

# Merchant & Gould

An Intellectual Property Law Firm

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A Professional Corporation

Nash-Finch Company, )  
Opposer, )  
v. ) Opposition No. \_\_\_\_\_  
Big Y Foods, )  
Applicant. )

## TTAB

Mark: ONLY THE BEST FOR YOUR FAMILY FROM OURS

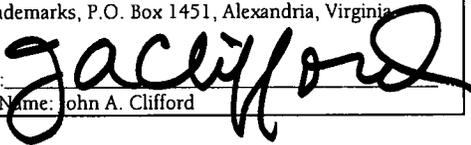
Serial No.: 78/784,542

Docket Number: 01183.0139USTB

Due Date: December 27, 2006

**CERTIFICATE UNDER 37 CFR 1.8:**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on December 27, 2006.

By:   
Name: John A. Clifford

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R.
- Notice of Opposition (1 Original and 1 Copy)
- Check in the amount of \$300.00 to cover Filing Fee.
- Other: 2 Certified Copies of Registration No. 2,263,186 and Registration No. 2,690,200.

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

01/04/2007 SWILSON1 00000001 78784542

01 FC:6402

300.00 OP

By:   
Name: John A. Clifford  
Reg. No. 30,247

12-29-2006  
U.S. Patent & TMO/TM Mail Rcpt Dt. #34

(CONTESTED MATTER)



cocoanut, canned tuna fish, canned salmon, canned soup, canned corn and beans, noodles, spaghetti, macaroni, tea, spices, mustard, vinegar, catsup, cocoa, evaporated milk, olives, pickles, jam, apple butter, peanut butter, fruit preserves, marmalade, cane" (International Classes 29 and 30). Opposer is also the owner of U.S. Trademark Registration No. 1,704,384 which issued on the Principal Register on July 28, 1992 for OUR FAMILY FOODS for "retail grocery store services" (International Class 42) and U.S. Registration No. 2,690,200 which issued on the Principal Register on February 25, 2003 for OUR FAMILY for dishwashing detergent, laundry detergent, laundry bleach (International Class 6) aluminum foil (International Class. 16) paper towels, paper napkins, bath tissue, and facial tissue (International Class. 21) paper plates (International Class 29) meals consisting of meat, fish or poultry in ready to cook portions, peanut butter, pickles, canned fruit and canned vegetables (International Class. 30) macaroni, noodles, spaghetti, rice, coffee, spaghetti sauce, tea, pretzels, nacho chips, cocoa, catsup, mustard (International Class 31) pet food and unpopped popcorn (International Class 32) vegetable juice, fruit juice and fruit drink. Opposer also owns U.S. Trademark Registration No. 2,263,186 issued July 20, 1999 for OUR BEST FOR YOU for grocery store services (International Class 35) based on the first use in June of 1998.

3. Opposer's Registration No. 369,014 issued 63 years prior to the filing of Applicant's application in the United States. Opposer's use of its marks vastly predated any use by Applicant of its mark opposed herein.
4. Pursuant to 37 C.F.R. § 2.122(d), Opposer hereby pleads ownership of its registration number 2,263,186 for the mark OUR BEST FOR YOU and registration number 2,690,200 for the mark OUR FAMILY and places two certified copies of each registration, showing both the current status of and current title to the registrations into evidence. Opposer also asserts rights based on its other registrations.

