

ESTTA Tracking number: **ESTTA11489**

Filing date: **07/12/2004**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SUPERVALU INC.
Granted to Date of previous extension	07/11/2004
Address	SUPERVALU INC. 11840 Valley View Road Eden Prairie, MN 55344 UNITED STATES

Attorney information	Scott W. Johnston Merchant & Gould P.C. P.O. Box 2910 Minneapolis, MN 55402-9944 UNITED STATES sjohnston@merchant-gould.com, slindemeier@merchant-gould.com Phone:(612) 332-5300
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Applicant Information

Application No	76323411	Publication date	01/13/2004
Opposition Filing Date	07/12/2004	Opposition Period Ends	07/11/2004
Applicant	Franco Manufacturing Co., Inc.		

Goods/Services Affected by Opposition

Class 024. First Use: 19970700 First Use In Commerce: 19970700

All goods and services in the class are opposed, namely: Towels, oven mitts, pot holders, textile placemats, and fabric kitchen towels

Attachments	2004 07 12 Notice of Opposition.pdf (5 pages)
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Signature	/SWJ/
Name	Scott W. Johnston
Date	07/12/2004

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

_____)	
SUPERVALU INC.,)	Opposition No. _____
)	
Opposer,)	Mark: SUPER VALUE
)	
v.)	Serial No. 76/323,411
)	
Franco Manufacturing Co., Inc.,)	Filing Date: October 10, 2001
)	
Applicant.)	Published: January 13, 2004
_____)	

NOTICE OF OPPOSITION

SUPERVALU INC., a Delaware corporation having its principal place of business at 11840 Valley View Road, Eden Prairie, Minnesota 55344 (hereinafter referred to as "Opposer"), believes that it will be damaged by the registration of the mark SUPER VALUE shown in application Serial No. 76/323,411, filed October 10, 2001, by Franco Manufacturing Co., Inc. (hereinafter referred to as "Applicant"), and hereby opposes registration of the mark pursuant to previously filed extensions of time to oppose. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946, as amended, registration upon the Principal Register of the mark SUPER VALUE for "towels, oven mitts, pot holders, textile placemats, and fabric kitchen towels" in International Class 24.

2. Applicant's mark published for opposition on January 13, 2004. Opposer filed and the Board approved extensions of time to oppose Applicant's Mark until July 11, 2004 (Sunday).

This Notice of Opposition is timely filed.

3. Opposer has been using the name and mark SUPERVALU since at least as early as 1942, and owns several registrations, including U.S. Registration Nos. 646,905; 646,906; 646,916 and 2,812,894 (collectively referred to herein as "Opposer's Marks").

4. Opposer is the owner of Registration No. 646,905 for the mark SUPERVALU for "bookkeeping and accounting services for others" in International Class 35. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

5. Opposer is the owner of Registration No. 646,906 for the mark SUPERVALU for "advertising services for others, through the media of radio, television, newspapers, direct mail, and the like" in International Class 35. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

6. Opposer is the owner of Registration No. 646,916 for the mark SUPERVALU for "personnel training services for others" in International Class 41. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

7. Opposer is the owner of Registration No. 760,163 for the mark SUPERVALU for "grocery store services" in International Class 35. Said registration is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and is therefore conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer's ownership of the mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

8. Opposer is the owner of Registration No. 2,812,894 for the mark SUPERVALU for "distributorships in the field of groceries; retail grocery store services" in International Class 35.

9. Opposer has also used the mark SUPERVALU on paper goods and printed matter, including paper sacks, paper napkins, stationery and coupons since long before Applicant's filing date or alleged first use date.

10. Upon information and belief, Applicant did not commence use of the SUPER VALUE mark prior to Opposer's first use of its SUPERVALU marks.

11. There is no issue as to priority as between Applicant's SUPER VALUE mark and Opposer's SUPERVALU marks given that Opposer's earliest SUPERVALU mark was filed August 3, 1954, nearly forty-seven (47) years before Applicant filed its SUPER VALUE application, and registered July 24, 1956, nearly forty-five (45) years before Applicant filed its SUPER VALUE application.

12. Opposer's SUPERVALU mark is famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and became famous before Applicant's first use of Applicant's mark.

13. Applicant's alleged goods are closely related to Opposer's goods marketed and sold by Opposer in connection with its SUPERVALU marks.

14. Due to the similarity between Applicant's claimed mark, SUPER VALUE, and Opposer's previously used and duly registered SUPERVALU marks, and the related nature of the goods of the respective parties, customers and potential customers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

15. Registration by Applicant of the mark SUPER VALUE for Applicant's goods is likely to cause confusion or to cause mistake and deception in the wholesale and/or retail trade, and among purchasers and potential purchasers, with Opposer's previously used and duly registered SUPERVALU marks, again resulting in damage to Opposer.

16. Because of the related nature of the goods, and the similarity of the marks, registration of the SUPER VALUE mark by Applicant is likely to cause confusion, mistake or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored or approved by Opposer for use with Opposer's goods and services causing further damage to Opposer.

17. Applicant's SUPER VALUE mark is identical in sight, sound and commercial impression to Opposer's Marks.

18. Registration of the mark shown in Application Serial No. 76/323,411 will result in damage to Opposer under the provisions of the Trademark (Lanham) Act §§ 2(a), 2(d), and 2(f), 15 U.S.C. §§ 1052(a), (d) and (f), pursuant to the allegations stated above.

WHEREFORE, Opposer requests that the registration sought by Applicant in application Serial No. 76/323,411 be refused and that this Notice of Opposition be sustained.

Please direct all correspondence to:

Scott W. Johnston,
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, Minnesota 55402-0910
Telephone: 612/332-5300

The Opposer appoints Paul A. Welter, Reg. No. 20,890; D. Randall King; John A. Clifford, Reg. No. 30,247; John L. Beard, Reg. No. 27,612; Sandra Epp Ryan, Reg. No. 39,667; Scott W. Johnston, Reg. No. 39,721; Kristina M. Foudray, Anna W. Manville, Gregory C. Golla, and Andrew S. Ehard of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Please charge the required fee of \$300.00 to Deposit Account No. 13-2725 of Opposer's counsel noted below.

Respectfully submitted,

SUPERVALU INC.

By its attorneys,



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Date: 7-12-04