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

Proceeding	92072311
Party	Defendant Super Chef's Breakfast and More LLC
Correspondence Address	SUPER CHEF'S BREAKFAST AND MORE LLC 199 E BROAD STREET COLUMBUS, OH 43215 UNITED STATES no email provided no phone number provided
Submission	Motion to Dismiss - Rule 12(b)
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Attachments	3 - Registrant - Motion to Dismiss - 10-28-2019.pdf(211476 bytes)

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

In the matter of Trademark Application Registration No. 4841206

DARNELL FERGUSON	:	
	:	Cancellation No. 92072311
Petitioner,	:	
	:	Mark: SUPER CHEF’S
-vs.-	:	Registration No. 4841206
	:	
SUPER CHEF’S BREAKFAST AND MORE	:	
LLC	:	
	:	
Registrant.	:	

**REGISTRANT SUPER CHEF’S BREAKFAST AND MORE LLC’S MOTION TO
DISMISS**

Now comes Registrant Super Chef’s Breakfast and More LLC (“*Registrant*”), by and through the undersigned counsel, and pursuant to Federal Rule of Civil Procedure 12(b)(6), respectfully moves the Trademark Trial and Appeal Board to dismiss all counts of Petitioner Darnell Ferguson’s Petition for Cancellation. The factual and legal basis for this motion is more fully set forth in the accompanying Memorandum in Support.

Respectfully submitted,

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MEMORANDUM IN SUPPORT

Petitioner Darnell Ferguson (“*Petitioner*”) fails to allege that he has any priority over the “SUPER CHEF’S” mark in any capacity. There are no allegations that Petitioner either used the mark in commerce or registered it prior to Registrant’s use and subsequent registration. Rather, Petitioner only states that he was nicknamed “super chef” during his time as an intern with the USA Olympic Team and that the name was previously used by a now dissolved Kentucky limited liability company, SuperChef’s Breakfast, L.L.C, which was allegedly jointly owned by Petitioner and Registrant’s principal, Mr. Ryan Bryson.

Neither of these statements support the notion that Petitioner has any priority to the Mark over Registrant. Receiving the nickname “super chef” does not constitute prior use in commerce. Similarly, the prior use that is alleged is on behalf of SuperChef’s Breakfast, L.L.C. and not Petitioner in his individual capacity. Even if SuperChef’s Breakfast, L.L.C. did have prior use and/or rights to the Mark, it has long since abandoned the Mark since it has been dissolved for approximately six years and has never resumed such use. To this extent, Petitioner lacks standing to bring this Petition for Cancellation. Finally, Petitioner’s allegations of misrepresentations by Registrant fall far short of any cognizable claim for fraud.

I. SUMMARY OF ALLEGED FACTS

Petitioner alleges he has priority over the use of the mark “SUPER CHEF’S”, registration number 4841206 (hereinafter the “*Mark*”) due to common law rights arising from his prior use of the Mark. However, Petitioner fails to make any allegations that he personally used the Mark in commerce at any time prior to Registrant. Petitioner alleges that he was “publicly recognized as ‘SuperChef’ since 2008” and points to his attached Exhibit A. (*Petition for Cancellation* at ¶9). According to Exhibit A, Petitioner was nicknamed “SuperChef” *during* his internship with

the USA Olympic Team during the 2008 Beijing Olympics. (*Id.* at ¶9). There are no allegations supporting Petitioner’s assertion that this was made public at the time or that it was otherwise used in commerce for goods or services that would establish any common law rights to the Mark.¹

Next, Petitioner details how he and Mr. Bryson opened the Kentucky entity SuperChef’s Breakfast, L.L.C. in May 2012 (allegedly as co-owners), but then states that the company was dissolved approximately one year later in 2013. (*Id.* at ¶4, 10). It was then, in June 2013, that Mr. Bryson opened the Ohio entity and associated restaurant Super Chef’s Breakfast and More, LLC (the Registrant in this matter) in Columbus, Ohio. (*Id.* at ¶28). However, by Petitioner’s own admission, he did not subsequently use the Mark again until 2015 when he opened a new Super Chef’s restaurant in Louisville, Kentucky under a newly formed Kentucky entity called The SuperChefs Limited Liability Company. (*Id.* at ¶38).

