

ESTTA Tracking number: **ESTTA352518**

Filing date: **06/12/2010**

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	Sensible Foods LLC
Granted to Date of previous extension	06/16/2010
Address	P.O. Box 750832 Petaluma, CA 94975 UNITED STATES

Correspondence information	Sensible Foods LLC P.O. Box 750832 Petaluma, CA 94975 UNITED STATES jr@sensiblefoods.com, db@sensiblefoods.com Phone:4156061689
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Applicant Information

Application No	77833401	Publication date	02/16/2010
Opposition Filing Date	06/12/2010	Opposition Period Ends	06/16/2010
Applicant	WORLD GOURMET MARKETING LLC 49 Lincoln Road Butler, NJ 07405 UNITED STATES		

Goods/Services Affected by Opposition

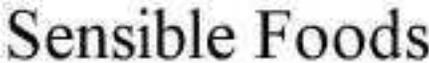
<p>Class 029. First Use: 2003/07/01 First Use In Commerce: 2003/07/01 All goods and services in the class are opposed, namely: Protein-based nutrient-dense snack bars; soy-based food bars; soy-based snack foods; potato-based snack foods; snack food dips; potato chips; soy chips; soy nuts; vegetable chips; vegetable-based snack foods; pellet snacks, namely, hot air expanded pellet snacks consisting primarily of soy, potato or vegetables</p>
<p>Class 030. First Use: 2003/07/01 First Use In Commerce: 2003/07/01 All goods and services in the class are opposed, namely: Crackers; cookies; corn chips; corn-based snack foods; tortilla chips; bakery goods; ready to eat, cereal derived food bars; granola-based snack bars; chocolate-based ready to eat food bars; pita chips; grain-based snack foods; grain-based chips; rice-based snack foods; pellet snacks, namely, hot air expanded pellet snacks consisting primarily of grains; puffed corn snacks; cheese flavored snacks, namely, cheese curls; cheese flavored puffed corn snacks</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	progressive encroachment

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3252283	Application Date	10/14/2004
Registration Date	06/12/2007	Foreign Priority Date	NONE
Word Mark	SENSIBLE FOODS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2006/10/26 First Use In Commerce: 2006/10/26 Magazines, leaflets, brochures, and newsletters featuring food, health and nutrition; catalogs featuring food, snacks, nutritional supplements, and general nutritional products		

U.S. Registration No.	3024683	Application Date	04/15/2004
Registration Date	12/06/2005	Foreign Priority Date	NONE
Word Mark	SENSIBLE FOODS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1996/12/17 First Use In Commerce: 1997/04/08 Dried Fruits, Dried Vegetables		

U.S. Registration No.	2861273	Application Date	05/01/2002
Registration Date	07/06/2004	Foreign Priority Date	NONE
Word Mark	SENSIBLE FOODS		

Design Mark	
Description of Mark	The design portion of the mark depicts an ear of corn, a strawberry, two blueberries, a mango, a pineapple and a cherry.
Goods/Services	Class 029. First use: First Use: 1996/12/17 First Use In Commerce: 1997/04/08 Dried fruit snacks

U.S. Registration No.	3383121	Application Date	03/02/2006
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	SNACKS MADE SENSIBLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2006/02/01 First Use In Commerce: 2006/06/01 Dehydrated fruit snacks; Dried fruit mixes; Dried fruits; Dried soybeans; Dried vegetables; Fruit-based snack food; Vegetable-based snack foods		

U.S. Registration No.	3793526	Application Date	05/11/2007
Registration Date	05/25/2010	Foreign Priority Date	NONE
Word Mark	SENSIBLE BABY		

Design Mark	Sensible Baby
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 2007/05/11 First Use In Commerce: 2010/03/02 Dried fruits; dried vegetables; processed fruits; processed vegetables

Attachments	78499792#TMSN.jpeg (1 page)(bytes) 78402771#TMSN.jpeg (1 page)(bytes) 78125557#TMSN.gif (1 page)(bytes) 78827662#TMSN.jpeg (1 page)(bytes) 77178357#TMSN.jpeg (1 page)(bytes) Opposition SFoods.pdf (11 pages)(431402 bytes)
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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	/jcr4144/
Name	Sensible Foods LLC
Date	06/12/2010

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

In the matter of Application Serial Nos. 77/833,401 and 77/833,386 for the mark
“SENSIBLE PORTIONS” Published in the Official Gazette of February 16, 2010.

