

ESTTA Tracking number: **ESTTA1092623**

Filing date: **11/02/2020**

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

Proceeding	92075086
Party	Plaintiff Black Rifle Coffee Company LLC
Correspondence Address	SCOTT W JOHNSTON MERCHANT & GOULD PC 150 SOUTH FIFTH STREET, SUITE 2200 PO BOX 2910 MINNEAPOLIS, MN 55402 UNITED STATES Primary Email: dockmpls@merchantgould.com Secondary Email(s): sjohnston@merchantgould.com, ljones@merchantgould.com, slindemeier@merchantgould.com 612-332-5300
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Scott W. Johnston
Filer's email	sjohnston@merchantgould.com, ljones@merchantgould.com, slindemeier@merchantgould.com
Signature	/SWJ/
Date	11/02/2020
Attachments	2020 11 02 Amended Petition for Cancellation 92075086 ORCA.PDF(699835 bytes )

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

Black Rifle Coffee Company LLC,	)	
	)	Cancellation No. 92075086
Petitioner,	)	
	)	Mark: <b>ORCA</b>
v.	)	
	)	Registration No. 5,101,888
Giancarlo Fantappié,	)	
	)	Registration Date: December 13, 2016
Registrant.	)	
	)	

**AMENDED PETITION FOR CANCELLATION**

1. Black Rifle Coffee Company LLC (hereinafter “Petitioner”), a limited liability company organized under the laws of Utah, located at 1144 South 500 West, Salt Lake City, Utah 84101, believes that it is and will continue to be damaged by the existence of U.S. Registration No. 5,101,888 for the mark ORCA, owned by Giancarlo Fantappié (hereinafter “Registrant”), an individual believed to have an address at 1605 Lockness Place, Torrance, California 90501, and hereby petitions to cancel the registration. The grounds for cancellation are as follows:

2. On December 13, 2016, U.S. Registration No. 5,101,888 for the mark ORCA (the “Registered Mark”) issued to Registrant for use in connection with “coffee pods, tea pods, tea based pods containing milk,” in International Class 30 (the “Registered Goods”). Mr. Fantappié filed a trademark application for the ORCA mark on January 8, 2016, and filed a Statement of Use in support of the application on September 26, 2016, asserting that the mark was in use in commerce on all of the goods listed as of December 15, 2015.

3. Upon information and belief, U.S. Registration No. 5,101,888 was assigned from Giancarlo Fantappié to Drinkstation, Inc. on or about March 23, 2020, and was assigned from Drinkstation, Inc. to Giancarlo Fantappié on August 14, 2020.

4. Petitioner is the owner of U.S. Application Serial No. 88/638,724 for the mark ATOMIC ORCA for use in connection with “drinkware and beverageware,” in International Class 21, “apparel, namely, shirts, shorts, and hats,” in International Class 25, and “coffee and coffee-based beverages,” in International Class 30. The ATOMIC ORCA application was filed on October 2, 2019 based on Petitioner’s intent to use the applied-for mark in U.S. commerce. A current printout of information from the electronic database records of the USPTO showing the current status of U.S. Application No. 88/638,724 is attached hereto as Exhibit A.

5. On November 19, 2019, and again on June 12, 2020, Petitioner’s U.S. Application Serial No. 88/638,724 for the goods in Class 30 was denied registration by the USPTO on the grounds that the applied-for mark may be likely to cause confusion with the Registered Mark.

6. Petitioner began an investigation into whether Registrant was currently using, or had ever used, the Registered Mark in interstate commerce in connection with the Registered Goods.

#### **EXPRESS ABANDONMENT**

7. Upon information and belief, Registrant expressly abandoned the Registered Mark. Petitioner conducted an independent investigation and failed to identify current use of the Registered Mark in connection with the Registered Goods on the Internet or elsewhere.

8. Upon information and belief, Registrant is not currently providing the Registered Goods in U.S. commerce under the Registered Mark.

9. According to Registrant's Facebook page, Registrant's business is "permanently closed." See Exhibit B. By telling the public that ORCA Coffee is permanently closed, Registrant expressly abandoned the ORCA mark.

