

ESTTA Tracking number: **ESTTA561267**

Filing date: **09/25/2013**

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	Orkla Brands Russia		
Entity	Corporation	Citizenship	Russia
Address	Socialisticheskaja str., 24 Saint-Petersburg, 191119 RUSSIAN FEDERATION		

Attorney information	Anthony F. Lo Cicero Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 UNITED STATES ptodocket@arelaw.com Phone:212-336-8000		
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Applicant Information

Application No	85801942	Publication date	08/27/2013
Opposition Filing Date	09/25/2013	Opposition Period Ends	09/26/2013
Applicant	Odyssey of Flagler, Inc. 2501 S. Ocean Drive Suite 1131 Hollywood, FL 33019 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. All goods and services in the class are opposed, namely: Bread; Chocolate; Chocolate candies; Chocolate confections; Chocolate for confectionery and bread; Confectioneries, namely, snack foods, namely, chocolate; Confectionery chips for baking; Confectionery made of sugar; Confectionery, namely, pastilles; Flour; Frozen confectionery; Honey; Ice; Preparations made from cereals, namely, cookies, cakes and pastry
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85941024	Application Date	05/23/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	1913		

Design Mark	
Description of Mark	The mark consists of a design in a curved rectangular shape with 1913 at the top center of the design, Cyrillic characters that transliterate to PEKAR in large lettering in the center of the design and underneath it Cyrillic characters that transliterate to SEVERNOJ STOLITSI in smaller lettering in the bottom part of the design.
Goods/Services	Class 030. First use: First Use: 1998/07/31 First Use In Commerce: 2009/09/30 Waffles; confectionery for decorating Christmas trees; cakes; pastries; confectionery, namely fruit jelly candy, caramels, sweetmeats, peppermint sweets; cocoa powder; pastry; crackers; biscuits; petit-beurre biscuits; gingerbread; chocolate; tarts

Attachments	Notice of Opposition - PEKAR.pdf(242373 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 Overnight Courier on this date.

Signature	/Anthony F. Lo Cicero/
Name	Anthony F. Lo Cicero
Date	09/25/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ORKLA BRANDS RUSSIA,	: Application Serial No. 85/801,942
	: Filing Date: December 13, 2012
Opposer,	: Publication Date: August 27, 2013
	: Trademark: 1913 PEKAR SEVERNOJ
v.	: STOLICE & Design
	:
ODYSSEY OF FLAGLER, INC.,	:
	:
Applicant.	:

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NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 85/801,942 filed by Odyssey of Flagler, Inc. (“Applicant”) on December 13, 2012 and published for opposition in the August 27, 2013 issue of the Official Gazette of the United States Patent and Trademark Office for the trademark 1913 PEKAR SEVERNOJ STOLICE & Design in Cyrillic (the “Accused Mark”) as applied to Bread; Chocolate; Chocolate candies; Chocolate confections; Chocolate for confectionery and bread; Confectioneries, namely, snack foods, namely, chocolate; Confectionery chips for baking; Confectionery made of sugar; Confectionery, namely, pastilles; Flour; Frozen confectionery; Honey; Ice; Preparations made from cereals, namely, cookies, cakes and pastry in Class 30 (the “Subject Application”).

As grounds for opposition of the above identified trademark application, Orkla Brands Russia (“Opposer”), by and through its attorneys, alleges as follows:

BACKGROUND

1. Opposer, a Russian corporation maintaining a principal place of business at Socialisticheskaja str., 24, Saint-Petersburg, 191119, Russian Federation, believes that it will be damaged by the registration of the Subject Application and hereby opposes the same.

2. Opposer is one of the top confectionery producers in Russia, has been producing confectioneries in the Soviet Union and Russia for decades.

3. Among the many products sold by Opposer are confectioneries sold under the trademark 1913 PEKAR SEVERNOJ STOLICE & Design in Cyrillic (the “1913 PEKAR SEVERNOJ STOLICE & Design Mark”).

4. The 1913 PEKAR SEVERNOJ STOLICE & Design Mark has been used by Opposer in Russia for many years, and in interstate commerce in the United States since at least as early as September 30, 2009.

5. Applicant has distributed Opposer’s products for several years. Opposer and Applicant are parties to a January 9, 2013 distribution agreement confirming Applicant’s agreement to continue to distribute Opposer’s products sold under the 1913 PEKAR SEVERNOJ STOLICE & Design Mark in the United States.

6. Opposer is the owner of U.S. Trademark Application No. 85/941,024, filed May 23, 2013, for the trademark 1913 PEKAR SEVERNOJ STOLICE & Design as applied to waffles; confectionery for decorating Christmas trees; cakes; pastries; confectionery, namely fruit jelly candy, caramels, sweetmeats, peppermint sweets; cocoa powder; pastry; crackers; biscuits; petit-beurre biscuits; gingerbread; chocolate; tarts in Class 30.

