

ESTTA Tracking number: **ESTTA183570**

Filing date: **12/27/2007**

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	Pinkberry, Inc.
Granted to Date of previous extension	12/29/2007
Address	2122 W. Washington Blvd. LOS ANGELES, CA 90018 UNITED STATES

Attorney information	Clark D. Gross Russ, August & Kabat 12424 Wilshire Boulevard, Suite 1200 LOS ANGELES, CA 90025 UNITED STATES cgross@raklaw.com Phone:310-826-7474
----------------------	--

Applicant Information

Application No	77170441	Publication date	10/30/2007
Opposition Filing Date	12/27/2007	Opposition Period Ends	12/29/2007
Applicant	Lee, Joontack #1 2348 Karen Dr. Santa Clara, CA 95050 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Retail store services featuring frozen yogurts, gelatos, smoothies and waffles

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3302143	Application Date	05/04/2006
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	PINKBERRY		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2005/01/31 First Use In Commerce: 2006/09/30 Frozen yogurt and frozen yogurt based desserts combined with fruit, nuts, cereal and shaved ice and rice cakes Class 032. First use: First Use: 2005/01/31 First Use In Commerce: 2006/09/30 Smoothies

U.S. Application No.	78876477	Application Date	05/04/2006
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	PINKBERRY
-----------	-----------

Design Mark	
-------------	--

Description of Mark	The mark consists of the word pinkberry in lime green lettering with a stylized berry to the left of the word pinkberry. The berry is pink with a lime green leafy stem..
---------------------	---

Goods/Services	Class 030. First use: First Use: 2005/01/31 First Use In Commerce: 2006/09/30 Frozen yogurt and frozen yogurt based desserts combined with fruit, nuts, cereal and shaved ice and rice cakes Class 032. First use: First Use: 2005/01/31 First Use In Commerce: 2006/09/30 Smoothies
----------------	---

U.S. Application/Registration No.	NONE	Application Date	NONE
-----------------------------------	------	------------------	------

Registration Date	NONE
-------------------	------

Design Mark	
-------------	--

Goods/Services	frozen yogurt, frozen yogurt based desserts combined with fruit, nuts,
----------------	--

	cereal and shaved ice and rice cakes, frozen confectionary, smoothies, blended beverages, shaved ice and restaurant services
--	--

Attachments	78876538#TMSN.jpeg (1 page)(bytes) 78876477#TMSN.jpeg (1 page)(bytes) Pinkberry-swirl-drawing.jpg 20071227162957097.pdf (5 pages)(551886 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/clark gross/
Name	Clark D. Gross
Date	12/27/2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of
Trademark Application No. 77/170,441
For the Mark: Yo berry (stylized)
Published in the *Official Gazette* on October 30, 2007

Pinkberry, Inc.

Opposer

v.

Joontack Lee, an individual,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Pinkberry, Inc, a California Corporation, having a place of business at 2212 W. Washington Boulevard, Los Angeles, CA 90018 (hereinafter "Pinkberry" or "Opposer") believes that it will be damaged by the registration of the mark shown in the above-identified application ("the '441 Application"), filed by Joontack Lee, an individual residing at 2348 Karen Drive, Santa Clara, CA 95050 (hereinafter referred to as "Applicant"), and hereby opposes same. This Opposition is filed as to all classes.

The grounds for this Opposition are as follows:

1. Since at least as early as January 31, 2005, Pinkberry has used its
 - a. Word mark consisting of the word "Pinkberry" (hereinafter "Pinkberry word mark");

- b. Stylized Pinkberry and swirl design (hereinafter “Stylized Pinkberry and Swirl Design Mark”) — a copy of which is shown below -



- c. Swirl design (hereinafter “Swirl Design Mark”) — a copy of which is shown below -



(collectively the “Pinkberry Marks”) on and in connection with, *inter alia*, frozen yogurt, frozen yogurt based desserts combined with fruit, nuts, cereal and shaved ice and rice cakes, frozen confectionary, smoothies, blended beverages, shaved ice and restaurant services, in the United States, and such use has been continuous to this day. Pinkberry has continuously used the Pinkberry Marks in commerce on and in connection with such goods and services since at least as early as September 30, 2006, and such use continues to this day. The Pinkberry Marks form the subject matter of pending United States trademark applications, and a United States trademark registration, as detailed below. Thus Applicant is not entitled to registration of the ‘441 Application.

