

ESTTA Tracking number: **ESTTA928309**

Filing date: **10/12/2018**

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

Proceeding	92067247
Party	Defendant Daesang Corporation
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Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Sung Joo
Filer's email	sjoo@lmiplaw.com, eld@lmiplaw.com, info@lmiplaw.com
Signature	/Sung Joo/
Date	10/12/2018
Attachments	Answer to Amended Petition.pdf(613444 bytes )

Registrations Subject to the filing

Registration No.	5146262	Registration date	02/21/2017
Registrant	Chef One Corporation 7 Bushwick Place Brooklyn, NY 11206 UNITED STATES Email: samuelkim@tmitrading.com		

Goods/Services Subject to the filing

Class 030. First Use: 2001/05/01 First Use In Commerce: 2001/05/01 All goods and services in the class are requested, namely: Asian style frozen foods, namely, noodles, dumplings, spring rolls, egg rolls, samosas, wonton appetizers; noodles and Asian noodles; dumplings; Chinese stuffed dumplings (gyoza, cooked); Korean-style dumplings (mandu); spring rolls; egg rolls; samosas; appetizers, namely, wontons; Asian-style buns; ramen noodles; potstickers; Asian-style sauces and fermented sauces; tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea; sausage rolls; sausage rolls marinated or cooked in Asian-style sauces			
Registration No.	5283788	Registration date	09/12/2017
Registrant	Chef One Corp. 7 Bushwick Place Brooklyn, NY 11206 UNITED STATES Email: samuelkim@tmitrading.com		

Goods/Services Subject to the filing

Class 030. First Use: 1998/07/01 First Use In Commerce: 1999/11/19 All goods and services in the class are requested, namely: Asian style frozen foods, namely, noodles,			
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dumplings, spring rolls, egg rolls, samosas, wonton appetizers; noodles and Asian noodles; dumplings; Chinese stuffed dumplings (gyoza, cooked); Korean-style dumplings (mandu); spring rolls; egg rolls; samosas; appetizers, namely, wontons; Asian-style buns; ramen noodles; potstickers; Asian-style sauces and fermented sauces; tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea; sausage rolls; sausage rolls marinated or cooked in Asian-style sauces

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

CHEF ONE CORPORATION,

Petitioner,

v.

DAESANG CORPORATION,

Respondent.

Proceeding no. 92067247

**RESPONDENT’S ANSWER TO AMENDED PETITION FOR CANCELLATION AND  
COUNTERCLAIMS**

Respondent-Registrant, Daesang Corporation (hereinafter “Respondent”) acting by and through its undersigned counsel, hereby responds to the Petition for Cancellation as follows:

To the extent that Petitioner’s introductory paragraph states factual allegations, Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations related to Chef One Corporation’s business address, and, therefore denies the same. Respondent denies that Chef One Corporation has been or will be damaged by Registration No. 4787760 for the mark “CHEFONE” & Design (“Respondent’s Mark”).

1. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the First Amended Petition for Cancellation, and for that reason, denies them.

2. Respondent admits the allegations contained in Paragraph 2 of the First Amended Petition for Cancellation.

3. Respondent admits the allegations contained in Paragraph 3 of the First Amended Petition for Cancellation.

4. Respondent denies the allegations contained in Paragraph 4 of the First Amended Petition for Cancellation.

5. Respondent neither denies nor admits the allegations contained in Paragraph 5 of the First Amended Petition for Cancellation and leaves the Petitioner to its proofs.

6. Respondent denies the allegations contained in Paragraph 6 of the First Amended Petition for Cancellation.

7. Respondent neither denies nor admits the allegations contained in Paragraph 7 of the First Amended Petition for Cancellation and leaves the Petitioner to its proofs.

8. Respondent denies the allegations contained in Paragraph 8 of the First Amended Petition for Cancellation.

9. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the First Amended Petition for Cancellation and, for that reason, denies them.

10. Respondent admits the allegations contained in Paragraph 10 of the First Amended Petition for Cancellation.

11. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 11 of the First Amended Petition for Cancellation and, for that reason, denies them.

