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

<b>Proceeding</b>	91158237
<b>Party</b>	Plaintiff World Confections Inc ,
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<b>Submission</b>	Reply in Support of Motion
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<b>Date</b>	07/06/2005
<b>Attachments</b>	91158237 Reply.pdf ( 10 pages )

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

-----X  
World Confections, Inc.

Opposer

Mark: ALPINE CONFECTIONS

v.

**Opposition No.: 91/158,237**

Kencraft Inc.

Application No. 76/362,977

Applicant  
-----X

**OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT**

**I. INTRODUCTION**

On July 14, 2004, Opposer (WCI<sup>1</sup>) filed its motion/brief for summary judgment on the issues of (1) WCI's priority and (2) likelihood of confusion, accompanied by the Declaration of Matthew Cohen, President of WCI and the Declaration of John Rannells, attorney for WCI. On August 17, 2004 WCI filed a supplemental declaration of Mr. Cohen ["1<sup>st</sup> Supp. Decl. Cohen"].

On April 14, 2005, pursuant to a Rule 56(f) ruling, the Respondent's attorney inspected thousands of documents produced by WCI<sup>1</sup>. On April 14, 2005, Respondent's attorney took the deposition of WCI's President, Matthew Cohen. On June 16, 2005, Respondent filed its response to the motion for summary judgment.

WCI, respectfully submits this Reply and the accompanying second supplemental declaration of Mr. Cohen ("2<sup>nd</sup> Supp. Decl. Cohen"), which WCI requests that the Board

<sup>1</sup> Statement of Respondent's attorney during Cohen deposition, Cohen Dep., p. 111.

consider. See, Fed. R. Civ. P. 56(e) and Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993) (additional affidavit submitted with reply brief considered).

The following facts are uncontroverted:

1. WCI has sold its ALPINE CONFECTIONS brand gummi candy continuously (i.e., without interruption) from 1997 to the present date<sup>2</sup>.

2. WCI has also sold ALPINE BRAND brand gummi candy continuously from mid-2003 to the present date<sup>3</sup>.

3. WCI has always been known by the trade names "Alpine Confections" and "Alpine." WCI's use of the mark ALPINE CONFECTIONS and WCI's use of the trade names "Alpine Confections" and "Alpine" long precede the filing of Respondent's application<sup>4</sup>.

4. ALPINE CONFECTIONS brand gummi candy is sold through typical channels of trade for the sale of candy products, including through supermarkets, grocery stores, mom-and-pop stores, drug stores, candy stores, delicatessens, convenience stores, and by third parties over the Internet<sup>5</sup>.

5. WCI sells millions of dollars worth of ALPINE CONFECTIONS / ALPINE BRAND gummi products each year<sup>6</sup>.

6. Kencraft applied to register the mark ALPINE CONFECTIONS with actual knowledge of WCI's use of the mark and name ALPINE CONFECTIONS<sup>7</sup>.

7. The application being opposed is an ITU application and there is no evidence of record of use of the mark by Respondent.

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<sup>2</sup> 1<sup>st</sup> Decl. Cohen ¶¶7, 9, 12 and Ex. 2; 2<sup>nd</sup> Supp. Decl. Cohen, ¶¶ 6-10, and Exs. A, B(1)-B(5), C, and D (pp. 18, 55, 58, 102, 138) thereto.

<sup>3</sup> 1<sup>st</sup> Decl. Cohen ¶¶9 and 13; 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (pp. 27-28).

<sup>4</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Exs. B(1)-B(5), and D (pp. 10-12, 17, 115, 116).

<sup>5</sup> 1<sup>st</sup> Decl. Cohen ¶10; 2<sup>nd</sup> Supp. Decl. Cohen Ex. D (pp. 43, 45, 49, 53, 54).

<sup>6</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. C (WCI annual sales 1997 – 2004), and Ex. D (p. 128).

<sup>7</sup> 2<sup>nd</sup> Supp. Decl. Cohen, ¶11; Ex. 12 to Respondent's response papers.

## II. ARGUMENT

### I. Summary Judgment Is Appropriate

To defeat a motion for summary judgment, the Rule requires a “*genuine issue of material fact*”, not simply an issue of fact. See, American International Group Inc. v. American International Bank, 926 F.2d. 829 (9<sup>th</sup> Cir. 1991). Unsupported arguments, conjecture, and conclusions cannot support a response and evidence presented in response to a motion for summary judgment that is merely colorable or not significantly probative is insufficient to meet the respondent’s burden. Levi Straus & Co. v. Genesco, Inc., 742 F.2d 1401; 222 USPQ 939 (Fed. Cir. 1984), and Lane Capital Management Inc. v. Lane Capital Management Inc., 192 F.3d 337 (2<sup>nd</sup> Cir. 1999).

