ESTTA Tracking number: **ESTTA12096**
Filing date: **07/21/2004**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	American Italian Pasta Company
Granted to Date of previous extension	07/21/2004
Address	American Italian Pasta Company 4100 N. Mulberry Drive Kansas City, MO 64116-1696 UNITED STATES

Attorney information	Thomas H Van Hoozer Hovey Williams LLP 2405 Grand Blvd, Ste 400 Kansas City, MO 64108 UNITED STATES klg@hoveywilliams.com Phone:816-474-9050

Applicant Information

Application No	78136703	**Publication date**	03/23/2004
Opposition Filing Date	07/21/2004	**Opposition Period Ends**	07/21/2004
Applicant	Barilla Alimentare S.p.A.		

Goods/Services Affected by Opposition

Class 030. First Use: First Use In Commerce: All goods and sevices in the class are opposed, namely: PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

Attachments	Notice of Opposition p1.tif (1 page) Notice of Opposition p2.tif (1 page) Notice of Opposition p3.tif (1 page) Notice of Opposition p4.tif (1 page) Notice of Opposition p5.tif (1 page) Notice of Opposition p6.tif (1 page)

Signature	/tvh/
Name	Thomas H Van Hoozer
Date	07/21/2004

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AMERICAN ITALIAN PASTA COMPANY,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
BARILLA ALIMENTARE S.p.A.	)	
	)	
	)	
Applicant.	)	

NOTICE OF OPPOSITION

In the matter of Application Serial No. 78/136,703, filed June 18, 2002, in the name of Barilla Alimentare S.p.A., published for opposition in the Trademark *Official Gazette* of March 23, 2004 for the mark BARILLA - AMERICA'S FAVORITE PASTA, American Italian Pasta Company (hereinafter referred to as "Opposer") believes that it would be damaged by registration of the mark shown in said application and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer, American Italian Pasta Company, is a corporation organized under the laws of the State of Missouri having a principal place of business at 4100 N. Mulberry Drive, Kansas City, Missouri 64116-1696.
2. Applicant, Barilla Alimentare S.p.A., is, on information and belief, a company organized under the laws of Italy, having a business address at Via Mantova 166, Parma PR, Italy 43100 (hereinafter referred to as "Applicant"). Applicant has

appointed G. Franklin Rothwell, Esq., 1425 K Street, NW Suite 800, Washington, D.C., 20005 as its domestic representative upon whom notice or process in the proceedings affecting the mark may be served.

3. Opposer and/or its predecessors in interest (hereinafter collectively referred to as "Opposer") have continuously used the trademark AMERICA'S FAVORITE PASTA since at least as early as September of 1997 for pasta, and from a date prior to the filing date or the claimed date of first use of the opposed application serial number 78/136,703. In addition, Opposer's predecessor in interest first began using the mark AMERICA'S FAVORITE on its packaging in the 1950's.

4. Opposer has filed applications for registration of the marks AMERICA'S FAVORITE PASTA (word mark) as application serial number 76/497,489 on March 14, 2003 and AMERICA'S FAVORITE PASTA and design as application serial number 76/497,190 on March 14, 2003. Both of these marks recite the goods as "pasta" and have been in continuous use and recite a claimed date of use prior to the filing date of the opposed application serial number 78/136,703.

5. Since the first use of the mark AMERICA'S FAVORITE PASTA in 1997, Opposer and its predecessor in interest have spent substantial sums of money in advertising and promoting its pasta products sold under the AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design marks.

6. As a result of the substantial marketing efforts of Opposer and its predecessor in interest and length of use , its efforts to protect its right to use the mark AMERICA'S FAVORITE PASTA, and its substantial sales of products bearing the marks AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design,

the mark AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design have become distinctive of opposer's pasta goods since before the filing date or first date of use of Applicant's mark.

7. Notwithstanding Opposer's prior rights in and to the aforesaid distinctive AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design marks, on June 18, 2002, Applicant filed an application for registration of a mark consisting of the terms BARILLA - AMERICA'S FAVORITE PASTA under Section 1(b) for "pasta, pasta products, sauces for pasta" in International Class 30 as Application Ser. No. 78/136,703.

