

ESTTA Tracking number: **ESTTA111027**

Filing date: **11/22/2006**

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	KELLOGG NORTH AMERICA COMPANY
Granted to Date of previous extension	11/22/2006
Address	One Kellogg Square PO Box 3599 Battle Creek, MI 49016 UNITED STATES
Correspondence information	DAVID A HERDMAN ASSISTANT SECRETARY/CORPORATE COUNSEL KELLOGG NORTH AMERICA COMPANY One Kellogg Square PO Box 3599 Battle Creek, MI 49016 UNITED STATES trademarks@kellogg.com Phone:269-961-2170

Applicant Information

Application No	76646016	Publication date	07/25/2006
Opposition Filing Date	11/22/2006	Opposition Period Ends	11/22/2006
Applicant	Marquez Brothers International, Inc. 5801 Rue Ferrari San Jose, CA 951381857 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 029. All goods and services in the class are opposed, namely: Cheese, cream, cream cheese, cheese spreads, milk, fish, sardines, pork, sausages, chili, processed nuts, pork rinds, canned fruits, fruit paste, soups, soup mixes, processed beans, dried beans, processed peppers, processed tomatoes, canned vegetables, processed edible seeds, edible processed cactus, cooking oil, edible oil, vegetable oil, vegetable based food beverages, unflavored and unsweetened gelatins, candied fruits, candied nuts, chocolate milk, clam juice, eggnog, eggnog mixes, fruit preserves, fruit pectin, fruit preserves, processed vegetables</p>
<p>Class 030. All goods and services in the class are opposed, namely: Chewing gum, flavored and sweetened gelatins, honey, pasta shells, rice, tortillas, tortilla chips, corn chips, salsa, cheese sauce, tomato sauce, spices, processed herbs, bakery products, bakery goods, bakery desserts, breakfast cereals, cake mixes, chili sauce, chili seasoning, chocolate food beverages not dairy or vegetable based, chocolate powder, chocolate syrup, chutney, cinnamon, coffee beans, crackers, dried chili peppers, flavored ices, flavored sweetened gelatin desserts, hominy, hominy grits, ice cream drinks, sauces, seasonings, shakes, sherbert, sorbert, taco shells, processed corn</p>

Attachments	Opposition Notice scan.pdf (7 pages)(1145888 bytes)
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Signature	/DAVID A HERDMAN/
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Name	DAVID A HERDMAN
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Date	11/22/2006
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KELLOGG NORTH AMERICA COMPANY)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	Serial No. 76/646,016
MARQUEZ BROTHERS)	Mark: LA TOÑA
INTERNATIONAL, INC.)	Filing Date: May 9, 2005
)	Publication Date: May 2, 2006
Applicant.)	

NOTICE OF OPPOSITION

Kellogg North America Company, a Delaware corporation, located and doing business at One Kellogg Square, P.O. Box 3599, Battle Creek, Michigan 49016, (hereinafter called "Opposer"), believes that it will be damaged by the registration of the mark shown in Application Serial No. 76/646,016 in Class 30, filed by Marquez Brothers International, Inc. (hereinafter "Applicant") on September 1, 2005, and opposes Application Serial No. 76/646,016.

The grounds for this opposition are as follows:

1. Commencing long prior to Applicant's filing date, Opposer and Opposer's predecessor in interest, Kellogg Company, have engaged, and Opposer is now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of food products, and an ever expanding range of licensed and promotional non-food products and services.
2. Opposer has for many years and continues to market its products under some of the most famous marks in the United States and the world, including, but not limited to, TONY THE TIGER and word and design equivalents of the same equity, including the Spanish version TONO (hereinafter called the Opposer's TONY Marks).

3. Commencing long prior to Applicant's filing date, Opposer and Opposer's predecessor in interest, Kellogg Company, have used, and Opposer is now using Opposer's TONY Marks in connection with said food products and promotional and licensed products distributed and sold by Opposer and its licensees in commerce.

