

ESTTA Tracking number: **ESTTA1076796**

Filing date: **08/21/2020**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Urban Accents Inc.		
Entity	Corporation	Citizenship	Illinois
Address	4043 N. RAVENSWOOD AVE., #208 CHICAGO, IL 60613 UNITED STATES		
Attorney information	MARY F. LOVE MUNCY, GEISSLER, OLDS & LOWE, P.C. 4000 LEGATO ROAD, SUITE 310 FAIRFAX, VA 22033 UNITED STATES Primary Email: maryfran@mg-ip.com Secondary Email(s): hds@mg-ip.com, pbb@mg-ip.com, swr@mg-ip.com 703 621-7140 ext 150		
Docket Number	18082-114		

Registration Subject to Cancellation

Registration No.	3235763	Registration date	05/01/2007
Registrant	WINN-DIXIE STORES, INC. SUITE 200 8928 PROMINENCE PARKWAY JACKSONVILLE, FL 32256 UNITED STATES		

Goods/Services Subject to Cancellation

Class 030. First Use: 2005/02/23 First Use In Commerce: 2005/02/23 Goods and services in the class that are subject to cancellation: Spice blends; Spices
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Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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Attachments	2020-08-21 Pet for Cancellation.pdf(210892 bytes) Exhibit A.pdf(1756802 bytes) Exhibit B.pdf(182620 bytes) Exhibit C.pdf(275056 bytes)
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Signature	/H. David Starr/
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Name	H. David Starr
Date	08/21/2020

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

_____)	
Urban Accents, Inc.,)	
)	
Petitioner,)	
)	
)	Cancellation No.: _____
v.)	Registration No. 3,235,763
)	Mark: FISHERMAN’S WHARF
Winn-Dixie Stores, Inc.,)	
)	
Respondent.)	
_____)	

PETITION FOR CANCELLATION

Urban Accents, Inc. ("Petitioner"), a corporation organized under the laws of the state of Illinois, located at 4043 N. Ravenswood Ave., #208, Chicago, Illinois, 60613, believes that it is or will be damaged by the continued registration of the mark identified above and hereby petitions to cancel the registration, pursuant to Section 14 of the Trademark Act, 15 U.S.C. §1064.

As grounds for this Petition, Petitioner alleges:

Respondent's Registration

1. Upon information and belief, Winn-Dixie Stores, Inc. ("Respondent") is the owner of record of Registration No. 3,235,763 for the mark FISHERMAN’S WHARF ("Respondent’s Mark") for various goods in International Classes 29 and 30, including “spices” and “spice blends”. With respect to International Class 30, the subject registration asserts a first use date of February 23, 2005.

2. Upon information and belief, Respondent is a corporation organized under the laws of the State of Florida, and has an address at 8928 Prominence Parkway, Suite 200, Jacksonville, Florida 32256.

Petitioner's Use and Standing

3. Petitioner has used the name FISHERMAN'S WHARF on spice products on a nationwide basis since 1997 without interruption. In particular, Petitioner uses the mark with a seasoning blend. Petitioner submits herewith as Exhibits A and B its 1999 catalog and a June 1, 2000 screen capture from its website evidencing such use. A current example of use is depicted in the below digital photograph:



4. As a result of this longstanding and uninterrupted use, Petitioner has common law rights in FISHERMAN'S WHARF in connection with spices.

5. As Petitioner's uninterrupted nationwide use of FISHERMAN'S WHARF was well before the October 18, 2006 filing date of the subject registration, Respondent's subject

registration confers no rights of priority with respect to Petitioner's common law rights. 15 U.S.C. §1057. Further, Respondent's asserted first use dates are several years subsequent to Petitioner's first use.

6. On information and belief, Respondent has sent demand letters to Petitioner's online platform and distributors, including Amazon and Publix Super Markets Inc. ("Publix"), asserting rights in the subject registration, improperly alleging infringement by Petitioner and its customers and threatening litigation. A copy of the demand letter sent to Publix on behalf of Respondent is attached herewith as Exhibit C.

7. Petitioner has standing with respect to its Section 14 claim because Respondent is improperly asserting rights to the subject registration to interfere with the business activities of Petitioner.

Respondent's Partial Abandonment of its Mark.

8. Upon information and belief, Respondent is not using Respondent's Mark in U.S. commerce on or in connection with "spices" and "spice blends".

