

ESTTA Tracking number: **ESTTA33271**

Filing date: **05/17/2005**

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

Notice of Opposition

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

Opposer Information

Name	Yoo-Hoo Chocolate Beverage Corp.
Granted to Date of previous extension	05/18/2005
Address	900 King Street Rye Brook, NY 10573 UNITED STATES

Attorney information	Barbara A. Solomon, Esq. Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES bsolomon@frosszelnick.com Phone:212-813-5900
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Applicant Information

Application No	76549829	Publication date	01/18/2005
Opposition Filing Date	05/17/2005	Opposition Period Ends	05/18/2005
Applicant	COTT CORPORATION 207 Queen's Quay West Suite 340 Toronto, Ontario, M5J 1A7		

CANADA

Goods/Services Affected by Opposition

Class 032.

All goods and services in the class are opposed, namely: NON-ALCOHOLIC BEVERAGES, NAMELY, CARBONATED AND NON-CARBONATED SOFT DRINKS, FRUIT DRINKS; WATER BEVERAGES, NAMELY, SPRING WATER, FLAVORED DRINKING WATER, PURIFIED DRINKING WATER AND FILTERED WATER

Attachments	NOTICE OF OPPOSITION.pdf (7 pages)
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Signature	/s/
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Name	Barbara A. Solomon, Esq.
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Date	05/17/2005
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 76/549,829
Mark: YAZOO
Filed: October 8, 2003
Published in the *Official Gazette* on January 18, 2005

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Mott's LLP, :
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 Opposer, :
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 - against - :
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 COTT CORPORATION, :
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 Applicant. :
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NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BOX TTAB - FEE

Opposer, Mott's LLP ("Opposer"), a limited liability company organized and existing under the laws of Delaware, with its principal place of business at 900 King Street, Rye Brook, New York, 10573, believes that it would be damaged by the issuance of a registration for the trademark YAZOO, applied for in intent-to-use application Serial No. 76/549,829 by Cott Corporation ("Applicant"), for "non-alcoholic beverages, namely carbonated and non-carbonated soft drinks, fruit drinks; water beverages, namely, spring water, flavored drinking water, purified drinking water and filtered water" in International Class 32, and therefore opposes the same. As grounds for the opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is the successor-in-interest, through a merger and change of name, to Yoo-Hoo Chocolate Beverage Corp.

2. Since at least as early as the 1920s and continuing through the present, Opposer and/or its predecessors have used the mark YOO-HOO on beverage products, which now include Yoo-Hoo Chocolate Drink, Yoo-Hoo Lite Chocolate Drink, Yoo-Hoo Strawberry and Yoo-Hoo Double Fudge.

3. YOO-HOO brand beverages are sold in convenience stores, delis, supermarkets, mass merchandisers, wholesale clubs and gas stations throughout the United States. During 2002, the year preceding the application filing date, in excess of 260 million bottles and cans of YOO-HOO beverages were distributed. In the period 2003 through 2004, Opposer and its predecessors distributed hundreds of millions of bottles and cans of YOO-HOO brand product throughout the U.S. with sales in excess of \$180 million.

4. Opposer and its predecessors have devoted and continue to devote significant resources to advertise and market YOO-HOO brand beverages throughout the United States. The YOO-HOO brand is advertised on television, radio, outdoor media, and local events as well as through coupons, in-store promotions, and give-aways. The YOO-HOO marks are used on ancillary goods such as candy and clothing to further promote the brand. Opposer and its predecessors have spent millions of dollars on advertising and marketing featuring the YOO-HOO Marks.

5. Opposer, as the successor-in-interest to Yoo-Hoo Chocolate Beverage Corp., owns the following U.S. registrations YOO-HOO for beverages (collectively the “YOO-HOO Marks”):

<u>Reg. No.</u>	<u>Mark</u>	<u>Dates</u>	<u>Goods</u>
*507,891	YOO-HOO (Stylized)	Reg. 3/11/1949 Use 7/03/1922	Nonalcoholic maltless beverage sold as a soft drink
*887,958	YOO-HOO	Reg. 3/17/1970 Use 3/22/1949	chocolate flavored food beverage

<u>Reg. No.</u>	<u>Mark</u>	<u>Dates</u>	<u>Goods</u>
*1,833,990	YOO-HOO	Reg. 5/03/1994 Use 7/03/1922	non-alcoholic beverage sold as a soft drink

Assignment of these registrations to Opposer were filed on May 16, 2005. These registrations are valid, subsisting, and in full force and effect and, further, are incontestable under 15 U.S.C. § 1065. As such, these registrations serve as conclusive evidence of Opposer's exclusive rights to use the marks on soft drinks and beverages as specified therein.

6. In addition to the YOO-HOO Marks for beverages, Opposer through its predecessors owns registrations for YOO-HOO for frozen confections, namely ice cream, ice milk, frozen yogurt, ices and sherbets (Reg. No. 1,870,718), and for candy (Reg. No. 2,171,406). Both of these registrations issued and the marks have been in use prior to any date on which Applicant can rely. Use of the YOO-HOO mark on these goods serves to reinforce the exclusive association between the YOO-HOO mark and goods offered by Opposer or its predecessors.

7. Through its years of use and advertising and as a result of the expenditure of significant resources by Opposer and its predecessors-in-interest, the YOO-HOO Marks have come to be associated uniquely with Opposer, represent enormous goodwill of Opposer and identify and distinguish the goods of Opposer from those of others.

8. Upon information and belief, Applicant is a Canadian corporation with a principal place of business at 207 Queen's Quay West, Suite 340, Toronto, Ontario, M5J 1A7 Canada.