A factual dispute is “genuine” if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the non-moving party. TBMP §528.01 (500-102). A fact is “material” if it may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings and when its resolution would affect the outcome of the case. TBMP §528.01 (500-103) [citing cases].

The present case is particularly suited to summary judgment procedure as the “material” governing facts set forth by WCI and described herein are indisputable.

In its response, the Respondent relies almost exclusively upon unsupported conjecture and assumptions based upon conjecture, while failing to address the relevant law and purposefully avoiding the facts and documents of record. As demonstrated, WCI has priority; WCI has not “abandoned its rights”; the marks in issue are legally identical, the goods in issue are legally identical and similar, and the channels of trade are legally identical. Accordingly, Opposer must prevail and summary judgment is appropriate.

## **2. There Is No Genuine Issue Of Material Fact Regarding WCI's Priority**

The uncontroverted facts of this case establish that Alpine USA Limited was established March 28, 1997<sup>8</sup>. Beginning in 1997, Alpine USA manufactured and distributed product under the mark and name ALPINE CONFECTIONS<sup>9</sup>. Sales are continuous to date. On January 24, 2002 Alpine USA Limited, as part of a merger with World Candies, Inc., changed its corporate name to World Confections, Inc.<sup>10</sup> At all times relevant, Alpine USA Limited traded under the names “Alpine Confections” and “Alpine”<sup>11</sup>, which names are still in use by WCI today. WCI is still referred to by various customers and trade persons as “Alpine Confections” or simply “Alpine” and WCI still receives checks made out to “Alpine Confections.”<sup>12</sup>

## **3. WCI's Continuous Sales - 1997 To The Present Date.**

With the exception of certain licensed sales (e.g., Marvel - Spiderman)<sup>13</sup> and certain recent sales under ALPINE BRAND, all gummi candy products sold by WCI from 1997 to the present have borne the mark ALPINE CONFECTIONS [See, f.n. at fact #1 above].

The documents speak for themselves – See (1) representative WCI invoices of sales of ALPINE CONFECTIONS brand gummi products 1997 – 2004 [1<sup>st</sup> Decl. Cohen, Ex. 2]; (2) representative pages from WCI Booking Reports, 2000 and 2001 (representative daily orders logged) and from WCI Broker Product Reports, 2002-2004 (periodic sales recaps). [2<sup>nd</sup> Supp. Decl. Cohen, Ex. A]; and (3) annual sales records of ALPINE CONFECTIONS gummi candies – 1997 to 2004 [See, f.n. 5 / fact #5 above]. Not surprisingly, Respondent failed to address, refer to, or advise the Board of the existence of these records produced to Respondent.

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<sup>8</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (p. 8) (and reference to Ex. 1 to Cohen deposition).

<sup>9</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (pp. 10-11).

<sup>10</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (pp. 11, 16).

<sup>11</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (p. 12).

<sup>12</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (p. 17).

<sup>13</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (p. 35).

#### 4. WCI's Packaging - 1997 To The Present Date.

WCI has produced all of the following samples of packaging bearing the mark ALPINE CONFECTIONS (not surprisingly, Respondent makes no reference to the same):

- June 1997: Archival record showing 6 different packages bearing the mark ALPINE CONFECTIONS<sup>14</sup>;
- July 2001: Advertisement that appeared in July-Aug 2001 Professional Candy Buyer magazine showing WCI's line of ALPINE CONFECTIONS brand gummi candy, all of which packaging bears the mark ALPINE CONFECTIONS<sup>15</sup>.
- June 2002: Eleven packages submitted with WCI Copyright Applications dated 6/12/2002: All packages bear the mark ALPINE CONFECTIONS<sup>16</sup>.
- December 2003: Gummi candy product packages current as of 12/03 – 7 bear the mark ALPINE CONFECTIONS and 3 bear the mark ALPINE BRAND<sup>17</sup>.
- July 2004: 17 ALPINE CONFECTIONS packages both old and current<sup>18</sup>.
- 2005: Representative current product packaging bearing the marks ALPINE CONFECTIONS and ALPINE BRAND<sup>19</sup>.

To say that Respondent has been less than candid in its brief at pages 4 (point 9), 6 (point 31), 7 (point 34), 9 (point 50), 17, 20 wherein it represents that WCI has not produced evidence of continuous use would be an understatement.

Respondent argues that the mark ALPINE CONFECTIONS on WCI's front packaging is not trademark use. Its argument, though not clear, appears to be that the term ALPINE CONFECTIONS cannot be both a trademark (as used in the front of Opposer's product packaging) and a trade name (as used on the back of Opposer's product packaging). The

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<sup>14</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. B(1).