4. Opposer is owner of, and will rely herein, upon the following Federal Trademark registrations: TONY'S, Reg. No. 1,672,993 (issued 1/21/1992); TONY THE TIGER, Reg. No. 2,916,395 (issued 1/4/2005); TONY'S TIGER BITES, Reg. No. 1,697,609 (issued 6/30/1992); TONY and TIGER DESIGN, Reg. Nos. 2,659,501 (issued 12/10/2002), 2,013,885 (issued 11/5/1996), 2,030,068 (issued 1/14/1997), and 2,136,777 (issued 2/17/1998); 2,316,185 for KELLOGG'S CEREAL CITY USA TONY & (Tiger) Design (issued February 8, 2000); 2,388,260 for KELLOGG'S CEREAL CITY USA TONY & (Tiger) Design (issued September 19, 2000); 2,496,549 for KELLOGG'S CEREAL CITY USA TONY & (Tiger) Design (issued October 9, 2001); 2,504,885 for KELLOGG'S CEREAL CITY USA TONY & (Tiger) Design (issued November 6, 2001); 2,530,130 for KELLOGG'S CEREAL CITY USA TONY & (Tiger) Design (issued January 15, 2002); 2,594,428 for THE GR-R-REAT TONY BALLOON (issued July 16, 2002); 2,659,501 for TONY & (Tiger) Design (issued December 10, 2002); and 2,882,851 for TONY'S FROSTED CRUNCH (issued September 7, 2004). The above registered marks are valid, subsisting and conclusive evidence of Opposer's exclusive right to the above registered marks in commerce for the goods and services specified in said registrations.

5. In addition to the registered marks specified above, Opposer shall rely herein upon its common law usage of its other TONY Marks, including foreign equivalents for its promotional and licensed uses, which together with the marks noted above form a family of valuable "TONY" marks, herein referred to as Opposer's TONY Marks. Given the fame and

widespread favorable public recognition of Opposer's TONY Marks use on these other products and services is a natural extension of Opposer's earlier usage on food products.

6. Opposer's TONY Marks were first adopted and used by Opposer as a trademark for "cereal breakfast foods" at least as early as 1952. Opposer's TONY Marks have been used continuously since 1952 by Opposer in conjunction with the sale of food products in interstate commerce by using the marks on packaging in which the goods are shipped and by displaying representations of said mark on displays associated with the goods and in advertising and promotion in other ways customary to the trade.

7. Opposer has made substantial investment in advertising and promoting its goods and services under Opposer's TONY Marks since their initial use in 1952. Opposer has extensively used, advertised, promoted and offered Opposer's goods and services bearing Opposer's TONY Marks to the public through various channels of trade in commerce, including cereal-based food products (including a chocolate flavored cereal), snack foods, entertainment services in the nature of live performances by a costumed character, restaurant services and retail store services with the result that Opposer's customers and the public in general have come to know and recognize Opposer's TONY Marks and associate the same with Opposer and/or the goods and services sold or provided by Opposer or its controlled licensees.

8. In view of the extensive favorable public recognition of Opposer's TONY Marks, Opposer's use of Opposer's TONY Marks on other products and services is a natural extension of Opposer's earliest use of Opposer's TONY Marks on food products and promotional items marketed in conjunction with the food products.

9. Owing to its continuous use and promotion for over 50 years in connection with cereal-based food products and the sale of millions of boxes of such product, nearly all of which

bear Opposer's TONY Marks, Opposer's TONY Marks are distinctive and famous marks in the United States as used on food products and became famous well prior to the Applicant's actual use or intended use of the alleged mark.