9. On or about October 8, 2003, Applicant filed an intent-to-use application for the mark YAZOO for "non-alcoholic beverages, namely carbonated and non-carbonated soft drinks, fruit drinks; water beverages, namely, spring water, flavored drinking water, purified drinking water and filtered water" in International Class 32.

10. Applicant is a direct competitor of Opposer. As a competitor, Applicant was on actual notice of Opposer's and its predecessors' prior rights in the YOO-HOO Marks and the fame of the YOO-HOO Marks in connection with beverages. In addition, as a matter of law Applicant was on constructive notice of Opposer's rights in the YOO-HOO Marks based on the registrations of YOO-HOO owned by Opposer's predecessors-in-interest.

11. Applicant's filing date, and the only date on which it can rely, is decades after the use, registration and acquisition of rights in the YOO-HOO Marks by Opposer or its predecessors-in-interest. As such, Opposer's rights in its YOO-HOO Marks are prior and superior to any rights Applicant can claim in the mark YAZOO.

12. Opposer's YOO-HOO mark is entitled to an extremely broad scope of protection. The YAZOO mark adopted by Applicant, with notice of the YOO-HOO Marks, is substantially similar to Opposer's prior used and registered trademark with respect to sound and appearance. Both Applicant's YAZOO mark and the YOO-HOO Marks are two-syllable marks starting with the letter "Y" and ending with a double "O."

13. Applicant's YAZOO mark does not have any commercial meaning. Given the fame of the YOO-HOO Marks, consumers will attribute to Applicant's YAZOO mark the same commercial impression created by Opposer's YOO-HOO Marks.

14. The goods identified in Applicant's application, namely non-alcoholic beverages including carbonated and non-carbonated soft drinks and fruit drinks and water beverages, are identical if not related to the beverages that Opposer and its predecessors have been offering for over 80 years under the YOO-HOO Marks as well as being identical if not substantially related to the goods identified in Opposer's incontestable trademark registrations for the YOO-HOO Marks.

15. Applicant has not restricted its customers or channels of trade and thus it is presumed that Applicant will sell its goods under the YAZOO mark to Opposer's very customers through similar channels of trade used by Opposer. Given the renown of Opposer's YOO-HOO Marks, Applicant's registration and use of a mark that is almost identical to Opposer's mark in connection with related if not identical goods sold through the same channels of trade to the same consumers is likely to cause confusion.

16. Based on the similarities of the parties' marks and goods, as well as the strength of the YOO-HOO Marks, the public is likely to associate the beverages sold by Applicant under the mark YAZOO with Opposer or with Opposer's YOO-HOO brand beverages or to believe that Applicant's beverages are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

17. Registration of Applicant's mark is inconsistent with Opposer's prior rights in its YOO-HOO Marks, is inconsistent with Opposer's statutory grant of exclusivity of use of the registered YOO-HOO Marks, and would destroy Opposer's investment and goodwill in its YOO-HOO Marks.

CLAIM FOR RELIEF UNDER SECTION 2(d)

18. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 17 as if fully set forth herein.

19. The YOO-HOO Marks are associated exclusively with Opposer and its predecessors-in-interest and have been used continuously and registered by Opposer or its predecessors since a date long prior to any date on which Applicant can rely.

20. Applicant's mark YAZOO trades on and is a colorable imitation of Opposer's prior registered and prior used YOO-HOO Marks and is sought to be registered for goods identical if not related to those offered under the YOO-HOO Marks.

21. By virtue of the use of the YOO-HOO Marks by Opposer and its predecessors, the goodwill associated with Opposer's marks, the registrations owned by Opposer for the YOO-HOO Marks, and the fame of the YOO-HOO Marks, the registration by Applicant of YAZOO for goods identical or substantially related to those provided by Opposer or its predecessors under the YOO-HOO Marks is likely to create the erroneous impression that Applicant's beverages originate from, come from or are otherwise associated with Opposer or that Applicant's beverages are endorsed, sponsored or in some way connected with Opposer. Registration of the mark YAZOO in connection with the goods set forth in Application S.N. 76/549,829 is likely to cause confusion, cause mistake, or to deceive the public into the belief that the beverages offered by Applicant under the mark YAZOO come from or are otherwise sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

22. By reason of the foregoing, Opposer is likely to be harmed by registration of Application S.N. 76/549,829 for the mark YAZOO.

CLAIM FOR RELIEF UNDER SECTION 2(f)

23. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 17 as if fully set forth herein.

24. Opposer's YOO-HOO Marks are inherently distinctive, have been used for over 80 years in connection with goods sold and advertised nationally, have become famous among consumers, and are the subject of numerous incontestable federal trademark registrations. As a result, the marks are famous marks under the Lanham Act.

25. Applicant's application to register YAZOO was filed after Opposer's YOO-HOO Marks became famous.

26. Registration of the mark YAZOO to Applicant would dilute the distinctive quality of Opposer's YOO-HOO Marks in that the registration of YAZOO would lessen the capacity of

the YOO-HOO Marks to identify and distinguish goods exclusively from Opposer.

27. Registration of the mark YAZOO is likely to dilute the YOO-HOO Marks in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

28. By reason of the foregoing, Opposer is likely to be harmed by registration of Application S.N. 76/549,829 for the mark YAZOO.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicant in Application S.N. 76/549,829 be denied.

Opposer authorizes the opposition fee in the amount of \$300.00 for one class to be debited from Opposer's attorneys' Deposit Account No. 23-0825-0576900.

Dated: New York, New York
May 17, 2005

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

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