10. Registrant referred to a website located at <https://orca.coffee> on its Facebook page. See Exhibit B. However, there is no active website at that URL. See Exhibit C.

11. Upon information and belief, Registrant has not provided any of Registrant's Goods in U.S. commerce under the Registered Mark for an extended period of time. This supports the conclusion that Registrant has no intent to resume use of the mark in connection with the Registered Goods and expressly abandoned the mark.

12. Therefore, based on the above allegations, upon information and belief, Registrant has legally abandoned the Registered Mark pursuant to 15 U.S.C. § 1127.

13. Petitioner is being damaged by U.S. Registration No. 5,101,888 in that it reasonably believes that the Registration is invalid and may wrongfully prevent the registration of Petitioner's U.S. Application Serial No. 88/638,724.

#### **ABANDONMENT BASED ON NON-USE**

14. In addition, Registrant has abandoned the Registered Mark due to non-use. The Registered Mark was registered on January 8, 2016 for use in connection with the Registered Goods, and the Statement of Use filed in support of the application for the Registered Mark asserted the Registered Mark was in use in commerce on all of the Registered Goods as of December 15, 2015.

15. Upon information and belief, Registrant is not currently providing "tea pods" or "tea based pods containing milk" under the Registered Mark in U.S. commerce, and has never sold these goods under the Registered Mark in U.S. commerce.

16. In its motion to dismiss, Registrant has provided no evidence that it has ever used the Registered Mark in connection with the “tea pods” or “tea based pods containing milk.” *See* 2 TTABVUE, D Mot to Dismiss: FRCP 12(B).

17. Upon information and belief, more than three years of non-use of the Registered Mark in connection with “tea pods” and “tea based pods containing milk” have elapsed since the date the mark was registered and the date the Statement of Use alleges Registrant’s Goods were first used in commerce in connection with the Registered Mark. As a result, there is a presumption that Registrant has no intent to resume use on such goods and therefore has abandoned the mark as to such goods.

18. Upon information and belief, Registrant’s business is permanently closed and Registrant has no intent to resume use of its mark in connection with and of the Registered Goods, including, specifically, the “tea pods” and “tea based pods containing milk” claimed in the Registration. *See, e.g.*, Exhibits B and C.

19. Upon information and belief, Registrant has legally abandoned the Registered Mark pursuant to 15 U.S.C. § 1127.

20. Petitioner is being damaged by U.S. Registration No. 5,101,888 in that it reasonably believes that the Registration is invalid and may wrongfully prevent the registration of Petitioner’s U.S. Application Serial No. 88/638,724 in Class 30.

#### **FRAUD**

21. Paragraphs 1-20 are incorporated as if fully set forth herein.

22. Upon information and belief, Registrant was not using the Registered Mark in U.S. commerce in connection with at least “tea pods” and “tea based pods containing milk” as

required by 15 U.S.C. § 1051 when Registrant filed the Statement of Use on September 26, 2016.

23. Upon information and belief, Registrant's Statement of Use was false and/or fraudulent because, at the time of submission, the Registered Mark was not in use in the United States in connection with at least "tea pods" and "tea based pods containing milk."

24. Upon information and belief, at the time Registrant submitted the Statement of Use, Registrant knew that it did not sell "tea pods" and "tea based pods containing milk" in connection with the Registered Mark and that its statement to the contrary to the USPTO was false.

25. Upon information and belief, Registrant submitted the Statement of Use with specific willful intent to deceive the USPTO for purposes of gaining registration of the Registered Mark.

26. Petitioner's belief as to Registrant's intent surrounding its submitted Statement of Use is based on a reasonable investigation into Registrant's business and offerings and its review of all information publicly available, including the information provided by Registrant in its motion to dismiss. No information available to Petitioner shows or otherwise suggests that Registrant has ever offered "tea pods" or "tea based pods containing milk" in connection with the Registered Mark.

27. The application upon which the Registered Mark was based ultimately issued on December 13, 2016. In issuing the resulting registration for the Registered Mark, the USPTO relied on Registrant's false and fraudulent declaration in the Statement of Use that Registrant was using the Registered Mark in connection with all of the Registered Goods.

