

ESTTA Tracking number: **ESTTA319137**

Filing date: **11/25/2009**

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	Contessa Premium Foods, Inc.
Granted to Date of previous extension	11/25/2009
Address	222 West Sixth Street8th Floor San Pedro, CA 90731-3316 UNITED STATES

Attorney information	J.D. Harriman II DLA Piper LLP (US) 1999 Avenue of the Stars Fourth Floor Los Angeles, CA 90067 UNITED STATES karl.hamel@dlapiper.com, krista.sirola@dlapiper.com Phone:310 595-3023
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**Applicant Information**

Application No	77526128	Publication date	07/28/2009
Opposition Filing Date	11/25/2009	Opposition Period Ends	11/25/2009
Applicant	Ina Garten LLC 46 Newtown Lane East Hampton, NY 11937 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 029. All goods and services in the class are opposed, namely: Fruit-based snack foods; potato-based snack foods; vegetable-based snack foods; nut and seed-based snack bars; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; processed nuts; dips; dairy-based snack foods excluding ice cream, ice milk and frozen yogurt</p>
<p>Class 030. All goods and services in the class are opposed, namely: Grain-based snack foods; grain-based chips; grain-based food bars also containing dried fruits and nuts; granola snacks; snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn; snack cakes; cookies; crackers; bakery goods; bakery desserts; dessert puddings; brownies; candy; salad dressings; sauces; marinades; spice rubs; flavor enhancers used in food products; frozen appetizers consisting primarily of dough</p>

**Grounds for Opposition**

Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2214744	Application Date	02/13/1998
Registration Date	12/29/1998	Foreign Priority Date	NONE
Word Mark	CONTESSA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1984/01/00 First Use In Commerce: 1984/01/00 Frozen seafood and frozen prepared dinners, entrees and side dishes consisting primarily of seafood, poultry, meat and/or vegetables Class 030. First use: First Use: 1984/01/00 First Use In Commerce: 1984/01/00 Frozen pizza and frozen prepared dinners, entrees and side dishes consisting primarily of pasta and grains		

U.S. Registration No.	2077457	Application Date	07/12/1996
Registration Date	07/08/1997	Foreign Priority Date	NONE
Word Mark	CONTESSA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1993/11/00 First Use In Commerce: 1993/11/00 [ frozen poultry and ] seafood; and frozen prepared dinners, entrees and side dish, consisting primarily of poultry, seafood and vegetables		

U.S. Registration No.	1903693	Application Date	03/15/1993
Registration Date	07/04/1995	Foreign Priority Date	NONE
Word Mark	CONTESSA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1984/01/01 First Use In Commerce: 1984/01/04 frozen [poultry and] seafood; and frozen prepared dinners, entrees and side dishes, consisting primarily of poultry, seafood and vegetables		

Related Proceedings	92049013 91190791
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/J.D. Harriman II/
Name	J.D. Harriman II
Date	11/25/2009

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

CONTESSA PREMIUM FOODS, INC.	)	
	)	
Opposer,	)	<b>OPPOSITION No.</b> _____
	)	
v.	)	
INA GARTEN, LLC	)	<b><u>NOTICE OF OPPOSITION</u></b>
	)	
Applicant.	)	
	)	
	)	
	)	

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**Trademark:** BAREFOOT CONTESSA  
**Serial No.:** 77/526,128  
**Int'l Class:** 29 and 30

As grounds for Opposition, Contessa Premium Foods ("Contessa") alleges as follows:

1. Opposer Contessa is a corporation with its principal place of business at 222 West Sixth Street, San Pedro, California 90731.
  
2. Contessa believes that it will be damaged by registration of the trademark BAREFOOT CONTESSA for the goods identified in Application Serial No. 77526128 (the "Application"), in Classes 29 and 30, filed by Ina Garten (hereafter "Applicant").<sup>1</sup> The Application was filed on July 18, 2008, under Section 1(b) of the Lanham Act, and alleges a bona fide intent to use the BAREFOOT CONTESSA mark in connection with "fruit-based snack foods; potato-based snack foods; vegetable-based snack foods; nut and seed-based snack bars; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; processed nuts; dips; dairy-based snack foods excluding ice cream, ice milk and frozen yogurt" in International

Class 29 and “grain-based snack foods; grain-based chips; grain-based food bars also containing dried fruits and nuts; granola snacks; snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn; snack cakes; cookies; crackers; bakery goods; bakery desserts; dessert puddings; brownies; candy; salad dressings; sauces; marinades; spice rubs; flavor enhancers used in food products; frozen appetizers consisting primarily of dough” in International Class 30.

3. The Application was filed on an intent-to-use basis. As such, the Application states that Applicant has a bona fide intent to use the BAREFOOT CONTESSA mark in commerce in connection with the identified goods.

