondent's Caloric mark, it should have taken the opportunity to oppose such registration during the opposition period.

**Third Affirmative Defense  
[Fraud]**

50. Respondent hereby incorporates by reference the allegations contained in paragraphs 40 through 49 herein.

51. As the third Affirmative Defense, Respondent submits that Petitioner's misuse of the trademark registration symbol ® on goods sold under the Kalorik name constitutes fraud.

52. Petitioner's initial trademark application for the Kalorik mark (U.S. Ser No: 79014218 ) encompassed a wide range of goods including "[e]lectric beaters, electromechanical beverage preparation machines, electric can openers, coffee grinders other than hand-operated; electric crushers and grinders for household purposes; electric knives; electric shoe polishers, electric blenders for household purposes; electric mixers for household purposes; electric food processors; vacuums for household purposes; juice machines" in class 07. Due to what the USPTO deemed to be a likelihood of confusion with another registered trademark, Petitioner agreed to limit its trademark registration under class 07 to include only electric shoe polishers.

53. Despite Petitioner's limited trademark registration covering only electric shoe polishers in class 07, Petitioner knowingly and willfully misused, and continues to misuse, the ® symbol in connection with Kalorik goods, including those not registered with the Patent and Trademark Office, with the intent to mislead consumers and others into believing that the mark is registered. "The improper use of a registration notice in connection with an unregistered mark, if done with intent to deceive the purchasing public or others in the trade into believing that the mark is registered, is a ground for denying the registration of an otherwise registrable mark." *Copelands' Enterprises Inc. v. CNV Inc., 20 USPQ2d 1295, 1298 (Fed. Cir. 1991).*

54. Petitioner's subsequent Kalorik trademark application with a filing date of Jun. 28, 2012 (Serial No: 85664850) lists many of the goods that appeared in Petitioner's original (later scaled down to include only shoe polishers) application, indicating that Petitioner knew, or should have known, that such goods were not a part of its active but limited Kalorik registration.

**Fourth Affirmative Defense  
[Estoppel]**

55. Respondent hereby incorporates by reference the allegations contained in paragraphs 40 through 54 herein.

56. As the fourth Affirmative Defense, Respondent submits that Petitioner is estopped from maintaining this Petition for Cancellation by the doctrine of Equitable Estoppel.

57. Equitable Estoppel is applied when a party takes a position factually inconsistent from its prior position. "There is a kind of evidential estoppel which, through it may not amount to a complete estoppel in pais, is raised when persons who have spoken or acted one way under one set of circumstances, and with one objective in mind, undertake under other circumstances and when their objective has changed, to testimonially give a different color to what they formally said and did." *Holly Hill Citrus Growers' Ass'n v. Holly Hill Fruit Prods. Inc.*, 75 F.2d 13 17 (5th Cir. 1935).

58. Petitioner was issued a Provisional Full Refusal on Jan. 16, 2006 by the USPTO for its Kalorik trademark application (U.S. Ser No: 79014218) in connection with the

aforementioned list of household kitchen appliances. This refusal was based on, among other things, a likelihood of confusion with the Caloric® mark owned by Raytheon Company (Reg. No: 827817) in connection with "[w]aste food disposers" in class 09.

58. In response to the Provisional Full Refusal, Petitioner argued that there was no likelihood of confusion because "while the two marks are phonetically the same, the dissimilar appearance of Caloric® and the stylized Kalorik logo give a different appearance and connotation to the two marks." Petitioner further contended that when each mark is considered in its entirety, the overall general impression given by the two marks is entirely different.

60. Respondent's claim of equitable estoppel is based on Petitioner's statements made in response to the Provisional Full Refusal, but also on its subsequent actions. Petitioner argued against a likelihood of confusion between Caloric® and Kalorik and, more importantly, began selling Kalorik goods in the marketplace as if no confusion existed.

61. Petitioner claims use of the Kalorik mark on a wide range of kitchen appliances including goods listed on Petitioner's trademark application (Ser No: 85664850) beginning on January 1, 2006 under class 7 and January 2, 2007 for goods listed under class 11. As cited in the Provisional Full Refusal, Raytheon Company had an active registration for the Caloric mark for Waste Food Disposers; a registration that remained active until Feb. 02, 2008. Petitioner's sale of goods under the Kalorik mark; a mark that was deemed by the USPTO to be confusingly



similar to Raytheon's Caloric mark, demonstrates that Petitioner rejected the confusingly similar position taken by the USPTO in its refusal.

62. Petitioner's claim of a likelihood of confusion cited in the Petition for Cancellation takes a position that is factually inconsistent, in both statement and action, with its earlier position that the two marks are dissimilar, and therefore the principle of equitable estoppel applies here.

**Fifth Affirmative Defense  
[No Likelihood of Confusion]**

63. Respondent hereby incorporates by reference the allegations contained in paragraphs 40 through 62 herein.

64. As the Fifth Affirmative Defense, Respondent submits that Petitioner lacks exclusive rights superior to those of Respondent, and therefore is unable to meet its burden of proof with regard to the allegation of the likelihood of confusion.

WHEREFORE, Registrant prays that the Petition for Cancellation be denied.

Respectfully Submitted,

/Michael J. Lee/  
Michael J. Lee  
JMM Lee Properties, LLC  
2807 Antigua Dr.  
Burbank, CA 91504  
(206) 850-6596  
Mlee@jmmlee.com

June 24, 2013

*In the Matter of U.S. Registration No. 3890577  
In the name of JMM Lee Properties, LLC  
Cancellation No: 92057196  
Mark: Caloric*

**CERTIFICATE OF SERVICE**

I hereby certify that on June 24, 2013 a copy of the foregoing Answer to Petition for Cancellation is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the attorneys for Petitioner as follows:

Patel & Almeida, P.C.  
16830 Ventura Blvd., Suite 360  
Encino, CA 91436

/Michael J. Lee/  
JMM Lee Properties, LLC