

ESTTA Tracking number: **ESTTA131084**

Filing date: **03/21/2007**

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	Sonafi S.A.
Granted to Date of previous extension	03/21/2007
Address	42 rue Rieussec Viroflay, 78220 FRANCE
Attorney information	Kristin H. Altoff Morgan, Lewis & Bockius LLP Attn: TMSU, 1111 Pennsylvania Ave., NW Washington, DC 20004 UNITED STATES trademarks@morganlewis.com, apolott@morganlewis.com, kaltoff@morganlewis.com Phone:202-739-3000

Applicant Information

Application No	79010756	Publication date	11/21/2006
Opposition Filing Date	03/21/2007	Opposition Period Ends	03/21/2007
International Registration No.	0849174	International Registration Date	05/09/2005
Applicant	Barry Callebaut AG Seefeldquai 17 CH-8034 Zürich SWITZERLAND		

Goods/Services Affected by Opposition

<p>Class 030. All goods and services in the class are opposed, namely: Confectionary products, namely, chocolates and assorted chocolates; other chocolate or cocoa products, namely, chocolate mass, cocoa mass; chocolate pieces; baking chocolate; chocolate bars; chocolate bars and chocolate tablets being made using milk and honey and other ingredients; chocolate coated candy being made using milk and honey and other ingredients; chocolate squares; non-medicated chocolate lozenges; chocolate molded into various shapes; chocolate bonbons and other assorted chocolates; filled chocolate bars; shaped, iced and hollow chocolates; sugar free chocolate, and sugar free chocolate coating; chocolate-based glazes; imitation chocolate; diet chocolate; raw chocolate, raw chocolate in the form of small lentils or tablets, in one piece or divided in small parts; raw chocolate in the form of lens-shaped drops or small tablets for use in industry or households; chocolate coatings and diet chocolate coatings, namely, compound coatings for use in coating candies; compound coating for use in the manufacture of candies and confectioners coating; chocolate products for further industrial processing, namely, air-filled chocolate, chocolate syrup, chocolate desserts; small wrapped milk chocolate eggs; chocolate cakes; chocolate candy drops; chocolate-based candy for retail sale and</p>
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use in food manufacturing; dark chocolate; plain chocolate, chocolate candy and sweets, in particular filled with fruits; chocolate coated fruits; chocolate-covered sweetmeats, namely, chocolate covered raisins, nuts, almonds; chocolate and cocoa food beverages not being dairy-based or vegetable based; chocolate flavored beverages, namely hot cocoa and milk shakes; cocoa powder for making beverages; beverages based on chocolate additives; chocolate bread spreads; chocolate spreads; thin chocolate slabs for laying on bread; chocolate-nut-nougat cream for bread; chocolate, candy and chocolate-based season's articles for Easter and Christmas; synthetic chocolate products, namely chocolate substitutes and diet chocolate; chocolate food beverages not being dairy-based or vegetable-based; liquid and solid chocolate intended for use by the chocolate industry and not for direct human consumption; chocolate based beverages, namely milk shakes; chocolate sauces; chocolate drops; chocolate pralines being made using milk and honey and other ingredients; pralines; alcoholic pralines; pralines filled with liquids and nuts, hazelnut cream and walnut cream; diet pralines; chocolate truffles; truffles; chocolate sticks, fudge; chocolate ices; wafers and pastries with chocolate coating; chocolate wafer; wafer biscuits; plain flour wafers; wafered pralines; wafer sandwiches; farinaceous and bakery products, namely rusks, cakes, breads, sweet breads, cookies, biscuits, pies; waffles; crackers; chocolate covered waffles, in particular, waffle biscuits and waffle pralines; gingerbread; syrup waffles-namely, two waffles held together by syrup; confectionery articles covered with chocolate namely cake, crackers, toast, gingerbread; chocolate-coated biscuits; chocolate wafers; blancmange powder; flour confectionery and sugar confectionery; honey; honey molasses; flavoring syrup; flan; marzipan

Class 035.

All goods and services in the class are opposed, namely: Advertising services; business management; business administration; providing office functions

Class 041.

