

ESTTA Tracking number: **ESTTA628487**

Filing date: **09/22/2014**

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	Whole Foods Market IP, L.P.
Granted to Date of previous extension	09/21/2014
Address	550 Bowie Street 6th Floor Austin, TX 78703 UNITED STATES

Attorney information	Christopher L. Graff Pirkey Barber PLLC 600 Congress Avenue Suite 2120 Austin, TX 78701 UNITED STATES jmatthysse@pirkeybarber.com, cgraff@pirkeybarber.com, ryounger@pirkeybarber.com, drausa@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512-322-5200
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Applicant Information

Application No	86087817	Publication date	03/25/2014
Opposition Filing Date	09/22/2014	Opposition Period Ends	09/21/2014
Applicant	Ali Baba Holdings, LLC 6 Dover Road Hooksett, NH 03105 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: providing retail whole food grocery stores

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.	1557320	Application Date	01/04/1988
Registration Date	09/19/1989	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS MARKET		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/09/30 First Use In Commerce: 1980/09/30 RETAIL GROCERY STORE SERVICES, IN-STORERESTAURANT SERVICES, AND IN-STORE BAKERY SERVICES IN HEALTH FOODS AND NATURAL FOODS		

U.S. Registration No.	1961586	Application Date	10/11/1994
Registration Date	03/12/1996	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS MARKET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1980/09/30 First Use In Commerce: 1980/09/30 retail grocery store services, in-storerestaurant services, and in-store bakery services specializing in health foods and natural foods		

U.S. Registration No.	3212836	Application Date	02/20/2006
Registration Date	02/27/2007	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS WHOLE PEOPLE WHOLE PLANET		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/12/00 First Use In Commerce: 1998/07/00		

	Hats, caps, shirts, jackets, aprons		
U.S. Registration No.	4158967	Application Date	05/06/2011
Registration Date	06/12/2012	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS WINE & SPIRITS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2011/05/24 First Use In Commerce: 2011/05/24 Retail store services featuring liquor,wine, beer, and beverages		

U.S. Registration No.	3689908	Application Date	08/29/2007
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	WHOLE FOODS MARKET PREMIUM BODY CARE		
Design Mark			
Description of Mark	The mark consists of the color blue-green appears in the wording "WHOLE FOODS MARKET" and "PREMIUM BODY CARE", and in the top background of the inner circle; the color green appears in the bottom background of the inner circle; the color white appears in the leaf design in the inner circle, and in the		

	background of the outer circle behind the wording; the color gray appears as shading surrounding the mark.
Goods/Services	Class 003. First use: First Use: 2008/02/00 First Use In Commerce: 2008/02/00 Hair shampoo; skin soap; facial and skin lotions; hair conditioners; bath and shower gels; essential oils for personal use; toothpaste; hair cleaning preparations; hand cream; facial creams; skin creams; facial and skin moisturizers; body and facial scrubs; skin cleansers; eye cream; night cream; body and beauty care cosmetics; cosmetic creams; lip balm; non-medicated toiletries; liquid soap; bar-soap; body oils; massage oils and lotions; body and skin creams; body deodorants

U.S. Registration No.	3941591	Application Date	11/24/2009
Registration Date	04/05/2011	Foreign Priority Date	NONE

Word Mark	WHOLE FOODS MARKET RESPONSIBLY FARMED 3RD PARTY VERIFIED
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Description of Mark	The mark consists of the words "RESPONSIBLY FARMED" stacked on a banner beneath a design of a fish and above the words "3RD PARTY VERIFIED", all on a circular background with zig-zag edges. The word "VERIFIED" is depicted between two star designs, and beneath the words "3RD PARTY". The owner's registered house mark "WHOLE FOODS MARKET" is depicted atop the words "RESPONSIBLY FARMED".
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Goods/Services	Class 029. First use: First Use: 2010/07/00 First Use In Commerce: 2010/07/00 Seafood; fish; frozen prepared dinners, entrees and side dishes consisting primarily of fish, seafood, meat, or vegetables Class 035. First use: First Use: 2010/01/00 First Use In Commerce: 2010/01/00 Retail grocery store services; Promoting public awareness of environmentally-responsible seafood farming practices and the need to support such practices
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Attachments	73704031#TMSN.png(bytes) 78819055#TMSN.png(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	/Christopher L. Graff/
Name	Christopher L. Graff
Date	09/22/2014

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

In Re Serial No. 86/087,817	§	
Filed: October 10, 2013	§	
Mark: ALI BABA WHOLEFOODS	§	Opposition No. _____
FESTIVAL TREASURES	§	
Published: March 25, 2014	§	
	§	
Whole Foods Market IP, L.P.,	§	
	§	
Opposer,	§	
v.	§	
	§	
Ali Baba Holdings, LLC,	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

