

ESTTA Tracking number: **ESTTA1135683**

Filing date: **05/21/2021**

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	Tastemade, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	3019 OLYMPIC BLVD., STAGE C SANTA MONICA, CA 90404 UNITED STATES		
Attorney information	MARTIN R. GREENSTEIN TECHMARK A LAW CORPORATION 4820 HARWOOD ROAD, SUITE 110 SAN JOSE, CA 95124 UNITED STATES Primary Email: PTOMail@TechMark.com Secondary Email(s): MRG@TechMark.com, AMR@TechMark.com 408-266-4700		
Docket Number	TSTMKR		

Registration Subject to Cancellation

Registration No.	5561753	Registration date	09/11/2018
Registrant	International Merchandising Company, LLC 1360 EAST 9TH STREET, SUITE 100 CLEVELAND, OH 44114 UNITED STATES		


Goods/Services Subject to Cancellation

<p>Class 035. First Use: 2017/08/16 First Use In Commerce: 2017/08/16 All goods and services in the class are subject to cancellation, namely: Promotional advertising of products and services of others through sponsoring arrangements and license agreements relating to food, celebrity chefs, and restaurants for charitable purposes</p>
<p>Class 041. First Use: 2017/08/16 First Use In Commerce: 2017/08/16 All goods and services in the class are subject to cancellation, namely: On-line journals, namely, blogs, featuring information about celebrity chefs and restaurants, and food festivals, and food topics; providing a website featuring blogs and non-downloadable publications in the nature of newsletters featuring information about celebrity chefs and restaurants, and food festivals, and food topics; organizing and conducting food festivals featuring a variety of activities for entertainment purposes; entertainment services, namely, food tastings; entertainment services, namely, hosting parties featuring food tastings</p>

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	90128011	Application Date	08/20/2020
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TASTEMAKERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 2013/04/23 First Use In Commerce: 2013/04/23 Educational services, namely, providing online instruction in the field of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle; Entertainment services, namely, providing ongoing webisodes featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle via a global computer network; Entertainment services, namely, an ongoing multimedia program featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle distributed via various platforms across multiple forms of transmission media; Entertainment services, namely, an ongoing series featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle provided through the internet and wireless communication networks; Entertainment services, namely, the provision of continuing television, internet TV, online video programming segments and an ongoing web series featuring information in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle delivered by television, the internet and wireless communication networks; Providing entertainment services in the nature of ongoing Internet Protocol Television (IPTV) television programming segments in the field of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle</p>		
U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	TASTEMAKERS		
Goods/Services	Various goods and services, including in connection with the creation, promotion, distribution and sharing of entertainment and educational		

	content delivered across multiple platforms, live and virtual events planning and hosting, promotional services and related goods and services
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Attachments	90128011#TMSN.png(bytes) Final - Tastemade v. Int Merch Co - TASTEMAKER - Pet to Cancel.pdf(382303 bytes)
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Signature	/Angelique M. Riordan/
Name	Angelique M. Riordan
Date	05/21/2021

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Petition to Cancel is being filed with the TTAB via ESTTA on the date set forth below, and the \$600 per class per mark statutory filing fee paid.

Date: May 21, 2021

/Angelique M. Riordan/
Angelique M. Riordan

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

IN THE MATTER OF **Registration No. 5,561,753** for the trademark **TASTEMAKER** (Classes 35 and 41), registered on September 11, 2018.

<p>TASTEMADE, INC.,</p> <p>Petitioner,</p> <p>v.</p> <p>INTERNATIONAL MERCHANDISING COMPANY, LLC,</p> <p>Registrant.</p>

Cancellation No.:

Trademark: TASTEMAKER

Reg. No.: 5,561,753

PETITION FOR CANCELLATION

TASTEMADE, INC., a corporation organized and existing under the laws of Delaware, with its principal place of business at 3019 Olympic Blvd., Stage C, Santa Monica, CA 90404 (hereafter “**Tastemade**”) believes it is or will be damaged by the continued registration on the Principal Register of the mark TASTEMAKER, shown in Reg. No. 5,561,753 (hereafter Registrant’s “**TASTEMAKER Mark**”), and hereby opposes the same.

As grounds for this cancellation, it is alleged that:

1. Tastemade is a modern media company that creates, and has for many years created, award-winning video content and original programming, as well as virtual and in-person events, across a wide variety of categories, available on a number of platforms, and has developed and maintained an impressive global community and social network related thereto.
2. Tastemade is the owner of the trademark TASTEMAKERS, having used said mark continuously in interstate commerce on and in connection with its entertainment and educational content, and related goods and services related or complementary thereto, since long prior to Registrant’s

August 16, 2017 claimed date of first use in U.S. commerce and the December 15, 2016 filing date of Registrant's Reg. No. 5,561,753 for the TASTEMAKER Mark.

