

Attorney Docket No. 222981US

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TRADEMARK TRIAL AND APPEAL BOARD

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

HARIBO OF AMERICA, INC.,)
)
Opposer,)
)
v.)
)
TREBOR ALLAN INC.,)
)
Applicant.)
)

Opposition No. _____
Appln. Serial No. 75/924,668
Mark: MISCELLANEOUS DESIGN



08-06-2002

U.S. Patent & TMOfo/TM Mail Rpt Dt. #70

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Commissioner:

HARIBO OF AMERICA, INC., a Delaware corporation located and doing business at 1825 Woodlawn Drive, Suite 204, Baltimore, Maryland 21207 (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No. 75/924,668, filed February 22, 2000, under the Trademark Act of 1946, in the name of TREBOR ALLAN INC. (hereinafter "Applicant"), published for opposition in the *Official Gazette* of April 9, 2002, Vol. 1257, No. 2, at page TM 350, for the alleged MISCELLANEOUS DESIGN mark.

The grounds of Opposition are as follows:

**FACTS AND ALLEGATIONS COMMON
TO ALL GROUNDS FOR OPPOSITION**

1. Opposer, HARIBO OF AMERICA, INC., is a Delaware corporation located and doing business at 1825 Woodlawn Drive, Suite 204, Baltimore, Maryland 21207.

2. Upon information and belief, Applicant, TREBOR ALLAN INC., is a Canadian corporation located and doing business in Burlington, Ontario, Canada.

3. Upon information and belief, on February 22, 2000, Applicant filed an application for registration of the alleged MISCELLANEOUS DESIGN mark for "candy." Said application was assigned Serial No. 75/924,668, and was published for opposition in the *Official Gazette* of April 9, 2002, Vol. 1257, No. 2, at page TM 350.

4. As published for opposition, Application Serial No. 75/924,668 contains the following description of Applicant's alleged mark: "the mark consists of the configuration of a piece of candy roughly shaped like a man."

5. As published for opposition, Application Serial No. 75/924,668 contains a claim of acquired distinctiveness (secondary meaning) pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

6. Applicant's proof of acquired distinctiveness (secondary meaning) of Applicant's alleged MISCELLANEOUS DESIGN mark in connection with the goods recited in Application Serial No. 75/924,668 is not apparent from the materials of record in the subject application, and Opposer therefore challenges same and leaves Applicant to its proofs with regard to the nature and sufficiency of whether Applicant's purported mark had and/or has acquired distinctiveness (secondary meaning) in connection with

Applicant's goods at the time of filing Application Serial No. 75/924,668, or at any time thereafter.

7. As published for opposition, in Application Serial No. 75/924,668 Applicant asserts that its first use anywhere and first use in commerce of the alleged MISCELLANEOUS DESIGN mark was May 25, 1989.

8. Upon information and belief, Applicant did not commence use in commerce of the alleged MISCELLANEOUS DESIGN mark any earlier than May 25, 1989.

9. Upon information and belief, Applicant promotes, distributes and sells the candy product that purportedly is the subject of Application Serial No. 75/924,668 under the trademark SOUR PATCH KIDS.

10. Upon information and belief, Applicant promotes, distributes and sells the candy product that purportedly is the subject of Application Serial No. 75/924,668 under the trademark SOUR PATCH.

11. Applicant's alleged MISCELLANEOUS DESIGN mark that is the subject of Application Serial No. 75/924,668, as published for opposition, does not accurately reflect the configuration of Applicant's goods comprising the alleged mark.

12. Commencing long prior to Applicant's claimed date of first use, Opposer has engaged, and is now engaged, *inter alia*, in the manufacture, promotion, distribution and sale of candy products.

13. Commencing long prior to Applicant's claimed date of first use, Opposer has been engaged in the manufacture, promotion, distribution and sale of candy shaped in the form of a standing human and/or a standing animal form.

14. Opposer has made a substantial investment in manufacturing, promoting, distributing and selling candy shaped in the form of a standing human and/or a standing animal form. Opposer has a continuing business interest in using the form of a standing human and/or the form of a standing animal in connection with the manufacture, promotion, distribution and sale of candy products, unfettered by competitors or third parties.

15. Opposer promotes, distributes and sells candy products in the form of a standing animal under the trademark HARIBO with and without the design of a little boy or design of a standing bear.

16. Upon information and belief, Opposer's and Applicant's goods will be sold in close proximity and purchased and consumed by the same general class of purchasers.

17. Opposer avers that it will be damaged by the registration by Applicant of the alleged MISCELLANEOUS DESIGN mark, as set for in Application Serial No. 75/924,668, in that a cloud will be placed upon Opposer's unfettered continued manufacture, promotion, distribution and sale of candy products shaped in the form of a standing human and/or a standing animal form.

FIRST GROUND FOR OPPOSITION
FAILURE TO FUNCTION AS A TRADEMARK/GENERICNESS

18. Opposer repeats the allegations contained in paragraphs 1 through 17 of the Notice of Opposition.

19. Applicant's alleged MISCELLANEOUS DESIGN mark does not function as a trademark, is generic of the goods recited in Application Serial No. 75/924,668, and is incapable of denoting origin in any specific source of the candy products for which

Applicant seeks protection in connection with the alleged mark, in violation of Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127.

