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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92060914
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United States Patent & Trademark Office
Trademark Trial & Appeal Board

Cancellation No. 92060914
WHITE CHOCOLATE & CHIPS

Snow Ball's Chance, Ltd.
v.
SnoWizard, Inc.

Trial Brief of Petitioner Snow Ball's Chance, Ltd.

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Competing manufacturers and suppliers of flavor concentrates are able to differentiate themselves by their service and by their different registered-trademark brand names, and do not need to commandeer flavor names for that purpose. 16

Respondent SnoWizard has clearly and explicitly stated that it does not assert nor exercise any trademark rights in any flavor name at the snowball making and consuming level. Therefore, SnoWizard has failed to establish, police, or protect any trademark right in any flavor name, and cannot invent such rights for a flavor concentrate whose only purpose is as a precursor ingredient for producing a snowball which has a generic flavor name.. 17

If Respondent SnoWizard's assertion of a 1986 first use is credited, SnoWizard's use of the term on its own goods was functional, generic, and descriptive, without any assertion of trademark, for decades. 18

A competing supplier had been offering a "White Chocolate & Chips" flavor concentrate since 1996.. 19

Respondent SnoWizard did not even start to apply for registration of WHITE CHOCOLATE & CHIPS until 7 months after civil litigation about that same purported mark had already commenced. 19

Respondent SnoWizard filed a second repetitive and duplicative application for registration of WHITE CHOCOLATE & CHIPS after being soundly denied, after appeal to the TTAB, in the first application. 19

In the first application, in rejecting SnoWizard's claim of acquired distinctiveness, the examining attorney initially identified 4 third parties making descriptive use of the term, and the TTAB panel noted such third-party uses in affirming the refusal to register. Afterward, the examining attorney identified 8 additional third-party descriptive uses in the record. . . 21

Respondent SnoWizard made misleading statements of known falsity regarding substantially exclusive use of WHITE CHOCOLATE & CHIPS, for the purpose of obtaining a registration to which it was not entitled, where the truth, if known to the USPTO, would have prevented such registration. 22

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Trial Brief of Petitioner Snow Ball's Chance, Ltd.

Snow Ball's Chance, Ltd., Petitioner in the captioned cancellation proceeding, submits this Trial Brief.

Procedural Background

Petitioner is Snow Ball's Chance, Ltd., a Louisiana corporation, domiciled at 110 Ridgelake Dr., Metairie, LA 70001, operating a snowball stand at 9231 Lake Forest Dr., New Orleans, LA 70127, who initiated this Cancellation proceeding on 20-FEB-2015 to cancel Registration No. 4,157,907 on the Principal Register for WHITE CHOCOLATE & CHIPS in IC 030, for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections", which had issued to Respondent SnoWizard Holdings, Inc. on 12-JUN-2012, on the grounds that the term, which is a flavor name, is functional, generic, and merely descriptive, and that the registration was obtained by fraud.

Petitioner also on 20-FEB-2015 initiated Cancellation No. 92060915 against SnoWizard's Registration No. 4,157,906 for CAJUN RED HOT in IC 030 for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections", which had issued to Respondent SnoWizard Holdings, Inc. on 12-JUN-2012, on substantially the same grounds.

Respondent SnoWizard attempted to effect a transfer of both TTAB cancellations to federal district court by filing Civil Action No. 15-1002 in US District Court for the Louisiana Eastern District, and then filing motions to suspend in both TTAB cancellation proceedings. In an Order and a Judgment entered 25-SEP-2015, the US District Court for the Louisiana Eastern District dismissed all of SnoWizard's claims, and dismissed Civil Action 15-1002 in its entirety, under Rule 12, on the motion of Snow Ball's Chance, Ltd.

Petitioner then moved to resume both TTAB cancellations, and in both motions Petitioner directed the Board's attention to the relationship of the concurrently filed and consecutively numbered petitions for cancellation against the two concurrently issued and consecutively numbered registrations for identical goods. Respondent SnoWizard filed motions to consolidate the cancellation proceedings, which Petitioner did not oppose. The Board declined to consolidate.

Evidence

Most of the relevant facts in this matter can be established from the concordance of the trial testimony in this matter from George Miller, principal of Petitioner Snow Ball's Chance, Ltd. with sworn testimony and statements of record from Ronald Sciortino, principal of Respondent SnoWizard, Inc., including Sciortino's testimony in court, under oath, in the LAED-06-9170 civil litigation that SnoWizard itself has placed at issue in this TTAB cancellation proceeding.

Petitioner Snow Ball's Chance, Ltd. will rely on evidence including the prosecution history of the mark contained in the file wrappers for denied Application No. 77-471425, including the unsuccessful appeal to the TTAB, and for allowed Application No. 85-473205, both for WHITE CHOCOLATE & CHIPS, the filings in this Cancellation proceeding, the trial declarations of Petitioner's principal George Miller and Respondent's principal Ronald R. Sciortino, and the transcribed sworn in-court testimony of Respondent's principal Ronald R. Sciortino in Civil Action LAED-06-9170. Although Snow Ball's Chance, the Petitioner here before the TTAB, was not a party to and was not otherwise involved in the LAED-06-9170 litigation, Respondent SnoWizard has, in this TTAB proceeding, contended that Snow Ball's Chance is merely a proxy for a plaintiff against SnoWizard in the prior litigation, trying to unfairly re-litigate the few issues upon which the plaintiffs did not prevail there. Also, SnoWizard contends that the LAED-06-9170 litigation has a preclusive or controlling effect upon this TTAB cancellation proceeding. Therefore the public record in the LAED-60-9170 litigation is likely to be of use as evidence for consideration by this TTAB. And for the purposes of judicial economy, this TTAB may, in its discretion, give appropriate consideration and weight to the several statements under oath made by Respondent SnoWizard's principal Ronald R. Sciortino.

Description of the Record

1. The application file wrapper (85-473205) of the subject registration is already of record in this proceeding, and will be referenced by Petitioner Snow Ball's Chance, Ltd. Excerpted relevant pages are provided as PNR-C, comprising 20 pages.

2. The application file wrapper (77-471425) of Respondent SnoWizard's prior application for the same mark WHITE CHOCOLATE & CHIPS, including the unsuccessful TTAB appeal of denial of the application. This file wrapper for Application No. 77-471425 is a publicly available

official record maintained by the USPTO, identified in the Petition to Cancel and in subsequent discovery. Excerpted relevant pages are provided as PNR-D, comprising 32 pages.

3. Excerpts from the transcripts of the in-court, sworn testimony of Ronald R. Sciortino, Respondent SnoWizard's principal, in the LAED-06-9170 prior civil litigation that SnoWizard itself has placed at issue in this TTAB cancellation proceeding have been offered into the record as PNR-B, comprising 39 pages, having been identified, with copies provided, to Respondent SnoWizard on 16-JAN-2017.

4. Petitioner's Petition, Motion to Resume, Trial Testimony, and other filings of record.

5. Respondent's Answer to the Petition, Trial Testimony, and other filings, already of record in this proceeding, which will be referenced by Petitioner pursuant to TBMP §704.06.

Statement of Issues

Is WHITE CHOCOLATE & CHIPS in IC 030, for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections" the functional flavor name on the label of a container of flavor concentrate for making ready-to-use "White Chocolate & Chips" flavoring syrup to pour over shaved ice to make "White Chocolate & Chips" snowballs, warranting cancellation under Lanham Act §14(3) (15 USC §1064(3))?

Is WHITE CHOCOLATE & CHIPS in IC 030, for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections" the generic flavor name for a flavor concentrate for making ready-to-use "White Chocolate & Chips" flavoring syrup to pour over shaved ice to make "White Chocolate & Chips" snowballs, warranting cancellation under Lanham Act §14(3) (15 USC §1064(3))?

