

12-05-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #59

Client Matter No. 522727-001

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

-----X  
RUDOLF WILD GMBH & CO. KG :  
Opposer, : Opposition No.  
: :  
v. : Serial No. 78/042,960  
: :  
Shelton-MacKenzie Wine Company :  
Applicant. :  
-----X

BOX TTAB -FEE  
Assistant Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202

**NOTICE OF OPPOSITION**

In the matter of the pending Application Serial No. 78/042,960, filed on January 12, 2001 by Shelton-MacKenzie Wind Company (hereinafter "Applicant") for the mark WILD THING, published in the Official Gazette of August 7, 2001 at TM 328 (hereinafter "Application"), Rudolf Wild GmbH & Co. KG (hereinafter "Opposer") believes that it would be damaged by the registration of the above mark and hereby gives notice of its intention to oppose the Application for registration, its grounds are as follows:

1. Opposer is a limited liability partnership existing under the laws of Germany located at Rudolf Wild Strabe 4-6, D-69214 Eppelheim-Heidelberg, Germany.

**Certificate of Mailing by "Express Mail" (37 C.F.R. 1.10)**

Number: EL 802145852 US  
Date of Deposit: December 5, 2001

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Name: M. Duane Rawls

Signature:

2. For many years prior to the date of first use by Applicant, Opposer has been using the trademarks WILD, WILD & Design and composite marks containing the term "WILD" therein in foreign commerce with the United States and interstate commerce within the United States in connection with flavors, aromas, essences and distillates used in the preparation of soft drinks of various kinds and for fruit based liquid ingredients for use in the preparation of other foods.

3. Opposer is the owner of U.S. Registration No. 1,296,602 issued on September 18, 1984 for the mark WILD for fruit based liquid ingredients for use in the preparation of other foods. This registration is valid and subsisting, in full force and effect.

4. Opposer is the owner of U.S. Registration No. 1,586,995 issued on March 13, 1990 for the mark WILD & Design for food flavoring, namely, flavors aromas, essences, and distillates not in the nature of essential oils and for flavors, aromas, essences and distillates not in the nature of essential oils for the preparation of soft drinks. This registration is valid and subsisting, in full force and effect and incontestable.

5. By reason of extensive distribution, sale and promotion of Opposer's goods in and throughout the United States, Opposer's marks WILD and WILD & Design have acquired substantial goodwill, distinctiveness, secondary meaning and fame as indicating a line of flavors, aromas, essences, and distillates used in the preparation of soft drinks and foods and fruit based liquid ingredients for use in foods having their origin exclusively with Opposer.

6. Applicant's mark is likely to cause confusion with Opposer's registered mark. The mark sought to be registered, namely, WILD THING, contains the word "WILD." Thus, Opposer's entire mark is subsumed in Applicant's mark. Moreover, the word "WILD" is the

prominent portion of Applicant's mark WILD THING, as the term "WILD" is the first word in the mark.

7. The goods in the Application are closely related to Opposer's goods. The Applicant's goods are for wine from grapes. Applicant's goods are beverages derived from fruit. Opposer's goods consist of fruit based products used to make beverages. Specifically, Opposer uses its WILD and WILD & Design marks for fruit based liquid ingredients, flavors, aromas, essences and distillates for use in the preparation of other foods and beverages. Thus, Applicant's goods are closely related to Opposer's goods and consumers are likely to be confused because the goods are sold under confusingly similar marks.

**COUNT I**  
**LIKELIHOOD OF CONFUSION**

8. Opposer repeats and re-alleges the allegations in Paragraphs 1 through 7 as fully set forth herein.

9. In view of the confusingly similarity of Applicant's trademark and goods, Applicant's use and registration of the mark WILD THING is likely to create confusion, mistake and deceive the trade and public into believing that Applicant's goods originate with or are otherwise licensed, sponsored or authorized by Opposer.

10. The use and registration of the mark WILD THING by Applicant is likely to damage and destroy the distinctiveness, goodwill, reputation, secondary meaning and fame created and established by Opposer in its WILD and WILD & Design marks by virtue of the confusion, mistake and deception likely to occur between the respective marks in derogation of Opposer's exclusive right to continue to use its registered marks for its present goods and its right to expand the use of its marks to related goods and services.

11. By reason of all the forgoing, Opposer will be gravely damaged by the registration of the mark WILD THING for the goods identified in the Application.

**COUNT II**  
**DILUTION**

12. Opposer repeats and re-alleges the allegations contained in Paragraphs 1-7 and 9-10 as fully set forth herein.

13. Opposer's WILD and WILD & Design marks are famous and the use and registration of Applicant's mark WILD THING is likely to dilute the distinctive quality of Opposer's famous marks pursuant to 15 U.S.C. §1125(c), which is applicable in an opposition proceeding.

14. By reason of all the forgoing, Opposer will be gravely damaged by the registration of the mark WILD THING for the goods identified in the Application.

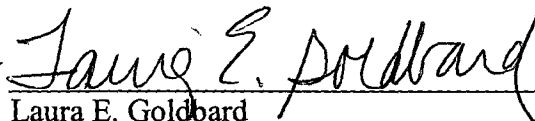
WHEREFORE, by reason of the confusing similarity of Applicant's and Opposer's marks and the likelihood that Applicant's mark will dilute Opposer's mark, Opposer respectfully requests that the opposition be sustained and that registration of the mark WILD THING be refused.

Dated: New York, New York  
December 5, 2001

Respectfully submitted,

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BY



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TAB

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Assistant Commissioner of Trademarks  
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Re: Client/Matter No. : 522727/001  
Applicant : Shelton-MacKenzie Wine Company  
Serial No. : 78-042,960  
Filed : January 12, 2001  
For Opposer : Rudolf Wild GmbH & Co. KG  
MARK : WILD THING

Sir:

Kindly file the annexed papers indicated below, charging the fee (including any deficiency in the fee as estimated below) to the undersigned attorney's Deposit Account No. 19-4709:

(X) Notice of Opposition

Respectfully submitted,

STROOCK & STROOCK & LAVAN LLP  
Attorneys for Opposer

By: Laura E. Goldbard  
Laura E. Goldbard  
Kiersten M. Skog

Estimated Fee \$ 300.00  
Dated : December 5, 2001

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