

ESTTA Tracking number: **ESTTA460584**

Filing date: **03/07/2012**

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	B.T.T.R. Ventures, LLC
Granted to Date of previous extension	03/07/2012
Address	2935 Adeline Street Oakland, CA 94608 UNITED STATES

Attorney information	Dawn Newton Fitzgerald Abbott & Beardsley 1220 Broadway 21st Floor Oakland, CA 94612 UNITED STATES dnewton@fablaw.com Phone:510 451 3300
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Applicant Information

Application No	85351051	Publication date	11/08/2011
Opposition Filing Date	03/07/2012	Opposition Period Ends	03/07/2012
Applicant	MICHAEL JASON BENDINELLI 103 Shoreview Rd. Chelsea, MI 48118 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2008/10/01 First Use In Commerce: 2008/10/01 All goods and services in the class are opposed, namely: Retail clothing boutiques; Retail clothing stores
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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)
Other	Rights to concurrent use

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85331206	Application Date	05/26/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BACK TO THE ROOTS		

Design Mark	Back to the Roots
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2009/04/22 First Use In Commerce: 2010/10/01 (Based on Use in Commerce) Soil amendments (Based on Intent to Use) Nutritive additive to enhance the biological activity of water, soil, seeds and plants for purposes of fertilization and bioremediation of pollutants

U.S. Application No.		Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

U.S. Application No.	85976291	Application Date	05/26/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BACK TO THE ROOTS		
Design Mark	Back to the Roots		
Description of Mark	NONE		
Goods/Services	Class 031. First use: First Use: 2009/04/22 First Use In Commerce: 2009/10/09 Fresh mushrooms; Organic gardening kit for indoor and outdoor planting composed primarily of organic agricultural seeds, mushroom spawn, herb seeds, fruit seeds, vegetable seeds, mycorrhizal root inoculum and also including educational materials, as well as, though not limited to, sustainable soils such as coffee grounds, spent grains and hops, spent okara, spent tea		

	waste, and compost; Spores and spawn
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Related Proceedings	Opposer B.T.T.R Ventures, LLC has filed Notice of Opposition against 85/357890
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Attachments	85331206#TMSN.jpeg (1 page)(bytes) 85976291#TMSN.jpeg (1 page)(bytes) NOO 051.PDF (5 pages)(214007 bytes)
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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	/DNewton/
Name	Dawn Newton
Date	03/07/2012

5. Opposer has spent substantial sums in the advertising and promotion throughout the United States of its products under the BACK TO THE ROOTS mark. As a result of the expenditure of considerable sums for promotional activities, advertising, and by virtue of the excellence of its products, the Opposer has garnered an extremely valuable reputation for its BACK TO THE ROOTS mark.

6. On May 26, 2011, Opposer filed one application for trademark registration with the United States Patent & Trademark Office in International Classes 1 and 31, on a combined 1A and 1B basis, which was Serial No. 85/331206.

7. On December 20, 2011, the Notice of Allowance issued for the intent-to-use section of the Class 1 Application.

8. On February 6, 2012, Opposer petitioned to divide out the Class 31 portion of the application into Serial No. 85/976291. The result was a parent application, Serial No. 85/331206 ("Class 1 Application"), for "(Based on actual use) Soil amendments (Based on Intent to Use) Nutritive additive to enhance the biological activity of water, soil, seeds and plants for purposes of fertilization and bioremediation of pollutants" and a child application, Serial No. 85/976291 ("Class 31 Application"), in International Class 31 for "Fresh mushrooms; Organic gardening kit for indoor and outdoor planting composed primarily of organic agricultural seeds, mushroom spawn, herb seeds, fruit seeds, vegetable seeds, mycorrhizal root inoculum and also including educational materials, as well as, though not limited to, sustainable soils such as coffee grounds, spent grains and hops, spent okara, spent tea waste, and compost; Spores and spawn." The division process is complete and Serial No. 85/976291 is proceeding to registration.