Applicant : World Gourmet Marketing, LLC
Assignee : FCC, LLC DBA First Capital
Mark : SENSIBLE PORTIONS
Serial No. : 77/833,401 & 77/833,386
Filed : September 23, 2009

SENSIBLE FOODS, LLC)
)
Opposer)
)
v.)
)
WORLD GOURMET MARKETING, LLC &)
WORLD GOURMET ACQUISITION)
Applicants and Assignors)
)
FCC, LLC, DBA First Capital)
)
Assignee)

Opposition No. [TBD]

NOTICE OF OPPOSITION

As a preliminary matter, in order to ensure the consistent treatment of related proceedings, the Opposer hereby request that the Board establish a single opposition proceeding for Application Serial Nos. 77/833,401 and 77/833,386 for the same mark “SENSIBLE PORTIONS” because the oppositions involve the same parties, same marks, and similar issues. Applications 77/833,386 only differs from 77/833,401 on the margins as 77/833,386 adds IC classes 5 and 32 and slightly alters the description of goods in Application 77/833,401 for goods in IC classes 29 and 30.

The Board, may order, upon its own initiative, the consolidation of the above referenced cases which is meant to ensure consistent treatment of related proceedings. See Fed. R. Civ. P. 42(a) and TBMP § 511. S. Industries Inc. v. Lamb-Weston Inc., 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); 8440 LLC v. Midnight Oil Company, 59 USPQ2d 1541 (TTAB 2001); (opposition and cancellation proceedings consolidated on Board's own initiative). Here, the Opposer, Sensible Foods, LLC has identical pleadings for both 77/833,386 and 77/833,401 and the combination will consolidate proceedings that will result in savings in time, effort, and expense for all parties.

Opposer, Sensible Foods, LLC, a California Limited Liability Company, with a business address of P.O. Box 750832, Petaluma, CA, 94975, United States, organized under the laws of the state of California, believes that it has been and will be further damaged by the registration on the Principle Register of the mark "SENSIBLE PORTIONS" and hereby opposes the registration of the mark SENSIBLE PORTIONS, that is the subject of Application Nos. 77/833,386 and 77/833,401, published in the Official Gazette of February 16, 2010. Opposer requests that the registration to the Applicant be refused.

As grounds in support of the opposition, Opposer asserts as follows:

1. On information and belief, Applicant, World Gourmet Marketing, LLC, is a limited liability company with its principle place of business at 49 Lincoln Road, Butler, New Jersey, 07405, United States, organized in New Jersey.
2. On information and belief, World Gourmet Acquisition, LLC is a limited liability company with an alleged principle place of business of 2870 Yellow Goose Rd. Lancaster, Pennsylvania 17601, organized in Pennsylvania.

3. On or about March 28, 2005, Applicant filed Application No 78/596051; earlier separate and different from 77/833,386 and 77/833,401 under Trademark Act Section 1(b), 15 U.S.C. §1051(b) of the Trademark Act, establishing an “intent-to-use” status under IC classes 29 and 30, with a description of goods as follows: IC 029. US 046; Protein-based nutrient-dense snack bars, soy-based food bars; soy-based snack foods; potato-based snack foods; snack food dips; potato chips; soy chips; soy nuts. IC 30. US 046; crackers; cookies; corn chips; tortilla chips; bakery goods, ready to eat, cereal derived food bars; granola-based snack bars, chocolate-based ready to eat food bars, (“Applicant’s Goods 05”).
4. On or about January 2, 2007, the Commissioner for Trademarks provided Applicant with Registration No. 3,195,083 for the subject mark of Application No. 78/596051 under the intent-to-use status of section 1(b) of the Trademark Act.
5. On information and belief and at a time unknown to Opposer, Applicant changed the status of 78/596,051 Registration No. 3,195,083 from 1(b), “intent-to-use ” to 1(a), “in-use” claiming a date of first use July 01, 2003 that is prior to the “intent-to-use” date of March 28, 2005 for the *exact* same goods, Applicant Goods 05.
6. On or about September 23, 2009, Applicant filed Application No. 77/833, 386 seeking registration on the Principal Register of the mark SENSIBLE PORTIONS, which is positioned partially in front of a heart-shaped design, in International Classes 05, 29, 30, and 32 with a description of goods as follows: IC 005; Energy boosting bars for use as a meal substitute; Meal replacement bars; Nutritional energy bars for use as a meal substitute; Nutritionally fortified beverages; Nutritionally fortified water; IC 029. US 046: Cheese; Prepared meat; Processed meat; Yogurts; IC 030. US 046: Cereal based energy