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 First Amended Petition for Cancellation and, for that reason, denies them.

13. Respondent denies the allegations contained in Paragraph 13 of the First Amended Petition for Cancellation.

14. Respondent denies the allegations contained in Paragraph 14 of the First Amended Petition for Cancellation.

15. Respondent denies the allegations contained in Paragraph 15 of the First Amended Petition for Cancellation.

16. Respondent denies the allegations contained in Paragraph 16 of the First Amended Petition for Cancellation and, for that reason, denies them.

17. Respondent denies the allegations contained in Paragraph 17 of the First Amended Petition for Cancellation.

18. Respondent denies the allegations contained in Paragraph 18 of the First Amended Petition for Cancellation and, for that reason, denies them.

19. Respondent admits the allegations contained in Paragraph 19 of the First Amended Petition for Cancellation.

20. Respondent admits the allegations contained in Paragraph 20 of the First Amended Petition for Cancellation.

21. Respondent denies the allegations contained in Paragraph 21 of the First Amended Petition for Cancellation.

### AFFIRMATIVE DEFENSES

1. The Petition for Cancellation fails to state a claim upon which relief may be granted.

2. Petitioner does not have priority based on alleged use of the wording CHEF ONE in connection with the goods named in paragraph 1 of the First Amended Petition For Cancellation, namely, “noodles, steam buns, dumplings and other Asian-inspired foods” (“Petitioner’s Goods”). It is noted that the description “Asian-inspired foods” is ambiguous and undefined.

3. Petitioner does not have priority based on alleged use of the marks shown in the



drawings of Registration Nos. 2573505 ( ), 3472727 ( ) and 3303188 (



) - (collectively, “Petitioner’s Marks”) in connection with Petitioner’s Goods and

as alleged in paragraphs 4, 6 and 8 of the First Amended Petition for Cancellation. It is noted that the goods named in Registrations '505, '727 and '188 are not identical to the goods on which Petitioner alleged Petitioner's Marks were used in commerce.

4. Petitioner discontinued use of Petitioner's Marks and the wording CHEF ONE in connection with Petitioner's Goods or in any other significant manner, without intent to resume use.

5. Petitioner did not file Declarations of Use in Registration Nos. 2573505, 3472727 and 3303188 because the marks therein were abandoned.

6. To the extent that Petitioner claims any common law rights in Petitioner's Marks and the wording CHEF ONE, the date of first use in commerce for those marks are after the filing date of February 6, 2012 or the priority date of January 20, 2012 of Respondent's Mark. Respondent claims constructive first use date of January 20, 2012 for Respondent's Mark, the priority date claimed in Registration '760.

7. To the extent that Petitioner claims any common law rights in Petitioner's Marks and the wording CHEF ONE, they are very limited to the small geographic areas.

8. Petitioner has not used the wording CHEF ONE alone or in a manner that has allowed the wording CHEF ONE to become recognized and relied upon by the relevant consumers as identifying Petitioner as the source of Petitioner's Goods or to distinguish Petitioner's Goods from the goods of others.

9. Petitioner's Marks are not identical or similar to Respondent's Mark and Petitioner's Goods are not identical or similar to the goods identified in Respondent's Mark and therefore there is no likelihood of confusion between Petitioner's Marks and Respondent's Mark.

10. Petitioner's claims are barred by the doctrine of laches, acquiescence and unclean hands.

11. Respondent reserves the right to amend its Answer to the Amended Petition for Cancellation and Counterclaims, to amend its Affirmative Defenses, to assert such additional Affirmative Defenses as it deems appropriate that may now exist or in the future are available based on discovery and further factual investigation in the proceeding.

## COUNTERCLAIMS

### Lack of Bona Fide Use

1. Respondent believes that it will be damaged by the continued registration of the mark as shown in Registration No. 5283788 (“Chinese Character Mark”) and mark shown in Registration No. 5146262 (“Fan Mark”).