5. Opposer first adopted the mark OUR FAMILY in 1904 and has continuously expanded use of the mark since then, Opposer now has over one thousand different products under its OUR FAMILY mark, and uses its mark on a wide variety of grocery items, now sold in virtually every aisle of the typical grocery store. Opposer adopted the mark OUR FAMILY FOODS as a service mark for grocery store services in 1992 and has the benefit of constructive nationwide use as early as July 1990. Opposer's mark OUR FAMILY represents a full line of grocery products made for and sold by Opposer. Opposer is one of the largest grocery wholesalers in the United States. Opposer's OUR BEST FOR YOU mark is a slogan used in conjunction with grocery store services to promote and advertise opposer, and the services of opposer.
6. Opposer's trademarks, OUR FAMILY, OUR BEST FOR YOU and OUR FAMILY FOODS, have been in continuous use, have been widely promoted by Opposer, and the marks have developed and represent substantial goodwill inuring to the benefit of Opposer. Opposer's marks are arbitrary and fanciful, with trademark significance to consumers and potential consumers. Opposer's marks are famous and well known with aggregate sales under the marks in the neighborhood of many hundreds of millions of dollars.
7. Applicant's mark is confusingly similar to Opposer's marks. The marks have an almost identical appearance, confusingly similar meaning, and the goods and services of the parties are very closely related and both would be marketed, sold, and used by the same or closely related consumers.
8. Applicant's services would appear to customers and potential customers to be a line extension of Opposer's product line. Applicant's services overlap with and compete directly with Opposer's services and are sold to the same class of customers in the same channel of trade. Applicant's services are closely related to Opposer's goods and services.

9. Applicant's mark is deceptively misdescriptive, is deceptive, and is likely to deceive customers into thinking the goods of Applicant are from OUR FAMILY when they are not. Applicant has used the same words as found in Opposer's OUR BEST FOR YOU mark only in a different order.
10. The use and registration by Applicant of the mark ONLY THE BEST FOR YOUR FAMILY FROM OURS for Applicant's services is likely to cause confusion or to cause mistake in the wholesale and retail trade, and among consumers and potential consumers, with Opposer's previously used and duly registered marks, OUR FAMILY, OUR BEST FOR YOU, and OUR FAMILY FOODS, again resulting in damage to Opposer.
11. Because of the related nature of the services, and the confusing similarity of the marks, use and registration of the term ONLY THE BEST FOR YOUR FAMILY FROM OURS by Applicant is likely to cause confusion, mistake, or deception that Applicant's services are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.
12. Use and registration By Applicant of the mark ONLY THE BEST FOR YOUR FAMILY FROM OURS causes dilution, weakens and diminishes the distinctive quality of Opposer's famous and well-known marks causing additional damage to Opposer, under section 43 (c) of the Trademark Act.
13. Registration of the mark show in Application Serial No. 78/784,542 will result in damage to Opposer under the provisions of §2 (a) § 2 (d) and §43 (c) of the U.S. Trademark Act, 15 U.S.C § 1052, 1125 pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that the registration of the term ONLY THE BEST FROM FOR YOUR FAMILY FROM OURS set forth therein be refused.

Please direct all correspondence to the attention of:

John A. Clifford  
Merchant & Gould P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910  
612-336-4616  
Fax: 612-332-9081

Opposer hereby appoints Charles E. Golla, Reg. No. 26,896; Brian H. Batzli, Reg. No. 32,960; John L. Beard, Reg. No. 27,612; John A. Clifford, Reg. No. 30,247; Gregory C. Golla; John D. Gould, Reg. No. 18,223; Scott W. Johnston, Reg. No. 39,721; D. Randall King, Andrew S. Ehard, Chris Schulte, and Danielle Mattessich as its attorneys with the full power to represent the Opposer in connection with this proceeding.

Please charge any fees or credit any overpayment to Deposit Account No. 13-2725 of Opposer's counsel noted above.

Respectfully submitted,

Nash-Finch Company

By its attorneys,

Date:

27 Dec 2006

  
\_\_\_\_\_  
John A. Clifford  
MERCHANT & GOULD P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910  
612.336.4616

1533393



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**October 26, 2006**

**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,690,200 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *February 25, 2003***

**SAID RECORDS SHOW TITLE TO BE IN:**

***NASH-FINCH COMPANY  
A DE CORP***

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**

**T. LAWRENCE  
Certifying Officer**



**Int. Cls.: 3, 6, 16, 21, 29, 30, 31 and 32**

**Prior U.S. Cls.: 1, 2, 4, 5, 6, 12, 13, 14, 22, 23, 25, 29,  
30, 33, 37, 38, 40, 45, 46, 48, 50, 51 and 52**

**Reg. No. 2,690,200**

**United States Patent and Trademark Office**

**Registered Feb. 25, 2003**

**TRADEMARK  
PRINCIPAL REGISTER**

**OUR FAMILY**

NASH-FINCH COMPANY (DELAWARE COR-  
PORATION)  
7600 FRANCE AVENUE SOUTH  
MINNEAPOLIS, MN 55453

FOR: DISHWASHING DETERGENT, LAUNDRY  
DETERGENT, LAUNDRY BLEACH , IN CLASS 3  
(U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 6-0-1995; IN COMMERCE 6-0-1995.

