

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



Serial No. 76211024

09-24-2002

DOUMAK, INC., )

U.S. Patent & TMO/c/TM Mail Ropt Dt. #58

Opposer )

Opposition No. \_\_\_\_\_

v. )

CONSOLIDATED BISCUIT CO., )

Applicant )

TRADEMARK TRIAL AND  
APPEAL BOARD  
02 OCT -7 PM 9:44

**NOTICE OF OPPOSITION**

Box TTAB FEE  
Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Sir or Madam:

Opposer, Doumak, Inc. ("Doumak") believes it will be damaged by registration of the mark "FIRESIDE" of Application Serial Number 76-211024 filed by the named applicant therein and hereby opposes the same. As grounds for this opposition, it is alleged as follows:

**THE PARTIES**

1. Opposer Doumak is a an Illinois corporation with its principal place of business at 2201 Touhy Avenue, Elk Grove Village, Illinois 60007-5327.

2. On information and belief, the Applicant, Consolidated Biscuit Co. ("Consolidated"), is an Ohio corporation with its principal place of business at P.O. Box 847, McComb, Ohio 45858.

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### DOUMAK REGISTRATION

3. Doumak is the owner by assignment of all right, title, and interest in and to the mark FIRESIDE of U.S. Registration No. 739,097 filed July 18, 1961, on the Principal Register in International Class 30 as applied to “marshmallows.” Doumak has been using the mark FIRESIDE since 1917.

4. Doumak’s ‘097 registration for the mark FIRESIDE for the goods stated therein is valid and subsisting, unrevoked and uncanceled, states dates of first use of the FIRESIDE mark anywhere and in commerce in 1917, and entitles DOUMAK to all of the benefits, advantages, privileges, and rights afforded under the applicable provisions of Title 15 of the United States Code, Sections 1051, *et seq.*

### CONSOLIDATED APPLICATION

5. On information and belief, the opposed application was filed by Consolidated in the United States Patent and Trademark Office on February 15, 2001 under Serial No. 76-211024, for registration of the mark FIRESIDE in International Classes 29 (meats and processed foods) for “roasted nuts and candied nuts”; 30 (staple foods) for “candy and confections, excluding marshmallows and marshmallow confections, namely, chocolate, chocolate chips, butterscotch chips, hard candies, candies containing jelly, licorice and chocolate covered nuts, all for snacking and eating”; and 31 (natural agricultural products) for “raw nuts” (collectively, “Consolidated’s Goods”). The ‘024 application is an intent-to-use application.

### FACTS

6. Since 1917, Doumak and/or a predecessor in interest has used the FIRESIDE mark throughout the United States for and in connection with the sale of marshmallow products, including “marshmallow-related confectionary products.” (collectively, “Doumak’s Goods”).

Doumak is presently using the FIRESIDE mark for Doumak's Goods and has been so using the mark in such commerce since 1917.

7. Doumak enjoys substantial and valuable goodwill and good reputation in connection with its FIRESIDE mark which is well-known through the United States as a symbol of a source or origin of Doumak's Goods.

8. Doumak and Consolidated are parties to a Settlement and Consent Agreement ("Agreement") dated September 15, 1997. The Agreement relates to each party's use and registration of the mark "FIRESIDE" in connection with its specified products. (A copy of the Agreement is attached as Exhibit A).

9. In the Agreement, Doumak authorizes Consolidated's use and registration of FIRESIDE in word and logo format only in connection with "biscuits, cookies, cakes and crackers." (Exhibit A). Section 5 of the Agreement also provides that Consolidated may develop and market new "bakery products" under the FIRESIDE mark. (Id.) (emphasis added). Consolidated consents, in the Agreement, to Doumak's exclusive use of FIRESIDE for marshmallows and related marshmallow products, "such as crème, dehydrated marshmallow and marshmallow-related confectionary products." (Id.)

10. As stated above, Consolidated has now filed an intent-to-use application to register the FIRESIDE mark in connection with nuts, candies and confections. Despite the exclusion of marshmallows and marshmallow confections from the goods covered by Consolidated's application, on information and belief, Consolidated's use of the mark FIRESIDE in connection with products that are closely related to Doumak's Goods, and that will be marketed and sold to the same customer base, in the same manner, and for the same purposes, will undoubtedly create

confusion, mistake and deception among the consuming public as to the source of each party's FIRESIDE goods and/or the affiliation between the parties' respective clients.

