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

Proceeding	91196412
Party	Defendant Yatim, Rim, Yatim, Najib
Correspondence Address	Yatim Cocoa Delices Chocolaterie 1155 Wembley Dr. Wayne, PA 19087 najib_yatim@yahoo.com
Submission	Answer
Filer's Name	Najib Yatim
Filer's e-mail	najib_yatim@yahoo.com
Signature	/Najib Yatim/
Date	10/15/2010
Attachments	Cocoa Delices Answer to Notice of Opposition.pdf (6 pages)(237202 bytes)

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

Kearny, Dennis,
dba Coco Delice Fine Chocolates,

Opposer,

vs.

Najib Yatim and Rim Yatim,

Applicants.

Application: 77509239

Opposition: 91196412

Mark: COCOA DELICES CHOCOLATERIE & Design



ANSWER TO NOTICE OF OPPOSITION

The following is the Answer of Applicants, Najib Yatim and Rim Yatim (“Applicants”), owners of Federal Trademark Application Serial No. 77509239 for the mark COCOA DELICES CHOCOLATERIE and Design (hereinafter “Applicants’ Mark”), to the Notice of Opposition served on September 8, 2010 by Dennis Kearny (hereinafter “Opposer”) and assigned Opposition No. 91196412.

Applicant hereby responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Notice of Opposition, as follows:

1. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Notice of Opposition including allegations that this mark has been in use since at least as early as November 2005, and on that basis deny them. Applicants deny the remaining allegations in paragraph 1 of the Notice of Opposition, particularly as they relate to Opposer’s rights.

2. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2 of the Notice of Opposition and on that basis deny them.

3. Admitted to the extent the USPTO records support the allegations. No denial or admittance is due in reference to Opposer's noted objection.

4. Denied

5. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Notice of Opposition and on that basis deny them.

6. To the extent Paragraph 6 of the Notice of Opposition contains factual allegations requiring a response, Applicants deny such allegations.

7. Applicants Admit that registration of Applicants' Mark would be prima facie evidence of the rights of Applicants under 15.U.S.C § 1057(b). The remaining statements in paragraph 7 are denied.

8. Denied

9. Applicants are without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 9 of the Notice of Opposition and on that basis deny them.

FURTHERMORE, Applicants set forth the following in support of their defense:

10. Applicants' related entity, filed application No. 77395277, to register the "Cocoa Delices" Mark on February 12, 2008 and was granted a priority date of December 27, 2007. The earlier application was later abandoned in favor of and after application No. 77509239 to register Applicants' mark COCOA DELICES CHOCOLATERIE and Design was filed on June 26, 2008 and granted a priority date of December 27, 2007.

11. Opposer filed application No. 77402783 on February 21, 2008, 9 days following Applicants' related entity's earlier filing and 57 days after applicants' priority date.

12. Opposer had knowledge of Applicants' Mark at least as early as Feb.12, 2008

13. Opposer had knowledge of Applicants' Mark prior to filing to register

Opposer's mark

14. Upon information and belief, Opposer, knowingly and willfully applied for a similar mark for goods in identical International Class 30

15. On or about April 29, 2009, Opposer served Applicants with a cease and desist letter to which, Applicants responded in a timely manner, on May 15, 2009, through their attorneys, Petock & Petock LLC refuting the alleged claims.

16. Opposer never responded or contacted Applicants since April 29, 2009. Applicants' continued to expand business and use of the mark, under the assumption that opposer's claims were abandoned.

17. Upon information and belief, Opposer knowingly and willfully filed the above captioned Notice of Opposition against the Mark of Applicants.

18. Applicants' COCOA DELICES CHOCOLATERIE and design and logo, are not the same or confusingly similar to Opposer's alleged Mark.

19. Applicants' Mark design is unique and distinctive.

20. Applicants' Mark and Opposer's Mark are different in appearance. Applicants' Mark claims a design of a "cocoa tree" whereas Opposer's Mark lacks a design differentiator.

21. Applicants' Mark and Opposer's Mark are different in spelling. Applicants' Mark contains the word "Cocoa" with an "A" and "Delices" with an "S", whereas Opposer's Mark contains the word "Coco", without the "A" and "Delice", without the "S"

22. Applicants' Mark and Opposer's Mark are different in sound. Applicants' is pronounced "Co-co-ah" where as Opposer's Mark is pronounced "Co-co".

23. Applicants' Mark and Opposer's Mark are different in meaning. The word "Cocoa" in Applicants' Mark references the "Cocoa Tree", the source and origin of chocolate, whereas, the word "Coco" is Opposer's Mark, reference among other things, the "Coco Nut Tree".

24. Applicants' Mark and Opposer's Mark are different in commercial impression.

25. On information and belief, the words, COCOA and COCO, DELICE and DELICES, are used by numerous third parties offering identical and or similar products.

26. On information and belief, Opposer's mark is diluted.

27. On information and belief, Opposer's mark is weak.

28. On information and belief, Applicants' and Opposer's products travel in different channels of trade. Applicants' products are sold exclusively through their store or Applicants' e-commerce website.

29. On information and belief, Applicants' and Opposer's products are not likely to be marketed on sold together.

30. On information and belief, Applicants' products are expensive and considered premium and or gourmet products.

31. On information and belief, Opposer's products are expensive and considered premium and or gourmet products.

32. On information and belief, Applicants' clients are sophisticated and use great care when selecting a source for the goods.

33. On information and belief, Opposer's clients are sophisticated and use great care when selecting a source for the goods.

34. On information and belief, there has never been any actual confusion between Applicants' Mark and Opposer's Mark.

35. Applicants' Mark and Opposer's Mark are not likely to cause confusion, mistake or deception to purchasers as to the source of Applicants' goods.

36. Applicants' Mark and Opposer's Mark are not likely to cause confusion, mistake or deception to purchasers as to the source of Opposer's goods.

37. On information and belief, Opposer is not likely to be damaged by registration or use of Applicants' Mark.

WHEREFORE, Applicants pray and respectfully request that the Opposition be denied, rejected or otherwise terminated with prejudice and that the Registration be issued for the subject Application.

Dated this 15th day of October, 2010

Respectfully Submitted,



Najib Yatim
Applicant
1155 Wembley Dr.
Wayne, PA 19087
Tel: (610) 203-0495



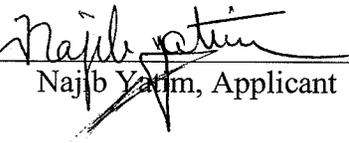
Rim Yatim
Applicant
11629 Ave. Des Violettes
Montreal Nord, Quebec H1G4N1
Canada

CERTIFICATE OF SERVICE

I hereby certify that a true, complete and accurate copy of ANSWER TO NOTICE OF OPPOSITION has been served on the following by delivering said copy on October 15, 2010, via First Class Mail, postage prepaid, to council for Opposer at the following address:

Gregory N. Owen
Owen, Wickersham & Erickson P.C
Attorneys for Opposer
455 Market Street, Suite 1910
San Fransisco, CA 94105

Date: October 15, 2010

By:  _____
Najib Yatim, Applicant