

ESTTA Tracking number: **ESTTA366414**

Filing date: **09/02/2010**

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	ProMark Brands Inc.		
Entity	Corporation	Citizenship	Idaho
Address	2541 North Stokesberry Place Suite 100 Meridian, ID 83642 UNITED STATES		

Attorney information	Timothy P. Fraelich JONES DAY 901 Lakeside Avenue Cleveland, OH 44114 UNITED STATES tfraclich@jonesday.com, jwalworth@jonesday.com, pcyngier@jonesday.com Phone:216-586-1247
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Applicant Information

Application No	77864268	Publication date	08/10/2010
Opposition Filing Date	09/02/2010	Opposition Period Ends	09/09/2010
Applicant	GFA Brands, Inc. 115 W. Century Rd. Suite 260 Paramus, NJ 07652 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. All goods and services in the class are opposed, namely: soy chips and yucca chips; snack mixes consisting primarily of processed fruits, processed nuts, raisins and/or seeds; nut and seed-based snack bars
Class 030. All goods and services in the class are opposed, namely: cake mix, frosting, cakes, frozen cakes, cookies, coffee, tea, hot chocolate, bread, rolls, crackers, pretzels, corn chips, snack mixes consisting primarily of crackers, pretzels, nuts and/or popped popcorn, spices, granola-based snack bars; pita chips

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1911590	Application Date	05/20/1994
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Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	SMART ONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1992/05/01 First Use In Commerce: 1992/05/01 frozen entrees consisting primarily of chicken, beef, fish and/or vegetables Class 030. First use: First Use: 1992/05/01 First Use In Commerce: 1992/05/01 frozen entrees consisting primarily of pasta and/or rice alone or in combination with other foods		

U.S. Registration No.	2204080	Application Date	01/08/1998
Registration Date	11/17/1998	Foreign Priority Date	NONE
Word Mark	SMART ONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1997/11/03 First Use In Commerce: 1997/11/03 Frozen desserts consisting of milk based or milk substitute based desserts, cakes, pies and mousses		

U.S. Registration No.	2916539	Application Date	01/14/2004
Registration Date	01/04/2005	Foreign Priority Date	NONE
Word Mark	SMART ONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2001/04/01 First Use In Commerce: 2001/04/01 Pre-cooked ready-to-eat frozen bread or wrap having a meat and/or vegetable filling with or without cheese		

U.S. Registration No.	2916538	Application Date	01/14/2004
Registration Date	01/04/2005	Foreign Priority Date	NONE
Word Mark	SMART ONES		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 1997/11/30 First Use In Commerce: 1997/11/30 Pizza

U.S. Registration No.	3462182	Application Date	01/10/2008
Registration Date	07/08/2008	Foreign Priority Date	NONE
Word Mark	SMART ONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Frozen foods, namely, breakfast sandwiches and muffins		

Attachments	78352011#TMSN.jpeg (1 page)(bytes) 78351994#TMSN.jpeg (1 page)(bytes) 77368176#TMSN.jpeg (1 page)(bytes) DOC087.pdf (8 pages)(232934 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	/Timothy P. Fraelich/
Name	Timothy P. Fraelich

Date	09/02/2010
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of

U.S. Trademark Application 77/864,268
For the Mark **SMART BALANCE**
Published in the Official Gazette on August 10, 2010

PROMARK BRANDS INC.,

Opposer,

Opposition No. _____

v.

GFA BRANDS, INC.,

Applicant.

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

NOTICE OF OPPOSITION

1. Opposer, ProMark Brands Inc. ("Opposer"), a corporation duly organized and existing under the laws of Idaho and having a place of business at 2541 North Stokesberry Place, Suite 100, Meridian, ID 83646, believes that it will be damaged by the registration of the mark SMART BALANCE ("Applicant's Mark") shown in trademark application Serial No. 77/864,268 (the "Application") and hereby opposes same pursuant to 15 U.S.C. §§ 1052 and 1063.

2. To the best of Opposer’s knowledge, the name and address of the current owner of the Application is GFA Brands, Inc. (“Applicant”), 115 W. Century Rd., Suite 260, Paramus, NJ 07652, United States.

As grounds for opposition, it is alleged that:

The Application

3. Applicant filed the Application on an intent-to-use basis to register the mark SMART BALANCE to identify:

- a. soy chips and yucca chips; snack mixes consisting primarily of processed fruits, processed nuts, raisins and/or seeds; nut and seed-based snack bars in International Class 29; and
- b. cake mix, frosting, cakes, frozen cakes, cookies, coffee, tea, hot chocolate, bread, rolls, crackers, pretzels, corn chips, snack mixes consisting primarily of crackers, pretzels, nuts and/or popped popcorn, spices, granola-based snack bars; pita chips in International Class 30.

4. The Application was published in the Official Gazette on August 10, 2010.

5. Applicant has not filed an amendment to allege use as of September 2, 2010.

Opposer’s Registered Marks

6. Opposer is the owner of the following registrations in the United States Patent and Trademark Office for SMART ONES (“Opposer’s Marks”), which registrations have not been cancelled, are valid and in full force and effect:

Trademark	Registration/ Serial No.	Registration/ Filing Date	International Class/Goods
SMART ONES	1,911,590	August 15, 1995	29 – Frozen entrees consisting primarily of chicken, beef, fish and/or vegetables.
SMART ONES	2,204,080	November 17, 1998	30 – Frozen desserts consisting of milk based or milk substitute based desserts, cakes, pies and mousses.

