

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

RHEE BROS., INC.
9505 BERGER ROAD
COLUMBIA, MARYLAND 21046

OPPOSER,

V

DAESANG CORPORATION
SEOUL, REPUBLIC OF KOREA

APPLICANT,

OPPOSITION NO. _____



04-14-2004
U.S. Patent & TMO/TM Mail Rcpt D.L. 522

Re: Trademark Application
Applicant: Daesang Corporation
Mark: Miscellaneous Design – Korean Characters
Transliteration: [SOON CHANG CHAL GOCHUJANG]
Serial No.: 76-482606
Date Filed: January 15, 2003
Goods: “hot pepper paste”
Int’l Class: 30
Published: TRADEMARK OFFICIAL GAZETTE, Vol. 438, December 9, 2003

BOX TTAB/FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

Opposer, Rhee Bros., Inc., a Maryland corporation, believes it will be damaged by registration of the Applicant’s of trademark [SOON CHANG CHAL GOCHUJANG] or their Korean equivalent terms (hereinafter “[SOON CHAN CHAL GOCHUJANG]”), for the above listed goods by Daesang Corporation (“Applicant”), and hereby opposes registration thereof pursuant to Section 13 of the 1946 Trademark Act (15 U.S.C. §1063), and files this Notice of

Opposition in duplicates together with referenced exhibits, and the filing fee of \$300 for each international classification, and states that:

1. The Opposer first began using the Opposer's trademark [SOON CHANG CHAP SAL GOCHUJANG] or their Korean equivalent terms (hereinafter "[SOON CHANG CHAP SAL GOCHUJANG]"), in the United States at least as early as January 5, 1978, and has continued to use said trademark in interstate commerce in connection with "hot bean paste".
2. The Opposer is the owner of the trademark [SOON CHANG CHAP SAL GOCHUJANG], U.S. Trademark Registration No. 2140224 used in connection with "hot bean paste" in International Classification 30 (hereinafter "Opposer's Trademark"). A copy of the Opposer's Trademark Registration printout from the uspto.gov is attached hereto as Exhibit A.
3. The Applicant claims to have first begun using its trademark [SOON CHANG CHAL GOCHUJANG] in connection with "hot pepper paste" as early as January 16, 2002.
4. The Applicant filed its trademark application for [SOON CHANG CHAL GOCHUJANG], Serial No. 76-482606, in connection with "hot pepper paste" in International Class 30 (hereinafter "Applicant's Trademark"). A copy of the Applicant's Trademark Application printout from the uspto.gov is attached hereto as Exhibit B.
5. There is no dispute as to priority of use. The Opposer first used its trademark on or about January 5, 1978, whereas the Applicant claims to have first used its mark on or about January 16, 2002.
6. The parties' trademarks, goods, and consumers are identical:
 - A. Trademarks: Both parties' trademarks are virtually identical. The Applicant's Trademark [SOON CHANG CHAL GOCHUJANG] is identical to the Opposer's Trademark [SOON CHANG CHAP SAL GOCHUJANG]. The only apparent different is the term "CHAL" [찰] in the Applicant's Trademark and the term "CHAP SAL" [chap sal] in the Opposer's Trademark. These two terms, however, mean the same. The term "CHAL" [찰] in Korean, as used in the Applicant's Trademark, is an abbreviated term for the terms "CHAP SAL" [chap sal] in Korean, as used in the Opposer's Trademark. They both mean "Glutinous Rice" or "Glutinous". Copies of the relevant pages from the

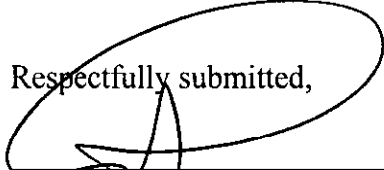
New Little Korean-English Dictionary, Minjungseorim's 4th Edition, are collectively attached hereto as Exhibit C.

- B. Goods: Both parties use their respective Trademarks to sell [고추장] products - the Applicant translated the Korean term as "hot pepper paste" and the Opposer translated the Korean term as "hot bean paste". These two translated terms, however, are essentially the same.
- C. Consumers: Both parties sell there [고추장] using their respective Trademarks to the Korean-Americans.
7. The Applicant's Trademark, Goods and Consumers are same as the Opposer's Trademark, Goods and Consumers. The Applicant's Trademark as used in connection with its Goods will be seen as being sponsored by the Opposer, and is likely to cause confusing, or to cause mistake, or to deceive as to the source of origin to the consuming public.
8. The registration of the Applicant's Trademark will damage the Opposer.

