

ESTTA Tracking number: **ESTTA992387**

Filing date: **08/02/2019**

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

Proceeding	92071449
Party	Defendant MACK & SCHUHLE, INC.
Correspondence Address	MACK & SCHUHLE, INC. SUITE 402, 104 CRANDON PARK BLVD KEY BISCAYNE, FL 33149 UNITED STATES no email provided no phone number provided
Submission	Other Motions/Papers
Filer's Name	John M. Rannells
Filer's email	jmr@br-tmlaw.com, p.chang@br-tmlaw.com, k.hnasko@br-tmlaw.com
Signature	/John M. Rannells/
Date	08/02/2019
Attachments	Response to Notice of Default revjmr.pdf(15907 bytes ) Declaration.pdf(52729 bytes ) Answer rev.pdf(16492 bytes )

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

In re United States Reg. No. 5531696  
Mark: LA RUE

-----  
LaRue Wines, Inc., )  
 )  
 Petitioner, )  
 )  
 v. ) **Cancellation No. 92071449**  
 )  
 MACK & SCHUHLE, INC., )  
 )  
 Registrant )  
-----

**REGISTRANT'S RESPONSE TO TTAB NOTICE OF DEFAULT AND ORDER TO  
SHOW CAUSE WHY JUDGMENT BY DEFAULT SHOULD NOT BE ENTERED**

Registrant, MACK & SCHUHLE, INC., (“Registrant”), by and through its attorneys Baker and Rannells, PA, hereby responds to the Board's Notice of Default and Order to Show Cause and requests that this Honorable Board permit the late filing of Registrant's Answer to the Petition of Cancellation in the captioned proceeding. Registrant's proposed Answer and Affirmative Defenses are attached hereto for consideration by the Board.

Pursuant to the Notice of Institution in the proceeding, Registrant's deadline to file an Answer to the captioned Petition for Cancellation was July 17, 2019.

Registrant’s attorneys of record were not served with the subject Petition for Cancellation or the Notice of Default. *See* TSDR documents and attorney correspondence record for Reg. 5531696. The Notice of Default was discovered by the undersigned attorney of record on August 1, 2019, during a random review of Registrant’s portfolio against Trademark Office records. We were entirely unaware. Upon discovering the Notice, an Answer and Affirmative

Defenses were immediately prepared, It is attached herewith. Registrant moves to have the same accepted and made of record.

The late filing is a result of the undersigned not being served by the Board and is not the result of willful conduct or gross neglect on the part of defendant.

The failure to timely file an Answer to a Petition for Cancellations is governed by the "good cause" standard of Fed. R. Civ. P. 55(c). *See, Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 21 USPQ2d 1556 (TTAB 1991). "Good cause is usually found to have been established if the delay in the filing is not the result of willful conduct or gross neglect on the part of the defendant." *Id.*, at 1557.

The marks in issue in the captioned proceeding are:

Registrant: The mark LA RUE for " Alcoholic beverages, except beer; sparkling wines; wines" (Reg. No. 5531696). Registrant's mark was published without any Section 2(d) citation to Opposer's or any other third-party marks.

Petitioner: The mark LARUE for hats, shirts in class 25 (Reg. No. 4572687) and alleged common law use of the marks LARUE, LARUE WINES, and LARUE and LARUE WINES in stylized form for wine.

As set forth in Registrant's Answer, Registrant denies that there is a likelihood of confusion. Further, and as set forth in Registrant's Affirmative Defenses, the marks "LA RUE" and "LARUE" are highly diluted in the United States as used on and/or registered for alcoholic beverages and other relevant goods and services.

Registrant submits an Answer (attached hereto) which is clearly not frivolous, and Registrant has shown, through said Answer and Affirmative Defenses that it has a meritorious defense.

A slight delay in filing its Answer due to non-service of the action, will cause little or no prejudice to Opposer.

Accordingly, for good cause shown, Registrant prays that its Answer submitted herewith be accepted and made of record.

