

TTAB

BEFORE THE TTAB

IN THE US TRADEMARK OFFICE

EZAKI GLICO KABUSHIKI KAISHA DBA

EZAKI GLICO COMPANY, LTD

OPPOSER

V

COLOMBINA, SA

APPLICANT

NOTICE OF OPPOSITION

IN RE APPLICATION SN 77/410,432

MARK - PONKY

FILED - Feb. 29, 2008

Published - Dec. 30, 2008

I hereby certify that the accompanying application
this notice is placed in the file of the application.
Patent Office. The fee for this notice is \$100.
at Chicago, Illinois 60601-1097.
P.O. Box 1451, Alexandria, VA 22131-1451.
and the fee for this notice is \$100.
Date: 1/23/09 (signed) [Signature]

Commissioner of Trademarks

PO Box 1451

Alexandria, VA 2213-1451

01/29/2009 SWILSON1 00000023 77410432

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300.00 US

Sirs:

Opposer, Ezaki Glico KK ("Opposer") a corporation organized and existing under the laws of Japan, with its office at 6-5, Utajima, 4-Chome, Nishiyodogawaku, Osaka, Japan believes that it would be damaged by the issuance of a registration of the trademark PONKY , on application SN 77/410,432 for goods listed therein in International Class 30, and therefore opposes the same. As grounds for opposition, Opposer, by its Attorney MOONRAY KOJIMA, alleges as follows:



01-26-2009

1. Since at least as early as 1971 and continuing through the present, Opposer, has used the mark POCKY and POCKY AND DESIGN (collectively, the "POCKY MARKS") for bakery and beverage goods.

2. POCKY brand goods are sold in convenience stores, delis, supermarkets, oriental and Asian stores, and the like, throughout the USA. Millions of boxes of POCKY branded goods have been distributed in the USA with sales in the millions of dollars. Opposer has been using the POCKY marks on goods continuously for a period commencing long prior to any date on which Applicant can rely up to the current date.

3. Due to the extreme popularity of POCKY branded products, there have been significant opportunities for Opposer to expand its use of the POCKY MARKS. In addition to using the POCKY mark in connection with the goods, Opposer uses the POCKY Mark on T-shirts which are sold nationwide. Opposer use of the POCKY Marks on such goods predates the application filing date of 2/29/08.

4. Opposer is the owner of numerous trademark registrations for POCKY MARKS including, but not limited to:

MARK	REG.NO.	DATE OF USE	CLASS
POCKY	1,249,460	May 14,1971	30
POCKY CRUSH	3,516,901	9/20/89	30
POCKY	2,748,236	1/24/03	32
POCKY	2,878,956	6/10/03	25
MOUSSE POCKY	2,614,710	3/7/01	30
MARBLE POCKY	2,409,803	12/3/94	30
POCKY & DEVICE	2,393,716	11/1/99	30

COPIES OF REGISTRATIONS ATTACHED AS APPENDIX.

All of the registrations set forth above are valid, subsisting and in full force and effect, all serve as prima facie evidence of Opposer's exclusive rights in and to the registered marks, all establish that Opposer's rights in the POCKY Marks are long prior to any rights on which Applicant can rely, and all serve to place Applicant on notice of Opposer's rights. In addition, all of the above recited registrations (except POCKY CRUSH) are incontestable and as such constitutes conclusive evidence of Opposer's exclusive right to use the POCKY Mark on the goods specified therein pursuant to Sections 7 and 33 of the Lanham Act, 15 USC 1057(b).

5. Through the years of use and advertising POCKY and as a result of the expenditure of significant resources by Opposer to promote POCKY products, Opposer has established strong common law rights in the POCKY Marks in addition to its rights flowing from its federal registrations. The POCKY Marks have come to become associated uniquely with Opposer, representing enormous goodwill of Opposer and identify and distinguish goods manufactured, approved or or licensed by Opposer from those of others.

6. As a result of the long use, registration and renown of the POCKY MARKS, Opposer's POCKY MARKS are entitled to an extremely broad scope of protection.

7. Upon information and belief, Applicant is a Colombian corporation based and doing business in Colombia.

8. As a matter of law, Applicant was on constructive notice of Opposer's rights in the POCKY Marks, based on Opposer's federal

trademark registrations for the same, at the time it filed the application herein opposed. Upon information and belief, as a result of Opposer's extensive use of the POCKY MARKS for almost 38 years, Applicant was on actual notice of Opposer's prior rights in and to the POCKY MARKS.

9. The only date on which Applicant can rely, is decades after use, registration and acquisition of rights in the POCKY Marks by Opposer. As such, Opposer's rights in its POCKY Marks are PRIOR and SUPERIOR to any rights Applicant may claim in the Mark PONKY.

10. The mark now being opposed PONKY incorporates in substantially its entirety and is so similar to Opposer's mark POCKY both orally and visually as to be likely to cause confusion, mistake or deception. The marks are very similar and the goods are so similar to support a finding of deception, mistake or confusion.

