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Attorney Docket No. 000291-013000US

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By: Charlene J. Foster

Charlene J. Foster

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JOSEPH ENTERPRISES, INC.

Opposer,

v.

AGROPECUARIA TUCSON,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Application No.: 78/640,421
Filed: May 31, 2005
Published: April 18, 2006
Mark: CHIAN

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

Madam:

Opposer JOSEPH ENTERPRISES, INC., a California corporation, having a business situs and address at 425 California Street, Suite 300, San Francisco, California 94104, believes it will be damaged by the registration of the mark CHIAN shown in U. S. Trademark Application Serial No. 78/640,421, filed May 31, 2005 by Agropecuaria Tucson, an Arizona corporation, having a principal place of business at 5770 East Chiricahua Trail, Tucson, Arizona 85750, and hereby opposes registration thereof.

[redacted]

10-18-2006
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #72

As grounds for the opposition, Opposer alleges that:

1. By this application, Applicant is seeking to obtain registration upon the Principal Register of the mark CHIAN for use with seeds, namely chia seeds.

2. Opposer owns incontestable United States registrations for the mark **CHIA**: Registration No. 1,859,361 for "growing mix for plants; kit comprising plastic cup and saucer, growing medium, and seeds; clay animals used as planters, and clay replicas of plants used as planters, and flower, vegetable and herb seeds" (Emphasis added) and Registration No. 2,090,156 for "clothing for men, women and children, namely, shirts, shorts, pants, sweatshirts, tee shirts, hats, caps, jackets, underwear, socks, ties, scarves, and sweaters." Opposer also owns incontestable registrations for the mark **CHIA HEAD** (Registration No. 2,076,769) for "terra cotta figurines used as planters;" the mark **CHIA TREE** (Registration No. 1,605,619) for "clay replicas of plants used as planters; and the mark **CHIA PET** (Registration No. 2,306,061) for "clay animals used as planters."

3. Opposer is the owner of additional registrations and applications for "**CHIA**" marks, including but not limited to: Registration No 2,773,363 for the mark **CHIA HERB GARDEN** for a "kit comprising terra cotta cup and saucer, growing medium, and seeds;" (Emphasis added), Registration No. 2,090,156 for the mark **CHIA**, for "clothing for men, women and children, namely, shirts, shorts, pants, sweatshirts, tee shirts, hats, caps, jackets, underwear, socks, ties, scarves, and sweaters," Registration No. 3,023,006 for the mark **CH CH CH CHIA** for "clay planters for flowers and plant," Registration No. 1,763,853 for the mark **CHIA HERB GARDEN** for a "kit comprising plastic cup and saucer, growing medium, and seeds," (Emphasis added), Application No. 76/416,852 for the **CHIA** mark for "plush toys; puppets; toys, namely, baby multiple activity toys, bath toys, crib toys, infant toys, party favors

in the nature of small toys, plastic character toys, building blocks, mobiles, basket balls, baseballs, beach balls, foot balls, rubber action balls, sport balls, and volley balls; games, namely, board games, card games, party games, video games, and video game interactive hand held remote controls for playing electronic games;" and Application No. 76/416,818 for the **CHIA** mark for "hobby craft sets for gardening comprising seed, growing pots, and growing media; holiday decorations for Christmas." (Emphasis added) (hereafter collectively referred to as "Opposer's Marks" or the "**CHIA** Marks").

4. Since at least as early as 1992, Opposer has used the **CHIA** trademark for seeds. The goods described under the aforementioned registrations have been extensively advertised and marketed under Opposer's Marks throughout the United States. By virtue of its efforts and the expenditure of considerable sums for promotional activities and the high quality of its products, Opposer has created widespread goodwill under Opposer's Marks throughout the United States in connection with such goods.

5. As a result of Opposer's extensive advertising and marketing, Opposer's Marks are famous marks that are well known to purchasers.

6. Opposer's Marks have become a valuable asset of Opposer and principal symbols of its extensive goodwill. By reason of such wide use of Opposer's Marks, the trade and purchasing public have come to recognize Opposer's Marks as signifying Opposer and as identifying Opposer as the source of the goods offered under Opposer's Marks.

7. Application Serial No. 78/640421 for the proposed CHIAN mark, opposed herein, was filed as an Intent-to-Use application on May 31, 2005, after registrations for Opposer's Marks had issued (with the exception of Registration No 3,023,006, which issued on December 6, 2005).

8. Applicant's proposed mark is nearly identical to the mark registered by Opposer in Registration Nos. 1,859,361, 2,773,363, 1,763,853 and 2,090,156 and so resembles Opposer's Marks so as to be likely to cause confusion, mistake, or deception in the trade and among purchasers as to the source, origin, or sponsorship of Applicant's goods.

9. The goods identified in Application Serial No. 78/640,421 and the goods offered under Opposer's Marks are nearly identical and are the type which could be sold in the same channels of trade and to the same prospective purchasers so as to be likely to cause confusion, mistake, or deception in the trade and among purchasers as to the source, origin, or sponsorship of Applicant's goods.

10. Because Applicant's proposed mark so resembles Opposer's Marks, is used on nearly identical goods, and Applicant offers its goods to purchasers or prospective purchasers of the goods offered under Opposer's Marks, the trade and purchasing public are likely to believe that Applicant's goods originate from Opposer or from an entity that is in some way associated with Opposer, thus resulting in damage and detriment to Opposer and its reputation, as well as to the purchasing public.

11. Registration and use of Applicant's proposed mark shown in the opposed application are likely to dilute Opposer's famous **CHIA** Marks.

12. Registration of Applicant's proposed mark will result in damage to Opposer under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125 (c), and pursuant to the allegations stated above.

WHEREFORE, Opposer requests that the registration sought by Applicant in the United States Application Serial No. 78/640,421 be refused and that this Notice of Opposition be sustained in favor of Opposer.

Dated October 16, 2006

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

By: _____

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