Respectfully submitted,  
Baker and Rannells PA

          /Pei-Lun Chang/            
Pei-Lun Chang  
John M. Rannells  
Stephen L. Baker  
Attorneys for Registrant  
92 East Main St., Suite 302  
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[p.chang@br-tmlaw.com](mailto:p.chang@br-tmlaw.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE DEFENSES has been served on Petitioner via email on August 2, 2019 to the attorneys for Petitioner –

DAVID E CROMER  
DORITY & MANNING PA  
75 BEATTIE PLACE SUITE 1100  
GREENVILLE, SC 29601  
UNITED STATES

litdocketing@dority-manning.com, dcromer@dority-manning.com, jpittman@dority-manning.com, timw@dority-manning.com  
Phone: 864-271-1592

*/Pei-Lun Chang/*

Pei-Lun Chang

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

In re United States Reg. No. 5531696  
Mark: LA RUE

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 Petitioner, )  
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 MACK & SCHUHLE, INC., )  
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 Registrant )  
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**DECLARATION OF PEI-LUN CHANG IN SUPPORT OF REGISTRANT MACK AND SCHUHLE, INC.'S RESPONSE TO TTAB NOTICE OF DEFAULT AND ORDER TO SHOW CAUSE WHY JUDGMENT BY DEFAULT SHOULD NOT BE ENTERED**

I, Pei-Lun Chang, declare as follows:

1. I am a partner at Baker and Rannells, PA. and am one of the counsels of Mack & Schuhle, Inc. I submit this declaration in support of Registrant's RESPONSE TO TTAB NOTICE OF DEFAULT AND ORDER TO SHOW CAUSE WHY JUDGMENT BY DEFAULT SHOULD NOT BE ENTERED.
2. Although the subject Petition for Cancellation was initiated by Petitioner on June 4<sup>th</sup>, 2019, the undersigned and his firm were not notified or served by the the Trademark Trial and Appeal Board regarding the action.
3. As such, the failure to Answer or respond to the Notice of Default was not the result of willful conduct or gross neglect on the part of defendant.
4. Attached as Exhibit 1 is a true and correct copy of the TTABVUE print out showing the Board did not include the undersigned or a member of his firm as correspondence for the case.

Respectfully submitted,

Baker and Rannells PA

/Pei-Lun Chang/

John M. Rannells

Stephen L. Baker

Pei-Lun Chang

Attorneys for Registrant

92 East Main St., Suite 302

Somerville, New Jersey 08876

(908) 722-5640

[jmr@br-tmlaw.com](mailto:jmr@br-tmlaw.com)

[s.baker@br-tmlaw.com](mailto:s.baker@br-tmlaw.com)

[p.chang@br-tmlaw.com](mailto:p.chang@br-tmlaw.com)

# Exhibit 1

Search:

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**Cancellation**

**Number:** 92071449 **Filing Date:** 06/04/2019  
**Status:** Suspended **Status Date:** 07/27/2019  
**General Contact Number:** 571-272-8500  
**Interlocutory Attorney:** [ANDREW P BAXLEY](#)  
**Paralegal Name:** [ROCHELLE L ADAMS](#)

**Defendant**

**Name:** [MACK & SCHUHLE, INC.](#)  
**Correspondence:** [MACK & SCHUHLE, INC.](#)  
SUITE 402, 104 CRANDON PARK BLVD  
KEY BISCAYNE, FL 33149  
UNITED STATES

**Serial #:** [87564633](#)      [Application File](#)      [Assignment](#)      **Registration #:** [5531696](#)  
**Application Status:** Cancellation Pending  
**Mark:** LA RUE

**Plaintiff**

**Name:** [LaRue Wines, Inc.](#)  
**Correspondence:** [DAVID E CROMER](#)  
DORITY & MANNING PA  
75 BEATTIE PLACE SUITE 1100  
GREENVILLE, SC 29601  
UNITED STATES  
litdocketing@dority-manning.com, dcromer@dority-manning.com, jpittman@dority-manning.com, timw@dority-manning.com  
Phone: 864-271-1592