9. Upon information and belief, for at least three years, Respondent has not used Respondent's Mark in U.S. commerce on or in connection with "spices" and "spice blends", and with no intent to resume use.

Damage to Petitioner and Request for Relief

10. Petitioner alleges that it is being damaged by the continued registration of Respondent's Mark, in that Respondent is improperly using its registration to potentially interfere in the business of the Petitioner.

11. Petitioner requests that Respondent's U.S. Registration No. 3,235,763 be cancelled, on the basis that Respondent has abandoned its mark through non-use, and with no

intent to resume use, in connection with “spices” and “spice blends” in the subject registration.

WHEREFORE, Petitioner, Urban Accents, Inc., prays that the Petition for Cancellation be granted, and that Registration No. 3,235,763 be cancelled as to “spices” and “spice blends”.

POWER OF ATTORNEY

Petitioner appoints MARY F. LOVE, and the following attorneys of the law firm of MUNCY, GEISLER, OLDS & LOWE, P.C., as its attorneys with full powers of substitution and revocation, to file and prosecute this cancellation proceeding and to transact all business in the Patent and Trademark Office in connection herewith:

Joe M. Muncy	Roberta S. Bren
Martin R. Geissler	Jeffrey H. Kaufman
Mark E. Olds	Kyoko Imai
Scott L. Lowe	H. David Starr
P. Jay Hines	Pamela Buff Baker

Please send all correspondence to MARY F. LOVE at maryfran@mg-ip.com and for paper communications, if any, to MARY F. LOVE at MUNCY, GEISLER, OLDS & LOWE, P.C., 4000 Legato Road, Suite 310, Fairfax, Virginia 22033.

The required \$400 filing fee for this Cancellation is being paid online through ESTTA.

Respectfully submitted,

Urban Accents, Inc.

By: /H. David Starr/

Mary F. Love

H. David Starr

Muncy, Geissler, Olds & Lowe, P.C.

4000 Legato Road, Suite 310

Fairfax, VA22033

(703) 621-7140 ext. 150

fax (703) 621-7155

email: maryfran@mg-ip.com, hds@mg-ip.com, pbb@mg-ip.com, swr@mg-ip.com

Counsel for Petitioner

Dated: August 21, 2020

EXHIBIT A



Urban Accents Spices are easy to showcase in our modular display racks. Stack up to four of these silver enameled steel racks for a wonderful display. Our racks are designed for the ultimate in flexibility and durability. Each rack holds 36 bottles (six across X six deep) with an approximate dimension of 12" X 12" X 8". Use these on any standard shelf or display case to make a powerful presentation.



URBAN ACCENTS®



t h e a r t o f s p i c e ™

URBAN ACCENTS®

5400 Roosevelt Road, Chicago IL 60644
 Phone: 773.528.9515 Fax: 773.528.9533
 Toll Free: 1.877.UA.SPICE
 E-Mail: www.urban-accents.com

To Order: Phone: 773.528.9515 FAX: 773.528.9533
 Toll Free: 1.887.UA.SPICE
 E-Mail: www.urban-accents.com
 Mail: Urban Accents, Inc
 5400 Roosevelt Road Chicago, Illinois 60644

Payment/Terms: First order prepaid or C.O.D.
 Net 15 days available upon credit approval
 Please request a credit application from Urban Accents
 Allow four weeks for processing
 Visa and Mastercard accepted

Shipping: All orders are shipped F.O.B. Chicago, IL via UPS.
 Shipping charges are added to the order and paid by the customer.

COD Charges: Current UPS rate per order in addition to normal freight charges

Prices: Our price list is at wholesale. Prices are subject to change without notice.

Returns: No returns without prior authorization.
 Report all damaged or shortage claims to delivering carrier within 24 hours.

