

ESTTA Tracking number: **ESTTA502918**

Filing date: **10/31/2012**

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                                  | Consorzio Del Formaggio Parmigiano-Reggiano      |
| Granted to Date of previous extension | 10/31/2012                                       |
| Address                               | Via Kennedy, 18<br>Reggio Emilia, 42100<br>ITALY |

|                      |   |
|----------------------|---|
| Attorney information | Stephen D. Adams<br>Luedeka Neely Group, P.C.<br>900 S Gay Street, P.O. Box 1871<br>Knoxville, TN 37901<br>UNITED STATES<br>SAdams@LNG-Patent.com, Aroehrig@Ing-patent.com Phone:865-546-4305 |
|----------------------|---|

**Applicant Information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85534454  | Publication date       | 07/03/2012 |
| Opposition Filing Date | 10/31/2012  | Opposition Period Ends | 10/31/2012 |
| Applicant              | It's In The Parm!<br>#2201 101 S. Ft. Lauderdale Beach Bl<br>Fort Lauderdale, FL 33316<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

|   |
|---|
| Class 029.<br>All goods and services in the class are opposed, namely: Cheese, namely, parmesan |
|---|


**Grounds for Opposition**

|   |                               |
|---|-------------------------------|
| Priority and likelihood of confusion                            | Trademark Act section 2(d)    |
| The mark is primarily geographically descriptive                | Trademark Act section 2(e)(2) |
| The mark is primarily geographically deceptively misdescriptive | Trademark Act section 2(e)(3) |


**Marks Cited by Opposer as Basis for Opposition**


|                       |                           |                       |            |
|-----------------------|---------------------------|-----------------------|------------|
| U.S. Registration No. | 3492751                   | Application Date      | 08/23/2006 |
| Registration Date     | 08/26/2008                | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO EXTRA |                       |            |

|                     |   |  |  |
|---------------------|---|--|--|
| Design Mark         |    |  |  |
| Description of Mark | The mark consists of yellow cheese wedge, gold cheese wheel with blue background, yellow words "PARMIGIANO REGGIANO" on blue background, and white word "EXTRA" on gold background. |  |  |
| Goods/Services      | Class A. First use: First Use: 2002/01/01 First Use In Commerce: 2003/07/01 Cheese  |  |  |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3258461  | Application Date      | 08/22/2006 |
| Registration Date     | 07/03/2007   | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO EXTRA  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class A. First use: First Use: 1991/01/01 First Use In Commerce: 2003/07/01 Cheese |                       |            |

|                       |                           |                       |            |
|-----------------------|---------------------------|-----------------------|------------|
| U.S. Registration No. | 3472348                   | Application Date      | 08/19/2006 |
| Registration Date     | 07/22/2008                | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO EXTRA |                       |            |

|                     |  |  |  |
|---------------------|--|--|--|
| Design Mark         |   |  |  |
| Description of Mark | NONE   |  |  |
| Goods/Services      | Class A. First use: First Use: 2002/01/01 First Use In Commerce: 2003/07/01 Cheese |  |  |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3445305   | Application Date      | 08/19/2006 |
| Registration Date     | 06/10/2008  | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO-REGGIANO   |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | The mark consists of Pin dot words used with a series of parallel circumferential rings spaced equidistant about a wheel of cheese. |                       |            |
| Goods/Services        | Class A. First use: First Use: 2002/01/01 First Use In Commerce: 2003/01/01 Cheese  |                       |            |

|                       |                     |                       |            |
|-----------------------|---------------------|-----------------------|------------|
| U.S. Registration No. | 3472347             | Application Date      | 08/19/2006 |
| Registration Date     | 07/22/2008          | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO |                       |            |

|                     |   |  |  |
|---------------------|---|--|--|
| Design Mark         |    |  |  |
| Description of Mark | The mark consists of a wheel of cheese and a wedge of cheese on a plate with a knife above the words "PARMIGIANO REGGIANO". |  |  |
| Goods/Services      | Class A. First use: First Use: 2002/01/01 First Use In Commerce: 2003/01/01 Cheese  |  |  |

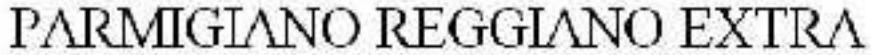
|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3472346   | Application Date      | 08/19/2006 |
| Registration Date     | 07/22/2008  | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | The mark consists of a yellow cheese wheel and wedge on a silver plate with a silver knife and a yellow handle, in front of a blue background, above the yellow words "PARMIGIANO REGGIANO" with a blue background. |                       |            |
| Goods/Services        | Class A. First use: First Use: 2002/01/01 First Use In Commerce: 2003/01/01 Cheese  |                       |            |

