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Filing date: **05/18/2021**

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

Proceeding	92068766
Party	Plaintiff Astor Chocolate Corp.
Correspondence Address	J MARK LANE LANE CROWELL LLP 707 WESTCHESTER AVENUE SUITE 411 WHITE PLAINS, NY 10604 UNITED STATES Primary Email: jmarklane@gmail.com Secondary Email(s): jmlane@lanecrowell.com, eshalyutin@lanecrowell.com 914-761-0001
Submission	Response to Board Order/Inquiry
Filer's Name	J. Mark Lane
Filer's email	jmlane@lanecrowell.com, jmarklane@gmail.com
Signature	/J. Mark Lane/
Date	05/18/2021
Attachments	Declaration of J. Mark Lane.pdf(172928 bytes) Exh A.pdf(6118548 bytes) Exh B.pdf(1097176 bytes) Exh C.pdf(825731 bytes)

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

In the Matter of Registration No. 4,938,797
Registered: April 12, 2016
Mark: ASTOR
International Class 30

ASTOR CHOCOLATE CORP.,

Petitioner,

v.

ELITE GOLD, LTD.,

Respondent.

Cancellation No. 92068766

**MOTION AND DECLARATION
OF J. MARK LANE IN SUPPORT OF
PETITIONER'S REQUEST TO REOPEN
TRIAL PERIOD AND RESET DATES**

J. MARK LANE, declares the following:

1. I am an attorney duly admitted and licensed to practice law in the courts of the State of New York, and a partner in the firm Lane Crowell LLP, counsel for the Petitioner Astor Chocolate Corp., in the above-captioned cancellation proceeding. I submit this declaration pursuant to F.R.Civ.P. 6(b), and Trademark Rule 2.132(a), and in response to the Order of the Trademark Trial and Appeal Board in this matter, dated April 28, 2021 (the "April 28 Order"), which directed Petitioner to show cause why it had not presented testimony and evidence during the period for same set by the Board's initial scheduling order, entered in this matter on June 19, 2018. As set forth below, Petitioner respectfully submits that the failure to present evidence during the initial time period was due to excusable neglect, that Respondent will not be prejudiced by the reopening of the time periods, that the administration of the relevant proceedings have not been affected by the delay and will not be affected by the reopening of the

schedule herein, and that the equities of this matter strongly favor reopening the proceedings and permitting the presentation of testimony and evidence.

2. As detailed further below, this is straightforward cancellation proceeding: Petitioner Astor Chocolate Corp. (“Astor”) has been using the mark “Astor” (the “Astor Mark”) in interstate commerce, in the chocolate and confectionaries industry, since at least 1950 (the business actually predates even that year, having been started in Eastern Europe by the same family that owns it today). Respondent Elite Gold Ltd. (“Elite Gold”) started using the same mark, “Astor” (the “Elite Gold Mark”), in the chocolate and confectionary industries in 2012, and registered the mark in 2016. Petitioner learned of Elite Gold’s use and registration only when its own application to register “Astor Chocolate” was met with an Office Action, initially rejecting the application based on Elite Gold’s prior registration. This cancellation petition was filed after initial efforts to resolve the matter failed, and is based on Petitioner’s prior use.

Procedural Background

3. On December 30, 2017, Astor filed an application to register the mark “Astor Chocolate” with the PTO, in International Class 30. In making that application, Astor voluntarily disclaimed the generic term “chocolate”, making “Astor” the key component of the applied-for mark. In that application, Astor provided a date of first use of July 19, 1950. The application was issued Serial No. 87719196 (the “Astor Application”).

4. On February 23, 2018, the PTO issued an Office Action in response to the Astor Application, by which it initially denied the requested registration, in part based on the prior registration of the mark “Astor” by Respondent Elite Gold. The Elite Gold registration, PTO Registration No. 4938707, had been granted on April 12, 2016, and stated a date of first use of January 1, 2012. The Elite Gold Mark is registered in the same International Class under

which Astor sought registration, IC30, and includes precisely the kinds of products that Astor has produced, under its name and mark, and sold in interstate commerce, for more than seventy years. The Elite Gold and Astor products are sold through the same channels of trade, including for example amazon.com.