11. On information and belief, Consolidated's Goods will be offered and sold by Consolidated through the same channels of trade and advertising media and are directed to the same general class of purchasers as Doumak's Goods which are offered and provided under Doumak's FIRESIDE mark. In particular, Doumak offers and provides Doumak's Goods under its FIRESIDE mark to a vast array of different types of companies, individuals, and organizations involved in diverse business enterprises and activities, at least some segment of which would also encounter Consolidated's Goods offered under the FIRESIDE mark. By way of example only, and not for purposes of limitation, Consolidated's "candy and confections" would undoubtedly be marketed to many customers and users of Doumak's Goods under its FIRESIDE mark. It is therefore contended that the aforementioned goods of Consolidated which it intends to offer under the FIRESIDE mark are and will be marketed to the same potential customers as are Doumak's Goods which are offered under its FIRESIDE mark.

12. Furthermore, Doumak's well-known FIRESIDE mark and the mark of Consolidated's application are used for goods that are associated and complimentary of one another. For example, and not for purposes of limitation, Doumak's "marshmallow and marshmallow confections" are similar to Consolidated's "candy and confections."

13. By reason of the overlapping trade channels in which Doumak uses its FIRESIDE mark for Doumak's Goods and in which Consolidated intends to use the FIRESIDE mark for Consolidated's Goods, the associated and complimentary nature of the goods of the parties, and the fact that the marks themselves are almost identical and practically indistinguishable, there is

a strong and indisputable likelihood of confusion, mistake, or deception as to the source or origin of Consolidated's Goods under 15 U.S.C. §1052(d).

14. If used for Consolidated's Goods in the manner applied for, the FIRESIDE mark is likely to cause confusion or to cause or mistake or deceive as to the source of the origin thereof.

15. Unauthorized use of the FIRESIDE mark for Consolidated's Goods is likely to cause confusion among members of the public and to deceive purchasers who, on seeing the FIRESIDE mark used for and in connection with Consolidated's Goods, are likely to believe that the goods originate with, have some connection or association with, or are sponsored by, approved or licensed by the source of Doumak's Goods offered and provided by Doumak under its FIRESIDE mark.

16. Doumak therefore avers that registration and/or use of the mark FIRESIDE of the opposed application would damage it for at least the following reasons:

a. Registration of the FIRESIDE mark of the opposed application may enable Consolidated to pass off its goods as those of the source of Doumak's Goods;

b. The FIRESIDE mark of the opposed application is so similar to Doumak's previously used FIRESIDE mark that unauthorized use of it for Consolidated's Goods would be likely to cause confusion or mistake among members of the public or to deceive purchasers who, on seeing the mark used for or in connection or association with, or are sponsored or approved by the source of Doumak's Goods offered and provided by Doumak under its FIRESIDE mark;

c. Unauthorized use of the FIRESIDE mark of the opposed application for Consolidated's Goods will constitute wrongful appropriation of Doumak's goodwill association with the FIRESIDE mark; and

d. Unauthorized use of the FIRESIDE mark of the opposed application for Consolidated's Goods threatens Doumak's right to expand the scope and use of its FIRESIDE mark for the same or related goods and will and does embarrass and restrict Doumak in the free use of its FIRESIDE mark.

WHEREFORE, Doumak believes it will be damaged by registration of the mark FIRESIDE of the opposed application and prays that registration thereof to Consolidated be refused.

In accordance with the rules, this Notice of Opposition (with Exhibit A) is filed in duplicate together with the required filing fee.

Dated: September 20, 2002

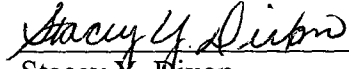
Respectfully submitted,

LORD, BISSELL & BROOK

By: Stacey Y. Dixon  
Kevin P. McJessy  
Reg. No. IL 06229825  
Stacey Y. Dixon  
Reg. No. IL 06269644  
Attorneys for Doumak, Inc.  
115 South LaSalle Street  
Chicago, Illinois 60603  
312.443.0700

**CERTIFICATE OF MAILING**

Stacey Y. Dixon, an attorney, hereby certifies that she caused the foregoing **Notice of Opposition** to be mailed to Box TTAB Fee, Trademark Trial and Appeal Board, United States Patent and Trademark Office, 2900 Crystal Drive, Arlington, VA 22202 via U.S. Express Mail No. \_\_\_\_\_ on this 20th day of September, 2002.