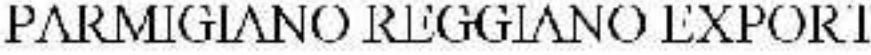
|                       |                     |                       |            |
|-----------------------|---------------------|-----------------------|------------|
| U.S. Registration No. | 3467954             | Application Date      | 08/18/2006 |
| Registration Date     | 07/15/2008          | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO |                       |            |

|                     |  |  |  |
|---------------------|--|--|--|
| Design Mark         | <p><b>PARMIGIANO<br/>REGGIANO</b></p>  |  |  |
| Description of Mark | The mark consists of the word "Parmigiano" positioned over the word "Reggiano".    |  |  |
| Goods/Services      | Class A. First use: First Use: 1954/04/10 First Use In Commerce: 1965/05/25 Cheese |  |  |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3348606  | Application Date      | 08/18/2006 |
| Registration Date     | 12/04/2007   | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO  |                       |            |
| Design Mark           | <p><b>PARMIGIANO REGGIANO</b></p>  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class A. First use: First Use: 1954/04/10 First Use In Commerce: 1965/05/25 Cheese |                       |            |

|                       |                           |                       |            |
|-----------------------|---------------------------|-----------------------|------------|
| U.S. Registration No. | 3256242                   | Application Date      | 08/18/2006 |
| Registration Date     | 06/26/2007                | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO EXTRA |                       |            |

|                     |  |  |  |
|---------------------|--|--|--|
| Design Mark         |  |  |  |
| Description of Mark | NONE   |  |  |
| Goods/Services      | Class A. First use: First Use: 2002/01/01 First Use In Commerce: 2003/07/01 Cheese |  |  |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3359791  | Application Date      | 08/18/2006 |
| Registration Date     | 12/25/2007   | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO REGGIANO EXPORT   |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class A. First use: First Use: 1955/01/10 First Use In Commerce: 1965/05/25 Cheese   |                       |            |

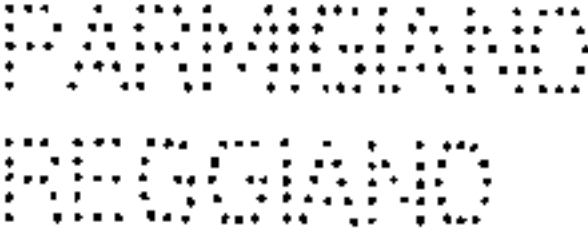
|                       |                            |                       |            |
|-----------------------|----------------------------|-----------------------|------------|
| U.S. Registration No. | 1892496                    | Application Date      | 06/11/1993 |
| Registration Date     | 05/02/1995                 | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO EXPORT REGGIANO |                       |            |

|                     |  |  |  |
|---------------------|--|--|--|
| Design Mark         |  |  |  |
| Description of Mark | NONE   |  |  |
| Goods/Services      | Class A. First use: First Use: 1955/01/10 First Use In Commerce: 1965/05/25 cheese |  |  |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1896683  | Application Date      | 06/07/1993 |
| Registration Date     | 05/30/1995   | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO-REGGIANO  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class A. First use: First Use: 1954/04/10 First Use In Commerce: 1965/05/25 cheese |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1753059   | Application Date      | 01/17/1992 |
| Registration Date     | 02/16/1993  | Foreign Priority Date | NONE       |
| Word Mark             | PARMIGIANO CONSORZIO TUTELA REGGIANO  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class A. First use: First Use: 1954/04/10 First Use In Commerce: 1965/05/25 cheese  |                       |            |

|                       |            |                  |            |
|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 1754410    | Application Date | 01/17/1992 |
| Registration Date     | 02/23/1993 | Foreign Priority | NONE       |

|                     |  |      |  |
|---------------------|--|------|--|
|                     |  | Date |  |
| Word Mark           | PARMIGIANO REGGIANO  |      |  |
| Design Mark         |  |      |  |
| Description of Mark | NONE   |      |  |
| Goods/Services      | Class A. First use: First Use: 1954/04/10 First Use In Commerce: 1965/05/25 cheese |      |  |

|             |   |
|-------------|---|
| Attachments | 78958612#TMSN.jpeg ( 1 page )( bytes )<br>78957642#TMSN.jpeg ( 1 page )( bytes )<br>78955921#TMSN.jpeg ( 1 page )( bytes )<br>78955909#TMSN.gif ( 1 page )( bytes )<br>78955884#TMSN.jpeg ( 1 page )( bytes )<br>78955878#TMSN.jpeg ( 1 page )( bytes )<br>78955589#TMSN.jpeg ( 1 page )( bytes )<br>78955413#TMSN.jpeg ( 1 page )( bytes )<br>78955236#TMSN.jpeg ( 1 page )( bytes )<br>78954983#TMSN.jpeg ( 1 page )( bytes )<br>74400394#TMSN.gif ( 1 page )( bytes )<br>74238400#TMSN.gif ( 1 page )( bytes )<br>74238399#TMSN.gif ( 1 page )( bytes )<br>6817699-tottab-20121031-NoticeOfOpposition.pdf ( 4 pages )(176526 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 | /Stephen D. Adams/ |
| Name      | Stephen D. Adams   |
| Date      | 10/31/2012         |