Is WHITE CHOCOLATE & CHIPS in IC 030, for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections" the descriptive flavor name for a flavor concentrate for making ready-to-use "White Chocolate & Chips" flavoring syrup to pour over shaved ice to make "White Chocolate & Chips" snowballs, and does at least 16 years of non-exclusive use, with others also offering and selling it continuously, prevent the acquisition of any distinctiveness, warranting cancellation under Lanham Act §14(1) (15 USC §1064(1))?

Was Reg. No. 4,157,907 for WHITE CHOCOLATE & CHIPS in IC 030, for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections" was obtained by fraud, warranting cancellation under Lanham Act §14(3) (15 USC §1064(3))?

Background Statement

While WHITE CHOCOLATE & CHIPS for snowball flavoring concentrate is the single mark at issue here, this cancellation is best understood in the context of Respondent's attempts to lock up the snowball flavor and supplies market by applying for federal registrations of SNOBALL (pseudo-mark SNOWBALL) itself, and ORCHID CREAM VANILLA, HURRICANE, BUTTERED POPCORN, MUDSLIDE, COOKIE DOUGH, PRALINE, CAJUN RED HOT, WHITE CHOCOLATE & CHIPS, GEORGIA PEACH, KING CAKE, MOUNTAIN MAPLE, and other common, functional, generic, and descriptive flavor names. Respondent SnoWizard has successfully snowed the USPTO into granting registration of some of these marks, including WHITE CHOCOLATE & CHIPS, at issue here, and CAJUN RED HOT, at issue in co-pending Cancellation No. 92060915.

Argument and Supporting Facts

In dismissing SnoWizard's attempt to, in effect, remove or transfer this TTAB proceding to District Court, the District Court observed that Petitioner Snow Ball's Chance was not a proxy for any party in prior litigation, and that the determinations made in the prior litigation were not binding here on Snow Ball's Chance.

Respondent SnoWizard asserts continuously and stridently that its right to registration of WHITE CHOCOLATE & CHIPS was established against the whole world by civil litigation against different, distinct parties in the USDC for the Louisiana Eastern District in LAED-06-9170. SnoWizard relies on the undeniable and undenied facts that Petitioner Snow Ball's Chance is a customer of, and prefers to do business with Southern Snow, which was a party in the prior litigation, and that Petitioner Snow Ball's Chance chose to retain the undersigned attorney Mark Edw. Andrews as counsel, after Andrews' mostly successful representation of Southern Snow and the other several plaintiffs in the prior LAED-06-9170 litigation, where SnoWizard conceded that the formerly federally and state registered trademarks and common-law trademarks HURRICANE, BUTTERCREAM, BUTTERED POPCORN, DILL PICKLE, GEORGIA PEACH, KING CAKE,

PRALINE, COOKIE DOUGH, CAKE BATTER, MUDSLIDE, ORCHID CREAM VANILLA, TIRAMISU, SNOBALL, SNOWBALL, and SNOBALL MACHINE were "generic"— on the last day of trial, after several years of litigation. (LAED-06-9170, Rec.Doc. 652, 27-FEB-2013, Consent Judgment, a public record, not of record here).

After Petitioner Snow Ball's Chance filed this cancellation against WHITE CHOCOLATE & CHIPS and a simultaneous cancellation against CAJUN RED HOT, Respondent SnoWizard filed a civil action in the USDC for the Louisiana Eastern District seeking to bypass this Trademark Trial and Appeal Board and impose a decision based on *res-judicata* grounds— having the prior LAED-06-9170 litigation among non-related parties controlling the TTAB cancellations. SnoWizard then moved to suspend, in the TTAB, this cancellation proceeding for WHITE CHOCOLATE & CHIPS and the separate cancellation proceeding for CAJUN RED HOT. The District Court dismissed SnoWizard's civil action in an Order and Judgment entered 25-SEP-2015. The primary grounds of dismissal were a lack of subject matter jurisdiction under Rule 12. The District Court also ruled that dismissal was proper under alternative grounds. The District Court addressed SnoWizard's assertions that Snow Ball's Chance, the Petitioner here, was merely a proxy for one of the parties in the prior litigation, and that the prior litigation had a res-judicata or preclusive effect against Snow Ball's Chance, and the District Court found no merit in those assertions.

After dismissal in the District Court, Petitioner Snow Ball's Chance urged this TTAB to resume the cancellation proceedings, appending copies of the District Court's Order and Judgment, and making them of record in this TTAB proceeding.

Petitioner's standing has been established.

Petitioner Snow Ball's Chance, Ltd. is an independent snowball vendor, in the business of making snowball shaved-ice confections, purchasing snowball supplies such as flavor concentrates, and selling snowballs directly to the consuming public.

Petitioner Snow Ball's Chance, Ltd. shows both standing and valid grounds for cancellation, as required.[1] A petition to cancel a registration may be brought by "any person who believes that he is or will be damaged ... by the registration of a mark on the principal register..."[2] Further, a party may

1. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).
2. 15 USC §1064.

challenge a mark that has become generic because continued registration of the mark interferes with the free flow of the products known by that generic term.[3]

The following characterizations of the channel of trade, the goods, and the relevant public are supported generally by the trial-testimony declaration (PNR-A pp.2–4) of George Miller of Snow Ball's Chance, by SnoWizard's statements to the USPTO (Sciortino Trial Testimony p.1; FW 85-473205, PNR-C pp.5, 9; & FW 77-471425, PNR-D p.11) and by Sciortino's trial testimony in LAED-06-9170, generally, and specifically at PNR-B pp.9:24–10:20 & 13:18–14:2.

The channel of trade is the snowball shaved-ice confection business where the ultimate consuming customer goes in person to a snowball stand operated by a snowball vendor who has prepared in advance the sweet ready-to-use flavored and colored syrups to be poured over freshly shaved ice to make the snowball for the ultimate customer.

Snowballs are shaved-ice confections consisting essentially of finely shaved ice with colorful and flavorful syrups poured over and soaking into the shaved ice. Snowballs are usually only available seasonally, during the hot, school-and-work-vacation months. Snowballs are most often purchased from a snowball vendor operating a snowball stand which houses an ice-shaving machine, which is usually large, expensive, and potentially dangerous if it is misused, houses a supply of ice, which is usually in the form of large blocks, and houses a supply of sweet ready-to-use snowball flavoring syrups having various flavors and colors, ready to be poured generously onto freshly shaved ice to make the snowball in the presence of the ultimate customer.

Regional variants of snowballs include "snow cones", which arguably allow a less finely shaved ice, and Hawaiian "shave ice", which traditionally is shaved into sheets which can be presented in the style of flower petals. The vendors of these variants of shaved ice confections tend to use the same flavor-concentrate and other supplies and the same suppliers as the snowball vendors, and are fairly considered to be in the same channel of trade.

Snowballs are perishable and are almost always made to order. An amount of plain, unflavored and uncolored ice is shaved into a cup or container. Then a "ready-to-use" flavoring syrup is poured over the plain shaved ice. The flavor and color of a ready-to-consume snowball are determined by what flavoring syrup is chosen and asked for by the customer.

3. *Generally In re Le Sorbet, Inc.*, 228 USPQ 27, 30-31 (TTAB 1985).

The goods are flavor concentrates used by the snowball vendor to prepare snowball flavoring syrups used to make the ultimate snowball to be sold to, and consumed by the ultimate customer.

Although some snowball vendors use such things as fruit juices as snowball flavoring syrup, and some snowball vendors make their own flavoring syrups "from scratch" using flavorings and food coloring from the grocery store, the majority of snowball vendors avail themselves of the convenience and cost savings of using flavor concentrates specifically formulated to provide— when diluted and sweetened as directed— the intensity of flavor and color needed to make an appealing snowball, which is difficult to achieve with general-purpose flavorings and colorings.

The ready-to-use snowball flavoring syrup, with its very high concentration of sugar, is susceptible to spoilage in very few days time. Spoilage can be slowed with refrigeration, but that would require a very large amount of refrigerated space and the logistical complexities of supplying and re-supplying the snowball stand from the refrigerated space.