11. The sounds of the two marks and the appearances are so similar as to cause confusion, mistake or deception. Also both marks are "coined".. thus, there is a hint that PONKY was deliberately coined to copy Opposer's mark POCKY. There are no disparate meanings for either.

12. Applicant seeks to use the mark PONKY in connection with goods which are related to the goods offered by Opposer under the POCKY marks. Since consumers are used to seeing a single entity make various kinds of foods, consumers are likely to be mistaken

as to the sources of Applicant's goods which are to be sold under PONKY which is similar to Opposer's mark POCKY. Moreover, given that Opposer's mark POCKY which have been used in connection with a variety of goods, consumers may believe that Applicant's goods are flavored with Opposer's products.

13. The application being opposed is not limited with respect to channels of trade or consumer goods to be sold under the similar mark PONKY. Accordingly, as a matter of law the goods listed by Applicant under the Ponky mark will be deemed to be sold to all customers and all channels of trade customary for such goods. These are identical channels of trade for goods and customers of goods bearing our POCKY marks.

14. The registration of Applicant's mark is inconsistent with Opposer's prior rights in its POCKY MARKS , is inconsistent with Opposer's Statutory grant of exclusivity of use of the registered POCKY MARKS , and would destroy Opposer's investment and goodwill it is POCKY MARKS.

15. PONKY 77/410,432 was filed 2/29/08 and published on 12/30/08 in Class 30 for "cookies,pastry, confectionery, namely, toffees, caramels, mints, suckers, lollipop,bubblegums,chocolates and cakes" Thus, the earliest provable date for applicant is at least 36 years after Opposer's date of use. Clearly Opposer would be damaged by Applicant's registration of PONKY.

CLAIMS FOR RELIEF UNDER SECTION 2(d)

16. Opposer repeats and realleges each and every allegation contained in paragraphs 1-15 as if fully set forth herein.

17. The POCKY Marks are associated exclusively with Opposer and have been used continuously and registered by Opposer since a date long prior to any date on which Applicant can rely.

18. Applicant's mark PONKY is similar to Opposer's registered and prior used POCKY MARKS. Applicant seeks to use its mark in connection with goods similar to or related to those provided by Opposer under its POCKY MARKS, sold to the same or overlapping consumer base who uses or is familiar with Opposer's POCKY branded goods, and sold through the same channels of trade used by Opposer.

19. By virtue of the use of the POCKY MARKS BY Opposer, the goodwill associated with Opposer's POCKY MARKS, the registrations owned by Opposer for the POCKY MARKS, the fame of the POCKY Marks, the use of the Pocky marks on various goods, the registration by Applicant of PONKY for the goods identified in SN 77/410,732 is likely to create the erroneous impression that Applicant's goods originate from, come from or are otherwise associated with Opposer or that Applicant's use of PONKY for goods licensed by or its products are endorsed or in some way connected with Opposer. Registration of the mark PONKY in connection with the goods set forth in SN 77/410,732 is likely to cause confusion, cause mistake, or to deceive the public into the belief that the goods offered by Applicant under the PONKY mark come from or otherwise sponsored by Opposer in violation of Sec .2(d) of the Lanham Act, 15 USC 1052(d).

20. By reason of the foregoing, Opposer is likely to be harmed by the registration of SN 77/410,432 for the mark PONKY.

WHEREFORE, it is respectfully requested that this Opposition be sustained and that the registration sought by Applicant in Application SN 77/410,432 be denied.

Opposer hereby submits the fee of \$300.00 for one class.

Dated: New York, NY


MOONRAY KOJIMA

Attorney for Opposer

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,249,460

Registered Aug. 23, 1983

TRADEMARK
Principal Register

POCKY

Ezaki Glico Kabushiki Kaisha (Japan corporation),
d.b.a. Ezaki Glico Co., Ltd.
18, 3-chome
Mitejima-Higashi, Nishiyodogawa-ku, Osaka, Japan

For: CONFECTIONARY, CAKES, CHEWING
GUMS, CHOCOLATES, COCOAS, BISCUITS,
CRACKERS, WAFERS, ICE CREAMS, HONEY
AND SUGAR, in CLASS 30 (U.S. Cl. 46).

Priority claimed under Sec. 44(d) on Japan
application No. 48,622, filed May 14, 1971, Reg. No.
1,327,836, dated Mar. 16, 1978, expires Mar. 16, 1988.

Ser. No. 406,232, filed Oct. 28, 1971.