5. On June 3, 2018, Astor filed the instant petition to cancel the Elite Gold registration (the “Petition to Cancel”), on the basis that it was improperly issued because Astor has prior use and superior rights to the term “Astor” in the chocolate and confectionary industries. 1 TTABVUE.

6. On June 19, 2018, the Board issued a Notice of Institution with a Conference, Discovery, Disclosure and Trial Schedule. 2 TTABVUE 1, 3. According to the Schedule, discovery was to open on August 28, 2018, and close on February 24, 2019. *Id.*

7. On July 30, 2018, Elite Gold filed an Answer, denying the claims set forth in the Petition to Cancel. 5 TTABVUE.

8. On August 15, 2018, at Petitioner’s request, the PTO suspended the Astor Application pending the outcome of the Petition to Cancel.

9. On September 27, 2018, Respondent served its Initial Disclosures; no documents were provided.

10. On September 28, 2018, Petitioner served its Initial Disclosures, and also provided documents in support of its claims, including marketing materials and industry awards going back decades in time. A copy of Petitioner’s Initial Disclosures, with copies of some of the materials provided therewith, is attached hereto as Exhibit A (the full set of documents that were provided with Petitioner’s Initial Disclosures is somewhat voluminous; the ones attached hereto are pages from a 1962 Astor brochure and a 1963 newspaper clipping). The documents

represent examples of the kinds of evidence Petitioner proposes to present in this proceeding, if permitted to do so; there are many more. That evidence will definitively establish Petitioner's prior use and claims of priority.

11. On October 5, 2018, Respondent served document demands and interrogatories on Petitioner. On October 30, 2018, Petitioner served document demands on Respondent. At the same time, Petitioner noted certain objections to Respondent's discovery requests, indicated that a confidentiality agreement would be needed in order for Petitioner to respond fully to Respondent's discovery requests, and suggested using the standard TTWB form.

12. On November 12, 2018, Respondent responded, indicating that the standard form would be acceptable. (See Exhibit B hereto (email chain)).

13. In the meantime, Petitioner made the decision to move the dispute to the district court, so that it could pursue other remedies beyond cancelation, and if necessary other parties. Accordingly, on December 18, 2018, Petitioner filed the initial complaint against Elite Gold in the Southern District of New York, seeking *inter alia* injunctive relief and monetary damages for trademark infringement. The case was given Index Number 18-cv-11913 and was assigned to The Honorable Paul A. Engelmayer,, where it is presently in the discovery phase with parties who remain in the case. (References to items in the District Court Action herein are as District Court Action Doc. # _.)

14. It took eight months to successfully obtain proof of service on Elite Gold in the British Virgin Islands, during which period Petitioner/Plaintiff regularly updated the District Court and Elite Gold's counsel. A Hague Convention Certificate of Service was filed in the District Court Action on July 26, 2019. (District Court Action, Doc. # 15).

15. Elite Gold did not timely respond to the Complaint in the District Court Action, leading Astor to advise the Court of its intention to move for a default judgment. (District Court Action, Doc. # 14). Soon thereafter, however, Elite Gold moved to dismiss the District Court Action on jurisdictional grounds. Skipping over the extensive proceedings that followed, and as further noted below, the District Court eventually addressed and granted Elite Gold's motion, finding that there was no basis for jurisdiction therein over Elite Gold.

16. In the meantime, while motions were proceeding in the District Court Action, on October 18, 2019, Elite Gold's counsel wrote to us, stating: "It has come to our attention that the Cancellation Proceeding was never suspended pending the current action in the SDNY. Please let us know if you consent to the attached motion and we will file it with the TTAB." (See Exh. C hereto).

17. We (I) wrote back that same day, stating: "That's odd, I thought it had been suspended. Probably thinking our application. Yes, you can say the motion is on consent. Thanks." (Id.)

18. Elite Gold's counsel filed the Motion to Suspend on that same date, October 18, 2019. 6 TTABVUE. Also on that same date, the Board granted the request, and issued an order stating, "proceedings are suspended pending final disposition of the civil action." 7 TTABVUE 1. The order stated, "Within twenty days after the final determination of the civil action, the interested party shall notify the Board so that this case may be called up for appropriate action." Id.

19. On December 21, 2020, the District Court issued the above-noted Decision and Order, among other things finding that there was no basis for jurisdiction over Elite Gold in that action, and dismissing Elite Gold from the case. (District Court Action, Doc. # 93).