<sup>15</sup> The center of the advertisement shows the mark ALPINE CONFECTIONS with the ® symbol. The ad also refers to the company by its trade name "Alpine Confections." [2<sup>nd</sup> Supp. Decl. Cohen, Ex. B(2)].

<sup>16</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. B(3).

<sup>17</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. B(4).

<sup>18</sup> 1<sup>st</sup> Decl. Cohen, Ex. 2.

<sup>19</sup> 2<sup>nd</sup> Supp. Decl. Cohen, Ex. B(5).

premise is erroneous law and Respondent does not cite any precedent in support of such an argument.

The mark ALPINE CONFECTIONS on the front of WCI's packaging fits the classic definition of a trademark, and as state by WCI's President in response to questioning:

Q. Why is a name including "Alpine" important to your companies?

A. Because that's the name that we chose to market our products . . . under. That's the name we have been continually using since 1997, '98, '99, 2000, one, two, three, four, five, today. We have continuity in the market with these products. We have come to be known by these products. . . Some customers ask for Alpine Strawberry or Alpine . . . "Alpine" is what our customers know." [2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (pp.37-38)], Also pp. 32, 65.

Q. My last question to you is, what in your opinion distinguishes your gummi products from the gummi products of other third parties?

A. My trademark, Alpine Confections. [2<sup>nd</sup> Supp. Decl. Cohen, Ex. D. (pp. 172-173)].

The fact that WCI used the identical trade name "Alpine Confection" on the rear of its packaging does not detract from or change the nature of WCI's trademark use of ALPINE CONFECTIONS on its front packaging. Use of the mark also as a trade name merely provides an additional basis upon which to oppose a mark. In that regard, 15 U.S.C. §1052(d) provides that one may challenge a mark that "consists of or comprises a mark . . . or trade name previously used in the United States by another . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive."

**5. WCI Has Not Abandoned Its Mark – WCI Never Ceased Substantial Use Of The Mark**

Respondent also argues that WCI abandoned rights in its mark ALPINE CONFECTIONS as a result of Alpine USA Ltd allowing a prior application for the mark to become abandoned and on the basis that WCI did not use the symbol "tm" next to its mark. The fact that WCI allowed a previous application for ALPINE CONFECTIONS to become abandoned is irrelevant and immaterial. The application was abandoned due to sloppy administration [2<sup>nd</sup> Supp. Decl.

Cohen, Ex. D (p. 139)]. The symbol “™” is certainly not a requirement and carries no legal weight. As such, it does not create a “genuine” issue of “material” fact.

As conceded by Respondent, “abandonment” requires two elements, namely (1) discontinuance of the mark in trade and (2) an intent not to resume use of the mark in trade. WCI has demonstrated beyond any doubt and beyond any possibility of dispute, that it has NEVER ceased or discontinued use of the mark ALPINE CONFECTIONS. Accordingly, Respondent’s abandonment claim cannot stand. WCI cannot have an “intent” not to resume use, as it has never ceased use.

**6. The Marks In Issue Are Legally Identical.**

WCI has continuously used the mark ALPINE CONFECTIONS on gummi candy from 1997 to the present date. WCI also used the corporate name Alpine USA Ltd. from 1997 to February 2002 and has also traded under and has been known by the trade names “Alpine Confections” and “Alpine” from 1997 to the present date. [See, Fact #s 1 and 3 above and their associated footnote citations to the record].

WCI is relying upon its trademark “ALPINE CONFECTIONS”, its trademark “ALPINE BRAND”, and its trade names “ALPINE CONFECTIONS” and “ALPINE.” All of said names are either identical to, legally identical to, or so similar as to be indistinguishable from the mark in issue, ALPINE being the dominant portion of the mark.

**7. The Parties’ Goods Are Legally Identical**

WCI has demonstrated use and ownership of the mark ALPINE CONFECTIONS for “gummi candy” and for “licorice.” The goods recited in the ITU application in issue are “candy.” Respondent has not submitted any evidence of use of the mark on any products.

Respondent has completely ignored the legal precedents cited by WCI in its principal brief, namely: The Board must assess this factor [i.e., the similarity of the goods/services] by comparing Applicant's goods as recited in Respondent's application (i.e., candy) with Opposer's goods as actually used by Opposer (gummi candy and licorice). See, Warnaco Inc. v. Adventure Knits, Inc., 210 USPQ 307, 314-315 (TTAB 1981) and other cases previously cited. And, it is established rule that where goods are broadly described in an application (as is the case with the goods recited in the Respondent's application), it creates, *inter alia*, the following legal presumption: that the description encompasses all goods or types of goods embraced by the broad terminology. See Id. at 210 USPQ 314-315 and cases previously cited.

