

ESTTA Tracking number: **ESTTA724894**

Filing date: **02/04/2016**

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 | Great Harvest Franchising, Inc. |
| Granted to Date of previous extension | 02/24/2016 |
| Address | 28 South Montana Street Dillon, MT 59725 UNITED STATES |
| Attorney information | CASIMIR W COOK II ANVIL LAW PLC 2723 SOUTH STATE STREET, SUITE 150 ANN ARBOR, MI 48104 UNITED STATES docketing@anvil-law.com, ccook@anvil-law.com Phone:734-794-4727 |

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86549341 | Publication date | 10/27/2015 |
| Opposition Filing Date | 02/04/2016 | Opposition Period Ends | 02/24/2016 |
| Applicant | Pumpnickel Associates, LLC 3630 S. Geyer Road St. Louis, MO 63127 UNITED STATES | | |

Goods/Services Affected by Opposition

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| <p>Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products, excluding ice cream, ice milk, and frozen yogurt; edible oils and fats; soups, vegetable and garden salads, tuna fish salad, stews, potato chips, cream cheese, meat, poultry, pork, beef, salmon, yogurt-based beverages, fruit salads, milk based beverages containing coffee, milk based beverages containing fruit, egg souffl s; prepackaged meals consisting primarily of meat, seafood or poultry</p> |
| <p>Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour; bread,pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces; spices; ice; bakery goods, coffee and tea drinks, coffee and tea based beverages, chocolate based beverages, brownies, prepared pastas, egg sandwiches, hot and cold sandwiches, pasta, bread, bagels, pastries, panini, cookies, muffins, oat-meal,granola, parfaits, salad dressings</p> |
| <p>Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Services for providing food and drink; tem-</p> |

porary accommodation; Restaurant, cafe and catering services; take-out restaurant services; restaurants featuring delivery; food preparation; preparation of carry out foods and beverages

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86549344 | Publication date | 10/27/2015 |
| Opposition Filing Date | 02/04/2016 | Opposition Period Ends | |
| Applicant | Pumpnickel Associates, LLC 3630 S. Geyer Road St. Louis, MO 63127 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 029. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products, excluding ice cream, ice milk, and frozen yogurt; edible oils and fats; soups, vegetable and garden salads, tuna fish salad, stews, potato chips, cream cheese, meat, poultry, pork, beef, salmon, yogurt-based beverages, fruit salads, milk based beverages containing coffee, milk based beverages containing fruit, egg souffl s; prepackaged meals consisting primarily of meat, seafood or poultry

Class 030. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour; bread,pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces; spices; ice; bakery goods, coffee and tea drinks, coffee and tea based beverages, chocolate based beverages, brownies, prepared pastas, egg sandwiches, hot and cold sandwiches, pasta, bread, bagels, pastries, panini, cookies, muffins, oat-meal,granola, parfaits, salad dressings

Class 043. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Services for providing food and drink; temporary accommodation; Restaurant, cafe and catering services; take-out restaurant services; restaurants featuring delivery; food preparation; preparation of carry out foods and beverages

Grounds for Opposition

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|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | Reverse confusion |

Mark Cited by Opposer as Basis for Opposition

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|-----------------------|--------------------------------|-----------------------|------------|
| U.S. Registration No. | 4862062 | Application Date | 10/22/2014 |
| Registration Date | 12/01/2015 | Foreign Priority Date | NONE |
| Word Mark | BREAD. THE WAY IT OUGHT TO BE. | | |

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|---------------------|---|
| Design Mark | BREAD. THE WAY IT OUGHT TO BE. |
| Description of Mark | NONE |
| Goods/Services | Class 030. First use: First Use: 2014/08/00 First Use In Commerce: 2014/08/00 Bread; cookies; flour Class 035. First use: First Use: 2014/08/00 First Use In Commerce: 2014/08/00 Franchising services, namely, business management advisory services in the establishment and/or operation of retail bakeries; retail bakery shop services Class 040. First use: First Use: 2014/08/00 First Use In Commerce: 2014/08/00 Bakery services, namely, manufacturing bakery products to order and/or specifications of others Class 043. First use: First Use: 2014/08/00 First Use In Commerce: 2014/08/00 Restaurant and caf  services |