©1999 Urban Accents, Inc. All Rights Reserved



t h e a r t o f s p i c e ™

At Urban Accents, we have devoted ourselves to finding the freshest and most flavorful herbs, spices and special gourmet blends available. Our products are designed with today's consumer in mind... with a healthy measure of convenience, a dash of originality and a pinch of class. Each bottle of Urban Accents contains a palette of wonderful flavors, delightful aromas and beautiful colors. We cordially invite you to explore, experience and enjoy... The Art Of Spice

THE BASICS

Our basic line of herbs and spices provide your customer with the highest quality staples used in today's kitchens. All of the products in this line have been thoroughly tested and evaluated by Urban Accents personnel and offer what we feel is the best in the marketplace. Taste, aroma, texture and appearance are all considered before we put the *Urban Accents*® label on the bottle.

the art of spice™

Our herb and spice blends offer unique, flavorful and easy to use combinations for both the master chef and novice alike. These products were selected for their ability to provide exciting and sophisticated seasonings in a quick, convenient manner for all who enjoy to cook. All of our blends are mixed and bottled in small batches to insure quality, taste and appearance.

THE BLENDS



Parisian Basil

Coarsely chopped and sifted, our basil is packaged at the peak of freshness. Here you will find the fragrance, taste and color associated with fresh basil with a twist. We've added dried lavender petals from France to compliment the taste and deliver a visual delight.



Garlic Flakes

One of the oldest known spices, garlic has a preeminent place in the history of man. Eaten by Egyptian slaves when building the pyramids and by the Roman Legions during battle, the garlic clove is now an indispensable ingredient in Italian, Chinese, French, Thai and American cuisine.



Shallots

Enhance virtually any dish with the light, sweet and deliciously delicate flavor of shallots. Often described as a subtle cross between onion and garlic. Perfect for seafood, sauces and omelets. Our freeze-dried shallots can also be powdered using fingers for sprinkling on chicken, steak, vegetables and much more.



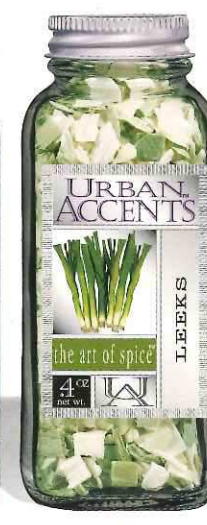
Oregano

This is an invaluable culinary herb. Used in all types of cooking, our oregano is imported from Greece and Turkey. The flavor and fragrance generated by oregano have made this one of the premier flavoring herbs since ancient times.



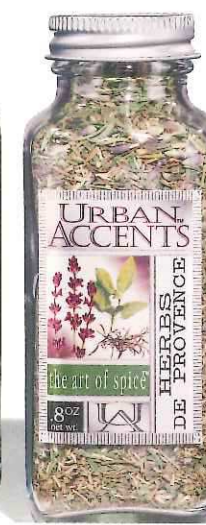
Cilantro

Arguably the most used herb in the world, cilantro is a must in Chinese, Thai, Indian, and Mexican cooking. Our dried version has a lighter taste than the fresh herb but adds wonderful flavor and aroma to all types of salsas, tomato dishes and sauces.



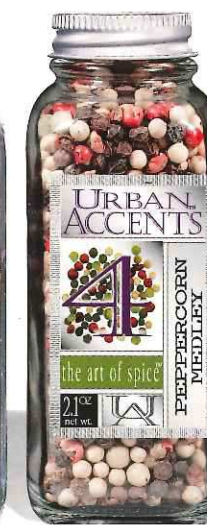
Leeks

While the leek is a close cousin to the onion, its unique flavors and delicate aromas make it indispensable in any well stocked kitchen. With Urban Accents freeze-dried Leeks, you'll always have this delicious and versatile vegetable to add to your recipes.



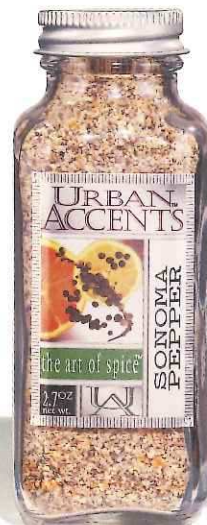
Herbs de Provence

This famous blend from the Provence region of France adds the essence of five herbs to any dish. Aromatic and subtle, our country-style version recalls the traditional cooking of rural France.



4-Peppercorn Medley

A beautiful blend of four different peppercorns, this melange will add a savory zest to your pepper mill. Use this combination of Tellicherry black peppercorns, Muntok white peppercorns, pink peppercorns and green peppercorns in place of plain black pepper for any dish or recipe.



Sonoma Pepper

The West Coast started the major shift to eating more chicken and fish... then created a mix of seasonings to awaken their taste. Inspired by California's sunny citrus groves, this unique recipe combines coarse Tellicherry black pepper, dried garlic and onion flakes with the tart flavor of lemon and orange peel.



