OIPE IAP97
JAN 12 2007
PATENT & TRADEMARK OFFICE

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

TTAB
78136703

AMERICAN ITALIAN PASTA COMPANY Opposer, v. BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI Applicant.	Opposition No. 91/161,373

NOTICE OF FILING OF TESTIMONY DEPOSITION TRANSCRIPT PURSUANT TO 37 C.F.R. § 2.125(c)

Applicant, BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI ("Applicant") hereby give notice to Opposer, AMERICAN ITALIAN PASTA COMPANY ("Opposer") in the above-identified Opposition proceeding that a certified transcript and accompanying exhibits 1-9 of the testimony deposition of Sergio Pereira taken by Applicant on December 19, 2006 in Bannockburn, Illinois (attended by Cheryl Burbach on behalf of Opposer and Brian Banner, Esq. on behalf of Applicant), has been filed with the U.S. Patent and Trademark Office, before the Trademark Trial and Appeal Board.

Counsel for Applicant has filed and served the transcript and accompanying exhibits 1-9 in accordance with the rules of the Trademark Trial and Appeal Board.

01-12-2007
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

January 11, 2007

Respectfully submitted,
BARILLA G. E R. FRATELLI -
SOCIETA PER AZIONI

By: Brian Banner

Brian Banner, Esq
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck
1425 K Street N.W.
Suite 800
Washington D.C. 20005

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the following **NOTICE OF FILING OF TESTIMONY DEPOSITION TRANSCRIPT PURSUANT TO 37 C.F.R. § 2.125(c)** was served on this 12th day of January, 2007, by U.S. Mail postage pre-paid on the following counsel for Opposer:

Thomas H. Van Hoozer, Esq.
Hovey Williams, LLP.
2405 Grand Boulevard
Suite 400
Kansas City, Missouri 64108

Patrick Collares

ORIGINAL

1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE TRADEMARK TRIAL
AND APPEAL BOARD
3
4
AMERICAN ITALIAN PASTA)
5 COMPANY) Opposition No. 91161373
OPPOSER:)
6 VS.)
BARILLA G.E.R.)
7 FARTELLI-SOCIETA PER) DEPOSITION TAKEN ON
AZIONI) BEHALF OF APPLICANT
8 APPLICANT.)
9 * * * * * * * * *
10
DEPONENT: SERGIO PEREIRA
11
DECEMBER 19, 2006
12
2:00 P.M.
13
14
15
16 Reported by: Deborah R. Santi, CSR
17
18
19
20
21
22
23
24

1 A P P E A R A N C E S:

2 MR. BRIAN BANNER
Rothwell, Figg, Ernst & Manbeck, P.C.
3 1425 K Street, NW, Suite 800
Washington D.C. 20005
4 (202) 783-6040
appearing on behalf of the Applicant;
5

MS. CHERYL BURBACH
6 Hovey Williams, LLP
2405 Grand Boulevard, Suite 400
7 Kansas City, Missouri 64108
(816) 474-9050
8 appearing on behalf of the Opposer.
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24

1 STIPULATIONS

2

3 IT IS HEREBY STIPULATED AND AGREED
4 by and between counsel for the applicant and
5 counsel for the opposer that this deposition
6 may be taken in stenographic shorthand by
7 Deborah R. Santi, Certified Court Reporter,
8 and afterwards reduced into typewriting.
9 IT IS FURTHER STIPULATED AND AGREED
10 by and between the parties that presentment to
11 the attorneys of record of a copy of this
12 deposition shall be considered submission to
13 the witness for signature pursuant to
14 703.01(j) -- 37 CFR 2.123(e)(5); but shall in
15 no way be considered as a waiver of the
16 witness's signature, to be signed by the
17 witness at any time before or at the trial of
18 this case, and if not signed by the time of
19 trial it may be used as if signed.
20 IT IS FURTHER STIPULATED AND AGREED
21 between counsel for the respective parties
22 hereto that the deposition of the witness may
23 be signed before a notary public.
24

1 (Witness sworn.)

2 MR. BANNER: Mr. Pereira, my name

3 is Brian Banner, and I'll be taking your

4 testimonial deposition in this matter today on

5 behalf of the applicant, Barilla G. ER.

6 Fratelli - SPA.

7 When I conclude, Ms. Burbach

8 is going to ask you questions. She represents

9 American Italian Pasta Company in this

10 matter

11 The testimonial deposition is

12 like being a witness in a trial before a

13 judge. In an opposition proceeding, such as

14 this, there isn't any actual judge. It's the

15 trademark trial and appeal board.

16 Have you been deposed before?

17 THE WITNESS: No.

18 MR. BANNER: Okay. In this

19 deposition I will ask you questions, and my

20 questions and your answers will be recorded by

21 the court reporter at the end of the table.

22 You understand you need to speak up, to answer

23 orally, and give your answers loud enough that

24 I can hear and she can hear, okay?

1 THE WITNESS: Yes.
2 MR. BANNER: On occasion I'll ask
3 you a question that you may not understand.
4 It's my job to ask clear questions.
5 If you don't understand one of
6 my questions or one of her questions, please
7 stop and say I don't understand, please
8 rephrase. That's okay.
9 If you need a break at any
10 time, just ask me and finish answering the
11 question, and we'll see to having a break. We
12 have water here and coffee in the office.
13 Feel free to get up and have some coffee or
14 water.
15 Sometimes in a deposition the
16 deponent answers the question and later on
17 remembers something that he or she didn't say
18 with regard to the prior question. If it
19 occurs with you, if you have any recollection
20 or you want to correct or augment an answer
21 that you've given previously, when it comes to
22 your mind, ask the person taking your
23 deposition if you can stop and go back to that
24 question and clarify your answer. We'll do

1 it -- We'll stop the deposition right then and
2 go back to the question and your answer and
3 you can supplement it at that point.
4 THE WITNESS: Okay.
5 SERGIO PEREIRA,
6 called as a witness herein, having been first
7 duly sworn, was examined and testified as
8 follows:
9 DIRECT EXAMINATION
10 BY MR. BANNER:
11 Q. Are you taking any medication today
12 that might inhibit your ability to answer
13 questions --
14 A. No.
15 Q. -- and understand them?
16 Would you please state your
17 full name for the record?
18 A. Sergio Pereira.
19 Q. Thank you.
20 Are you appearing today
21 pursuant to the notice of deposition --
22 MR. BANNER: Can you please mark
23 this Number 1?
24 (Whereupon, Pereira

1 Exhibit No. 1 was
2 marked for
3 identification.)
4 THE WITNESS: Okay.
5 BY MR. BANNER:
6 Q. Can you please tell us your
7 education level since high school?
8 A. Yeah. I have a Bachelor's of
9 Science from -- in business from Syracuse
10 University and a Master's in Business from
11 Northwestern.
12 Q. When did you get your Master's in
13 Business from Northwestern?
14 A. In 1987.
15 Q. Who is your current employer?
16 A. Barilla America.
17 Q What is your current position?
18 A. I am the vice president of
19 marketing.
20 Q. Okay. What is your current
21 responsibility?
22 A. I have responsibility for the
23 Barilla pasta, Barilla sauces, Barilla filled
24 pasta, and the Wasa cracker business in North

1 America.
2 Q. How long have you held this
3 position?
4 A. Since 2001.
5 Q. Okay. When did you begin your
6 employment with Barilla?
7 A. In 1998.
8 Q. Prior to assuming your current
9 title and position you worked for Barilla for
10 that period of time.
11 What did you do?
12 A. I was the director of marketing.
13 Q. Prior to your employment with
14 Barilla, do you have any experience in the
15 food industry?
16 A. Yes.
17 Q. Can you please tell me?
18 A. Yeah. I worked at Kraft Foods from
19 1987 through 1995.
20 Q. What did you do at Kraft Foods?
21 A. I worked in marketing as well. So
22 my last job there was business director for
23 the salad dressing business.
24 Q. Okay. And is that the Kraft Foods

1 that's in Illinois?
2 A. Yeah. Here, in Glenview.
3 Q. Okay. Now, returning to Barilla,
4 what is the geographical scope of the sales of
5 pasta sold by Barilla today in terms of USA?
6 A. We sell in all 50 states.
7 Q. In June -- On June 18, 2002 Barilla
8 filed three separate intent-to-use trademark
9 applications at the United States Patent and
10 Trademark Office.
11 MR. BANNER: Please mark this
12 Applicant's Exhibit Number 2.
13 (Whereupon,
14 Applicant's Exhibit
15 No. 2 was marked for
16 identification.)
17 BY MR. BANNER:
18 Q. All were goods as identified as
19 pasta, pasta products, and sauces for pasta.
20 Were you involved with those
21 applications?
22 A. Yes, I was.
23 Q. Would you explain your involvement?
24 A. My involvement was identifying the

1 marks that we wanted to send for application
2 and submitting them to the attorneys for
3 applications.
4 Q. Okay. The first filed application
5 was Barilla - America's Favorite Pasta.
6 A. Okay
7 Q. I have marked it -- the file
8 history as Applicant's Exhibit 2, serial
9 number 78/136,703.
10 What was Barilla's intent at
11 the time this application was filed on June
12 18, 2002?
13 A. Our intent was to file this for use
14 to essentially denote the fact that the
15 product is and was at the time the highest
16 sales brand in the United States.
17 Q. Okay.
18 MR. BANNER: Please mark this
19 Applicant's Exhibit Number 3.
20 (Whereupon,
21 Applicant's Exhibit
22 No. 3 was marked for
23 identification.)
24 BY MR. BANNER:

1 Q. I hand you what has been marked as
2 Applicant's Exhibit Number 3 which is a copy
3 of Judge Scott Wright's February 25, 2003
4 order in the civil action captioned American
5 Italian Pasta Company v New World Pasta
6 Company, number 02-0594-CV-W-SOW.
7 Have you read this?
8 A. In it's entirety. It's been a long
9 time since I read it, but yes.
10 Q. Okay. Directing your attention to
11 page two of the order of the Judge, he has
12 written, "The parties agree that Barilla was
13 the largest seller of dried pasta in the
14 United States during the year 2002."
15 Do you see that?
16 A. Yes.
17 Q. Does this statement continue to be
18 true today?
19 A. Yes.
20 Q. Was it true in 2002?
21 A. It has been true every year since.
22 Q. Okay.
23 MR. BANNER: Please mark this
24 Exhibit Number 4.

1 (Whereupon,
2 Applicant's Exhibit
3 No. 4 was marked for
4 identification.)
5 BY MR. BANNER:
6 Q. I hand you what has been marked
7 Applicant's Exhibit Number 4, which is a copy
8 of the June 7, 2004 opinion of the United
9 States Court of Appeals for the Eighth Circuit
10 in the civil action captioned American Italian
11 Pasta Company versus New World Pasta.
12 Have you read this?
13 A. I believe I have, yes.
14 Q. Directing your attention to page
15 three of that order the Judge has written
16 quote, "American and New World agree Barilla
17 sells the most dried pasta in the United
18 States."
19 That statement was accurate in
20 2004?
21 A. Yes, it was.
22 Q. And it's accurate today?
23 A. Yes.
24 Q. As vice president of marketing for

1 Barilla America, what does the slogan,
2 "Barilla - America's Favorite Pasta" mean to
3 your marketing efforts and mean to you?
4 A. Well, it tells people that we are
5 the brand of pasta that has the highest
6 consumption in the United States.
7 Q. Okay.
8 MR. BANNER: Please mark this
9 Applicant's Exhibit Number 5.
10 (Whereupon,
11 Applicant's Exhibit
12 No. 5 was marked for
13 identification.)
14 BY MR. BANNER:
15 Q. I hand you what has been marked
16 Applicant's Exhibit Number 5, which is the
17 second attempt to use trademark application
18 for the slogan, "Barilla - America's #1 Pasta"
19 filed on June 18, 2002 as serial number
20 78137 -- 136706 at the U.S. Patent and
21 Trademark Office.
22 Again, this is for the goods
23 identified as pasta, pasta products, and
24 sauces for pasta.

1 What was Barilla's intent at
2 the time this application was filed?
3 A. Our intent was to consider it for
4 use, again, to denote that the brand was, in
5 fact, the number one pasta brand in sales in
6 the United States for consumption.
7 Q. Okay.
8 MR. BANNER: Please mark this as
9 Applicant's Exhibit Number 6.
10 (Whereupon,
11 Applicant's Exhibit
12 No. 6 was marked for
13 identification.)
14 BY MR. BANNER:
15 Q. I hand you what's been marked
16 Applicant's Exhibit Number 6 in this case, the
17 third intent to use trademark application for
18 the slogan "Barilla - America's Preferred
19 Pasta" filed June 18, 2002 as serial number
20 78136708. This application also was for goods
21 identified as pasta, pasta products, and
22 sauces for pasta.
23 What was Barilla's intent at
24 the time this application was filed?

1 A. It's the same intent as for the
2 prior two which was to communicate to
3 consumers the number one ranking of this brand
4 in terms of consumer sales and consumption.
5 Q. Okay. In your employment at
6 Barilla, has Barilla ever been accused of
7 trademark infringement?
8 A. No, not that I know of.
9 Q. Okay.
10 MR. BANNER: Please mark this
11 Applicant's Exhibit --
12 THE WITNESS: Actually, let me --
13 You know, as I'm thinking about that, we did
14 have a small company called No Boil Lasagna,
15 the actual term no boil was trademarked. Our
16 noodle said no boil lasagna noodles. So
17 they -- We were not actually -- We didn't
18 litigate. They didn't sue us. We had
19 conversations and eventually we reached an
20 agreement.
21 BY MR. BANNER:
22 Q. But that's been the only time?
23 A. Yes.
24 (Whereupon,

1 Applicant's Exhibit
2 No. 7 was marked for
3 identification.)
4 BY MR. BANNER:
5 Q. I hand you what's been marked
6 Applicant's Exhibit Number 7, the Joie Warner
7 copyright 1994 cookbook titled Spaghetti
8 America's Favorite Pasta, and ask you, to the
9 best of your knowledge, is spaghetti really
10 America's favorite pasta?
11 A. It is. It is the cut of pasta that
12 has the highest penetration among America
13 households, and it represents about 35 percent
14 of the sales of pasta in the United States
15 making it the biggest type of pasta consumed.
16 Q. Thank you.
17 MR. BANNER: Please mark this
18 Applicant's Exhibit Number 8.
19 (Whereupon,
20 Applicant's Exhibit
21 No. 8 was marked for
22 identification.)
23 MS. BURBACH: I'm sorry, I had a
24 question about objections. I don't want to

1 interrupt the flow of the deposition or
2 anything, but if I do have objections would
3 you prefer that I object at the moment on
4 speaking objection, that type of thing, or
5 would you prefer that I reserve them and we go
6 back later?
7 MR. BANNER: Let's do them as we go
8 and then we can get them on the record and
9 he'll go on and answer them.
10 MS. BURBACH: And there probably
11 won't be very many.
12 I want to object to that last
13 response because it lacks foundation and calls
14 for speculation.
15 BY MR. BANNER:
16 Q. I hand you what has been marked
17 Applicant's Exhibit 8 which is a picture of
18 Opposer's two-pound spaghetti box.
19 Please look at the picture,
20 and based on your marketing experience, tell
21 me what you think is the trademark or
22 trademarks in the picture.
23 MS. BURBACH: I'm going to object
24 on the basis that it lacks foundation and

1 calls for speculation.
2 MR. BANNER: Okay. Please answer
3 the question.
4 THE WITNESS: I believe the
5 trademark is Mueller's Quality Since 1867.
6 BY MR. BANNER:
7 Q. What, if any similarity, is there
8 between the wording spaghetti on that exhibit
9 and the slogan America's Favorite Pasta?
10 A. The font of these two is the same.
11 (Whereupon,
12 Applicant's Exhibit
13 No. 9 was marked for
14 identification.)
15 BY MR. BANNER:
16 Q. Okay. I hand you what has been
17 marked Applicant's Exhibit Number 9 in this
18 matter. At the top it says Bravo.
19 Can you tell me what the date
20 of this is and what is it?
21 A. Yeah. This was a trade ad that ran
22 in 1998 when Barilla became the number one
23 brand in sales in the United States. I cannot
24 remember exactly the magazine, but I believe

1 is ran in Supermarket News as one of the
2 magazines.
3 Q. Supermarket News.
4 A. Supermarket News and maybe another
5 trade publication essentially communicating
6 the fact that Barilla was the number one brand
7 in the United States.
8 Q. And what was the date of that?
9 A. Somewhere in 1998. Well, it says
10 here four week ending October. So it was --
11 It must have been published in November or
12 December of '98.
13 Q. Okay.
14 MR. BANNER: Thank you.
15 I have no further questions of
16 this witness.
17 Do you want to take a break?
18 MS. BURBACH: Let's take a quick
19 break.
20 (A short break was
21 taken.)
22 MR. BANNER: Back on the record.
23 MS. BURBACH: Mr. Pereira, my name
24 is Cheryl Burbach.

1 THE WITNESS: Hello, Cheryl.
2 MS. BURBACH: Hello. I'm here on
3 behalf of American Italian Pasta Company in
4 the opposition, and I would just echo
5 everything Mr. Banner said about if I ask you
6 a question that's unclear, please feel free to
7 ask me to clarify it.
8 Take as much time as you need
9 to to answer the questions as well.
10 THE WITNESS: Okay.
11 MS. BURBACH: I don't have that many
12 questions.
13 CROSS-EXAMINATION
14 BY MS. BURBACH:
15 Q. With regard to the application
16 serial number 78/136,703 for Barilla -
17 America's Favorite Pasta, what involvement did
18 you have in that trademark application?
19 I understand that you helped
20 select the mark.
21 A. Right.
22 Q. Was there anything else that you
23 did?
24 A. Like what?

1 Q. Did you assist in the information
2 that went into the trademark application?
3 A. As far as I know the information
4 that went in the trademark application was the
5 attorneys. The selection of the claim, yes;
6 the legal process, no.
7 Q. Right.
8 Did you -- For instance, in
9 deciding what goods would be listed in the
10 trademark application, was that your decision?
11 A. It was -- Yeah, it probably was my
12 decision.
13 Q. Okay. And would the same be true
14 for the other two applications: America's --
15 Barilla - America's #1 Pasta and Barilla -
16 America's --
17 A. Yeah, it should have been the same
18 list. As far as I know, yes.
19 Q. Do you recall if you signed the
20 trademark applications?
21 A. No, I don't recall.
22 Q. Okay. Isn't it true that your
23 company also filed a trademark application for
24 Barilla - America's Best Pasta?

1 A. Yeah, I believe we did.
2 Q. And do you know what the status of
3 that application is?
4 A. I understand that application is no
5 longer active.
6 Q. And do you know why that is the
7 case?
8 A. No.
9 Q. Did you have any involvement in
10 that application?
11 A. It was -- If it was dated the same
12 day, yes.
13 Q. Let's talk about what's been marked
14 as Exhibit Number 3 that Mr. Banner handed
15 you.
16 Are you familiar with this
17 lawsuit?
18 A. Yes.
19 Q. Can you tell me what you know about
20 the lawsuit?
21 A. I know that New World Pasta sued
22 AIPC because they believed that the claim
23 America's Favorite Pasta was not truthful.
24 Q. Do you know why they believed that?

1 A. Because it was a statement -- It
2 was purported to be a statement of fact, and
3 Mueller's was not, in fact, the pasta with
4 greatest sales and it didn't have a national
5 presence either, so.
6 Q. Do you know what the ultimate
7 outcome was of that case?
8 A. Yes, I do. I know that it was --
9 The case was decided in favor of Mueller's
10 because the America's Favorite Pasta wording
11 was considered to be a claim that was puffery.
12 Q. Can you explain what you believed
13 puffery means?
14 A. The way I understand puffery is a
15 claim that is either so outrageous that not --
16 someone with common sense wouldn't believe it
17 to be true. So the most beautiful person in
18 the world, for example, or something that is
19 vague and non-measurable.
20 Q. Are you aware that that decision
21 was appealed before the Eighth Circuit Court
22 of Appeals?
23 A. Yes.
24 Q. And do you know the outcome of that

1 decision?