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| Attachments | 86431516#TMSN.png(bytes) 975-0041_NoticeOfOpposition-2-4-16.pdf(70023 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 | /Casimir W. Cook II/ |
| Name | CASIMIR W COOK II |
| Date | 02/04/2016 |

milk and milk products, excluding ice cream, ice milk, and frozen yogurt; edible oils and fats; soups, vegetable and garden salads, tuna fish salad, stews, potato chips, cream cheese, meat, poultry, pork, beef, salmon, yogurt-based beverages, fruit salads, milk based beverages containing coffee, milk based beverages containing fruit, egg soufflés; prepackaged meals consisting primarily of meat, seafood or poultry,” in International Class 29; “coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour; bread, pastry and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces; spices; ice; bakery goods, coffee and tea drinks, coffee and tea based beverages, chocolate based beverages, brownies, prepared pastas, egg sandwiches, hot and cold sandwiches, pasta, bread, bagels, pastries, panini, cookies, muffins, oatmeal, granola, parfaits, salad dressings,” in International Class 30; and “services for providing food and drink; temporary accommodation; Restaurant, cafe and catering services; take-out restaurant services; restaurants featuring delivery; food preparation; preparation of carry out foods and beverages,” in International Class 43 (hereafter “Applicant’s Goods and Services”), and hereby opposes the same.

As grounds of opposition it is alleged that:

1. Great Harvest is now and has for many years been engaged in the development, marketing, advertising, distribution and sale of various products and services including, retail bakery shops, baked goods, restaurants, and related goods and services throughout the United States.

2. Great Harvest owns the trademark/service mark BREAD. THE WAY IT OUGHT TO BE. (“Opposer’s Mark”). From at least as early as August 2014, to the present, long prior to the February 28, 2015 filing date of the Applications and, upon information and belief, long prior

to any date of first use of Applicant's Opposed Marks that Applicant can claim in connection with Applicant's Goods and Services, Great Harvest has used the trademark/service mark BREAD. THE WAY IT OUGHT TO BE. in connection with, and to identify and distinguish its restaurant and bakery goods and services.

3. Opposer's Mark is extensively advertised in the United States, and has appeared on or in relation to products and services, product packaging, point-of-sale displays and other promotional materials for products and services sold, offered and advertised, and/or have been used in connection with its restaurant and bakery goods and services, and various other products and services related or complementary thereto, advertised, offered, conducted and/or promoted in the United States.

4. Opposer owns United States Combined Trademark/Service Mark Registration No. 4862062 – BREAD. THE WAY IT OUGHT TO BE. covering “bread; cookies; flour,” in International Class 30; “franchising services, namely, business management advisory services in the establishment and/or operation of retail bakeries; retail bakery shop services,” in International Class 35; “bakery services, namely, manufacturing bakery products to order and/or specifications of others,” in International Class 40; and “restaurant and café services,” in International Class 43. (“Opposer's Goods and Services”) This registration is valid and subsisting.

5. As a result of the use described in paragraphs 1, 2 and 3 above, Opposer's Mark functions as a distinctive trademark and service mark identifying Opposer's Goods and Services, and has functioned as such since prior to the filing date of the Applications and, on information and belief, any date of first use that Applicant can claim for Applicant's Opposed Marks in connection with Applicant's Goods and Services or any other goods or services.

7. Applicant intends to use and is currently using Applicant's Opposed Marks in commerce in connection with Applicant's Goods and Services.

8. Applicant is not now and never was entitled to register Applicant's Opposed Marks as trademarks or service marks for Applicant's Goods and Services.

9. Applicant was not entitled to exclusive use of Applicant's Opposed Marks as trademarks or service marks on the date it filed the Applications, namely, February 28, 2015, or on the date of publication of the Applications, October 27, 2015.

10. As between Opposer's Mark and Applicant's Opposed Marks, Great Harvest is the senior filer, senior user and senior registrant.

11. Upon information and belief, Applicant did not use Applicant's Opposed Marks as a tradename, trademark, service mark or in any manner analogous to tradename, trademark or service mark use in connection with Applicant's Goods prior to the February 28, 2015 filing date of the Applications.

12. Applicant's Goods and Services are closely commercially related and in part identical to Opposer's Goods and Services identified by Opposer's Mark such that purchasers, prospective purchasers, persons in the trade, and the public are likely to believe, contrary to fact, that Applicant's Goods and Services and Opposer's Goods and Services originate from the same source or that Applicant and Opposer are affiliated with or in some other way associated with each other.

