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U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64



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

MARS, INCORPORATED,
(successor-in-interest to Uncle Ben's, Inc.),

Opposer,

v.

MOHAMED MUSTAFA &
SAMSUDDIN CO. PTE. LTD.,

Applicant.

Serial No.: 76/027,299

Opposition No.:

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NOTICE OF OPPOSITION

In the matter of pending trademark application Serial No. 76/027,299 for the mark UNCLE COOK'S (hereinafter the "Mark") filed by Mohamed Mustafa & Samsuddin Co. Pte. Ltd., Block 668, No. 02-18, Chander Road, Singapore 210668 (hereinafter "Applicant") for "preserved lentils and preserved nuts; edible oil; dried, cooked and preserved fruits and vegetables; prepared snack foods, namely, fruit-based snack foods and potato based snack foods; foodstuffs prepared in the form of fillings, namely, fruit-based filling for cakes and pies in International Class 29; Prepared snack foods, namely, rice-based snack foods, wheat based snack foods, and cereal-based snack foods; foodstuffs prepared in the form of fillings, namely, custard based fillings for cakes and pies, chocolate-based fillings for cakes and pies, and stuffing mixes containing bread; rice; flour; spices in International Class 30", published in the Official Gazette of November 19, 2002, Petitioner Mars, Incorporated, successor-in-interest (by merger effective December 28, 2002) to Uncle Ben's, Inc. (hereinafter "Opposer"), whose business address is 3250 E. 44th

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Street, Vernon, California 90058, believes it will be damaged by the registration of such trademark and hereby opposes same.

The grounds for opposition are as follows:

1. Opposer is, and through Uncle Ben's, Inc., for many years has been, an internationally known manufacturer, distributor and seller of food products including, *inter alia*, UNCLE BEN'S® Brand rices; rice mixes; packaged entrees (containing meat, vegetables, rice, pasta, cheese, sauces and seasonings); packaged "breakfast bowls" containing, *inter alia*, fruit, pancakes and French toast; soups, stuffing mixes, rice pudding mixes, sauces and marinades.

2. Opposer is using the distinctive trademark UNCLE BEN'S® in interstate commerce, and has used that trademark in connection with food products since at least as early as 1937.

3. Long prior to the filing date of the instant intent-to-use application, Opposer adopted and used the famous trademark UNCLE BEN'S® for food products and related services. In connection with such use, Opposer has spent substantial sums of money advertising and promoting its products and services sold under the UNCLE BEN'S® trademark, and has enjoyed substantial sales of such products and services.

4. Opposer is the owner of numerous Federal trademark registrations for the trademark UNCLE BEN'S®. These trademark registrations include the following:

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
UNCLE BEN'S	437,176	March 9, 1948	rice for food

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
UNCLE BEN'S	740,123	October 30, 1962	food mixes consisting of rice, dehydrated vegetables, chicken or meat extracts, spices, seasonings and other food ingredients
UNCLE BEN'S	903,134	November 24, 1970	rice
UNCLE BEN'S CHILI BOWL	2,511,231	November 20, 2001	frozen rice and vegetable dishes
UNCLE BEN'S	1,695,480	June 16, 1992	gravies and sauces
UNCLE BEN'S AND DESIGN	1,888,708	April 11, 1995	rice
UNCLE BEN'S	1,995,687	August 20, 1996	rice pudding mix
UNCLE BEN'S	1,997,104	August 27, 1996	rice and beans mix
UNCLE BEN'S	2,001,081	September 17, 1996	soup mixes
UNCLE BEN'S	2,002,712	September 24, 1996	stuffing mixes containing bread

Certified copies of these registrations (as well as others) will be made of record during Opposer's Testimony Period.

5. As a result of the substantial use, sales, advertising and promotion by Opposer of products bearing the UNCLE BEN'S® trademark, that trademark has become famous and exclusively associated with Opposer. Further, as a result of this

extensive use, Opposer has acquired an eminent reputation and valuable goodwill throughout the United States in the UNCLE BEN'S® trademark.

6. Because the UNCLE BEN'S® trademark and the goods and services sold under that trademark are exclusively associated with Opposer, the registration of the substantially similar mark UNCLE COOK'S by Applicant for food products, namely the products identified in the application opposed herein, will inevitably cause confusion in the minds of the public, leading the public to believe that Applicant's goods emanate from Opposer or that Applicant is in some way associated with or connected to Opposer, when no such relationship exists.

7. Given the nature of the products upon which Applicant has alleged it has an intention to use the mark, it is highly likely that such products will be advertised, promoted and sold through many (if not all) of the same channels of trade as, and to the same class of consumers as, the food products bearing Opposer's famous and distinctive UNCLE BEN'S® trademark.

8. Accordingly, because the goods for which Applicant's mark is used are closely related to, and are likely to travel in the same channels of trade as, and be marketed to the same classes of consumers as, those goods on which Opposer has been and presently is using its UNCLE BEN'S® trademark, registration of the mark UNCLE COOK'S by Applicant in connection with the goods specified in its application is likely to cause consumers to be confused, mistaken or deceived as to the source, origin or sponsorship of Applicant's goods, to believe that Applicant's goods emanate from Opposer, to believe that Applicant is in some way related to Opposer, and/or to believe that

Applicant's products marketed under the opposed mark are marketed with the consent, permission or authorization of Opposer.

9. Further, due to the fame and distinctiveness of the UNCLE BEN'S® trademark, Applicant's use of the mark UNCLE COOK'S on and in connection with food products dilutes the distinctive quality of Opposer's famous trademark, thereby further damaging Opposer.

10. For the foregoing reasons Opposer will be damaged by the registration of Applicant's alleged mark because such registration dilutes the distinctive quality of the UNCLE BEN'S® trademark, and because the public and the trade will be caused to believe that the goods sold under Applicant's alleged mark are produced or licensed by Opposer under the UNCLE BEN'S® trademark, and/or are produced by Applicant under a mark confusingly similar to Opposer's UNCLE BEN'S® trademark with the authorization, permission or sponsorship of Opposer.

11. For the foregoing reasons, Applicant is not entitled to registration of its alleged mark UNCLE COOK'S and is not entitled to the exclusive use thereof.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and registration of the mark UNCLE COOK'S, as sought by Applicant be refused.

Respectfully submitted,

Dated: March 12, 2003

By: 

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