

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA**

BADIA SPICES, INC.,

Plaintiff,

vs.

GEL SPICE COMPANY, INC.

Defendant.

Civil Action: 1:15-cv-24391-MGC

GEL SPICE COMPANY, INC.,

Counterclaim Plaintiff,

vs.

BADIA SPICES, INC.,

Counterclaim Defendant.

**DEFENDANT GEL SPICE COMPANY, INC.'S ANSWER,
AFFIRMATIVE DEFENSES AND COUNTERCLAIMS**

Defendant Gel Spice Company, Inc. ("Gel"), through its undersigned attorneys for its answer to the Complaint of plaintiff Badia Spices, Inc. ("Badia"), answers and says as follows:

**RESPONSES TO THE
ALLEGATIONS OF THE COMPLAINT**

1. Gel neither admits nor denies the allegations of ¶1 of the Complaint, which is merely a characterization thereof and requires no response.
2. Denied.
3. Denied, except with respect to the allegations in subpart (d).

4. Admitted that defendant sells its goods in this District. Defendant lacks information and belief with respect to the allegations concerning the location of the property referred to in ¶4, and denies the remaining allegations in ¶ 4.

5. Denied, except with respect to the allegations incorporating by reference the allegations of ¶ 3(d).

6. Defendant lacks information and belief with respect to the allegations in ¶ 6.

7. Admitted.

8. Defendant lacks information and belief with respect to the allegations in ¶ 8, except admits that plaintiff manufactures spices and seasonings in the United States.

9. Defendant lacks information and belief with respect to the allegations in ¶ 9, except admits that plaintiff offers the referenced products for sale.

10. Defendant lacks information and belief with respect to the allegations in ¶ 10.

11. Defendant lacks information and belief with respect to the allegations in ¶ 11.

12. Defendant lacks information and belief with respect to the allegations in ¶ 12.

13. Defendant lacks information and belief with respect to the allegations in ¶ 13.

14. Defendant lacks information and belief with respect to the allegations in ¶ 14.

15. Defendant lacks information and belief with respect to the allegations in ¶ 15.

16. Defendant lacks information and belief with respect to the allegations in ¶ 16.

17. Denied.

18. Defendant lacks information and belief with respect to the allegations in ¶ 18.

19. Admitted, except denied that defendant's truthful description of its spice mix as a "complete mix" is an infringement of any party's trademark rights.

20. Denied, except admitted that the products are competing spice and seasoning products and may be sold in adjacent locations.

21. Denied.

22. Admitted, except with respect to plaintiff's use of the term "Infringing Marks."

23. Denied, except that defendant admits that it has been aware of plaintiff's specious trademark claims.

24. Denied.

25. Denied, except admitted that, after finding plaintiff unwilling to compromise with plaintiff, defendant refused to acquiesce to plaintiff's demand that its trademark claims were grounds for preventing defendant from any use of the word "complete" as a word to truthfully describe "complete" combinations of spices on its product labels.

26. Denied.

27. Denied.

28. Admitted, except denied that any consent, license or permission is required.

29. Denied.

30. Denied.

31. Denied.

COUNT I

32. Defendant incorporates its responses to the corresponding allegations incorporated into paragraph 32.

33. Denied.

34. Denied.

35. Denied.

36. Denied.

37. Denied.

COUNT II

38. Defendant incorporates its responses to the corresponding allegations incorporated into paragraph 38.

39. Denied.

40. Denied.

41. Denied.

42. Denied.

COUNT III

43. Defendant incorporates its responses to the corresponding allegations incorporated into paragraph 43.

44. Denied.

45. Denied.

46. Denied.

47. Denied.

48. Denied.

49. Denied.

FIRST AFFIRMATIVE DEFENSE

The Complaint fails to state a claim for which relief can be granted because the claimed COMPLETE SEASONING trademark is generic.

SECOND AFFIRMATIVE DEFENSE

The Complaint fails to state a claim for which relief can be granted because the claimed SAZON COMPLETA trademark is generic under the doctrine of foreign equivalents because these words mean “complete seasoning” in the Spanish language.