28. But for Registrant's false and fraudulent declaration in the Statement of Use that Registrant was using the Registered Mark in connection with all of the Registered Goods, the USPTO would not have granted registration of the Registered Mark.

29. Upon information and belief, Registrant has fraudulently obtained registration of the Registered Mark pursuant to 15 U.S.C. § 1119.

30. Registration of the mark shown in U.S. Registration No. 5,101,888 damages and will continue to damage Petitioner because the Registration has been fraudulently obtained and may wrongfully prevent the registration of Petitioner's U.S. Application Serial No. 88/638,724.

WHEREFORE, Petitioner requests that its Petition for Cancellation be granted and that U.S. Registration No. 5,101,888 be cancelled.

**Please direct all correspondence to:**

**Scott W. Johnston**  
**MERCHANT & GOULD P.C.**  
**150 South Fifth Street, Suite 2200**  
**P.O. Box 2910**  
**Minneapolis, MN 55402**  
[sjohnston@merchantgould.com](mailto:sjohnston@merchantgould.com)  
[ljones@merchantgould.com](mailto:ljones@merchantgould.com)  
[slindemeier@merchantgould.com](mailto:slindemeier@merchantgould.com)  
[dockmpls@merchantgould.com](mailto:dockmpls@merchantgould.com)

Petitioner herein appoints Gregory C. Golla; Andrew S. Ehard; Scott W. Johnston; Lindsay M.R. Jones; Danielle I. Mattessich; Christopher J. Schulte; William D. Schultz; and all

other attorneys of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

BLACK RIFLE COFFEE COMPANY LLC

By its Attorneys,

Date: November 2, 2020

s/Scott W. Johnston

Scott W. Johnston

Lindsay M.R. Jones

MERCHANT & GOULD P.C.

150 South Fifth Street, Suite 2200

Minneapolis, Minnesota 55402

(612) 332-5300



**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing AMENDED PETITION FOR CANCELLATION was served upon the following attorney of record for Registrant by email this 2nd day of November, 2020:

Eric L. Tanezaki  
Stetina Brunda Garred & Brucker  
75 Enterprise, Suite 250  
Aliso Viejo, CA 92656

[etanezaki@stetinalaw.com](mailto:etanezaki@stetinalaw.com)  
[gdelgadillo@stetinalaw.com](mailto:gdelgadillo@stetinalaw.com)  
[rlau@stetinalaw.com](mailto:rlau@stetinalaw.com)

s/Scott W. Johnston  
\_\_\_\_\_  
Scott W. Johnston

# **EXHIBIT A**

Generated on: This page was generated by TSDR on 2020-08-18 12:54:43 EDT

Mark: ATOMIC ORCA

ATOMIC ORCA

US Serial Number: 88638724

Application Filing Date: Oct. 02, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

**Status:** A final Office action refusing registration has been sent (issued) because the applicant neither satisfied nor overcame all requirements and/or refusals previously raised. The applicant may respond by filing (1) a request for reconsideration; and/or (2) an appeal to the Trademark Trial and Appeal Board. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

**Status Date:** Jun. 12, 2020

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## Mark Information

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**Mark Literal Elements:** ATOMIC ORCA

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

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## Goods and Services

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**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Coffee and coffee-based beverages

**International Class(es):** 030 - Primary Class

**U.S Class(es):** 046

**Class Status:** ACTIVE

**Basis:** 1(b)

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**For:** Apparel, namely, shirts, shorts, and hats

**International Class(es):** 025 - Primary Class

**U.S Class(es):** 022, 039

**Class Status:** ACTIVE

**Basis:** 1(b)

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**For:** Drinkware and beverageware

**International Class(es):** 021 - Primary Class

**U.S Class(es):** 002, 013, 023, 029, 030, 033, 040, 050

**Class Status:** ACTIVE

**Basis:** 1(b)

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## Basis Information (Case Level)

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**Filed Use:** No  
**Filed ITU:** Yes  
**Filed 44D:** No  
**Filed 44E:** No  
**Filed 66A:** No  
**Filed No Basis:** No

**Currently Use:** No  
**Currently ITU:** Yes  
**Currently 44E:** No  
**Currently 66A:** No  
**Currently No Basis:** No

