

ESTTA Tracking number: **ESTTA436787**

Filing date: **10/19/2011**

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	ConAgra Foods RDM, Inc.
Granted to Date of previous extension	10/19/2011
Address	One ConAgra Drive Omaha, NE 68102 UNITED STATES

Correspondence information	ConAgra Foods RDM, Inc. One ConAgra Drive Omaha, NE 68102 UNITED STATES pto-om@huschblackwell.com Phone:4029645144
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Applicant Information

Application No	85285445	Publication date	06/21/2011
Opposition Filing Date	10/19/2011	Opposition Period Ends	10/19/2011
Applicant	Shoney's North America Corp. 1717 Elm Hill Pike, Suite B-1 Nashville, TN 37210 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 2011/02/21 First Use In Commerce: 2011/02/21 All goods and services in the class are opposed, namely: Omelets served at restaurants, concession stands or at catered events
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Grounds for Opposition

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

U.S. Registration No.	3420506	Application Date	05/01/2006
Registration Date	04/29/2008	Foreign Priority Date	NONE
Word Mark	SLIM JIM		


Design Mark	SLIM JIM
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2006/10/01 First Use In Commerce: 2006/10/01 Clothing, namely, hats, shirts, shorts, sweatshirts, and jackets

U.S. Registration No.	897953	Application Date	12/22/1969
Registration Date	09/01/1970	Foreign Priority Date	NONE
Word Mark	SLIM JIM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U046 (International Class 001, 005, 029, 030, 031, 032). First use: First Use: 1968/01/00 First Use In Commerce: 1968/01/00 DRY SMOKED SAUSAGE, BEEF JERKY [, VINEGAR PICKLED SAUSAGE, PICKLED PIGS KNUCKLES AND PIGS FEET, AND VINEGAR PICKLED EGGS]		

U.S. Registration No.	3433303	Application Date	07/07/2006
Registration Date	05/20/2008	Foreign Priority Date	NONE
Word Mark	SLIM JIM MONSTER		
Design Mark	SLIM JIM MONSTER		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2006/11/01 First Use In Commerce: 2006/11/01 meat snack sticks		

U.S. Registration No.	3495877	Application Date	02/25/2008
Registration Date	09/02/2008	Foreign Priority Date	NONE
Word Mark	SLIM JIM SIZZLE STICKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2008/03/31 First Use In Commerce: 2008/03/31 MEAT BASED SNACK FOOD		

U.S. Registration No.	1995265	Application Date	07/31/1995
Registration Date	08/20/1996	Foreign Priority Date	NONE
Word Mark	SNAP INTO A SLIM JIM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1989/08/00 First Use In Commerce: 1989/08/00 packaged meat snacks		

U.S. Registration No.	3840202	Application Date	09/08/2009
Registration Date	08/31/2010	Foreign Priority Date	NONE
Word Mark	SLIM JIM		
Design Mark			
Description of Mark	The mark consists of the words "SLIM JIM" placed inside of a box.		
Goods/Services	Class 015. First use: First Use: 2007/11/01 First Use In Commerce: 2008/01/01		

	<p>harmonicas</p> <p>Class 016. First use: First Use: 2007/11/01 First Use In Commerce: 2008/01/01 adhesive plastic film for mounting images for decorative purposes</p> <p>Class 025. First use: First Use: 2007/11/01 First Use In Commerce: 2008/01/01 clothing, namely, baseballs caps, beanies, t-shirts and sweatshirts</p> <p>Class 029. First use: First Use: 2007/11/01 First Use In Commerce: 2008/01/01 packaged meat snacks; oven-baked potato based snack food</p>
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Attachments	<p>78873387#TMSN.jpeg (1 page)(bytes)</p> <p>78924619#TMSN.jpeg (1 page)(bytes)</p> <p>77404706#TMSN.jpeg (1 page)(bytes)</p> <p>77821767#TMSN.jpeg (1 page)(bytes)</p> <p>SLIM JIM 85285445 - NOTICE OF OPPOSITION.pdf (8 pages)(557372 bytes)</p>
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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	/Christopher M. Bikus/
Name	ConAgra Foods RDM, Inc.
Date	10/19/2011

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

In The Matter Of Application Serial No. 85/285,445
Published In the *Official Gazette* on June 21, 2011

CONAGRA FOODS RDM, INC.)	
)	
Opposer,)	MARK: SLIM JIM
)	
v.)	
)	SERIAL NO. 85/285,445
SHONEY'S NORTH AMERICA CORP.)	
)	
Applicant.)	
)	
)	

