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

Proceeding	91195262
Party	Plaintiff Sensible Foods LLC
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Date	11/25/2010
Attachments	SF Op Cncl WGHC.pdf ( 1 page )(69384 bytes ) SF Op Cncl WGHC 1.pdf ( 1 page )(78519 bytes ) SF Op Cncl WGHC 2.pdf ( 1 page )(76222 bytes ) SF Op Cncl WGHC 3.pdf ( 1 page )(82751 bytes ) SF Op Cncl WGHC 4.pdf ( 1 page )(70990 bytes ) SF Op Cncl WGHC 5.pdf ( 1 page )(72645 bytes ) SF Op Cncl WGHC 6.pdf ( 1 page )(78228 bytes ) SF Op Cncl WGHC 7.pdf ( 1 page )(74075 bytes ) SF Op Cncl WGHC 8.pdf ( 1 page )(76160 bytes ) SF Op Cncl WGHC 9.pdf ( 1 page )(81619 bytes ) SF Op Cncl WGHC 10.pdf ( 1 page )(56617 bytes ) SF Op Cncl WGHC 11.pdf ( 1 page )(35704 bytes )

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

In the matter of the mark “SENSIBLE PORTIONS” under Application Serial Nos. 77/833,401 and 77/833,386 Published in the Official Gazette of February 16, 2010 and Registration No. 3,195,083.

Applicant : World Gourmet Marketing, LLC  
Mark : SENSIBLE PORTIONS  
Serial No. : 77/833,401 & 77/833,386  
Filed : September 23, 2009  
Reg. No. : 3,195,083  
Recorded : January 2, 2007

SENSIBLE FOODS, LLC )  
 )  
Opposer/Petitioner, ) Opposition No. **91195262**  
 ) Cancellation No. **92053083**  
 )  
v. )  
 )  
WORLD GOURMET MARKETING, LLC )  
 )  
Applicant/Respondent. )  
\_\_\_\_\_ )

COMBINED NOTICE OF OPPOSITION AND PETITION TO CANCEL

As per Board Order dated October 4, 2010, here is Opposer-Petitioner’s amended complaint for the consolidated Opposition and Cancellation, captioned above.

Sensible Foods, LLC (“Sensible Foods,” “Opposer” or “Petitioner”), 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 will <sup>be</sup> damaged by 1) the registration on the Principle Register of the mark “SENSIBLE PORTIONS” under App. Ser. Nos. 77/833,386 and 77/833,401 (collectively, “Applicant’s Applications”) and 2) the

maintenance of the SENSIBLE PORTIONS mark shown in Registration No. 3,195,083 (“Respondent’s Registration”), filed by World Gourmet, LLC (“Applicant” or “Respondent”), and hereby opposes registration of the Applicant’s Applications and requests cancellation of the Respondent’s Registration.

As grounds in support of the opposition and cancellation, Opposer/Petitioner alleges that:

1. Since long prior to the filing date for Applicant’s Applications and priority date of Respondent’s Registration, Sensible Foods has continuously used the SENSIBLE FOODS Mark and other marks containing the SENSIBLE FOODS mark (collectively, “SENSIBLE FOODS Mark”) in commerce in connection with dried fruits, dried vegetables and dried-fruit snacks and related goods.
2. Sensible Foods has registered its SENSIBLE FOODS Mark in the United States Patent and Trademark Office, including but not limited to the following federal registrations:

MARK	REG. NO.
SENSIBLE FOODS	3,252,283
SENSIBLE FOODS	3,024,683
SENSIBLE FOODS & Design	2,861,273
SNACKS MADE SENSIBLE	3,383,121
SENSIBLE BABY	3,793,526

(“Opposer’s Registrations” or “Petitioner’s Registrations”). These registrations are valid, subsisting and owned by Sensible Foods. Registration No. 2,861,273 is incontestable in accordance with 15 U.S.C. §§ 1065, 1115.

3. Sensible Foods has sold millions of dollars worth of goods in connection with its SENSIBLE FOOD Mark.
4. Sensible Foods has spent significant sums and resources advertising and promoting its SENSIBLE FOODS Mark throughout the United States.
5. Due to the popularity of Sensible Foods' goods offered in connection with the SENSIBLE FOODS Mark, and its advertising and promotion of the SENSIBLE FOODS Mark, Sensible Foods has built up and now owns an extremely valuable goodwill, which is symbolized by its SENSIBLE FOODS Mark.
6. Applicant/Respondent, 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.
7. 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").
8. The status of Application No. 77/833,386 is Section 1(b) of the Trademark Act.

9. 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”).
10. The status of Application No. 77/833,401 is Section 1(a) of the Trademark Act.
11. On or about March 28, 2005, Respondent filed Application No. 78/596,051; under Trademark Act Section 1(b), 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, (“Respondent’s Goods 05-051”

together with Applicant's Goods 09-386 and Applicant's Goods 09-401, "Applicant's Goods").

