



06-24-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

**BOX TTAB FEE**

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

THE NATIONAL CANCER INSTITUTE, )  
an agency of the )  
United States Government, )  
 )  
OPPOSER, )  
 )  
v. )  
 )  
NATIONAL DAIRY COUNCIL, )  
an ILLINOIS corporation, )  
 )  
APPLICANT )

Opposition No. \_\_\_\_\_  
Appln. Serial No. 76/429,154  
Mark: EAT THE FIVE FOOD  
GROUP WAY

Honorable Director for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

**NOTICE OF OPPOSITION**

Dear Director:

THE NATIONAL CANCER INSTITUTE, an institute of the National Institutes of Health, an agency of the United States Government (hereinafter "Opposer"), believing that it will be damaged by registration of the mark in the above-referenced application, hereby opposes Application Serial No. 76/429,154, filed July 9, 2002, under the Trademark Act of 1946, in the name of the National Dairy Council, published for opposition in the Official Gazette of March 4, 2003, Vol.1268, No.1, at Page TM 254, for the mark EAT THE FIVE FOOD GROUP WAY.

The grounds for opposition are:

**CONFUSION**

1. The Opposer, the NATIONAL CANCER INSTITUTE, is an agency of the United States Government, having offices at 9000 Rockville Pike, Bethesda, Maryland, 20892.

2. Commencing long prior to Applicant's filing date and claimed date of first use, beginning at least as early as 1988, Opposer has engaged in, and is now engaged in, the advertising, distribution and promotion in interstate commerce of its services for encouraging the public to eat a healthier diet consisting of at least five portions per day of fruits and vegetables in order to reduce the risk of cancer and other diseases.

3. Commencing long prior to Applicant's filing date and claimed date of first use, beginning at least as early as 1988, Opposer has used, and is now using Opposer's EAT 5 A DAY marks (hereinafter sometimes referred to as Opposer's Mark(s)) in connection with services to encourage healthy eating in a nationwide government endeavor provided by the Opposer in commerce.

4. Opposer is the owner of, and will rely herein, upon the following Federal trademark registrations:

<b><u>MARK</u></b>	<b><u>REGISTRATION NO.</u></b>	<b><u>ISSUED</u></b>
EAT 5 A DAY-FOR BETTER HEALTH FRUITS & VEGETABLES & design	1,641,635	April 16, 1991
EAT 5 A DAY & design	2,416,006	Dec. 26, 2000

Opposer's Registration No. 1,641,635 identifies the services as "association services, namely promoting the interests of maintaining a healthy diet for cancer prevention". Opposer's Registration No. 1,641,635 is incontestible by virtue of Opposer having filed a Section 15 Declaration for the Registration on March 26, 2001. Registration No. 1,641,635 was amended to its present form on March 5, 2002. The prior mark was 5 A DAY FOR BETTER HEALTH FRUITS & VEGETABLES and Design. Opposer's Registration No. 2,416,006 identifies the services as "services to increase public awareness of the health benefits, including cancer prevention, of eating five or more servings of fruits and vegetables daily and to provide consumers with specific information directed toward increasing the number of servings of fruits and vegetables in their daily eating patterns". Copies of both registrations are attached hereto, as Opposer's Exhibit 1. Said registrations of Opposer's Marks are valid and subsisting and are conclusive and prima facie evidence, respectively, of Opposer's exclusive right to use Opposer's Marks in commerce on the services specified in said registrations.

5. Since its initial use of the EAT 5 A DAY mark, Opposer has made a substantial investment in advertising and promoting its services under the mark. Opposer has extensively used, advertised, promoted and offered Opposer's services associated with the mark to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's Mark and associate same with Opposer and/or services provided by Opposer. The services offered by the Opposer are in the nature of providing educational information designed to make consumers aware of the health benefits of eating a diet rich in fruits and vegetables.

6. Upon information and belief, notwithstanding Opposer's rights in and to its mark, on July 9, 2002, Applicant filed an application for registration of the alleged EAT THE FIVE FOOD GROUP WAY mark for "Posters, stationery folders, unmounted photographs, brochures, booklets, catalogs, and printed educational worksheets featuring information on nutrition". Said application was assigned Serial No. 76/429,154, and was published for Opposition in the Official Gazette of March 4, 2003, Vol. 1268, No. 1, at Page TM 254.

7. Applicant's EAT THE FIVE FOOD GROUP WAY mark includes the salient features of the dominant part of Opposer's Marks, namely, "EAT" and "5" and together with Applicant's reference to "FOOD", so resembles Opposer's Marks that are associated with the nutritional benefits of eating five fruits and vegetables, as to be likely, when applied to the proposed goods and services of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

8. Upon information and belief, goods bearing Opposer's Mark and goods bearing Applicant's mark will be distributed to the same general class of purchasers, namely the food-consuming public.