Flavor concentrates are less expensive to ship and handle than corresponding volumes of perishable ready-to-use snowball flavoring syrups would be, but flavor concentrates, being thick liquids and being subject to food-service and sanitary regulations, are still relatively expensive to ship and bulky to properly store. If a snowball vendor is within reasonable driving distance of a supplier or distributor of flavor concentrates, then that snowball vendor might prefer to pick up the flavor concentrates and save the shipping costs, and might prefer to pick up smaller volumes in more frequent trips, reducing the need for temperature-controlled storage space and spreading out the outlay of money. A close-by supplier might make free local deliveries, either regularly or as a "hot-shot" service to replenish low stocks. When the snowball vendor trades with a more distant supplier, it is significantly less costly for the snowball vendor to place one order comprising nearly all of the flavor concentrates anticipated to be needed in the upcoming season, which can then be made up as palatalized freight and shipped more economically. Also, the supplier might offer more favorable prices for large-quantity purchases. The disadvantages of that approach are that future needs have to be forecast, almost the entire season's flavor-concentrate budget has to be spent before the season's revenue starts to come in, and the snowball vendor has to provide facilities to unload and properly store multiple pallets of flavor concentrates.

The significant expense of shipping and then storing flavor concentrates might be a determining factor in the preference of a snowball vendor to trade with one supplier instead of another. Also, there are cost and logistic benefits in a snowball vendor dealing exclusively or primarily with a single flavor-concentrate supplier, where orders can be placed, fulfilled, and tracked with the minimum number of interactions, where quantity discounts can be taken, and where shipping can be aggregated and done more cheaply.

The Relevant Public is independent snowball vendors.

The snowball vendor somewhat resembles a retailer or a value-added reseller, buying long-lasting flavor concentrates in bulk, advance-preparing not more than a few days worth of perishable sweetened ready-to-use snowball flavoring syrup, and pouring that snowball flavoring syrup over shaved ice to make a quickly perishable made-to-order snowball to sell to the ultimate customer, usually for immediate consumption on or near the premises.

There are an estimated 10,000 independent snowball vendors operating single or small-chain snowball stands selling finished snowballs to the snowball-consuming public, and purchasing their supplies, such as ice, cups, sugar, and flavoring concentrates from whomever they choose among the approximately 11 manufacturers or wholesalers of snowball-specific supplies in the US. Other, non-independent snowball vendors operate as franchisees, and are obliged to purchase supplies from their franchisor.

Respondent's principal Sciortino testified in LAED-06-9170, reading from a SnoWizard response to an office action in the first CAJUN RED HOT application:

> A. "The examiner notes that registrant's food flavorings are identified broadly. Therefore, it is presumed that the registration encompasses all goods of the type described, including those in applicant's identification, that they move in all normal channels of trade, and that they are available to all potential customers. However, applicant's product is not being sold through all normal channels of trade and they are not available to all potential customers. Applicant provides goods and services to snow cone vendors and to distributors and suppliers to snow cone vendors. Applicant provides a complete package of equipment, supplies and consulting services for assisting individuals and entities with establishing in or operating a viable snow cone business."

(PNR-B, pp.10:8–20, Sciortino testimony in LAED-06-9170.)

As acknowledged by Respondent SnoWizard's principal, the relationships among snowball vendors and their chosen preferred supplier or suppliers tend to be close and long-term relationships comprising many factors more important than a claim of trademark on a few of the many different flavor names of flavor concentrates that the snowball vendor will order and re-order year after year.

Supply and logistics matters are important to the snowball vendor, who must ensure an adequate supply— or re-supply— of ice, cups, spoons, straws, and ready-to-use snowball flavoring syrups in all of the offered flavors.

Because a snowball consists essentially of a cup of shaved ice with snowball flavoring syrup poured on it and served with a spoon or straw or both, it is important that a snowball stand either starts its business day with a properly working ice-shaving machine and adequate supplies of ice, cups, spoons, straws, and advance-prepared ready-to-use snowball flavoring syrups in adequate amounts of each and every different flavor name that is offered, or that the snowball stand has a system for re-supply of these items during the business day.

Snowball vendors in most jurisdictions must maintain a food-service certificate, which often requires that the mixing of simple syrup and of ready-to-use flavoring syrups takes place in a separate commissary area not seen by the snowball-consuming public. Consequently, a snowball vendor or an employed manager is challenged in overseeing and monitoring both the front-of-house customer service and cash register operations and the back-of-house or even off-site mixing and re-supply operations simultaneously.

Where the snowball stand is not operated by the snowball vendor personally, or where the snowball stand sees a large volume of business, it is usually operated with the help of employees who often are young people working a first job during the school holiday. Working at a snowball stand is a suitable summer job for school-age workers, but usually only for a few summers, with the result that many snowball stands have a high percentage of less-experienced workers. The more-experienced workers are usually more suited to working up front with customers, and the less-experienced workers frequently start their employment with back-of-house duties including mixing and preparing the ready-to-use flavoring syrups.

Purpose-made snowball flavoring concentrates are available in quarts and gallons, with a quart yielding 250 finished snowballs and a gallon yielding 1000, approximately. Generally, and

historically, snowball flavor concentrates are labeled with the same flavor name that the snowball customer uses to order the snowball and that the snowball vendor uses to identify which bottle of ready-to-use flavoring syrup to pick from the display rack and pour over the plain shaved ice. So when enough Strawberry snowballs have been made to deplete the Strawberry flavoring syrup in the bottle labeled "Strawberry", then the labeled empty bottle is sent to the back-of-house commissary where new Strawberry ready-to-use flavoring syrup is made from simple syrup mixed with Strawberry flavoring concentrate taken from a bottle or jug labeled "Strawberry". Having all of the component ingredients consistently labeled "Strawberry" helps prevent mistakes and mis-identification in the mixing process, because the commissary will commonly have as many different bottles or jugs of flavoring concentrate as there are different flavors on the flavor list.

Snowball vendors must attend to their inventories of supplies, including the flavor-concentrate inventories for each of the snowball flavor names offered by the snowball vendor. Tracking and ordering and re-ordering flavoring concentrates requires the use of snowball flavor names, and if the flavor name on the order sheets and label for the flavoring concentrate is different than the flavor name used by customers and listed on a snowball vendor's sign, unnecessary confusion is introduced into the process.

Bottles or jugs of flavoring concentrate are generally kept by the snowball vendor in a commissary area separate from the area where ice is shaved and finished snowballs are made and handed to customers. Consequently, snowball customers very rarely see any bottles or jugs of flavoring concentrate, and are not at all influenced by the labeling or anything else about the flavoring concentrates. The snowball customers are only influenced by the flavor names and colors associated with the finished snowballs, displayed as a list of available flavors and as colorful bottles of ready-to-use flavoring syrup which are labeled with the flavor name.

The ultimate snowball customer asks for a snowball by its flavor name, and more appealing flavor names sell more snowballs.

There are a large variety of flavors and colors for snowballs. Except for special situations such as temporary snowball stands at parties, fairs, or events, where only a few flavors might be offered— to avoid transporting a larger amount of liquid in glass and to speed up ordering by offering customers

fewer choices— most snowball stands offer a large variety of flavors. Snowball customers expect and desire a large variety of flavors from which to choose.

