

ESTTA Tracking number: **ESTTA541329**

Filing date: **06/03/2013**

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	CADBURY UK LIMITED
Granted to Date of previous extension	06/19/2013
Address	PO Box 12 Bournville Lane Bournville Birmingham, B30 2LU UNITED KINGDOM
Attorney information	Robert A. Becker Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES rbecker@frosszelnick.com Phone:212-813-5900

Applicant Information

Application No	85784682	Publication date	02/19/2013
Opposition Filing Date	06/03/2013	Opposition Period Ends	06/19/2013
Applicant	Meenaxi Enterprise, Inc. 2500B Hamilton Boulevard South Plainfield, NJ 07080 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. All goods and services in the class are opposed, namely: Cereal based energy bars; Cookies; Eclairs

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant is not the owner of the applied-for mark so registration would violate Trademark Act Section 1(a).

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BOURNVITA		

Goods/Services	drink mixes
----------------	-------------

Attachments	F1238010.PDF(410527 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	/Robert Becker/
Name	Robert A. Becker
Date	06/03/2013

A. Opposer's BOURNVITA Mark

1. Opposer and its related entities manufacture and produce a wide variety of well-known food and beverage products that are sold around the world. Among these products is BOURNVITA brand drink mixes.

2. BOURNVITA branded malt drink mixes were launched in India in 1948. The brand is among the oldest brands in the malt food category and has been a leader in that category for over 60 years. Opposer has been marketing and selling BOURNVITA drink mixes in the United States, in the exact design format shown in the opposed application, continuously since prior to the filing date of the opposed intent-to-use Application or any date on which Applicant can rely in connection with the opposed Application.

3. Only Opposer and those entities that are authorized by Opposer may use the BOURNVITA mark (regardless of spacing or punctuation) in the United States.

4. Long prior to any date on which Applicant can rely, Opposer's BOURNVITA mark and product had become well known among consumers not only in the United States but also among consumers who are from or have family or cultural ties to India, Nigeria, and other African countries.

5. The BOURNVITA mark is wholly arbitrary as it relates to Opposer's goods. The term BOURN in Opposer's BOURNVITA mark was taken from Bournville Lane, the street on which Opposer is located, and Bournville, the town in which Opposer is located.

6. As a result of the use of the BOURNVITA mark in the United States by Opposer and those who have been authorized by Opposer to use the BOURNVITA mark, Opposer has acquired common law rights in the BOURNVITA mark, and consumers associate the BOURNVITA mark and the products marketed under that mark exclusively with Opposer. The BOURNVITA mark represents substantial goodwill of Opposer that merits protection.

B. Applicant and its Opposed Application

7. On information and belief, Applicant is a New Jersey corporation with a stated address of 2500B Hamilton Boulevard, South Plainfield, NJ 07080.

8. On information and belief, Applicant is engaged in importing well-known products from India and other countries and selling them to consumers in the United States. Among the products that Applicant imports and advertises on its website is Opposer's very BOURNVITA drink mix. In fact, the only BOURNVITA branded product advertised on Applicant's website is Opposer's product.

9. There is no agreement of any kind between Opposer and Applicant that would allow Applicant to use the BOURNVITA mark or to claim ownership of the mark.

10. As a matter of law, Applicant's distribution of BOURNVITA branded products of Opposer does not give Applicant any basis to claim ownership rights in or to the BOURNVITA mark. T.M.E.P. § 1201.06(a) (a distributing agent of goods of a manufacturer "does not acquire a right of ownership in the manufacturer's or producer's mark merely because it moves the goods in trade").

11. Applicant has never been authorized by Opposer to claim rights or ownership of the BOURNVITA (or BOURN VITA) mark or to sell BOURNVITA branded products to the public, and Applicant is not and has never been an authorized distributor of BOURNVITA branded goods. To the extent that Applicant is selling Opposer's product to the public it is without Opposer's permission or the permission of Opposer's authorized distributors.

12. On November 20, 2012, Applicant filed intent-to-use application Ser. No. 85/784,682 (the "Application") to register BOURN VITA and Design (the "Mark") for "cereal based energy bars; cookies; eclairs" in Class 30.

13. Applicant has never received any written consent from Opposer to register the Mark or to claim ownership of Opposer's mark.

14. As part of the Application, Applicant's representative, under Applicant's authorization, signed a declaration stating that "he...believes the applicant to be the owner of the trademark...sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he...believes applicant to be entitled to use such mark in commerce; to the best of his...knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive...." (This statement is hereafter referred to as the "Declaration Statement.")

15. As of the date that Applicant filed the opposed application and as of the date that Applicant executed the signed declaration, Applicant was at most distributing Opposer's BOURNVITA beverage mixes and was aware that the BOURNVITA mark used for such goods was associated exclusively with Opposer and with Opposer's goods.

16. Applicant's application and its assertion of exclusive rights in what it knows to be Opposer's very mark is inconsistent with Opposer's prior use of and rights in and to the BOURNVITA mark. Registration of the opposed mark will harm Opposer.

COUNT ONE
AS AND FOR A CLAIM FOR RELIEF FOR
LIKELIHOOD OF CONFUSION IN VIOLATION OF 15 U.S.C. §1052(d)

17. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 16 above as if fully set forth herein.

18. The mark sought to be registered by Applicant is identical to Opposer's mark. Indeed it copies exactly the very mark that Opposer has long been using for its drink mixes, the

very mark that appears on Opposer's product sold in the United States, and the very mark that appears on Opposer's goods that Applicant is distributing in the United States.