4. Applicant’s Application is not entitled to registration because Applicant has committed fraud in the prosecution of the Application. Based on the information and knowledge available to Contessa, Applicant did not have a bona fide intent to use the BAREFOOT CONTESSA mark in connection with fruit-based snack foods; potato-based snack foods; vegetable-based snack foods; nut and seed-based snack bars; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; processed nuts; dips; dairy-based snack foods excluding ice cream, ice milk and frozen yogurt; grain-based snack foods; grain-based chips; grain-based food bars also containing dried fruits and nuts; granola snacks; snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn; snack cakes; cookies; crackers; bakery goods; bakery desserts; dessert puddings; brownies; candy; salad dressings; sauces; marinades; spice rubs; flavor enhancers used in food products; or frozen appetizers consisting primarily of dough at the time it filed the Application.

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<sup>1</sup> Contessa notes that it timely filed a request for extension of time to oppose the Application which was granted to November 25, 2009.

5. Contessa alleges upon information and belief that Applicant or its agent made material misrepresentation to the United States Patent and Trademark Office (“USPTO”) when it stated it had a bona fide intent to use the BAREFOOT CONTESSA mark in commerce in connection with the identified goods.

6. Upon information and belief, Contessa alleges that Applicant knew that the statement was false at the time it was made.

7. Upon information and belief, Contessa alleges that Applicant made such material misrepresentations to the USPTO with the intent to induce authorized agents of the USPTO to grant the Application and that, reasonably relying upon the truth of these material misrepresentations, the USPTO did, in fact, allow the Application to proceed to publication.

8. Contessa is a leading producer of fine quality foods and food products that has been in business since 1984. Contessa’s food products are served in fine-dining restaurants and in many of the major hotel chains nationwide and are available in retail supermarkets, warehouse club stores, and U.S. military bases nationwide. Since 1984, Contessa has been using the trademark CONTESSA in connection with a variety of goods, and has received extensive media coverage. Contessa has developed common law rights in the CONTESSA mark and also owns several federal trademark registrations for the CONTESSA mark (collectively, the “CONTESSA Mark”), including those listed below:

<b>Mark</b>	<b>Reg. No.</b>	<b>Goods/Services</b>
CONTESSA	2/214,744	Frozen seafood and frozen prepared dinners, entrees and side dishes consisting primarily of seafood, poultry, meat and/or vegetables (Class 29); and frozen pizza and frozen prepared dinners, entrees and side dishes consisting primarily of pasta and grains (Class 30).

CONTESSA (Stylized)	2/077,457	Frozen poultry and seafood; and frozen prepared dinners, entrees and side dish, consisting primarily of poultry, seafood and vegetables (Class 29).
CONTESSA	1/903,693	Frozen poultry and seafood; and frozen prepared dinners, entrees and side dishes, consisting primarily of poultry, seafood and vegetables (Class 29).

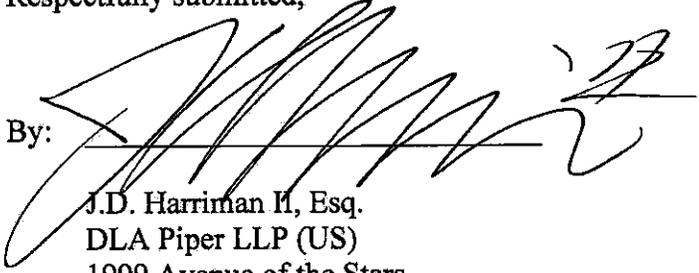
9. Applicant has averred an intent to use the BAREFOOT CONTESSA mark in connection with certain goods in the United States. Applicant's intent to use the BAREFOOT CONTESSA mark indicates a likelihood of dilution by blurring by impairing the distinctiveness of Contessa's famous mark CONTESSA, all causing the irreparable injury and damage to Contessa.

10. If Applicant's Application were granted registration, dilution, damage and/or other injury to Contessa would result.

WHEREFORE, Contessa prays that registration of the BAREFOOT CONTESSA mark covered by Application Serial No. 77/526,128 be denied.

Respectfully submitted,

Dated: November 25, 2009

By: 

J.D. Harriman II, Esq.  
DLA Piper LLP (US)  
1999 Avenue of the Stars  
Fourth Floor  
Los Angeles, California 90067  
(310) 595-3023

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the following document:

**NOTICE OF OPPOSITION**

was served on Applicant Ina Garten, LLC, by depositing the same in the United States mail, First Class Mail, postage prepaid, addressed to Applicant's counsel of record as follows:

Nancy DiConza  
Fross Zelnick Lehrman & Zissu, P.C.  
866 United Nations Plaza  
New York, New York 10017

this 25th day of November 2009.

  
June L. Etheridge