8. During prosecution of said application, Applicant amended the identification of goods to "pasta, pasta products, namely, meals consisting primarily of pasta, macaroni salad, pasta salad, sauces for pasta" and entered a disclaimer of the words "AMERICA'S FAVORITE PASTA" apart from the mark as a whole. Application Ser. No. 78/136,703 was published in the *Official Gazette* on March 23, 2004.

9. Application Ser. No. 78/136,703 has been cited against Opposer's Application Ser. No. 76/497,489 and 76/487,190 and as a result, Opposer has been unable to secure registration of its marks AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA and design. Applicant's BARILLA - AMERICA'S FAVORITE PASTA mark is so substantially similar to Opposer's AMERICA'S FAVORITE PASTA and AMERICA'S FAVORITE PASTA marks adopted and used by Opposer and its predecessors in interest since a date long prior to Applicant's filing date that it is likely to cause confusion, or reverse confusion, as to the source, sponsorship

or affiliation as to the user by the purchasing public as to the source of goods sold under the mark.

10. Applicant has previously registered the mark BARILLA as shown, for example, in Reg. No. 2,005,752 for pasta, and thus granting Applicant registration of the mark BARILLA - AMERICA'S FAVORITE PASTA is not calculated to protect Applicant's Barilla trademark but to prevent others from use or registration of the portion of the mark AMERICA'S FAVORITE PASTA contrary to Opposer's prior rights therein.

11. Applicant's BARILLA - AMERICA'S FAVORITE PASTA designation so resembles Opposer's prior and aforesaid AMERICA'S FAVORITE PASTA Marks as to be likely, when used in connection with the services of Applicant, to cause confusion or reverse confusion, or mistake or to deceive customers, thereby resulting in damage and detriment to Opposer, its AMERICA'S FAVORITE PASTA Marks, and its right to enjoy exclusive use and registration thereof.

12. The goods identified in the opposed application are the same or so similar and/or related to the goods sold by Opposer under its AMERICA'S FAVORITE PASTA Marks, and, upon information and belief, Opposer and Applicant engage in, and/or will engage in, the sale and promotion of their respective goods through the same and/or similar channels of trade, and/or to the same general class of purchasers.

13. Upon information and belief, members of the relevant trade and public are likely to be confused, mistaken or deceived as to the origin, sponsorship, and/or association of Opposer's goods rendered under Opposer's AMERICA'S FAVORITE PASTA Marks, and misled into believing that such goods emanate from, or in some way, directly or indirectly, are associated with and/or endorsed by Applicant if Applicant

is granted the right to register the mark BARILLA - AMERICA'S FAVORITE PASTA with its presumption of exclusive right to use said mark, to the damage and detriment of Opposer, its goodwill and reputation.

14. Upon information and belief, the application to register the mark of Applicant, namely, BARILLA - AMERICA'S FAVORITE PASTA, was submitted with notice and knowledge of the prior rights and use of Opposer's AMERICA'S FAVORITE PASTA Marks in connection with pasta products.

15. To allow registration of the mark BARILLA - AMERICA'S FAVORITE PASTA for the goods identified in the subject application serial number 78/136,703 to Applicant in view of the prior rights of Opposer would cause damage to Opposer and to the reputation and goodwill it enjoys in its AMERICA'S FAVORITE PASTA Marks for pasta.

16. For the reasons set forth above, Opposer, by this Notice of Opposition, opposes the registration by Applicant of the mark BARILLA - AMERICA'S FAVORITE PASTA and therefore requests that this opposition be sustained.

WHEREFORE, Opposer prays that registration of Application Serial No. 78/136,703 be denied as filed and published and Applicant adjudged not entitled to registration of the mark BARILLA - AMERICA'S FAVORITE PASTA. If any additional fee is due in connection with the filing of this Notice of Opposition, it may be charged to Deposit Account 19-0522.

Respectfully submitted,

AMERICAN ITALIAN PASTA COMPANY

By its attorneys,

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Attorneys for Opposer