3. Tastemade is the owner of the valid and subsisting U.S. Trademark Appln. No. 90/128,011 for the mark TASTEMAKERS, which claims a first use in U.S. commerce date at least as early as April 23, 2013 and covers:

Educational services, namely, providing online instruction in the field of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle; Entertainment services, namely, providing ongoing webisodes featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle via a global computer network; Entertainment services, namely, an ongoing multimedia program featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle distributed via various platforms across multiple forms of transmission media; Entertainment services, namely, an ongoing series featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle provided through the internet and wireless communication networks; Entertainment services, namely, the provision of continuing television, internet TV, online video programming segments and an ongoing web series featuring information in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle delivered by television, the internet and wireless communication networks; Providing entertainment services in the nature of ongoing Internet Protocol Television (IPTV) television programming segments in the field of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle, in Int'l Class 41.

A copy of the TSDR record for this application, showing current status and title, is attached hereto as Exhibit A.

4. Tastemade is also the owner of various common law rights in the trademark TASTEMAKERS for various goods and services, including in connection with the creation, promotion, distribution and sharing of entertainment and educational content delivered across multiple platforms, live and virtual events planning and hosting, promotional services and related goods and services. These common law rights, together with Appln. No. 90/128,011 set forth above, are collectively referred to herein as Tastemade's "**TASTEMAKERS Mark.**"
5. Tastemade's TASTEMAKERS Mark is and has become a valuable asset of Tastemade, directly contributing to Opposer's identity and persona and identifying its entertainment and educational content and growing global community and social network, as well as its various other products

and services related or complementary thereto, and distinguish Tastemade's products and services from the products and services of others.

6. Tastemade's TASTEMAKERS Mark, as described herein, has been extensively advertised, offered and/or promoted in the United States and throughout the world.
7. Tastemade has studios across the world with over 300 million active viewers and over 2.5 billion monthly views in over 200 countries. As a result of the success and public recognition of Tastemade's constantly growing popularity, following and viewership, and as a result of the extensive promotion and presence of the TASTEMAKERS Mark and related products and services in the United States and throughout the world, the TASTEMAKERS Mark, alone and in connection with Tastemade's house mark, has become famous, and is recognized as such in the United States and elsewhere. This extensive promotion and online presence of the TASTEMAKERS Mark on entertainment and educational content and related goods and services in the United States and through the world has also directly contributed to Tastemade's brand and persona.
8. Tastemade's over 300 million active viewers across the world rely on Tastemade's name and on its TASTEMAKERS Mark to identify and seek out Tastemade's specific award-winning entertainment and educational content. Consumers view Tastemade's TASTEMAKERS Mark as an identifier for Tastemade's trusted content – Tastemade has gained this trust by providing consistently outstanding entertainment content that meets its high standards.
9. Tastemade's award winning content is available through major streaming and cable platforms 24 hours a day, seven days per week. Tastemade also offers its content through its own Tastemade TV video-on-demand subscription service and on its website. Tastemade also regularly offers both virtual and in-person events on a worldwide basis.
10. Tastemade enjoys an extensive and impressive social media following with nearly 32 million followers on Facebook, 10.3 million followers on Snapchat, 7.4 million followers on Instagram, 7

million followers on Pinterest, 1.6 million subscribers on YouTube, 1.2 million followers on TikTok (with 24.1 million likes) and nearly 330,000 followers on Twitter.

11. The huge popularity of Tastemade's TASTEMAKERS Mark and entertainment and educational content has prompted large, well-known brands and widely-recognized industry professionals to partner with Tastemade to further build on Tastemade's entertainment, educational and related content and even further expand recognition of the already widely recognized TASTEMAKERS mark.

12. Registrant, International Merchandising Company, LLC ("**Registrant**"), a limited liability company organized under the laws of Ohio with an address of 1360 East 9th Street, Suite 100, Cleveland, Ohio 44114, obtained Reg. No. 5,561,753 on September 11, 2018 in connection with:

"Promotional advertising of products and services of others through sponsoring arrangements and license agreements relating to food, celebrity chefs, and restaurants for charitable purposes," in Class 35.