To the Commissioner of Patents and Trademarks:

NOTICE OF OPPOSITION

ConAgra Foods RDM, Inc., a corporation organized and existing under the laws of the State of Delaware, with offices located at One ConAgra Drive, Omaha, Nebraska 68102, believes that it will be damaged by registration of the mark shown in Application Serial No. 85/285,445 and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Pursuant to Application Serial No. 85/285,445, filed on April 4, 2011, Applicant seeks to register the mark SLIM JIM ("Applicant's Mark") as a trademark for "omelets served at restaurants, concession stands or at catered events" in International Class 29, as evidenced by the publication of said mark in the June 21, 2011 issue of the Official Gazette.

2. Opposer is the owner of Registration No. 3,420,506 issued on April 29, 2008 pursuant to Application Serial No. 78/873,387, for the trademark SLIM JIM as used on

"clothing, namely, hats, shirts, shorts, sweatshirts, and jackets" in International Class 25. Opposer has used the trademark SLIM JIM in interstate commerce on these goods, through its licensees and predecessors in interest, since at least as early as October 1, 2006 and continues to use the trademark SLIM JIM on these goods in interstate commerce.

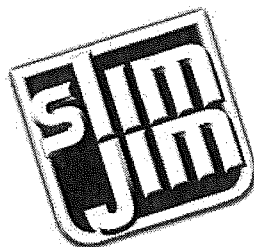
3. Opposer is the owner of Registration No. 0,897,953 issued on September 1, 1970 pursuant to Application Serial No. 72/346,805, for the trademark SLIM JIM as used on "dry smoked sausage, beef jerky" in International Class 29. Opposer has used the trademark SLIM JIM in interstate commerce on these goods, through its licensees and predecessors in interest, since at least as early as January 31, 1968 and continues to use the trademark SLIM JIM on these goods in interstate commerce.

4. Opposer is the owner of Registration No. 3,433,303 issued on May 20, 2008 pursuant to Application Serial No. 78/924,619, for the trademark SLIM JIM MONSTER as used on "meat snack sticks" in International Class 29. Opposer has used the trademark SLIM JIM MONSTER in interstate commerce on these goods, through its licensees and predecessors in interest, since at least as early as November 1, 2006 and continues to use the trademark SLIM JIM MONSTER on these goods in interstate commerce.

5. Opposer is the owner of Registration No. 3,495,877 issued on September 2, 2008 pursuant to Application Serial No. 77/404,706, for the trademark SLIM JIM SIZZLE STICKS as used on "meat based snack food" in International Class 29. Opposer has used the trademark SLIM JIM SIZZLE STICKS in interstate commerce on these goods, through its licensees and predecessors in interest, since at least as early as March 31, 2008 and continues to use the trademark SLIM JIM SIZZLE STICKS on these goods in interstate commerce.

6. Opposer is the owner of Registration No. 1,995,265 issued on August 20, 1996 pursuant to Application Serial No. 74/708,058, for the trademark SNAP INTO A SLIM JIM as used on "packaged meat snacks" in International Class 29. Opposer has used the trademark SNAP INTO A SLIM JIM in interstate commerce on these goods, through its licensees and predecessors in interest, since at least as early as August 31, 1989 and continues to use the trademark SNAP INTO A SLIM JIM on these goods in interstate commerce.

7. Opposer is the owner of Registration No. 3,840,202 issued on August 31, 2010 pursuant to Application Serial No. 77/821,767, for the trademark SLIM JIM & DESIGN as used on "harmonicas" in International Class 15; " adhesive plastic film for mounting images for decorative purposes" in International Class 16; "clothing, namely, baseballs caps, beanies, t-shirts and sweatshirts" in International Class 25; and "packaged meat snacks; oven-baked potato based snack food" in International Class 29. Opposer has used the trademark SLIM JIM & DESIGN in interstate commerce on these goods, through its licensees and predecessors in interest, since at least as early as November 1, 2007 and continues to use the trademark SLIM JIM & DESIGN on these goods in interstate commerce.



8. Opposer's goods are marketed, promoted, sold and distributed nationwide and as a result, Opposer's mark is exclusively identified with Opposer's quality goods.

9. There is no issue as to priority. Opposer's date of first use in commerce for its mark is well prior to the filing date of Application Serial No. 85/285,445.

10. Applicant is co-owner of Trademark Registration 3694531 along with Big Boy Restaurants International LLC (“Big Boy Restaurants”) for the mark SLIM JIM.

