

ESTTA Tracking number: **ESTTA78655**

Filing date: **05/01/2006**

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	FABRICA DE ESPECIES Y PRODUCTOS EL REY S.A.
Granted to Date of previous extension	05/03/2006
Address	Carrera 68G No. 42C 30 Sur Bogota, COLOMBIA

Attorney information	Katrin Lewertoff Sidley Austin LLP 787 Seventh Avenue New York, NY 10019 UNITED STATES klewertoff@sidley.com Phone:212 839 7366
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Applicant Information

Application No	78561085	Publication date	01/03/2006
Opposition Filing Date	05/01/2006	Opposition Period Ends	05/03/2006
Applicant	Cargill, Incorporated 15407 McGinty Road West Wayzata, MN 55391 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 2003/07/31 First Use In Commerce: 2003/07/31
All goods and services in the class are opposed, namely: shortening, edible oils and fats

Attachments	DT-7285 not of opp class 29.pdf (17 pages)(1901054 bytes)
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Signature	/Katrin Lewertoff/
Name	Katrin Lewertoff
Date	05/01/2006

1. Under the trademarks and trade names EL REY and EL REY & Design Opposer has engaged in the business of selling spices and condiments since long prior to July 31, 2003, to wit Applicant's claimed first use date, and February 4, 2005, Applicant's filing date. Opposer never abandoned use of its marks.
2. Opposer has secured valuable rights in the marks EL REY and EL REY & Design based on use in U.S. commerce. A depiction of Opposer's EL REY & Design mark is attached hereto as Exhibit A.
3. Opposer is the owner of the trademarks for EL REY and EL REY & Design which are used in connection with goods highly similar to those listed in the subject application for EL REY.
4. Opposer is the owner of use-based U.S. Trademark Applications for EL REY and EL REY & Design as applied to "spices, condiments, seasonings and seasoning pastes," Serial Nos. 78/860,723 and 78/860,672, filed on April 13, 2006. Copies of the current TARR printouts of the application specifics are attached hereto as Exhibits B and C.
5. Opposer has expended, and continues to expend significant amounts of money, time and effort in advertising, promoting and popularizing its EL REY and EL REY & Design trademark so that the trade in general, and the consuming public in particular, have come to know and recognize Opposer's trademark and products, and to know that the same originate with, and belong to, Opposer.

6. Opposer's marks EL REY and EL REY & Design are arbitrary as applied to Opposer's goods. The marks are thus highly distinctive and serve as strong indicators of origin.
7. As a consequence of Opposer's continuous and widespread use since at least May 2000, the promotion and advertising of the marks EL REY and EL REY & Design, Opposer has acquired substantial and protectable goodwill in such marks in the United States. A copy of an invoice dated May 12, 2000, from Paradise Distributors Inc. of East Elmhurst, New York, one of Opposer's distributors, to Morristown Mini Market of Morristown, New Jersey, evidencing a sale of Opposer's spices is attached hereto as Exhibit D. The marks have been used for and on Opposer's products for a significant period of time and are therefore instantly recognized by consumers as symbols of the quality of Opposer's goods.
8. There is no issue of priority since Opposer's first use of its marks precedes Applicant's filing date and claimed first use date.
9. Applicant's EL REY and Opposer's EL REY and EL REY & Design are highly similar visually and aurally.
10. The goods for which Applicant seeks registration of the EL REY mark are highly similar to the goods for which and in connection with which Opposer's EL REY marks have been used for many years. The goods marketed by Opposer are sold to the same consumers, and are thus in competition with the goods marketed and sold by Applicant.

11. Applicant's mark is confusingly and deceptively similar to Opposer's marks and is likely to cause confusion and mistake in the minds of the purchasing public and to deceive the purchasing public as to the source or origin of Applicant's goods. Persons familiar with Opposer's trademarks would be likely to believe that Applicant's goods originate with or are sponsored by Opposer. Any such confusion in the trade could seriously injure Opposer to the extent that any defect, objection or fault found with Applicant's goods marketed under its mark would necessarily reflect upon the reputation which the Opposer has established for its products offered and merchandised under its trademarks.
12. If the Applicant were granted registration for the subject mark it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration and use would be a source of damage and injury to Opposer and Opposer's customers.

WHEREFORE, Opposer requests that this opposition be sustained and that U.S. Trademark Application Serial. No. 78/561,085 be refused.

Please charge the filing fee in connection with this Notice of Opposition to the undersigned's firm's Deposit Account No. 50-0955.

Petitioner herein appoints Peter J. Toren and Katrin Lewertoff as its attorneys, to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,
Fabrica de Especies y Productos El Rey S.A.
By its attorneys,

Dated: May 1, 2006

By: _____

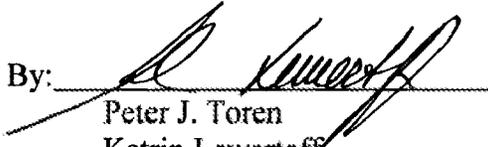

Peter J. Toren
Katrin Lewertoff
SIDLEY AUSTIN LLP
787 Seventh Avenue
New York, New York 10019
(212) 839 7366

Exhibit A



EL REY®

Exhibit B

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-05-01 12:33:05 ET

Serial Number: 78860672

Registration Number: (NOT AVAILABLE)

Mark



(words only): EL REY

Standard Character claim: No

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2006-04-24

Filing Date: 2006-04-13

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 042 -New Application Processing

Date In Location: 2006-04-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Fabrica de Especias y Productos EL REY S.A.

