

ESTTA Tracking number: **ESTTA746558**

Filing date: **05/16/2016**

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	Cackalacky, Inc.
Granted to Date of previous extension	05/14/2016
Address	P.O. Box 605 Pittsboro, NC 27312 UNITED STATES

Correspondence information	Cackalacky, Inc. P.O. Box 605 Pittsboro, NC 27312 UNITED STATES dphillips@rbh.com Phone:919-328-8808
----------------------------	--

Applicant Information

Application No	86748917	Publication date	03/15/2016
Opposition Filing Date	05/16/2016	Opposition Period Ends	05/14/2016
Applicant	Rhodes, Terrell T PO Box 292520 Columbia, SC 29229 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2002/04/01 First Use In Commerce: 2002/04/01 All goods and services in the class are opposed, namely: Clothing, namely, pants, shirts, t-shirts, sweatshirts, shorts, headwear, and footwear

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2959504	Application Date	11/09/2003
Registration Date	06/07/2005	Foreign Priority Date	NONE
Word Mark	CACKALACKY		

Design Mark	<h1>CAKALACKY</h1>
-------------	--------------------

Description of Mark	NONE
---------------------	------

Goods/Services	<p>Class 016. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 [notepaper; loose leaf paper; note pads; children's books; newsletters having a retail, restaurant and/or food-based interest or theme; information publications, namely, pamphlets, brochures, newsletters, journals, and magazines being of a retail, restaurant and/or food-based interest or theme; cook books; cooking instruction sheets; order forms; recipe cards; recipe instruction sheets; announcement cards; bar code labels; business forms; business cards; restaurant periodicals, entertainment and food-oriented publications, namely, pamphlets, brochures, newsletters, journals, and magazines being of a retail, restaurant and/or food-based interest or theme; decals, namely, adhesive, non-adhesive, thermal, non-thermal, iron-on, press-on, pressure-sensitive, static, temporary and permanent decals; decalcomania decals; temporary tattoos; stationery; stickers; writing implements such as pens and pencils; cardboard floor display units for merchandising products; photographs; pictures; calendars; posters; pamphlets being of a retail, restaurant and/or food-based interest or theme; shipping labels; printed paper labels, namely, product labels; envelopes; fax paper; paper party decorations; paper party and decorative packaging, namely, packing cardboard containers, industrial packaging containers of paper, paper bags for packaging, plastic bags for packaging, paper wrapping, and plastic wrapping all for shipping; paperweights; scratch pads; sheet music; song books; clothing transfers, namely, decals for clothing, adhesive labels for clothing, iron-on, plastic, and thin-film, screen print forms; trivia cards; paper napkins; signs, namely, paper and cardboard signs; paper place mats; informational flyers, not for advertising, and being of a retail, restaurant and/or food-based interest or theme; circulars being of a retail, restaurant and/or food-based interest or theme; printed menus; coupons; cardboard containers;] bumper stickers; [printed tickets; book covers; cardboard flags; paper and printed emblems; paper party hats; fabric gift bags]</p>
----------------	--

U.S. Registration No.	4022436	Application Date	02/04/2011
Registration Date	09/06/2011	Foreign Priority Date	NONE
Word Mark	CAKALACKY		

Design Mark	CACKALACKY
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 Hot chili pepper sauce and hot chili pepper spice mix

U.S. Registration No.	4684866	Application Date	08/25/2014
Registration Date	02/10/2015	Foreign Priority Date	NONE

Word Mark	CACKALACKY
-----------	------------

Design Mark	
-------------	---

Description of Mark	The mark consists of a stylized version of a Pepper smoking a pipe and wearing a western-styled cowboy-type hat and a bandanna. The figure is within and partially obscuring an oval line. A star is centered outside of and on each side of the oval. The stylized literal element "CACKALACKY" is centered over the figure.
---------------------	---

Goods/Services	Class 030. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 Pepper-based sauces and pepper-based foodstuff products, namely, being hot sauces, seasonings in the form of sprinkles for decorative and flavoring food purposes, seasonings, dipping sauces, marinades; barbecue and grilling sauces or dry rubs; and, chicken wing sauces
----------------	--