9. Opposer, upon information and belief, avers that its customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed services to be identified under Applicant's alleged EAT THE FIVE FOOD GROUP WAY mark and misled into believing that the goods bearing Applicant's mark are produced by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

Mark and the wide national exposure of Opposer's slogan mark and program for nearly fifteen years, the Mark has achieved the status of fame for the well-known government-private industry initiative as applied to food products, beverage products, and nutritional information and as used in connection with Opposer's promotional services.

### **UNFAIR COMPETITION**

11. Applicant's adoption and use of its alleged EAT THE FIVE FOOD GROUP WAY mark violates Section 43(a)(1) of the Trademark Act by attempting to pass off advertisements for its nutritional information as advertisements sponsored or approved by Opposer.

12. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged EAT THE FIVE FOOD GROUP WAY, as set forth in Applicant's Trademark Application Serial No.76/429,154, in that the mark is substantially similar to the dominant portion of Opposer's mark and common law rights and will be used in connection with goods and services similar to the goods and services offered to the public on which Opposer, or its partners or licensees, place its mark. Consequently, this injury provides Opposer standing to oppose this Application.

WHEREFORE, this Opposer, THE NATIONAL CANCER INSTITUTE, believes and avers that it is being and will continue to be damaged by registration of the EAT THE FIVE FOOD GROUP WAY mark as aforesaid, and prays that said Application Serial No. 76/429,154 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

By: Malka Scher 6/20/03  
Malka Scher, Esq. Date

And by: Richard A. Lambert 6/23/03  
Richard A. Lambert, Esq. Date  
Attorney for the U.S. Public Health Service

**PLEASE DIRECT ALL COMMUNICATIONS TO:** Malka Scher, at 6120 Executive Blvd., EPS Suite 450; Bethesda, Maryland 20892; telephone number (301) 496-0477, fax number (301) 402-2117.

**AUTHORIZATION TO CHARGE FEES TO DEPOSIT ACCOUNT**

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS

OPPOSER: NATIONAL CANCER INSTITUTE  
(An agency of the United States Government)

National Cancer Institute  
9000 Rockville Pike  
Bethesda, Maryland 20892

Authorization is hereby provided, on behalf of the NATIONAL CANCER INSTITUTE, for charging fees on the enclosed opposition to trademark application, Serial. No. 76/429,154. Please charge all fees to Account No. 14-0314.

By: *Malka Scher*  
Malka Scher  
Technology Transfer Specialist  
Technology Transfer Branch,  
National Cancer Institute

OPPOSER'S EXHIBIT 1



Int. Cl.: 42

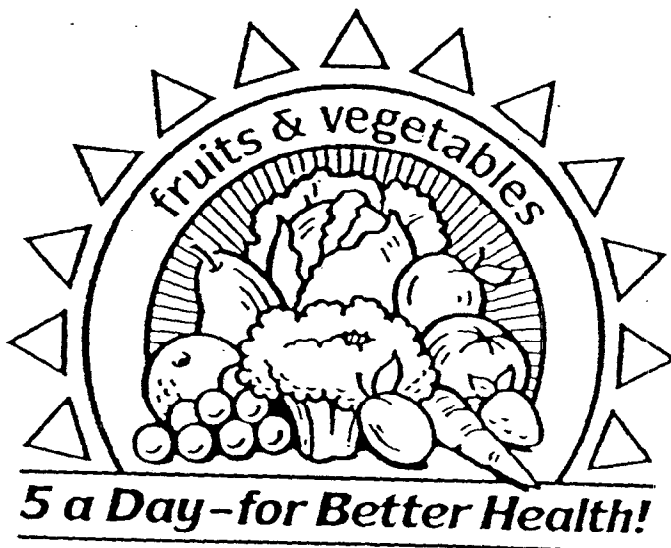
Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,641,635

Registered Apr. 16, 1991

SERVICE MARK  
PRINCIPAL REGISTER



CALIFORNIA PUBLIC HEALTH FOUNDATION  
SUITE 210  
2001 ADDISON STREET  
BERKELEY, CA 94704

FOR: ASSOCIATION SERVICES, NAMELY  
PROMOTING THE INTERESTS OF MAINTAINING  
A HEALTHY DIET FOR CANCER PREVENTION,  
IN CLASS 42 (U.S. CL. 100).

