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Filing date: **02/14/2018**

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

Proceeding	92067247
Party	Defendant Daesang Corporation
Correspondence Address	SUNG JOO LUCAS & MERCANTI, LLP 30 BROAD ST FL 21 NEW YORK, NY 10004 UNITED STATES Email: sjoo@lmiplaw.com, ychoe@lmiplaw.com, info@lmiplaw.com
Submission	Answer and Counterclaim
Filer's Name	Sung Joo
Filer's email	sjoo@lmiplaw.com, eld@lmiplaw.com, info@lmiplaw.com
Signature	/Sung Joo/
Date	02/14/2018
Attachments	SKM_C654e18021421410.pdf(706181 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, 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-			
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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 AND COUNTERCLAIM FOR CANCELLATION

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

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

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

4. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Petition for Cancellation and, for that reason, denies them.

5. Respondent denies the allegations contained in Paragraph 5 of the Petition for Cancellation.

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

7. Respondent denies the allegations contained in Paragraph 7 of the Petition for Cancellation.

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

9. Respondent denies the allegations contained in Paragraph 9 of the Petition for Cancellation.

10. Respondent denies the allegations contained in Paragraph 10 of the Petition for Cancellation.

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

12. Respondent denies the allegations contained in Paragraph 12 of the Petition for Cancellation.

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

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

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

16. Respondent denies the allegations contained in Paragraph 16 of the Petition for Cancellation.

17. Respondent admits the allegations contained in Paragraph 17 of the Petition for Cancellation.

18. Respondent admits the allegations contained in Paragraph 18 of the Petition for Cancellation.


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

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

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

AFFIRMATIVE DEFENSES

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

2. Petitioner will not suffer any damage by Respondent's use of the mark CHEFONE & Design  as identified in Registration No. 4787760.

3. To the extent that Petitioner's claims that Registration No. 2573505 was cited in the refusal to register Respondent's Mark issued by USPTO on July 8, 2013, was cancelled for failure to file a declaration of use during the pendency of Respondent's time to respond to the refusal, that as a result of its cancellation the USPTO allowed Respondent's Mark to register, are incorrect, Petitioner has not pleaded the mark(s) upon which it relies with sufficient particularity.

4. To the extent that it is undetermined whether Petitioner filed a trademark application for the word mark "Chef One" in combination with a fan logo consisting of forks and spoons, which was registered on July 22, 2008, as U.S. Registration No. 3472727, Petitioner has not pleaded the mark(s) upon which it relies with sufficient particularity.

5. Except to the extent Petitioner has pleaded rights in the particular registered marks in Registration Nos. 2573505 and 3472727, Petitioner has not pleaded any rights in any other registered or common law marks.

6. Petitioner committed fraud in the procurement of or during the prosecution of its application for Registration No. 3472727.

7. There is no likelihood of confusion between Respondent's Mark and the marks in Petitioner's Registration Nos. 2573505 and 3472727. Among other things, Respondent's mark is not identical or similar to these marks in sight, sound, appearance or commercial impression.

8. Petitioner's Registration Nos. 2573505 and 3472727 lack priority of use. Registration Nos. 2573505 and 3472727 are no longer active, having been cancelled on March 7, 2009 and April 9, 2015, respectively. On the other hand, with regards to Registration No. 4787760, Respondent filed its request for extension of protection based on an international registration that claimed a priority date of January 20, 2012. Respondent claims constructive first use as of that date. Petitioner has not provided proof of common-law use prior to January 20, 2012.

9. On information and belief, Petitioner intentionally discontinued the use of mark identified in U.S. Trademark Registration No. 3472727 on its claimed products in commerce or in any other significant manner.

10. On information and belief, Petitioner intentionally discontinued the use of mark identified in U.S. Trademark Registration Nos. 2573505 on its claimed products in commerce or in any other significant manner, prior to Respondent's priority date of January 20, 2012.

11. To the extent that Petitioner has any rights in the marks in U.S. Trademark Registration Nos. 2573505 and 3472727, they are very limited to the small geographic areas where Petitioner can establish prior and continuous rights.