Opposer Whole Foods Market IP, L.P., a limited partnership organized under the laws of the State of Delaware, having an address at 550 Bowie Street, 6th Floor, Austin, Texas 78703, and whose general partner is WFM IP Management, Inc., a Delaware corporation, believes that it will be damaged by registration of the mark identified above, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer is the owner of the well-known WHOLE FOODS mark, as well as a family of WHOLE FOODS-formative marks, such as WHOLE FOODS MARKET, WHOLE FOODS WHOLE PEOPLE WHOLE PLANET, WHOLE FOODS WINE & SPIRITS, WHOLE FOODS MARKET PREMIUM BODY CARE, and WHOLE FOODS MARKET RESPONSIBLY FARMED 3RD PARTY VERIFIED (the “WHOLE FOODS Marks”), which have been used for decades in connection with an extremely successful chain of retail grocery stores and related goods and services, including food and beverage products and a wide array of consumer goods.

2. Opposer's use of its WHOLE FOODS Marks has been continuous and extensive.

3. The goods and services offered by Opposer under its WHOLE FOODS Marks are well-known in the industry and marketplace, and have been featured in leading publications such as THE NEW YORK TIMES, THE CHICAGO TRIBUNE, FORTUNE MAGAZINE, ZAGAT SURVEY GUIDES, and PEOPLE MAGAZINE, as well as on national television programs and networks such as *The Tonight Show with Jay Leno*, *Live with Regis and Kelly*, *Bravo*, and *The Food Network*.

4. As a result of Opposer's extensive use and promotion of its WHOLE FOODS Marks, the marks have become distinctive and are widely recognized by consumers. Opposer has invested significant effort and resources in advertising and promoting its WHOLE FOODS Marks and the goods and services offered under those marks, with the result that the purchasing public has come to know, rely on, and recognize the goods and services of Opposer by the WHOLE FOODS Marks. Opposer has established significant goodwill in its WHOLE FOODS Marks

5. Several of Opposer's WHOLE FOODS Marks have become famous for all purposes relevant to this proceeding, including within the meaning of 15 U.S.C. § 1125(c)(2)(A).

6. In addition to its extensive common-law rights, Opposer is the owner of numerous United States Trademark registrations covering its WHOLE FOODS Marks.

Opposer's registrations include, but are not limited to those listed below:

Mark	U.S. Reg. No.	Registration Date
WHOLE FOODS MARKET (Stylized)	1,557,320	September 19, 1989
WHOLE FOODS MARKET	1,961,586	March 12, 1996
WHOLE FOODS WHOLE PEOPLE WHOLE PLANET	3,212,836	February 27, 2007
WHOLE FOODS WINE & SPIRITS	4,158,967	June 12, 2012
WHOLE FOODS MARKET PREMIUM BODY CARE (& Design)	3,689,908	September 29, 2009
WHOLE FOODS MARKET	3,941,591	April 05, 2011

RESPONSIBLY FARMED 3RD PARTY VERIFIED (& Design)		
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Each registration listed above is valid and subsisting, and the first three registrations are incontestable pursuant to 15 U.S.C. § 1065.

7. Ali Baba Holdings, LLC (the “Applicant”) is a limited liability company with an address of 6 Dover Road, Hooksett, New Hampshire 03105. The Applicant filed U.S. Serial No. 86/087,817 (the “Application”) pursuant to 15 U.S.C. § 1051(b) on October 10, 2013 for the mark ALI BABA WHOLEFOODS FESTIVAL TREASURES (“Applicant’s Mark”). The Application covers “providing retail whole food grocery stores” in Class 35.

8. There is no issue as to Opposer’s priority. Opposer’s first use in commerce of its WHOLE FOODS Marks precedes any date of first use of Applicant’s Mark and the filing date of the Application.

9. Opposer has not given Applicant permission or approval to use or register Applicant’s Mark.

10. Applicant’s services are, upon information and belief, purchased and used by the same or similar types of consumers who purchase and use Opposer’s goods and services.

11. Applicant’s Mark so resembles Opposer’s WHOLE FOODS Marks as to be likely, when used in connection with Applicant’s identified services, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are familiar with Opposer’s WHOLE FOODS Marks and are likely to mistakenly believe that the services Applicant intends to offer under Applicant’s Mark are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its WHOLE FOODS products and services. Registration should therefore be refused under 15 U.S.C. §§ 1052(d) and 1063.

12. Further, Applicant's Mark is likely to cause dilution by blurring of Opposer's famous WHOLE FOODS Marks, and registration should therefore also be refused under 15 U.S.C. § 1125(c).

Wherefore, Opposer prays that Application Serial No. 86/087,817 be rejected, and that registration of Applicant's Mark be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.R. F. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/WFMV:5645/CLG, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: September 22, 2014

/Christopher L. Graff/
Christopher L. Graff
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Austin, TX 78701
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ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served via First-Class Mail, postage pre-paid, on September 22, 2014 on Applicant's attorney of record at the address below:

Kimberly A. Peaslee
Devine, Millimet & Branch
111 Amherst Street
Manchester, New Hampshire 03101-1809

/Christopher L. Graff/
