

ESTTA Tracking number: **ESTTA496215**

Filing date: **09/24/2012**

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	FERRERO S.p.A.
Granted to Date of previous extension	09/23/2012
Address	Piazzale Pietro Ferrero 1 Alba (Cuneo), 12051 ITALY
Correspondence information	Anna Kurian Shaw 555 13th Street, NW Washington, DC 20004 UNITED STATES DCPTOTrademarkMail@hoganlovells.com, anna.shaw@hoganlovells.com Phone:202-637-5600

Applicant Information

Application No	85447839	Publication date	03/27/2012
Opposition Filing Date	09/24/2012	Opposition Period Ends	09/23/2012
Applicant	Dotchirne pidpriemstvo "Konditerska korporatzia "ROSHEN" vul. Pavla Usenka, 8 Kyiv 02105, UKRAINE		

Goods/Services Affected by Opposition

Class 030. First Use: 1998/01/30 First Use In Commerce: 2008/05/22 All goods and services in the class are opposed, namely: Confectioneries, namely, candies, pastries, chocolate, hard candies, and fruit jelly candy

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1680513	Application Date	05/16/1988
Registration Date	03/24/1992	Foreign Priority Date	03/11/1988
Word Mark	ROCHER		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 030. First use: CANDY

U.S. Registration No.	2048551	Application Date	01/10/1994
Registration Date	04/01/1997	Foreign Priority Date	NONE
Word Mark	FERRERO ROCHER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1981/01/00 First Use In Commerce: 1981/05/13 candy		

Attachments	ROSHEN - Notice of Opposition.pdf (8 pages)(150929 bytes)
-------------	--

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	/AKS/
Name	Anna Kurian Shaw
Date	09/24/2012

marks ROCHER and FERRERO ROCHER (“ROCHER Marks”) in connection with confections, candy and chocolates, by virtue of long and extensive use and federal registrations as pleaded hereinafter.

2. Ferrero began selling candies and confectionary products under the ROCHER Marks in the United States at least as early as 1981. Since that time, Ferrero has prominently, extensively, and continuously used, advertised, and promoted the ROCHER Marks and its goods sold under the ROCHER Marks throughout the United States and the world.

3. As a result of Ferrero’s extensive and continuous use of the ROCHER Marks in interstate commerce, the marks have become well-known among consumers of candy and confectionary products and the public generally, as persons recognize the distinctive ROCHER Marks and associate such marks with the goods that Ferrero offers. The ROCHER Marks therefore, are symbolic of extensive goodwill and consumer recognition built up by Ferrero through its sales, advertising and promotional efforts. Ferrero asserts that the ROCHER Marks are famous and were famous prior to the filing of Applicant’s Mark.

4. Ferrero is the owner, user, and registrant of various marks for “ROCHER” and “FERRERO ROCHER” on the Principal Register, including U.S. Registration No. 1,680,513 for the word mark ROCHER and U.S. Registration No. 2,048, 551 for the word mark FERRERO ROCHER, both for “candy” in International Class 30. Such registrations were issued on March 24, 1992 and April 1, 1997, respectively, and both have achieved incontestable status. Copies of these registrations are attached as Exhibit A.

5. On October 14, 2011, Applicant filed an application for U.S. Application Serial Number 85/447,839 to register the trademark ROSHEN & Design in connection with

“confectioneries, namely, candies, pastries, chocolate, hard candies, and fruit jelly candy” in International Class 30

6. Applicant’s application for ROSHEN & Design mark was published for opposition on March 27, 2012. Ferrero sought and was granted a timely extension of time to file a Notice of Opposition.

7. Ferrero’s use and registration of its ROCHER Marks in the United States predate any alleged use of Applicant’s ROSHEN & Design mark in the United States.

8. Applicant’s mark ROSHEN & Design is confusingly similar to Ferrero’s ROCHER Marks when used on or in connection with the goods, as applied for.

9. Given Ferrero’s prior and substantial use of the ROCHER Marks in connection with candy and confectionary products as well as the fame of the ROCHER Marks, Applicant’s use of the ROSHEN & Design mark as set forth in U.S. Application Serial Number 85/447,839 is likely to cause confusion, mistake, or deception with Ferrero’s ROCHER Marks, or to cause the mistaken belief by consumers of the parties’ respective goods and by others that Applicant or its goods are in some way legitimately connected with, sponsored by, or approved by Ferrero.

10. Applicant’s use of the mark ROSHEN & Design marks as set forth in U.S. Application Serial Number 85/447,839 is also likely to dilute and does dilute the distinctive quality of Ferrero’s famous ROCHER Marks.

11. Ferrero believes, and therefore states, that it will be damaged by the registration of the mark that is the subject of U.S. Application Serial Number 85/447,839.

WHEREFORE, Opposer Ferrero S.p.A. requests that this opposition be sustained and that U.S. Application Serial Number 85/447,839 be refused.

Please charge the required \$300 filing fee to the Deposit Account of Hogan Lovells US
LLP, Account No. 50-1349, referencing our client number 082047-000102

Respectfully Submitted,

HOGAN LOVELLS US LLP

/aks/

Dated: September 24, 2012

By: _____

Raymond A. Kurz
Anna Kurian Shaw
Lauren Chamblee
555 Thirteenth Street, N.W.
Washington, D.C. 20004
Telephone: (202) 637-5900
Fax: (202) 637-5910

Attorneys for Opposer,
Ferrero S.p.A.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY THAT the foregoing Notice of Opposition will be served upon the following attorney of record for U.S. Application Serial No. 85/447,839 by first class mail, postage prepaid, on September 24, 2012:

JOHN ALUMIT
PATEL & ALUMIT PC
16830 VENTURA BLVD, SUITE 360
ENCINO, CA 91436-1711
UNITED STATES



Abena S. Ankrah
HOGAN LOVELLS US LLP
555 Thirteenth Street N.W.
Washington, D.C. 20004
Telephone: (202) 637 -5600

Exhibit A

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,680,513

Registered Mar. 24, 1992

**TRADEMARK
PRINCIPAL REGISTER**

ROCHER

FERRERO S.P.A. (ITALY CORPORATION)
PIAZZALE PIETRO FERRERO
12051 ALBE, CUNEO, ITALY

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).

PRIORITY CLAIMED UNDER SEC. 44(D) ON
ITALY APPLICATION NO. 40288-C/88, FILED
3-11-1988, REG. NO. 513867, DATED 10-2-1989,
EXPIRES 3-11-2008.

OWNER OF U.S. REG. NOS. 1,416,162, 1,458,572
AND OTHERS.

THE ENGLISH TRANSLATION OF THE
WORD "ROCHER" IN THE MARK IS "ROCK".

SER. NO. 73-728,528, FILED 5-16-1988.

ALAN DATRI, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 2,048,551

United States Patent and Trademark Office

Registered Apr. 1, 1997

**TRADEMARK
PRINCIPAL REGISTER**

FERRERO ROCHER

FERRERO S.P.A. (ITALY CORPORATION)
PIAZZALE PIETRO FERRERO, 1
12051 ALBA (CUNEO), ITALY

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).
FIRST USE 1-0-1981; IN COMMERCE
5-13-1981.

OWNER OF U.S. REG. NOS. 1,261,844, 1,366,927
AND OTHERS.

THE ENGLISH TRANSLATION OF THE
WORD "ROCHER" IN THE MARK IS "ROCK".

SER. NO. 74-477,665, FILED 1-10-1994.

MICHAEL MASON, EXAMINING ATTORNEY