19. Both Opposer and Applicant use or seek to use the identical mark on goods that are clearly related. The products covered by the subject application and the flavored drink mixes marketed by Opposer under its BOURNVITA mark are all foods. Further, Opposer's BOURNVITA drink mixes and Applicant's energy bars are both marketed as nutritional products. The remaining goods in the application herein opposed are sufficiently complementary to Opposer's products that consumers would believe they come from a single source. This is evidenced by the fact that numerous companies market both drink mixes and food products under the same mark, including, by way of example only, Nestle and Hershey.

20. Given both the arbitrary nature and the uniqueness of the BOURNVITA mark, consumers will assume that there is a connection between the parties and their products by virtue of the use of the same unique and arbitrary mark.

21. Applicant's application is unrestricted as to consumers and as to channels of trade. Accordingly, as a matter of law it is presumed that the goods identified in Applicant's application will travel through all customary trade channels for such goods and will be made available to all consumers of such goods. The consumers and trade channels for the goods identified in the Application clearly overlap with the consumers and trade channels for Opposer's goods sold under the identical mark. Indeed, the fact that Applicant already sells Opposer's goods is proof of this overlap.

22. Registration of the subject mark by Applicant is likely to cause confusion or to cause mistake, or to deceive the trade and public into mistakenly believing that Applicant's goods to be offered under the subject mark by Applicant come from the same source as goods

bearing Opposer's BOURNVITA mark, or are otherwise authorized, sponsored, or licensed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

23. Registration of the subject mark by Applicant is inconsistent with Opposer's prior uses and ownership of the BOURNVITA mark.

24. By reason of the foregoing, Opposer will be damaged by the registration of the mark shown in Application Serial No. 85/784,682.

COUNT TWO
AS AND FOR A CLAIM FOR
RELIEF FOR FRAUD ON THE PTO

25. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 24 above as if fully set forth herein.

26. When Applicant filed the Application, Applicant, who had long been selling BOURNVITA branded products of Opposer, was fully aware that BOURNVITA was a brand of Opposer. As such, Applicant could not and on information and belief did not believe that no other person, firm, corporation, or association had the right to use the Mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

27. On information and belief, when Applicant filed the Application, Applicant knew that the Declaration Statement was false.

28. In executing and submitting the declaration in support of the Application, Applicant knowingly made a false, material misrepresentation of fact when it filed the Application, with the intent to defraud the United States Patent and Trademark Office, by claiming that no other person, firm, corporation, or association had the right to use that Mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or

in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, when in fact Applicant knew that Opposer had such right, and by obtaining a registration based on such fraudulent claim.

29. Applicant made the false statement in the Declaration Statement for the sole purpose of obtaining rights in the BOURNVITA mark to which it was not otherwise entitled.

30. Applicant's conduct constitutes fraud on the United States Patent and Trademark Office.

31. By virtue of Applicant's fraudulent statement, registration of the Mark must be refused. Registration of the applied-for Mark by Applicant would prevent Opposer, which is the rightful owner of the BOURNVITA mark, from registering that Mark itself. Such registration would also cast a cloud over Opposer's ownership of and right to use that Mark, since such registration would give Applicant a rebuttable presumption of an exclusive right to use the subject mark. Thus, registration of the applied-for Mark by Applicant would damage Opposer.

COUNT THREE
AS AND FOR A CLAIM FOR RELIEF AS
APPLICANT IS NOT THE OWNER OF THE APPLIED-FOR MARK

32. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 31 above as if fully set forth herein.

33. Applicant is not, and was not at the time of filing the Application, the rightful owner of the Mark it is applying for, and thus registration of the applied-for Mark by Applicant would violate Section 1(a) of the Lanham Act, 15 U.S.C. § 1051.

34. Applicant's sole claim is as an unauthorized distributor of Opposer's branded product. Applicant cannot claim or assert any rights in the marks used in connection with the goods that it sells absent an explicit agreement to the contrary which does not exist.

35. There is no parent-subsidary relationship between Applicant and Opposer.

36. Opposer has never consented to Applicant's registration of the Mark.

37. Opposer has never agreed or acknowledged that Applicant is the owner of the Mark in any jurisdiction.

38. Opposer has never assigned Opposer's rights in the Mark in any jurisdiction to Applicant.

39. Registration of the applied-for Mark by Applicant would prevent Opposer, which is the rightful owner of the BOURNVITA Mark, from registering that Mark itself. Such registration would also cast a cloud over Opposer's ownership of and right to use that Mark, since such registration would give Applicant a rebuttable presumption of an exclusive right to use the subject mark. Thus, registration of the applied-for Mark by Applicant would damage Opposer.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Application Serial No. 85/784,682 for registration of the mark BOURN VITA and Design be in all respects denied.

The Trademark Trial and Appeal Board is hereby authorized to charge the opposition filing fee of \$300 to oppose in International Class 30 to Opposer's counsel's deposit Account Number 230825.

Dated: New York, New York
June 3, 2013

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

Barbara A. Solomon

Robert A. Becker

Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the NOTICE OF OPPOSITION to be served by prepaid, first-class mail on this 3rd day of June, 2013, upon Applicant's correspondent of record as identified in the records of the United States Patent and Trademark Office, Jungjin Lee, Esq., Lee, Lee & Associates, P.C., 2531 Jackson Avenue, Suite 234, Ann Arbor, MI 48103-3818.



Robert A. Becker