"On-line journals, namely, blogs, featuring information about celebrity chefs and restaurants, and food festivals, and food topics; providing a website featuring blogs and non-downloadable publications in the nature of newsletters featuring information about celebrity chefs and restaurants, and food festivals, and food topics; organizing and conducting food festivals featuring a variety of activities for entertainment purposes; entertainment services, namely, food tastings; entertainment services, namely, hosting parties featuring food tastings," in Class 41.

13. During prosecution of Appln. No. 90/128,011, Registrant's TASTEMAKER Mark was cited against Tastemade's TASTEMAKERS Mark.

Claim 1: Priority and Likelihood of Confusion Under §2(d) of the Trademark Act

14. Tastemade repeats and realleges each and every allegation contained in paragraphs 1-13, inclusive, as if fully recited in this paragraph.

15. Registrant's TASTEMAKER Mark so resembles Tastemade's TASTEMAKERS Mark as to be likely, when applied to the services of Registrant's Reg. No. 5,561,753, to cause confusion, mistake or deception among purchasers, users and the public, thereby damaging Tastemade.

16. The Class 35 and 41 services in connection with which Registrant claims to have use in conjunction with its TASTEMAKER Mark include and are closely related to, used for the same or similar purposes, and/or are or will be advertised and promoted to and directed at the same

trade channels, the same purchasers and are or will be used in the same environment as Tastemade's services and related goods.

17. Simultaneous use of Registrant's TASTEMAKER Mark on the Class 35 and 41 services set forth in Reg. No. 5,561,753 and Tastemade's TASTEMAKERS Mark on its services and related goods as set forth above is likely to cause confusion, mistake or deception among purchasers, users and the public, thereby damaging Tastemade.
18. Use by Registrant of its TASTEMAKER Mark on the Class 35 and 41 services set forth in Reg. No. 5,561,753 is likely to lead to the mistaken belief that Registrant's services are sponsored by, affiliated with, approved by or otherwise emanate from Tastemade, thereby damaging Tastemade.
19. As set forth in Paragraphs 14-18 above, Registrant's TASTEMAKER Mark is likely caused confusion with Tastemade's prior TASTEMAKERS Mark, in violation of §2(d) of the Trademark Act.

Wherefore, Tastemade requests that this cancellation be sustained and that Reg. No. 5,561,753 be cancelled, accordingly.

TASTEMADE, INC.
By: /Martin R. Greenstein/
Martin R. Greenstein
Angelique M. Riordan
TechMark a Law Corporation
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San Jose, CA 95124
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Attorney for Opposer Tastemade, Inc.

Dated: May 21, 2021

Exhibit A

Generated on: This page was generated by TSDR on 2021-05-21 20:20:23 EDT

Mark: TASTEMAKERS

TASTEMAKERS

US Serial Number: 90128011

Application Filing Date: Aug. 20, 2020

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

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 non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Dec. 16, 2020

Mark Information

Mark Literal Elements: TASTEMAKERS

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

Related Properties Information

Claimed Ownership of US Registrations: 4437209, 4859167, 5340414 and others

Goods and Services

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: Educational services, namely, providing online instruction in the field of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle; Entertainment services, namely, providing ongoing webisodes featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle via a global computer network; Entertainment services, namely, an ongoing multimedia program featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle distributed via various platforms across multiple forms of transmission media; Entertainment services, namely, an ongoing series featuring content in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle provided through the internet and wireless communication networks; Entertainment services, namely, the provision of continuing television, internet TV, online video programming segments and an ongoing web series featuring information in the fields of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle delivered by television, the internet and wireless communication networks; Providing entertainment services in the nature of ongoing Internet Protocol Television (IPTV) television programming segments in the field of food and beverage, food preparation, food presentation, arts and crafts, style, budgeting, travel, design and decoration, do it yourself and how-to, shopping and lifestyle

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 23, 2013

Use in Commerce: Apr. 23, 2013

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Tastemade, Inc.

Owner Address: 3019 Olympic Boulevard, Stage C
Santa Monica, CALIFORNIA UNITED STATES 90404

Legal Entity Type: CORPORATION

State or Country DELAWARE
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Martin R. Greenstein

Docket Number: TASTEMAKERS

Attorney Primary PTOMail@TechMark.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent MARTIN R. GREENSTEIN
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Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 16, 2020	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 16, 2020	NON-FINAL ACTION E-MAILED	6325
Dec. 16, 2020	NON-FINAL ACTION WRITTEN	95368
Dec. 16, 2020	ASSIGNED TO EXAMINER	95368
Sep. 24, 2020	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Aug. 24, 2020	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: STURMAN, JOSHUA M

Law Office LAW OFFICE 103
Assigned:

File Location

Current Location: TMEG LAW OFFICE 103 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Dec. 16, 2020