

FTAB

**LADAS & PARRY LLP**  
INTELLECTUAL PROPERTY LAW

John E. McKie



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July 15, 2005

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

Re: *Snackmasters, Inc. v. Hickory Farms, Inc*  
Opposition No. 91165467  
Application No. 78/421981  
Mark Opposed: **TURKEY STICK**

Dear Madam:

Enclosed for filing please find the following:

1. Applicant's Answer to Opposer's Notice of Opposition;
2. Applicant's Certificate of Service;
3. Certificate of Mailing; and
4. Return Receipt Postcard.

Please affix your date stamp to the enclosed return-receipt postcard to evidence your receipt of the above items. The Commissioner is authorized to charge any additional fees associated with this case or credit any overpayment to Deposit Account 12-0400.

Very truly yours,

John E. McKie

JEM/rw  
Encl.: as recited above  
S:/RobertW/TURKEY STICK Opp 7-15-05



07-19-2005

U.S. Patent & TMO/c/TM Mail RcptDt. #57

**CERTIFICATE OF MAIL (37 CFR 1.10)**

**Date of Deposit:** July 15, 2005  
**Applicant:** Hickory Farms, Inc.  
**Application No.** 78/421981  
**Mark Opposed:** TURKEY STICK  
**Opposer:** Snackmasters, Inc.  
**Opposition No.** 91165467  
**Documents:** Applicant's Answer to Opposer's Notice of Opposition;  
Applicant's Certificate of Service; and Return Receipt  
Postcard.

I hereby certify that these documents and fees are being deposited with the United States Postal Service First Class Mail under 37 CFR 1.10 on the date indicated above and is addressed to:

The Honorable Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451



John E. McKie

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

Published Application No. 78421981  
Published Mark: **TURKEY STICK**

Snackmasters, Inc.  Opposer,  - against -  Hickory Farms, Inc.  Applicant.
--

Opposition No. 91165467

**ANSWER**

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

**APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION**

In response to the Notice of Opposition pleaded and filed by Snackmasters, Inc. ("Opposer"), as issued by the Board, Applicant Hickory Farms, Inc. ("Applicant") hereby pleads and answers as follows:

1. Applicant admits the allegations of asserted Paragraph 1 of the Notice of Opposition, with the exception that Applicant's first use anywhere and in commerce of TURKEY STICK was at least as early as June 1991.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted Paragraph 2 of the Notice of Opposition, and therefore denies them, except that the Applicant specifically denies Opposer's reference to the Applicant's mark in a generic manner.
3. Applicant denies the allegations of asserted Paragraph 3 of the Notice of Opposition, and in particular Opposer's attempt to generically refer to Applicant's mark.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted Paragraph 4 of the Notice of Opposition, and therefore denies them, except that Applicant specifically denies the generic assertions of Applicant's mark in its paragraph.

5. Applicant denies the allegations of asserted Paragraph 5 of the Notice of Opposition.

6. Applicant admits the allegations of Paragraph 6 of the Notice of Opposition as applied to Applicant's products. Otherwise, Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters asserted, and therefore denies them.

7. Applicant denies the allegations of asserted Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations of asserted Paragraph 8 of the Notice of Opposition.

9. Applicant admits that registration of TURKEY STICK would provide a prima facie exclusive right to use thereof, but otherwise denies the allegations of Paragraph 9 of the Notice of Opposition.

10. Applicant admits that it provided Opposer with a written notice claiming ownership and exclusive rights in the mark BEEF STICK under the '260 Registration, and demanding that Opposer cease and desist from any further use of the mark BEEF STICK, as set forth in Exhibit A hereto. Otherwise, the allegations in Paragraph 10 are denied.

11. Applicant denies the allegations asserted in Paragraph 11 of the Notice of Opposition.

**RELIEF REQUESTED**

WHEREFORE, Applicant requests that the Opposition brought by Opposer be dismissed, with prejudice, and that this application proceed onto issuance of the certificate of registration.

Respectfully submitted,

**HICKORY FARMS, INC**

By: 

Burton S. Ehrlich  
John E. McKie  
**Ladas & Parry LLC**  
224 S. Michigan Avenue  
Chicago, IL 60604-2505  
Attorneys for Applicant  
Telephone: 312-427-1300

Dated: July 15, 2005.