Under questioning by SnoWizard's attorney, at trial in LAED-06-9170, SnoWizard's principal Sciortino testified that he learned "[flavor] names are important" from a snowball-vendor customer who was making ready-to-use snowball flavoring syrup from a flavor concentrate called "Green Apple", but the snowball vendor was selling the flavor to his ultimate snowball consuming customers under the name "Granny Smith Apple" which was a much more appealing name:

> Q. In the case of Cajun Red Hot, do you specifically recall creating that name for that flavor?
> A. Yeah. In fact, there are several on here that I did at the same time. There's Granny Smith Apple, there's Cajun Red Hot, Georgia Peach, White Chocolate and Chips, just looking over that very quickly. And it all started with a customer in Florida, and he was purchasing -- if you saw on one of those earlier lists we were getting Green Apple, that was coming from National Fruit Flavor Company. And Green Apple was a delicious flavor, and even when I took over we were getting that from National Fruit Flavor but even though when I took it over from Warren Leruth, I started making my own green apple and I couldn't understand why it was[n't]selling well. Delicious flavor.
>
> And then I took an order for a customer, he was located in Florida, and we were just talking and he ordered two cases of gallons, that's eight gallons of Green Apple. And I just, you know, had to ask him, it's like what do you do with Green Apple that you sell so much of it? He says, oh, we add additional citric acid to it and we call it Granny Smith Apple and it's our best seller. And that's what lit off the light in my head to say the names are important.
>
> So I wanted to start coming up with creative names that would get people to focus on the flavor to where it looked better, you know, Granny Smith Apple, Green Apple, Mountain Maple, you know, Georgia Peach instead of Peach. So that's when I changed my names, or created the flavor for the new one I wanted to come up with. And it does make a difference tremendously. Granny Smith Apple is now -- it went from like the bottom ten percent to the top ten flavors.

(PNR-B, pp.15:20–16:23, Sciortino testimony in LAED-06-9170.)

The importance of snowball flavor names can also be fairly inferred from the vast amount of money and effort that SnoWizard has invested in trying to lock up the rights and deny competing suppliers of flavor concentrates the ability to sell flavor concentrates bearing their proper snowball

flavor name on the label, which, in turn, denies every snowball vendor the ability to purchase a properly labeled jug of flavor concentrate from the snowball vendor's preferred supplier.

A jug of flavor concentrate which is not labeled with the exact, proper snowball flavor name that the concentrate is meant to produce is non-functional and useless to the snowball vendor because that jug is mislabeled and cannot be used in the snowball vendor's work and production flow.

Petitioner Snow Ball's Chance principal George Miller gives a detailed explanation of the function of flavor concentrate in the operation of his snowball stand, which is substantially the same as all of the other snowball stands he is familiar with. (Petitioner's Trial Testimony, PNR-A.) Miller explains how the flavor names on the labels of the several various jugs of flavor concentrate have to match the flavor names on the bottles of ready-to-use snowball flavoring syrup which have to match the flavor names by which the customers order their snowballs. If the flavor name on the label of the jug of flavor concentrate does not match the flavor name of the ultimate snowball, it leads to mistakes made by employees in making up the ready-to-use syrups, and it causes confusion in the ordering, supplying, and re-supplying of needed flavor concentrates, increasing the possibilities both of running out of a flavor and of over-purchasing or overstocking a flavor.

In all but the very smallest snowball-stand operations, there is too much volume and too many different people involved to implement any work-around such as intercepting all wrongly labeled jugs of flavor concentrate and placing substitute labels on them. There is no reasonable alternative available to Petitioner Snow Ball's Chance, Ltd. because— given the volume of snowballs sold and the established system for mixing flavoring syrups— the re-labeling or altering the labels of any alternative flavor concentrate from any other supplier would be unreasonably cumbersome and would be an arguable continuing act of infringement or counterfeiting.

The flavor name on the label of a jug of flavor concentrate is **functional** for the sole intended use of the flavor concentrate in producing an ultimate snowball having that flavor name. A jug of flavor concentrate not labeled with the correct flavor name is nonfunctional and useless to the snowball vendor.

Competing manufacturers and suppliers of flavor concentrates are able to differentiate themselves by their service and by their different registered-trademark brand names, and do not need to commandeer flavor names for that purpose.

The rather small relevant public of snowball vendors know quite well which supplier or suppliers they are dealing with. Unless a snowball vendor is paying exorbitant rent for the snowball stand itself, the purchase of flavor concentrates and related supplies is almost certainly the biggest expense and the biggest logistical task in the operation of a snowball stand. It is very likely that the snowball vendor has, on occasion, spoken directly with the owner or principal of the supplier. Respondent SnoWizard has represented to the USPTO that "[a]pplicant provides a complete package of equipment, supplies and consulting services for assisting individuals and entities with establishing in or operating a viable snow cone business" (PNR-B p.10:17–20, Sciortino testimony in LAED-06-9170).

A cursory search of the public records of the USPTO shows that SnoWizard has registered trademarks in its brand name SNOWIZARD (Reg. Nos. 5118396, 4157708, 3669146, 2544216) and in so many other slogans, tag lines, products, and— at issue here— flavor names. The specimen label in the record (PNR-C p.4) shows that the brand name "SnoWizard" is most prominent, and that the flavor name is just a later-printed functional identification of which flavor is in which jug.

In the federal Fifth Circuit, the seminal decision standing for the proposition that, as a matter of law, confusion is unlikely under the circumstances of the "house brand" being prominently and truthfully displayed so that a customer can see it or know it while making a purchasing decision, is from a trademark infringement action that SnoWizard brought against a competitor, and lost, in 1986.[4]

For these goods, in this channel of trade, for this relevant public, the functional and generic snowball flavor name any given jug of flavor concentrate is supposed to yield cannot serve as an indication of source. It is an indication of **destination**; what kind of snowball can be made from this jug of flavor concentrate?

4. *Sno-Wizard Mfg., Inc. v. Eise[n]mann Products Co.*, 84-3755 (CA5 6/11/1986) 791 F.2d 423, 429.

Respondent SnoWizard has clearly and explicitly stated that it does not assert nor exercise any trademark rights in any flavor name at the snowball making and consuming level. Therefore, SnoWizard has failed to establish, police, or protect any trademark right in any flavor name, and cannot invent such rights for a flavor concentrate whose only purpose is as a precursor ingredient for producing a snowball which has a generic flavor name.

Under questioning by SnoWizard's attorney, at trial in LAED-06-9170, SnoWizard's principal Sciortino also testified:

Q. When you -- the flavoring concentrates that you make and sell, do you sell -- you don't sell them to purchase or to snowball eaters, people who eat snowballs?
A. No. These go to the -- you couldn't use it like that. These go to the snowball shops and then they mix them with sugar and water, simple syrup, to make the ready-to-use flavor. The snowball concentrate is not edible as it is, it needs further processing, you might say, before you can consume it.
Q. So the snowball shops are your customers?
A. Yes.
Q. And is it -- when you, when SnoWizard claims trademarks on certain flavors for concentrates that it develops, does SnoWizard expect or the shops that buy that flavor to use that flavor name when they sell the snowball using it?
A. Well, they could use any name that they wanted, but most of them are going to use the names that we have on our labels.
Q. And the fact that SnoWizard may or may not claim a trademark on that, does that affect the right of that snowball shop owner to do that?
A. Not that I am aware of.
Q. Has SnoWizard ever demanded that a snowball shop not use a particular flavor name?
A. No, never -- well, I think it stands to reason you wouldn't want to trademark a flavor to prevent your snowball shop from being able to use it, it's for people who are doing what you're doing, making flavoring concentrates, not what's going to the consumer who is buying it at the snowball shop.

(PNR-B, pp.13:18–14:19, Sciortino testimony in LAED-06-9170.)

On cross-examination, Sciortino reiterated:

Q [] Yesterday at 3:43 approximately, did you state that SnoWizard has never demanded that a snowball shop cease and desist from selling any flavor?
A Correct.
Q Did you also testify that you had no intention to make snowball shops cease and desist anything?
A That's correct.

(PNR-B, pp.32:24–33:5, Sciortino testimony in LAED-06-9170.)

SnoWizard wants to rely on a false analogy to the concentrated beverage syrup of a well-known soft drink being entitled to trademark protection even in its concentrated state before dilution with carbonated water. But there, the ultimate finished soft drink is protected under trademark law, and protection of the concentrated-syrup precursor flows directly from that protection of the ultimate product sold to consumers.

Here, SnoWizard has clearly and explicitly stated that it does not assert any trademark rights at the ultimate-snowball-consumer level. Therefore, even if SnoWizard ever had any common-law trademark rights or potential rights in "White Chocolate & Chips" or any flavor name, SnoWizard has failed to police and protect such rights, and the snowball flavor names have long since passed into the realm of the generic. And the flavor names of the flavor concentrates used to produce snowballs having generic flavor names are functional and necessary identifiers for ordering, stocking, re-stocking, mixing, and making ready-to-use snowball flavoring syrups bearing those generic flavor names.