12. On or about January 2, 2007, the Commissioner for Trademarks provided Respondent 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.
13. Applicant changed the status of 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.
14. Applicant's proposed use of SENSIBLE PORTIONS for the applied goods is without Opposer's consent or authorization.
15. Respondent's use of the SENSIBLE PORTIONS as set forth in Respondent's Registration is without Petitioner's consent or authorization.
16. Registration of Applicant's Applications for the applied goods would be damaging to Opposer.
17. Maintenance of Respondent's Registrations is damaging to Petitioner.
18. 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.

19. On or about August 04, 2009, the Commissioner for Trademarks acknowledged the Petitioner'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."
20. Applicant's Goods as the proposed goods set forth in Applicant's Application and the goods for Respondent's Registration in Int. Classes 05, 29, 30 and 32 are among the natural scope of expansion of Opposer/Petitioner's goods.

**COUNT ONE**

**LIKELIHOOD OF CONFUSION UNDER 15. U.S.C § 1052 (d)**

21. Sensible Foods re-alleges the allegations in paragraphs 1 through 22.
22. Applicant's proposed use of the mark SENSIBLE PORTIONS for the applied for goods set forth in Applicant's Application is likely to result in confusion, mistake or deception with Opposer and its SENSIBLE FOODS Mark, and/or in the belief that Applicant or Applicant's Goods used in connection with its SENSIBLE PORTIONS mark are in some way legitimately connected with, or licensed or approved by, Opposer.
23. Respondent's use of SENSIBLE PORTIONS as set forth in Respondent's Registration is likely to cause confusion, mistake or deception with Petitioner, and its SENSIBLE FOODS Mark, and/or in the belief that Respondent or its SENSIBLE PORTIONS goods are in some way legitimately connected with, or licensed or approved by, Petitioner.

24. On or about and between the dates April 19, 2007 and March 19, 2008, Applicant/ Respondent conducted a recall of their products, which led to extensive damage to and confusion with the Opposer/Petitioner's goodwill, reputation and goods.

**COUNT II**  
**SUGGESTION OF FALSE CONNECTION UNDER 15 U.S.C. §1052 (a)**

25. Sensible Foods re-alleges the allegations of paragraphs 1 through 20 and 22 through 24.

26. Since long prior to the filing date for Applicant's Applications and priority date of Respondent's Registration, and by virtue of Sensible Foods' extensive use, advertising and promotion of its SENSIBLE FOODS Mark in connection with fruit and vegetable-based snack foods and related goods, the SENSIBLE FOODS Mark has become very well-known and closely identified with Sensible Foods by consumers and others.

27. Upon information and belief, consumers and others will erroneously believe that Applicant's applied for marks and Respondent's Registration are related to, or a reference to, SENSIBLE FOODS.

28. Sensible Foods is not connected with Applicant or its proposed Applicant's Goods 09-401 and 09-386 or with Respondent or Respondent's Goods 05-051.

29. Opposer's SENSIBLE FOODS Mark is sufficiently well-known and closely identified with Opposer that Applicant's use and registration of the SENSIBLE PORTIONS mark for the applied for goods will falsely suggest to consumers a connection with Opposer.

30. Petitioner's SENSIBLE FOODS Mark is sufficiently well-known and closely identified with Petitioner that Respondent's use of the SENSIBLE PORTIONS mark as set forth in Respondent's Registration falsely suggest to consumers a connection with Petitioner.

31. Upon information and belief, Applicant's attempt to register SENSIBLE PORTIONS unfairly trades on the association of the SENSIBLE PORTION Mark with SENSIBLE FOODS.
32. Upon information and belief, Respondent's Registrations unfairly trade on the association of SENSIBLE PORTIONS with SENSIBLE FOODS.

**COUNT III**  
**EXAMINING ATTORNEY SHOULD HAVE REJECTED REGISTRATION UNDER**  
**15 U.S.C §1064 (1), (3).**

33. Sensible Foods re-alleges the allegations of paragraphs 1 through 20, 22 through 24 and 26 through 32.
34. On or about June 22, 2007, Applicant/Respondent, filed Application No. 77/210,120 for the mark "SENSIBLE SNACKS," in connection goods substantially similar to Applicant's Goods.
35. On September 21, 2007 the examining attorney mailed an office action memo to Alison P. Grossman attorney for applicant World Gourmet Marketing, LLC regarding Application No. 77/210120 for the mark "SENSIBLE SNACKS" stating among other findings:  
  
"Registration Refusal –Likelihood of Confusion 2(d): The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the marks in U.S. Registration Nos. 3,024,683 and 2,861,273 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 et seq.
36. The examining attorney continued: "Registration Refusal -Similarity of Marks: The applicant's mark is SENSIBLE SNACKS. The registrant's marks are SENSIBLE

FOODS and SENSIBLE FOODS with a design. The marks are similar in sound, appearance and commercial impression because they each contain the dominant term SENSIBLE. Further, the terms SNACKS and FOODS convey a highly similar commercial impression.”