# **EXHIBIT A**

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**LADAS & PARRY LLP**

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80335 MUNICH, GERMANY

February 16, 2005

Mr. James Rekoutis  
**SnackMasters, Inc.**  
3861 Brickitt Court, Suite A  
Ceres, CA 95307

**VIA OVERNIGHT DELIVERY**

Re: **Hickory Farms, Inc.**  
Demand Against SnackMasters, Inc.'s Use of  
**BEEF STICK® & TURKEY STICK**  
U.S. Trademark Reg. No. 875,260, **BEEF STICK**

Dear Mr. Rekoutis:

Please be advised that we represent Hickory Farms, Inc. of Maumee, Ohio in its trademark matters. For over 50 years, Hickory Farms has sold a variety of gift and other packaged foods.

One of their most popular products is Hickory Farms' BEEF STICK® and TURKEY STICK summer sausage. Through its long and successful efforts over many years in the marketplace, Hickory Farms has earned a reputation and recognition for quality in BEEF STICK® and TURKEY STICK brand summer sausage.

As you may also know, Hickory Farms, Inc. owns the BEEF STICK registered trademark, which is the subject of U.S. Trademark Registration Number 875,260. We enclose a copy of the particulars of this registration for your information. The registration dates to 1968 and is incontestable. Use of this mark (and of the TURKEY STICK mark) dates back to 1955. The incontestable registration evidences Hickory Farms' exclusive right to use the trademark BEEF STICK.

Hickory Farms regularly monitors the marketplace to detect any misuse of its marks. As part of its regular monitoring efforts, Hickory Farms has just been notified that your company SnackMasters is using Hickory Farms' trademark BEEF STICK and TURKEY STICK, as illustrated by the attached which we

enclose for your convenience. This use by your company of BEEF STICK and of TURKEY STICK is unauthorized by Hickory Farms.

The use of BEEF STICK and of TURKEY STICK by your company will inevitably cause confusion with the genuine BEEF STICK and TURKEY STICK. Affected consumers exposed to these designations will naturally be misled into believing that your company's goods originate from, or are sponsored, approved or endorsed in some fashion by Hickory Farms, owner of the BEEF STICK and TURKEY STICK trademarks.

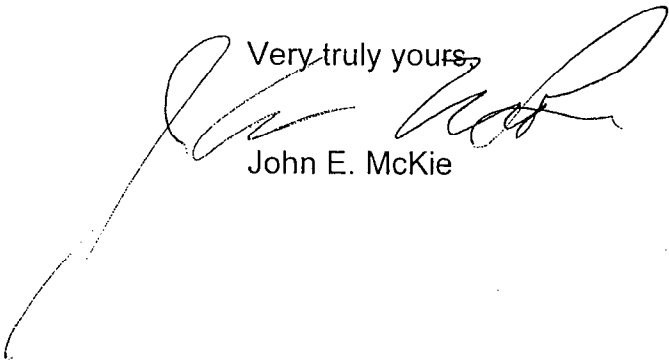
On behalf of Hickory Farms, we now hereby formally request your voluntary cooperation in doing the following, at least by **March 5, 2005**, to resolve this matter:

1. Cease and desist from all current and future use of BEEF STICK and of TURKEY STICK and any confusingly similar designation whether alone or in combination with other marks, whether on product packaging or elsewhere.
2. Agree to remove promptly all references to BEEF STICK and of TURKEY STICK or similar terms from your promotional materials and all product packaging.
3. Provide us your company's written assurances of compliance with the above points.

At this point we presume that your company generally respects the rights of others, and that for some reason this incident has occurred without your knowledge of the above facts. Your prompt discontinuation detailing the steps you have taken, together with your assurance of corrective action, will allow this matter to be concluded amicably. However, your corrective action is required to right this matter.

We look forward to your early response.