bars; Pretzels; Snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn; and IC 032. US 045 046 048: Flavored waters; Sports drinks; Sports drinks, namely, energy drinks, (“Applicant’s Goods 09-386” together with Applicant’s Goods 05, “Applicant’s Goods.”)

7. The status of Application No. 77/833,386 is Section 1(b) of the Trademark Act.
8. On or about September 23, 2009, Applicant filed Application No. 77/833,401, seeking registration on the Principal Register of the mark SENSIBLE PORTIONS, which is positioned partially in front of a heart-shaped design, in International Classes 29 and 30 with a description of goods as follows: IC 029. US 046: Protein-based nutrient-dense snack bars; soy-based food bars; soy-based snack foods; potato-based snack foods; snack food dips; potato chips; soy chips; soy nuts; vegetable chips; vegetable-based snack foods; pellet snacks, namely, hot air expanded pellet snacks consisting primarily of soy, potato or vegetables and IC 030. US 046: Crackers; cookies; corn chips; corn-based snack foods; tortilla chips; bakery goods; ready to eat, cereal derived food bars; granola-based snack bars; chocolate-based ready to eat food bars; pita chips; grain-based snack foods; grain-based chips; rice-based snack foods; pellet snacks, namely, hot air expanded pellet snacks consisting primarily of grains; puffed corn snacks; cheese flavored snacks, namely, cheese curls; cheese flavored puffed corn snacks. (“Applicant’s Goods 09-401” together with Applicant’s Goods 05 and Applicant’s Goods 09-386, “Applicant’s Goods.”)
9. The status of Application No. 77/833,401 is Section 1(a) of the Trademark Act.
10. On information and belief, Applicant provides, in Application No. 77/833,401, a Date of First Use of July 1, 2003, that is prior to the date of first use detailed for Registration No.

3,915,083, filed under 1(b) of the Trademark Act, which had an “intent-to-use” date of March 28, 2005, for the same mark and the same goods, Applicant Goods 05.

11. On information and belief, on or about April 26, 2010 Assignors World Gourmet Marketing and World Gourmet Acquisition assigned their interests in Application Nos. 77/833,386 and 77/833,401 to FCC, LLC a Florida limited liability company doing business as First Capital with its principle place of business as 3520 NW 58th Street Oklahoma City, Oklahoma 73112.

11.1. Both assignments Recorded April 26, 2010 Reel/Frame 4192/0110.

12. Opposer has sold fruit and vegetable-based snack foods under the mark SENSIBLE FOODS since at least as early as April 8, 1997, well before any date upon which Applicant may rely; especially in light of the discrepancy between Applicant’s “intent-to-use” date of March 28, 2005 for Application No. 78/596,051 and its claimed date of first use of July 01, 2003, for the same mark and the same or similar goods. Opposer’s use of the SENSIBLE FOODS mark has been continuous.

13. Opposer is the owner of numerous marks and registrations thereof on the Principal Register of the U.S. Patent and Trademark Office, including the following:

13.1. SENSIBLE FOODS (in standard characters), Registration No. 3,252,283 in International Class 016 with the following description of goods: Magazines, leaflets, brochures, and newsletters featuring food, health and nutrition; catalogs featuring food, snacks, nutritional supplements, and general nutritional products

13.2. SENSIBLE FOODS Registration No. 3,024,683 in International Class 029 with the following description of goods Dried Fruits and Dried Vegetables.