RICHARD A. STRASER, Examining Attorney

Int. Cl.: 30

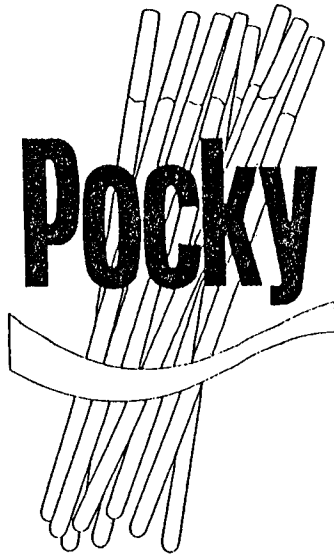
Prior U.S. Cl.: 46

Reg. No. 2,393,716

United States Patent and Trademark Office

Registered Oct. 10, 2000

**TRADEMARK
PRINCIPAL REGISTER**



EZAKI GLICO KABUSHIKI KAISHA (JAPAN CORPORATION), DBA EZAKI GLICO CO., LTD
6-5, UTAJIMA, 4-CHOME
NISHIYODOGAWAKU, OSAKA, JAPAN

FOR: CHOCOLATE COATED BISQUITS AND
CHOCOLATE COATED PRETZELS, IN CLASS 30
(U.S. CL. 46).

FIRST USE 11-1-1999; IN COMMERCE 11-1-1999.

OWNER OF U.S. REG. NO. 1,249,460.

SER. NO. 75-869,466, FILED 12-11-1999.

TERESA LEE, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 2,614,710
Registered Sep. 3, 2002

**TRADEMARK
PRINCIPAL REGISTER**

MOUSSE POCKY

EZAKI GLICO KABUSHIKI KAISHA (JAPAN
CORPORATION), DBA EZAKI GLICO COM-
PANY, LIMITED
6-5,UTAJIMA, 4-CHOME
NISHIYODOGAWAKU, OSAKA, JAPAN

FOR: CANDY, CAKES, CHEWING GUMS, CHO-
COLATES, COCOAS, BISCUITS, CRACKERS, WA-
FERS, ICE CREAM, COOKIES, HONEY, SUGAR,
CHOCOLATE COVERED BISCUITS AND CHOCO-
LATE COVERED PRETZELS, IN CLASS 30 (U.S. CL.
46).

FIRST USE 3-7-2001; IN COMMERCE 3-7-2001.

OWNER OF U.S. REG. NOS. 1,249,460, 2,393,716,
AND 2,409,803.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "MOUSSE", APART FROM THE
MARK AS SHOWN.

SER. NO. 76-242,456, FILED 4-9-2001.

YVONNE JONES, EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,878,956

Registered Aug. 31, 2004

**TRADEMARK
PRINCIPAL REGISTER**

POCKY

**EZAKI GLICO KABUSHIKI KAISHA (JAPAN
CORPORATION), DBA EZAKI GLICO COM-
PANY, LIMITED
6-5, 4-CHOME, UTAJIMA, NISHIYODOGAWAKU
OSAKA, JAPAN**

**OWNER OF U.S. REG. NOS. 1,249,460, 2,614,710
AND OTHERS.**

**FOR: "T" SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND
39).**

SER. NO. 76-545,597, FILED 9-17-2003.

FIRST USE 6-10-2003; IN COMMERCE 6-10-2003.

DAVID ELTON, EXAMINING ATTORNEY

Int. Cl.: 32

Prior U.S. Cls.: 45, 46, and 48

United States Patent and Trademark Office

Reg. No. 2,748,236

Registered Aug. 5, 2003

**TRADEMARK
PRINCIPAL REGISTER**

POCKY

EZAKI GLICO KABUSHIKI KAISHI (JAPAN
CORPORATION), DBA EZAKI GLICO COM-
PANY, LIMITED,
6-5, UTAJIMA, 4-CHOME
NISHIYODOGAWA-KU, OSAKA, JAPAN

FIRST USE 1-24-2003; IN COMMERCE 1-24-2003.

OWNER OF U.S. REG. NOS. 1,249,460, 2,393,716,
AND 2,409,803.

FOR: SOFT DRINKS; FRUIT AND VEGETABLE
JUICES; NON-ALCOHOLIC BEVERAGES, NAME-
LY, PUNCH, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

SN 76-298,130, FILED 8-11-2001.

ANDY COREA, EXAMINING ATTORNEY

Int. Cl.: 30

Prior U.S. Cl.: 46

Reg. No. 3,516,901

United States Patent and Trademark Office

Registered Oct. 14, 2008

TRADEMARK
PRINCIPAL REGISTER

POCKY CRUSH

EZAKI GLICO KABUSHIKI KAISHA (JAPAN CORPORATION), DBA EZAKI GLICO COMPANY, LIMITED,
6-5,UTAJIMA,4-CHOME
NISHIYODOGAWA-KU, OSAKA, JAPAN

FOR: CHOCOLATE BISCUIT STICKS, CHOCOLATE COVERED BISCUITS, AND CHOCOLATE COVERED PRETZELS, IN CLASS 30 (U.S. CL. 46).

FIRST USE 9-20-1989; IN COMMERCE 6-30-1991.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,249,460, 2,614,710, AND OTHERS.

SN 76-685,031, FILED 12-17-2007.

TOBY BULLOFF, EXAMINING ATTORNEY