Very truly yours,

  
John E. McKie

JEM/rw  
Enclosures  
S:/RobertW/BEEF STICK C&D 2-16-05



Int. Cl.: 29

Prior U.S. Cl.: 46

United States Patent and Trademark Office  
10 Year Renewal

Reg. No. 875,260  
Registered Aug. 19, 1969  
Renewal Approved Apr. 23, 1990

**TRADEMARK  
PRINCIPAL REGISTER**

**BEEF STICK**

HICKORY FARMS, INC. (DELAWARE  
CORPORATION)  
1505 HOLLAND ROAD  
MAUMEE, OH, ASSIGNEE BY MESNE  
ASSIGNMENT RANSOM, RICHARD K.  
(UNITED STATES CITIZEN), DBA  
HICKORY FARMS OF OHIO,  
TOLEDO, OH

APPLICANT DISCLAIMS THE WORD  
"BEEF" APART FROM THE MARK AS  
SHOWN.

FOR: SUMMER SAUSAGE, IN CLASS  
46 (INT. CL. 29).

FIRST USE 5-0-1955; IN COMMERCE  
5-0-1955.

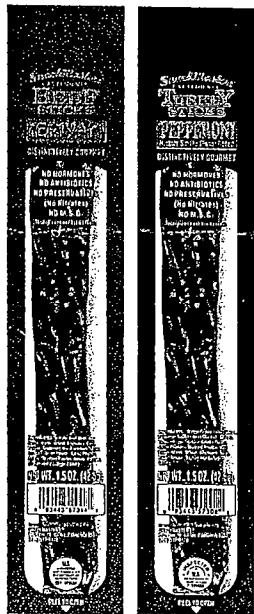
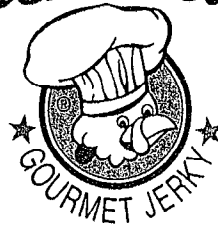
SER. NO. 72-290,646, FILED 2-8-1968.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on June 5, 1990.*

COMMISSIONER OF PATENTS AND TRADEMARKS

# INTRODUCING

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**NEW  
ITEM!**

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*Tastes Great!*

*SnackMasters Turkey and Beef Sticks are Preservative Free,  
No Hormones, No Antibiotics, No M.S.G.  
No Artificial Colors or Flavor Enhancers, ever!*

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**LADAS & PARRY LLP**

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DACHAUERSTRASSE 37  
80335 MUNICH, GERMANY

March 21, 2005

Via Courier

R. Michael West, Esq.  
**Law Offices of R. Michael West**  
455 Capitol Mall, Suite 405  
Sacramento, California 95814

Re: Hickory Farms, Inc. – SnackMasters, Inc.'s Unauthorized Use  
of the BEEF STICK and TURKEY STICK Trademarks  
U.S. Trademark Registration No. 875260, Mark: BEEF STICK

Dear Mr. West:

Thank you for your letter of February 24, 2005, advising that SnackMasters, Inc. respects other parties' trademark rights, and that it was, in commencing use of the designations BEEF STICK and TURKEY STICK, apparently unaware of Hickory Farms, Inc.'s trademark rights.

With this in mind, on Hickory Farms' behalf we renew our call for SnackMasters, Inc. to honor those rights and cease its unauthorized use of the BEEF STICK and TURKEY STICK trademarks.

The Internet references you provided fall far short of demonstrating that these long registered and long respected marks are generic. These stray and unfounded references, of which we were previously unaware, are insufficient to indicate that the parties are even using those designations, let alone support the conclusion that Hickory Farms' BEEF STICK trademark is generic, an affirmative defense which is rightly subject to a difficult burden of proof, particularly in view of the registration's incontestability. To be generic, the registered term's primary significance to the relevant consuming public must be shown to be as a generic term, and proving the perception of the relevant public is only properly done through extensive evidence of long term use and recognition as a category designation. There is no dictionary or other reference work evidence of such use, no surveys, and Hickory Farms is convinced as a factual matter summer sausage is not known to the consuming public as BEEF STICK or Turkey STICK. These marks just are not known as category designations for summer sausage, and there are many other names and designations available to readily and accurately identify your product besides Hickory Farms' own marks. We also add that your client's