2 A. I know -- Yeah. I think that the

3 outcome was that the court favored again for

4 Mueller's claiming that America's Favorite

5 Pasta is a claim of puffery.

6 Q. And when you say Mueller's, are you

7 referring to American Italian Pasta Company?

8 A. Yes.

9 Q. Okay. You spoke about the

10 trademark No Boil Lasagna, and I wanted to

11 follow up a little bit more on that.

12 Do you recall who the owner of

13 the No Boil trademark was?

14 A. It's a very small company. I don't

15 know the name. I could find it, but.

16 Q. That's okay.

17 And do you know when this

18 dispute occurred?

19 A. I'm going to say it occurred -- It

20 wasn't a dispute per se. They sent us a

21 letter noting that our product said no boil

22 and they had a trademark on No Boil. We

23 replied to them and thought that the use of it

24 was descriptive. Further down the road as we

1 revised our package, we changed our package to
2 say no boiling required and notified them we
3 were making that change.
4 Q. Do you recall if you filed a
5 trademark application for the words or that
6 included the words no boil?
7 A. We did not file a trademark
8 application.
9 Q. Were you using the words no boil as
10 a trademark?
11 A. No. We were using it as a
12 descriptor.
13 Q. And what does that mean to you, a
14 descriptor?
15 A. Something that describes what the
16 product does or describes something about the
17 product. So for example, if I go here, you
18 know, two-pound family size, to me, this is a
19 descriptor of the product. Made with North
20 American Grown Durum Wheat is a descriptor of
21 the product. America's Favorite Pasta is a
22 descriptor of the product. The popularity of
23 a product and spaghetti is a descriptor. So
24 there's a lot of descriptive stuff on this

1 package.
2 MR. BANNER: Let's -- Could you
3 please identify you're talking about Exhibit
4 8?
5 THE WITNESS: I can't tell whether
6 it's 6 or 8.
7 MR BANNER: It's 8.
8 THE WITNESS: Okay, Exhibit 8.
9 Yeah, on the Mueller's packaging there is the
10 amount of product is descriptive, the type of
11 cut is descriptive, the America's Favorite
12 Pasta claim is descriptive.
13 So on the Barilla package
14 there's descriptive in terms of the cooking --
15 MR. BANNER: And what number is
16 that?
17 THE WITNESS: Exhibit 115.
18 MS. BURBACH: It's Opposer's
19 Exhibit 115.
20 THE WITNESS: So it was descriptive
21 on the Al Dente Perfection in 10 to 12
22 Minutes, 100 percent Selected Durum Wheat
23 Semolina.
24 BY MS. BURBACH:

1 Q. Do you see on package -- on Exhibit
2 Number 115 where it says Italy's #1 Pasta?
3 A. Yes.
4 Q. Is that descriptive?
5 A. Well, we have a trademark on
6 Italy's #1 Pasta, and we have a separate
7 trademark on Barilla. So we actually have two
8 trademarks here.
9 Q. And by trademark you mean two
10 registered trademarks?
11 A. Yes.
12 Q. But nonetheless, would you agree
13 that Italy's #1 Pasta is descriptive?
14 A. Yeah. It could be descriptive,
15 yes.
16 Q. Okay. I'm going to hand you what
17 has been marked as Opposer's Exhibit Number
18 116.
19 Can you identify that for me?
20 A. Yeah. This is the Barilla logo.
21 Q. What kind of document is it?
22 Do you know what kind of document it is?
23 A. Yes. Well, I'm looking at it right
24 now. It says U.S. Patent Office Principal

1 Register Trademark.

2 Q. And what are the goods identified?

3 A. Pasta.

4 Q. And could you, for the record, read

5 the registration number at the top right-hand

6 corner of the exhibit?

7 A. 897,460.

8 MR. BANNER: I'm sorry, what number

9 was this?

10 MS. BURBACH: One one six.

11 MR. BANNER: Thank you.

12 BY MS. BURBACH:

13 Q. I'm going to hand you what's been

14 marked as Opposer's Exhibit Number 117.

15 Could you please identify what

16 that document is?

17 A. It is a Trademark Service Mark

18 Principal Register for the Barilla logo.

19 Q. And what is the registration number

20 of that?

21 A. 2,657,872.

22 Q. And what are the goods identified

23 in there or services?

24 A It says ready-made and pre-prepared

1 dishes based on pasta for restaurants and
2 catering services.
3 Q. Okay. I'm going to hand you what
4 has been marked as Opposer's Exhibit Number
5 118.
6 Would you please identify that
7 exhibit?
8 A. It is the word Barilla.
9 Q. And what is the registration
10 number?
11 A. 2,005,752.
12 Q. And what are the goods or services
13 identified in the registration?
14 A. Flour and preparations made from
15 cereals, bread, breadsticks, rusks, crackers,
16 pasta in Class 30.
17 Q. Thank you.
18 I'm now handing you Exhibit --
19 Opposer's Exhibit Number 119.
20 Would you again identify that?
21 A. It is the Barilla logo in its new
22 contemporary look, and it is -- Do you want
23 the number again?
24 Q. Yes, please.

1 A. Registration number 2,964,682.
2 Q. And can you tell me if pasta is
3 among the goods identified in that
4 registration?
5 A. Meat, fish, poultry, and game.
6 Yes, it is.
7 Q. Okay. Thank you.
8 One more exhibit, Opposer's
9 Exhibit Number 120, and could you, again,
10 identify what the document is, the same
11 information?
12 A. It is a trademark for the words
13 Italy's #1 Pasta. Registration number
14 2,790,465
15 Q. And could you identify what the
16 goods are?
17 A. Yeah. Pasta and pasta products.
18 Do you want me to read all of
19 this?
20 Q. No, that's okay.
21 Mr. Pereira, are you -- Is
22 your company the owner of these trademark
23 registrations?
24 A. Barilla Alimentare, the holding

1 company is

2 Q. And on Exhibit 115, the box for

3 Barilla, do you see a registration symbol?

4 A. I see one registration symbol.

5 Q. And for what mark is that

6 identifying?

7 A. I think that's for the Barilla

8 logo.

9 Q. And is there a registration symbol

10 or trademark symbol next to the trademark

11 Italy's #1 Pasta?

12 A. No.

13 Q. Okay.

14 A. Not in the front. I don't know if

15 there's one in the back.

16 MR. BANNER: I'm going to enter an

17 objection to that question because the R in

18 circle is in -- Well, I'm going to mark an

19 objection to the question because it calls for

20 careful review of the box top and your answer

21 was I think directed to the front of the box.

22 THE WITNESS: Yes, it is.

23 MR. BANNER: Take a look at the top

24 of the box. Is your answer the same?

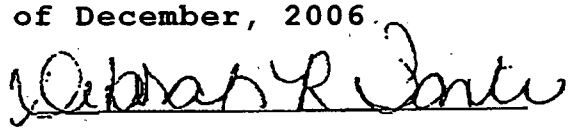
1 Look at the Barilla mark at
2 the top of the box and the R and the circle.
3 MS. BURBACH: Is it okay if you do
4 that on redirect?
5 MR BANNER: Yeah, I'm sorry.
6 MS. BURBACH: That's okay. I'm
7 almost done anyway.
8 You know, I don't have any
9 more questions.
10 THE WITNESS: The only thing, you
11 know, as I examine the logo, I have no idea
12 what the right way to treat a double -- when
13 you have two registered trademarks. What I do
14 know is we have used Italy's #1 Pasta as a
15 trademark by itself and protected it with a
16 proper circle R or TM as the case may have
17 been at the time. I'm sure we can identify
18 many examples of that.
19 MR. BANNER: I think that covers my
20 question.
21 MS. BURBACH: Actually, one last
22 question, if you don't mind.
23 BY MS. BURBACH:
24 Q. I have been staring at your phone

1 facing you at this time and I see it has your
2 Barilla logo on it.
3 A. Yes.
4 Q. And can you read what's beneath the
5 logo on there?
6 A. It says Italy's #1 Pasta.
7 Q. Does Italy's #1 Pasta, when it is
8 near the logo of Barilla, usually appear in
9 smaller font?
10 A. Well, the font of the logo is so
11 big that even when it's not close to the logo
12 it's never bigger than the logo. The logo is
13 the main visual element in all of our
14 packaging.
15 Q. So Italy's #1 Pasta you consider
16 that a trademark as well, correct?
17 A. Yes, but it's secondary in the
18 placement. If you look at our most recent
19 execution, it's even smaller. It now says
20 Italy's #1 Brand of Pasta. We became very
21 specific.
22 Q. So did you substitute that language
23 for Italy's #1 Pasta?
24 A. On the package I think that's what

1 it says now. I'll have to take a look.
2 Q. Have you filed a trademark
3 application for that new language?
4 A. I don't recall.
5 MS. BURBACH: I don't have anything
6 else. I'm finished.
7 MR. BANNER: Let's take a break.
8 (A short break was
9 taken.)
10 MS. BURBACH: For the record,
11 Opposer's Exhibit 115 is been -- has been
12 formally identified as Opposer's Exhibit
13 Number 78.
14 MR. BANNER: Yes, 78.
15 And for the record, I move the
16 admission of my exhibits that are marked.
17 MS. BURBACH: And for the record I
18 also move the admission and entry of my
19 exhibits.
20 (WITNESS EXCUSED.)
21
22
23
24

1 IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE BEFORE THE
2 TRADEMARK TRIAL AND APPEALS BOARD
3 AMERICAN ITALIAN PASTA
COMPANY,
4 Opposer,
v. Opposition No. 91-161,373
5 BARILLA G. ER. FRATELLI -
SOCIETA PER AZIONI,
6
Applicant.
7
8
I hereby certify that I have read the
9 foregoing transcript of my deposition given on
Tuesday, December 19, 2006, and I do again
10 subscribe and make oath that the same is a
true, correct, and complete transcript of my
11 deposition so given as aforesaid, as it now
appears.
12
Please check one:
13 I have no corrections.
Number of errata sheets
14 enclosed.
15 SERGIO PEREIRA
16
SUBSCRIBED AND SWORN to
17 before me this _____
day of _____, 2006.
18
Notary Public
19
20
21
22
23
24

1 STATE OF ILLINOIS)
2) SS.
3 COUNTY OF COOK)
4 I, DEBORAH R. SANTI, Certified Shorthand Reporter and Notary Public in and
5 for the County of Cook, State of Illinois, do hereby certify that on the 19th day of
6 December, 2006, the deposition of the witness SERGIO PEREIRA, called by the Applicant, was
7 taken before me, reported stenographically, and was thereafter reduced to typewriting
8 under my direction.
The said deposition was taken
9 at the offices of Barilla, 1200 Lakeside Drive, Bannockburn, Illinois, and there were
10 present counsel as previously set forth.
The said witness, SERGIO
11 PEREIRA, was first duly sworn to tell the truth, the whole truth, and nothing but the
12 truth, and was then examined upon oral interrogatories.
13 I further certify that the foregoing is a true, accurate, and complete
14 record of the questions asked of and answers
15 made by the said witness, SERGIO PEREIRA, at the time and place hereinabove referred to.
16 The undersigned is not interested in the within case, nor of kin or
17 counsel to any of the parties.
18 IN TESTIMONY WHEREOF: I have hereunto set my hand and affixed my notarial
19 seal this 25th day of December, 2006.
20



21 DEBORAH R. SANTI, CSR
22 CSR # 084-004107
23
24

1 I N D E X

WITNESS: PAGES:

2 SERGIO PEREIRA

Direct Examination by Mr. Banner 4 - 17

3 Cross-Examination by Ms. Burbach 18 - 34

4 E X H I B I T S

5 Pereira Exhibit No. 1 6

Applicant's Exhibit No. 2 9

6 Applicant's Exhibit No. 3 10

Applicant's Exhibit No. 4 12

7 Applicant's Exhibit No. 5 13

Applicant's Exhibit No. 6 14

8 Applicant's Exhibit No. 7 15

Applicant's Exhibit No. 8 16

9 Applicant's Exhibit No. 9 18

10

11

12

13

14

15

16

17

18

19

20

21

22

23

24

A

ability 6:12
accurate 12:19,22 36:13
accused 15:6
action 11:4 12:10
active 22:5
actual 4:14 15:15
ad 18:21
admission 34:16,18
affixed 36:18
aforesaid 35:11
agree 11:12 12:16 27:12
AGREED 3:3,9,20
agreement 15:20
AIPC 22:22
Al 26:21
Alimentare 30:24
America 7:16 8:1 13:1 16:12
American 1:4 4:9 11:4 12:10,16 20:3 24:7 25:20 35:3
America's 10:5 13:2 13:18 14:18 16:8 16:10 18:9 20:17 21:14,15,16,24 22:23 23:10 24:4 25:21 26:11
amount 26:10
answer 4:22 5:20,24 6:2,12 17:9 18:2 20:9 31:20,24
answering 5:10
answers 4:20,23 5:16 36:14
anyway 32:7
appeal 1:2 4:15
appealed 23:21
Appeals 12:9 23:22 35:2
appear 33:8
appearing 2:4,8 6:20
appears 35:11
applicant 1:7,8 2:4 3:4 4:5 35:6 36:6
Applicant's 9:12,14 10:8,19,21 11:2 12:2,7 13:9,11,16 14:9,11,16 15:11 16:1,6,18,20 17:17 18:12,17 37:5,6,6 37:7,7,8,8,9
application 10:1,4 10:11 13:17 14:2 14:17,20,24 20:15 20:18 21:2,4,10,23 22:3,4,10 25:5,8 34:3
applications 9:9,21 10:3 21:14,20
asked 36:14
assist 21:1
assuming 8:8
attempt 13:17
attention 11:10 12:14
attorneys 3:11 10:2 21:5
augment 5:20
aware 23:20
AZIONI 1:7 35:5

B

B 37:4
Bachelor's 7:8
back 5:23 6:2 17:6 19:22 31:15
Banner 2:2 4:2,3,18 5:2 6:10,22 7:5 9:11,17 10:18,24 11:23 12:5 13:8,14 14:8,14 15:10,21 16:4,17 17:7,15 18:2,6,15 19:14,22 20:5 22:14 26:2,7 26:15 28:8,11 31:16,23 32:5,19 34:7,14 37:2
Bannockburn 36:9
Barilla 1:6 4:5 7:16 7:23,23,23 8:6,9 8:14 9:3,5,7 10:5 11:12 12:16 13:1,2 13:18 14:18 15:6,6 18:22 19:6 20:16 21:15,15,24 26:13 27:7,20 28:18 29:8 29:21 30:24 31:3,7 32:1 33:2,8 35:5 36:9
Barilla's 10:10 14:1 14:23
based 17:20 29:1
basis 17:24
beautiful 23:17
behalf 1:7 2:4,8 4:5 20:3
believe 12:13 18:4 18:24 22:1 23:16
believed 22:22,24 23:12
beneath 33:4
best 16:9 21:24
big 33:11
bigger 33:12
biggest 16:15
bit 24:11
board 1:2 4:15 35:2
boil 15:14,15,16 24:10,13,21,22 25:6,9
boiling 25:2
Boulevard 2:6
box 17:18 31:2,20 31:21,24 32:2
brand 10:16 13:5 14:4,5 15:3 18:23 19:6 33:20
Bravo 18:18
bread 29:15
breadsticks 29:15
break 5:9,11 19:17 19:19,20 34:7,8
Brian 2:2 4:3
Burbach 2:5 4:7 16:23 17:10,23 19:18,23,24 20:2 20:11,14 26:18,24 28:10,12 32:3,6,21 32:23 34:5,10,17 37:3
business 7:9,10,13 7:24 8:22,23

C

C 2:1
called 6:6 15:14 36:6
calls 17:13 18:1 31:19
captioned 11:4 12:10
careful 31:20
case 3:18 14:16 22:7 23:7,9 32:16 36:16
catering 29:2
cereals 29:15
Certified 3:7 36:4
certify 35:8 36:5,13
CFR 3:14
change 25:3
changed 25:1
check 35:12
Cheryl 2:5 19:24 20:1
circle 31:18 32:2,16
Circuit 12:9 23:21
City 2:7
civil 11:4 12:10

13:19 14:2,19,24 21:23 25:4 34:2
filled 7:23
find 24:15
finish 5:10
finished 34:6
first 6:6 10:4 36:11
fish 30:5
Flour 29:14
flow 17:1
follow 24:11
follows 6:8
font 18:10 33:9,10
food 8:15
Foods 8:18,20,24
foregoing 35:9 36:13
formally 34:12
forth 36:10
foundation 17:13,24
four 19:10
Fratelli 4:6 35:5
free 5:13 20:6
front 31:14,21
full 6:17
further 3:9,20 19:15 24:24 36:13

G

G 4:5 35:5
game 30:5
geographical 9:4
give 4:23
given 5:21 35:9,11
Glenview 9:2
go 5:23 6:2 17:5,7,9 25:17
going 4:8 17:23 24:19 27:16 28:13 29:3 31:16,18
goods 9:18 13:22 14:20 21:9 28:2,22 29:12 30:3,16
Grand 2:6
greatest 23:4
Grown 25:20
G.E.R 1:6

H

H 37:4
hand 11:1 12:6 13:15 14:15 16:5 17:16 18:16 27:16 28:13 29:3 36:18
handed 22:14
handing 29:18
hear 4:24,24
held 8:2
Hello 20:1,2
helped 20:19
hereinabove 36:15
hereto 3:22
hereunto 36:18
he'll 17:9
high 7:7
highest 10:15 13:5 16:12
history 10:8
holding 30:24
households 16:13
Hovey 2:6

I

idea 32:11
identification 7:3 9:16 10:23 12:4 13:13 14:13 16:3 16:22 18:14
identified 9:18 13:23 14:21 28:2 28:22 29:13 30:3 34:12
identify 26:3 27:19 28:15 29:6,20 30:10,15 32:17
identifying 9:24 31:6
Illinois 9:1 36:1,5,9
included 25:6
industry 8:15
information 21:1,3 30:11
infringement 15:7
inhibit 6:12
instance 21:8
intent 10:10,13 14:1 14:3,17,23 15:1
intent-to-use 9:8
interested 36:16
interrogatories 36:12
interrupt 17:1
involved 9:20
involvement 9:23,24 20:17 22:9
Italian 1:4 4:9 11:5 12:10 20:3 24:7 35:3
Italy's 27:2,6,13 30:13 31:11 32:14 33:6,7,15,20,23

J

job 5:4 8:22
Joie 16:6
judge 4:13,14 11:3 11:11 12:15
June 9:7,7 10:11 12:8 13:19 14:19

K

K 2:3
Kansas 2:7
kin 36:16
kind 27:21,22
know 15:8,13 21:3 21:18 22:2,6,19,21 22:24 23:6,8,24 24:2,15,17 25:18 27:22 31:14 32:8 32:11,14
knowledge 16:9
Kraft 8:18,20,24

L

lacks 17:13,24
Lakeside 36:9
language 33:22 34:3
largest 11:13
lasagna 15:14,16 24:10
lawsuit 22:17,20
legal 21:6
letter 24:21
Let's 17:7 19:18 22:13 26:2 34:7
level 7:7
list 21:18
listed 21:9
litigate 15:18
little 24:11
LLP 2:6
logo 27:20 28:18 29:21 31:8 32:11 33:2,5,8,10,11,12 33:12
long 8:2 11:8
longer 22:5
look 17:19 29:22 31:23 32:1 33:18 34:1
looking 27:23
lot 25:24
loud 4:23