THIRD AFFIRMATIVE DEFENSE

The Complaint fails to state a claim for which relief can be granted because the claimed SAZON COMPLETA trademark is generic for a spice mix marketed as “sazon completa” in commerce in the United States.

DEMAND FOR RELIEF

WHEREFORE, Defendant demands that the Complaint be dismissed, with prejudice, in its entirety, and that defendant be granted its attorneys’ fees, costs, and such other relief as the Court finds just and proper.

COUNTERCLAIM

1. Counterclaim plaintiff Gel incorporates by reference its foregoing responses to the Complaint herein.

2. This is an action seeking cancellation of counterclaim defendant Badia's federal trademark registration (No. 2,885,777) for “COMPLETE SEASONING” and its federal trademark registration (No. 2,896,679) for "SAZON COMPLETA" pursuant to the Lanham Act, 15 U.S.C. § 1119, identified in the Complaint as the “Registrations.”

PARTIES, JURISDICTION AND VENUE

3. Counterclaim plaintiff incorporates the allegations of the Complaint with respect to the parties, jurisdiction and venue as well as its responses thereto as if fully set forth herein.

FACTUAL ALLEGATIONS

4. As set forth in the Complaint, Badia maintains the “Registrations” for COMPLETE

SEASONING and SAZON COMPLETA on the Primary Register of the United States Patent and Trademark Office.

5. Neither mark is, however, a valid, protectable mark, as set forth below.

COUNT I

“COMPLETE SEASONING” REGISTRATION CANCELLATION

6. Counterclaim plaintiff incorporates the foregoing paragraphs as if set forth herein.
7. COMPLETE SEASONING is not a valid, protectable trademark because the COMPLETE SEASONING trademark is generic.
8. Counterclaim defendant has no protectable trademark rights in the term “COMPLETE SEASONING” when used in connection with blends of several spices for use in food preparation because the mark is generic or, at best, contains the generic term “complete” plus the disclaimed "seasoning" to describe “complete” blends of spices meant to achieve a particular flavor combination.
9. For this reason, the term “COMPLETE SEASONING” does not qualify for registration under the Lanham Act, 15 U.S.C. §§ 1052(e)(1) and (2), 1064(3).
10. Registration was improvidently allowed and should be cancelled.

COUNT II

“SAZON COMPLETA” REGISTRATION CANCELLATION

11. Counterclaim plaintiff incorporates the foregoing paragraphs as if set forth herein.
12. SAZON COMPLETA is not a valid, protectable trademark because the words SAZON COMPLETA is generic because it means “complete seasoning” in the Spanish language..
13. Counterclaim defendant has no protectable trademark rights in the term “SAZON COMPLETA” when used in connection with blends of several spices for use in food preparation

because the mark is generic or, at best, contains the Spanish word for the generic term “complete” plus the disclaimed Spanish word “sazon” to describe “complete” blends of spices meant to achieve a particular flavor combination.

14. Counterclaim defendant has no protectable trademark rights in the term "SAZON COMPLETA" when used in connection with blends of several spices for use in food preparation because the mark is generic a spice mix marketed as “sazon completa” in commerce in the United States.

15. For these reasons, the term “SAZON COMPLETA” does not qualify for registration under the Lanham Act, 15 U.S.C. §§ 1052(e)(1) and (2), 1064(3).

16. Registration was improvidently allowed and should be cancelled.

WHEREFORE, counterclaim plaintiff prays that this Court declare that its use of the phrases ”COMPLETE SEASONING” and similar phrases in any language, including “SAZON COMPLETA” in the Spanish language, in connection with blends of several spices for use in food preparation, is entirely lawful and does not constitute trademark infringement and/or unfair competition under the Lanham Act, 15 U.S.C. §§ 1114 & 1125, or applicable Florida law, and order such other and further relief as this Court finds just and proper.

Dated: March 11, 2016

Respectfully submitted,

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on March 11, 2016, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record identified on the Service List below in the manner specified, either via transmission of Notice of Electronic Filing Generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

By: /s/Mark E. Stein

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