- 13.3.** SENSIBLE FOODS (in standard characters, with a design portion depicting assorted fruits and vegetables), Registration No. 2,861,273 in International Class 029 for Dried Fruit Snacks from Application No. 78/125,557 filed May 01, 2002.
- 13.4.** SNACKS MADE SENSIBLE (in standard characters), Registration No. 3,383,121 in International Class 029 for Dehydrated fruit snacks; Dried fruit mixes; Dried fruits; Dried soybeans; Dried vegetables; Fruit-based snack food; Vegetable-based snack foods.
- 13.5.** SENSIBLE BABY (in standard characters), Registration No. 3,793,526 in International Class 029 for Dried fruits; dried vegetables; processed fruits; processed vegetables.
- 14.** The filing dates of Opposer's federal trademark applications that matured into the SENSIBLE FOODS registrations predate September 23, 2009, the filing date of both Applicant's Application No. 77/833,386 for SENSIBLE PORTIONS based upon intent to use and Application No. 77/833,401 for SENSIBLE PORTIONS filed based upon a date of first use, July 1, 2003 which predates Applicant's intent-to-use date of March 28, 2005 for the same mark and the same goods under Application No. 78/596,051.
- 15.** Since prior to September 23, 2009, the filing date of Applicant's two Applications for SENSIBLE PORTIONS one of which is based upon intent to use, Opposer has widely advertised and promoted the SENSIBLE FOODS marks in connection with Opposer's goods, with the result that Opposer has built-up a valuable reputation and tremendous goodwill in the SENSIBLE FOODS Marks belonging exclusively to Opposer.
- 16.** On or about July 17, 2009, Opposer filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 of the Trademark Act for Registration No.

2,861,273 establishing that for International Class 029, the mark SENSIBLE FOODS (stylized and or with design) has been in use in commerce on or in connection with all of the goods or services listed in the existing registration for this specific class; and the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, July 06, 2004.

17. On or about August 04, 2009, the Commissioner for Trademarks acknowledge the Opposer's §§ 8 & 15 Declaration stating: "The combined declaration of use and incontestability filed in connection with the registration identified below meets the requirements of Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§1058 and 1065. The combined declaration is accepted and acknowledged. The registration remains in force."
18. Opposer's SENSIBLE FOODS Marks are unrevoked and uncanceled, and Opposer is the owner of each registration and mark shown therein, as well as all of the business goodwill connected therewith. Opposer's SENSIBLE FOODS Registrations are prima facie evidence of Opposer's exclusive right to the use of the SENSIBLE FOODS Marks in commerce in connection with the goods specified in the respective registrations, as well as the natural expansion into related goods and channels of commerce.
19. Applicant's mark SENSIBLE PORTIONS, so resembles Opposer's SENSIBLE FOODS Marks, as to already have caused confusion as used in connection with Applicant's Goods and to be likely, when used in connection with the Applicant's Goods, to continue to cause confusion, to cause mistake, or to deceive. Consumers have believed, will continue to incorrectly believe, and are likely to believe in the future that Applicant's use of SENSIBLE PORTIONS in connection with Applicant's Goods is in some way associated

or connected with or sponsored, authorized or approved by Opposer. Any objection or fault found with Applicant's Goods offered and provided under the mark SENSIBLE PORTIONS would reflect upon and seriously injure the reputation that Opposer has established in the SENSIBLE FOODS Marks.

20. As per No. 19, Opposer receives regular correspondence from the general public confused as to the source of the goods that they have ordered; including, but not limited to a May 3, 2010 telephone message by a caller who inquired with Sensible Foods about her order made with Sensible Portions. Upon a call-back by the Sensible Foods' Retail Account Manager, said caller repeatedly stated that she made the order with Sensible Foods until convinced that she had actually made the order with Sensible Portions.
21. As per No. 19, on or about and between the dates April 19, 2007 and March 19, 2008, Applicant conducted a recall of their products, which may have led to extensive damage to and confusion with the Opposer's goodwill and reputation and goods; respectively. Subsequent to the recall, on or about September 18, 2009, Opposer received an email from a consumer confusing the source of the defective Garden Veggie Chips sold by Applicant and complaining of a "yellow cheesy looking substance on it that was covered in MOLD." The confusion with and association to Applicant's defective product(s) seriously injured and could likely further injure the reputation and consumer trust that Opposer has established in its dried fruit and vegetable snacks sold in connection with the SENSIBLE FOODS marks.
22. As per No. 19, on or about and between the dates February 1, 2008 and October 07, 2009, the following condensed events occurred: 1) Sensible Portions presumably planned for and placed an advertisement in the New Season Marketplace (2004 N. Vancouver St.