11. On or about March 19, 2008, Opposer filed a trademark opposition against Big Boy Restaurant’s pending application for the mark SLIM JIM.

12. Big Boy and Opposer ultimately resolved the trademark opposition and Big Boy amended its SLIM JIM application. The amended application proceeded to registration under registration number 3694531.

13. On or about June 16, 2010, Applicant and Big Boy entered into a trademark assignment whereby Applicant became a “Co-Owner” of an “equal, undivided and joint right, title, and interest in and to [the SLIM JIM] Mark on a worldwide basis, including but not limited to the registration set forth above.....”

14. In its pending Application, Applicant references and relies on registration number 3694531 as a Co-Owner of this registration.

COUNT I – LIKELIHOOD OF CONFUSION.

15. All prior allegations are incorporated herein by reference.

16. Applicant's Mark and Opposer's mark are identical in sight, sound and commercial impression, and as such, a likelihood of confusion exists between Applicant's Mark and Opposer's mark, SLIM JIM.

17. Opposer's goods sold under Opposer's mark and Applicant's goods sold under its mark are sold to, or are capable of sale to, the same class of consumers.

18. If Applicant is permitted to use and register Applicant's Mark in connection with "omelets served at restaurants, concession stands or at catered events", such use and registration is likely to cause confusion and lead to deception as to the source, origin and/or sponsorship of

the goods bearing Applicant's Mark, causing damage and injury to Opposer and its SLIM JIM trademark.

19. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to use the SLIM JIM trademark, causing damage and injury to Opposer.

COUNT II – DILUTION.

20. All prior allegations are incorporated herein by reference.

21. Through extensive advertising and promotion, Opposer's SLIM JIM Marks have become famous in the United States.

22. Opposer's SLIM JIM Marks were famous prior to the filing date of the Application.

23. Registration of the Applicant's Mark is likely to cause dilution of Opposer's SLIM JIM Marks, to the injury of Opposer, by lessening the capacity of the SLIM JIM Marks to identify and distinguish Opposer's goods, or otherwise diluting or tarnishing Opposer's SLIM JIM Marks.

24. Based on the foregoing, the grant of a registration for Applicant's Mark as sought in the Application should be denied based on a likelihood of dilution of the distinctive quality of Opposer's famous SLIM JIM Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

COUNT III – FRAUD.

25. All prior allegations are incorporated herein by reference.

26. Applicant's Application references and relies upon Registration No. 3694531.

27. At the time Applicant filed the Application, Applicant knew that Registration No. 3694531 was subject to express conditions set forth in a mutually executed settlement agreement.

28. Applicant's representation that it had the right to use the mark in commerce in connection with the goods set forth in the Application was false and the statement was made knowingly to the Trademark Office for the purpose of seeking registration of Application No. 85/285,445.

29. Applicant's misrepresentation is material to the Trademark Examiner's approval of Application Serial No. 85/285,445.

30. Applicant's actions in filing Application Serial No. 85/285,445 constitute fraud, thereby invalidating Applicant's Application.

WHEREFORE, Opposer prays that trademark Application Serial No. 85/285,445 be rejected, and that the mark therein sought for the goods therein specified be denied and refused.

Dated this 19th day of October, 2011.

Respectfully submitted,

CONAGRA FOODS RDM, INC.



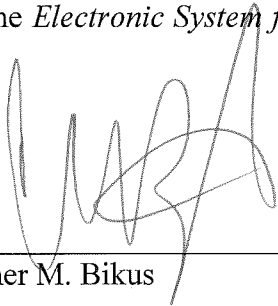
By:

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ATTORNEY FOR OPPOSER

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this NOTICE OF OPPOSITION is being filed electronically with the United States Patent and Trademark Office utilizing the *Electronic System for Trademark Trials and Appeals* this 19th day of October, 2011.

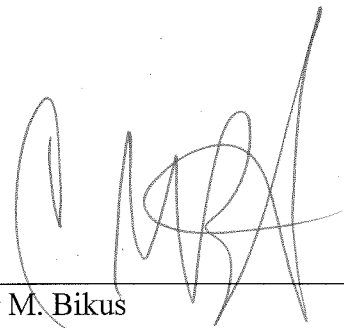


Christopher M. Bikus

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION was served via United States first class mail, postage pre-paid, on this 19th day of October, 2011 to the following:

F. Richard Rimer, Jr., Esq.
Troutman Sanders LLP
600 Peachtree Street NE, Suite 5200
Atlanta, GA 30308-2216



Christopher M. Bikus