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

13. Respondent reserves the right to amend its Answer to the Petition for Cancellation, to amend its Affirmative Defenses, to assert such additional Affirmative Defenses

as it deems appropriate and such Counterclaims as may be permitted that may now exist or in the future are available based on discovery and further factual investigation in the proceeding.

COUNTERCLAIM FOR CANCELLATION

Lack of Bona Fide Use

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

2. Petitioner, in its Petition for Cancellation, cited Registration Nos. 5283788 and 5146262 in support of its claims.

3. 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.

4. 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.”

5. 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.

6. 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.

7. 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 Cancellation be dismissed in its entirety, that Respondent’s Counterclaim 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: February 14, 2018

/Sung Joo/
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Attorneys for Defendant

Exhibit A

DUMPLINGS - RETAIL

Select Products Category



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



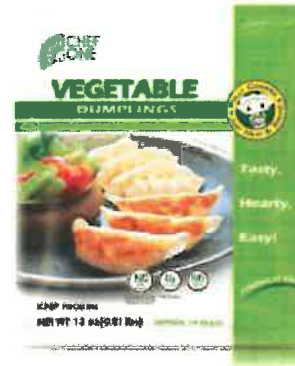
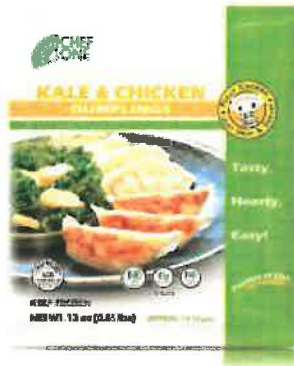
(<http://chefonefoods.com/products-category/kung-pao-chicken/>)

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

Pork & Chives Dumpling

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



Want to learn more about our products?

CONTACT US ([HTTP://CHEFONEFOODS.COM/CONTACT-US/](http://chefonefoods.com/contact-us/))

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@chefonedumplings

Filled with Inspiration 🍲 ! Made in Brooklyn 🏠 Tag us #letsdodumplings
(<https://instagram.com/chefonedumplings>)



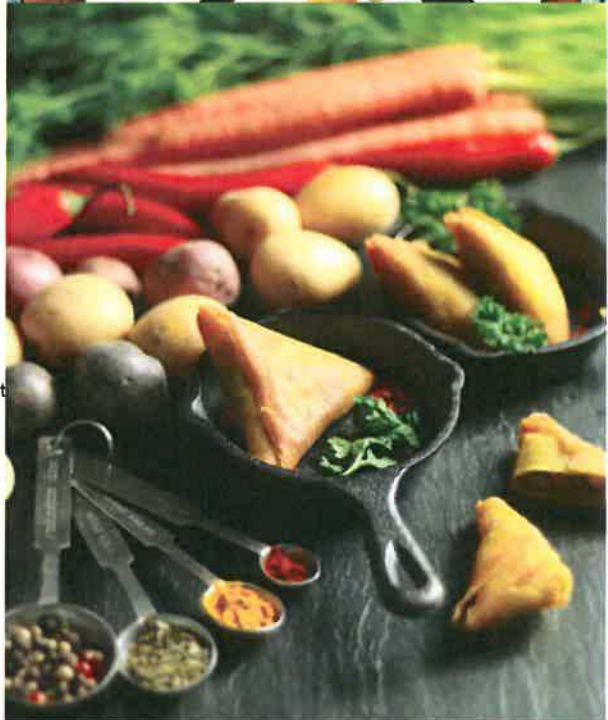
(https://www.instagram.com/p/BdyXdEbDf8T/)

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/))

([HTTPS://WWW.FACEBOOK.COM/CHEFONECORP](https://www.facebook.com/chefonecorp))

([HTTPS://TWITTER.COM/CHEFONEDUMPLING](https://twitter.com/chefonedumpling))

info@chefonefoods.com (<mailto:info@chefonefoods.com>)

(718) 386 6868 (<tel:7183866868>)

7 Bushwick Place, NY 11206

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing RESPONDENT'S ANSWER AND COUNTERCLAIM FOR CANCELLATION was served on the Petitioner's attorneys via email at cpark@choiandpark.com, lkleist@choiandpark.com, hchoi@choiandpark.com and jpatten@choiandpark.com.

/Sung Joo/ _____

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