2. On July 14, 2016, Petitioner filed an application to register the Chinese Character Mark under Serial No. 87106111 and the Fan Mark under Serial No. 87104314, both on the Principal Register and for “Asian style frozen foods, namely, noodles, dumplings, spring rolls, egg rolls, samosas, wonton appetizers; noodles and Asian noodles; dumplings; Chinese stuffed dumplings (gyoza, cooked); Korean-style dumplings (mandu); spring rolls; egg rolls; samosas; appetizers, namely, wontons; Asian-style buns; ramen noodles; potstickers; Asian-style sauces and fermented sauces; tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea; sausage rolls; sausage rolls marinated or cooked in Asian-style sauces” (“Applied for Goods”) claiming a first use date of May 1, 2001. These applications were thereafter allowed and registered under Registration Nos. 5283788 and 5146262.

3. In the applications for the Chinese Character Mark and the Fan Mark, Petitioner declared the following:

“The mark is in use in commerce on or in connection with the goods/services in the application.”

4. Petitioner has not used the Chinese Character Mark or the Fan Mark in commerce in the past or present in connection with beverages. See Exhibit A.

5. Upon information and belief, at the time Petitioner filed these applications based on use, Petitioner did not have use of the marks in connection with, at least, “tea-based beverages; boba teas, namely, tea-based beverages also containing tapioca pearls; tea-based beverages also containing fruits, milk, soy, flavored syrups; ginger tea; syrups for making tea” listed in the applications.

6. Thus, upon information and belief, at the time Petitioner filed its applications and as of the claimed date of first use of the applications, any use by Petitioner of the Chinese Character Mark and the Fan Mark did not constitute bona fide use of the Chinese Character Mark and the Fan Mark in United States commerce in connection with any of the Applied for Goods, and thus the Applications should be deemed void ab initio and the Registration Nos. 5283788 and 5146262 should be cancelled.

WHEREFORE, Respondent respectfully requests that the First Amended Petition for Cancellation be dismissed in its entirety, that Respondent's Counterclaims for cancellation of Registration Nos. 5283788 and 5146262 be granted and such Registrations be cancelled pursuant to 15 U.S.C. § 1064 and that the Board grant Respondent such other and further relief as it deems just and appropriate.

Respectfully submitted,

Dated: October 12, 2018

*/Sung Joo/*  
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*Attorneys for Defendant*



**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing RESPONDENT'S ANSWER TO AMENDED PETITION FOR CANCELLATION AND COUNTERCLAIMS was served on the Petitioner's attorneys via email at acarroll@mayerbrown.com and ipdocket@mayerbrown.com.

/Sung Joo/

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## Exhibit A

# DUMPLINGS - RETAIL

Select Products Category



(<http://chefonefoods.com/products-category/chicken-napa-cabbage-dumpling/>)



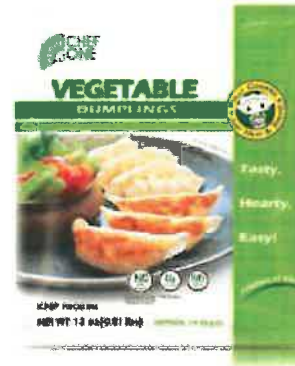
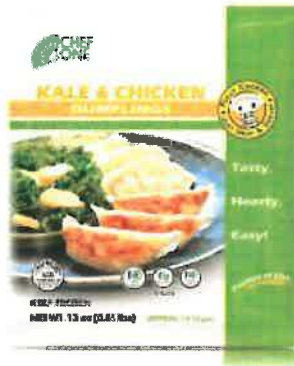
(<http://chefonefoods.com/products-category/kung-pao-chicken/>)

### Chicken Napa Cabbage Dumpling

(<http://chefonefoods.com/products-category/chicken-napa-cabbage-dumpling/>)

### Kung Pao Chicken Dumpling

(<http://chefonefoods.com/products-category/kung-pao-chicken/>)



(<http://chefonefoods.com/products-category/kale-and-chicken/>)

(<http://chefonefoods.com/products-category/vegetable-dumpling/>)

### Kale and Chicken Dumpling

(<http://chefonefoods.com/products-category/kale-and-chicken/>)

### Vegetable Dumpling

(<http://chefonefoods.com/products-category/vegetable-dumpling/>)



(<http://chefonefoods.com/products-category/thai-style-chicken/>)

