

ESTTA Tracking number: **ESTTA944059**

Filing date: **12/27/2018**

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

| | |
|------------------------|--|
| Proceeding | 92067247 |
| Party | Plaintiff Chef One Corporation |
| Correspondence Address | AMY E CARROLL MAYER BROWN LLP 1999 K STREET NW WASHINGTON, DC 20006-1101 UNITED STATES ipdocket@mayerbrown.com, acarroll@mayerbrown.com 202-263-3041 |
| Submission | Other Motions/Papers |
| Filer's Name | Amy E. Carroll |
| Filer's email | ipdocket@mayerbrown.com, acarroll@mayerbrown.com |
| Signature | /amyecarroll/ |
| Date | 12/27/2018 |
| Attachments | Final Chef One Reply Brief Motion to Dismiss.pdf(13925 bytes) |

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

In the Matter of Registration No. 4,787,760
For the mark: CHEFONE & Design
Registered: August 11, 2015

| |
|--|
| <p>CHEF ONE CORPORATION,</p> <p style="text-align:center">PETITIONER,</p> <p style="text-align:center">v.</p> <p>DAESANG CORPORATION,</p> <p style="text-align:center">RESPONDENT.</p> |
|--|

Cancellation No. 92-067,247

**PETITIONER’S REPLY BRIEF IN SUPPORT OF
MOTION TO DISMISS**

Petitioner, Chef One Corporation, through its undersigned counsel, hereby submits its reply to Respondent’s Opposition to Petitioner’s Motion to Dismiss (the “Opposition Brief”) pursuant to Section 503.02 of the Trademark Trial and Appeal Board’s Manual of Procedure.

With respect to the issue of Respondent's standing to bring the asserted Counterclaim, Respondent has not in its Opposition Brief presented any additional facts that support its standing. In particular, Respondent has not established that it has a “real interest” in the outcome of the allegations set forth in the Counterclaim or a “reasonable basis” for its belief of damage. Moreover, the various cases to which Respondent cites involve the finding of standing because the counterclaims pertained to *pleaded* registrations. See, e.g., *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478 (TTAB 2007) (addressing standing in the context of pleaded registrations); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492 (TTAB 2005) (addressing standing in the context of pleaded registrations).

Petitioner recognizes that in the case of cancellations involving pleaded registrations, standing to cancel such pleaded registrations is inherent. In the instant case, however, the Counterclaim involves only Petitioner's Registrations No. 5,146,262 and 5,283,788, which are *not* pleaded registrations. As the Board noted in its order dated September 10, 2018, “[t]he amended petition for cancellation is now Petitioner’s operative pleading,” and such amended petition does not include the registrations to which the Counterclaim pertains. 20 TTABVUE 7.

The facts present in the *Syntex* case cited extensively in Respondent's Opposition Brief also vary considerably from the facts in the present proceeding. In the *Syntex* case, the registration that was asserted as the basis for the counterclaim was alleged to be confusingly similar to the counterclaimant's mark. As the Board noted in that case, “[a]pplicant has been threatened by opposer with opposer's registration ... [and] has been forced into a litigation as the result of opposer's action.” *Syntex (U.S.A.) Inc. v. E. R. Squibb & Sons*, 14 USPQ2d 1879, 1880 (TTAB 1990). In the instant proceeding, Petitioner mistakenly included Registrations No. 5,146,262 and 5,283,788 as bases for its cancellation, but corrected this mistake shortly after it was made aware of the same. As Petitioner noted in its Motion to Amend, the removed registrations “are not at all relevant to Petitioner’s basis for seeking cancellation” and “there is no likelihood of confusion between the two registrations.” 15 TTABVUE 2. Far from threatening Respondent with the mistakenly included registrations, Petitioner did not in its initial Petition to Cancel make *any* assertions regarding these registrations as validly forming the basis for its claim. In sum, Petitioner has never used the mistakenly included registrations as a “weapon” against Respondent, and Respondent thus lacks standing in bringing its permissive Counterclaim. *Syntex (U.S.A.)* at 1880.

Petitioner also notes that Respondent's attempt to establish standing based on a "same transaction or occurrence" argument is not supported by the cited cases. In particular, neither of the cited cases deal with the issue of standing, but rather address the issue of a court's subject matter jurisdiction over permissive counterclaims. *See Leipzig v. AIG Life Insurance Co.*, 362 F.3d 406, 409-410 (7th Cir. 2004); *Crosby Yacht Yard, Inc. v. Yacht "Chardonnay"*, 164 F.R.D. 135 (D. Mass. 1996). In other words, these cases have nothing to do with a party's standing to bring a permissive counterclaim in a Board proceeding.

With respect to Respondent's failure to state a claim upon which relief can be granted, Petitioner similarly cites to case law involving facts that differ from the facts in the present proceeding. In particular, the *Spirits International* case involved the Board finding that an applicant lacked a bona fide *intent to use* its mark because it did not rebut any of opposer's evidence, nor did it even file a brief. *Spirits international, B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliigi*, 99 USPQ2d 1545 (TTAB 2011). In other words, it did not involve an allegation of lack of bona fide use, as the Respondent has asserted in its Counterclaim. As Petitioner noted in its Motion to Dismiss, Respondent does not allege in its Counterclaim that the marks identified in Petitioner's Registrations No. 5,146,262 and 5,283,788 were *not* in use with respect to *all* goods covered. In fact, Respondent includes as Exhibit A to its own Counterclaim pleading evidence that Petitioner is making use of the marks covered by the registrations that Respondent is challenging. For this reason, Respondent's assertion of lack of bona fide use as a basis for its Counterclaim fails.

Based on the foregoing, and for the reasons set forth in Petitioner's Motion to Dismiss, Petitioner respectfully requests that the Board grant Petitioner's Motion to Dismiss filed on November 16, 2018.

Dated: December 27, 2018

Respectfully submitted,

By: /Amy E. Carroll/
Amy E. Carroll, Esq.
Mayer Brown LLP
1999 K Street, N.W.
Washington, DC 20006-1101
202-263-3041
acarroll@mayerbrown.com
ipdocket@mayerbrown.com

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Reply Brief in Support of Motion to Dismiss has been served on Sung Joo, Esq. by forwarding said copy on December 27, 2018, via email and U.S. first class mail to:

Sung Joo
Lucas & Mercanti, LLP
30 Broad Street
New York, New York 10004
info@lmiplaw.com
eld@lmiplaw.com
sjoo@lmiplaw.com

/Amy E. Carroll/

Amy E. Carroll