On January 11, 2021, Petitioner filed a motion to resume the instant Petition to Cancel, attaching the District Court's Decision and Order. (15 TTABVUE and Exh A thereto).

20. On January 22, 2021, the Board issued an order, directing that the Petition to Cancel be resumed, and setting a new schedule for the remaining proceedings. 16 TTABVUE 1. According to the newly set schedule, discovery would remain open until May 31, 2021, and Petitioner's trial period would remain open until August 29, 2021. Id.

21. However, one week later, on January 29, 2021, Respondent filed a further motion to suspend. (18 TTABVUE). Following additional filings, the Board issued the April 28 Order, addressing *inter alia* the above applications.

Analysis

22. Throughout the above proceedings, neither party nor the Board indicated any view that evidence or testimony should have been presented in this petition following the initiation of the District Court Action; indeed, all parties appeared to assume that it should not be, in light of the fact that the same claims set forth herein were then before the District Court. As the Board noted in the April 28 Order, "It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case." (25 TTABVUE 3 (emphasis in original, citations omitted)). This policy is of course entirely reasonable, as the pendency and prosecution of two distinct actions between the same parties seeking the same relief is not only an inefficient use of Board and judicial resources, but runs a risk of inconsistent outcomes.

23. The District Court Action was filed two months before the close of discovery in this proceeding, pursuant to the original schedule in place at that time. As of the filing of the District Court Action, neither party to this proceeding had produced any discovery:

demands and initial disclosures had been exchanged, but nothing more. Nothing otherwise has changed: the witnesses remain the same and are available, relevant documents are preserved and can be promptly produced, and this matter should be capable of relatively expeditious resolution.

24. There will be no prejudice to anyone from granting Petitioner's within application to reopen this matter and reset deadlines. Denial of Petitioner's application, on the other hand, would result in great prejudice to Petitioner. Petitioner has incontrovertibly been using the Astor Mark in interstate commerce in the chocolate and confectionaries industry continuously since 1950. Respondent has been using the identical mark in the same industry since January 2012. Thus, Petitioner has more than 60 years of prior use. Petitioner is a family business that employs some 200 people and is well-known in the industry, counting among its customers many Fortune 500 companies as well as smaller establishments in hospitality, travel and other industries. It is presently blocked from registering the Astor Mark, despite this extensive prior use, due to the Elite Gold Registration that is the subject of this Petition. It is also prevented from doing business in some places due to the absence of a registration of its basic company name and brand. To dismiss this Petition or default Petitioner would result in extreme prejudice to Petitioner, and would grant to Respondent an unfair windfall flowing from a mere inadvertence of counsel. Petitioner respectfully submits that such an outcome should not obtain where there has been no prejudice and the inadvertence has not resulted in any reliance or change that alters the face of the dispute or the positions of the parties.

Relevant Standards

25. As the Board noted in its April 28, 2021 Order, the standard for determining an application under Rule 6(b) to reopen a time period that has passed is "excusable neglect." The Supreme Court articulated the meaning and scope of that standard in Pioneer Inv.

Servs. Co. v. Burnswick Assocs. Ltd. P'ship, 507 U.S. 380 (1993). There, the Court held that that the concept is “at bottom an equitable one, taking account of all relevant circumstances....”

Id. At 395. Factors to be considered include

the danger of prejudice to [the other party], the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith.

Id. This standard was adopted by the Board in Pumpkin Ltd. v. The Seed Corps., 43 USPQ.2d 1582 (TTAB 1997).

26. The term “prejudice” in this context means “more than the mere inconvenience and delay caused by the movant’s previous failure to take timely action, and more than the non-movant’s loss of any tactical advantage that it otherwise would enjoy as a result of the movant’s delay or omission.” TMBP 509.01(b)(1). On the contrary, “prejudice” refers to the “ability to litigate the case.” Id. (citing Pumpkin, 43 USPQ.2d at 1587).