M

magazine 18:24
magazines 19:2
main 33:13
making 16:15 25:3
Manbeck 2:2
mark 6:22 9:11

prior 5:18 8:8,13 15:2
probably 17:10 21:11
proceeding 4:13
process 21:6
product 10:15 24:21 25:16,17,19,21,22 25:23 26:10
products 9:19 13:23 14:21 30:17
proper 32:16
protected 32:15
public 3:23 35:18 36:4
publication 19:5
published 19:11
puffery 23:11,13,14 24:5
purported 23:2
pursuant 3:13 6:21
P.C 2:2
P.M 1:12

Q

Quality 18:5
question 5:3,11,16 5:18,24 6:2 16:24 18:3 20:6 31:17,19 32:20,22
questions 4:8,19,20 5:4,6,6 6:13 19:15 20:9,12 32:9 36:14
quick 19:18
quote 12:16

R

R 1:16 2:1 3:7 31:17 32:2,16 36:4,20
ran 18:21 19:1
ranking 15:3
reached 15:19
read 11:7,9 12:12 28:4 30:18 33:4 35:8
ready-made 28:24
really 16:9
recall 21:19,21 24:12 25:4 34:4
recollection 5:19
record 3:11 6:17 17:8 19:22 28:4 34:10,15,17 36:14
recorded 4:20
redirect 32:4
reduced 3:8 36:7
referred 36:15
referring 24:7
regard 5:18 20:15
Register 28:1,18
registered 27:10 32:13
registration 28:5,19 29:9,13 30:1,4,13 31:3,4,9
registrations 30:23
remember 18:24
remembers 5:17
rephrase 5:8
replied 24:23
reported 1:16 36:7
reporter 3:7 4:21 36:4
represents 4:8 16:13
required 25:2
reserve 17:5
respective 3:21
response 17:13
responsibility 7:21 7:22
restaurants 29:1
returning 9:3
review 31:20
revised 25:1
right 6:1 20:21 21:7 27:23 32:12
right-hand 28:5
road 24:24
Rothwell 2:2
rusks 29:15

S

S 2:1 37:4
salad 8:23
sales 9:4 10:16 14:5 15:4 16:14 18:23 23:4
Santi 1:16 3:7 36:4 36:20
sauces 7:23 9:19 13:24 14:22
says 18:18 19:9 27:2 27:24 28:24 33:6 33:19 34:1
school 7:7
Science 7:9
scope 9:4
Scott 11:3
se 24:20
seal 36:19
second 13:17
secondary 33:17
see 5:11 11:15 27:1 31:3,4 33:1
select 20:20
Selected 26:22
selection 21:5
sell 9:6
seller 11:13
sells 12:17
Semolina 26:23
send 10:1
sense 23:16
sent 24:20
separate 9:8 27:6
Sergio 1:10 6:5,18 35:15 36:6,10,15 37:2
serial 10:8 13:19 14:19 20:16
Service 28:17
services 28:23 29:2 29:12
set 36:10,18
sheets 35:13
short 19:20 34:8
shorthand 3:6 36:4
signature 3:13,16
signed 3:16,18,19,23 21:19
similarity 18:7
six 28:10
size 25:18
slogan 13:1,18 14:18 18:9
small 15:14 24:14
smaller 33:9,19
SOCIETA 35:5
sold 9:5
sorry 16:23 28:8 32:5
SPA 4:6
spaghetti 16:7,9 17:18 18:8 25:23
speak 4:22
speaking 17:4
specific 33:21
speculation 17:14 18:1
spoke 24:9
SS 36:2
staring 32:24
state 6:16 36:1,5
statement 11:17 12:19 23:1,2
states 1:1 9:6,9 10:16 11:14 12:9 12:18 13:6 14:6 16:14 18:23 19:7 35:1
status 22:2
stenographic 3:6

32:5
year 11:14,21

#

#1 13:18 21:15 27:2 27:6,13 30:13 31:11 32:14 33:6,7 33:15,20,23

0

02-0594-CV-W-S... 11:6
084-004107 36:21

1

1 6:23 7:1 37:5
10 26:21 37:6
100 26:22
115 26:17,19 27:2 31:2 34:11
116 27:18
117 28:14
118 29:5
119 29:19
12 26:21 37:6
120 30:9
1200 36:9
13 37:7
136706 13:20
14 37:7
1425 2:3
15 37:8
16 37:8
17 37:2
18 9:7 10:12 13:19 14:19 37:3,9
1867 18:5
19 1:11 35:9
19th 36:5
1987 7:14 8:19
1994 16:7
1995 8:19
1998 8:7 18:22 19:9

2

2 9:12,15 10:8 37:5
2,005,752 29:11
2,657,872 28:21
2,790,465 30:14
2,964,682 30:1
2.123(e)(5) 3:14
2:00 1:12
20005 2:3
2001 8:4
2002 9:7 10:12 11:14,20 13:19 14:19
2003 11:3
2004 12:8,20
2006 1:11 35:9,17 36:6,19
202 2:4
2405 2:6
25 11:3
25th 36:19

3

3 10:19,22 11:2 22:14 37:6
30 29:16
34 37:3
35 16:13
37 3:14

4

4 11:24 12:3,7 37:2 37:6
400 2:6
474-9050 2:7

5

5 13:9,12,16 37:7
50 9:6

6

6 14:9,12,16 26:6 37:5,7
64108 2:7

7

7 12:8 16:2,6 37:8
703.01(j) 3:14
78 34:13,14
78/136,703 10:9 20:16
78136708 14:20
78137 13:20
783-6040 2:4

8

8 16:18,21 17:17 26:4,6,7,8 37:8
800 2:3
816 2:7
897,460 28:7

9

9 18:13,17 37:5,9
91-161,373 35:4
91161373 1:5
98 19:12

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

AMERICAN ITALIAN PASTA COMPANY,	)	
Opposer	)	
v.	)	Opposition No. 91-161,373
BARILLA G. E R. FRATELLI – SOCIETA PER AZIONI,	)	
Applicant	)	

NOTICE OF DEPOSITION

PLEASE TAKE NOTICE THAT pursuant to 37 C.F.R. 2.123, Applicant, Barilla G. E R. Fratelli – Societa Per Azioni, by and through its attorneys, will take the deposition of Sergio Pereira before a Notary Public, or other officer authorized to administer oaths and will be recorded by stenographic and/or audiovisual means, commencing Tuesday, December 19, 2006, at 2:00 p.m. at 1200 Lakeside Drive, Bannockburn, IL 60015.

You are invited to attend and cross-examine.

Dated: December 7, 2006

Respectfully submitted,

Brian Banner

Brian Banner, Esq.
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck
1425 K Street, NW, Suite 800
Washington, DC 20005
Telephone: (202) 783-6040
Facsimilie: (202) 783-6031

DEPOSITION EXHIBIT
Pereira #1
12/19/06 DS 10

CERTIFICATE OF SERVICE

I certify that on this 7th day of December, 2006, a true copy of the foregoing Notice of Deposition of Mr. Sergio Pereira was served by first class mail, postage prepaid to:

Thomas H. Van Hoozer, Esq.
Hovey Williams, LLP.
2405 Grand Boulevard
Suite 400
Kansas City, MO64108

Counsel for Opposer

Brian Banner

Brian Banner, Esq.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
www.uspto.gov

Mar 3, 2004

NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:
78/136,703

2. Mark:
BARILLA - AMERICA'S FAVORITE PASTA

3. International Class(es):
30

4. Publication Date:
Mar 23, 2004

5. Applicant:
Barilla Alimentare S.p.A.

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202) 512-1800

By direction of the Commissioner.

Correspondence Address:

G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW
Suite 800
Washington DC 20005

TMP&I

DEPOSITION EXHIBIT
Applicant's #2
12/19/06 DS 10

Trademark

TRADEMARK

Serial Number

Keyword Search

Search

Search Results

PROSECUTION HISTORY

Entry

OIPE JC174
NOV 14 2003
PATENT & TRADEMARK OFFICE

2778-127
GRF:mec:nlf

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Barilla Alimentare S.p.A.	)	
Serial No. 78/136,703	)	Trademark Attorney Darryl M. Spruill
Filed: June 18, 2002	)	
Mark: BARILLA-AMERICA'S FAVORITE PASTA	)	Law Office 112

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003, Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use **"AMERICA'S FAVORITE PASTA"** apart from the mark as shown.--

REMARKS

Since this appears to be the only outstanding matter at issue it appears this application is in condition to be approved for publication.

11-14-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #11

Serial No.: 78/136,703
Mark: BARILLA - AMERICA'S FAVORITE PASTA
Attorney Docket No.: 2778-126

Respectfully submitted,

Barilla Alimentare S.p.A.

By: G. F. Rothwell

G. Franklin Rothwell
Attorney for Applicant
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: BARILLA - AMERICA'S FAVORITE PASTA

Serial No: 78136703

[redacted]

Mail Date: 11142003

[redacted]

Doc. Type: Responses to Office Actions

[redacted]

No Fee

RAM Mail Date: 111403

[redacted]

2778-127
GRF:mec:nlf

OIPE JC174
NOV 14 2003
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Barilla Alimentare S.p.A.	)	
Serial No. 78/136,703	)	Trademark Attorney Darryl M. Spruill
Filed: June 18, 2002	)	
	)	Law Office 112
Mark: BARILLA-AMERICA'S FAVORITE PASTA	)	

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

In response to the final refusal mailed June 18, 2003, Applicant responds in accordance with the headings therein.

DISCLAIMER

Please enter the following disclaimer:

-- No claim is made to the exclusive right to use "**AMERICA'S FAVORITE PASTA**" apart from the mark as shown.--

REMARKS

Since this appears to be the only outstanding matter at issue it appears this application is in condition to be approved for publication.

TMEO
LAW OFFICE 112
2003 DEC -3 A 11:58
RECEIVED

11-14-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt #11

Serial No.: 78/136,703
Mark: BARILLA - AMERICA'S FAVORITE PASTA
Attorney Docket No.: 2778-126

Respectfully submitted,

Barilla Alimentare S.p.A.

By: G. F. Rothwell

G. Franklin Rothwell
Attorney for Applicant
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040

TYPED DRAWING

Serial Number
78136703

Filing Date
Jun 18, 2002

Status of Application
RESPONSE AFTER NON-FINAL ACTION - ENTERED

Register
PRINCIPAL

MARK DATA

Word Mark
BARILLA - AMERICA'S FAVORITE PASTA

Mark Drawing Code
(1) TYPED DRAWING

FILING BASIS DATA

FILED 1(a): NO	CURRENT 1(a): NO	AMENDED 1(a): NO
FILED 1(b): YES	CURRENT 1(b): YES	AMENDED 1(b): NO
FILED 44D : NO	CURRENT 44D : NO	AMENDED 44D : NO
FILED 44E : NO	CURRENT 44E : NO	AMENDED 44E : NO
FILED NO B: NO	CURRENT NO B: NO	

GOODS AND SERVICES DATA

Type of Mark
TRADEMARK

G & S: Class Status -- ACTIVE. IC 030. US 046. PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

OWNER DATA

PARTY TYPE 10 - ENTRY NUMBER 001 - COMPOSED FLAG FALSE

ASSIGNMENT RECORDED: NO

Barilla Alimentare S.p.A.
CORPORATION

ITALY
Via Mantova 166
Parma PR, ITALY 43100

OTHER DATA

FOREIGN REGISTRATION DATA

CORRESPONDENCE DATA

Attorney of Record
G. Franklin Rothwell, Esq.

Telephone Number
202-783-6040

Fax Number
202-783-6031

Domestic Representative
G. Franklin Rothwell, Esq.

Telephone Number
202-783-6040

Fax Number
202-783-6031

Correspondence Address
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW
Suite 800
Washington DC 20005

Telephone Number
202-783-6040

Fax Number
202-783-6031

Effective Date of Change
Jun 18, 2002

Automatic Last Update
NOT UPDATED

Attorney Docket Number
2778-127

HISTORY OF CORRESPONDENCE CHANGES

PROSECUTION HISTORY

DATE: 2003/04/15
COMMUNICATION RECEIVED FROM APPLICANT

DATE: 2003/04/15
PAPER RECEIVED

DATE: 2002/10/15
NON-FINAL ACTION MAILED

DATE: 2002/10/01 - PROCEEDING NUMBER: 076731
ASSIGNED TO EXAMINER

DATE: 2002/09/28 - PROCEEDING NUMBER: 069249
ASSIGNED TO EXAMINER

Examining Attorney
SPRUILL, DARRYL
LAW OFFICE 112

TYPED DRAWING

Serial Number
78136708

Filing Date
Jun 18, 2002

Status of Application
RESPONSE AFTER NON-FINAL ACTION - ENTERED

Register
PRINCIPAL

MARK DATA

Word Mark
BARILLA - AMERICA'S PREFERRED PASTA

Mark Drawing Code
(1) TYPED DRAWING

FILING BASIS DATA

FILED 1(a): NO	CURRENT 1(a): NO	AMENDED 1(a): NO
FILED 1(b): YES	CURRENT 1(b): YES	AMENDED 1(b): NO
FILED 44D : NO	CURRENT 44D : NO	AMENDED 44D : NO
FILED 44E : NO	CURRENT 44E : NO	AMENDED 44E : NO
FILED NO B: NO	CURRENT NO B: NO	

GOODS AND SERVICES DATA

Type of Mark
TRADEMARK

G & S: Class Status -- ACTIVE. IC 030. US 046. PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA

OWNER DATA

PARTY TYPE 10 - ENTRY NUMBER 001 - COMPOSED FLAG FALSE

ASSIGNMENT RECORDED: NO

Barilla Alimentare S.p.A.
CORPORATION

ITALY
Via Mantova 166
Parma PR, ITALY 43100

OTHER DATA

FOREIGN REGISTRATION DATA

CORRESPONDENCE DATA

Attorney of Record
G. Franklin Rothwell

Telephone Number
202-783-6040

Fax Number
202-783-6031

Domestic Representative
G. Franklin Rothwell

Telephone Number
202-783-6040

Fax Number
202-783-6031

Correspondence Address
G. Franklin Rothwell
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW
Suite 800
Washington DC 20005

Telephone Number
202-783-6040

Fax Number
202-783-6031

Effective Date of Change
Jun 18, 2002

Automatic Last Update
NOT UPDATED

Attorney Docket Number
2778-132

HISTORY OF CORRESPONDENCE CHANGES

PROSECUTION HISTORY

DATE: 2003/04/15
COMMUNICATION RECEIVED FROM APPLICANT

DATE: 2003/04/15
PAPER RECEIVED

DATE: 2002/10/15
NON-FINAL ACTION MAILED

DATE: 2002/10/08 - PROCEEDING NUMBER: 076731
ASSIGNED TO EXAMINER

DATE: 2002/10/01 - PROCEEDING NUMBER: 073358
ASSIGNED TO EXAMINER

DATE: 2002/10/01 - PROCEEDING NUMBER: 076731
ASSIGNED TO EXAMINER

DATE: 2002/09/28 - PROCEEDING NUMBER: 069249
ASSIGNED TO EXAMINER

Examining Attorney
SPRUILL, DARRYL
LAW OFFICE 112

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136703

APPLICANT: Barilla Alimentare S.p.A.

CORRESPONDENT ADDRESS:
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW
Suite 800
Washington DC 20005

JUN 18 2003

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom112@uspto.gov

MARK: BARILLA - AMERICA'S FAVORITE PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-127

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

RE: Serial Number 78/136703

This letter responds to the applicant's communication filed April 15, 2003.

STATUS OF THE APPLICATION

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, *TMEP §1209.03(s):*

> **1209.03(s) Slogans**
>
> Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). *See* TMEP §1202.04 and cases cited therein.

The wording **AMERICA'S FAVORITE PASTA** in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (FAVORITE), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from *LEXIS/NEXIS® computerized database,* listing the terms **AMERICA'S FAVORITE PASTA**. *See* the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the terms **AMERICA'S FAVORITE** disclaimed. *See* the attached enclosure.[1] Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." *See* TMEP section 1207.01(c)(iv); *see also*, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of **"AMERICA'S FAVORITE PASTA "** is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill
Trademark Attorney
Law Office 112
(703) 308-9112, Ext. 203
darryl.spruill@uspto.gov
/Darryl M. Spruill/

RESPONSE GUIDELINES

The applicant may respond via regular mail to the address listed above, or via e-mail to Ecom112@uspto.gov. In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;

[1] No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.

2. send the response to mailto:ecom112@uspto.gov. E-mail sent to any other address will NOT be processed, and may result in ABANDONMENT of the application;
3. submit specimens and/or evidence as scanned images or digital photographs in .GIF or .JPG format only. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the Office action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. *See* 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to Comments@uspto.gov.

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at **http://www.uspto.gov/main/trademarks.htm**

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

EVIDENCE

108B8C
Print Request: Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003 08:15 PM EDT

Number of Lines: 159
Job Number: 1842:0:4165955

Client ID/Project Name:
Research Information:
US Newspapers and Wires
"america! favorite! pasta"
Send to: SPRUILL, DARRYL
TRADEMARK LAW LIBRARY
2101 CRYSTAL PLAZA ARC
MAILBOX 314
ARLINGTON, VIRGINIA 22202-4600

5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

SECTION: LIFESTYLE / FOOD; Pg. F06

LENGTH: 449 words

HEADLINE: SAUCE IT UP, VEGAN STYLE

COLUMN: NATURALLY YOURS

BYLINE: JAN WOLFF

BODY:

...your spaghetti, and if you're a vegan, you may still crave a sprinkling of Parmesan now and then. What's left to put on **America's favorite pasta?** Plain old tomato sauce can get tiresome, even if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.
PR Newswire

April 24, 1998, Friday

SECTION: Financial News

DISTRIBUTION: TO FOOD, NATIONAL AND FEATURES EDITORS

LENGTH: 301 words

HEADLINE: Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998**LEXIS-NEXIS Related Topics** Full Article Related Topics Overview

This document contains no targeted Topics.

DATELINE: NEW YORK, April 24

BODY:

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of **America's favorite pasta** dish is based on consumer research as well as pasta's history in the U.S.," said Jula Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

SECTION: FOOD, Pg. J10

LENGTH: 475 words

HEADLINE: Beard awards nominees

BODY:

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, **America's Favorite Pasta'** by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

SECTION: FLORIDA; Pg. 18

LENGTH: 861 words

HEADLINE: FOR YOUNG TASTE BUDS ONLY

BYLINE: By Scott Joseph, Sentinel Restaurant Critic

BODY:

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for **Americas favorite pasta.**

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

SECTION: FEATURES; Pg. 3E

LENGTH: 806 words

HEADLINE: AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

BYLINE: Michael Storey

BODY:

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with **America's favorite pasta-eating cat** going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company; Los Angeles Times All Rights Reserved
Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

SECTION: Business; Part D; Page 1; Column 2; Financial Desk

LENGTH: 924 words

HEADLINE: FARMERS COUNT ON A NEW CASH CROP: PASTA;
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH DAKOTA WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

BYLINE: By GREG JOHNSON, TIMES STAFF WRITER

DATELINE: IRVINE

BODY:
...plant. We can grow it, mill it and send it through the noodle plant."

Pasta Popularity

Spaghetti and linguine are **America's favorite pasta** products, followed by elbows and twists.
Dry pasta retail sales by shape in 1993:
Long goods (...

Copyright 1985 UMI Inc.;
Copyright Business First of Louisville Inc. 1985;
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while **America's favorite pasta** may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136703

APPLICANT: Barilla Alimentare S.p.A.

CORRESPONDENT ADDRESS:
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW
Suite 800
Washington DC 20005

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
ecom112@uspto.gov

MARK: BARILLA - AMERICA'S FAVORITE PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-127

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/136703

This letter responds to the applicant's communication filed April 15, 2003.

STATUS OF THE APPLICATION

Registration was refused because of procedural informalities concerning the identification of goods and a disclaimer.

