

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
January 22, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

General Mills, Inc. and General Mills IP Holdings II, LLC
v.
Fage Luxembourg S.A.R.L.¹

Opposition No. 91118482
to application Serial No. 75597291
filed on November 30, 1998

Opposition No. 91118950
to application Serial No. 75597292
filed on November 30, 1998

Opposition No. 91155075
to application Serial Nos. 76016809; 76016810; 76016811;
76016812; 76016813
all filed on April 4, 2000

Opposition No. 91182937
to application Serial Nos. 77037793; 77037808; 77037835;
77037851; 77037869; 77037897; 77037905; 77037924
all filed on November 6, 2006

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Fulbright & Jaworski LLP for General Mills, Inc. and General
Mills IP Holdings II, LLC.

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Winston & Strawn LLP for Fage Dairy Processing Industry S.A.

¹ We note applicant's change of name from Fage Dairy Processing Industry S.A. to Fage Dairy Industry S.A. and subsequent assignment to Fage Luxembourg S.A.R.L. recorded respectively at reel/frame nos. 4699/0239 and 4979/0802 for Ser. No. 75597291; and 4699/0239 and 4907/0138 for the remaining application Serial Numbers.

Before Quinn, Kuhlke and Mermelstein, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

The above-listed oppositions were sustained by the Board² in a precedential decision dated September 14, 2011. *General Mills Inc. v. Fage Dairy Processing Industry*, 100 USPQ2d 1584 (TTAB 2011). Applicant appealed the decision of the Board by filing, pursuant to 15 U.S.C. § 1071(b), civil action No. 06:11-CV-01174-(DEP) in the United States District Court for the Northern District of New York.³

Thereafter, the parties, having reached a settlement with respect to the civil action, entered into a consent judgment which was approved by the District Court on November 5, 2013. The court dismissed the claims in the civil actions. The court's order further provides:

B. General Mills' Opposition to FAGE's Application Serial Nos. 77/037,793; 77/037,808; 77/037,835; 77/037,851; 77/037,869; 77/037,897; 77/037,905; 77/037,924 ("FAGE's 2006 Applications") is dismissed without prejudice with consent.

C. Pursuant to 15 U.S.C. §§ 1071(b) and 1119, the United States Patent and Trademark Office is directed to register on the Principal Register FAGE's United States Trademark Application Serial

² We note Opposition No. 91155075 was dismissed as to the goods in International Class 30 in Application Serial No. 76016809, and that application has since issued into Registration No. 4208121 for the goods listed in that class.

³ We note opposers filed a related action (Case No. 06:12-CV-0920 (DEP)) that was consolidated with the applicant's case.

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Nos. 77/037,793; 77/037,808; 77/037,835;
77/037,851; 77/037,869; 77/037,897; 77/037,905 and
77/037,924 *without vacatur of the TTAB's September
14, 2011 decision.* (emphasis added)

We construe these provisions, taken together, to provide only that the relief ordered by the September 14, 2011 Board order be set aside, on consent of the parties, to the extent indicated above, while the factual findings and rulings of law in that decision remain undisturbed. In view thereof, Opposition No. 91182937 is dismissed without prejudice with consent of the parties and application Serial Nos. 77037793, 77037808, 77037835, 77037851, 77037869, 77037897, 77037905 and 77037924 will be forwarded for issuance of notices of allowance. Because the applications were filed under Section 1(b), 15 U.S.C. § 1051(b), based on applicant's stated intention to use the marks in commerce, applicant must first comply with the remaining procedural requirements prior to registration of the marks. See 15 U.S.C. § 21 ("The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, *upon compliance with the requirements of law.*") (emphasis added)

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In view of the court's order that the September 14, 2011 opinion is not vacated, the findings of fact, legal analysis and rulings of law otherwise stand undisturbed.

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