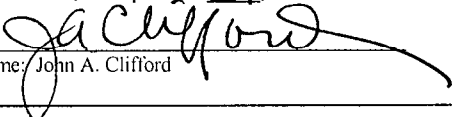


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

\_\_\_\_\_)  
Nash-Finch Company, )  
Opposer, ) Opposition No. \_\_\_\_\_  
v. )  
Castle Wine and Brandy Company Limited, )  
Applicant. ) Serial No.: 76/017,244  
\_\_\_\_\_) Mark: B BERNINI BERNINI

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513, on September 24, 2003.  
By:   
Name: John A. Clifford

**NOTICE OF OPPOSITION**

To The Assistant Commissioner for  
Trademarks  
ATTN: BOX TTAB  
2900 Crystal Drive  
Arlington, VA 22202-3513

Dear Sir:

Opposer, Nash-Finch Company, a corporation duly organized and existing under the laws of Minnesota, with a mailing address of 7600 France Avenue South; Minneapolis, Minnesota 55435, believes that it will be damaged by the registration of the mark shown in Application Serial No. 76/107,244 filed April 4, 2000 by Applicant, Castle Wine and Brandy Company Limited, a corporation duly organized and existing under the laws of South Africa, with a mailing address of Aam-De-Wagenweg; Stellenbosh, South Africa , and hereby opposes registration of the mark. The grounds for opposition are as follows,

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1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the Trademark B BERNINI BERNINI for aperitif wines (International Class 33). No Amendment to Allege Use has been filed. The application is based only on Section 1 (b) of the Trademark Act, Applicant claiming only to have an intention to use the mark.
2. Opposer is the owner of U.S. Trademark Registration No. 1,620,244, registered on October 30, 1990, for the mark BERNINI for prepared pizza (International Class 30).
3. Opposer's registration is incontestable by operation of law, and is conclusive evidence of Opposer's rights. There is no issue of priority concerning application Serial No. 76/124,208 since Opposer's registration issued over thirteen years before Applicant's filing date and Applicant asserts no date of first use for its mark.
4. Opposer's mark BERNINI has been in use in interstate commerce since at least 1987, has been advertised and promoted by Opposer, and has developed and represents valuable goodwill inuring to the benefit of Opposer. Opposer's mark has trademark significance to purchasers and potential purchasers.
5. Applicant's mark is confusingly similar to Opposer's mark. The two are nearly identical in pronunciation and meaning, and have almost the same appearance. Pizza and wine are often consumed together, sold together and travel in similar, identical, or overlapping channels of trade.
6. Due to the similarity between Applicant's claimed mark, and Opposer's previously used and duly registered mark, and the closely related nature of the goods, customers are likely to view Applicant's goods as Opposer's goods or as a line extension of Opposer's goods marketed under the same mark.

7. The goods and services sold by Opposer are closely related to the proposed goods to be sold by Applicant.
8. Opposer's and Applicant's goods may be sold in the same channels of trade to the same customers or class of consumers.
9. Due to the confusing similarity of Opposer's previously used and registered trademark with Applicant's proposed trademark and the closely related nature of the goods of the respective parties, customers and potential customers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace and damage to Opposer.
10. The use or registration by Applicant of the mark B BERNINI BERNINI is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used mark BERNINI again resulting in damage to Opposer.
11. Because of the closely related nature of the goods, and the nearly identical nature of the marks, use and registration of the mark B BERNINI BERNINI by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods and services are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.
12. Registration of the mark shown in Application Serial No. 76/017,244 will result in damage to Opposer under the provisions of Section 2(a) and 2(d) of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that the registration of the term B BERNINI BERNINI set forth therein be refused.

Please direct all correspondence to the attention of:

John A. Clifford  
Merchant & Gould P.C.  
PO Box 2910  
Minneapolis, MN 55402  
612.336.4616

Opposer hereby appoints Allen W. Hinderaker, Kristina M. Foudray; Brian H. Batzli, Reg. No. 32,960; John L. Beard, Reg. No. 27,612; Linda M. Byrne, Reg. No. 32,404; John A. Clifford, Reg. No. 30,247; Sandra Epp Ryan, Reg. No. 39,667; Gregory C. Golla; John D. Gould, Reg. No. 18,223; Curtis B. Hamre, Reg. No. 29,165; Scott W. Johnston, Reg. No. 39,721; D. Randall King; Anna W. Manville; and Paul A. Welter, Reg. No. 20,890 of Merchant & Gould P.C. as its attorneys with the full power to represent the Opposer in connection with this application.

Accompanying the duplicate signed copies of this Notice of Opposition is the required fee of \$600.00. Please charge any excess fees or credit any overpayment to Deposit Account No. 13-2725 of Opposer's counsel noted above.

Respectfully submitted,

Nash-Finch Company.

By its attorneys,

Date:

22<sup>nd</sup> Sept 2003

  
\_\_\_\_\_  
John A. Clifford

TTAB

# Merchant & Gould

An Intellectual Property Law Firm

P.O. Box 2910  
Minneapolis, Minnesota  
55402-0910  
TEL 612.332.5300  
FAX 612.332.9081  
www.merchant-gould.com

Direct Contact | John A. Clifford  
612.336.4616

A Professional Corporation

Nash-Finch Company, )  
Opposer, )  
v. )  
Castle Wine and Brandy Company Limited, )  
Applicant. )

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



09-29-2003

U.S. Patent & TMOs/TM Mail Rpt Dt. #04

Mark: B BERNINI BERNINI  
Serial No.: 76/017,244  
Docket Number: 1183.58-US-TA  
Official Gazette: May 27, 2003

Due Date: September 24, 2003  
Filing Date: April 4, 2000

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513, on September 24, 2003.

By:   
Name: John A. Clifford

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

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.8
- Notice of Opposition (1 Original and 1 Copy)
- Check in the amount of \$300.00 to cover Filing Fee.

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By:   
Name: John A. Clifford  
Reg. No.: 30,247  
JAC/aes

# Merchant & Gould

An Intellectual Property Law Firm

Direct Contact | John A. Clifford  
612.336.4616

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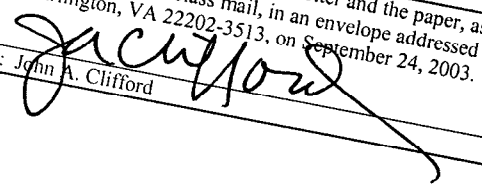
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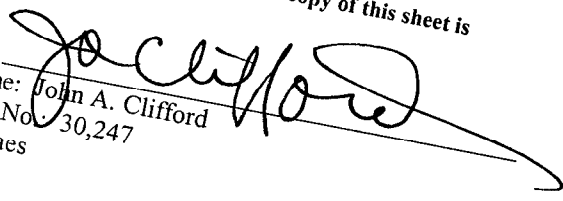
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(CONTESTED MATTER)