**Serial #:** [85239451](#)      [Application File](#)      [Assignment](#)      **Registration #:** [4572687](#)  
**Application Status:** Registered  
**Mark:** LARUE WINES

**Prosecution History**

Date	History Text	Due Date
07/27/2019	<a href="#">NOTICE OF DEFAULT</a>	
06/07/2019	INSTITUTED	
06/07/2019	<a href="#">NOTICE AND TRIAL DATES SENT; ANSWER DUE:</a>	07/17/2019
06/04/2019	<a href="#">FILED AND FEE</a>	

Results as of 08/01/2019 04:51 PM Search:



**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Declaration has been served on Petitioner via email on August 2, 2019 to the attorneys for Petitioner –

DAVID E CROMER  
DORITY & MANNING PA  
75 BEATTIE PLACE SUITE 1100  
GREENVILLE, SC 29601  
UNITED STATES

litdocketing@dority-manning.com, dcromer@dority-manning.com, jpittman@dority-manning.com, timw@dority-manning.com  
Phone: 864-271-1592

/Pei-Lun Chang/

Pei-Lun Chang

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**ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE  
DEFENSES**

Registrant, MACK & SCHUHLE, INC., (“Registrant”), by and through its attorneys Baker and Rannels, PA, for its Answer to the Petition for Cancellation filed by Petitioner, LaRue Wines, Inc.(“Petitioner”), alleges on knowledge as to its own acts and otherwise upon information and belief as follows:

**ANSWER**

1. Admitted.
2. Admitted.
3. Admitted and affirmatively asserts that the application was not opposed and that no extensions of time to oppose were filed against the application
4. Admitted.
5. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 5 of the Petition for Cancellation concerning Petitioner's alleged common law rights and therefore denies the same.

6. Registrant admits issuance of Petitioner's Reg. No. 4572687 but otherwise has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 6 of the Petition for Cancellation and therefore denies the same.

7. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 7 of the Petition for Cancellation and therefore denies the same.

8. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 8 of the Petition for Cancellation and therefore denies the same.

9. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 9 of the Petition for Cancellation and therefore denies the same.

10. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 10 of the Petition for Cancellation and therefore denies the same.

11. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 11 of the Petition for Cancellation and therefore denies the same.

12. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 12 of the Petition for Cancellation and therefore denies the same.

13. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 13 of the Petition for Cancellation and therefore denies the same.

14. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 14 of the Petition for Cancellation and therefore denies the same.

15. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 15 of the Petition for Cancellation and therefore denies the same.

16. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 16 of the Petition for Cancellation and therefore denies the same.

17. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 17 of the Petition for Cancellation and therefore denies the same.

18. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 18 of the Petition for Cancellation and therefore denies the same.

19. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 19 of the Petition for Cancellation and therefore denies the same

### **AFFIRMATIVE DEFENSES**

1. Registrant affirmatively asserts that during examination and prosecution of Registrant's application, there was no Section 2(d) refusal of Registrant's mark based upon any third-party mark.
2. The marks "LARUE" and "LA RUE" are registered by third-parties for goods and services relevant to alcoholic beverages in the U.S. Patent and Trademark Office by numerous third-parties and accordingly, Petitioner's marks are weak and subject to the very limited area of protection.
3. The marks "LARUE" and "LA RUE" are highly diluted as used and/or registered in the United States and accordingly, Petitioner's marks are weak and subject to the very limited area of protection.

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

BAKER AND RANNELLS, PA

By:           /Pei-Lun Chang/            
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Stephen L. Baker  
Pei-Lun Chang  
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[s.baker@br-tmlaw.com](mailto:s.baker@br-tmlaw.com)

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*/Pei-Lun Chang/*

Pei-Lun Chang