The applicant satisfactorily responded to the identification of goods requirement.

The examining attorney has considered the applicant's arguments carefully but has found them unpersuasive. For the reasons below, the refusal for registration based on the disclaimer requirement is continued and made **Final** for the below reason.

REFUSAL

The disclaimer requirement must be considered in the context of a descriptiveness refusal. A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry,* 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright#Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

The examining attorney must consider whether a mark is merely descriptive in relation to the identified goods, not in the abstract. *In re Omaha National Corp.,* 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Abcor Development Corp.,* 588 F.2d 811, 200 USPQ 215 (CCPA 1978); *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985).

Essentially, the applicant argues that the wording in the mark is unitary as a slogan.

It is the examining attorney's position that the wording in the mark must be disclaimed irrespective of the House mark name BARILLA being attached to the other wording because the wording is such that it is informational or common phrases used in business. The following addresses Slogans, *TMEP §1209.03(s):*

> **1209.03(s) Slogans**
>
> Slogans that are considered to be merely informational in nature or to be common laudatory phrases or statements that would ordinarily be used in business or in the particular trade or industry are not registrable. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (THE BEST BEER IN AMERICA so highly laudatory and descriptive as applied to beer and ale that it is incapable of acquiring distinctiveness). *See* TMEP §1202.04 and cases cited therein.

The wording **AMERICA'S FAVORITE PASTA** in the applicant's mark is a combination of a primarily geographically descriptive term (AMERICA or AMERICA'S), a laudatorily descriptive term (FAVORITE), and a generic term (PASTA). Also, the wording as presented on the drawing is such that it is separate and set apart from the wording BARILLA, which further supports the disclaimer requirement.

In support of the refusal, the examining attorney submits evidence in the form of *selected* excerpts of stories taken from *LEXIS/NEXIS® computerized database,* listing the terms **AMERICA'S FAVORITE PASTA**. *See* the attached enclosures.

The Trademark Trial and Appeal Board has held that materials obtained through computerized text searching are competent evidence to show the descriptive use of terms under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). *In re National Data Corp.*, 222 USPQ 515, 517 n.3 (TTAB 1984).

Also, the examining attorney previously provided third-party registrations showing the terms **AMERICA'S FAVORITE** disclaimed. *See* the attached enclosure.[1] Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." *See* TMEP section 1207.01(c)(iv); *see also*, e.g., Specialty Brands, Inc. v. Coffee Bean

Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

Therefore, based on the evidence provided the refusal made for the disclaimer requirement of **"AMERICA'S FAVORITE PASTA "** is deemed to have been proper.

Please note that the only appropriate responses to a final action are (1) compliance with the outstanding requirements, if feasible, (2) filing of an appeal to the Trademark Trial and Appeal Board, or (3) filing of a petition to the Director if permitted by 37 C.F.R. §2.63(b). 37 C.F.R. §2.64(a); TMEP §715.01. Regarding petitions to the Director, see 37 C.F.R. §2.146 and TMEP Chapter 1700. If the applicant fails to respond within six months of the mailing date of this refusal, this Office will declare the application abandoned. 37 C.F.R. §2.65(a).

Darryl M. Spruill
Trademark Attorney
Law Office 112
(703) 308-9112, Ext. 203
darryl.spruill@uspto.gov
/Darryl M. Spruill/

RESPONSE GUIDELINES

The applicant may respond via regular mail to the address listed above, or via e-mail to Ecom112@uspto.gov. In the body of the response, please clearly state the applicant's name, mark, serial number, Law Office and Examining Attorney, mailing date of the Office Action, and the applicant's telephone number.

To respond to this Office action electronically, the applicant must:

1. include the serial number in the subject line;
2. send the response to mailto:ecom112@uspto.gov. E-mail sent to any other address will NOT be processed, and may result in ABANDONMENT of the application;
3. NO OTHER FORMATS WILL BE PROCESSED (TMEP §304.01);
4. respond within six-months from the Office action mailing date, or within the period stated in the Office action;
5. respond in English; and
6. sign the response electronically, e.g. /john smith/. *See* 37 CFR §1.4(d)(1)(iii); TMEP §804.05.

The examining attorney will send correspondence only to the e-mail address listed in the application. A request to change an e-mail address may be submitted by signed e-mail to one of the above e-mail addresses.

Note: only one e-mail address may be used for correspondence. TMEP §§304.03 and 304.07.

Send comments on the USPTO e-Commerce Law Office Pilot Program to Comments@uspto.gov.

PLEASE NOTE: Because it delays processing, submission of duplicate papers is discouraged. Unless specifically requested to do so by the Office, parties should not mail follow up copies of documents transmitted by fax. TMEP 702.04(e); Cf. ITC Entertainment Group Ltd. V. Nintendo of America Inc. 45 USPQ2d 2021 (TTAB 1998).

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at **http://www.uspto.gov/main/trademarks.htm**

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

EVIDENCE

108B8C

```
Print Request:   Selected Document(s): 5-8,10,13,16

Time of Request: June 17, 2003  08:15 PM EDT

Number of Lines: 159
Job Number:      1842:0:4165955

Client ID/Project Name:
Research Information:
 US Newspapers and Wires
"america! favorite! pasta"
Send to:  SPRUILL, DARRYL
          TRADEMARK LAW LIBRARY
          2101 CRYSTAL PLAZA ARC
          MAILBOX 314
          ARLINGTON, VIRGINIA 22202-4600
```

5 of 16 DOCUMENTS

Copyright 1999 Bergen Record Corp.
The Record (Bergen County, NJ)

February 3, 1999; WEDNESDAY; ALL EDITIONS

SECTION: LIFESTYLE / FOOD; Pg. F06

LENGTH: 449 words

HEADLINE: SAUCE IT UP, VEGAN STYLE

COLUMN: NATURALLY YOURS

BYLINE: JAN WOLFF

BODY:

...your spaghetti, and if you're a vegan, you may still crave a sprinkling of Parmesan now and then. What's left to put on **America's favorite pasta?** Plain old tomato sauce can get tiresome, even if you spruce it up with some mushrooms or other veggies.

If ...

6 of 16 DOCUMENTS

Copyright 1998 PR Newswire Association, Inc.
PR Newswire

April 24, 1998, Friday

SECTION: Financial News

DISTRIBUTION: TO FOOD, NATIONAL AND FEATURES EDITORS

LENGTH: 301 words

HEADLINE: Coming Soon to a Country Near You! 'World Pasta Day' Set for October 25, 1998**LEXIS-NEXIS Related Topics** Full Article Related Topics Overview

This document contains no targeted Topics.

DATELINE: NEW YORK, April 24

BODY:

...Pasta Association will commemorate World Pasta Day by announcing America's most popular pasta dish. "The selection of **America's favorite pasta** dish is based on consumer research as well as pasta's history in the U.S.," said Jula Kinnaird, president of the National ...

7 of 16 DOCUMENTS

Copyright 1995 P.G. Publishing Co.
Pittsburgh Post-Gazette (Pennsylvania)

April 2, 1995, Sunday, FIVE STAR EDITION

SECTION: FOOD, Pg. J10

LENGTH: 475 words

HEADLINE: Beard awards nominees

BODY:

...Vegetable Cookbook" by Lorraine Bodger; "Onions, Onions, Onions" by Linda and Fred Griffith; "Joie Warner's Spaghetti, **America's Favorite Pasta'** by Joie Warner.

General interest: "Now You're Cooking: Everything A Beginner Needs To Know To Start Cooking ...

8 of 16 DOCUMENTS

Copyright 1995 Sentinel Communications Co.
Orlando Sentinel (Florida)

January 22, 1995 Sunday, 3 STAR

SECTION: FLORIDA; Pg. 18

LENGTH: 861 words

HEADLINE: FOR YOUNG TASTE BUDS ONLY

BYLINE: By Scott Joseph, Sentinel Restaurant Critic

BODY:

...someplace else, but your kids will eat this place up. Heck, even the name is baby talk for **Americas favorite pasta.**

Spageddies is the latest chain to enter the Central Florida market. Although it is new, you likely have seen other places like ...

10 of 16 DOCUMENTS

Copyright 1994 Little Rock Newspapers, Inc.
Arkansas Democrat-Gazette (Little Rock, AR)

December 1, 1994, Thursday

SECTION: FEATURES; Pg. 3E

LENGTH: 806 words

HEADLINE: AS HOLIDAY SEASON APPROACHES, BRACE UP FOR A BEVY OF SPECIALS

BYLINE: Michael Storey

BODY:

...seasonal music.

Also on Dec. 14, "A Garfield Christmas Special" (7 p.m., Channel 11) will return with **America's favorite pasta**-eating cat going to the country with Jon for an old-fashioned Christmas.

The cartoon first aired on Dec. ...

13 of 16 DOCUMENTS

Copyright 1994 The Times Mirror Company; Los Angeles Times All Rights Reserved

Los Angeles Times

September 7, 1994, Wednesday, Orange County Edition

SECTION: Business; Part D; Page 1; Column 2; Financial Desk

LENGTH: 924 words

HEADLINE: FARMERS COUNT ON A NEW CASH CROP: PASTA;
AGRICULTURE: IRVINE GROUP IS MARKETING FOODS PROCESSED BY NORTH DAKOTA WHEAT GROWERS. GOAL IS TO CUT OUT MIDDLEMAN.

BYLINE: By GREG JOHNSON, TIMES STAFF WRITER

DATELINE: IRVINE

BODY:

...plant. We can grow it, mill it and send it through the noodle plant."

Pasta Popularity

Spaghetti and linguine are **America's favorite pasta** products, followed by elbows and twists. Dry pasta retail sales by

shape in 1993:
Long goods (...

16 of 16 DOCUMENTS

Copyright 1985 UMI Inc.;
Copyright Business First of Louisville Inc. 1985;
Business Dateline;

Business First-Louisville

July 8, 1985

SECTION: Vol 1; No 48; Sec 1; pg 8

LENGTH: 1098 words

HEADLINE: Visitors Can't 'Kuwait' to Try Recipes Learned in Louisville

BYLINE: Connie Dorval

DATELINE: Louisville; KY; US

BODY:

...El Houssinez, Khaled Al-Mail and Zainab Abdul Rahim are learning how to make gallons of Italian spaghetti. And while **America's favorite pasta** may not be typical fare back in Kuwait, the three will be taking home some valuable recipes -- management ...

JOURNAL-CODE: BFL

[1] No third party registration were provided for a disclaimer of the wording PASTA because the term is generic.

TRADEMARK EXAMINATION WORKSHEET

☑ AMENDMENT STAGE ☐ NO CHANGE ☐ PUBLICATION/REGISTRATION STAGE

Name: Lorri White L.O. 112 Serial No. 78/134203

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

Legal Instrument Examiner (LIE)

	Amended	Data Element	
Class Data	✓	☐ Prime/International Class	☑ Goods and Services
		☐ First Use Date	☐ First Use in Commerce Date
		☐ In Another Form	☐ Certification
		☐ 1b	
Mark Data		☐ Word Mark	☐ Pseudo Mark
		☐ Mark Drawing Code	☐ Design Search Code
		☐ Scan Sub Drawing	
Misc. Mark Data		☐ Mark Description	☐ Disclaimer
		☐ Lining/Stippling	☐ Name/Portrait/Consent
		☐ Translation	
Section 2(f)		☐ Section 2(f) Entire Mark	
		☐ Section 2(f) Limitation Statement	☐ Section 2(f) in Part
		☐ Amended Register	☐ Amended Register Date
Foreign Reg. Data		☐ Foreign Country	☐ 44(d)
		☐ Foreign Application Number	☐ Foreign Application Filing Date
		☐ Foreign Registration Number	☐ Foreign Registration Date
		☐ Foreign Registration Expiration Date	☐ Foreign Renewal Reg. Number
		☐ Foreign Reg. Renewal Expiration Date	☐ Foreign Renewal Reg. Date
Owner Data		☐ Owner Name	☐ DBA/AKA/TA
		☐ Address 1	☐ Address 2
		☐ City	☐ State
		☐ Zip Code	
		☐ Citizenship	☐ Entity
		☐ Entity Statement	☐ Composed of
		☐ Assignment(s)/Name Change	
Amd/Corr Restr.		☐ Concurrent Use	
Prior U.S. Reg.		☐ Prior Registration	
Correspondence		☐ Attorney	☐ Domestic Representative
		☐ Attorney Docket Number	
		☐ Correspondence Firm Name/Address	

I certify that all corrections have been entered in accordance with text editing guidelines.

Lorri White
LIE

5/7/2003
DATE

Other:

2778-127
GFR:RHC:czb

OIPE JC174
APR 1 5 2003
PATENT & TRADEMARK OFFICE

Examining Attorney: SPRUILL, DARRYL
Serial Number: 78/136703
[redacted]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
Barilla Alimentare S.p.A.	)	
Serial No. 78/136,703	)	Trademark Attorney
Filed: June 18, 2002	)	Darryl M. Spruill
Mark: BARILLA - AMERICA'S FAVORITE PASTA	)	Law Office 101

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject application as follows:

--PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA in International Class 30.--

DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the wording "AMERICA'S FAVORITE PASTA" apart from the mark as shown. The grounds cited are that AMERICA'S has geographical significance, FAVORITE is a laudatory term and PASTA is a generic

term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregisterable components of a mark otherwise registerable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive and does not concede that the term FAVORITE is laudatory in this instance, Applicant respectfully traverses the requirement to disclaim AMERICA'S FAVORITE PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983)("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA[1], but obviously creates a commercial impression distinct from that of its house mark. Professor McCarthy provides an

---

[1] See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.

illustrative example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v.Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991)("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S FAVORITE PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S FAVORITE PASTA clearly characterize the well-recognized trademark of Applicant -- in order words, they meld with the BARILLA registered mark. All of these factors support a

determination that Applicant's proposed slogan is a unitary mark. See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a)(rev. 1986)). For the foregoing reasons, Applicant believes that disclaimer of AMERICA'S FAVORITE PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully requested that the subject application be approved for publication.

Respectfully submitted,

By Robert H. Cameron

G. Franklin Rothwell
Robert H. Cameron
Attorneys for Applicant
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040

2778-127.amend&resp.wpd

Incoming Correspondence Routing Sheet

To: TMO LAW OFFICE 112 - AWAITING RESPONSE DOCKET

Word Mark: BARILLA - AMERICA'S FAVORITE PASTA

2A

Serial No: 78136703

[redacted]

Mail Date: 04152003

[redacted]

Doc. Type: Amendments to Response

[redacted]

No Fee

RAM Mail Date: 041503

[redacted]

TMEO
LAW OFFICE 112

2778-127
GFR:RHC:czb

Examining Attorney: SPRU[redacted] DARRYL
Serial Number: 78/136703
[redacted]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	
	)	
Barilla Alimentare S.p.A.	)	
	)	
Serial No. 78/136,703	)	Trademark Attorney
	)	Darryl M. Spruill
Filed: June 18, 2002	)	
	)	Law Office 101
Mark: BARILLA - AMERICA'S FAVORITE PASTA	)	

AMENDMENT AND RESPONSE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Dear Sir:

Applicant hereby responds to Office Action No. 01 in accordance with the headings therein.

IN THE IDENTIFICATION OF GOODS

Kindly amend the identification of goods in the subject application as follows:

> --PASTA, PASTA PRODUCTS, NAMELY MEALS CONSISTING PRIMARILY OF PASTA, MACARONI SALAD, PASTA SALAD, SAUCES FOR PASTA in International Class 30.--

DISCLAIMER REQUIREMENT

The Office Action has called for Applicant to disclaim the wording "AMERICA'S FAVORITE PASTA" apart from the mark as shown. The grounds cited are that AMERICA'S has geographical significance, FAVORITE is a laudatory term and PASTA is a generic

term for the goods. The Trademark Manual of Examining Procedure informs that the Office has discretion to require an Applicant to disclaim unregisterable components of a mark otherwise registerable, such as matter that is generic or merely descriptive or primarily geographically descriptive of the goods or services. See TMEP §§ 1213.01(a), 1213.03(a).

Although Applicant disagrees with the conclusion in the Office Action that the term AMERICA'S is geographically descriptive and does not concede that the term FAVORITE is laudatory in this instance, Applicant respectfully traverses the requirement to disclaim AMERICA'S FAVORITE PASTA on different grounds. Applicant submits that its proposed mark is a slogan clearly designed to identify and distinguish its pasta and pasta products from those of others. See Conde Nast Publications Inc. v. Redbook Publishing Co., 217 U.S.P.Q. 356, 360 (TTAB 1983)("A slogan or any other combination of words is capable of being a trademark if used in such a manner as to identify and distinguish the seller's goods and services from those of others."). The slogan incorporates Applicant's separate registered trademark, BARILLA[1], but obviously creates a commercial impression distinct from that of its house mark. Professor McCarthy provides an

---

[1] See, e.g., U.S. Registration Nos. 897,460; 2,022,842; 2,074,319; 2,005,752; 2,657,872.

illustrative example of such slogans, e.g., "You are in good hands with Allstate." J. Thomas McCarthy, 1 McCarthy on Trademarks and Unfair Competition, § 7:21(4th Ed. 2000).

According to the Trademark Manual of Examining Procedure, registerable slogans are "considered unitary and should not be broken up for purposes of requiring a disclaimer." See TMEP § 1213.05(b); accord Dena Corp. v.Belvedere Int'l, Inc., 950 F.2d 1555, 1560 (Fed. Cir. 1991)("A unitary mark cannot be separated into registerable and non-registerable parts. Because unitary marks do not fit within the language of [15 U.S.C. §§ 1056 and 1057], the Commissioner cannot require a disclaimer.").

There can be no doubt that Applicant's proposed slogan is a unitary mark. Unitary marks create a single and distinct commercial impression apart from their constituent elements. Dena, 950 F.2d at 1561. Here, Applicant's separate registered mark BARILLA is incontestable and has acquired secondary meaning based on extensive and continuous use for more than 30 years, and said mark is physically connected to AMERICA'S FAVORITE PASTA by virtue of a hyphen such that each of the constituent elements of the slogan appear side by side on the same line. Moreover, the words AMERICA'S FAVORITE PASTA clearly characterize the well-recognized trademark of Applicant -- in order words, they meld with the BARILLA registered mark. All of these factors support a

determination that Applicant's proposed slogan is a unitary mark. See Dena, 950 F.2d at 1561 (citing TMEP § 807.13(a)(rev. 1986)). For the foregoing reasons, Applicant believes that disclaimer of AMERICA'S FAVORITE PASTA is inappropriate.

In view of the foregoing remarks, it is respectfully requested that the subject application be approved for publication.

Respectfully submitted,

By Robert H. Cameron

G. Franklin Rothwell
Robert H. Cameron
Attorneys for Applicant
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202)783-6040

2778-127.amend&resp.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/136703

APPLICANT: Barilla Alimentare S.p.A.

OCT 15 2002

CORRESPONDENT ADDRESS:
G. Franklin Rothwell, Esq.
Rothwell, Figg, Ernst & Manbeck, P.C.
1425 K Street, NW
Suite 800
Washington DC 20005

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
ecom101@uspto.gov

MARK: BARILLA - AMERICA'S FAVORITE PASTA

CORRESPONDENT'S REFERENCE/DOCKET NO: 2778-127

CORRESPONDENT EMAIL ADDRESS:
N/A

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

PRIORITY ACTION

OFFICE SEARCH: The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 704.02.

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE. This case will be given priority as an amended case if you respond to the requirements stated below within two months.

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.

RE: Serial Number 78/136703

The following issues were discussed in communication with G. Franklin Rothwell on 10/11/02.