27. As discussed above, there is no prejudice to Respondent from the delay: the District Court Action, presenting the identical issue presented in this Petition, was filed during the initial discovery period, before the trial period, with no actual discovery having been produced by either party. The parties had exchanged initial disclosures and had served discovery requests, but no other events or proceedings occurred herein prior to the filing of the District Court Action. All witnesses were disclosed and Petitioner produced documents in support of its claims, showing dates of use and industry recognition. See, e.g., The Coffee Studio LLC v. Reign LLC, Cancellation No. 92066245, 129 USPQ2d 1480 (TTAB 2019). Indeed, it was Respondent’s counsel who brought up the issue with us, and who prepared and filed the motion

to suspend, without seeking any other result or remedy, suggesting only that the parties file the motion to suspend at that time.¹

28. The length of the delay, although not brief, had literally no impact on any proceedings, here or in the District Court Action. Indeed, no one appears to have even given it any thought prior to the Board in reviewing the filings of the parties in early 2021, and the Board's re-set schedule as set forth in its January 22, 2021 Order did not lead to any objections. 16 TTABVUE 1.

29. In essence, the primary error here, and it is one for which we (I) take full responsibility, is in not promptly notifying the Board that the District Court Action had been filed and asking that this proceeding be stayed pending its outcome. However, and notably, had Petitioner (or the parties jointly) requested that this proceeding be suspended in a more timely manner – sooner after the initiation of the District Court Action – the outcome would, we respectfully submit, be exactly as it now is: nothing would have changed, except the date of a docket entry suspending this Petition.

30. As acknowledged above, the reason for the delay here is plain and simple, inadvertence of counsel. Although this heavily-weighted factor perhaps does not speak well of us, and absent any of the other circumstances present here might not counsel in favor of granting the request to reopen, we respectfully submit that it was and remains relatively harmless, and is coupled with compelling reasons why equity and fairness support granting the request. In addition, for whatever it is worth, I personally apologize to the Board for the delay.

¹ I am not in any way attempting to put the blame for the delay on Respondent's counsel – it was our petition and inarguably my responsibility – I simply point it out to show that neither party apparently experienced any prejudice or felt the need to invoke the delay for any purpose, requesting only that all parties consent to suspend the Petition to Cancel.

31. Petitioner has acted in good faith at all times. Petitioner did not abandon its claims or neglect them, but merely moved them to a different forum, a process as to which Respondent has been updated (and involved) at all times. Indeed, there was no advantage to be had for Petitioner in delaying notifying the Board of the filing of the District Court Action, or in filing a motion to suspend; as the current situation shows, if anything the opposite is true. Petitioner therefore respectfully submits that a realistic and fair assessment of the excusable neglect factors, applying equitable principles in light of all relevant circumstances present here, counsels in favor of granting the instant request, reopening proceedings herein, and resetting deadlines.

Conclusion

32. Petitioner accordingly requests that the Board grant this request and reopen proceedings in this Petition to Cancel, and reset deadlines accordingly.

Dated: May 18, 2021

LANE CROWELL LLP



By: _____

J. Mark Lane
178 Myrtle Boulevard, Suite 105
Larchmont, New York 10538
Telephone: (914) 761-0001
Facsimile: (914) 761-0002
Attorneys for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the Petitioner's **MOTION AND DECLARATION OF J. MARK LANE IN SUPPORT OF PETITIONER'S REQUEST TO REOPEN TRIAL PERIOD AND RESET DATES**, together with the Exhibits thereto, was served upon Attorney of record for Respondent in these proceedings by electronic mail addressed to:

Adam J. Bruno
trademarks@baystateptent.com

On this 18th day of May 2021.



By: _____
J. Mark Lane
Attorneys for Petitioner

DECLARATION OF J. MARK LANE

EXHIBIT A
(Initial Disclosures & Sample Documents)

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

In the Matter of Registration No. 4,938,707

Registered: April 12, 2016

Mark: ASTOR

International Class 30

ASTOR CHOCOLATE CORP.,)	
)	
Petitioner,)	Cancellation No. 92068766
)	
v.)	
)	
ELITE GOLD LTD.,)	
)	
Respondent.)	
)	
)	

**PETITIONER'S INITIAL DISCLOSURES
PURSUANT TO TRADEMARK RULE 2.120(a)(2)**

Pursuant to Rule Trademark Rule 2.120(a)(2), 37 C.F.R. § 2.120(a)(2), petitioner Astor Chocolate Corp., by and through its undersigned attorneys, hereby provides its Initial Disclosures, as follows:

I. Name, Address and Telephone Number of Individuals Likely to Have Discoverable Information:

David Grunhut: May be contacted through the undersigned counsel. Mr. Grunhut is a member of the founding family of Astor, and is the President and CEO of the company. He has knowledge of the history and use of the Astor trademark, and the claims and defenses in the case.

