

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

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MARS, INCORPORATED, :
(successor-in-interest to Uncle Ben's, Inc.), :
 :
Opposer, :
 :
v. :
 :
HICKORY FARMS, INC., :
 :
Applicant. :
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Serial No.: 76/326,116

Opposition No.:

01-27-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #77

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TIMOTHY J. KELLY
Name of Attorney for Applicant
[Signature]
Signature Date of Signature 1/22/03

NOTICE OF OPPOSITION

In the matter of pending trademark application Serial No. 76/326,116 for the mark UNCLE WALT'S CHEDDAR (hereinafter the "Mark") in International Class 29 filed by Hickory Farms, Inc., 1505 Holland Road, Maumee, Ohio 43637 (hereinafter "Applicant") for "cheese", published in the Official Gazette of September 24, 2002, Petitioner Mars, Incorporated, successor-in-interest (by merger effective December 28, 2002) to Uncle Ben's, Inc. (hereinafter "Opposer" or "Mars"), whose business address is 3250 E. 44th 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"

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containing, *inter alia*, pancakes and French toast, soups, stuffing mixes (containing bread), 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
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

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
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 (and, indeed, the UNCLE BEN'S® family of trademarks), 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 and in the UNCLE BEN'S® family of trademarks as a whole.

6. Because the UNCLE BEN'S® trademark and the goods and services sold by Uncle Ben's under that trademark are exclusively associated with Opposer, the registration of the substantially similar mark UNCLE WALT'S CHEDDAR by Applicant for food products, namely cheese, 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 -- cheese -- 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® trademarks.

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® trademarks, registration of the mark UNCLE WALT'S CHEDDAR 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® trademarks, Applicant's use of the mark UNCLE WALT'S CHEDDAR on and in connection with food products is likely to dilute the distinctive quality of Opposer's trademarks, and thereby further damage Opposer.

10. For the foregoing reasons Opposer will be damaged by the registration of Applicant's alleged mark because such registration will dilute the distinctive quality of the UNCLE BEN'S® trademarks, and 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® trademarks, and/or are produced by Applicant under a mark confusingly similar to Opposer's UNCLE BEN'S® marks with the authorization, permission or sponsorship of Opposer.

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

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

Respectfully submitted,

Dated: January 22, 2003

By: 

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