1. **IDENTIFICATION OF GOODS -UNACCEPTABLE:**
The identification of goods is indefinite because the applicant uses the wording "products." The identification of goods must be specific. The applicant must amend the identification to specify the common commercial name of the goods or to indicate their nature. The recitation identification must be all-inclusive. The applicant should amend the identification to replace this wording with "namely." The applicant may amend the identification to substitute the following wording, if

accurate: **"Pasta, pasta products, namely, [specify the products], sauces for pasta," in International Class 030.** 37 C.F.R. Section 2.71(a); TMEP sections 804 and 804.08(c).[1]

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 804.09. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

2. **DISCLAIMER REQUIREMENT:**

The applicant must disclaim the wording AMERICA'S FAVORITE PASTA in the mark because the wording AMERICA'S is a term having geographical significance combined with FAVORITE a laudatory descriptive term, and PASTA a generic term.

Also, the examining attorney has attached third-party registrations showing the term **AMERICA('S)** combined with laudatory and generic terms disclaimed. *See* the attached enclosure. Third-party registrations are probative to the extent of demonstrating "that a mark or a portion thereof is suggestive or descriptive of certain goods and/or services and hence is entitled to a narrow scope of protection; properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used." *See* TMEP section 1207.01(c)(iv); *see also*, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1975); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991); In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910, 1911 (TTAB 1988); In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172, 1174 (TTAB 1987).

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.09(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use **"AMERICA'S FAVORITE PASTA"** apart from the mark as shown.

Darryl M. Spruill
Trademark Attorney
Law Office 101
(703) 308-9101, Ext. 170
darryl.spruill@uspto.gov

[1] Please note that the recommended identification of goods is not exhaustive. The applicant is directed to the Office's searchable database of the Manual of Acceptable Identifications of Goods and Services. The address for this is: http://www.uspto.gov/web/offices/tac/doc/gsmanual/.

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit **http://www.uspto.gov/teas/index.html** and follow the instructions.

To respond formally via E-mail, visit **http://www.uspto.gov/web/trademarks/tmelecresp.htm** and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at **http://www.uspto.gov/main/trademarks.htm**

[Typed Drawing]

Mark
AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark
AMERICAS FAVORITE PIZZA FEAST

Goods and Services
IC 030. US 046. G & S: Pizza for consumption on or off the premises.
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
78057808

Filing Date
April 11, 2001

Publication for Opposition Date
January 15, 2002

Registration Number
2558945

Registration Date
April 9, 2002

Owner Name and Address
(REGISTRANT) Domino's Pizza PMC, Inc. CORPORATION MICHIGAN 30 Frank Lloyd Wright Drive Ann Arbor MICHIGAN 48106

Prior Registration(s)
1705234;1791773;1825321;AND OTHERS

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
Elizabeth F. Janda

*** Search: 14 *** Document Number: 2 ***

[Typed Drawing]

Mark
AMERICA'S FAVORITE COOKIE

Goods and Services
IC 030. US 046. G & S: Cookies. FIRST USE: 19980201. FIRST USE IN COMMERCE: 19980201

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
78039333

Filing Date
December 14, 2000

Filed ITU
FILED AS ITU

Supplemental Register Date
November 19, 2001

Registration Number
2572410

Registration Date
May 21, 2002

Owner Name and Address
(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE 1105 North Market Street, Suite 803 Wilmington DELAWARE 19801

Assignment Recorded
ASSIGNMENT RECORDED

Prior Registration(s)
2149887

Type of Mark
TRADEMARK

Register
SUPPLEMENTAL

Live Dead Indicator
LIVE

Attorney of Record
Kathleen J. Gallagher, Esq.

[Typed Drawing]

Mark
AMERICA'S FAVORITE SOUR GUM

Pseudo Mark
AMERICAS FAVORITE SOUR GUM

Goods and Services
IC 030. US 046. G & S: BUBBLE GUM. FIRST USE: 19990615. FIRST USE IN COMMERCE: 19990615

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75768708

Filing Date
August 5, 1999

Supplemental Register Date
December 15, 1999

Registration Number
2347915

Registration Date
May 2, 2000

Owner Name and Address
(REGISTRANT) Philadelphia Chewing Gum Corporation CORPORATION PENNSYLVANIA Havertown PENNSYLVANIA 190832189

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOUR GUM" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
SUPPLEMENTAL

Live Dead Indicator
LIVE

Attorney of Record
Harriet E. Perkins

*** User: dspruill *** Serial Number: 75618178 *** 10/11/02 10:58:14 AM *

[Typed Drawing]

Mark
TUMARO'S GOURMET TORTILLAS -- AMERICA'SFAVORITE

Pseudo Mark
TUMAROS GOURMET TORTILLAS AMERICAS FAVORITE

Goods and Services
IC 030. US 046. G & S: tortillas and crepes. FIRST USE: 20000411.
FIRST USE IN COMMERCE: 20000411

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75618178

Filing Date
January 11, 1999

Filed ITU
FILED AS ITU

Publication for Opposition Date
October 26, 1999

Registration Number
2419870

Registration Date
January 9, 2001

Owner Name and Address
(REGISTRANT) Tumaro's, Inc. CORPORATION CALIFORNIA 5300 Santa Monica Boulevard Los Angeles CALIFORNIA 90029

Prior Registration(s)
1893236;2133513

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "GOURMET TORTILLAS- - AMERICA'S FAVORITE" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
Corrine M. Freeman

*** Search: 14 *** Document Number: 5 ***

[Typed Drawing]

Mark
AMERICA'S FAVORITE

Pseudo Mark
AMERICAS FAVORITE

Goods and Services
IC 030. US 046. G & S: Doughnuts. FIRST USE: 19721003. FIRST USE IN COMMERCE: 19721201

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75538444

Filing Date
August 18, 1998

Publication for Opposition Date
April 27, 1999

Registration Number
2263243

Registration Date
July 20, 1999

Owner Name and Address
(REGISTRANT) HDN Development Corporation CORPORATION KENTUCKY 7303 Turfway Road Florence KENTUCKY 41042

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Attorney of Record
JOHN M HARRINGTON

Mark
AMERICA'S FAVORITE FOODS PRESTO

Pseudo Mark
AMERICAS FAVORITE FOODS PRESTO

Goods and Services
IC 030. US 046. G & S: pizza crust mix, garlic sauce and cheddar sauce. FIRST USE: 19920217. FIRST USE IN COMMERCE: 19920217

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code
261702 261707

Serial Number
75501805

Filing Date
June 15, 1998

Publication for Opposition Date
September 21, 1999

Registration Number
2299622

Registration Date
December 14, 1999

Owner Name and Address
(REGISTRANT) OHIO PIZZA PRODUCTS INC. CORPORATION OHIO 1522 Manchester Road Dayton OHIO 454490127

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE FOODS" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator

*** User: dspruill *** Serial Number: 75501805 ***

LIVE

Attorney of Record
THEODORE D LIENESCH

*** Search: 14 *** Document Number: 8 ***

[Typed Drawing]

Mark
AMERICA'S FAVORITE CANDIES

Pseudo Mark
AMERICAS FAVORITE CANDIES

Goods and Services
IC 030. US 046. G & S: CANDY NOT INCLUDING JELLY BEANS. FIRST USE: 19851118. FIRST USE IN COMMERCE: 19851118

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75470400

Filing Date
April 20, 1998

Publication for Opposition Date
November 2, 1999

Registration Number
2359173

Registration Date
June 20, 2000

Owner Name and Address
(REGISTRANT) PROMOTION IN MOTION, INC. CORPORATION DELAWARE 3 REUTEN DRIVE CLOSTER NEW JERSEY 07624

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CANDIES" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Attorney of Record
RICHARD M GOLDBERG

[Typed Drawing]

Mark
BEST PIE IN AMERICA

Goods and Services
IC 030. US 046. G & S: PIES. FIRST USE: 19970100. FIRST USE IN COMMERCE: 19970100

IC 042. US 100 101. G & S: RESTAURANT SERVICES. FIRST USE: 19970100. FIRST USE IN COMMERCE: 19970100

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75447700

Filing Date
March 10, 1998

Supplemental Register Date
October 14, 1998

Registration Number
2239993

Registration Date
April 13, 1999

Owner Name and Address
(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th Avenue Denver COLORADO 80216

Assignment Recorded
ASSIGNMENT RECORDED

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PIE" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK. SERVICE MARK

Register
SUPPLEMENTAL

Live Dead Indicator
LIVE

Attorney of Record
SABRINA C STAVISH

Mark
BAKERS SQUARE BEST PIE IN AMERICA

Goods and Services
IC 030. US 046. G & S: pies. FIRST USE: 19970400. FIRST USE IN COMMERCE: 19970400

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code
010103 260117

Serial Number
75300090

Filing Date
May 29, 1997

Filed ITU
FILED AS ITU

Publication for Opposition Date
October 6, 1998

Registration Number
2213980

Registration Date
December 29, 1998

Owner Name and Address
(REGISTRANT) Vicorp Restaurants, Inc. CORPORATION COLORADO 400 West 48th Avenue Denver COLORADO 80216

Assignment Recorded
ASSIGNMENT RECORDED

*** User: dspruill *** Serial Number: 75300090 ***

Prior Registration(s)
1394236;1394428;1403328;2002503

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BEST PIE IN AMERICA" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)-IN PART

Live Dead Indicator
LIVE

Distinctiveness Limitation Statement
as to "BAKERS"

Attorney of Record
SABRINA C STAVISH

*** Search: 14 *** Document Number: 11 ***

[Typed Drawing]

Mark
AMERICA'S BEST

Pseudo Mark
AMERICAS BEST

Goods and Services
IC 030. US 046. G & S: iced coffee-based beverages, namely, unflavored iced coffees and coffees with flavorings including cappuccino, hazelnut, French vanilla, Viennese mocha and original chocolate flavors. FIRST USE: 19930200. FIRST USE IN COMMERCE: 19930200

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75265223

Filing Date
March 27, 1997

Publication for Opposition Date
July 21, 1998

Registration Number
2194941

Registration Date
October 13, 1998

Owner Name and Address
(REGISTRANT) America's Best Beverage Company, Inc. CORPORATION FLORIDA 35 Mason Street Greenwich CONNECTICUT 06830

Assignment Recorded
ASSIGNMENT RECORDED

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Attorney of Record
MICHAEL I WOLFSON

[Typed Drawing]

Mark
AMERICA'S FAVORITE CHOCOLATE CHIP COOKIE!

Pseudo Mark
AMERICAS FAVORITE CHOCOLATE CHIP COOKIE

Goods and Services
IC 030. US 046. G & S: cookies. FIRST USE: 19960400. FIRST USE IN COMMERCE: 19960400

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75222072

Filing Date
January 8, 1997

Filed ITU
FILED AS ITU

Supplemental Register Date
January 20, 1998

Registration Number
2149887

Registration Date
April 7, 1998

Owner Name and Address
(REGISTRANT) Nabisco Brands Company CORPORATION DELAWARE One South Wacker Drive, Suite 2740 Chicago ILLINOIS 60606

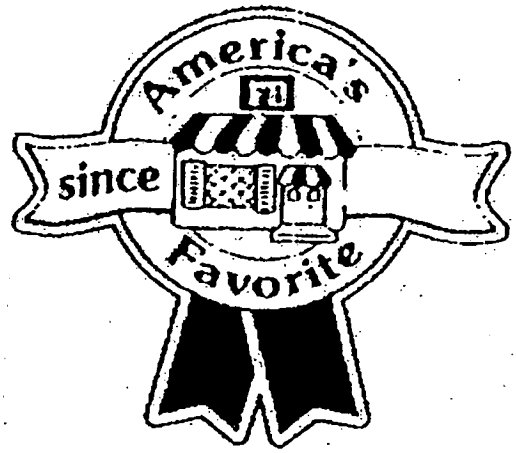
Assignment Recorded
ASSIGNMENT RECORDED

Type of Mark
TRADEMARK

Register
SUPPLEMENTAL

Live Dead Indicator
LIVE

Attorney of Record
KATHLEEN J GALLAGHER



Mark
AMERICA'S FAVORITE SINCE FBI

Goods and Services
IC 030. US 046. G & S: confectionery, namely, candy, caramels, marshmallows, marshmallow creme, and fudge. FIRST USE: 19960700. FIRST USE IN COMMERCE: 19960700

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code
070104 240707 240907

Serial Number
75144931

Filing Date
August 5, 1996

Publication for Opposition Date
September 16, 1997

Registration Number
2119233

Registration Date
December 9, 1997

Owner Name and Address
(REGISTRANT) Favorite Brands International, Inc. CORPORATION DELAWARE 75 Tri State International Lincolnshire ILLINOIS 60069

Assignment Recorded
ASSIGNMENT RECORDED

Disclaimer Statement

*** User: dspruill *** Serial Number: 75144931 ***

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE SINCE" APART FROM THE MARK AS SHOWN

Description of Mark

The mark consists of the design of a canopied building, with the stylized letters "FBI" appearing directly above the building, and the phrase "AMERICA'S FAVORITE SINCE" (followed by a date of origin, which varies from candy to candy), all being enclosed in a banner and seal-with-ribbon design. The lining in the drawing is a feature of the mark, and it is not intended to indicate color.

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Paula J. Krasny

*** Search: 14 *** Document Number: 14 ***

[Typed Drawing]

Mark
IT'S AMERICA'S FAVORITE JELLY BEAN

Goods and Services
IC 030. US 046. G & S: jelly beans. FIRST USE: 19890531. FIRST USE IN COMMERCE: 19890531

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75116367

Filing Date
June 10, 1996

Publication for Opposition Date
April 15, 1997

Registration Number
2077329

Registration Date
July 8, 1997

Owner Name and Address
(REGISTRANT) HERMAN GOELITZ CANDY CO., INC. CORPORATION CALIFORNIA 2400 North Watney Way Fairfield CALIFORNIA 94533

Assignment Recorded
ASSIGNMENT RECORDED

Prior Registration(s)
1604190

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "JELLY BEAN" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Attorney of Record
JAMES R. CYPHER

[Typed Drawing]

Mark
AMERICA'S FAVORITE KETCHUP

Pseudo Mark
AMERICAS FAVORITE KETCHUP

Goods and Services
IC 030. US 046. G & S: condiments, namely, ketchup. FIRST USE: 19920600. FIRST USE IN COMMERCE: 19920600

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75068756

Filing Date
March 7, 1996

Publication for Opposition Date
July 1, 1997

Registration Number
2098790

Registration Date
September 23, 1997

Owner Name and Address
(REGISTRANT) H. J. HEINZ COMPANY CORPORATION PENNSYLVANIA 1062 Progress Street Pittsburgh PENNSYLVANIA 15212

Assignment Recorded
ASSIGNMENT RECORDED

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "KETCHUP" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Attorney of Record
Dean A. Bierkan

[Typed Drawing]

Mark
AMERICA'S FAVORITE SOFT PRETZEL

Goods and Services
IC 030. US 046. G & S: snack foods, namely, soft pretzels. FIRST USE: 19960300. FIRST USE IN COMMERCE: 19960300

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75036522

Filing Date
December 26, 1995

Filed ITU
FILED AS ITU

Publication for Opposition Date
February 17, 1998

Registration Number
2155994

Registration Date
May 12, 1998

Owner Name and Address
(REGISTRANT) J&J Snack Foods Corp. CORPORATION NEW JERSEY 6000 Central Highway Pennsauken NEW JERSEY 08109

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOFT PRETZEL" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL-2(F)

Live Dead Indicator
LIVE

Attorney of Record
J. Rodman Steele, Jr.

[Typed Drawing]

Mark
AMERICA'S #1 SPICE VALUE

Goods and Services
IC 030. US 046. G & S: spices. FIRST USE: 19950324. FIRST USE IN COMMERCE: 19950324

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
75035078

Filing Date
December 20, 1995

Publication for Opposition Date
March 11, 1997

Registration Number
2066497

Registration Date
June 3, 1997

Owner Name and Address
(REGISTRANT) ROSE SPICE, INC. CORPORATION DELAWARE 4500 Northchase Parkway NE Wilmington DELAWARE 28405

Assignment Recorded
ASSIGNMENT RECORDED

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S #1 SPICE" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL

Live Dead Indicator
LIVE

Attorney of Record
WILLIAM J MASON

*** Search: 14 *** Document Number: 19 ***

[Typed Drawing]

Mark
AMERICA'S FAVORITE HOLIDAY CANDY

Pseudo Mark
AMERICAS FAVORITE HOLIDAY CANDY

Goods and Services
IC 030. US 046. G & S: chocolates and other candy. FIRST USE: 19921201. FIRST USE IN COMMERCE: 19921201

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74322961

Filing Date
October 15, 1992

Filed ITU
FILED AS ITU

Supplemental Register Date
December 14, 1993

Registration Number
1837304

Registration Date
May 17, 1994

Owner Name and Address
(REGISTRANT) R. M. PALMER COMPANY CORPORATION PENNSYLVANIA 77 Second Avenue West Reading PENNSYLVANIA 19611

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "HOLIDAY CANDY" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
SUPPLEMENTAL

Affidavit Text
SECT 8 (6-YR).

Live Dead Indicator
LIVE

Attorney of Record
John F. McNulty

*** Search: 14 *** Document Number: 21 ***

America's Favorite Pizza Feast

Mark
AMERICA'S FAVORITE PIZZA FEAST

Pseudo Mark
AMERICAS FAVORITZ PIZZA FEAST

Goods and Services
IC 030. US 046. G & S: pizza for consumption on or off the premises.
FIRST USE: 19920427. FIRST USE IN COMMERCE: 19920427

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number
74270458

Filing Date
April 29, 1992

Filed ITU
FILED AS ITU

Publication for Opposition Date
December 15, 1992

Registration Number
1791773

Registration Date
September 7, 1993

Owner Name and Address
(REGISTRANT) Domino's Pizza, Inc. CORPORATION MICHIGAN 30 Frank Lloyd Wright Drive P.O. Box 997 Ann Arbor MICHIGAN 481060997

Assignment Recorded
ASSIGNMENT RECORDED

Prior Registration(s)
1700700

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AMERICA'S FAVORITE PIZZA" APART FROM THE MARK AS SHOWN

Type of Mark
TRADEMARK

Register
PRINCIPAL

*** User: dspruill *** Serial Number: 74270458 ***

Affidavit Text
SECT 15. SECT 8 (6-YR).

Live Dead Indicator
LIVE

Attorney of Record
JEFFREY P THENNISCH

*** Search: 14 *** Document Number: 22 ***

[Typed Drawing]

Mark
AMERICA'S SNACK FAVORITE

Pseudo Mark
americas snack favorite

Goods and Services
IC 030. US 046. G & S: snack cakes. FIRST USE: 19891200. FIRST USE IN COMMERCE: 19891200

Mark Drawing Code
(1) TYPED DRAWING

Serial Number
74044195

Filing Date
March 30, 1990

Supplemental Register Date
November 14, 1990

Registration Number
1638019

Registration Date
March 12, 1991

Owner Name and Address
(REGISTRANT) McKee Baking Company CORPORATION TENNESSEE P.O. Box 750 Collegedale TENNESSEE 37315

(LAST LISTED OWNER) MCKEE FOODS CORPORATION CORPORATION BY CHANGE OF NAME FROM TENNESSEE P.O. BOX 750 COLLEGEDALE TENNESSEE 373150750

Assignment Recorded
ASSIGNMENT RECORDED

Prior Registration(s)
1542109

Type of Mark
TRADEMARK

Register
SUPPLEMENTAL

Affidavit Text
SECT 8 (6-YR). SECTION 8(10-YR) 20010618.