Alan Weisberger: May be contacted through the undersigned counsel. Mr. Weisberger is the Executive Vice President of Astor and has worked for the company for twenty-five

years. He has knowledge of the history and use of the Astor trademark, and the claims and defenses in the case.

Meir Grunhut: May be contacted through the undersigned counsel. Mr. Grunhut is a member of the founding family of Astor, and is a Vice President of the company. He has knowledge of the history and use of the Astor trademark, and the claims and defenses in the case.

Nathan Grunhut: May be contacted through the undersigned counsel. Mr. Grunhut is a member of the founding family of Astor, and is a Vice President of the company. He has knowledge of the history and use of the Astor trademark, and the claims and defenses in the case.

II. **A Copy or Description By Category Of All Documents, Stored Information and Tangible Things In Petitioner's Custody, Possession or Control That May Be Used to Support Claims or Defenses in This Case**

Petitioner is as yet unsure of the scope, but expects documents including e-mails and documents relating to: (a) branding, and specifically demonstrating petitioner's use of the Astor trademark in connection with chocolate and confectionary products over a period of more than six decades; (b) attempts to register its mark with the US Patent and Trademark Office; and (c) problems encountered in marketing as a result of respondent's use of its infringing mark. The aforementioned documents, to the extent they exist, are all kept or maintained at petitioner's offices. Certain documents illustrative of the above are being provided herewith, including samples of usage, industry awards and recognitions, major contracts and media coverage.

The above Initial Disclosures are based on documents and information reasonably available at this time, and are without prejudice, and are not intended to identify every document or category

that may be relevant to this matter. These Initial Disclosures may be supplemented as this case proceeds, and petitioner also may offer or use materials or information obtained from respondent and from third parties.