Obviously, "gummi candy" and "licorice" are encompassed by the broad terminology "candy."

Respondent failed to distinguish the relevant case law or even address the same. Respondent's sole arguments are (1) to refer to irrelevant case examples and (2) to advise the Board that it allegedly has no plans to sell gummi candy. In its attempt to argue that "gummi candy" and "licorice" are somehow not "similar" to "candy", the Respondent cites three cases (see p 16 Resp. Brief) which do nothing more than highlight the fact that the cited cases are irrelevant – they involve (1) cooking classes v. kitchen textiles, (2) liquid drain opener v. advertising services, and (3) coaxial cable v. lamps and tubes used in photocopy machines.

Regarding Respondent's alleged plans not to sell "gummi candy", the same is irrelevant. The goods in issue in this proceeding are "candy." The goods sold by Opposer are candy products. Respondent's irrelevant cases and alleged plans do not create a "genuine" issue of "material" fact.

## **8. Similarity Of Trade Channels**

WCI sells its ALPINE CONFECTIONS gummi candies to all types of outlets typical for the sale of candy products. See, f.n. 5, fact #4 above. During Rule 56(f) document production, Respondent's attorney was shown hundreds, and perhaps thousands of invoice records showing client's throughout the U.S. of each type alleged by WCI. In fact, the representative invoices attached to Mr. Cohen's first Declaration show sales to a variety of accounts, including a distributor, a 99 Cent Store; a Dollar Tree store, a Save-A-Lot Store, Value City Merchants Warehouse, Only Deals, Inc., the Wakefern grocery chain, Casey's General Store in Ankeny, Iowa, and Palmer Candy Company.

In any event, there is nothing to contrast with, as there is no evidence of any sales by Respondent through any channels of trade. As previously briefed by Opposer:

It is established rule that where goods are broadly described in an application, without any restriction as to classes of purchasers or trade channels, (as is the case with the goods recited in Applicant's application), it creates, *inter alia*, the following legal presumptions: (1) that the goods move through all of the channels of trade suitable for goods of that type; and (2) that they reach all potential users or customers for such goods. See Warnaco, *supra*, at 210 USPQ 314-315, and cases previously cited.

The Respondent made not attempt to distinguish or to even address the above controlling case law. Respondent has not raised a "genuine" issue of "material" fact.

## **9. Evidence of Actual Confusion**

WCI presented evidence of a number of examples of actual confusion (generally, confusion resulting from various press releases from and news articles about Respondent's parent)<sup>20</sup>. Respondent argues that the confusion is irrelevant because it comes from "non-market participants." While Opposer respectfully disagrees as to Respondent's characterization, actual

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<sup>20</sup> 1<sup>st</sup> Supp. Decl. Cohen; 2<sup>nd</sup> Supp. Decl. Cohen, Ex. D (pp. 74-76, 80, 81, 86, 87).

confusion is not necessary in order to prove likelihood of confusion. Further, since Respondent has not yet begun to sell product under the mark in issue, any lack of "retail" type confusion is immaterial.

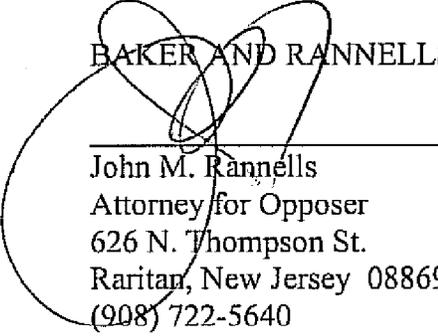
**III. CONCLUSION**

The purpose of a summary judgment motion is "judicial economy, that is, to avoid the unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case". TBMP §528.01. There being no genuine issue of material fact, summary judgment is appropriate.

Dated: July 6, 2005

Respectfully submitted,

BAKER AND RANNELLS PA



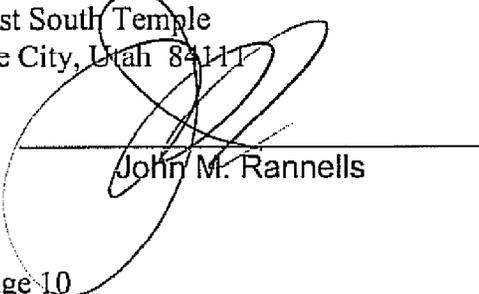
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**CERTIFICATE OF SERVICE**

I hereby certify a copy of the foregoing OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT in re: World Confections, Inc. v. Kencraft, Inc. Opp. No. 91/158,237 was served on counsel for Applicant, this 6<sup>TH</sup> day of July, 2005, by sending same via First Class Mail, postage prepaid, to:

Todd E. Zenger, Esq.  
Kirton & McConkie  
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John M. Rannells