All goods and services in the class are opposed, namely: Educational services, namely, providing classes in the field of making chocolate candies, desserts and foods; training services in the field of making chocolate candies, desserts and foods; entertainment services, namely, organizing cooking and pastry competitions; organizing community sporting and cultural events

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3080952	Application Date	05/14/2003
Registration Date	04/11/2006	Foreign Priority Date	NONE
Word Mark	EUROPEAN CHOCOLATE MASTERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/02/21 First Use In Commerce: 2005/02/21 Promoting the goods and services of others in the field of candy through the distribution of printed material; wholesale distributorships featuring candy		

Attachments	WORLD CHOCOLATE MASTERS Notice.pdf (3 pages)(21699 bytes)
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Signature	/Kristin H. Altoff/
Name	Kristin H. Altoff
Date	03/21/2007

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

SONAFI S.A.

Opposer,

v.

Barry Callebaut AG,

Applicant.

In re Application Serial No. 79/010,756
Published: November 21, 2006
Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Sonafi S.A., a corporation organized and existing under the laws of France, having a principal place of business at 42 rue Rieussec, Viroflay 78220, France (“Opposer”), believes that it will be damaged by registration of the mark WORLD CHOCOLATE MASTERS and Design shown in Application Serial No. 79/010,756 (the “WORLD CHOCOLATE MASTERS Mark”), owned by Barry Callebaut AG (“Applicant”) to identify:

- a wide variety of goods in International Class 30;
- “advertising services; business management; business administration; providing office functions” in Class 35; and
- “educational services, namely, providing classes in the field of making chocolate candies, desserts and foods; training services in the field of making chocolate candies, desserts and foods; entertainment services, namely, organizing cooking and pastry competitions; organizing community sporting and cultural events” in Class 41.

Opposer hereby opposes the same under the provisions of Sections 2(d) and 13 of the Trademark Act of July 5, 1946 (the “Lanham Act”), 15 U.S.C. §§ 1052(d) and 1063.

As grounds for opposition, Opposer alleges that:

1. Opposer owns common law rights for the trademark EUROPEAN CHOCOLATE MASTERS in connection with goods and services relating to candy and chocolates, including

distribution of chocolate and culinary classes (the “EUROPEAN CHOCOLATE MASTERS Mark”).

2. Opposer’s common law rights are based on Opposer’s use of EUROPEAN CHOCOLATE MASTERS as a trade name and/or trademark at least as early as December 1995.

3. Opposer also owns a federal registration on the Supplemental Register for the EUROPEAN CHOCOLATE MASTERS Mark (Registration Number 3,080,952) filed on May 14, 2003 for use in connection with “promoting the goods and services of others in the field of candy through the distribution of printed material; wholesale distributorships featuring candy.”

4. By virtue of its use and registration, Opposer has established goodwill in the EUROPEAN CHOCOLATE MASTERS Mark in the United States.

5. On May 9, 2005, Applicant filed a Madrid Protocol-based application under Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), for federal registration of the mark WORLD CHOCOLATE MASTERS and Design, Application Serial No. 79/010,756 covering goods in International Class 30 and services in International Class 35 and 41.

6. Applicant’s application for the WORLD CHOCOLATE MASTERS Mark claims a priority date of November 9, 2004 under Section 67 of the Lanham Act, 15 U.S.C. § 1141g.

7. Applicant’s WORLD CHOCOLATE MASTERS Mark was published for opposition in the *Official Gazette* on November 21, 2006.

8. The Trademark Trial and Appeal Board (the “Board”) extended the opposition period for Applicant’s WORLD CHOCOLATE MASTERS application by granting Opposer’s timely requests for extensions. The opposition period is currently set to expire on March 21, 2007. Opposer, therefore, timely files this opposition.

9. Through its use of the EUROPEAN CHOCOLATE MASTERS Mark, Opposer has acquired rights in the EUROPEAN CHOCOLATE MASTERS Mark that predate any rights upon which Applicant may rely. Opposer's rights to the EUROPEAN CHOCOLATE MASTERS Mark are superior to those of Applicant.

10. Opposer believes it will be damaged by registration of Applicant's WORLD CHOCOLATE MASTERS Mark under Section 13 of the Lanham Act, 15 U.S.C. § 1063, because consumers, familiar with Opposer's EUROPEAN CHOCOLATE MASTERS Mark, are likely to believe, mistakenly, that Applicant or its products or services emanate from, are sponsored or authorized by, or are otherwise associated or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes it will be damaged by registration of the mark WORLD CHOCOLATE MASTERS Stylized shown in Application Serial No. 79/010,756 and respectfully requests that the registration sought by Applicant be refused.

Dated: March 21, 2007

Respectfully submitted,

By: /s/ Kristin H. Altoff
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