If Respondent SnoWizard's assertion of a 1986 first use is credited, SnoWizard's use of the term on its own goods was functional, generic, and descriptive, without any assertion of trademark, for decades.

For at least 19 years Respondent SnoWizard's use of the term "White Chocolate & Chips" on its own goods was generic and descriptive. From 1986 when SnoWizard alleges it first used the flavor name until 2005 when SnoWizard sent a letter asserting an unregistered trademark, there was never any indication of any claim of trademark. There was no "TM" on the label of the goods— not even on the specimen submitted in the second application for registration in 2011. (PNR-C, p.4, specimen from FW 85-473205.) At trial in LAED-06-9170 in 2013, nothing in the over-500 pages of exhibits offered by SnoWizard could be found that indicated any claim or assertion of trademark in WHITE CHOCOLATE & CHIPS before a cease-and-desist letter in April 2005, and nothing could be found to support SnoWizard's contentions of first use in 1986, with the flavor name not showing up on a 1986 price list, and first showing up— with no claim of trademark— on a 1992 flavor list. (PNR-B pp.24:1–31:2, 36:19–39:7, Sciortino testimony in LAED-06-9170.)

A competing supplier had been offering a "White Chocolate & Chips" flavor concentrate since 1996.

At trial in LAED-06-9170 in 2013 it was established that Southern Snow, a competing supplier of flavor concentrates, had been offering and selling a "White Chocolate & Chips" flavor concentrate continually since 1996, and therefore was an alternative supplier of the goods from 1996 up through April 2005 when SnoWizard sent Southern Snow a cease-and-desist letter claiming a common-law trademark in WHITE CHOCOLATE & CHIPS, through the start of litigation in March 2006 which would become the LAED-06-9170 litigation, and up until trial of that action in 2013. (PNR-B pp.17:12–18, 19:16–25, Sciortino testimony in LAED-06-9170.)

Respondent SnoWizard did not even start to apply for registration of WHITE CHOCOLATE & CHIPS until 7 months after civil litigation about that same purported mark had already commenced.

SnoWizard first applied for a Louisiana state registration of WHITE CHOCOLATE & CHIPS on 17-NOV-2006, which was 19 months after sending a cease-and-desist letter— asserting only common-law rights— in April 2005, and was 7 months after the recipient of that letter filed suit in March 2006. (PNR-B pp.3:3–4:10, Sciortino testimony in LAED-06-9170.) Under Louisiana procedure, the registration was granted without any examination or independent verification of the sworn statements in the application.

SnoWizard first applied for federal registration of WHITE CHOCOLATE & CHIPS on 12-MAY-2008, which was more than 3 years after the cease-and-desist letter and more than 2 years after the commencement of litigation, which was still pending at the time. (PNR-B pp.6:20–8:11, Sciortino testimony in LAED-06-9170; PNR-D p.1 & generally, FW 85-473205.)

Respondent SnoWizard filed a second repetitive and duplicative application for registration of WHITE CHOCOLATE & CHIPS after being soundly denied, after appeal to the TTAB, in the first application.

(The evidence supporting the following synopsis of the first and second applications for trademark registration is found under the given dates in the appropriate file wrapper, of record here, excerpted in PNR-C, FW 85-473205, & PNR-D, FW 77-471425.)

SnoWizard applied for federal trademark registration for WHITE CHOCOLATE & CHIPS in International Class 030, for "food flavorings", on 12-MAY-2008, in Application No. 77-471425.

SnoWizard did not disclose to the USPTO, on 12-MAY-2008 or at any time after, in Application No. 77-471425, that WHITE CHOCOLATE & CHIPS was the subject of a pending civil action filed 2 years before.

On 15-OCT-2009, the USPTO rejected SnoWizard's Application No. 77-471425 for WHITE CHOCOLATE & CHIPS on the grounds of mere descriptiveness.

SnoWizard filed Appeal No. 77-471425, re WHITE CHOCOLATE & CHIPS, on 15-APR-2010, in the USPTO TTAB.

On 17-FEB-2011, in Appeal No. 77-471425, the USPTO TTAB affirmed rejection of SnoWizard's Application No. 77-471425 for WHITE CHOCOLATE & CHIPS on the grounds of descriptiveness.

On 18-APR-2011, SnoWizard filed Case No. LAED-11-0880 in the U.S.D.C. La.E.D. "seeking judicial review of the TTAB decision dated February 17, 2011", which rejected WHITE CHOCOLATE & CHIPS.

SnoWizard re-applied on 15-NOV-2011 for federal trademark registration for WHITE CHOCOLATE & CHIPS in IC 030, for "flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections", in Application No. 85-473205, and obtained Registration No. 4,157,907 on 12-JUN-2012.

SnoWizard's application on 15-NOV-2011 for registration of WHITE CHOCOLATE & CHIPS was made at a time when the purported WHITE CHOCOLATE & CHIPS trademark was the subject of still-pending litigation, in LAED-06-9170, that had been pending since 2006, and at a time when the USPTO's prior refusal to register the same purported mark, in prior 2008 Application No. 77-471425, was the subject of still-pending litigation, in LAED-11-0880.

Ronald R. Sciortino, SnoWizard's principal, signed the Declaration in the WHITE CHOCOLATE & CHIPS Application No. 85-473205 on 15-NOV-2011, and attested to the truthfulness and accuracy of the statements made.

SnoWizard's principal Sciortino signed an additional solemn declaration dated 15-NOV-2011, submitted to the USPTO in Application No. 85-473205, stating in ¶9: "The mark WHITE CHOCOLATE & CHIPS has been in substantially exclusive and continuous use by Applicant in interstate commerce since at least as early as May 1, 1986, other than an isolated instance of

trademark infringement by a competitor, which first occurred about a year ago and well after the mark had become distinctive of Applicant's goods."

SnoWizard's Application No. 85-473205 for WHITE CHOCOLATE & CHIPS, and the Declarations and evidence filed with the application, were endorsed and filed electronically by SnoWizard's attorney Kenneth L. Tolar on 15-NOV-2011.

In a USPTO Examiner's Amendment dated 23-DEC-2011 in SnoWizard's Application No. 85-473205 for WHITE CHOCOLATE & CHIPS, the Trademark Examining Attorney required SnoWizard to make a claim of acquired distinctiveness under Lanham Act §2(f), making SnoWizard's claim of exclusive use not only material, but essential to obtaining registration.

In the first application, in rejecting SnoWizard's claim of acquired distinctiveness, the examining attorney initially identified 4 third parties making descriptive use of the term, and the TTAB panel noted such third-party uses in affirming the refusal to register. Afterward, the examining attorney identified 8 additional third-party descriptive uses in the record.

In the first application, No. 77-471425, the examining attorney refused registration of WHITE CHOCOLATE & CHIPS on the grounds of mere descriptiveness, and identified 4 different third parties making descriptive use of the term. Southern Snow was one of those 4 parties identified.

In affirming refusal, the TTAB panel (Bucher writing, Seeherman, & Zervas) on 17-FEB-2011 stated:

> These third-party uses support our view that the term "White Chocolate & Chips" is merely descriptive. Applicant dismisses these uses by its competitors by asserting that they are "unlawful use," although it is not clear what applicant has done to counteract this usage. In any event, the fact that third parties consistently use this term to describe a flavoring is an indication that manufacturers and retail merchants as well as the ultimate snow cone consumers in New Orleans and Houston view "White Chocolate& Chips" as a descriptive term for this particular flavoring.

(PNR-D p.8, TTAB decision from FW 77-471425.)

On 5-MAY-2010, in denying SnoWizard's request for reconsideration, the examining attorney identified and made of record "additional evidence of descriptiveness" comprising 8 additional third parties— over and above the 4 already identified— as making descriptive use. (PNR-C pp.12-32, FW 85-473205.)