Dated: September 28, 2018

LANE CROWELL LLP

By: /s/ J. Mark Lane

J. Mark Lane

707 Westchester Avenue, Suite 411

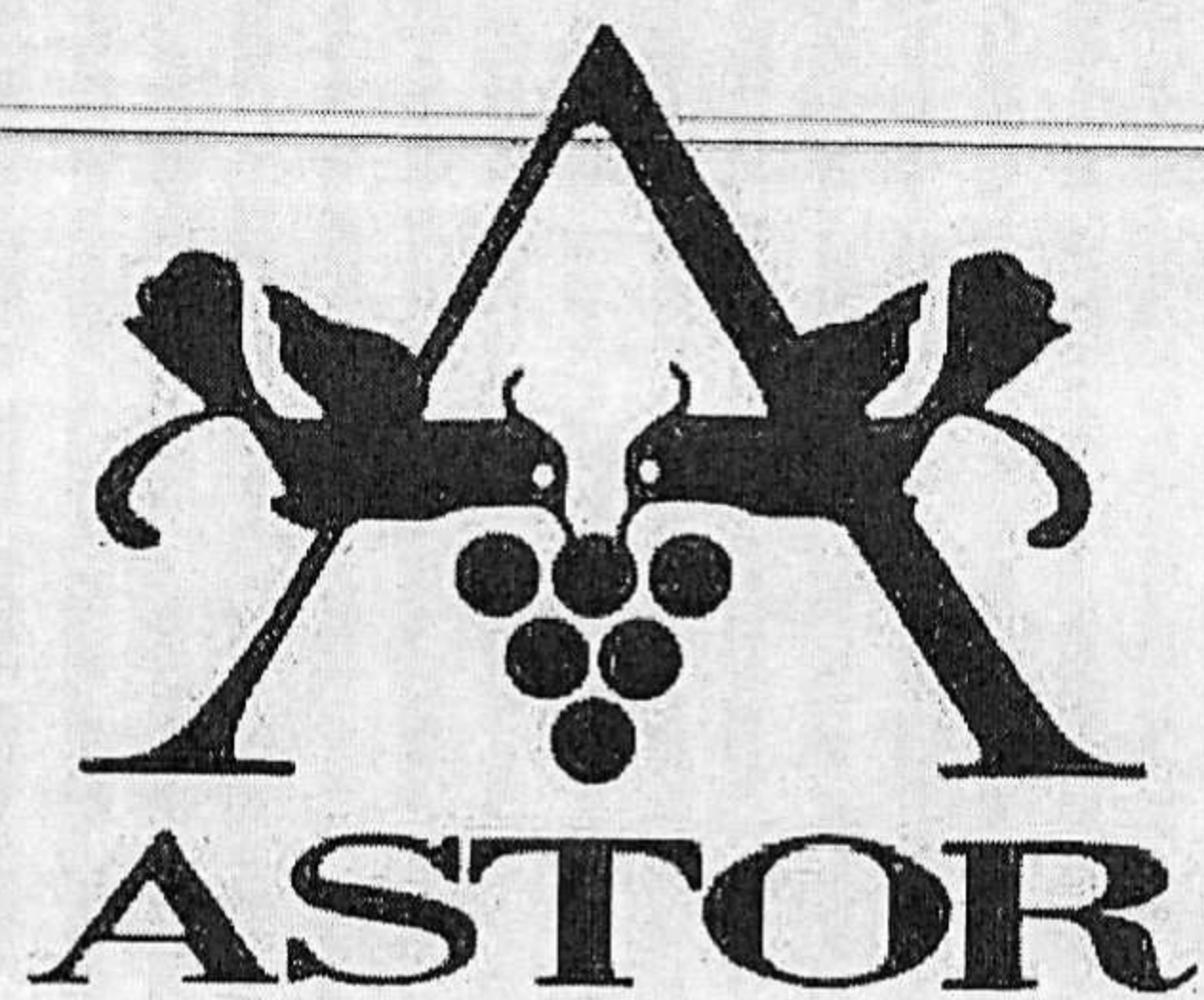
White Plains, New York 10604

(914) 761-0001 (telephone)

(914) 761-0002 (facsimile)

jmlane@lanecrowell.com

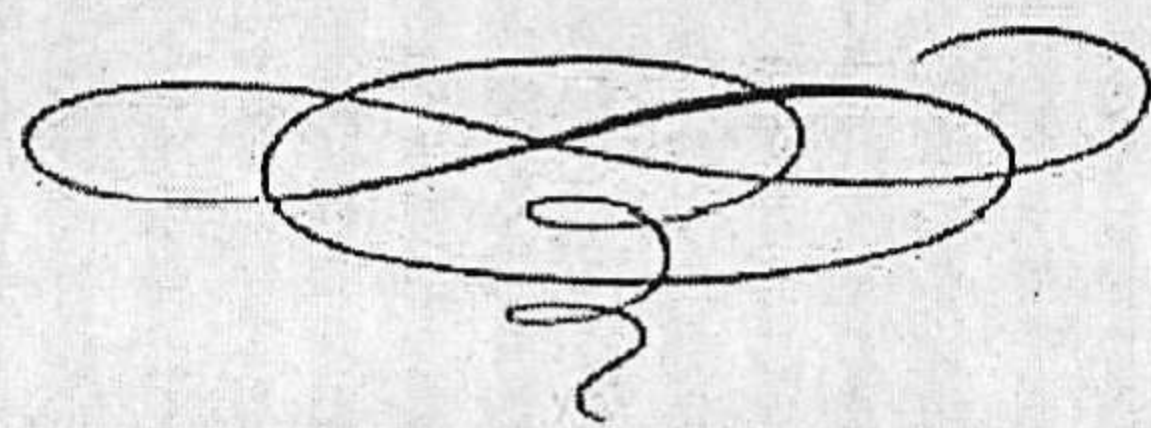
Attorneys for Petitioner

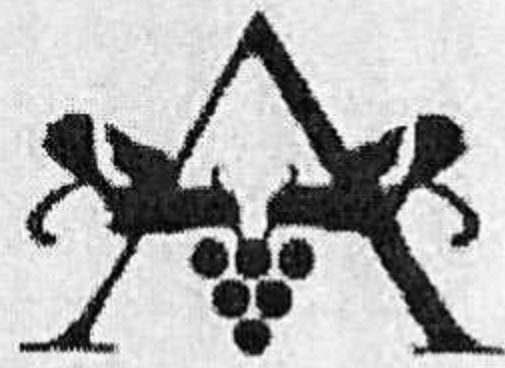
A black and white photograph showing a large, modern industrial-style building with a flat roof. In the foreground, there is a landscaped area with several young trees and bushes. To the left of the building, a white sign on two posts reads 'ASTOR CHOCOLATE' with the number '651' in the top right corner. The sky is overcast with soft clouds.