Trademark	Registration/ Serial No.	Registration/ Filing Date	International Class/Goods
SMART ONES	2,916,539	January 4, 2005	30 – Pre-cooked ready-to-eat frozen bread or wrap having a meat and/or vegetable filling with or without cheese.
SMART ONES	2,916,538	January 4, 2005	30 – Pizza.
SMART ONES	3,462,182	July 8, 2008	30 – Frozen foods, namely, breakfast sandwiches and muffins.

Registration Nos. 1,911,590 and 2,204,080 have become incontestable as a matter of law under 15 U.S.C. § 1065.

7. Opposer's ownership in Registration Nos. 1,911,590 and 2,204,080 results from the following chain of title:

Assignment	by Weight Watchers International, Inc. to H.J. Heinz Company (recorded at Reel 1971/Frame 0642);
Assignment	by H.J. Heinz Company to ProMark International, Inc. (recorded at Reel 2327/Frame 0405);
Merger	of ProMark International, Inc. with H.J. Heinz Company (recorded at Reel 2633/Frame 0413);
Assignment	by H.J. Heinz Company to ProMark Brands Inc. (recorded at Reel 2631/Frame 0678).

Opposer's Use Of Its Famous Marks

8. Opposer, through its predecessors and licensee, since at least as early as May 1, 1992, has been, and is now, using the mark SMART ONES throughout the United States in connection with the goods described above.

9. Opposer's use of Opposer's Marks, as described above, has been valid and continuous since the date of first use.

10. Opposer's continuous, exclusive and commercially-successful use of the mark SMART ONES is symbolic of extensive good will and consumer recognition built up by

Opposer through substantial amounts of time, money and effort in manufacturing, advertising and promotion.

11. Upon information and belief, Applicant's SMART ONES mark is widely and highly recognized by the general, consuming public of the United States as a designation of source of Opposer's goods.

12. Upon information and belief, the mark SMART ONES has come to serve as a unique and famous identifier of Opposer's goods.

Dilution And Confusion Are Likely

13. Opposer's use of the mark SMART ONES predates any alleged use by Applicant for Applicant's Mark.

14. Opposer's use of the mark SMART ONES predates the filing date of the Application.

15. Opposer's Marks were well established and famous long before the filing date of the Application and at the time that Applicant filed the Application.

16. Upon information and belief, Applicant's Mark SMART BALANCE, to be used in connection with the goods covered by Application No. 77/864,268, is confusingly similar to Opposer's Marks as used and registered by Opposer.

17. Upon information and belief, the products to which Applicant's Mark SMART BALANCE will be used are related to, or identical to, various products on and in connection with which Opposer and its predecessors-in-interest have used, and are using, the mark SMART ONES.

18. Upon information and belief, the goods to which Applicant's Mark SMART BALANCE will be applied, and the products on and in connection with which Opposer uses its

mark SMART ONES, are products that are offered for sale and sold in identical channels of trade.

19. Upon information and belief, the goods to which Applicant's Mark SMART BALANCE will be applied, and the products on and in connection with which Opposer uses its mark SMART ONES, are products that are offered for sale and sold to the same class of purchasers.

20. Upon information and belief, both Opposer's goods and Applicant's goods are relatively low-priced and may be purchased on impulse by consumers.

Applicant Has Essentially Admitted That Dilution And Confusion Are Likely

21. In numerous proceedings before the Trademark Trial and Appeal Board, Applicant has challenged applications arguing that its registrations and applications for "smart" related marks that predate other "smart" related marks should bar registration.

22. Specifically, Applicant has argued that permitting other "smart" marks to register would interfere with its use of its marks and would seriously damage Applicant.

23. Opposer's use of the mark SMART ONES predates any alleged use by Applicant for Applicant's Mark. Further, Opposer's SMART ONES mark became famous before Applicant filed the Application. Thus, based upon Applicant's own admissions, as set forth in multiple pleadings before the Trademark Trial and Appeal Board, in this instance, permitting Applicant's Mark to register would interfere with Opposer's use of Opposer's Marks and would seriously damage Opposer.

COUNT I
LIKELIHOOD OF CONFUSION

24. ProMark incorporates each and every allegation of Paragraphs 1-23 of this Notice as though fully set forth herein.

25. In view of the fame of Opposer's Marks, the similarity of the respective marks, similarity of the channels of trade, related nature of the goods and the relatively low-priced nature of the goods, the mark shown in the Application so resembles Opposer's Marks so as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Applicant's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Opposer.

26. In view of the fame of Opposer's Marks, the similarity of the respective marks, similarity of the channels of trade, related nature of the goods and the relatively low-priced nature of the goods, the mark shown in the Application so resembles Opposer's Marks so as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Opposer's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Applicant.

COUNT II
TRADEMARK DILUTION

27. ProMark incorporates each and every allegation of Paragraphs 1-26 of this Notice as though fully set forth herein.

28. SMART ONES has become famous in accordance with the standard set forth in 15 U.S.C. § 1125(c).

29. Applicant filed the Application for SMART BALANCE after Opposer's SMART ONES mark became famous.

30. Applicant's Mark is likely to cause the dilution of the distinctiveness of the Opposer's famous SMART ONES mark.

WHEREFORE, Opposer prays that Application Serial No. 77/864,305 be rejected in its entirety on the basis of: (1) likelihood of confusion and (2) likelihood of dilution; and that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Opposer.

Dated this 2nd day of September, 2010.

Respectfully submitted,

By: /James W. Walworth, Jr./
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ProMark Brands Inc.

CERTIFICATE OF SERVICE

A copy of the foregoing was served on this 2nd day of September, 2010, via first-class mail upon the Attorney of Record for Applicant:

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/James W. Walworth, Jr./
Attorney for Opposer