Respondent SnoWizard made misleading statements of known falsity regarding substantially exclusive use of WHITE CHOCOLATE & CHIPS, for the purpose of obtaining a registration to which it was not entitled, where the truth, if known to the USPTO, would have prevented such registration.

As amended, SnoWizard's Application No. 85-473205 for WHITE CHOCOLATE & CHIPS included the solemn statement:

> The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

(PNR-C p.2, FW 85-473205.) And the date of that statement was 23-DEC-2011.

Sciortino's sworn Declaration of 15-NOV-2011, and additional sworn statement of 23-DEC-2011, claiming "substantially exclusive" use of WHITE CHOCOLATE & CHIPS by SnoWizard, is false because Southern Snow was also offering and selling "White Chocolate & Chips" flavor concentrate from 1996 continuously through 2012. In 2011, the LAED-06-9170 litigation was still pending and did not go to trial until February 2013. In SnoWizard's first Application No. 77-471425, Southern Snow's use of the flavor name was noted and relied upon by the examining attorney and by the TTAB on appeal. (PNR-D p.6, TTAB Opinion.) The examining attorney also identified 11 other third parties using the term descriptively, making a total of 12 third-party descriptive uses. SnoWizard did not account for those other 11 third-party uses, and SnoWizard mis-characterized Southern Snow's use as having only happened "recently", when in fact Southern Snow had been using the term continually since 1996— nearly a decade before SnoWizard's 2005 cease-and-desist letter. SnoWizard relied on its supposed exclusive use from the asserted first offering in 1986 up to Southern Snow's use in 1996. But the standard is "for at least the five years immediately before the date of this statement". During those five years— 2007 through 2011— SnoWizard was not exclusively using the term. The record shows that a dozen third parties were also using that term.

Sciortino's sworn Declaration of 15-NOV-2011 and additional sworn statement of 23-DEC-2011 claiming "substantially exclusive" use of WHITE CHOCOLATE & CHIPS by SnoWizard is a fraud upon the USPTO, being a false statement of material information by SnoWizard, made willfully, in bad faith, and with the intent to obtain a registration to which the Defendant was not entitled, where the truth of the matter, if disclosed to the USPTO, would have resulted in disallowance of registration.

The term "White Chocolate & Chips", which has already been determined to be descriptive, cannot have acquired distinctiveness with a dozen different third parties using the term descriptively, and without SnoWizard even indicating any claim of trademark for two decades before 2005.

Respondent SnoWizard's purported mark WHITE CHOCOLATE & CHIPS has not acquired distinctiveness under 15 USC §1052(f). As shown above, SnoWizard did not give any indication of trademark nor make any assertion of trademark for the two decades between the claimed first offering in 1986 and the cease-and-desist letter in 2005. The record in Application No. 77-471425 shows that there were a dozen known third-party descriptive uses identified in 2011— the year the second application was filed. The testimony of SnoWizard's Sciortino in LAED-06-9170 shows that third-party Southern Snow had been making continuous use of the term since 1996, and that litigation regarding the term was pending from 2006 through 2013.

White Chocolate & Chips is generic.

The law, at 15 USC §1064(3), permits a party to petition for cancellation of a registration for a trademark when the registered mark becomes the generic name for the goods or services for which it is registered. A mark is generic when members of the relevant public primarily use or understand the registered term to refer to the category or class of goods in question.[5] The test for determining whether a designation is generic, as applied to the goods, turns upon how the term is perceived by the relevant public.[6] Evidence of the public's understanding and perception of a term may be obtained from any competent source, including testimony, surveys, dictionaries, catalogs, trade journals, newspapers, magazines, and other publications.[7] If a combination of two or more generic terms is such that each term retains its generic significance, then the combined expression is generic and thus incapable of denoting source.[8] Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question?; and (2) is

5. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

6. *See Loglan Institute Inc. v. Logical Language Group, Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992).

7. *See Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 at 1143 (Fed. Cir. 1987); and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

8. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services?[9]

Here, the genus of the goods is flavoring concentrate to produce a ready-to-use snowball flavoring syrup to produce a "White Chocolate & Chips" flavored and colored snowball to be consumed by the ultimate customer, as has been established above.

Here, the relevant public of snowball vendors use and understand "White Chocolate & Chips" to refer to the flavor name by which ultimate snowball purchasers specify a snowball, and consequently the identifier of a bottle of ready-to-use snowball flavoring syrup which needs to be prepared in advance using a precursor from the proper jug of flavoring concentrate. SnoWizard has explicitly conceded that the snowball flavor name used in the transaction between the snowball customer and the snowball vendor is used generically and outside the control of SnoWizard or anyone else.

"White Chocolate & Chips" is therefore a generic flavor name for the ultimate snowball and the ready-to-use snowball flavoring syrup which proximally creates the snowball, and the flavor name of the flavor concentrate whose stated and intended use is only to conveniently produce that generic ready-to-use snowball flavoring syrup for that generic snowball must itself be deemed generic, or functional, or both, within the meaning of 15 USC §1064(c).

Competitors have a competitive need to use this functional, generic, descriptive term.

The customers of Respondent, Petitioner, and other competitors purchase a flavoring concentrate of a certain name because they want to offer that flavor to their own customers. All of Respondent's competitors have a competitive need to be able to satisfy the wants of their snowball vendor customers by offering a flavor concentrate named "White Chocolate & Chips".[10]

Respondent never owned this mark because it is generic, functional, and descriptive.

Ownership of a mark is a condition precedent for the registration of that mark. "The Trademark Act is not an act to register mere words, but rather to register trademarks. Before there can be registration, there must be a trademark, and unless words have been so used they cannot qualify."[11]

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9. *See In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

10. *See In re Tekdyne Inc.*, 33 USPQ2d 1949, 1953 (TTAB 1994); and J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

11. *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) (footnote omitted).

Registration is only available to a "trademark by which the goods of the applicant may be distinguished from the goods of others" according to the first sentence of 15 USC §1052.

Here, Respondent's White Chocolate & Chips flavoring concentrate goods are a convenient and alternative way to produce derivative "White Chocolate & Chips" flavoring syrup and flavored snowball goods already widely known by that same name and which have long been and still can be produced by other means. Respondent has admitted that the term when used for snowballs sold by snowball vendors is generic. Respondent appropriated a term that was descriptive and that had become generic. Respondent should not have applied to register this term, the USPTO should not have granted registration, and probably would not have done so but for receiving inaccurate information, and the registration for this generic and descriptive term should be cancelled.

Conclusion

For the reasons stated, Respondent SnoWizard's Reg. No. 4,157,907 for WHITE CHOCOLATE & CHIPS in IC 030, for "Flavoring concentrate for non-nutritional purposes, namely, flavoring concentrate for shaved ice confections" should be cancelled as being a generic and functional term for Respondent's goods under 15 USC §1064(c), or descriptive of Respondent's goods under 15 USC §1052(e)(1) with no acquired distinctiveness as a mark associated with Respondent under 15 USC §1052(f), and therefore incapable of distinguishing Respondent's goods under 15 USC §1052, first sentence.

Dated: 6 September 2017

Respectfully Submitted:
Attorney for Petitioner Snow Ball's Chance, Ltd.

Mark Edw. Andrews
La. Bar No. 26172
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504-383-3632
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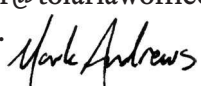
—Certificate of Service—
I, Mark Edw. Andrews, certify this document is served on counsel for Registrant SnoWizard, Inc. Kenneth L. Tolar by U.S. Mail to 2908 Hessmer Av, Ste 2,Metairie, LA 70002, and by e-mail to <tolar@tolarlawoffice.com>, this 6 September 2017.