Portland, OR, 97227) store-advertising circular, apparently at the direction of Dynamic Presence Inc., (5100 South Dawson Street, Ste 103, Seattle, WA 98108) for Applicant's *Multi-Grain Crisps*, 2) New Season Marketplace sent a PAST DUE invoice, dated May 12, 2009 to Dynamic Presence, Inc for the "Sensible Portions Snack Ad" for \$600 stating that "Past Due Invoices may be deducted through UNFI or JC Wright," 3) under the direction of a letter, dated March 31, 2008, from Shannon Rinck, New Season Marketplace Marketing Account Department, United Natural Foods, Inc. ("UNFI") (1101 Sunset Blvd., Rocklin, CA 95765) deducted \$600 from invoices due to the Opposer, **Sensible Foods**, 4) between the date of the PAST DUE invoice and October 1, 2009, UNFI deducted the PAST DUE invoice intended for **Sensible Portions** from Opposer's invoices, 5) fortunately **Sensible Foods** caught the mistake and 6) UNFI reimbursed Opposer for the deductions attributable to **Sensible Portions**. This sequence of events is just one example of many situations that has led to significant and costly confusion among customers and the public as to the mistaken source of Applicant's goods and confirms the injury Opposer suffers as the Applicant encroaches in, on and around Opposer's **SENSIBLE FOODS**, registered, un-cancelled, and un-revoked marks, still in force.

23. As per the above, Pursuant to Section 13(a) of the Trademark Act (15 U.S.C § 1063(a)), Opposer believes that it has been and will continue to be damaged by the registration of **SENSIBLE PORTIONS** in connection with Applicant's goods in Int. Classes 29 and 30.
24. Applicant's mark **SENSIBLE PORTIONS** is applied for in connection with goods in Int. Classes 05, 29, 30 and 32 that are related to Opposer's Goods and are also among the natural scope of expansion of Opposer's Goods.

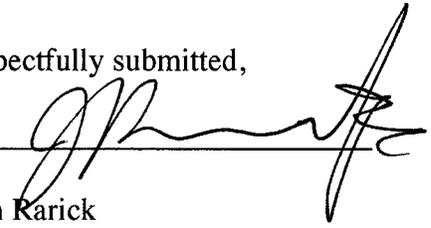
25. Registration of Applicant's mark SENSIBLE PORTIONS in connection with Applicant's Goods has caused and will continue to cause the distinctiveness of Opposer's famous Marks to be diluted and would thereby be a source of damage and injury to Opposer.
26. Applicant's mark has already falsely suggested a connection with Opposer and will continue to do so.
27. Applicant's use of the SENSIBLE PORTIONS mark and design for Applicant's Goods in IC classes 05, 29, 30 and 32 in Application Nos. 77/833,386 and 77/833,401 is without Opposer's consent or permission.
28. If Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of further damage and injury to and likely confusion with Opposer and Opposer's goods.

WHEREFORE, the Opposer, Sensible Foods, LLC, prays that the Application Serial Nos. 77/833,386 and 77/833,401 for the mark SENSIBLE PORTIONS and design in Int. Classes 05, 29, 30, and 32 be rejected. Opposer respectfully requests that this opposition be sustained and that Application Serial Nos. 77/833,386 and 77/833,401 be denied registration.

Date June 11, 2010

Appearing *per se*:

Respectfully submitted,

By: 

John Rarick
Vice President
Sensible Foods, LLC
P.O. Box 750832
Petaluma, CA
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415.606.1689

CERTIFICATE OF SERVICE/MAILING

I HEREBY CERTIFY that on this 11th day of June, 2010, I caused to be served via the United States Patent and Trademark Office's Electronic System for Trademark Trials and Appeals (ESSTA) and via the US Postal Service, postage prepaid, the following:

NOTICE OF OPPOSITION

TO:

Applicant and Co-Assignor
World Gourmet Marketing, LLC,
C/O
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