Bayou Barbeque

The best barbeque on Bourbon Street boasts a soulful, slightly hot sauce from the seductive backwaters of Louisiana. This spicy blend has its roots in the British West Indies, which calls for a pinch of cayenne pepper that's a flavorful and distinctive addition to pork chops, ribs, chicken, fish and other meat dishes.



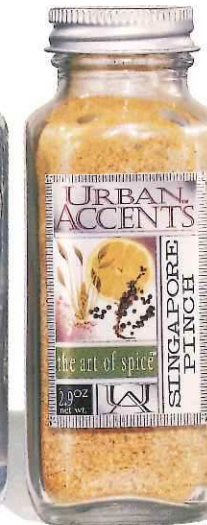
Pride of Prague

This Old World European favorite is as picturesque and pungent as its heritage. Mixing over 30 spices and herbs in a Hungarian paprika base, this most flavorful seasoning enhances the taste of almost anything—baked chicken, fish, pork roast, hamburgers, soups, stews, potatoes and vegetables.



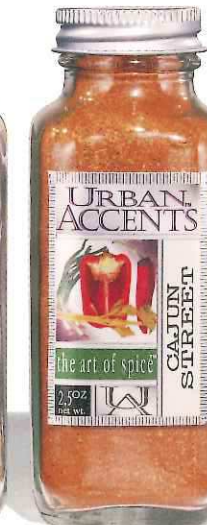
Fisherman's Wharf

Home to some of the finest seafood fare in America inspired this savory blend of herbs and spices. The peppery-lemony base is coarsely ground with flake salt, green onions and parsley. This blend makes home cooking of seafood an adventure in taste. It's also a sensational seasoning for chicken, eggs and vegetables.



Singapore Pinch

For a slightly sweet, exotic Oriental spin on chicken, fish, steak, and vegetables just add a pinch of this tangy blend featuring sweet curry, garlic, onion, lemon peel, and a touch of sugar. Great for stir-fry cooking and a tasty surprise for any dip recipe. Turns ordinary turkey breast into an international delight.



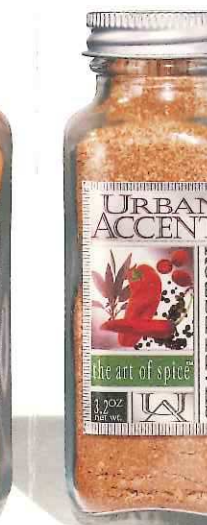
Cajun Street

This seductive blend is named after one of the most popular and dynamic cuisines of recent memory. It captures the heat of the French Quarter and the legacy of the Louisiana bayou. It adds a little fire to a sweet encounter that's always spicy but never too hot.



Curry Row

East meets West in this special curry blend... discovered in London where natives prefer the more conservative interpretation of curry dishes found in the most popular Indian restaurants. This milder blend adds a savory touch of the East to all meats, vegetables, soups and salads.



Charleston Char

From Malibu to Manhattan, this authentic southern style rib rub adds a touch of nutmeg, some freshly ground sage and a little heat from the spicy red pepper to bring out the flavor of any grilled meat dish or roast... plus, it adds the right zip for a hearty barbeque sauce.



Roma

Italian cooking has become almost standard fare in America, but our Old World blend is anything but standard. It unleashes the flavor and aroma of fragrant basil, oregano, marjoram, thyme, rosemary and garlic, reminiscent of the most popular neighborhood trattorias in Rome.



Montego Bite

A coarsely ground version of the Caribbean standard, this blend combines over one dozen zesty herbs and spices... Originally popular as a seasoning for marinating chicken and pork, this version adds a spicy snap when sprinkled over turkey, steaks and ribs.



Thai Garden

This intriguing oriental blend combines the favorite exotic spices used to impart the sweet heat that distinguishes the popular regional cuisine introduced to the West by Bangkok's best chefs. An ideal rub for adding a touch of Thai to any grilled fish, chicken or beef dish. And, the perfect seasoning for authentic Bangkok noodles, vegetables and peanut sauce.



Moroccan Road

This subtly seductive blend of North African spices play a key role in the rich, colorful symphony of Moroccan dishes. Use generously to flavor and enhance your favorite couscous recipes, steamed vegetable salads or Moroccan "tagines"—traditional meat stews. Also serves as a deliciously unique rub for broiled or roasted lamb, chicken, beef, and fish. Bismillah!