Renewal
1ST RENEWAL 20010618

Live Dead Indicator

*** User: dspruill *** Serial Number: 74044195 ***

LIVE

Attorney of Record
DONALD A. KAUL & PATRICIA R. BROWN

*** Search: 14 *** Document Number: 23 ***

*** User: dspruill ***

#	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	39	4	35	14	0:01	"barilla alimentare"[on]
02	1609	N/A	0	0	0:04	*b$1r{v}l$1{v}*[bi,ti]
03	223	0	223	67	0:11	2 and "030"[cc] not dead[ld]
04	34385	N/A	0	0	0:06	*m{v}r{v}{"ckqx"}a*[bi,ti]
05	1017	N/A	0	0	0:11	*{"fh"}avor{v}t*[bi,ti]
06	8369	N/A	0	0	0:02	*be{"sz"}t*[bi,ti]
07	1530	N/A	0	0	0:01	*pre{"fp"}$1er*[bi,ti]
08	23850	N/A	0	0	0:04	("1" one*)[bi,ti]
09	1325	N/A	0	0	0:01	*pa{"sz"}ta*[bi,ti]
10	901	N/A	0	0	0:01	4 and (5 6 7 8 9)
11	23	13	10	2	0:01	9 and (5 6 7 8)
12	214	0	214	69	0:10	10 and "030"[cc] not dead[ld]

Session started 10/11/02 9:29:16 AM
Session finished 10/11/02 9:44:24 AM
Total search duration 0 minutes 53 seconds
Session duration 15 minutes 8 seconds

Default NEAR limit= 1 ADJ limit= 1

Drawing Page

Serial Number:
78136703

Applicant:
Barilla Alimentare S.p.A.
Via Mantova 166
Parma PR Italy 43100

[redacted]

Goods and Services:
PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

Mark:

BARILLA - AMERICA'S FAVORITE PASTA

[redacted]

NO OCR

[redacted]

06-18-2002

DOCUMENT INFORMATION	
TRADEMARK/SERVICEMARK APPLICATION	
VERSION 1.24	
APPLICANT INFORMATION	
NAME	Barilla Alimentare S.p.A.
STREET	Via Mantova 166
CITY	Parma PR
COUNTRY	Italy
ZIP/POSTAL CODE	43100
APPLICANT ENTITY INFORMATION	
CORPORATION: STATE/COUNTRY OF INCORPORATION	Italy
TRADEMARK/SERVICEMARK INFORMATION	
MARK	BARILLA - AMERICA'S FAVORITE PASTA
TYPED FORM	Yes
BASIS FOR FILING AND GOODS/SERVICES INFORMATION	
INTENT TO USE: SECTION 1(b)	Yes
INTERNATIONAL CLASS NUMBER	030
LISTING OF GOODS AND/OR SERVICES	PASTA, PASTA PRODUCTS, SAUCES FOR PASTA
ATTORNEY INFORMATION	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800

CITY	Washington
STATE	DC
COUNTRY	USA
ZIP/POSTAL CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
ATTORNEY DOCKET NUMBER	2778-127
OTHER APPOINTED ATTORNEY(S)	Robert H. Cameron; Anne M. Sterba
DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT	
NAME	G. Franklin Rothwell, Esq.
STREET	1425 K Street, NW Suite 800
CITY	Washington
STATE	DC
ZIP CODE	20005
FIRM NAME	Rothwell, Figg, Ernst & Manbeck, P.C.
TELEPHONE NUMBER	202-783-6040
FAX NUMBER	202-783-6031
FEE INFORMATION	
TOTAL FEES PAID	325
NUMBER OF CLASSES PAID	1
NUMBER OF CLASSES	1

LAW OFFICE INFORMATION	
E-MAIL ADDRESS FOR CORRESPONDENCE	N/A
SIGNATURE AND OTHER INFORMATION	
SIGNATURE	/Robert H. Cameron/
DATE	06/18/2002
NAME	Robert H. Cameron
TITLE	Attorney for Applicant
MAILING ADDRESS	
LINE	G. Franklin Rothwell, Esq.
LINE	Rothwell, Figg, Ernst & Manbeck, P.C.
LINE	1425 K Street, NW
LINE	Suite 800
LINE	Washington DC 20005
RAM INFORMATION	
RAM SALE NUMBER	127
RAM ACCOUNTING DATE	20020619
SERIAL NUMBER INFORMATION	
SERIAL NUMBER	78/136703
INTERNET TRANSMISSION DATE	Tuesday, 06-18-2002 16:40:16 EDT
TEAS STAMP	USPTO-12150177130-20020618164022616-78/136703-124c18cc5c8a2b5c1d36e5f455ca4201533-RAM-127-20020618163822616
E-MAIL ADDRESS FOR	bmanning@rothwellfigg.com

ACKNOWLEDGMENT	

<SERIAL NUMBER> 78136703
<FILING DATE> 06/18/2002

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME>	Barilla Alimentare S.p.A.
<STREET>	Via Mantova 166
<CITY>	Parma PR
<COUNTRY>	Italy
<ZIP/POSTAL CODE>	43100

<APPLICANT ENTITY INFORMATION>
<CORPORATION: STATE/COUNTRY OF INCORPORATION> Italy

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> BARILLA - AMERICA'S FAVORITE PASTA
<TYPED FORM> Yes
* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). *

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>
<INTENT TO USE: SECTION 1(b)> Yes
* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) *
<INTERNATIONAL CLASS NUMBER> 030
<LISTING OF GOODS AND/OR SERVICES> PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

<ATTORNEY INFORMATION>

<NAME>	G. Franklin Rothwell, Esq.
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<COUNTRY>	USA
<ZIP/POSTAL CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.

<TELEPHONE NUMBER> 202-783-6040
<FAX NUMBER> 202-783-6031
<ATTORNEY DOCKET NUMBER> 2778-127
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>
* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served *

<NAME>	G. Franklin Rothwell, Esq.
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<ZIP CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040
<FAX NUMBER>	202-783-6031

<FEE INFORMATION>
<TOTAL FEES PAID> 325
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>
<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>
* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. *

<SIGNATURE>	/Robert H. Cameron/
<DATE>	06/18/2002

<NAME> Robert H. Cameron
<TITLE> Attorney for Applicant

<MAILING ADDRESS>
<LINE> G. Franklin Rothwell, Esq.
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.
<LINE> 1425 K Street, NW
<LINE> Suite 800
<LINE> Washington DC 20005

<RAM INFORMATION>
<RAM SALE NUMBER> 127
<RAM ACCOUNTING DATE> 20020619

<SERIAL NUMBER INFORMATION>
<SERIAL NUMBER> 78/136703
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:40:16 EDT
<TEAS STAMP>
USPTO-12150177130-20020618164022616-78/136703-
124c18cc5c8a2b5c1d36e5f455ca4201533-RAM-127-20020618163822616
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmanning@rothwellfigg.com

Internet Transmission Date:
2002/06/18

Serial Number:
78136703

Filing Date:
2002/06/18

[redacted]

TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: $325

RAM SALE NUMBER: 127
RAM ACCOUNTING DATE: 20020619

[redacted]

NO OCR

[redacted]

06-18-2002

Drawing Page

Serial Number:
78136703

[redacted]

Applicant:
Barilla Alimentare S.p.A.
Via Mantova 166
Parma PR Italy 43100

Goods and Services:
PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

Mark:

BARILLA - AMERICA'S FAVORITE PASTA

[redacted]

NO OCR

[redacted]

06-18-2002

Drawing Page

Serial Number:
78136703

[redacted]

Applicant:
Barilla Alimentare S.p.A.
Via Mantova 166
Parma PR Italy 43100

Goods and Services:
PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

Mark:

BARILLA - AMERICA'S FAVORITE PASTA

[redacted]

NO OCR

[redacted]

06-18-2002

Internet Transmission Date:
2002/06/18

Serial Number:
78136703

Filing Date:
2002/06/18

[redacted]

TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: $325

RAM SALE NUMBER: 127
RAM ACCOUNTING DATE: 20020619

[redacted]

NO OCR

[redacted]

06-18-2002

<SERIAL NUMBER> 78136703
<FILING DATE> 06/18/2002

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME>	Barilla Alimentare S.p.A.
<STREET>	Via Mantova 166
<CITY>	Parma PR
<COUNTRY>	Italy
<ZIP/POSTAL CODE>	43100

<APPLICANT ENTITY INFORMATION>
<CORPORATION: STATE/COUNTRY OF INCORPORATION> Italy

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> BARILLA - AMERICA'S FAVORITE PASTA
<TYPED FORM> Yes
* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). *

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>
<INTENT TO USE: SECTION 1(b)> Yes
* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) *
<INTERNATIONAL CLASS NUMBER> 030
<LISTING OF GOODS AND/OR SERVICES> PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

<ATTORNEY INFORMATION>

<NAME>	G. Franklin Rothwell, Esq.
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<COUNTRY>	USA
<ZIP/POSTAL CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040

<FAX NUMBER> 202-783-6031
<ATTORNEY DOCKET NUMBER> 2778-127
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>
* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served *

<NAME>	G. Franklin Rothwell, Esq.
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<ZIP CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040
<FAX NUMBER>	202-783-6031

<FEE INFORMATION>
<TOTAL FEES PAID> 325
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>
<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>
* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. *

<SIGNATURE>	/Robert H. Cameron/
<DATE>	06/18/2002
<NAME>	Robert H. Cameron
<TITLE>	Attorney for Applicant

<MAILING ADDRESS>
<LINE> G. Franklin Rothwell, Esq.
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.
<LINE> 1425 K Street, NW
<LINE> Suite 800
<LINE> Washington DC 20005

<RAM INFORMATION>
<RAM SALE NUMBER> 127
<RAM ACCOUNTING DATE> 20020619

<SERIAL NUMBER INFORMATION>
<SERIAL NUMBER> 78/136703
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:40:16 EDT
<TEAS STAMP>
USPTO-12150177130-20020618164022616-78/136703-
124c18cc5c8a2b5c1d36e5f455ca4201533-RAM-127-20020618163822616
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmanning@rothwellfigg.com

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF MISSOURI
WESTERN DIVISION

AMERICAN ITALIAN PASTA COMPANY	)	
	)	
Plaintiff,	)	
	)	
v.	)	No. 02-0594-CV-W-SOW
	)	
NEW WORLD PASTA COMPANY	)	
	)	
Defendant.	)	

ORDER

Before the Court are defendant New World Pasta Company's Motion for Partial Summary Judgment (Doc. #26), plaintiff American Italian Pasta Company's Suggestions in Opposition, and defendant's Reply. For the reasons stated herein, defendant's motion is denied.

I. Background

Plaintiff American Italian Pasta Company ("AIPC") filed a Complaint for Declaratory Judgment on June 18, 2002. Plaintiff's Complaint seeks a declaratory judgment pursuant to 28 U.S.C. §2201(a) that its use of the phrase "America's Favorite Pasta" on its pasta packaging and in advertising and promoting its pasta products does not constitute false advertising in violation of 15 U.S.C. §1125(a)(1)(B).

Defendant New World Pasta Company ("New World") responded to plaintiff's Complaint by filing an Answer and Counterclaim on August 2, 2002. In the Answer and Counterclaim, New World alleges that AIPC's use of the advertising claim "America's Favorite Pasta" on its Mueller's branded dried pastas is literally false because it conveys to consumers that Mueller's is a national brand of pasta and is the number one selling brand of pasta in the country. New World alleges that Mueller's branded pasta is not sold anywhere west of the Mississippi River and is, at

DEPOSITION EXHIBIT
Applicant's #3
12/19/02 DS

best, in second place in sales. New World asserts that AIPC's advertising claim "America's Favorite Pasta" on its Mueller's branded pasta is a false representation in violation of Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a) and in violation of the unfair competition laws of seventeen states in which Mueller's pasta is sold. New World seeks injunctive relief and damages.

New World has filed a motion for partial summary judgment. The following undisputed material facts are relevant to the pending motion: AIPC has been manufacturing Mueller's dried pasta since 1997. From 1997 through November of 2000, AIPC manufactured Mueller's dried pasta for Best Foods. Then, on or about November 14, 2000, AIPC purchased the exclusive rights to own all aspects of the Mueller's pasta business. At that time, AIPC assumed responsibility for packaging, distribution, pricing, and marketing of the Mueller's brand pastas.

The phrase "America's Favorite Pasta" has appeared continuously on Mueller's pasta packaging since at least November of 2000.[1] These packages are placed on product shelves next to competitive brands of pasta at the point of purchase. The phrase "America's Favorite Pasta" has also been used in advertising materials for Mueller's brand pasta products.

The parties agree that Barilla was the largest seller of dried pasta in the United States during the year 2002. Similarly, it is undisputed that in its 2001 Annual Report, AIPC did not claim that Mueller's is the largest selling brand of dried pasta in the United States. In addition, it is undisputed that Mueller's brand pasta is not sold anywhere west of the Mississippi River. The advertising and packages for AIPC's Mueller's brand of dried pasta products have not claimed

[1]There is a dispute between the parties as to whether or not the phrase "America's Favorite Pasta" was used on packages of Mueller's brand pasta between 1997 and 2000 while AIPC was manufacturing the pasta for Best Foods.

that Mueller's is the best-selling pasta in the United States. Mueller's claims a brand heritage starting in 1867 and it has been continuously sold through the present.

On May 21, 2002, defendant New World sent a letter to plaintiff AIPC demanding that AIPC assure New World in writing no later than May 29, 2002 that by July 2, 2002, AIPC would cease all use of the phrase "America's Favorite Pasta" for Mueller's products. On June 20, 2002, AIPC filed this lawsuit seeking a declaratory judgment that its use of the phrase "America's Favorite Pasta" does not violate § 43(a) of the Lanham Act.

In addition to these undisputed material facts, defendant New World contends that a substantial number of consumers perceive AIPC's phrase "America's Favorite Pasta" as conveying that Mueller's is the number one selling pasta in the country. New World also asserts that a substantial number of consumers perceive the phrase as conveying that Mueller's is a national brand of pasta available everywhere in the country. New World's allegations are based on the results of a consumer survey. Plaintiff AIPC disputes New World's allegations, claiming that these conclusions are unreliable due to the flawed methodology and analysis found in the protocol of the study relied upon by New World.

II. Standard

A motion for summary judgment should be granted if, viewing the evidence in the light most favorable to the non-moving party, there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); Rafos v. Outboard Marine Corp., 1 F.3d 707, 708 (8th Cir. 1993) (citing Celotex Corp. v. Catrett, 477 U.S. 317, 322-23 (1986)). A defendant who moves for summary judgment has the burden of showing that there is no genuine issue of fact for trial. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 256 (1986). A plaintiff opposing a properly supported motion for summary judgment may not rest upon the

allegations contained in the pleadings, "but must set forth specific facts showing there is a genuine issue for trial." Id.

III. Discussion

Defendant New World alleges that plaintiff AIPC's use of the phrase "America's Favorite Pasta" on its Mueller's brand pasta packaging and in advertising materials for its Mueller's brand pasta is literally false and violates the Lanham Act. In the alternative, New World argues that AIPC's use of the phrase is impliedly false and misleading. AIPC contends that the phrase is non-actionable puffery.

A. Literal Falsity

To demonstrate falsity within the meaning of the Lanham Act, a plaintiff may show (1) that the statement is literally false as a factual matter or (2) that the statement is literally true or ambiguous but it implicitly conveys a false impression, is misleading in context, or is likely to deceive consumers. United Industries Corp. v. The Clorox Co., 140 F.3d 1175, 1180 (8th Cir. 1998) (citations omitted). Defendant New World alleges that AIPC's use of the phrase "America's Favorite Pasta" on its Mueller's brand pastas and in advertising those pastas is literally false. Courts determine whether an accused statement is literally false without considering factual issues about public perception of the statement. Id. "In assessing whether an advertisement is literally false, a court must analyze the message conveyed within its full context." Id. at 1181 (citation omitted).

Defendant New World argues that within the advertising industry, claims to be America's "favorite" are well known and "only the market leader can properly make the claim." New World suggests that because AIPC's Mueller's brand is not the best-selling brand of pasta in the United States, AIPC's use of the phrase "America's Favorite Pasta" is literally false. This Court

disagrees.

As defendant New World concedes, there are no court decisions addressing an advertising claim of being a "favorite." Instead, New World relies on decisions issued by the National Advertising Division of the Better Business Bureau ("NAD"). These decisions are not binding on this Court nor are they persuasive. The facts and holdings found in the NAD decisions do not support defendant's conclusions.

The use of the term "favorite" is not literally false. The term "favorite" is ambiguous and does not necessarily refer to the best selling item in a category. It is logical that a product could be a favorite without being the best-selling product in its category. For example, a group of individual consumers could participate in a wine tasting study. Their favorite wine might be a red wine that sells for $200 a bottle. That wine would be their favorite, but it probably would not become the best-selling red wine due to its cost.

Furthermore, as plaintiff AIPC suggests, the term "favorite" is ambiguous. It could refer to a preference in quality, taste, price, or cooking ease. Defendant has not established that the words in the phrase "America's Favorite Pasta" have a specific meaning and that the phrase is unambiguously, literally false.

Therefore, the Court finds that as a factual matter, plaintiff's use of the phrase "America's Favorite Pasta" is not literally false. Defendant's motion for summary judgment is denied as to its claim of literal falsity.

2. <u>False Impression, Misleading, or Deceptive</u>

Defendant New World argues that even if the statement is too ambiguous to be literally false, it violates the Lanham Act because it "conveys a false message to consumers." Defendant

relies on a consumer study that it claims demonstrates that a substantial number of consumers (over 40%) perceive the advertising claim "America's Favorite Pasta" to convey that plaintiff's Mueller's brand pasta is the best selling brand of dried pasta.

In order to establish that plaintiff AIPC is violating the Lanham Act, defendant New World must show:

1. a false statement of fact was made by the defendant in a commercial advertisement about its own or another product;
2. the statement actually deceived or has the tendency to deceive a substantial segment of its audience;
3. the deception is material, in that it is likely to influence the purchasing decision;
4. the defendant caused its false statement to enter interstate commerce; and
5. the plaintiff has been or is likely to be injured as a result of the false statement, either by direct diversion of sales from itself to defendant or by a loss of goodwill associated with its products.

United Indus. Corp. v. Clorox Co., 140 F.3d at 1180. A determination of implicit falsity requires either proof of wilfulness or actual material misleading of consumers. Id. at 1183.

Plaintiff AIPC argues that its use of the phrase "America's Favorite Pasta" is non-actionable "puffery." "A court may consider as a matter of law whether the alleged misrepresentation in an advertisement is a statement of fact, actionable under the Lanham Act, or mere puffery." In re Century 21-RE/MAX Real Estate Adver. Claims Litig., 882 F.Supp. 915, 926 (C.D. Cal. 1994)(citing Cook, Perkiss, & Leihe, Inc. v. N. Cal. Collection Serv., 911 F.2d 242, 245 (9th Cir. 1990)).

"Puffery is exaggerated advertising, blustering, and boasting upon which no reasonable

buyer would rely and is not actionable under § 43(a)." United Indus. Corp., 140 F.3d at 1180 (internal quotations omitted). Due to their generalized nature, advertisements or statements that fall into the category of "puffery" do not meet the first and second elements required under § 43(a) because "it is beyond the realm of reason to assert . . . that a reasonable consumer would interpret [the puffery] as a factual claim upon which he or she could rely." In re Century 21, 882 F.Supp. at 926 (citation omitted). Puffing applies to claims that cannot be proven false because they are not capable of measurement. United Indus. Corp., 140 F.3d at 1180; Castrol Inc. v. Pennzoil Co., 987 F.2d 939, 946 (3rd Cir. 1993).

Viewed in context, the phrase "America's Favorite Pasta" is the kind of general claim of superiority that is "so vague, it would be understood as a mere expression of opinion." Pizza Hut, Inc. v. Papa John's Int'l Inc., 227 F.3d 489, 496 (5th Cir. 2000), cert. denied, 532 U.S. 920 (2001)(citing 4 J. Thomas McCarthy, McCarthy of Trademarks and Unfair Competition, § 27.38 (4th ed. 1996)).