(<http://chefonefoods.com/products-category/shrimp-dumpling/>)

Thai Style Chicken Dumpling  
 (<http://chefonefoods.com/products-category/thai-style-chicken/>)

Shrimp Dumpling  
 (<http://chefonefoods.com/products-category/shrimp-dumpling/>)



(<http://chefonefoods.com/products-category/chicken-lotus-root-dumpling/>)

(<http://chefonefoods.com/products-category/pork-napa-cabbage-dumpling/>)

Chicken & Lotus Root Dumpling  
 (<http://chefonefoods.com/products-category/chicken-lotus-root-dumpling/>)

Pork & Napa Cabbage Dumpling  
 (<http://chefonefoods.com/products-category/pork-napa-cabbage-dumpling/>)



(<http://chefonefoods.com/products-category/chicken-woodear-mushroom-dumpling/>)

(<http://chefonefoods.com/products-category/pork-chives-dumpling/>)

Chicken & Wood ear Mushroom Dumpling  
(<http://chefonefoods.com/products-category/chicken-woodear-mushroom-dumpling/>)

Pork & Chives Dumpling  
(<http://chefonefoods.com/products-category/pork-chives-dumpling/>)



(<http://chefonefoods.com/products-category/pork-shiitake-mushroom-dumpling/>)

Pork & Shiitake Mushroom Dumpling  
(<http://chefonefoods.com/products-category/pork-shiitake-mushroom-dumpling/>)



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(<https://instagram.com/chefonedumplings>)





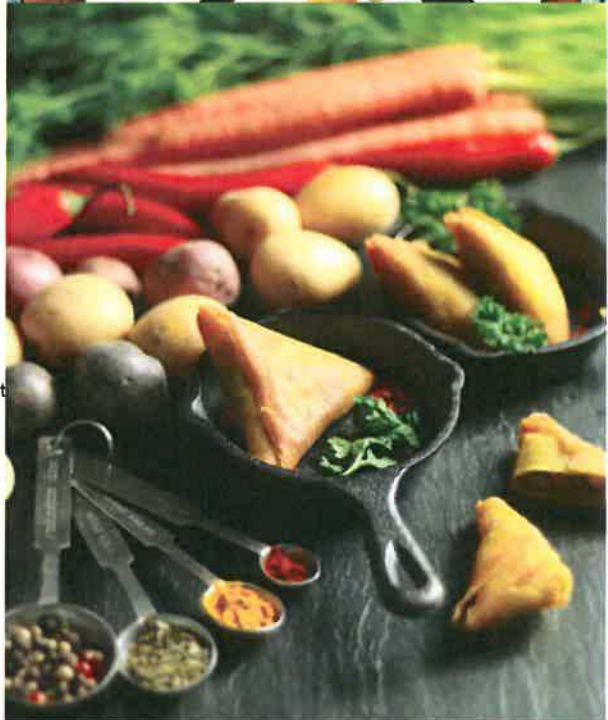
(https://www.instagram.com/p/BdyXdEbDf8T/)

### THE CHEF ONE ROLL BOWL

Philly Cheese Steak Egg Roll



Buffalo Chicken Egg Roll



(https://www.instagram.com/p/Bdled1pDgJx/)

CJ TMI (HTTP://WWW.CJTMI.COM/)
FAQ (HTTP://CHEFONEFOODS.COM/FAQ/)

CJ TMI (HTTP://WWW.CJTMI.COM)



(HTTP://WWW.TWINMARQUIS.COM/)

CHEF ONE (HTTP://WWW.CHEFONEFOODS.COM/)

tmi TRADING (HTTP://WWW.TMITRADING.COM/)

Designed by Socialfix (https://www.socialfix.com/)

([HTTPS://WWW.YOUTUBE.COM/CHANNEL/UCMH6XKY3FS1BDHRVPXLDPCW](https://www.youtube.com/channel/UCMH6XKY3FS1BDHRVPXLDPCW))

([HTTPS://WWW.INSTAGRAM.COM/CHEFONEDUMPLINGS/](https://www.instagram.com/chefonedumplings/))

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