In other words, Petitioner Darnell Ferguson, as an individual, never once alleges use of the Mark in commerce prior to Registrant’s opening in June 2013. He merely claims to be one-half owner of the Kentucky entity and restaurant SuperChef’s Breakfast, L.L.C., which has been dissolved since 2013. To the extent there is any *prior use* of the Mark, it was on behalf of the Kentucky entity and not Petitioner in his personal capacity. Further, because SuperChef’s Breakfast, L.L.C. has been dissolved for approximately six years, even if it did have any rights to the Mark, they have long since been abandoned.

At best, Petitioner alleges an ownership dispute over SuperChef’s Breakfast, L.L.C. To the extent Petitioner feels he is an owner of SuperChef’s Breakfast, L.L.C., and any intellectual

¹ Petitioner claims that Registrant’s website “admits that Petitioner was publicly recognized as ‘SuperChef’ since 2008” and cites Exhibit A in support. (*Petitioner for Cancellation* at ¶9). But Exhibit A states nothing more than Petitioner was dubbed “SuperChef” which later served as inspiration for the Kentucky entity SuperChef’s Breakfast, L.L.C. However, as explained *infra*, mere adoption does not qualify as use in commerce.

property rights the company may own, Petitioner would be better served bringing such a claim in an appropriate court of law rather than this forum which is designed strictly for trademark registration disputes.

II. LAW AND ARGUMENT

“The Lanham Act allows for cancellation of a Principal Register registration by anyone ‘who believes that he is or will be damaged ... by the registration.’ The party seeking cancellation must prove two elements: (1) that it has standing; and (2) that there are valid grounds for canceling the registration.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000). If the registered Mark has been on the Principal Register for less than five years, then “any ground that would have prevented registration in the first place qualifies as a valid ground for cancellation.” *Id.* at 945–46.

A. Counts 1, 2, and 4 of the Petition for Cancellation Fail Because Petitioner Has Failed to Allege Any Priority of Use Over the Mark.

Counts 1 (prior use of the Mark), 2 (prior common law rights), and 4 (likelihood of confusion) of the Petition for Cancellation are all premised on the notion that Petitioner has some priority over Registrant’s Mark via prior use and established common law rights; which his allegations fail to show.

i. Receiving a Nickname and Adopting it as a Personal Moniker is Mere Adoption and Does Not Constitute Use in Commerce.

Petitioner’s allegations that he was nicknamed “super chef” during an internship with the USA Olympic team and that he adopted this as a personal moniker does not constitute use in commerce, even if it was the motivation behind naming a now dissolved Kentucky entity or Registrant’s restaurant. It is use in commerce, and not mere adoption, that gives one common law rights in a mark.

“One valid ground for cancellation is section 2(d) of the Lanham Act, which precludes registration when a Mark is likely to cause confusion with a Mark or trade name previously used or registered by another. Hence, a party petitioning for cancellation under section 2(d) must show that it had priority and that registration of the Mark creates a likelihood of confusion.” *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1161–62 (Fed. Cir. 2002) (internal citations omitted).

“To establish priority, the petitioner must show proprietary rights in the Mark that produce a likelihood of confusion.” *Id.* at 1162. These proprietary rights may arise from a prior registration or prior trademark or service mark use. *Id.* “Before a prior use becomes an analogous use sufficient to create proprietary rights, the petitioner must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the petitioner's goods.” *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002). “[T]he activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark.” *Id.* Further, common-law trademarks, and the right to their exclusive use, grows **out of use, not mere adoption**. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413, 36 S. Ct. 357, 360, 60 L. Ed. 713 (1916) (emphasis added).

“One of the bedrock principles of trademark law is that trademark or service mark ownership is not acquired by federal or state registration. Rather, ownership rights flow only from prior appropriation and actual use in the Market.” *Allard Enterprises, Inc. v. Advanced Programming Res., Inc.*, 146 F.3d 350, 356 (6th Cir. 1998). “In the absence of federal registration, prior ownership of a Mark is only established as of the first actual use of a Mark in a genuine commercial transaction.” *Id.* at 358. Intent to use a Mark establishes no rights at all.