7. Products sold under the 1913 PEKAR SEVERNOJ STOLICE & Design Mark have been advertised to the trade and purchasing public in the United States.

8. The 1913 PEKAR SEVERNOJ STOLICE & Design Mark, by reason of the high quality of products provided under the Mark, has come to be known to the purchasing public, including without limitation the Russian-speaking public, as representing candy and confectioneries of the highest quality as produced by Opposer. As a result thereof, the 1913

PEKAR SEVERNOJ STOLICE & Design Mark and the goodwill associated therewith are of inestimable value to Opposer.

9. By virtue of the renown acquired by the 1913 PEKAR SEVERNOJ STOLICE & Design Mark, coupled with Opposer's reputation for high quality products, the 1913 PEKAR SEVERNOJ STOLICE & Design Mark has acquired secondary meaning and has developed an enviable reputation in the minds of the purchasing public.

APPLICANT'S ACTIVITIES

10. Long after Opposer commenced use of the 1913 PEKAR SEVERNOJ STOLICE & Design Mark, and long after the 1913 PEKAR SEVERNOJ STOLICE & Design Mark became well known to consumers, Applicant applied to register the identical Accused Mark knowing Opposer to be the true owner of the Accused Mark.

11. Applicant is not the owner of either the 1913 PEKAR SEVERNOJ STOLICE & Design Mark or the Accused Mark, being solely a distributor of Opposer's products sold under the 1913 PEKAR SEVERNOJ STOLICE & Design Mark.

12. The Accused Mark is identical and confusingly similar to the 1913 PEKAR SEVERNOJ STOLICE & Design Mark. The likelihood of confusion is exacerbated because the 1913 PEKAR SEVERNOJ STOLICE & Design Mark and the Accused Mark are both used for candy and confectionery products.

13. Based on the foregoing, the use and/or registration of the Accused Mark by Applicant is likely to cause confusion and mistake in the minds of the purchasing public, and, in particular, will, upon information and belief, tend to falsely create the impression that any products sold by Applicant under the Accused Mark are authorized, sponsored, or approved by Opposer when, in fact, they are not.

14. Further, the sworn statement and declaration made by Applicant in the Subject Application, that “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” is false.

15. At the time the Subject Application was sworn to, Applicant was aware that Opposer had rights in and was the true owner of the identical 1913 PEKAR SEVERNOJ STOLICE & Design Mark and Accused Mark due to the fact that Applicant was acting as Opposer’s distributor in the United States and the parties ultimately entered into an agreement confirming Opposer’s ownership of the 1913 PEKAR SEVERNOJ STOLICE & Design Mark.

16. The sworn statement made by Applicant was made with knowledge that said statement was false and with the intent to induce the United States Patent & Trademark Office to grant the Subject Application, thus rendering the Subject Application void.

17. Accordingly, it is Opposer’s belief that if Applicant is granted the registration opposed herein, Opposer will suffer irreparable harm and damage.

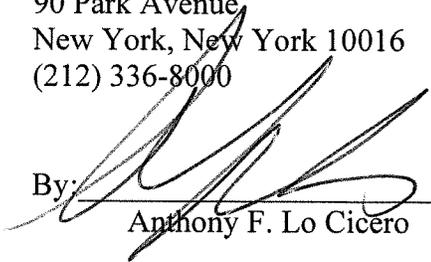
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WHEREFORE, Opposer respectfully requests that the mark shown in U.S. Trademark Application Serial No. 85/801,942 be refused registration and that this Opposition be sustained.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Opposer Orkla Brands Russia
90 Park Avenue
New York, New York 10016
(212) 336-8000

Dated: New York, New York
September 25, 2013

By: 
Anthony F. Lo Cicero

CERTIFICATE OF SERVICE

I hereby certify that true and complete copies of the foregoing NOTICE OF OPPOSITION have been served on Applicant Odyssey of Flagler, Inc. by delivering said copies via Federal Express, overnight delivery, prepaid to Applicant and its attorney of record, as follows:

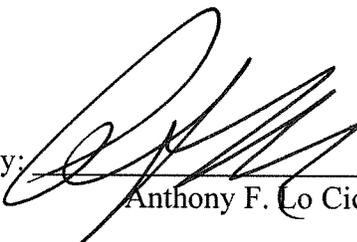
Applicant

Odyssey of Flagler, Inc.
2501 S. Ocean Drive, Suite 1131
Hollywood, FL 33019

Applicant's Attorney of Record

Julian Henry Lowenfeld, Esq.
350 Central Park West, Suite 13-C
New York NY 10025 USA

By: _____


Anthony F. Lo Cicero

Dated: September 25, 2013
New York, New York