  
\_\_\_\_\_  
Stacey Y. Dixon

## SETTLEMENT AND CONSENT AGREEMENT

THIS AGREEMENT, is made this 17<sup>th</sup> day of September, 1997 by and between Doumak Inc., a corporation organized and existing under the laws of the State of Illinois, having its principal place of business at 2201 Touhy Avenue, Elk Grove Village, Illinois 60007-5327 ("Doumak"), and Consolidated Biscuit Co., a corporation organized and existing under the laws of the State of Ohio, having its principal of business at [P.O. Box 847], McComb, Ohio 45858 ("Consolidated").

WHEREAS, Consolidated was the owner of U.S. Trademark Registration No. 86,929, dated June 11, 1912, for the mark "FIRESIDE" as applied to "biscuits," and of U.S. Registration No. 1,228,655, dated February 22, 1983, for the mark "FIRESIDE" as applied to "cookies, crackers and cakes." Each of these registrations was canceled pursuant to Section 8 of the Trademark Act;

WHEREAS, Consolidated is the owner of U.S. trademark application Serial No. 74/446,865, filed October 14, 1993, for the mark "Fireside" as applied to "cookies, biscuits, crackers and cakes," and of application Serial No. 74/446,866, filed October 14, 1993, for the mark "Fireside (and Design)" as applied to "cookies, biscuits, crackers and cakes" (hereinafter collectively "Consolidated's Applications");

WHEREAS, Doumak Inc. is the owner by assignment of U.S. Registration No. 739,097, for the mark "Fireside" as applied to "marshmallows" (hereinafter "Doumak's Registration");



WHEREAS, Consolidated has used the mark "FIRESIDE" in association with biscuits since at least as early as August 29, 1911 and Doumak has used the mark "FIRESIDE" in association with marshmallows since at least as early as 1917. To date, the parties have experienced no confusion based upon their respective uses of the "FIRESIDE" mark;

WHEREAS, Consolidated filed Cancellation No. 24,167, with the Trademark Trial and Appeal Board, the result of which was an order was issued by the Trademark Trial and Appeal Board on January 29, 1997, canceling Doumak's Registration;

WHEREAS, Consolidated's Applications were published for opposition on June 24, 1997 and Doumak has requested an extension of the time to oppose registration of each of Consolidated's Applications; and

WHEREAS, Doumak and Consolidated each desire to restore their respective trademark registrations and to resolve the dispute between them with regard to the parties' use of the mark "FIRESIDE."

NOW, THEREFORE, based upon the premises and covenants set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties agree as follows:

1. CONCURRENT USE

a. Consolidated may use and register the marks "FIRESIDE" and "FIRESIDE (and Design)" in association with biscuits, cookies, cakes and crackers.

b. Doumak may use and register the mark "FIRESIDE" in association with marshmallows and products made from marshmallows, such as marshmallow creme, dehydrated marshmallows and marshmallow-related confectionery products.

## 2. CONSOLIDATED'S TRADEMARK REGISTRATIONS

a. It is the intention of the parties that Consolidated shall have a federal registration for each of the marks "FIRESIDE" and "FIRESIDE (and Design)" (as depicted in Consolidated's application Serial No. 74/446,866), as applied to cookies, cakes, crackers and biscuits.

b. Doumak will not oppose registration of Consolidated's Applications. Further, if reinstatement of Doumak's Registration results in a refusal to register Consolidated's Applications pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), Doumak shall consent to registration of Consolidated's Applications or otherwise cooperate in overcoming such a refusal to register.

## 3. DOUMAK'S TRADEMARK REGISTRATION

a. It is the intention of the parties that Doumak Inc. shall have a federal registration for the mark "FIRESIDE" as applied to marshmallows.

b. Consolidated acknowledges that it has been advised of Doumak's intention to file a Motion to Vacate the judgment of the Trademark Trial and Appeal Board canceling Doumak's Registration. Consolidated will not oppose Doumak's Motion to Vacate or otherwise object to reinstatement of Doumak's Registration.

c. In the event that Doumak's Motion to Vacate the Judgment of the Trademark Trial and Appeal Board is granted and the cancellation proceedings are

reinstated, Consolidated agrees that it will file a Notice of Dismissal of the cancellation proceedings within 10 days of the Trademark Trial and Appeal Board order causing the cancellation proceedings to be reinstated.

d. In the event that Doumak's Motion to Vacate is not granted, Consolidated acknowledges that Doumak may file an application to re-register the mark "FIRESIDE" in association with marshmallows and products made from marshmallows, such as marshmallow creme, dehydrated marshmallows, and marshmallow-related confectionery products. Consolidated will not oppose registration of any such application by Doumak and further agrees that it will cooperate in overcoming any objections by the U.S. Patent and Trademark Office to registration of the mark "FIRESIDE" for marshmallows filed by Doumak.