651
ASTOR
CHOCOLATE

Presenting

Astor Chocolate





ASTOR CHOCOLATE CORP.

ABOUT ASTOR

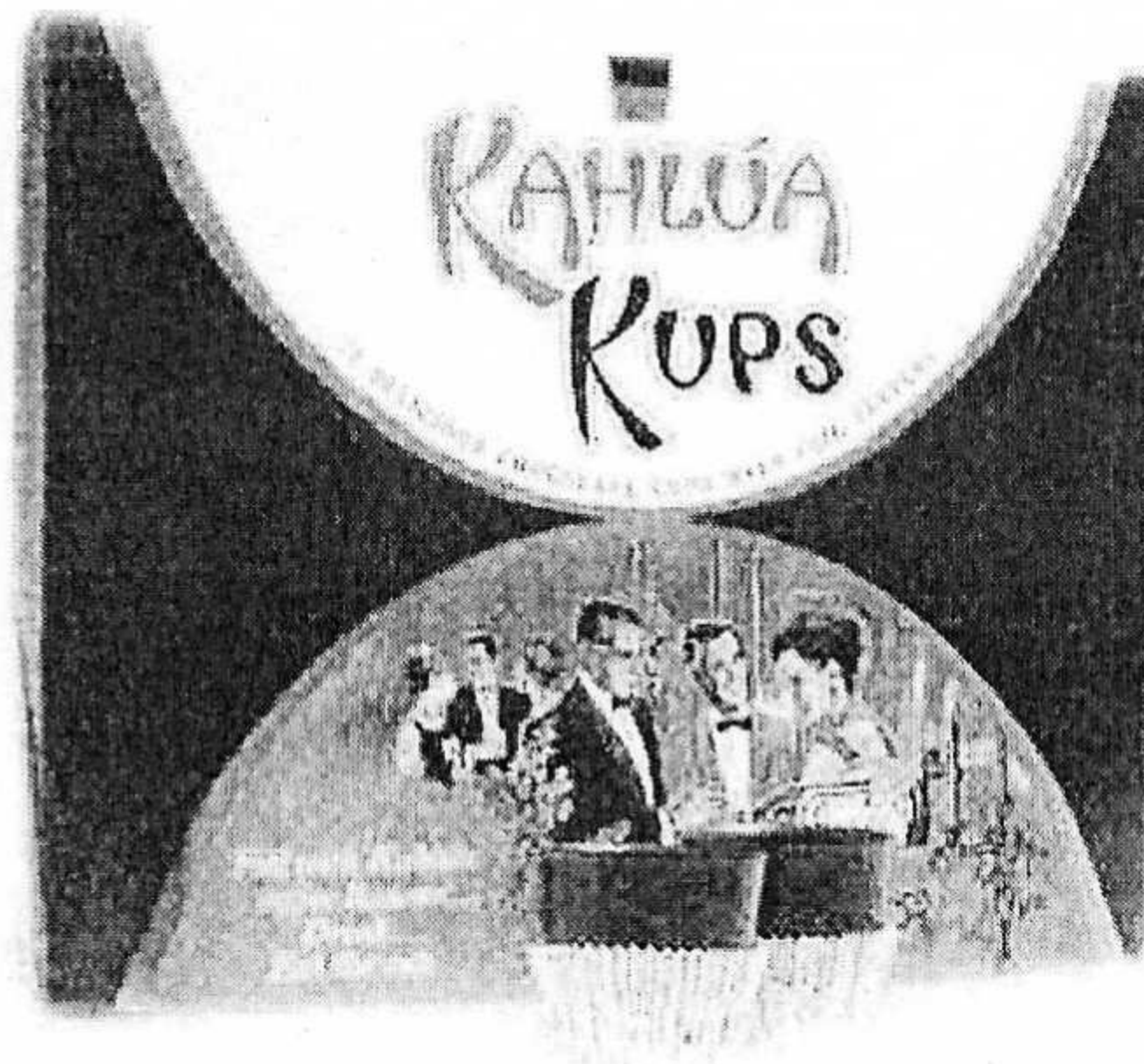
ASTOR Chocolate, a fourth-generation family owned business, was

established in 1950 in New York. The secret of Astor's success is strict adherence to quality - from the cocoa bean to the packaged chocolate. Astor products are made with premium Belgian chocolate - considered to be among the finest chocolate in the world. We serve such diverse industries as hospitality, travel, corporate gifts and foodservice