**37.** The examining attorney continued: “Registration Refusal -Similarity of Goods/Services:

The applicant’s goods/services are “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-based snack foods; pellet snacks” and “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; grain-based chips; cheese flavored snacks, namely, cheese curls; corn-based snack foods; popcorn; caramel popcorn; glazed popcorn; pita chips”. The registrant’s goods are Dried Fruits, Dried Vegetables and Dried fruit snacks respectively. The goods are related because these goods are all snack foods which would be marketed and sold to similar consumers using the same channels of trade.”

**38.** On April 28, 2008 the Commissioner for Trademarks mailed an Abandonment Notice for the mark “SENSIBLE SNACKS” under Application No. 77/210120 stating in part: “The trademark application identified below was abandoned in full because a response to the Office Action mailed on Sep 21, 2007 was not received within the 6-month response period.”

**39.** The Description of Goods for Applicant’s Applications and Respondent’s Registration for the mark SENSIBLE PORTIONS consists of substantially the same Description of

Goods under Application No. 77/210,120 for the mark SENSIBLE SNACKS, which was rejected by the Commissioner of Trademarks and abandoned by the Applicant.

40. As per paragraphs 34 through 39, the examining attorney should have rejected Application No. 77/596,051 that gave rise to Registration No. 3,195,083 for the same reasons and under the same authorities cited in the September 21, 2007 Office Action to deny registration of Applicant's Application No. 77/210120 for the mark "SENSIBLE SNACKS".
41. The filing date of this amendment and the original petition for cancellation, August 2, 2010, is within five years of the registration date for Registrant's Registration No. 3,195,083, which was January 2, 2007.
42. The Applicant/Respondent has a legal duty to select a mark or marks which is totally dissimilar to trademarks already being used.

**COUNT IV**  
**APPLICANT/RESPONDENTS ARE BARRED FROM OBTAINING AND**  
**MAINTAINING REGISTRATIONS BECAUSE THEY FAILED TO USE**  
**APPLICANT'S MARK IN COMMERCE IN CONNECTION WITH ALL THE**  
**GOODS LISTED IN THE APPLICATION AS OF THE CLAIMED DATE OF FIRST**  
**USE.**

43. Applicant provides, in Application No. 77/833,401, a Date of First Use of July 1, 2003, that is prior to March 28, 2005, the date Respondent provided in its Application No. 78/596,051 that gave rise to Respondent's Registration No. 3,915,083, filed under 1(b) of the Trademark Act, for substantially the same goods.
44. Respondent's Application, filed March 5, 2005, was filed pursuant to Section 1(b) of the Lanham Act based upon an intent to use Respondent's Mark in connection with the Respondent's Goods 05-051 listed in said application. Subsequently, Respondent alleges

that they first used Respondent's Mark in connection with Respondent's Goods 05-051 on or before July 7, 2003.

45. Upon information and belief, Respondent had not used Respondent's Mark in connection with all of Respondent's Goods 05-051 anywhere and/or in U.S. interstate commerce as of either the filing date, March 23, 2005 or the subsequently provided date of first use, July 7, 2003.

46. Upon information and belief, Respondent did not first use Respondent's Mark in U.S. interstate commerce in connection with Respondent's Goods 05-051 on or before July 7, 2003.

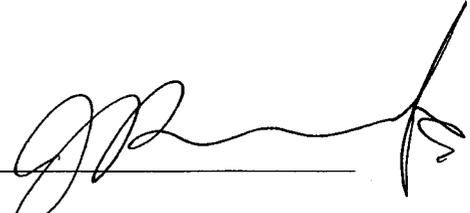
**WHEREFORE**, Sensible Foods, prays that Application Serial Nos. 77/833,386 and 77/833,401 for the mark SENSIBLE PORTIONS and design in Int. Classes 05, 29, 30, and 32 be rejected and denied registration. Further, Petitioner requests that Registration No. 3,189,083 be canceled.

Date November 24, 2010

Respectfully submitted,

Appearing *pro se*:

By: \_\_\_\_\_

  
John Rarick  
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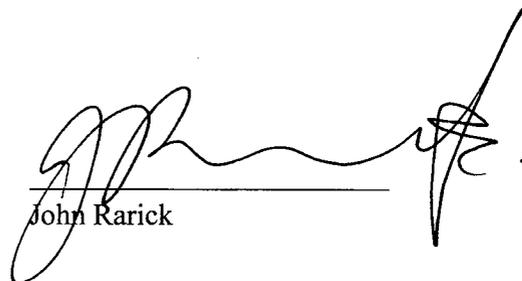
CERTIFICATE OF SERVICE/MAILING

I HEREBY CERTIFY that on this 24 day of November, 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:

**COMBINED NOTICE OF OPPOSITION AND PETITION TO CANCEL**

TO:

World Gourmet Marketing, LLC, C/O  
Vanessa A. Ignacio, Esq.  
Lowenstein Sandler PC  
65 Livingston Ave, Ste. 2  
Roseland, NJ 07068-1791

  
\_\_\_\_\_  
John Rarick