2. Pinkberry and the Pinkberry Marks have become famous as a result of such use and of highly favorable publicity. Pinkberry has acquired substantial statutory and common law rights in and to the Pinkberry Marks. Applicant’s use or registration of a confusingly similar mark on identical and closely related goods and services would damage Pinkberry and damage and dilute its Pinkberry Marks. Thus, Pinkberry has standing to initiate this Opposition.
3. On or about May 1, 2007, a date well after Opposer’s first use of the Pinkberry Marks, and after the filing dates of Opposer’s trademark applications detailed below, Applicant filed the ‘441 Application under §1(b), for the following goods and services: “retail store services featuring frozen yogurts, gelatos, smoothies and waffles.”
4. Applicant’s is not entitled to register the mark of ‘441 Application, due to

Opposer's prior use of the Pinkberry Marks in the United States, and such use has not been abandoned. Opposer's Pinkberry Marks are so similar to the mark of the '441 Application as to be likely, when used on or in connection with the goods and services of the Applicant, to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer.

5. The mark of the '441 Application so resembles the Pinkberry Marks, and the respective goods and services are so similar, as represent a false designation of origin, prior use of the mark, false or misleading description of fact, or false or misleading representation of fact, which is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer.
6. On information and belief, at the time Applicant filed the '441 Application, Applicant was well aware of Opposer's use of the Pinkberry Marks, and intentionally and falsely swore that the following material "facts" were true, knowing them to be false:
 - a. Applicant "believes the applicant to be the owner of the trademark/service mark sought to be registered ...";
 - b. Applicant "believes applicant to be entitled to use such mark in commerce"; and
 - c. To the best of Applicant's "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"
7. Each of the statements in paragraph 6 above were false. The truth was:
 - a. Applicant knew that Applicant was not "the owner of the trademark/service mark sought to be registered ...";
 - b. Applicant knew that Applicant was not "entitled to use such mark in commerce"; and
 - c. Applicant knew that another "person, firm, corporation, or

association had 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 such other corporation was Opposer.

Such intentional, material misrepresentations constitute fraud on the Patent & Trademark Office. Thus Applicant is not entitled to registration of the '441 Application.

8. The following side-by-side comparison of the mark of the '441 Application and the Pinkberry Marks clearly demonstrates the likelihood of confusion:

'441 APPLICATION

PINKBERRY MARKS

The logo for '441 Application, featuring the word "Yoberry" in a bold, black, sans-serif font. The letter "o" is replaced by a stylized berry icon with a stem and two leaves.The logo for Pinkberry Marks, featuring the word "pinkberry" in a lowercase, pink, sans-serif font. The letter "i" is replaced by a stylized swirl design with a stem and two leaves.

Pinkberry



9. On or about May 4, 2006, almost a year before the filing date of the '441 Application, Opposer filed application serial number 78876538 for the mark **Pinkberry**, said application reciting the following goods: Frozen yogurt and frozen yogurt based desserts combined with fruit, nuts, cereal and shaved ice and rice cakes,” in Int. Cl. 30, and “smoothies,” in Int. Cl. 32. On October 2, 2007, application serial number 78876538 registered on the Principal Register as United States Trademark Registration No. 3302143. The mark of the '441 Application, and the goods and services recited therein, are so similar to the mark of Reg. No. 3302143 and its recited goods as to be likely, to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer. Thus Applicant is not entitled to registration of the '441 Application.
10. On or about May 4, 2006, almost a year before the filing date of the '441 Application, Opposer filed application serial number 78876477 for the Stylized Pinkberry and Swirl Design Mark, as shown in paragraph 1(b) above, said application reciting the following goods: Frozen yogurt and frozen yogurt based desserts combined with fruit, nuts, cereal and shaved ice and rice cakes,” in Int. Cl. 30, and “smoothies,” in Int. Cl. 32. That

application is still pending. The mark of the '441 Application, and the goods and services recited therein, are so similar to the mark of application serial number 78876477 and its recited goods as to be likely, to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods, services, or commercial activities by Opposer. Thus Applicant is not entitled to registration of the '441 Application.

12. An Extension of Time to Oppose was previously granted by the Trademark Trial & Appeal Board, until and including December 29, 2007.

Therefore, Opposer respectfully requests that this Opposition be sustained against application no. 77/170,441.

Respectfully submitted,

RUSS, AUGUST & KABAT



Clark D. Gross
Irene Y. Lee
Russ, August & Kabat
12424 Wilshire Boulevard, Suite 1200
Los Angeles, California 90025
Telephone: (310) 826-7474
Facsimile: (310) 826-6991
email: cgross@raklaw.com

Dated: December 27, 2007

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Joontack Lee by mailing said copy on December 27, 2007, via First Class Mail, postage prepaid to:

Joontack Lee
2348 Karen Drive, Apt. 1
Santa Clara, CA 95050-5031

Dated: December 27, 2007



Clark D. Gross