U.S. Registration No.	4927628	Application Date	08/26/2015
-----------------------	---------	------------------	------------

Registration Date	03/29/2016	Foreign Priority Date	NONE
Word Mark	CACKALACKY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2013/01/24 First Use In Commerce: 2013/01/24 Flavored nuts; Seasoned nuts; Spicy nuts, namely, PEANUTS		

U.S. Registration No.	4932610	Application Date	11/16/2015
Registration Date	04/05/2016	Foreign Priority Date	NONE
Word Mark	CACKALACKY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/02/28 First Use In Commerce: 2002/02/28 Aprons; Caps; Headwear; Scarfs; T-shirts		

U.S. Registration No.	4932571	Application Date	10/21/2015
Registration Date	04/05/2016	Foreign Priority Date	NONE
Word Mark	CACKALACKY		

Design Mark	<h1>CAKALACKY</h1>		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2015/08/29 First Use In Commerce: 2015/08/29 Sandwiches		

U.S. Registration No.	4941511	Application Date	11/17/2015
Registration Date	04/19/2016	Foreign Priority Date	NONE
Word Mark	CAKALACKY		
Design Mark	<h1>CAKALACKY</h1>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2003/05/05 First Use In Commerce: 2003/05/05 Financial sponsorship of athletes and athletic events; financial sponsorship of musical and cultural events; financial sponsorship of food and culinary related events; Philanthropic services relating to making contributions to charitable and community organizations		

U.S. Registration No.	4464201	Application Date	12/07/2012
Registration Date	01/07/2014	Foreign Priority Date	NONE
Word Mark	CAKALACKY		
Design Mark	<h1>CAKALACKY</h1>		
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2013/01/27 First Use In Commerce: 2013/01/27 beer; beer, ale, lager, stout and porter; flavored beers; spiced beers		

U.S. Application No.	86918384	Application Date	02/24/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CACKALACKY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2001/12/11 First Use In Commerce: 2001/12/11 On-line retail store services featuringFOOD, SEASONINGS, CLOTHING, SPORTING GOODS, OUTDOOR GEAR, GLASSWARE, BARWARE, BEVERAGE COZIES, BUMPER STICKERS		

Attachments	78325250#TMSN.png(bytes) 85234134#TMSN.png(bytes) 86375787#TMSN.png(bytes) 86738200#TMSN.png(bytes) 86821897#TMSN.png(bytes) 86794759#TMSN.png(bytes) 86823172#TMSN.png(bytes) 85797123#TMSN.png(bytes) 86918384#TMSN.png(bytes) NOTICE OF OPPOSITION.pdf(13737 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	/J. Dickson Phillips, III/
Name	Cackalacky, Inc.
Date	05/16/2016

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

In the Matter of U.S. Application Serial No. 86748917

Mark: CACKALAK

Filing Date: September 6, 2015

Cackalacky, Inc., a North Carolina corporation,

Opposer,

v.

Terrell T. Rhodes, an individual,

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

Opposer Cackalacky, Inc., a North Carolina corporation, believes it will be damaged by registration of the mark CACKALAK shown in Application Serial No. 86748917 filed by Applicant Terrell T. Rhodes, and therefore hereby opposes that application.

As grounds in support of its opposition, Opposer alleges:

1. Opposer is engaged primarily in the business of producing and selling spiced sauces and nuts and various merchandise including t-shirts, caps, and bumper stickers under the mark CACKALACKY, and licenses its mark CACKALACKY to producers and vendors of beer and other food items.
2. Opposer is the owner of the following U.S. Trademark Registrations, all of which are valid and subsisting:
 - a. Reg. No. 2959504 for the trademark CACKALACKY for bumper stickers;

b. Reg. No. 4022436 for the trademark CACKALACKY for hot chili pepper sauce and hot chili pepper spice mix;