#### 4. NO LIKELIHOOD OF CONFUSION

The parties' respective uses of the "FIRESIDE" mark have not resulted in confusion between the parties in the approximately 80 years during which they have concurrently used that mark on their respective products and, therefore, the parties believe that no confusion is likely in the future.

#### 5. FUTURE USE

a. Consolidated shall not be precluded from developing new bakery products to be sold under the mark "FIRESIDE." Doumak shall not be precluded from developing new marshmallow products, such as creme, dehydrated marshmallow and marshmallow-related confectionery products, to be sold under the mark "FIRESIDE."

b. The parties agree to take reasonable action to prevent any confusion due to the coexistence and registration of their respective marks, to notify each other of any instances of confusion of which they become aware, and to take reasonable action to correct any such confusion.

c. In the event that Consolidated elects to manufacture a product having marshmallow as an ingredient, Consolidated shall attempt to purchase the marshmallow to be used as such an ingredient from Doumak, provided that the terms and conditions of such purchase from Doumak are reasonable. Consolidated shall contact Mr. John Casey or Mr. Daniel Donahue at Doumak at the address set forth hereinabove for this purpose.

#### 6. NOTICE

All notices, requests, information, or other documents required to be sent to either party shall be in writing and delivered personally or sent by first-class mail, postage prepaid, as follows:

If to Doumak, addressed to:

Mr. Daniel Donahue  
Mr. John Casey  
Doumak Inc.  
2201 Touhy Avenue  
Elk Grove Village, Illinois 60007-5327

with copies to:

John A. Jeffries, Esq.  
Lord, Bissell & Brook  
115 South LaSalle Street - Suite 3500  
Chicago, Illinois 60603

Heather C. Steinmeyer, Esq.  
Bell, Boyd and Lloyd  
70 W. Madison Street, Suite 3300  
Chicago, Illinois 60602-4207

If to Consolidated, addressed to:

William H. Casney, V.P.  
Consolidated Biscuit Co.  
P.O. Box 847  
McComb, Ohio 45858

with a copy to:

Charles R. Schaub, Esq.  
Emch, Schaffer, Schaub & Porcello Co., L.P.A.  
One Seagate, Suite 1980  
Toledo, Ohio 43604

7. MERGER AND AMENDMENT

This Agreement constitutes the entire agreement between the parties and supersedes all existing or prior understandings, representations, or undertakings which may have been made or entered into between the parties with regard to the subject matter hereof. No amendments, changes or modifications of or additions to this Agreement shall be valid unless the same shall be in writing and signed by both parties.

8. BINDING AGREEMENT

This Agreement shall inure to the benefit of and be binding upon the heirs, successors, and assigns of the parties.

9. GOVERNING LAW

This Agreement shall be construed and interpreted in accordance with the laws of the State of Illinois.

NOW, THEREFORE, the parties have caused this Agreement to be executed by their duly authorized representatives as of the date and year first written above.

DOUMAK INC.

CONSOLIDATED BISCUIT CO.

By: *John A. Jeffries*  
Name: John A. JEFFRIES  
Title: V. P.

By: *William H. Varney, Vice President*  
Name: William H. Varney  
Title: Vice President

TTAB



09-24-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

September 23, 2002

Stacey Y. Dixon

312.443.1882  
Fax: 312.896.6582  
sdixon@lordbissell.com

**VIA OVERNIGHT MAIL**

Box TTAB FEE  
Trademark Trial and Appeal Board  
United States Patent and Trademark Office  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Re: Doumak, Inc. v. Consolidated Biscuit Co.

To Whom It May Concern:

Please find enclosed copies of the Notices of Opposition regarding Consolidated Biscuit Co.'s applications for registration of the FIRESIDE mark, Serial Numbers 76-211022 and 76-211024. Please forward to us a file-stamped copy of each notice. Thank You.

Sincerely,

LORD, BISSELL & BROOK

Stacey Y. Dixon

Enclosures