

VIA EXPRESS MAIL

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

In the matter of Application Serial No. 76/404,299, TOSTILEO
Published in the *Official Gazette* on November 12, 2002

03-12-2003

U.S. Patent & TMO/TM Mail Rpt. Dt. #40

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RECOT, INC.

Opposer,

vs.

SERGIO VELA TERAN

Applicant.
-----X

Opposition No.

EL 911895106US

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NOTICE OF OPPOSITION

Opposer, Recot, Inc., a Delaware corporation, having a place of business at 5000 Hopyard Road, Suite 460, Pleasanton, California 94588, believes it will be damaged by the issuance of a registration to Sergio Vela Teran (hereinafter "Applicant"), an individual, with an address at Calle Huizache 3614 Fracc. Jardines De San-Rafael, Guadalupe, N.L., Mexico 67110, upon his Application Serial No. 76/404,299 for the mark TOSTILEO in International Class 30 for "corn chips," filed on May 6, 2002 and based on an intent-to-use the mark.

The grounds for opposition are as follows:

1. Opposer, Recot, Inc., through its predecessors in interest and title and through its related company Frito-Lay, Inc. (hereinafter collectively "Opposer"), has been engaged in the manufacture and sale of snack foods for over fifty years and is now one of the largest manufacturers of snack foods in the United States.

2. Opposer's snack foods are marketed and sold in tremendous quantities on a nationwide basis, supported by many millions of dollars of advertising and

promotion each year. Opposer's food products are sold in almost every supermarket in the United States as well as in numerous convenience stores, vending machines, mass merchandise stores, schools and other outlets.

3. Opposer has used the mark TOSTITOS and variants thereof on and in connection with snack foods and related products, including tortilla chips, since at least as early as 1977. Since a date long prior to the filing date of the above-identified application and continuing through the present, the mark TOSTITOS has been identified with Opposer and has appeared on a tremendous amount of product packaging, advertising, national television commercials, in-store display racks, trucks, signage, point-of-purchase material, etc.

4. Opposer has, by virtue of incredibly extensive usage, advertising and promotion, built up a very high level of consumer and trade recognition symbolized by its mark TOSTITOS and variants. Due to extensive public exposure to, and awareness by, consumers and the trade, the TOSTITOS mark is famous and has acquired and now possesses an extremely favorable reputation and distinctiveness with an invaluable amount of goodwill, solely signifying Opposer as the source of food products of high quality.

5. Each year for the past (10) years, Opposer has sold millions of dollars worth of products bearing the mark TOSTITOS. By virtue of its tremendous sales success, and extensive and popular advertising and promotional efforts, Opposer's TOSTITOS trademark has long enjoyed strong brand recognition and distinctiveness which has resulted in a highly favorable reputation and goodwill among the trade and consumers as identifying high quality snack food products manufactured and exclusively sold by Opposer.

6. Since first introducing TOSTITOS tortilla chips, Opposer has expanded its use of the mark TOSTITOS to identify other snack food products, styles or flavors, manufactured and sold exclusively by Opposer.

7. Opposer is also the owner of valid and subsisting U.S. registrations

and applications for the following marks:

MARK	REG./SER. NUMBER.	REG/FILE DATE	GOODS/FIRST USE
TOSTITOS	1,100,909	August 29, 1978	Potato chips, corn chips and tortilla chips
TOSTITOS	1,528,349	March 7, 1989	Clothing, namely sweatshirts, shirts, and fleece tops and bottoms
TOSTITOS	1,174,439	October 20, 1981	Picante sauce
TOSTITOS	2,341,230	April 11, 2000	Sauces and salsa
TOSTITOS WOW!	2,219,081	January 19, 1999	Tortilla chips
DIG IN. KICK BACK. TOSTITOS	2,507,477	November 13, 2001	Corn-based snack foods, including tortilla chips
BAKED TOSTITOS	2,187,806	September 8, 1998	Snack foods, namely tortilla chips
TOSTITOS TOPPERS	76/272,692	June 15, 2001	Corn-based snack foods, namely, tortilla chips
TOSTITOS DIPPAS	76/435,238	July 26, 2002	Snack food dips; corn-based snack foods, namely, tortilla chips; sauces and salsa
TOSTITOS and Design	76/383,188	October 1, 2002	Corn-based snack foods, namely, tortilla chips; picante sauce; salsa
TOSTITOS GOLD	76/403,086	May 2, 2002	Corn-based snacks, namely, tortilla chips
TOSTITOS GOLD CANTINA STYLE	76/416,966	May 28, 2002	Corn-based snacks, namely, tortilla chips
TOSTITOS READY, SET, DIP!	76/424,116	June 20, 2002	Snack food dips; sauces and salsas
LAY'S TOSTITOS CHEETOS RUFFLES GREAT TASTE . . . NATURALLY	76/478,547	December 20, 2002	Potato-based snacks, namely potato chips, potato crisps and puffed potato snacks; corn-based snacks, namely, tortilla chips and cheese-flavored puffed corn snacks
WHEN YOU'VE GOT TOSTITOS, YOU'VE GOT A PARTY!	76/436,770	August 1, 2002	Corn-based snacks, namely, tortilla chips