c. Reg. No. 4684866 for the trademark CACKALACKY and design for pepper-based sauces and pepper-based foodstuff products, namely, being hot sauces, seasonings in the form of sprinkles for decorative and flavoring food purposes, seasonings, dipping sauces, marinades; barbecue and grilling sauces or dry rubs; and, chicken wing sauces;

d. Reg. No. 4927628 for the trademark CACKALACKY for flavored nuts; seasoned nuts; spicy nuts, namely, peanuts;

e. Reg. No. 4932610 for the trademark CACKALACKY for aprons; caps; headwear; scarves; t-shirts;

f. Reg. No. 4932571 for the trademark CACKALACKY for sandwiches;

g. Reg. No. 4941511 for the trademark CACKALACKY for financial sponsorship of athletes and athletic events; financial sponsorship of musical and cultural events; financial sponsorship of food and culinary related events; philanthropic services relating to making contributions to charitable and community organizations;

h. Reg. No. 4464201 (supplemental register) for the trademark CACKALACKY for beer, ale, lager, stout and porter; flavored beers; spiced beers.

3. Opposer is also the owner of U. S Trademark application serial number 86918384 for the mark CACKALACKY for on-line retail store services featuring food, seasonings, clothing, sporting goods, outdoor gear, glassware, barware, beverage cozies, bumper stickers.

4. Through long term use of its mark commencing in 2001, and the popularity of its goods and services, Opposer has acquired substantial goodwill and value in its CACKALACKY mark. Opposer's food products have been featured in national publications and media, including Bon

Appetit, Southern Living, The Washington Post, National Public Radio, and Comedy Central, among others.

5. Opposer has used the CACKALACKY mark since long prior to the filing date of the application opposed herein and prior to any date of first use upon which Applicant can rely. Opposer's rights in the CACKALACKY mark were accordingly established prior to any date on which Applicant can rely.

6. Upon information and belief, neither Applicant nor any predecessor of Applicant was making bona fide use in commerce of the proposed CACKALAK mark on any of the goods identified in its application at the time it filed its opposed application under section 1(a) of the Lanham Act.

7. Upon information and belief, Applicant is not making bona fide use in commerce of the proposed CACKALAK mark, or Applicant's use fails to function as a mark, in connection with any of the goods identified in its application.

8. Applicant's alleged use and registration of the CACKALAK mark is without Opposer's permission or authorization.

9. Applicant is in no way authorized, sponsored, or licensed by, or in any other way legitimately connected with, Opposer.

10. The proposed CACKALAK mark, when used for the goods in the application opposed, so resembles Opposer's CACKALACKY mark as to be likely to cause confusion, mistake, and/or deception within the meaning of Section 2(d) of the Trademark Act, to the consequent damage of Opposer.

11. By reason of the foregoing, Opposer would be damaged by Applicant's registration of the CACKALAK mark as sought in Application Serial No. 86748917.

WHEREFORE, Opposer Cackalacky, Inc. respectfully requests that this opposition be sustained and the registration sought by Applicant in Serial No. 86748917 for the mark CACKALAK be denied.

This 15th day of July, 2016.

Respectfully submitted,

/J. Dickson Phillips, III/

J. Dickson Phillips, III
ROBINSON, BRADSHAW & HINSON, P.A.
1450 Raleigh Road, Suite 100
Chapel Hill, North Carolina 27517
Telephone: (919) 328.8808
Facsimile: (919) 328.8794
E-mail: dphillips@rbh.com
Attorneys for Cackalacky, Inc.

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Notice of Opposition was served on Applicant by mailing a copy by first class mail, certified, postage prepaid, to the following address of record with the Trademark Trial and Appeal Board:

Terrell T. Rhodes
P.O. Box 292520
Columbia, SOUTH CAROLINA 29229

Dated: May 16, 2016

/J. Dickson Phillips, III/

J. Dickson Phillips, III
ROBINSON, BRADSHAW & HINSON, P.A.
1450 Raleigh Road, Suite 100
Chapel Hill, North Carolina 27517
Telephone: (919) 328.8808
Facsimile: (919) 328.8794
E-mail: dphillips@rbh.com
Attorneys for Cackalacky, Inc.