13. Applicant's Opposed Marks so resemble marks previously used and in use in the United States and not abandoned, namely, Opposer's Mark, as to be likely to cause confusion, or to cause mistake, or to deceive when used in connection with Applicant's Goods and Services.

14. Because Applicant's Goods and Services are so closely related to and in part identical to Opposer's Goods and Services, the contemporaneous use of Applicant's Opposed Marks and Opposer's Mark in connection with the parties' respective goods and services is likely to cause confusion, or mistake or deception among purchasers, potential purchasers and the public, and in the trade, to the damage of Opposer.

15. The use of Applicant's Opposed Marks for Applicant's Goods and Services is likely to cause confusion, mistake or deception by causing purchasers, potential purchasers, members of the public and the trade to mistakenly assume or believe that such goods and services emanate from Opposer, or are in some other way associated or connected with or sponsored by Opposer, all to Opposer's irreparable damage.

16. The use of Applicant's Opposed Marks for Applicant's Goods and Services is likely to cause confusion, mistake or deception by causing purchasers, potential purchasers, members of the public and the trade to mistakenly assume or believe that such goods and services emanate from Opposer, or are in some other way associated or connected with or sponsored by Opposer, all to Opposer's irreparable damage.

17. Upon information and belief, Applicant has expended millions of dollars in advertising and videos that have been and continue to be presented to the public as a part of a saturation campaign for Applicant's Opposed Marks which usurp the goodwill and associated rights, of the senior user, Great Harvest, in Opposer's Mark.

18. Upon information and belief, Applicant's advertising campaign and continued use of Applicant's Opposed Marks are calculated to instill in the minds of consumers an association between the Applicant's Opposed Marks and food products and services.

19. Applicant's advertising campaign and continued use of Applicant's Opposed Marks results in reverse confusion in that use of Opposer's Mark for Opposer's Goods and Services is likely to cause confusion, mistake or deception by causing purchasers, potential purchasers, members of the public and the trade to mistakenly assume or believe that such goods and services emanate from Applicant, or are in some other way associated or connected with or sponsored by Applicant, all to Opposer's irreparable damage.

20. Applicant's Opposed Marks were published in contravention of, and their registration is barred by the provisions of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. 1052(d), as amended, because they consists of or comprise marks that so resembles Opposer's Mark as to be likely, when applied to the Applicant's Goods and Services to cause confusion or to cause mistake or to deceive.

21. Opposer is being or will be damaged by the use and registration of Applicant's Opposed Marks for Applicant's Goods and Services, because purchasers, prospective purchasers, persons in the trade, the public and Opposer's own customers will mistakenly believe, contrary to fact, that Applicant is licensed or endorsed or sponsored or franchised by, or is in some other way affiliated or connected with Opposer, to the detriment and damage of Opposer.

22. Opposer is being or will be damaged by the use and registration of Applicant's Opposed Marks for Applicant's Goods and Services, because purchasers, prospective purchasers, persons in the trade, the public and Opposer's own customers will mistakenly believe, contrary to fact, that Opposer is licensed or endorsed or sponsored or franchised by, or is in some other way affiliated or connected with Applicant, to the detriment and damage of Opposer.

* * * * *

WHEREFORE, Opposer respectfully prays that this Notice of Opposition be granted and sustained, and that the Applicant be refused registration of PANERA FOOD AS IT SHOULD BE and PANERA BREAD FOOD AS IT SHOULD BE for Applicant's Goods and Services set forth in Application Nos. 86/549,341 and 86/549,344.

This Notice of Opposition is submitted electronically through ESTTA, together with payment by credit card in the amount of \$1600.00 in payment of the statutory filing fee.

Respectfully submitted,

GREAT HARVEST FRANCHISING, INC.



Dated: February 4, 2016

Casimir W. Cook, II
Anvil Law, PLC
2723 South State Street, Suite 150
Ann Arbor, MI 48104
Main Telephone: (734) 794-4727

Attorney for Opposer

CERTIFICATE OF SERVICE

The undersigned counsel does hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served upon Applicant at Applicant's address of record, on the 4th day of February 2016, by first-class mail, postage prepaid, and addressed as follows:

Hope V. Shovein
Brooks Kushman P C
1000 Town Ctr Fl 22
Southfield, MI 48075-1183



Georgia Alberter