WHEREFORE, the Opposer prays that said application for Applicant's Trademark [SOON CHANG CHAL GOCHUJANG], Serial No. 76-482,606, be denied, that no registration be issued thereon to the Applicant, and that this Opposition be sustained in favor of the Opposer.

4/12/04

Respectfully submitted,


Jonathan Hsong Ahn
Semmes, Bowen & Semmes
250 West Pratt Street
Baltimore, Maryland 21201
(410) 576-4783
jahn@mail.semmes.com

Attorney for Opposer, Rhee Bros., Inc.

CERTIFICATE OF MAILING

It is hereby certified that on 12th day of April, 2004, the aforementioned original Notice of Opposition, is mailed, via U.S. Postal Service first class mail, postage prepaid, to

TTAB
Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202

And, a copy of the same is mailed, via U.S. Postal Service first class mail, postage prepaid, to:

Michael A. Grow, Esq.
Evan S. Stolove, Esq.
Arent Fox PLLC
1050 Connecticut Avenue, N.W.
Washington, DC 20036

Attorneys for Registrant, Daesang Food Co. Ltd.
(previously identified as Daesang Corp. and
formerly known as Hwa Young Foods Co., Ltd.)


Jonathan Hsong Ahn

TTAB

SEMMES, BOWEN & SEMMES

A PROFESSIONAL CORPORATION
ATTORNEYS AT LAW

250 WEST PRATT STREET
BALTIMORE, MARYLAND 21201

TELEPHONE 410-539-5040

FACSIMILE 410-539-5223

WWW.SEMMES.COM

Jonathan Ilson Ahn
Direct Dial: 410-576-4783
Email: jahnr@semmes.com

OFFICES IN
HAGERSTOWN, MARYLAND
McLEAN, VIRGINIA
SALISBURY, MARYLAND
WASHINGTON, D.C.



April 12, 2004

04-14-2004

U.S. Patent & TMOtc/TM Mail Rept Dt. #22

Ms. Tamika Whitsey
TTAB
Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202

Re: Petition to Oppose
Opposer: Rhee Bros., Inc.
Applicant: Dacsang Corp.
Mark: [SOON CHANG CHAL HOT PEPPER PASTE]
Serial No.: 76/482606

Dear Ms. Whitsey:

As you requested, enclosed is a signed Petition to Oppose and a copy in connection with the above-referenced trademark application.

This is an unusual situation. As you know, the Opposer timely filed its Opposition on December 23, 2003 in response to the publication of the Applicant's trademark on December 9, 2003. Subsequently, TTAB notified the Opposer's attorney to resubmit the Opposition because the application was re-published on March 16, 2004. Upon investigation of the prosecution history, it appears that the Trademark Office had withdrawn its previously allowed comment on December 19, 2003 in a late response to the Applicant's Amendment to the Application, which was filed on October 16, 2003.

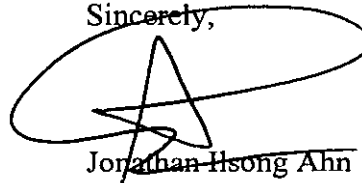
Based on our telephone discussions, you informed me that there was no correspondence from the Applicant since the first publication date, which caused or gave rise to the Trademark Office's withdrawal of the previous allowance. Furthermore, if TTAB later discovers any communication from the relating Applicant relating to the Application, TTAB would naturally allow the Opposer to examine the correspondence and amend its Opposition. If my understanding of the background or our discussion is inaccurate, please let me know.

SEMMES, BOWEN & SEMMES
A PROFESSIONAL CORPORATION

Ms. Tamika Whitsey
April 12, 2004
Page 2

Thank you for your thoughtful review and explanation of the situation. I appreciate your accommodation in this matter.

Sincerely,

A handwritten signature in black ink, appearing to be "Jonathan Hsong Ahn", written over a large, loopy oval scribble.

Jonathan Hsong Ahn

JIA/cld

Enclosures

cc: Syng Man Rhee (w/enclosure)
Jay P. Koh (w/enclosure)
Jay Wilcoxson, Esq. (w/enclosure)