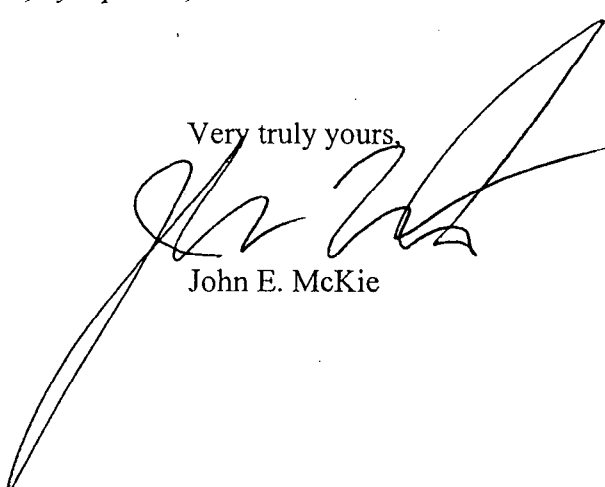
actual use of the marks BEEF STICKS and TURKEY STICKS on packaged product in the marketplace has come to Hickory Farms' attention, and SnackMasters at least has made no denial of its own use. This misuse is more like a trademark than some of these misuses to which Hickory Farms had not previously been alerted. For both these reasons, therefore, SnackMasters' use concerns Hickory Farms more immediately.

Hickory Farms has long and widespread use of these marks and has built up a valuable reputation in these marks. It has successfully taken action over the years to bring its rights to the attention of others, and once others are put on notice of Hickory Farms' rights who policed its mark over the years, they have done the right thing and discontinued the offending use of these marks. Hickory Farms is convinced that continued use by SnackMasters stands to profit off Hickory Farms' marks, their recognition, and Hickory Farms' reputation. If these apparently recent third party uses are actual uses in the marketplace, they show nothing more than the fact that Hickory Farms' marks and its marked products are popular, attractive, and subject to poaching by others.

Based upon your assurances that SnackMasters has acted in good faith, we call upon your client SnackMasters, Inc. to promptly cease the unauthorized use of the BEEF STICK and TURKEY STICK marks. With your prompt confirmation of a switchover, Hickory Farms, Inc. would be amenable to allowing a reasonable period to exhaust its existing supply of products and materials which bear the designations; and, barring any further incidence of or information evidencing infringement of Hickory Farms' rights, consider the matter closed on this basis. SnackMasters, Inc. may, without admission or prejudice, easily indicate its willingness to resolve the matter along these lines by executing and returning the enclosed extra copy of this letter.

We look forward to hearing from you with SnackMasters' assurances of corrective action soon, and in any event, by April 15, 2005.

Very truly yours,



John E. McKie

Agreed and Accepted,

**SnackMasters, Inc.**

By: \_\_\_\_\_

Date: \_\_\_\_\_

Name: \_\_\_\_\_

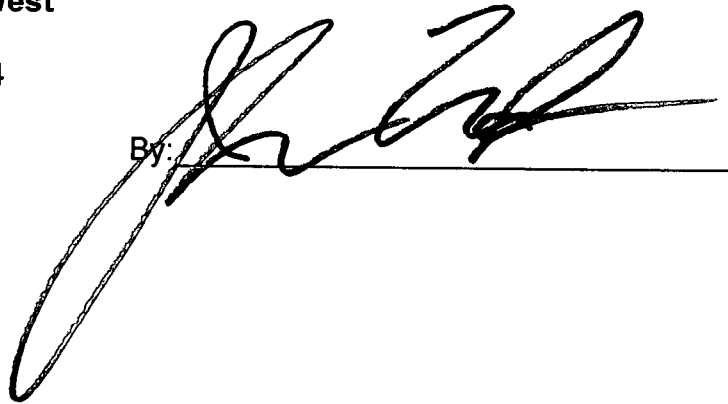
Title: \_\_\_\_\_

**Certificate of Service**

The undersigned, one of Applicant's attorneys, hereby certifies that he caused a true and correct copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION to be served upon Opposer's counsel by deposit in the U.S. mail, first class postage pre-paid, on this <sup>15th</sup> day of July 2005 at the following address:

R. Michael West  
**Law Offices of R. Michael West**  
455 Capitol Mall, Suite 405  
Sacramento, California 95814

By: \_\_\_\_\_

A large, stylized handwritten signature in black ink, written over a horizontal line. The signature is highly cursive and appears to be the name of the undersigned attorney.