> Drawing guidance from the writings of our sister circuits and the leading commentators, we think that non-actionable "puffery" comes in at least two possible forms: (1) an exaggerated, blustering, and boasting statement upon which no reasonable buyer would be justified in relying; or (2) a general claim of superiority over comparable products that is so vague that it can be understood as nothing more than a mere expression of opinion.

Pizza Hut, Inc., 277 F.3d at 496-97.

The term "favorite" necessarily implies an opinion. Plaintiff AIPC has not specified that its Mueller's brand pasta is a favorite based upon any criteria for evaluating pasta. *See* In Re Century 21, 882 F.Supp. at 928 ("the chairman of RMI has 'declared RE/MAX #1 in the United States - and the World.' Not only is this mere opinion, but it makes no reference to the category in which RE/MAX is number one."). As recognized in Pizza Hut, Inc., "Bald assertions of superiority or general statements of opinion cannot form the basis of Lanham Act liability." 227

F.3d at 496 (citations omitted). To be actionable, the statements at issue "must be a 'specific and measurable claim, capable of being proved false or of being reasonably interpreted as a statement of objective fact.'" Id. (citing Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co., 173 F.3d 725, 731 (9th Cir. 1999)).

Defendant has not persuaded the Court that the phrase "America's Favorite Pasta" is a specific and measurable claim. Rather, the phrase is a "general claim of superiority over comparable products that is so vague that it can be understood as nothing more than a mere expression of opinion." Pizza Hut, Inc., 227 F.3d at 497.

Therefore, this Court finds as a matter of law that the phrase "America's Favorite Pasta" is mere puffery and is not actionable under the Lanham Act.

IV. Conclusion

For the reasons stated above, it is hereby

ORDERED that defendant New World Pasta Company's Motion for Partial Summary Judgment (Doc. #26) is denied. It is further

ORDERED that defendant's Counterclaim is dismissed based upon the Court's finding that the phrase "America's Favorite Pasta" constitutes non-actionable "puffery" and is not a violation of the Lanham Act. It is further

ORDERED that defendant's state law claims are dismissed as the Court declines to exercise supplemental jurisdiction over such claims having dismissed defendant's federal claim.

/s/Scott O. Wright
SCOTT O. WRIGHT
Senior United States District Judge

Dated: 2-25-03

United States Court of Appeals
FOR THE EIGHTH CIRCUIT

No. 03-2065

American Italian Pasta Company,	*	
	*	
Appellee,	*	
	*	Appeal from the United States
v.	*	District Court for the
	*	Western District of Missouri.
New World Pasta Company,	*	
	*	
Appellant.	*	

Submitted: November 17, 2003
Filed: June 7, 2004

Before RILEY, RICHARD S. ARNOLD, and MELLOY, Circuit Judges.

RILEY, Circuit Judge.

"America's Favorite Pasta"–Commercial puffery or factual claim?

American Italian Pasta Company (American) sued New World Pasta Company (New World), seeking a declaratory judgment that American's use of the phrase "America's Favorite Pasta" does not constitute false or misleading advertising under section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a)(1)(B) (2000). New World counterclaimed, asserting American's use of "America's Favorite Pasta" violated the Lanham Act and many states' unfair competition laws. On summary judgment, the

DEPOSITION EXHIBIT
Applicant's #4
12/19/06 DS

district court[1] concluded American's use of "America's Favorite Pasta" did not violate the Lanham Act, dismissing New World's counterclaims and declining to exercise jurisdiction over New World's state law claims. We affirm.

I. BACKGROUND

From 1997 to 2000, American[2] manufactured Mueller's brand (Mueller's) dried pasta for Best Foods. In the fall of 2000, American purchased Mueller's and assumed all packaging, distributing, pricing, and marketing for the brand. Since purchasing Mueller's, American has placed the phrase "America's Favorite Pasta" on Mueller's packaging. On various packages, the phrases "Quality Since 1867," "Made from 100% Semolina," or "Made with Semolina" accompany the phrase "America's Favorite Pasta." The packaging also contains a paragraph in which the phrase "America's Favorite Pasta" appears. The paragraph states (1) pasta lovers have enjoyed Mueller's pasta for 130 years; (2) claims Mueller's "pasta cooks to perfect tenderness every time," because Mueller's uses "100% pure semolina milled from the highest quality durum wheat;" and (3) encourages consumers to "[t]aste why Mueller's is America's favorite pasta."

New World[3] sent American a letter demanding American cease and desist using the phrase "America's Favorite Pasta." Consequently, American filed this suit, requesting a declaration that its use of the phrase "America's Favorite Pasta" does not constitute false or misleading advertising under the Lanham Act. In its federal

---

[1]The Honorable Scott O. Wright, United States District Judge for the Western District of Missouri.

[2]American sells dried pasta under the brand names Mueller's, Golden Grain, Mrs. Grass, Ronco, Luxury, R & F, Global A1, Pennsylvania Dutch, and Anthony's.

[3]New World sells dried pasta under the brand names Ronzoni, San Giorgio, Skinner, American Beauty, Light n' Fluffy, Goodman, Mrs. Weiss, Prince, Creamette, Monder, Albadoro, Catelli, Lancia, and Ronzoni Canada.

counterclaim, New World asserted American's use of "America's Favorite Pasta" violated the Lanham Act. New World claims American's use of the phrase is false or misleading advertising, because, according to New World's consumer survey, the phrase conveys Mueller's is a national pasta brand or the nation's number one selling pasta. American and New World agree Barilla sells the most dried pasta in the United States and American's brands are regional.

American moved to dismiss New World's counterclaims, arguing the phrase "America's Favorite Pasta" constituted non-actionable puffery. New World resisted American's motion and filed a motion for partial summary judgment. The district court denied American's motion, concluding it would have to consider facts outside the pleadings to determine if the phrase "America's Favorite Pasta" constituted puffery. Two weeks later, the district court denied New World's motion for partial summary judgment, dismissed New World's Lanham Act counterclaim, and declined to exercise jurisdiction over New World's state law counterclaims. The district court concluded the phrase "America's Favorite Pasta" constitutes non-actionable puffery as a matter of law, and the phrase is not actionable under the Lanham Act. New World appeals, contending the phrase "America's Favorite Pasta" is not puffery, but is a deceptive factual claim.

II. DISCUSSION

We review the district court's summary judgment decision de novo. Interstate Cleaning Corp. v. Commercial Underwriters Ins. Co., 325 F.3d 1024, 1027 (8th Cir. 2003). A purpose of the Lanham Act is "to protect persons engaged in commerce against false advertising and unfair competition." United Indus. Corp. v. Clorox Co., 140 F.3d 1175, 1179 (8th Cir. 1998). To establish a false or deceptively misleading advertising claim under section 43(a) of the Lanham Act,[4] New World must establish:

---

[4]Section 43(a) of the Lanham Act states, in pertinent part:

> (1) a false statement of *fact* by [American on its packaging] about its own or another's product; (2) the statement actually deceived or has the tendency to deceive a substantial segment of its audience; (3) the deception is material, in that it is likely to influence the purchasing decision; (4) the defendant caused its false statement to enter interstate commerce; and (5) the plaintiff has been or is likely to be injured as a result of the false statement.

Id. at 1180 (emphasis added). The failure to establish any element of the prima facie case is fatal. Pizza Hut, Inc. v. Papa John's Int'l, Inc., 227 F.3d 489, 495 (5th Cir. 2000).

Under section 43(a), two categories of actionable statements exist: (1) literally false factual commercial claims; and (2) literally true or ambiguous factual claims "which implicitly convey a false impression, are misleading in context, or [are] likely to deceive consumers." United Indus., 140 F.3d at 1180. Besides actionable statements, a category of non-actionable statements exists. Id. Many statements fall into this category, popularly known as puffery. Id. Puffery exists in two general

---

> (1) Any person who, on or in connection with any goods . . . uses in commerce any . . . false or misleading description of *fact*, or false or misleading representation of *fact*, which –
>
> . . .
>
> (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,
>
> shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a) (emphasis added).

forms: (1) exaggerated statements of bluster or boast upon which no reasonable consumer would rely; and (2) vague or highly subjective claims of product superiority, including bald assertions of superiority. Pizza Hut, 227 F.3d at 496-97; United Indus., 140 F.3d at 1180.

Juxtaposed to puffery is a factual claim. A factual claim is a statement that "(1) admits of being adjudged true or false in a way that (2) admits of empirical verification." Pizza Hut, 227 F.3d at 496 (quoting Presidio Enters., Inc. v. Warner Bros. Distrib. Corp., 784 F.2d 674, 679 (5th Cir. 1986)). To be actionable, the statement must be a "specific and measurable claim, capable of being proved false or of being reasonably interpreted as a statement of objective fact." Coastal Abstract Serv., Inc. v. First Am. Title Ins. Co., 173 F.3d 725, 731 (9th Cir. 1999); cf. United Indus., 140 F.3d at 1180 (noting puffery does not include "false descriptions of specific or absolute characteristics of a product and specific, measurable claims of product superiority"). Generally, opinions are not actionable. Coastal Abstract, 173 F.3d at 731.

Puffery and statements of fact are mutually exclusive. If a statement is a specific, measurable claim or can be reasonably interpreted as being a factual claim, i.e., one capable of verification, the statement is one of fact. Conversely, if the statement is not specific and measurable, and cannot be reasonably interpreted as providing a benchmark by which the veracity of the statement can be ascertained, the statement constitutes puffery. Defining puffery broadly provides advertisers and manufacturers considerable leeway to craft their statements, allowing the free market to hold advertisers and manufacturers accountable for their statements, ensuring vigorous competition, and protecting legitimate commercial speech.

A. "America's Favorite Pasta" Standing Alone

The phrase "America's Favorite Pasta," standing alone, is not a statement of fact as a matter of law. The key term in the phrase "America's Favorite Pasta" is

"favorite." Used in this context, "favorite" is defined as "markedly popular especially over an extended period of time." Webster's Third New International Dictionary 830 (unabridged 1961). Webster's definition of "favorite" begs the question of how "popular" is defined. In this context, "popular" is defined as "well liked or admired by a particular group or circle." Id. at 1766. By combining the term "favorite" with "America's," American claims Mueller's pasta has been well liked or admired over time by America, a non-definitive person.[5]

"America's Favorite Pasta" is not a specific, measurable claim and cannot be reasonably interpreted as an objective fact. "Well liked" and "admired" are entirely subjective and vague. Neither the words "well liked" nor "admired" provide an empirical benchmark by which the claim can be measured. "Well liked" and "admired" do not convey a quantifiable threshold in sheer number, percentage, or place in a series. A product may be well liked or admired, but the product may not dominate in sales or market share. For example, assume a consumer's favorite cut of meat is beef tenderloin. If we were to look at the sheer amount of beef tenderloin our hypothetical consumer buys relative to other cuts of meat, beef tenderloin may not have a sizable market share or account for a significant percentage of the amount of money spent on meat. Therefore, we could not accurately determine whether beef tenderloin was the consumer's favorite cut of beef based on those benchmarks. The fact is, the consumer may admire beef tenderloin and like it best among beef cuts, but beef tenderloin is too expensive for our consumer to eat often. Likewise, sales volume and total dollars spent on particular pasta brands in the United States may not uncover America's favorite pasta.

---

[5]We note the outcome of this case might be different if American claimed Mueller's pasta was the favorite pasta of a specific person or an identifiable group. Such a claim might be a statement of fact. For example, the claim that Mueller's is Judge Michael Melloy's favorite pasta would not be puffery. Such a statement is a factual statement that could be verified by simply asking Judge Melloy which pasta brand is his favorite.

"America's Favorite Pasta" also does not imply Mueller's is a national brand. First, "America's" is vague, and "America's," as well as "America" and "American" used in a similar context, is a broad, general reference. Second, a brand, chain, or product could be America's favorite without being national. For example, an individual restaurant or restaurant chain may be America's favorite, but may be located only in one or a few states. Although the restaurant chain may not be available nationally, consumers may prefer the restaurant because of its quality of food, quality of service, atmosphere, or some other attribute. Because "America's Favorite" depends on numerous characteristics, many of which may be intrinsic, a product (be it a restaurant, grits, or pasta) need not be sold nationally to be America's favorite.

B. "America's Favorite Pasta" Viewed In Context

Having decided the phrase "America's Favorite Pasta," standing alone, is not a statement of fact, we consider whether the context in which the phrase is used by American transforms it into a statement of fact. See Pizza Hut, 227 F.3d at 495 n.5 (noting the context in which a statement appears can be used to determine if the statement is actionable under the Lanham Act). "America's Favorite Pasta" appears on Mueller's packaging in two places. First, Mueller's packaging contains the phrase "America's Favorite Pasta" in the following paragraph (Paragraph):

> For over 130 years, pasta lovers have enjoyed the great taste of Mueller's. Our pasta cooks to perfect tenderness every time because it's made from 100% pure semolina milled from the highest quality durum wheat. Taste why Mueller's is America's favorite pasta.

Second, "America's Favorite Pasta" appears directly above "Quality Since 1867" on some packaging, and directly above "Made from 100% Semolina" or "Made with Semolina" on other packaging (Phrases).

The Paragraph and the Phrases fail to transform "America's Favorite Pasta" into a statement of fact. The Paragraph does not suggest a benchmark by which the veracity of American's statement can be verified. The Paragraph generally declares the brand has existed for 130 years, Mueller's tastes great, cooks to perfect tenderness, and is manufactured from high quality grain. We assume, *arguendo*, the sentence "Taste why Mueller's is America's favorite pasta" incorporates the attributes listed in the Paragraph into American's claim. Two attributes listed in the Paragraph are subject to verification: Mueller's is made from 100% pure semolina, and the brand is more than 130 years old. New World does not contend these claims are false. The remaining attributes listed in the Paragraph are unquantifiable and subject to an individual's fancy.

Notwithstanding the incorporation of these claims into "America's Favorite Pasta," the unverifiable attributes attenuate verifiable, and accurate, claims. "Taste why Mueller's is America's favorite pasta" suggests all of the attributes listed in the Paragraph are the reason Mueller's is "America's Favorite Pasta" and suggests each carries equal weight. The unquantifiable attributes coupled with two verifiable attributes do not render the phrase "America's Favorite Pasta" subject to verification.

Similarly, the Phrases do not convey a benchmark for "America's Favorite Pasta." The term "quality" is vague, entirely subjective, and a bare assertion of product superiority. In the context used, "quality" means "inherent or intrinsic excellence of character or type" or "superiority in kind." Webster's Third New International Dictionary 1858 (unabridged 1961). The only portion of "Quality Since 1867" that can be verified is "Since 1867," but "Since 1867" does not provide a methodology or a reason why Mueller's is America's favorite. The words simply state, accurately, when the brand was founded. Likewise, while presenting factual claims, the phrases "Made from 100% Semolina" and "Made with Semolina" do not define a methodology by which to ascertain the veracity of American's claim that

Mueller's is "America's Favorite Pasta." The two phrases simply, and correctly, list characteristics of the pasta.

C. Consumer Surveys

We now consider whether the results of New World's consumer survey transform the phrase "America's Favorite Pasta" into a specific, measurable claim. In its survey, New World asked consumers if the phrase "America's Favorite Pasta" conveyed a meaning. According to New World, thirty-three percent of those surveyed allegedly perceived the phrase "America's Favorite Pasta" to mean Mueller's is the number one brand. Fifty percent of those surveyed allegedly perceived the phrase "America's Favorite Pasta" to mean Mueller's is a national brand.

The Seventh Circuit confronted a similar question in Mead Johnson & Co. v. Abbott Laboratories, 201 F.3d 883 (7th Cir.), opinion amended on denial of reh'g, 209 F.3d 1032 (7th Cir. 2000). Having concluded the phrase "1st Choice of Doctors" conveyed more doctors prefer this product over its rivals, the Seventh Circuit considered whether a consumer survey can assign a different meaning to a phrase. Id. at 883-84. Mead Johnson's survey indicated consumers perceived the phrase "1st Choice of Doctors" to mean a majority of doctors. Concluding the district court erred in using the survey to assign such a meaning, the Seventh Circuit noted, "never before has survey research been used to determine the meaning of words, or to set the standard to which objectively verifiable claims must be held." Id. at 886. While acknowledging dictionaries are surveys by people who devote their entire lives to discovering the usage of words, the Seventh Circuit cogitated "[i]t would be a bad idea to replace the work of these professionals with the first impressions of people on the street." Id. The Seventh Circuit reasoned that using consumer surveys to determine the benchmark by which a claim is measured would remove otherwise useful words from products and would reduce ads and packaging to puffery. Id. at 886-87.

We agree with the Seventh Circuit. To allow a consumer survey to determine a claim's benchmark would subject any advertisement or promotional statement to numerous variables, often unpredictable, and would introduce even more uncertainty into the market place. A manufacturer or advertiser who expended significant resources to substantiate a statement or forge a puffing statement could be blind-sided by a consumer survey that defines the advertising statement differently, subjecting the advertiser or manufacturer to unintended liability for a wholly unanticipated claim the advertisement's plain language would not support. The resulting unpredictability could chill commercial speech, eliminating useful claims from packaging and advertisements. As the Seventh Circuit noted, the Lanham Act protects against misleading and false statements of fact, not misunderstood statements. Id. at 886.

III. CONCLUSION

For the foregoing reasons, we affirm.