9. Applicant filed two applications for the identical mark, BACK TO THE ROOTS, on or about June 28, 2011. Each application was filed on an actual use basis. Application 85351051 ("Opposed Application") was filed in International Class 35 for "Retail clothing boutiques; Retail clothing stores." In addition, Applicant also filed Application 85357890 ("Class 43 Application") in International Class 43 for "Cafe; Cafe and restaurant services; Cafe-restaurants; Provision of food and drink in restaurants; Restaurant; Restaurant services featuring Sushi; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurants."

10. The Opposed Application is fraudulent in that the formal application papers filed by Applicant stated that Applicant first used the mark in commerce with the United States by October 1, 2008 for retail clothing boutique services in International Class 35. Opposer is informed and believes that this statement was false in that the true facts are that Applicant did not open its retail business until 2009. Applicant made or authorized this statement to be made by its authorized agent with the knowledge and belief that it was false.

11. Applicant's false statement was made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant a registration of the Opposed Application and to establish Applicant as the senior user of the mark, as Opposer had already filed the Class 31 Application and alleged its own first use date in April 2009.

12. Opposer has been unable to obtain credible information regarding Applicant's true first use date in connection with the Opposed Application. If Applicant's first use date is

prior to that of Opposer, Opposer alleges that at the time Opposer adopted its mark and began aggressive sales and promotional activity which was intended to and did develop substantial goodwill in Opposer's mark, Opposer was geographically remote from and unaware of Applicant's existence and activities.

13. On information and belief, in or about July 2011, after Opposer had already developed substantial goodwill and recognition of its BACK TO THE ROOTS mark and products nationwide and expended substantial amounts on marketing efforts and business infrastructure, Applicant opened a 45-seat restaurant within the same physical space as its retail clothing store, which caused its retail clothing services to become associated with food services under the disputed mark.

14. Opposer will be damaged by a registration of the Opposed Application, in that since at least April 2009, Opposer has continuously used the mark BACK TO THE ROOTS in the United States in connection with its organic gardening mushroom kits. Opposer is aware of members of the public who have been confused as to a connection between Applicant's business operations and Opposer's retail products, and one of Applicant's co-venturers has himself reported to Opposer that members of the public have called Applicant's business asking to purchase Opposer's goods, believing Applicant to be the source of such goods. Registration of Applicant's mark will harm Opposer by allowing Applicant to expand its existing, single location retail location into a broader chain of businesses which may include a food service element, easily confused with Opposer's retail sales of kits and soil to grow healthy, sustainable food at home.

15. Opposer is the senior user of the BACK TO THE ROOTS mark in connection with food products, and actual confusion in the marketplace is already occurring. If Applicant obtains a registration for the mark in connection with retail clothing boutique services, Opposer may be unable to exercise its rights to restrict Applicant from establishing additional businesses into which it may incorporate restaurant services in a manner that harms Opposer's goodwill in its mark or prevents Opposer from expanding its use of the mark in connection with food, and may therefore be damaged further by a false association between its well-known and highly recognized goods and the services offered by Applicant.

16. If Applicant is permitted to register its mark, Opposer's concurrent rights in the mark in connection with food (the Class 31 Application) and soil nutrients (the Class 1 Application) should be recognized and Applicant should be denied a geographically unrestricted territory and granted registration only within the boundary of the area in which it established rights prior to Opposer's nationwide sales, in order to avoid harm to Opposer.

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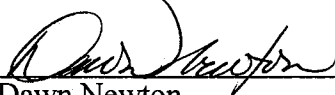
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Wherefore, Opposer prays that Serial No. 85/351051 be refused registration or, in the alternative, granted a geographically restricted territory in its registration.

Respectfully submitted,

FITZGERALD ABBOTT & BEARDSLEY LLP

By  _____
Dawn Newton
David C. Lee
Attorneys for B.T.T.R. Ventures, LLC

Date: March 7, 2012

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing Notice of Opposition was served by First Class Mail, on March 7, 2012 on counsel for Applicant at the following address:

Aaron Israels
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4155 E. Jewell Avenue, Ste. 502
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Dated: March 7, 2012

By:  _____

Dawn Newton, Esq.

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