Zazu Designs v. L'Oreal, S.A., 979 F.2d 499, 504 (7th Cir. 1992); citing *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1472 (Fed.Cir.1987). “To acquire ownership of a trademark it is not enough to have intended the mark first or even have registered it first; the party claiming ownership must have been the first to actually use the Mark in the sale of goods or services.” *Sengoku Works Ltd. v. RMC Int'l, Ltd.*, 96 F.3d 1217, 1219 (9th Cir.), as modified, 97 F.3d 1460 (9th Cir. 1996).

Petitioner’s claim that he was nicknamed “super chef” in 2008 during the Olympics, even if it did inspire the name used by Registrant, is simply not enough to establish a common law right in the Mark without some additional allegation that the Mark was used by Petitioner in commerce. At most, this is mere adoption and not use in commerce. Case law throughout the federal circuits are replete with examples illustrating this principle.

For instance, in *Zazu Designs v. L'Oreal, S.A.*, the Seventh Circuit held that Zazu Designs did not have priority of the mark “Zazu” (associated with shampoo) over L’Oreal even though Zazu Designs had begun developing the line one year prior to L’Oreal’s use and subsequent registration. 979 F.2d 499, 503 (7th Cir. 1992). Zazu Designs began developing its product as early as 1985, and between November 1985 and February 1986 shipped bottles of it to a friend in Texas and to a hair stylist in Florida – which “were designed to interest the Floridian in the future marketing of the product line.” *Id.* at 502. However, the bottles “could not have been sold to the public because they lacked labels listing the ingredients and weight.” *Id.* L’Oreal did not make its first shipment of a product under the same name until April 1986 and filed for federal registration in June 1986. *Id.* at 501. The court held that even though Zazu Designs developed the product line and name first, its shipment of the product designed to gauge interest, rather than actually selling to the public, did not qualify as prior use in commerce. *Id.* at 503.

Petitioner in this case similarly conflates mere adoption with use in commerce. Simply being nicknamed “super chef” and adopting that nickname as a personal moniker does not constitute prior use in commerce that would establish any common law rights in the Mark.

Petitioner does not allege that he used the Mark in commerce after receiving the nickname. Petitioner does not allege that he sold any goods or services prior to Registrant’s registration of the Mark. Petitioner’s only other allegation of prior use of the Mark in commerce is that he was allegedly a co-owner of SuperChef’s Breakfast, L.L.C. (*Petition for Cancellation* at ¶4). However, according to Petitioner’s allegations, SuperChef’s Breakfast, L.L.C. was formed in 2012 and dissolved in 2013. (*Id.* at ¶4).

ii. Petitioner Only Alleges Prior Use in Commerce by non-party Super Chef’s Breakfast, L.L.C. Which was Dissolved Six Years Ago and Has Long Abandoned Any Rights to the Mark it May Have Had.

To the extent the dissolved Kentucky entity SuperChef’s Breakfast, L.L.C. obtained any common law rights in the Mark, these rights belong exclusively to it and not to Petitioner individually. “As a general rule, a trademark can only have one owner and that owner is the entity that controls the good will associated with the Mark. It is axiomatic that a trademark has no existence apart from the good will of the product or service it symbolizes.” *Intrawest Fin. Corp. v. W. Nat. Bank of Denver*, 610 F. Supp. 950, 956 (D. Colo. 1985). Petitioner has only alleged that SuperChef’s Breakfast, L.L.C. used the Mark in the operation of a restaurant prior to Registrant’s first date of use – rather than Petitioner himself. (*Petition for Cancellation* at ¶4). This simply does not qualify as prior use by Petitioner. To the extent SuperChef’s Breakfast, L.L.C. believes it has an interest in the Mark, then it should bring a petition for cancellation rather than Petitioner in his individual capacity.

To the extent SuperChef's Breakfast, L.L.C. had any rights to the Mark, it unquestionably abandoned them. Under 15 U.S.C. § 1127, "a registered trademark is considered abandoned if its use has been discontinued with intent not to resume such use. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment." *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010). According to petitioner's own allegations, SuperChef's Breakfast, L.L.C. was dissolved in 2013. (*Petitioner for Cancellation* at ¶4). Petitioner makes no allegation that it ever resumed or intended to resume use of the Mark.