FOR: ALUMINUM FOIL, IN CLASS 6 (U.S. CLS. 2,  
12, 13, 14, 23, 25 AND 50).

FIRST USE 1-0-1994; IN COMMERCE 1-0-1994.

FOR: PAPER TOWELS, PAPER NAPKINS, BATH  
TISSUE, AND FACIAL TISSUE, IN CLASS 16 (U.S.  
CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 3-0-1984; IN COMMERCE 3-0-1984.

FOR: PAPER PLATES, IN CLASS 21 (U.S. CLS. 2,  
13, 23, 29, 30, 33, 40 AND 50).

FIRST USE 1-31-1992; IN COMMERCE 1-31-1992.

FOR: MEALS CONSISTING OF MEAT, FISH OR  
POULTRY IN READY TO COOK PORTIONS, PEA-

NUT BUTTER, PICKLES, CANNED FRUIT AND  
CANNED VEGETABLES, IN CLASS 29 (U.S. CL. 46).

FIRST USE 1-0-1904; IN COMMERCE 1-0-1904.

FOR: MACARONI, NOODLES, SPAGHETTI,  
RICE, COFFEE, SPAGHETTI SAUCE, TEA, PRE-  
TZELS, NACHO CHIPS, COCOA, CATSUP, MUS-  
TARD, IN CLASS 30 (U.S. CL. 46).

FIRST USE 1-0-1962; IN COMMERCE 1-0-1962.

FOR: PET FOOD AND UNPOPPED POPCORN, IN  
CLASS 31 (U.S. CLS. 1 AND 46).

FIRST USE 10-0-1966; IN COMMERCE 10-0-1966.

FOR: VEGETABLE JUICE, FRUIT JUICE AND  
FRUIT DRINK, IN CLASS 32 (U.S. CLS. 45, 46 AND  
48).

FIRST USE 1-0-1958; IN COMMERCE 1-0-1958.

OWNER OF U.S. REG. NOS. 369,014 AND 1,704,384.

SER. NO. 76-326,349, FILED 10-16-2001.

PATRICK JENNINGS, EXAMINING ATTORNEY

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**REGISTERED FOR A TERM OF 10 YEARS FROM *July 20, 1999***

**SECTION 8 & 15**

**SAID RECORDS SHOW TITLE TO BE IN:**

***NASH-FINCH COMPANY***

***A DE COMPANY***

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
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**T. LAWRENCE  
Certifying Officer**



**Int. Cl.: 35**

**Prior U.S. Cls.: 100, 101 and 102**

**Reg. No. 2,263,186**

**United States Patent and Trademark Office**

**Registered July 20, 1999**

**SERVICE MARK  
PRINCIPAL REGISTER**

**OUR BEST FOR YOU**

**NASH-FINCH COMPANY (DELAWARE COM-  
PANY)  
7600 FRANCE AVENUE SOUTH  
MINNEAPOLIS, MN 55440**

**FIRST USE 6-9-1998; IN COMMERCE  
6-9-1998.**

**SER. NO. 75-527,365, FILED 7-29-1998.**

**FOR: RETAIL GROCERY STORE SERVICES,  
IN CLASS 35 (U.S. CLS. 100, 101 AND 102).**

**STEVEN R. FINE, EXAMINING ATTORNEY**

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**T. LAWRENCE  
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**Prior U.S. Cls.: 1, 2, 4, 5, 6, 12, 13, 14, 22, 23, 25, 29, 30, 33, 37, 38, 40, 45, 46, 48, 50, 51 and 52**

**Reg. No. 2,690,200**

**Registered Feb. 25, 2003**

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