20. Alternatively, Applicant's alleged MISCELLANEOUS DESIGN mark is not intended by Applicant to function as a trademark, and is not used by Applicant so as to denote origin in any specific source of the candy products for which Applicant seeks protection in connection with the alleged mark, in violation of Sections 1, 2 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052 and 1127.

SECOND GROUND FOR OPPOSITION
ABANDONMENT

21. Opposer repeats the allegations contained in paragraphs 1 through 17 of the Notice of Opposition.

22. Upon information and belief, with Applicant's knowledge, consent and acquiescence, third parties, including Opposer, have used, from a date preceding Applicant's date of first use, and are using the form of a standing human and/or the form of a standing animal in connection with the manufacture, promotion, distribution and sale of candy products that are the same as and/or highly similar to the candy products for which Applicant seeks protection in connection with the registration of Applicant's alleged MISCELLANEOUS DESIGN mark.

23. Upon information and belief, Applicant has engaged in a course of conduct, including acts of omission as well as commission that have caused the alleged MISCELLANEOUS DESIGN mark of Application Serial No. 75/924,668 to become the generic configuration for the goods in connection with which it is used or to otherwise lose its significance as a mark.

24. Thus, Applicant has abandoned whatever trademark rights it allegedly has or had in Applicant's purported MISCELLANEOUS DESIGN mark, pursuant to Section 45 of the Trademark Act, 15 U.S.C. § 1127.

THIRD GROUND FOR OPPOSITION
MERE DESCRIPTIVENESS

25. Opposer repeats the allegations contained in paragraphs 1 through 17 of the Notice of Opposition.

26. Applicant's alleged MISCELLANEOUS DESIGN mark is merely descriptive of the goods recited in Application Serial No. 75/924,668, in violation of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), in that the mark describes the nature, qualities and/or characteristics of the goods.

27. Applicant has not shown, and cannot establish, that Applicant's purported mark had and/or has acquired distinctiveness (secondary meaning) in connection with Applicant's goods at the time of filing Application Serial No. 75/924,668, or at any time thereafter.

FOURTH GROUND FOR OPPOSITION
DECEPTIVE MISDESCRIPTIVENESS

28. Opposer repeats the allegations contained in paragraphs 1 through 17 of the Notice of Opposition.

29. Applicant's alleged MISCELLANEOUS DESIGN mark is deceptively misdescriptive of the goods recited in Application Serial No. 75/924,668, in violation of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), in that the mark misdescribes the nature, qualities and/or characteristics of the goods, and prospective

purchasers are likely to believe the misdescription actually describes the configuration of Applicant's goods.

30. Applicant has not shown, and cannot establish, that Applicant's purported mark had and/or has acquired distinctiveness (secondary meaning) in connection with Applicant's goods at the time of filing Application Serial No. 75/924,668, or at any time thereafter.

FIFTH GROUND FOR OPPOSITION
DECEPTIVENESS

31. Opposer repeats the allegations contained in paragraphs 1 through 17 of the Notice of Opposition.

32. Applicant's alleged MISCELLANEOUS DESIGN mark is deceptive of the goods recited in Application Serial No. 75/924,668, in violation of Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), in that the mark misdescribes the nature, qualities and or characteristics of the goods, prospective purchasers are likely to believe the misdescription actually describes the configuration of Applicant's goods, and the misdescription is likely to affect the decision of purchasers to buy the goods.

SIXTH GROUND FOR OPPOSITION
FUNCTIONALITY

33. Opposer repeats the allegations contained in paragraphs 1 through 17 of the Notice of Opposition.

34. Applicant's right to the exclusive use of the alleged MISCELLANEOUS DESIGN mark in connection with candy, if Applicant were to be granted a registration therefor, would put competitors, including Opposer, at a significant non-reputation-related disadvantage, because the shape and configuration of Applicant's purported mark

is essential to the use or purpose of the goods and/or affects the cost or quality of the goods.

35. Applicant's right to the exclusive use of the alleged MISCELLANEOUS DESIGN mark in connection with candy, if Applicant were to be granted a registration therefor, would put competitors, including Opposer, at a significant non-reputation-related disadvantage, because the aesthetic value of the shape and configuration of Applicant's purported mark lies in its ability to confer a significant benefit that cannot be practically duplicated by the use of alternative designs.

36. Applicant's alleged MISCELLANEOUS DESIGN mark, as a whole, comprises a *de jure* functional configuration of the goods recited in Application Serial No. 75/924,668, in violation of Section 2(e)(5) of the Trademark Act, 15 U.S.C. § 1052(e)(5).

WHEREFORE, Opposer, HARIBO OF AMERICA, INC., believes and avers that it is being and will be continued to be damaged by registration of the alleged MISCELLANEOUS DESIGN mark in connection with the goods recited in Application Serial No. 75/924,668, and prays that said application be rejected, that no registration be issued thereon, and this Opposition be sustained in favor of Opposer.

Opposer has appointed KATHLEEN COONEY-PORTER, a member of the Bar of the District of Columbia, and JONATHAN HUDIS, a member of the Bar of the Commonwealth of Virginia, who are both members of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., its attorneys to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection therewith.

Please address all correspondence to:

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Arlington, Virginia 22202

The filing fee for this opposition in the amount of \$300.00 is enclosed herewith. Should the filing fee become detached, or be insufficient, the Commissioner is hereby authorized to charge any additional fees that may be required to oppose the captioned application, or to credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

HARIBO OF AMERICA, INC.

Dated: August 6, 2002

By:


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