

ESTTA Tracking number: **ESTTA156598**

Filing date: **08/14/2007**

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	Royal Crown Company, Inc.
Granted to Date of previous extension	08/15/2007
Address	900 King Street Rye Brook, NY 10573 UNITED STATES
Attorney information	Barbara A. Solomon Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES bsolomon@frosszelnick.com Phone:212-813-5900

Applicant Information

Application No	78580598	Publication date	04/17/2007
Opposition Filing Date	08/14/2007	Opposition Period Ends	08/15/2007
Applicant	The Coca-Cola Company One Coca-Cola Plaza Atlanta, GA 30313 UNITED STATES		

Goods/Services Affected by Opposition

Class 032. First Use: 2005/06/13 First Use In Commerce: 2005/06/13
All goods and services in the class are opposed, namely: Beverages, namely soft drinks; syrups and concentrates for the making of the same

Grounds for Opposition

Other	Trademark Act section 2(e); Fraud
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Attachments	78580598 NOTICE OF OPPOSITION.pdf (7 pages)(1663745 bytes)
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Signature	/Barbara A. Solomon/
Name	Barbara A. Solomon
Date	08/14/2007

3. Opposer and its predecessors have continued to lead in innovations in the diet soft drink category by introducing unique flavor extensions. In addition, Diet Rite Cola was the first diet drink to be salt/sodium free; was the first sodium/caffeine and calorie-free soft drink made with Nutrasweet; and pioneered the use of SLENDA in 2000 to become the first major aspartame-free diet cola in the United States.

4. Since at least 2003 Opposer has been continuously using the term ZERO in connection with its diet beverages. The term ZERO is descriptive of characteristics of the product, namely that the product has zero carbs and calories.

5. On February 28, 2005, Opposer filed Application Serial No. 78/576,257 to register the mark DIET RITE PURE ZERO for "soft drinks and syrups used in the preparation thereof" in International Class 32 based on an intent to use.

6. On August 9, 2005, a non-final office action issued requiring Opposer to disclaim zero because it is descriptive of one or more features of Opposer's product. The office action also identified as a possible bar to registration the mark herein opposed. Subsequently, on August 2, 2006, the application was suspended.

7. On March 7, 2005, Opposer filed Application Serial No. 78/581,917 to register the mark PURE ZERO for "soft drinks and syrups and concentrates used in the preparation thereof" in International Class 32 based on an intent to use.

8. On August 9, 2005, a non-final office action issued in connection with Opposer's PURE ZERO application requiring Opposer to disclaim the term ZERO because it merely describes one or more features of the beverage product, namely that the product has zero calories or zero carbohydrates or zero sugar. The PTO also suspended action on the application on the grounds that the mark herein opposed was filed prior to the filing date of the PURE ZERO

application and should the COCA-COLA ZERO mark register, registration of Opposer's PURE ZERO mark could be refused on the grounds of likelihood of confusion.

9. Upon information and belief, the only basis for citing the opposed application against Opposer's DIET RITE PURE ZERO and PURE ZERO marks is the fact that Opposer's pending application and Applicant's opposed application both use the term ZERO to describe characteristics of their soda.

10. Opposer has disclaimed the term ZERO in both its DIET RITE PURE ZERO and PURE ZERO applications and is not seeking any exclusive rights in the term ZERO when used in connection with soft drinks that have zero calories, zero sugar or zero carbohydrates.

11. Upon information and belief, Opposer is not the only entity that uses the term ZERO to describe characteristics of soft drinks. Rather, the term ZERO is commonly used in the trade to inform consumers that the soft drink product at issue has no calories, no carbohydrates and/or no sugar.

12. Upon information and belief, Applicant The Coca-Cola Company ("Applicant") is a Delaware corporation located and doing business at One Coca-Cola Plaza, Atlanta, Georgia 30313.

13. On March 4, 2005, Applicant filed Application Serial No. 78/580,598 to register the mark COCA-COLA ZERO for "beverages, namely soft drinks; syrups and concentrates for the making of the same" in International Class 32. Applicant originally filed its application on the basis of an intent to use but later amended to allege use since June 13, 2005. At the time Applicant filed the application herein opposed, the term ZERO was being used in the beverage industry to describe a characteristic of diet soft drinks namely zero calories and zero carbs. In fact, Opposer had been using ZERO on packaging for Diet Rite for more than one year before Applicant filed the application herein opposed for just this purpose.

14. On March 30, 2005, the PTO issued an office action noting that ZERO is merely descriptive of a feature of Applicant's goods, namely calorie or carbohydrate content and requiring Applicant to disclaim the descriptive wording. Since that time, the PTO has issued similar findings in connection with several other applications filed by Applicant including COCA-COLA CHERRY ZERO, CHERRY COKE ZERO, COCA-COLA VANILLA ZERO, VANILLA COKE ZERO, CHERRY COCA-COLA ZERO, COKE CHERRY ZERO and PIBB ZERO.