Drawing Page

Serial Number:
78136706

[redacted]

Applicant:
Barilla Alimentare S.p.A.
Via Mantova 166
Parma PA Italy 43100

Goods and Services:
PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

Mark:

BARILLA - AMERICA'S #1 PASTA

DEPOSITION EXHIBIT
Applicant's #5
12/19/06 DS

[redacted]

NO OCR

[redacted]

Internet Transmission Date:
2002/06/18

Serial Number:
78136706

Filing Date:
2002/06/18

[redacted]

TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: $325

RAM SALE NUMBER: 133
RAM ACCOUNTING DATE: 20020619

[redacted]

NO OCR

[redacted]

<SERIAL NUMBER> 78136706
<FILING DATE> 06/18/2002

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME>	Barilla Alimentare S.p.A.
<STREET>	Via Mantova 166
<CITY>	Parma PA
<COUNTRY>	Italy
<ZIP/POSTAL CODE>	43100

<APPLICANT ENTITY INFORMATION>
<CORPORATION: STATE/COUNTRY OF INCORPORATION> Italy

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> BARILLA - AMERICA'S #1 PASTA
<TYPED FORM> Yes
* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). *

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>
<INTENT TO USE: SECTION 1(b)> Yes
* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) *
<INTERNATIONAL CLASS NUMBER> 030
<LISTING OF GOODS AND/OR SERVICES> PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

<ATTORNEY INFORMATION>

<NAME>	G. Franklin Rothwell, Esq.
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<COUNTRY>	USA
<ZIP/POSTAL CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040

<FAX NUMBER> 202-783-6031
<ATTORNEY DOCKET NUMBER> 2778-126
<OTHER APPOINTED ATTORNEY(S)> Robert H. Cameron; Anne M. Sterba

<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>
* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served *

<NAME>	G. Franklin Rothwell, Esq.
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<ZIP CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040
<FAX NUMBER>	202-783-6031

<FEE INFORMATION>
<TOTAL FEES PAID> 325
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>
<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>
* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. *

<SIGNATURE>	/Robert H. Cameron/
<DATE>	06/18/2002
<NAME>	Robert H. Cameron
<TITLE>	Attorney for Applicant

<MAILING ADDRESS>
<LINE> G. Franklin Rothwell, Esq.
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.
<LINE> 1425 K Street, NW
<LINE> Suite 800
<LINE> Washington DC 20005

<RAM INFORMATION>
<RAM SALE NUMBER> 133
<RAM ACCOUNTING DATE> 20020619

<SERIAL NUMBER INFORMATION>
<SERIAL NUMBER> 78/136706
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:47:06 EDT
<TEAS STAMP>
USPTO-12150177130-20020618164722902-78/136706-
124de3c7ddbdf84fb36b39936a341f7c902-RAM-133-20020618164622902
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmanning@rothwellfigg.com

Drawing Page

Serial Number:
78136708

[redacted]

Applicant:
Barilla Alimentare S.p.A.
Via Mantova 166
Parma PR Italy 43100

Goods and Services:
PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

Mark:

BARILLA - AMERICA'S PREFERRED PASTA

DEPOSITION EXHIBIT
Applicant's #6
12/13/06 DS

[redacted]

NO OCR

[redacted]

Internet Transmission Date:
2002/06/18

Serial Number:
78136708

Filing Date:
2002/06/18

[redacted]

TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

TOTAL FEES PAID: $325

RAM SALE NUMBER: 136
RAM ACCOUNTING DATE: 20020619

[redacted]

NO OCR

[redacted]

<SERIAL NUMBER> 78136708
<FILING DATE> 06/18/2002

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.24>

<APPLICANT INFORMATION>

<NAME>	Barilla Alimentare S.p.A.
<STREET>	Via Mantova 166
<CITY>	Parma PR
<COUNTRY>	Italy
<ZIP/POSTAL CODE>	43100

<APPLICANT ENTITY INFORMATION>
<CORPORATION: STATE/COUNTRY OF INCORPORATION> Italy

<TRADEMARK/SERVICEMARK INFORMATION>
<MARK> BARILLA - AMERICA'S PREFERRED PASTA
<TYPED FORM> Yes
* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). *

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>
<INTENT TO USE: SECTION 1(b)> Yes
* Applicant has a bona fide intention to use or use through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(b), as amended.) *
<INTERNATIONAL CLASS NUMBER> 030
<LISTING OF GOODS AND/OR SERVICES> PASTA, PASTA PRODUCTS, SAUCES FOR PASTA

<ATTORNEY INFORMATION>

<NAME>	G. Franklin Rothwell
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<COUNTRY>	USA
<ZIP/POSTAL CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040

<FAX NUMBER> 202-783-6031
<ATTORNEY DOCKET NUMBER> 2778-132
<OTHER APPOINTED ATTORNEY(S)> Anne M. Sterba; Robert H. Cameron

<DOMESTIC REPRESENTATIVE FOR FOREIGN APPLICANT>
* is hereby appointed applicant's representative upon whom notice or process in the proceedings affecting the mark may be served *

<NAME>	G. Franklin Rothwell
<STREET>	1425 K Street, NW Suite 800
<CITY>	Washington
<STATE>	DC
<ZIP CODE>	20005
<FIRM NAME>	Rothwell, Figg, Ernst & Manbeck, P.C.
<TELEPHONE NUMBER>	202-783-6040
<FAX NUMBER>	202-783-6031

<FEE INFORMATION>
<TOTAL FEES PAID> 325
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<LAW OFFICE INFORMATION>
<E-MAIL ADDRESS FOR CORRESPONDENCE> N/A

<SIGNATURE AND OTHER INFORMATION>
* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. *

<SIGNATURE>	/Robert H. Cameron/
<DATE>	06/18/2002
<NAME>	Robert H. Cameron
<TITLE>	Attorney for Applicant

<MAILING ADDRESS>
<LINE> G. Franklin Rothwell
<LINE> Rothwell, Figg, Ernst & Manbeck, P.C.
<LINE> 1425 K Street, NW
<LINE> Suite 800
<LINE> Washington DC 20005

<RAM INFORMATION>
<RAM SALE NUMBER> 136
<RAM ACCOUNTING DATE> 20020619

<SERIAL NUMBER INFORMATION>
<SERIAL NUMBER> 78/136708
<INTERNET TRANSMISSION DATE> Tuesday, 06-18-2002 16:50:14 EDT
<TEAS STAMP>
USPTO-12150177130-20020618165023026-78/136708-
124c59fb751b1b38bcda38f7aeedb856b55-RAM-136-20020618164923026
E-MAIL ADDRESS FOR ACKNOWLEDGMENT> bmanning@rothwellfigg.com

joie warner's spaghetti

-12808-4

ISBN 0-688-12808-4 FPT $12.00

joie warner's spaghetti

america's favorite pasta

PHOTOGRAPHS BY DREW WARNER

one the heavy cream, the oily tomato paste—Joie Warner has created fast, fresh, and fabulous contemporary classics, all epared by the time the spaghetti is *al te*. Here spaghetti is tossed with today's favorites—goat cheese and olive oil, capers and Kalamata olives, sun-dried tomatoes and eggplant, Parmesan and basil—all full flavored and fresh! fresh! fresh!

There's something for everyone and for any time of day—even a spaghetti dessert. Kids will clamor for fun-to-open Spaghetti Packages, the luncheon crowd will love spaghetti-stuffed tomatoes, the sophisticated set will swoon over Spaghetti with Smoked Salmon, Capers, and Dill, and vegetarians will think they've died and gone to heaven—there's not one sauce with meat in the tempting array of wonderful sauces Joie has included.

Once you've tried them, you'll want to rewrite Omar Khayyam—A Jug of Wine, a Loaf of Bread—a bowl of spaghetti—and Thou!

DEPOSITION EXHIBIT
Applicant's 7
12/19/96 DS

2 lb.
FAMILY SIZE

MUELLER'S
Quality Since 1867

America's Favorite Pasta

Spaghetti

ENRICHED SPAGHETTI PRODUCT
MADE WITH NORTH AMERICAN GROWN DURUM WHEAT

NET WT 32 OZ (2 LB) 908 g

COOKING TIME 10-11 MINUTES

American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 2

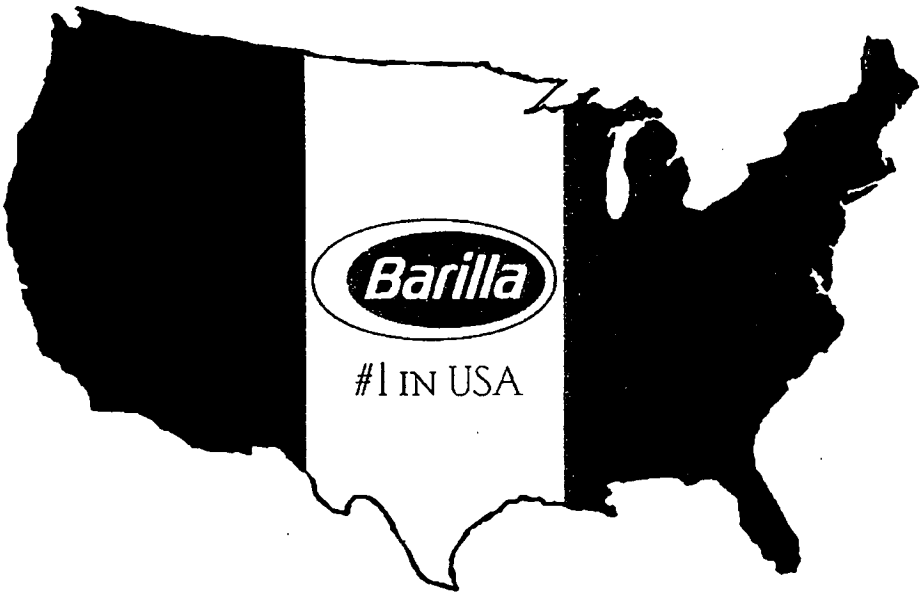
DEPOSITION EXHIBIT
Applicant #8
12/9/06 DS

A011594

SOURCE: ACNielsen - Dry Pasta Category - SCANTRACK Total U.S. - 4 weeks ending 10/3/98

©1998 Barilla America, Inc.

BRAVO!

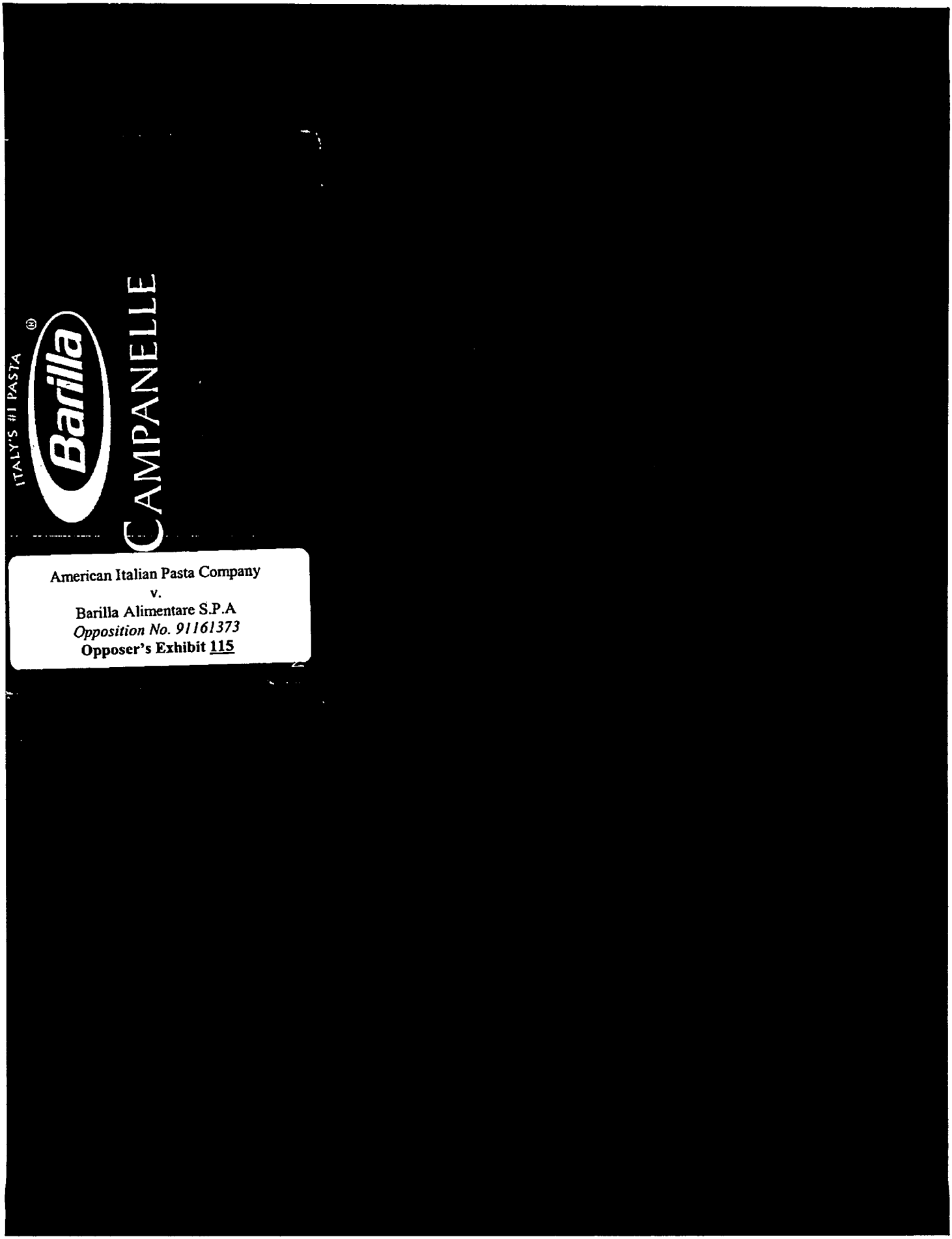


Ed Critst Guido Barilla.

NOW THE #1 PASTA IN ITALY IS ALSO THE #1 PASTA IN AMERICA.
THANKS TO EVERYONE WHO HELPED MAKE THAT HAPPEN IN JUST 3 YEARS.

DEPOSITION EXHIBIT
Applicant's #9
12/19/06 DS 10

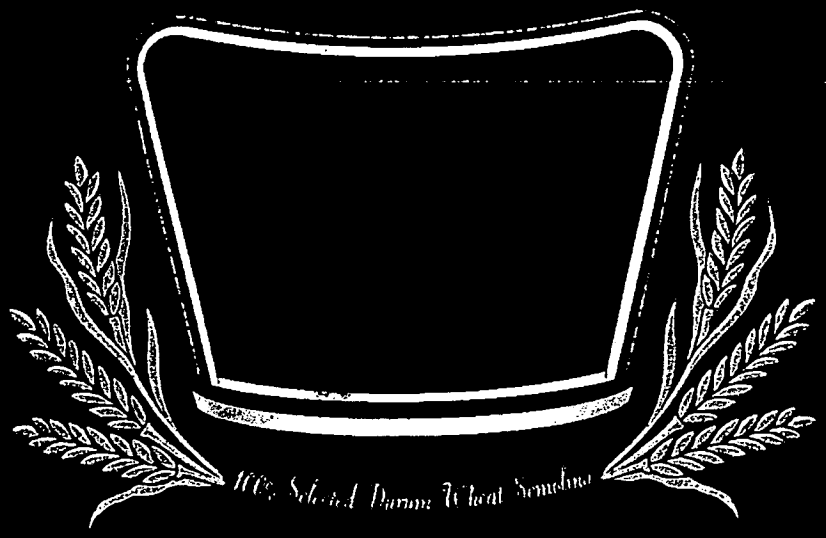
American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 78



American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 115

ITALY'S #1 PASTA

Barilla®



CAMPANELLE

"Al Dente" Perfection in 10-12 Minutes

1 LB
(454g)

American Italian Pasta v. Barilla
Opposition No. 91/161,373
Opposer Deposition Exh. 115 Page 2 of 2

United States Patent Office

897,460
Registered Aug. 25, 1970

PRINCIPAL REGISTER
Trademark

Ser. No. 337,215, filed Sept. 5, 1969

Barilla G. e R. F.lli S.p.A. (Italian corporation)
3, Viale Veneto
Parma, Italy

For: PASTA, in CLASS 46 (INT. CL. 30).
Owner of Italian Reg. No. 231,675, dated Aug. 8, 1968.

A. G. DIETZ, Examiner

American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 116

Int. Cls.: 30 and 42

Prior U.S. Cls.: 46, 100 and 101

Reg. No. 2,657,872

United States Patent and Trademark Office

Registered Dec. 10, 2002

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER

BARILLA ALIMENTARE S.P.A. (ITALY JOINT STOCK COMPANY)
VIA MANTOVA 166
43100 PARMA, ITALY

FOR: READY-MADE AND PRE-PREPARED DISHES BASED ON PASTA, IN CLASS 30 (U.S. CL. 46).

FOR: RESTAURANT AND CATERING SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

OWNER OF ITALY REG. NO. 826277, DATED 5-12-2000, EXPIRES 5-12-2010.

OWNER OF U.S. REG. NOS. 897,460, 2,005,752 AND OTHERS.

THE MARK CONSISTS OF THE WORD "BARILLA" IN STYLIZED WHITE LETTERS INSIDE AN ELONGATED RED OVAL WHICH IS INSIDE A LARGER ELONGATED WHITE OVAL OUTLINED IN RED. THE COLORS RED AND WHITE ARE CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 76-093,283, FILED 7-21-2000.

ELIZABETH HUGHITT, EXAMINING ATTORNEY

American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 117

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 2,005,752
Registered Oct. 8, 1996

TRADEMARK
PRINCIPAL REGISTER

BARILLA

BARILLA ALIMENTARE S.P.A. (ITALY JOINT STOCK COMPANY)
VIALE R. BARILLA 3/A
43100 PARMA, ITALY

FOR: FLOUR AND PREPARATIONS MADE FROM CEREALS, BREAD, BREADSTICKS, RUSKS, CRACKERS; PASTA, IN CLASS 30 (U.S. CL. 46).

FIRST USE 0-0-1900; IN COMMERCE 0-0-1965.

OWNER OF U.S. REG. NOS. 897,460, 1,308,222, AND 1,432,123.

SEC. 2(F).

SER. NO. 74-678,653, FILED 5-22-1995.

DARREN COHEN, EXAMINING ATTORNEY

American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 118

Int. Cls.: 29, 30, 35 and 43

Prior U.S. Cls.: 46, 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,964,682
Registered July 5, 2005

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER

BARILLA G. E R. FRATELLI - SOCIETA PER AZIONI (ITALY CORPORATION)
VIALE RICCARDO E PIETRO BARILLA 3/A
PARMA, ITALY

FOR: MEAT, FISH, POULTRY AND GAME; MEAT EXTRACTS; PRESERVED, DRIED AND COOKED FRUITS AND VEGETABLES; JELLIES, JAMS, COMPOTES; EGGS, MILK AND MILK BASED PRODUCTS, NAMELY DAIRY PRODUCTS, EXCLUDING ICE CREAM, ICE MILK AND FROZEN YOGURT; EDIBLE OILS AND FATS, IN CLASS 29 (U.S. CL. 46).

FOR: COFFEE, TEA, COCOA, SUGAR, RICE, TAPIOCA, SAGO, ARTIFICIAL COFFEE; FLOUR AND PREPARATIONS MADE FROM CEREALS, NAMELY CEREAL-BASED SNACK FOODS, BREAKFAST CEREALS, READY-TO-EAT CEREAL DERIVED FOOD BARS, BREAD, PASTA, BISCUITS, PASTRY AND CONFECTIONERY, NAMELY CANDIES, ICES; HONEY, TREACLE; YEAST, BAKING-POWDER; SALT, MUSTARD; VINEGAR, SAUCES, CONDIMENTS; SPICES; ICE, IN CLASS 30 (U.S. CL. 46).

FOR: ADVERTISING; BUSINESS MANAGEMENT IN FRANCHISING; RESTAURANT FRANCHISING; BUSINESS ADMINISTRATION; OFFICE FUNCTIONS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FOR: SERVICES FOR PROVIDING FOOD AND DRINK; PROVIDING TEMPORARY ACCOMMODATION, IN CLASS 43 (U.S. CLS. 100 AND 101).

OWNER OF ITALY REG. NO. 899753, DATED 6-26-2003, EXPIRES 6-13-2013.

OWNER OF U.S. REG. NOS. 897,460, 2,657,872 AND OTHERS.

THE COLOR(S) RED AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE WORD BARILLA IN STYLIZED WHITE LETTERS INSIDE AN ELONGATED RED OVAL WITH A WHITE FADE IN THE UPPER LEFT SIDE; THE ELONGATED RED OVAL IN TURN IS INSIDE A LARGER ELONGATED WHITE OVAL OUTLINED IN RED, WITH A WHITE FADE IN THE UPPER LEFT AND LOWER RIGHT OF THE RED OUTLINE.

SER. NO. 76-570,344, FILED 1-15-2004.

CHERYL STEPLIGHT, EXAMINING ATTORNEY

American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 119

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 2,790,465

United States Patent and Trademark Office

Registered Dec. 9, 2003

TRADEMARK
PRINCIPAL REGISTER

ITALY'S #1 PASTA

BARILLA ALIMENTARE S.P.A. (ITALY CORPORATION)
VIA MANTOVA 166
PARMA, ITALY 43100

FOR: PASTA, PASTA PRODUCTS, NAMELY PENNE LISCE, PENNETTE RIGATE, LINGUINE, CAPELLINI, LINGUINE FINI, SPAGHETTI, THIN SPAGHETTI, FARFALLE, ROTINI, RIGATONI, CONCHIGLIE RIGATE, PENNE RIGATE, TORTIGLIONI, GEMELLI, FETTUCCINE, SAUCES FOR PASTA, IN CLASS 30 (U.S. CL. 46).

FIRST USE 0-0-1996; IN COMMERCE 0-0-1996.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PASTA", APART FROM THE MARK AS SHOWN.

SEC. 2(F) AS TO "ITALY'S #1".

SER. NO. 76-422,402, FILED 6-19-2002.

GEORGIA CARTY, EXAMINING ATTORNEY

American Italian Pasta Company
v.
Barilla Alimentare S.P.A
Opposition No. 91161373
Opposer's Exhibit 120