Our manufacturing facilities have been relocated to Lakewood, New Jersey into a state-of -the-art 120,000 square foot plant. This move enabled us to install additional advanced production equipment to increase productivity, provide better quality and enhance flexibility. To better serve you, we have also established complete graphic and comprehensive in-house printing departments. These have allowed us to lower costs- and pass the savings on to you.

OUR MISSION:

ASTOR CHOCOLATE is committed to providing you with superior chocolate at excellent prices, without ever compromising on quality or service. We strive to continually develop winning products that sell. Our goal is your continued success.



Kahlua Kups - 1962

...ese qualities, you
have kept yourself far from the
judge's office, and you have not
brought it over yourself to be ap-

0-2423
New York 17, N. Y.
or the Sole N.Y. Distributor
KEDEM WINES
132 Norfolk St.
N. Y. C. GR 3-828

For MISHLOACH MANOT

Send The Finest

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Manufacturers of the finest Kosher, Parve, C

ASTOR CHOCOLATES

898 Kent Ave.

● Brooklyn, N. Y.

DECLARATION OF J. MARK LANE

**EXHIBIT B
(Emails Regarding Discovery)**

J. Mark Lane

From: Adam Bruno <abruno@baystatepatent.com>
Sent: Monday, November 12, 2018 12:42 PM
To: J. Mark Lane
Cc: George MacInnis
Subject: RE: Astor

Good afternoon Mark,

The standard order that is in place with the TTAB is fine on our end.

Best,

Adam

Adam J. Bruno
Bay State IP, LLC
One Boston Place
201 Washington St, Suite 2600
Boston, MA 02108

(617) 439-3200 (Phone)
(617) 507-0757 (Facsimile)

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From: J. Mark Lane [mailto:jmlane@lanecrowell.com]
Sent: Tuesday, October 30, 2018 2:41 PM
To: Adam Bruno <abruno@baystatepatent.com>
Subject: Astor

Adam,

Attached is our first set of document requests. If you compare to yours, that will indicate a narrowing and elimination of a number of categories of requests. This narrowing reflects also our objections to your requests, which we will serve separately. (Some of your requests were duplicative of each other, some were overbroad, etc.)

I don't recall whether we discussed using the standard TTAB protective order? I am fine with that, but we should finalize if so, or use another one (also fine with me).

Any questions etc. please call or email.

Mark

 LaneCrowell LLP

707 Westchester Avenue, Suite 411 | White Plains, New York 10604
Tel 914.761.0001 | Fax 914.761.0002 | www.lanecrowell.com

Please note our new firm name and email address.

DECLARATION OF J. MARK LANE

EXHIBIT C

(Emails Regarding Motion to Suspend)

J. Mark Lane

From: J. Mark Lane
Sent: Friday, October 18, 2019 3:06 PM
To: Adam Bruno
Cc: George MacInnis
Subject: RE: Astor v Elite Gold Ltd

Hello Adam,

That's odd, I thought it had been suspended. Probably thinking our application. Yes, you can say the motion is on consent.

Thanks,

Mark

From: Adam Bruno <abruno@baystatepatent.com>
Sent: Friday, October 18, 2019 2:56 PM
To: J. Mark Lane <jmlane@lanecrowell.com>
Cc: George MacInnis <gmacinnis@baystatepatent.com>
Subject: RE: Astor v Elite Gold Ltd

Good afternoon Mark,

It has come to our attention that the Cancellation Proceeding was never suspended pending the current action in SDNY.

Please let us know if you consent to the attached motion and we will file with the TTAB.

Best,

Adam

Please note our new mailing address as of June 1, 2019

Adam J. Bruno
Bay State IP, LLC
10 Post Office Square, Suite 800 South
Boston, MA 02109

(617) 439-3200 (Phone)
(617) 507-0757 (Facsimile)

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