Address:

Fabrica de Especias y Productos EL REY S.A.
Calle 40 Sur No. 68D - 55

7700500 Bogota

Colombia

Legal Entity Type: Corporation

State or Country of Incorporation: Colombia

GOODS AND/OR SERVICES

International Class: 030

Class Status: Active

Spices, condiments, seasonings and seasoning pastes

Basis: 1(a)

First Use Date: 1994-01-21

First Use in Commerce Date: 2000-05-11

ADDITIONAL INFORMATION

Color(s) Claimed: The color(s) white, red, yellow, black and green is/are claimed as a feature of the mark.

Description of Mark: The mark consists of the picture of a king and the words EL REY.

Design Search Code(s):

02.01.01 - Busts of men; Heads of men; Men, heads, portraiture, busts

02.01.03 - Crowns, men wearing; Kings; Men wearing crowns or other symbols of royalty, including kings, princes and jacks; Princes; Royalty (men)

02.01.31 - Men, stylized, including men depicted in caricature form

26.09.20 - Squares inside one another

26.09.21 - Squares that are completely or partially shaded

26.09.25 - Squares with curved sides

26.11.02 - Plain single line rectangles; Rectangles (single line)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-04-20 - Notice Of Design Search Code Mailed

2006-04-19 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Katrin Lewertoff (Attorney of record)

KATRIN LEWERTOFF AND PETER J. TOREN

787 7TH AVE

NEW YORK, NY 10019-6018

Phone Number: 212 839 7366

Fax Number: 212 839 5599

Domestic Representative

Katrin Lewertoff and Peter J. Toren

Phone Number: 212 839 7366

Fax Number: 212 839 5599

Exhibit C

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-05-01 12:33:26 ET

Serial Number: 78860723

Registration Number: (NOT AVAILABLE)

Mark

EL REY

(words only): EL REY

Standard Character claim: Yes

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2006-04-24

Filing Date: 2006-04-13

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 042 -New Application Processing

Date In Location: 2006-04-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Fabrice de Especies y Productos EL REY S.A.

Address:

Fabrice de Especies y Productos EL REY S.A.
Calle 40 Sur No. 68D - 55

7700500 Bogota
Colombia

Legal Entity Type: Corporation

State or Country of Incorporation: Colombia

GOODS AND/OR SERVICES

International Class: 030

Class Status: Active

Spices, condiments, seasonings and seasoning pastes

Basis: 1(a), 44(e)

First Use Date: 1940-06-30

First Use in Commerce Date: 2000-05-11

ADDITIONAL INFORMATION

Foreign Registration Number: 94250

Foreign Registration Date: 1978-06-26

Country: Colombia

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-04-25 - TEAS Preliminary Amendment Received

2006-04-19 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

Katrin Lewertoff (Attorney of record)

KATRIN LEWERTOFF AND PETER J. TOREN

787 7TH AVE

NEW YORK, NY 10019-6018

Phone Number: 212 839 7366

Fax Number: 212 839 5599

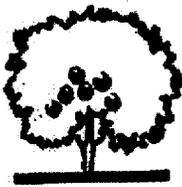
Domestic Representative

Katrin Lewertoff and Peter J. Toren

Phone Number: 212 839 7366

Fax Number: 212 839 5599

Exhibit D



PARADISE Distributors Inc.

19-63 Hazen Street-East Elmhurst, NY 11370

Tel. (718) 626-8828 Fax (718) 626-8834

Email: Voparadise@aol.com

Invoice

Invoice Number: 16662
Ship Date: May 12, 2000
Page: 1

Sold To:

Morristown Mini Market
66 Morris St
Morristown, NJ 07960

Ship To:

7/10

Customer ID		P.O. #	Sales Rep. ID	Shipping Method	Payment Terms
16009		4	2-006-PS	Courier	C. O. D.
Qty	Code #	Description		Unit Price	Amount
5.00	25048	Milo Colombiano 12/400 gr		45.00	225.00
100.00	48003U	Molinillos de madera = 1 unidad		1.00	100.00
2.00	29001U	Caja Marshall M-50 1/100		37.70	75.40
1.00	27050	Tostadas Susanita 90/4.5 oz		71.35	71.35
2.00	80001	Varela Jabon Coco 25/300gr		22.00	44.00
2.00	80002	Varela Barrigon Azul 25/300gr		14.50	29.00
2.00	80003	Varela Puro Azul 25/300gr		18.50	37.00
1.00	25012	Leche Klim Tradicional 24/400gr		73.25	73.25
1.00	25045	Leche Klim Tradicional 12/1000		88.90	88.90
1.00	25053	Nestle Leche Klim 1-2-3 24/400		83.43	83.43
1.00	27013	Gelatina sin sabor 48/30gr		53.00	53.00
12.00	43001U	Chocolatera #231 = 1 unidad		3.79	45.48
1.00	26058	Alifios El Rey 36/12 Dis		59.00	59.00
5.00	23002	Del Valle Panela 18/24 oz		27.00	135.00
1.00	23020	Cocoa Universal C 20/500gr		17.50	17.50
1.00	22038	Frugal Brevas 12/790g		27.00	27.00
1.00	24043	Imperio Frijol Rojo 20/24 oz		45.00	45.00
1.00	31006	Marañon Concentrado 1/16.9 oz		39.80	39.80
1.00		Colmaza Empanadas 25/22 lb		51.00	51.00
1.00		Arepina Quaker 25/200g		32.00	32.00

[Handwritten Signature]

7/10

ALL BOUNCE CHECKS ARE SUBJECT TO \$25.00 FEE. NO RETURNS OR ALLOWANCES ALLOWED OVER 30 DAYS FROM INVOICE PURCHASE. ALL SHORTAGES MUST BE NOTICED AT TIME OF DELIVERY

1332.91

TOTAL CASE

PLEASE REMIT THIS AMOUNT

Phone: (201) 857-3206