10. Upon information and belief, notwithstanding Opposer's rights in and to Opposer's TONY Marks, on September 1, 2005, Applicant filed an application for registration of the LA TOÑA trademark, alleged to be in use for "Cheese, cream, cream cheese, cheese spreads, milk, fish, sardines, pork, sausages, chili, processed nuts, pork rinds, canned fruits, fruit paste, soups, soup mixes, processed beans, dried beans, processed peppers, processed tomatoes, canned vegetables, processed edible seeds, edible processed cactus, cooking oil, edible oil, vegetable oil, vegetable based food beverages, unflavored and unsweetened gelatins, candied fruits, candied nuts, chocolate milk, clam juice, eggnog, eggnog mixes, fruit conserves, fruit pectin, fruit preserves, processed vegetables" in International Class 29 and "Chewing gum, flavored and sweetened gelatins, honey, pasta shells, rice, tortillas, tortilla chips, corn chips, salsa, cheese sauce, tomato sauce, spices, processed herbs, bakery products, bakery goods, bakery desserts, breakfast cereals, cake mixes, chili sauce, chili seasoning, chocolate food beverages not dairy or vegetable based, chocolate powder, chocolate syrup, chutney, cinnamon, coffee beans, crackers, dried chili peppers, flavored ices, flavored sweetened gelatin desserts, hominy, hominy grits, ice cream drinks, sauces, seasonings, shakes, sherbert, sorbert, taco shells, processed corn" in International Class 30. Said application was assigned Serial No. 76/646,016, and was published for Opposition in the Official Gazette of July 25, 2006.

11. Applicant's LA TOÑA mark so resembles Opposer's TONY Marks, including TOÑO, as to be likely, when applied to the proposed goods of Applicant, to cause confusion or mistake or to deceive users resulting in damage and detriment of Opposer and its reputation.

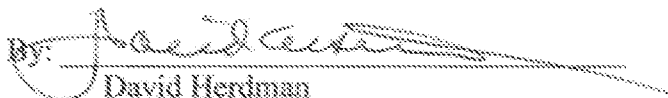
12. Opposer, upon information and belief, avers that its customers, and the public general, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed good to be marketed under Applicant's alleged LA TOÑA mark and misled into believing that such goods emanate from, or are licensed by or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

13. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged LA TOÑA trademark, as set forth in Applicant's Trademark Application Serial No. 76/646,016, in that the mark is substantially similar to Opposer's TONY Marks and common law rights and in view of the great fame of Opposer's TONY Marks and the extensive range of goods and services offered to the public by Opposer and its controlled licensees under Opposer's TONY Marks will be presumed to emanate from Opposer, either directly or indirectly.

14. Opposer, upon information and belief, also avers that it will be damaged by the registration by Applicant of the proposed LA TOÑA trademark, as set forth in Applicant's Trademark Application Serial No. 76/646,016, in that the alleged mark will dilute the distinctiveness of Opposer's famous TONY Marks within the meaning of the provisions of the Federal Trademark Dilution Act of 1995, as amended by the Trademark Revisions Act of 2006.

Wherefore, this Opposer, Kellogg North America Company believes and avers that it is being and will continue to be damaged by registration of alleged LA TOÑA trademark as aforesaid, and pray that said Application Serial No. 76/646,016 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully Submitted,
KELLOGG NORTH AMERICA COMPANY

By: 

David Herdman
Assistant Secretary and
Corporate Counsel
Kellogg North America Company
One Kellogg Square
P.O. Box 3599
Battle Creek, MI 49016

Date: November 22, 2006

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KELLOGG NORTH AMERICA COMPANY)	
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Opposer,)	
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v.)	Opposition No. _____
)	Serial No. 76/646,016
MARQUEZ BROTHERS)	Mark: LA TOÑA
INTERNATIONAL, INC.)	Filing Date: May 9, 2005
)	Publication Date: May 2, 2006
Applicant.)	

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Marquez Brothers International, Inc. by mailing said copy on November 22, 2006, via First Class Mail, postage prepaid to:

Emma Pena Madrid
Marques Brothers International, Inc.
5801 Rue Ferrari
San Jose, CA 95138-1857



Patricia A. Conor