B. Petitioner Lacks Valid Grounds for Opposing Registrant's Mark Via Allegations of Fraud.

Petitioner fails to allege any valid grounds for fraud. At the time of filing its registration for the Mark in 2015, the Kentucky entity was already dissolved. Further, Petitioner is simply incorrect that Registrant misrepresented its date of first use of the Mark.

"A petitioner seeking to cancel a trademark based on fraudulent procurement bears a heavy burden of proof. The petitioner must prove with clear and convincing evidence that the applicant knowingly made a false, material representation, with the intent to deceive the PTO. It is not enough that the applicant should have known the statement was misleading." *Beling v. Ennis, Inc.*, 613 F. App'x 924, 925–26 (Fed. Cir. 2015) (internal citations omitted).

Petitioner makes two allegations of fraud in this case. First, that Registrant committed fraud by claiming that "only itself – Super Chef's Breakfast and More LLC – had the right to use the mark SUPER CHEF'S concerning restaurant services" when "Bryson knew that another entity and/or individual had the right to use the Mark." (*Petition for Cancellation* at ¶25). Yet, according to Petitioner's own allegations, the only prior use of the Mark in commerce was that of SuperChef's Breakfast, L.L.C., which was dissolved six years ago in 2013. (*Id.* at ¶4). According to Petitioner, he later became part owner of another similarly named restaurant under a new

Kentucky entity, The SuperChef's Limited Liability Company, in 2015. (*Petition for Cancellation* at ¶38). Therefore, Registrant's statement was not false, let alone fraudulent. At the time when Registrant filed for registration of the Mark in 2015, the previous Kentucky entity had already been dissolved.

Second, Petitioner alleges that Registrant committed fraud by claiming on its application that the "date of first use and first use in commerce of the mark SUPER CHEF'S to be July 15, 2013" and that Registrant "knew that this date was incorrect and that the mark Super Chef's had been used in reference to 'restaurant services' prior to his claimed date of first use." (*Petition for Cancellation* at ¶28). However, Petitioner fundamentally misunderstands the question being asked on the application. "The requirements for an application under section 1(a) of the Act are:*** (ii) The date of the **applicant's** first use of the Mark anywhere on or in connection with the goods or services." (37 CFR § 2.34). The question is not the date of first use by **anyone**. Registrant's Trademark/Service Mark Application specifically states "the mark was first used **by the applicant** or the applicant's related company or licensee predecessor in interest at least as early as 07/15/2013." (*See TEAS Plus Application*, filed March 19, 2015), emphasis added. Therefore, Registrant properly stated the date of **its** first use when it opened a restaurant in Columbus, Ohio.

Thus, the Petition for Cancellation falls far short of making any allegations of fraud by clear and convincing evidence.

C. Petitioner Has No Standing Because He Lacks a Real Interest In the Proceedings and Any Reasonable Basis In Fact to Believe He Would be Damaged by the Mark's Registration.

Petitioner lacks standing to bring this Petition for Cancellation because he has no direct interest in the Mark. Standing “requires only that the party seeking cancellation believe that it is likely to be damaged by the registration.” *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000). “A belief in likely damage can be shown by establishing a direct commercial interest.” *Id.*

In the case at bar, Petitioner has failed to allege that he has any direct commercial interest in the Mark. Petitioner merely alleges to have had one-half ownership in the dissolved Kentucky entity SuperChef’s Breakfast, L.L.C., which has been out of business for approximately six years. (*Petition for Cancellation* at ¶4). Petitioner then alleges that he reopened another restaurant in Kentucky bearing the Mark in 2015 under the newly formed entity, The SuperChefs Limited Liability Company, of which Petitioner was a co-owner. (*Petition for Cancellation* at ¶38). Thus, Petitioner has only managed to allege that two Kentucky entities may have some standing to bring a petition for cancellation. Otherwise, Petitioner has wholly failed to allege any direct commercial interest in the Mark on behalf of himself because he, personally, has not used the Mark in commerce.

III. Conclusion

Petitioner’s Petition for Cancellation fails to allege any prior use in commerce on behalf of Petitioner and fails to state any valid grounds for revocation of the Mark based upon fraud. Further, he lacks any standing to bring this petition at all because he never alleges that he, personally, used the Mark in connection with any goods or services in commerce. For the reasons stated herein, Petitioner’s Petition for Cancellation should be dismissed on all counts.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing has been served upon the following via email this 28th day of October 2019:

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