FIRST USE 8-25-1988; IN COMMERCE  
8-25-1988.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "FRUITS & VEGETABLES"  
AND "FIVE A DAY-FOR BETTER HEALTH",  
APART FROM THE MARK AS SHOWN.

THE LINING IN THE DRAWING IS A FEATURE  
OF THE MARK AND IS NOT INTENDED  
TO INDICATE COLOR.

SER. NO. 74-010,299, FILED 12-13-1989.

TINA POMPEY, EXAMINING ATTORNEY

Int. Cl.: 42

Prior U.S. Cl.: 100

Reg. No. 1,641,635

United States Patent and Trademark Office

Registered Apr. 16, 1991

Amended

OG Date Mar. 5, 2002

**SERVICE MARK  
PRINCIPAL REGISTER**



NATIONAL CANCER INSTITUTE (UNITED STATES GOVERNMENT AGENCY),  
9000 ROCKVILLE PIKE  
NIH, PHS, DHHS  
BETHESDA, MD 20892. BY ASSIGNMENT  
CALIFORNIA PUBLIC HEALTH  
FOUNDATION (CALIFORNIA NON-  
PROFIT PUBLIC BENEFIT CORPORATION),  
BERKELEY, CA  
NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "FRUITS & VEGETABLES"  
AND "EAT FIVE A DAY-FOR BETTER  
HEALTH", APART FROM THE MARK AS  
SHOWN.

THE LINING IN THE DRAWING IS A  
FEATURE OF THE MARK AND IS NOT  
INTENDED TO INDICATE COLOR.

FOR: ASSOCIATION SERVICES,  
NAMELY PROMOTING THE INTERESTS  
OF MAINTAINING A HEALTHY DIET  
FOR CANCER PREVENTION, IN CLASS  
42 (U.S. CL. 100).

FIRST USE 8-25-1988; IN COMMERCE  
8-25-1988.

SER. NO. 74-010,299, FILED 12-13-1989.



*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on May 5, 2002.*

**DIRECTOR OF THE U.S. PATENT AND TRADEMARK OFFICE**

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,416,006

Registered Dec. 26, 2000

SERVICE MARK  
PRINCIPAL REGISTER



NATIONAL CANCER INSTITUTE (UNITED STATES  
AN AGENCY OF THE UNITED STATES GOVERN-  
MENT)  
NATIONAL CANCER INSTITUTE  
9000 ROCKVILLE PIKE  
BETHESDA, MD 20892

FOR: SERVICES TO INCREASE PUBLIC AWARE-  
NESS OF THE HEALTH BENEFITS, INCLUDING  
CANCER PREVENTION, OF EATING FIVE OR  
MORE SERVINGS OF FRUITS AND VEGETABLES  
DAILY AND TO PROVIDE CONSUMERS WITH SPE-  
CIFIC INFORMATION DIRECTED TOWARD IN-

CREASING THE NUMBER OF SERVINGS OF  
FRUITS AND VEGETABLES IN THEIR DAILY EAT-  
ING PATTERNS, IN CLASS 42 (U.S. CLS. 100 AND  
101).

FIRST USE 8-12-1999; IN COMMERCE 8-12-1999.  
OWNER OF U.S. REG. NO. 1,641,635.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT  
TO USE "EAT 5 A DAY", APART FROM THE  
MARK AS SHOWN.

SER. NO. 76-000,500, FILED 3-9-2000.

JEFFREY S. MOLINOFF, EXAMINING ATTORNEY

MAB



DEPARTMENT OF HEALTH & HUMAN SERVICES

Public Health Service

Phone: (301) 496-0477  
Fax: (301) 402-2117  
E-mail: scherm@mail.nih.gov

National Institutes of Health  
National Cancer Institute  
Technology Transfer Branch  
Executive Plaza South, Room 450  
6120 Executive Blvd.  
Bethesda, MD 20892-7181  
Direct Phone: (301) 435-3114



06-24-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

June 24, 2003

Box TTAB  
FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Dear Commissioner:

Enclosed please find a Notice of Opposition for Application Serial Number 76/429,154 on behalf of opposer, the National Cancer Institute. This Notice of Opposition is filed in duplicate. Also enclosed is an Authorization to Charge Fees to Deposit Account in duplicate. This Notice is being sent via Express Mail on the date indicated above. The Express Mail label No. for this Request is ER255334088US.

Please stamp the enclosed postcard with the date of receipt and return it to the sender.

Very truly yours,

Malka Scher, Esq.  
Technology Transfer Branch  
National Cancer Institute

Encl.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 on the date shown below:

Malka Scher

6/24/03 (date)