From: **Mark Edw. Andrews** mea@mealaw.com
Subject: Snow Ball's Chance Ltd. initial disclosure in 3 cancellation proceedings
Date: 5 July 2016 at 10:55
To: Kenneth Tolar tolar@tolarlawoffice.com
Bcc: Mark Edw. Andrews artsciencelaw@gmail.com

ME

Snow Ball's Chance Ltd. initial disclosure in 3 cancellation proceedings is attached.
--MEA
--Mark Edw. Andrews <mea@mealaw.com>

UNITED STATES PATENT & TRADEMARK OFFICE
TRADEMARK TRIAL & APPEAL BOARD

CANCELLATION NO. 92062751
MOUNTAIN MAPLE

CANCELLATION NO. 92060915
CAJUN RED HOT

CANCELLATION NO. 92060914
WHITE CHOCOLATE & CHIPS

SNOW BALL'S CHANCE, LTD.
v.
SNOWIZARD, INC.

INITIAL DISCLOSURE

Snow Ball's Chance, Ltd., Petitioner in the three captioned cancellation proceedings, makes this initial disclosure in all three of the proceedings.

The owner of Snow Ball's Chance, Ltd. is George Miller, who may be contacted at the snowball stand at 9231 Lake Forest Blvd in New Orleans, telephone number 504-241-2035.

Snow Ball's Chance, Ltd., intends to use "flavor lists", price sheets, and similar promotional or advertising material from various flavor suppliers, including SnoWizard, over a period of many years. Those materials are in the process of being identified and assembled, and copies will be timely provided when the process is completed. Snow Ball's Chance, Ltd. also intends to refer to the USPTO application and TTAB proceedings files of these and other trademarks claimed by SnoWizard, Inc. All such files are publicly available from the USPTO, and copies of the files should already be in SnoWizard's possession.

DATED: 5 JULY 2016

SUBMITTED BY:
Attorney for Petitioner Snow Ball's Chance, Ltd.

MARK EDW. ANDREWS
La. Bar No. 26172
ANDREWS ARTS & SCIENCES LAW LLC
7104 Coliseum St., New Orleans, LA 70118
504-383-3632
mea@mealaw.com

—CERTIFICATE OF SERVICE—
I, Mark Edw. Andrews, certify this document is served on counsel for Registrant SnoWizard, Inc. Kenneth L. Tolar by U.S. Mail to 2908 Hessmer Av, Ste 2,Metairie, LA 70002, and by e-mail to <tolar@tolarlawoffice.com>, this 5 July 2016.

From: **Mark Edw. Andrews** mea@mealaw.com
Subject: TTAB 92062751, MOUNTAIN MAPLE, P's Pretrial Disclosure
Date: 26 September 2016 at 14:56
To: Kenneth Tolar [redacted]r@tolarlawoffice.com
Bcc: Mark Edw. Andrews artsciencelaw@gmail.com

ME

Counsel—
Attached is Petitioner's Pretrial Disclosure.
--MEA
--Mark Edw. Andrews <mea@mealaw.com>

UNITED STATES PATENT & TRADEMARK OFFICE
TRADEMARK TRIAL & APPEAL BOARD

CANCELLATION NO. 92062751
MOUNTAIN MAPLE

SNOW BALL'S CHANCE, LTD.
v.
SNOWIZARD, INC.

PRETRIAL DISCLOSURE

Snow Ball's Chance, Ltd., Petitioner in the captioned cancellation proceeding, makes this Pretrial Disclosure under 37 CFR § 2.121(e).

Petitioner intends to depose George Miller, the owner of Snow Ball's Chance, Ltd., already disclosed to Respondent.

Petitioner intends to use transcripts of sworn, in-court testimony of SnoWizard's Ronald R. Sciortino, already of public record in other proceedings, as evidence. Specifically testimony in LAED-06-9170 on 21-FEB-2013 pp.102–03, 123–24, 118–19; 25-FEB-2013 pp. 142–50; 26-FEB-2013 pp.6, 11, 13, 47–49, 59, 73. Petitioner also intends to use other sworn statements of Ronald R. Sciortino in other proceedings in court and before the USPTO and the TTAB.

DATED: 26 SEPTEMBER 2016

SUBMITTED BY:
Attorney for Petitioner Snow Ball's Chance, Ltd.

MARK EDW. ANDREWS
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—CERTIFICATE OF SERVICE—
I, Mark Edw. Andrews, certify this document is served on counsel for Registrant SnoWizard, Inc. Kenneth L. Tolar by U.S. Mail to 2908 Hessmer Av, Ste 2,Metairie, LA 70002, and by e-mail to <tolar@tolarlawoffice.com>, this 26 September 2016.

From: **Mark Edw. Andrews** mea@mealaw.com
Subject: Re: SBC TTAB matters
Date: 28 October 2016 at 15:09
To: Kenneth Tolar [redacted]
Cc: Jack E. Morris jem@jemorrislaw.com

ME

I can make George Miller available from 1pm to 4pm on any day except Tuesday for the next two weeks. I have a jury trial in federal court in Arkansas starting 14 November, so I would like to get this done before then.
--MEA
--Mark Edw. Andrews <mea@mealaw.com>

> On 26-Oct-2016, at 18:33 , Kenneth Tolar <[redacted]
>
> Mark. We are unavailable Monday. We would agree to extend the deadlines if we could take his testimony for both discovery and trial purposes and for all three cases. Please provide some alternate dates on which your client would be available. Thanks.
>
> Sent from my iPhone
>
> On Oct 26, 2016, at 5:54 PM, Mark Edw. Andrews <mea@mealaw.com> wrote:
>
> > Monday afternoon. I want to depose George Miller for the purpose of getting my evidence in. Shall we call it a joint deposition and split the reporter? With no limitations about confining questions to strict cross and re-cross rules? I propose to go first, but y'all will not be limited just to cross during your turn. I'm thinking petitioner, respondent, petitioner again, and respondent again, and even more if we have any reason to. Also, I'll get all the discovery to you before close of business Friday, so you'll have everything the weekend and the morning before the deposition. There really is not a lot of discovery to digest— the snowball stand keeps minimal records, and the stand does not sell Mountain Maple, White Chocolate & Chips, or Cajun Red Hot flavors presently, and has not ever sold them during any time that SnoWizard has claimed a trademark on them. The main reason that I'm so late with discovery is that I've been trying to find the information.
> >
> > George Miller is available on Monday after lunchtime, but is not available Tuesday, because he is short a manager at the snowball stand. I think my deadline in the Mountain Maple procedure is 8 November. So this works well for me.
> > I can get a court reporter and a room, but it seems easiest to do the joint deposition at one of y'all's offices and let y'all pick the reporter.
> > --MEA
> > --Mark Edw. Andrews <mea@mealaw.com>
> >
> > > On 26-Oct-2016, at 16:44 , Kenneth Tolar <tolar@tolarlawoffice.com> wrote:
> > >
> > > Mark:
> > >
> > > We like to notice the 30(b)(6) deposition of Snow Ball's Chance as soon as possible. To streamline matters, we would like to depose the appropriate corporate representative relative to all three TTAB matters on the same date(s). Please provide date(s) on which such representative would be available for a deposition. Thanks.
> > >
> > > Kenneth L Tolar
> > > Attorney at Law
> > > 2908 Hessmer Avenue
> > > Metairie, LA 70002
> > > (504) 780-9891
> > > (504) 780-7741 (fax)

From: **Mark Edw. Andrews** mea@mealaw.com
Subject: Re: TTAB proceedings, Depose George Miller Thursday 10 November 2016, 1:00 PM start
Date: 4 November 2016 at 16:20
To: Kenneth Tolar [redacted]
Cc: Jack E Morris jem@jemorrislaw.com

ME

Ye[redacted]n to you Monday morning. Snow Ball's Chance, Ltd. does not presently offer snowball flavors "Mountain Maple", "Cajun Red Hot", or "White Chocolate & Chips", and has not offered those flavors in the past.
--MEA
--Mark Edw. Andrews <mea@mealaw.com>