15. In a submission dated June 20, 2006, Applicant requested reconsideration of the disclaimer requirement. The PTO, find the arguments for registration "unpersuasive," continued its refusal to register on the basis that ZERO is descriptive (and is understood to mean that soft drinks sold under such mark have no calories or carbohydrates) and must be disclaimed.

16. On January 25, 2007, Applicant submitted arguments to the PTO claiming that the term ZERO had acquired distinctiveness under Section 2(f) and that its primary meaning was to identify source, not to describe characteristics of Applicant's zero calorie soft drink. At the time the claim of acquired distinctiveness was submitted, Opposer had been using ZERO or PURE ZERO continuously since 2003.

FIRST CLAIM FOR RELIEF UNDER SECTION 2(e)

17. Opposer repeats and realleges paragraphs 1 through 16 above as is fully set forth herein.

18. Applicant's claim that the term ZERO is registrable under Section 2(f) of the Lanham Act is inconsistent with the use by Opposer and others in the beverage industry to describe fundamental characteristics of their beverage products. In view of such use, the term ZERO cannot be source-indicating as denoting goods emanating substantially exclusively from Applicant.

19. In arguing that the term ZERO has acquired distinctiveness the evidence submitted by Applicant refers repeatedly to the “no-cal,” “no-sugar,” “no-calorie,” or zero-calorie” attributes of COCA-COLA ZERO showing that as used by Applicant, the term ZERO is merely descriptive.

20. Registration to Applicant of the mark COCA-COLA ZERO without a disclaimer of the word ZERO is currently harming Opposer since Applicant’s opposed application has prevented Opposer from obtaining registration of its DIET RITE ZERO and PURE ZERO marks. Further, registration to Applicant of the mark COCA-COLA ZERO without a disclaimer of the term ZERO will continue to harm Opposer by giving Applicant presumptive exclusivity in and to a term widely in use by others, including the Opposer, thereby impairing Opposer’s ability to use this common term in connection with beverages.

21. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Serial No. 78/580,598 for the mark COCA-COLA ZERO.

COUNT TWO – FRAUD

22. Opposer repeats and realleges paragraphs 1 through 21 above as if fully set forth herein.

23. In connection with its claim that the term ZERO need not be disclaimed and had acquired distinctiveness under Section 2(f) of the Lanham Act 15 U.S.C. §1052(f), Applicant was required to prove “substantially exclusive and continuous use” of ZERO as a mark for the “five years before the date on which the claim of distinctiveness was made.”

24. As of the date Applicant made the claim of acquired distinctiveness, January 25, 2007, Opposer had been using the term ZERO to describe the fact that its diet soda had zero carbs and zero calories since 2003. As such, Applicant could not have shown and cannot prove “substantially exclusive” use of ZERO for the five years preceding its claim of distinctiveness.

In addition, on information and belief, third parties in the beverage industry were making use of the term ZERO to describe fundamental characteristics of their diet sodas during the five year preceding Applicant's claim of acquired distinctiveness.

25. As a result of the use by Opposer and third parties of the term ZERO prior to January 25, 2007, Applicant could not have shown proof of substantially exclusive use of the term ZERO nor that the term has become vested with secondary meaning and has become distinctive exclusively of Applicant's products.

26. Applicant's claim of substantially exclusive use of ZERO in connection with its products for the five years preceding January 2007 was false and was known to be false at the time it was made and was made for the purpose of inducing the Patent and Trademark Office to approve publication of the mark herein opposed without acquiring a disclaimer of the term ZERO.

27. Applicant's statements to the Patent and Trademark Office concerning its exclusive rights in and use of the term ZERO were false and were known to be false when made.

28. Applicant's conduct constitutes fraud on the Patent and Trademark Office.

29. As a result of Applicant's false statements, Applicant's mark has been passed to publication without a disclaimer of the word ZERO. Registration to Applicant of the mark COCA-COLA ZERO without a disclaimer of the word ZERO is harming and will continue to harm Opposer.

30. By reason of the foregoing, Opposer is likely to be harmed by registration of Applicant Serial No. 78/580,598 for the mark COCA-COLA ZERO.

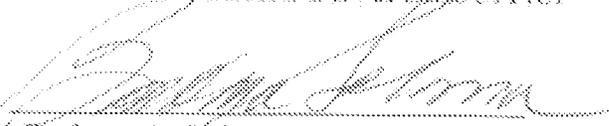
WHEREFORE, it is respectfully requested that Opposer's opposition be sustained and that the registration sought by Applicant in Application Serial No. 78/580,589 for the mark COCA-COLA ZERO be denied absent the entry of a disclaimer of the descriptive term ZERO.

The Trademark Trial and Appeal Board is hereby authorized to charge the opposition filing fee of \$300 to Opposer's counsel's deposit Account Number 23-0825-0576900.

Dated: New York, New York
August 14, 2007

FROSS ZELNICK LEHRMAN & ZISSU P.C.

By:


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