## Current Owner(s) Information

**Owner Name:** Black Rifle Coffee Company LLC  
**Owner Address:** 1144 S 500 W  
Salt Lake City, UTAH UNITED STATES 84101  
**Legal Entity Type:** LIMITED LIABILITY COMPANY  
**State or Country Where Organized:** UTAH

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Andrew S. Ehard  
**Attorney Primary Email Address:** [dockmpls@merchantgould.com](mailto:dockmpls@merchantgould.com)  
**Docket Number:** 18523.19US01  
**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Andrew S. Ehard  
MERCHANT & GOULD P.C.  
P.O. BOX 2910  
MINNEAPOLIS, MINNESOTA UNITED STATES 55402-0910  
**Phone:** 612-332-5300  
**Fax:** 612-332-9081  
**Correspondent e-mail:** [dockmpls@merchantgould.com](mailto:dockmpls@merchantgould.com) [aehard@merchantgould.com](mailto:aehard@merchantgould.com) [cmanthie@merchantgould.com](mailto:cmanthie@merchantgould.com) [ljones@merchantgould.com](mailto:ljones@merchantgould.com)  
**Correspondent e-mail Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Jun. 12, 2020	NOTIFICATION OF FINAL REFUSAL EMAILED	
Jun. 12, 2020	FINAL REFUSAL E-MAILED	
Jun. 12, 2020	FINAL REFUSAL WRITTEN	69197
May 26, 2020	TEAS/EMAIL CORRESPONDENCE ENTERED	68552
May 26, 2020	CORRESPONDENCE RECEIVED IN LAW OFFICE	68552
May 22, 2020	ASSIGNED TO LIE	68552
May 18, 2020	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Nov. 19, 2019	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Nov. 19, 2019	NON-FINAL ACTION E-MAILED	6325
Nov. 19, 2019	NON-FINAL ACTION WRITTEN	69197
Nov. 12, 2019	ASSIGNED TO EXAMINER	69197
Oct. 05, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 05, 2019	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information

**TM Attorney:** BLOHM, LINDA E  
**Law Office Assigned:** LAW OFFICE 110

### File Location

**Current Location:** TMO LAW OFFICE 110 - EXAMINING ATTORNEY ASSIGNED  
**Date in Location:** Jun. 12, 2020

# Assignment Abstract Of Title Information

## Summary

Total Assignments: 1

Applicant: Black Rifle Coffee Company LLC

## Assignment 1 of 1

Conveyance: SECURITY INTEREST

Reel/Frame: [6854/0800](#)

Pages: 20

Date Recorded: Feb. 03, 2020

Supporting Documents: [assignment-tm-6854-0800.pdf](#)

## Assignor

Name: [BLACK RIFLE COFFEE COMPANY LLC](#)

Execution Date: Jan. 31, 2020

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

## Assignee

Name: [LAGO INNOVATION FUND, LLC](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: DELAWARE

Address: 500 W MADISON STREET  
SUITE 1000  
CHICAGO, ILLINOIS 60661

## Correspondent

Correspondent Name: STEWART WALSH

Correspondent Address: 1025 VERMONT AVE NW, STE 1130  
COGENCY GLOBAL INC.  
WASHINGTON, DC 20005

Domestic Representative - Not Found

# **EXHIBIT B**

USPTO TTABVue, Trademark Trial & Appeal Board | Trademark Status & Document Review | ORCA Coffee | Facebook

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The ORCA Coffee Club, authentic Italian coffee and espresso delivered to your door.

The ORCA Coffee Club provides an all encompassing coffee subscription service for coffee and espresso drinkers everywhere. As a member of the ORCA Coffee Club, you'll receive a box of coffee and espresso delivered to your door every month. See More

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(310) 413-4902

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**ORCA Coffee**  
March 19, 2019 ·

Visit An Italian Café Without Getting Out Of Bed. Try Out ORCA For 100 Days And Never Look Back.

Photos See All



# **EXHIBIT C**



Only one step left!  
To finish setting up your new web address, go to [your domain settings](#), click "Connect existing domain", and enter: orca.coffee