Asian Pepper Market

For those who enjoy firing-up their taste buds, this highly versatile and pungent blend of Chinese herbs 'n spices is guaranteed to add the heat that distinguishes most Mongolian, Szechwan and Hunan dishes. Adjust amount used to reach the desired "fire" level in oriental soups, sauces, noodle and vegetable dishes...as well as your favorite meat, poultry or fish stir fry.



Yucatan Grill

Much of the current popularity of nuevo Mexican cuisine has its roots in Yucatan cooking. The intoxicating layers of flavor that come from roasted or grilled meats, fish, poultry and vegetables are a result of a mixture of regional spices, called "recados." Use as a marinade, along with a favorite salsa, wine or lime juice. Also makes a delicious seasoning for soups, stews and sauces.

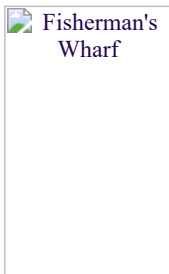
EXHIBIT B



[HOME](#) | [PRODUCTS](#) | [RECIPES](#) | [SPICE SPOT](#) | [GIFT IDEAS](#) | [TO ORDER](#)

[<-- Previous Blend](#)

[Next Blend -->](#)



Fisherman's Wharf

Fisherman's Wharf

Home to some of the finest seafood fare in America, inspired this savory blend of herbs and spices. The peppery-lemony base is coarsely ground with flake salt, green onions and parsley . . . excellent for broiling, baking or sauteing, this blend makes home cooking of seafood an adventure in taste. It's also a sensational seasoning for chicken, eggs and vegetables.

How to use: Put a little butter or margarine and lemon juice over any type of fish and sprinkle a bit of this blend over the top before cooking. Also try rolling new potatoes in some olive oil and this blend before baking them in the oven, skins and all. Sprinkle over any steamed vegetable before serving for a terrific new taste.

Recipes: [Fisherman's Wharf Favorites](#), [Fisherman's Wharf Vegetable Kebabs](#)

Great Recipes of your own?
E-mail us at urban-accents.com

Best recipes chosen monthly for great prizes and discounts!

EXHIBIT C

Jeffrey H. Kamenetsky
jkamenetsky@burr.com
Direct Dial: (954) 414-6208

DATE RECEIVED

AUG 13 2020

PUBLIX LEGAL DEPT.

Las Olas Centre II
350 East Las Olas Boulevard
Suite 1420
Ft. Lauderdale, FL 33301

Main (954) 414-6200
Fax (954) 414-6201

BURR.COM

August 11, 2020

VIA: FEDEX – TRACKING NO. 771232347890

Merriann Metz, Esq.
Vice President, General Counsel and Secretary
Publix Super Markets, Inc.
3300 Publix Corporate Parkway
Lakeland, Florida 33811

Re: Publix' Infringement of Winn-Dixie's Federally Registered FISHERMAN'S WHARF
Trademark

Dear Ms. Metz:

We represent Winn-Dixie Stores, Inc. ("Winn-Dixie") with respect to its intellectual property matters and we have been asked to contact you. Winn-Dixie is the owner of U.S. Trademark Registration No. 3235763 for the mark FISHERMAN'S WHARF (see, attached, Exhibit 1) and all of the common law rights and goodwill associated therewith ("FISHERMAN WHARF trademark"). The 3235763 registration is associated with, among other goods, "spice blends" and "spices." Our client's mark has been in continuous use since at least February, 2005, and has attained incontestability status.

Winn-Dixie is also the owner of U.S. Trademark Registration No. 1312772 for FISHERMAN'S WHARF for retail store services-namely, a seafood department in a grocery store. This mark has been used continuously since January 1984 and has also attained incontestability status.

It has come to our client's attention that Publix is currently selling seafood seasoning by Urban Accents, Inc. ("Urban Accents") under the name "Fisherman's Wharf." The following link shows the product on Urban Accents' web page:

<https://www.urbanaccents.com/product/fishermans-wharf/> (see, attached, Exhibit 2). This product was on the shelves at the Nocatee Greenwise store on July 23, 2020.