> On 4-Nov-2016, at 14:11 , Kenneth Tolar <tolar@tolarlawoffice.com> wrote:
>
> Mark:
>
> Will be receiving responses to our outstanding discovery prior to the deposition?
>
> ---
>
> **From:** Mark Edw. Andrews [mailto:mea@mealaw.com]
> **Sent:** Friday, November 4, 2016 2:02 PM
> **To:** Kenneth Tolar; Jack E Morris
> **Subject:** TTAB proceedings, Depose George Miller Thursday 10 November 2016, 1:00 PM start
>
> Counsel—
> George Miller of Snow Ball's Chance, Ltd will appear for a joint and combined deposition as we have discussed, on Thursday, 10 November 2016, at 1:00 PM. Mr. Miller is a musician and does not rise until near noon. I need very little time, so y'all will have several hours. But if for some reason we run out of time on that day, we will make him available for a follow-up on another day.
> We are, of course, waiving the formality of a subpoena and 15 days.
> Location of deposition will be Tolar Law Office. Y'all, SnoWizard, will arrange for the court reporter, with the understanding that we, Snow Ball's Chance, will pay any reporter expenses fairly allocated to us.
> --MEA
> --Mark Edw. Andrews <mea@mealaw.com>

From: **Mark Edw. Andrews** mea@mealaw.com
Subject: Re: TTAB Order - Do Not Reply By E-mail. Mail Box Not Monitored - proceeding 92062751
Date: 8 November 2016 at 09:57
To: Kenneth Tolar [redacted]

Agreed. No deposition on 10 November. Will re-set.
--MEA
--Mark Edw. Andrews <mea@mealaw.com>

> On 8-Nov-2016, at 06:59 , Kenneth Tolar <[redacted]> wrote:
>
> Mark. In light of the fact that we have yet to receive your responses to our written discovery and since the board has extended the deadlines, there is no reason to proceed with your client's deposition Thursday. Let's select a mutually agreeable date after we receive your responses. Thanks
>
> Sent from my iPhone
>
> Begin forwarded message:
>
> > **From:** "ESTTA@uspto.gov" <ESTTA@uspto.gov>
> > **Date:** November 8, 2016 at 5:20:18 AM CST
> > **To:** Kenneth Tolar <[redacted]>, "Jem@jemorrislaw.com" <Jem@jemorrislaw.com>
> > **Subject: TTAB Order - Do Not Reply By E-mail. Mail Box Not Monitored - proceeding 92062751**
> >
> > UNITED STATES PATENT AND TRADEMARK OFFICE
> > Trademark Trial and Appeal Board
> >
> > Proceeding No. 92062751
> >
> > 11/08/2016
> >
> > IMPORTANT NOTICE
> >
> > The Trademark Trial and Appeal Board (TTAB) has issued an order in this proceeding. To see the order, click on the link below or paste the URL into the address box of your browser.
> >
> > http://ttabvue.uspto.gov/ttabvue/v?pno=92062751&pty=CAN&eno=8
> >
> > This order contains important information which you should review immediately. A response may be required and trial dates may have [redacted] will receive. An e-mail copy of the order itself will not be sent.
> >
> > If you are unable to view the order, call the TTAB for technical assistance at 571-272-8500. Do not use the reply button to respond to this message by e-mail.
> >
> > _____
> >
> > The e[redacted]
> > http://ttabvue.uspto.gov.
> >
> > Papers in Board proceedings may be filed electronically with ESTTA at http://estta.uspto.gov.
> >
> > Further information is available at the TTAB's web page at http:// www.uspto.gov.

From: **Kenneth Tolar** tolar@tolarlawoffice.com
Subject: WCC
Date: 29 November 2016 at 15:16
To: mea@mealaw.com
Cc: Jack E. Morris jem@jemorrislaw.com

KT

Mark:

Attached are SnoWizard's First Set of Interrogatories and Requests for Production of documents in the WCC matter. We would like to take a discovery deposition of SBC's principal sometime in December. It would be much easier if the depo were for all three cases. However, we need responses to the written discovery before proceeding with the discovery deposition. Please provide dates on which responses will be provided and when Mr. Miller would be available for a deposition. Thanks.

Kenneth L Tolar
Attorney at Law
2908 Hessmer Avenue
Metairie, LA 70002
(504) 780-9891
(504) 780-7741 (fax)

first set of disc reques...BC.pdf

From: Kenneth Tolar tolar@tolarlawoffice.com
Subject: FW: ESTTA. Motion for Sanctions (Other) confirmation receipt ID: ESTTA793557
Date: 6 January 2017 at 14:07
To: mea@mealaw.com
Cc: Jack E. Morris jem@jemorrislaw.com

KT

Mark:

Please see the attached pleadings filed today.

-----Original Message-----
From: estta-server@uspto.gov [mailto:estta-server@uspto.gov]
Sent: Friday, January 6, 2017 2:05 PM
To: mea@mealaw.com; docket@artsciencelaw.com; Kenneth Tolar; Jem@jemorrislaw.com; Kenneth Tolar
Subject: ESTTA. Motion for Sanctions (Other) confirmation receipt ID: ESTTA793557

Cancellation No.: 92062751

Tracking No: ESTTA793557

ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS Filing Receipt

The Trademark Trial and Appeal Board (Board) has received a filing titled ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS submitted through the Electronic System for Trademark Trials and Appeals (ESTTA). This Notice verifies receipt of the filing and includes an ESTTA Tracking Number.

Unless the filing fails to meet all applicable minimum legal requirements for filing , the Board will not retract the filing or refund any fees paid.

The filing, and any Board proceeding, may be viewed on TTABVUE at http://ttabvue.uspto.gov. Please allow up to two hours for the system to process this filing.

If the filer has a question, or if the filing is not viewable in TTABVUE, the TTAB Assistance Center is available at 571-272-8500, Monday to Friday from 8:30 a.m. to 5:00 p.m. Eastern Time (ET), or email at estta@uspto.gov . Please provide your ESTTA Tracking No.

ESTTA server at http://estta.uspto.gov

ESTTA Tracking number: ESTTA793557
Filing date: 01/06/2017

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

Proceeding: 92062751
Party: Defendant
SnoWizard, Inc.

Correspondence Address: KENNETH L TOLAR
TOLAR LAW OFFICE
2908 HESSMER AVENUE, SUITE 2
METAIRIE, LA 70002
UNITED STATES
tolar@tolarlawoffice.com, Jem@jemorrislaw.com Phone:

Submission: Motion for Sanctions (Other)

Filer's Name: Kenneth L Tolar
Filer's e-mail: tolar@tolarlawoffice.com
Signature: /kenneth l tolar/
Date: 01/06/2017

Attachments: Motion for sanctions.pdf
memo in support of motion for sanctions.pdf Exhibit A.pdf Exhibit B.pdf

Exhibit A.pdf

memo in suppor...ns.pdf

Motion for sanctions.pdf

Kenneth Tolar

From: Mark Edw. Andrews [mea@mealaw.com]
Sent: Wednesday, December 28, 2016 3:27 PM
To: Kenneth Tolar; Jack E Morris
Subject: Snow Balls Chance cancellations

Ken & Jack—

I am putting the discovery into proper form and will deliver it not later than tomorrow. I've got some financials that were hard to run down. We can depose George Miller whenever you want to, starting at one o'clock any afternoon and going as late as we need to. He's a musician, and he stays up all night and sleeps until noon.

I can have him there tomorrow (Thurs) if you want. Or Friday. Whatever y'all need. I apologize again for the delay in getting the discovery together.

--MEA

--Mark Edw. Andrews <mea@mealaw.com>

From: **Mark Edw. Andrews** mea@mealaw.com
Subject: Re: ESTTA. Motion for Sanctions (Other) confirmation receipt ID: ESTTA793557
Date: 6 January 2017 at 15:15
To: Kenneth Tolar tolar@tolarlawoffice.com
Cc: Jack E. Morris jem@jemorrislaw.com

ME

You never responded to my email from a week ago. I guess you were just running down the clock.
--MEA
--Mark Edw. Andrews <mea@mealaw.com>

> On 6-Jan-2017, at 14:07 , Kenneth Tolar <tolar@tolarlawoffice.com> wrote:
>
> <Motion for sanctions.pdf>