These registrations and applications are valid and in force, and Registration Numbers 1,100,909; 1,528,349; and 1,174,439 are incontestable. Hereinafter the marks, including those registered and/or used in commerce by Opposer, are referred to individually and collectively as the "TOSTITOS Marks."

8. As a result of the extensive and continuous advertising, sales, use and promotion of products bearing Opposer's TOSTITOS Marks for over twenty-five (25) years and their high quality, said marks have acquired substantial public and consumer recognition throughout the United States, enjoy valuable goodwill, have become famous, and have become assets of considerable value to Opposer.

9. On information and belief, on May 6, 2002, Applicant filed Application Serial No. 76/404,299 to register TOSTILEO for "corn chips" in International Class 30, based on an intent-to-use the mark for such goods.

10. Opposer has priority over Applicant because its use and/or registration dates precede the Applicant's filing date for its intent-to-use application or on information and belief, any claimed use of the purported mark TOSTILEO.

11. Applicant's alleged TOSTILEO mark and Opposer's TOSTITOS Marks are similar in their overall appearance, sound and commercial impression. In view of the similarities between the marks, there is a likelihood of confusion that would arise from the use and registration of the applied for mark.

12. On information and belief, the goods to which Applicant's alleged TOSTILEO trademark will be applied and the goods upon which Opposer's TOSTITOS Marks are registered and/or extensively used are likely to be related, if not identical, products. On information and belief, they appeal or will appeal to the same class of purchasers, and are goods of a type which are often sold through the same channels of trade.

13. Applicant's alleged TOSTILEO mark is confusingly similar to the TOSTITOS Marks owned by Opposer; it falsely suggests a connection with Opposer; and its use and registration contemporaneously with Opposer's TOSTITOS Marks is likely to cause consumer confusion, mistake and deception as to the source of Applicant's goods, all within the meaning of 15 U.S.C. §1052(d).

14. Further, registration and use of Applicant's purported mark would likely dilute the distinctive quality of Opposer's famous and highly distinctive TOSTITOS Marks, pursuant to 15 U.S.C. §1125(c).

15. Applicant's alleged mark TOSTILEO so resembles Opposer's TOSTITOS Marks as to be likely, when applied to Applicant's goods, to constitute a false representation that Applicant's goods are approved or sponsored by Opposer or that Applicant's business is connected or affiliated with Opposer or that TOSTILEO is a version of Opposer's TOSTITOS mark, thereby deceiving the public and causing damage to Opposer within the meaning of 15 U.S.C. §1063.

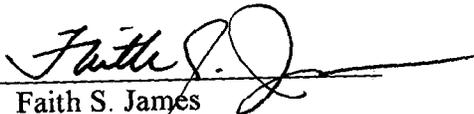
16. In view of the foregoing, Opposer would be damaged by the registration of Applicant's claimed mark TOSTILEO within the meaning of 15 U.S.C. §1063.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied to Applicant on its Application Serial No. 76/404,299.

The original and one copy of this Notice of Opposition is enclosed herewith. Please charge all required filing fees for the Notice of Opposition to Opposer's deposit account No. 06-2160.

Respectfully submitted,
RECOT, INC.

Date: March 12, 2003

By: 
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CERTIFICATE OF MAILING

I hereby certify that this paper is being deposited on the date indicated below with the United States Postal Service "Express Mail Post Office To Addressee Service," in an envelope addressed to: Box TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513

Faith S. James
Attorney Name

March 12, 2003
Date of Deposit


Signature

March 12, 2003
Date of Signature