Merriann Metz, Esq.
Publix Super Markets, Inc.
August 11, 2020
Page 2

The offering for sale of Urban Accents' Fisherman's Wharf seafood seasoning appears to be made with the intent to trade on the goodwill associated with Winn-Dixie's FISHERMAN WHARF trademark. Such use creates the false impression that Publix' products originate or are somehow associated with Winn-Dixie's goods, so as to deceive customers or to cause confusion or mistake as to the origin or affiliation of Publix' and Winn-Dixie's goods.

Your company does not have the authority to sell products identified by Winn-Dixie's FISHERMAN'S WHARF trademark, and by doing so is clearly acting with a bad faith intent to profit from Winn-Dixie's trademark. Sales, by Publix, of Urban Accents' Fisherman's Wharf seafood seasoning subjects Publix to liability for willful trademark infringement, false designation of origin, and trademark dilution, in violation of the Lanham Trademark Act, 15 U.S.C. § 1051 *et seq.* Publix' actions may also give rise to separate claims under state unfair competition and dilution laws. The civil remedies available for these violations include immediate and permanent injunctive relief, recovery of Publix' profits, and up to three times the amount of monetary damages suffered by our client, as well as an award of attorney's fees.

Winn-Dixie demands that Publix immediately cease such infringing activity, desist from such infringing activity in the future, and comply with Winn-Dixie's other requirements set forth in this letter.

Winn-Dixie consistently enforces its trademark rights against infringers through all appropriate legal means. However, under the circumstances, Winn-Dixie is prepared to try to resolve this matter amicably provided that Publix cooperates fully with Winn-Dixie and establishes to Winn-Dixie's satisfaction that this was a one-time error of judgment on Publix' part and not a systematic effort to profit from or devalue Winn-Dixie's intellectual property.

Winn-Dixie therefore demands that Publix immediately:

1. Cease and desist from selling Urban Accents' Fisherman's Wharf seafood seasoning or any other products that include designations likely to cause confusion with Winn-Dixie's FISHERMAN'S WHARF trademark;
2. Destroy any materials in its possession or control bearing any designation likely to cause confusion with or dilution of Winn-Dixie's FISHERMAN'S WHARF trademark; and
3. Provide Winn-Dixie with sufficient information to determine the full amount of Publix' gross revenues and profits derived from its use of Winn-Dixie's FISHERMAN'S WHARF trademark.

Merriann Metz, Esq.
Publix Super Markets, Inc.
August 11, 2020
Page 3

Winn-Dixie further demands that Publix provides, by no later than the close of business on **August 18, 2020**, written confirmation that Publix will comply with these demands. Publix is specifically advised that any failure or delay in complying with these demands will likely compound the damages for which Publix may be liable. If Winn-Dixie does not receive a satisfactory and timely response by the above deadline, Winn-Dixie is prepared to take all steps necessary to protect Winn-Dixie's valuable intellectual property rights, without further notice to Publix.

The above is not an exhaustive statement of all the relevant facts and law. Winn-Dixie expressly reserves all of its legal and equitable rights and remedies, including the right to seek injunctive relief and recover monetary damages.

Sincerely,

Jeffrey H. Kamenetsky

Jeffrey H. Kamenetsky

JHK/mc

Enclosures

cc: Winn-Dixie Stores, Inc.

EXHIBIT 1

Int. Cls.: 29 and 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 3,235,763

Registered May 1, 2007

**TRADEMARK
PRINCIPAL REGISTER**

FISHERMAN'S WHARF

WINN-DIXIE STORES, INC. (FLORIDA CORPORATION)
LEGAL DEPT
5050 EDGEWOOD COURT
JACKSONVILLE, FL 32254

FOR: SHELL FISH, NOT LIVE SHRIMP, PRAWNS,
AND LOBSTERS, IN CLASS 29 (U.S. CL. 46).

FIRST USE 5-2-2005; IN COMMERCE 5-2-2005.

FOR: HORSERADISH; SAUCES; SPICE BLENDS;
SPICES; TARTAR SAUCE, IN CLASS 30 (U.S. CL. 46).

FIRST USE 2-23-2005; IN COMMERCE 2-23-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 1,312,772.

SER. NO. 77-024,220, FILED 10-18-2006.

MARGARET POWER, EXAMINING ATTORNEY

EXHIBIT 2



Urban Accents Fisherman's Wharf Seasoning