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

In the Matter of trademark application Serial No. 85/534,454

Published in the TM Official Gazette of July 3, 2012

For: IT'S IN THE PARM! (and Design)

Applicant: It's In The Parm! LLC

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Consorzio del Formaggio  
Parmigiano-Reggiano,

Opposer

v.

Opposition No. \_\_\_\_\_

It's In The Parm! LLC,

IT'S IN THE PARM! (and Design)

Applicant.

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**NOTICE OF OPPOSITION**

Consorzio Del Formaggio Parmigiano-Reggiano, a consortium chartered by the Republic of Italy, having a principal place of business at Via Kennedy 18, 42100 Reggio Emilia, ITALY (hereinafter referred to as "Opposer" or "Consorzio"), believes it will be damaged by the registration of the mark "IT'S IN THE PARM!" (and Design) shown in Application Serial No. 85/534,454, filed February 6, 2012, by It's In The Parm! LLC (hereinafter referred to as "Applicant") and hereby opposes the same.

As ground for its Opposition, Opposer alleges as follows:

1. The Consorzio is an Italian Association entrusted under Italian law, specifically Article 2602 *et seq.* of the Civil Code, Article 15 of Law 128/98 and Ministerial Decrees, with the tasks of promoting and defending cheese bearing the Protected Designation of Origin Parmigiano Reggiano and, therefore, that cheese which

meets certification standards for the use of the certification mark PARMIGIANO REGGIANO.

2. The Consorzio is a successor in interest to the first Voluntary Association of Reggiano Producers created in 1934 to protect, promote, and oversee the production of the unique, inimitable cheese produced on farms in the entire provinces of Parma, Reggio Emilia, Modena and part of the province of Mantua on the right bank of the river Po and part of the province of Bologna on the left bank of the river Reno (hereinafter the "Parma/Reggio Emilia region").

3. Under the International Convention of Stresa of 1951, whose protocol was signed at the Hague, Parmigiano Reggiano cheese is one of only four cheese names that cannot be used on a cheese product produced outside its designated place of origin.

4. On June 21, 1996, the name Parmigiano Reggiano was entered as a Protected Designation of Origin on the European Union register of protected designations of origin and protected geographical indications under Council Regulation (EC) No. 510/2006 of March 20, 2006, for the protection of geographical indications and designations of origin for agricultural products and foodstuffs, which repealed and replaced Regulation (EEC) No. 2081/92.

5. In order for cheese to bear the mark PARMIGIANO REGGIANO, it must be produced in the Parma/Reggio Emilia region of Italy, and meet the Consorzio's standards for quality.

6. Parma is an Italian province that is well known for its production of Parmigiano Reggiano cheese.

7. Parmigiano is the Italian adjective form of Parma meaning "of" or "from" Parma.

8. Parmigiano Reggiano cheese has achieved widespread recognition by chefs, cooks, gourmets, and connoisseurs of fine food as representing the standard for excellence of Italian hard grating cheeses. This recognition has spread from Italy, through Europe and to the United States.

9. In the press, and among consumers, references to Parmigiano Reggiano cheeses are sometimes shortened to Parmigiano alone or, less frequently, Reggiano alone.

10. By European Union law, and as a result of decisions of the European Union Court of Justice, the name "Parmesan" can only be used to refer to Parmigiano Reggiano cheese throughout the entire European Union (EU). Many U.S. consumers refer to Parmigiano Reggiano cheese as simply "Parmigiano."

11. Parmigiano Reggiano cheese is frequently referred to as Parmigiano by purchasers and culinary professionals.

12. The public has come to associate the terms Parmigiano and Parma with cheese having the quality and characteristics of cheese certified as Parmigiano Reggiano under the auspices of the Consorzio, marked with the certification mark PARMIGIANO REGGIANO and originating from the Parma/Reggio Emilia region of Italy.

13. Applicant, on information and belief, is a Florida limited liability company having a principal place of business located at 101 S. Ft. Lauderdale Beach Blvd., #2201, Fort Lauderdale, Florida 33316.

14. Applicant has applied to register the terms "IT'S IN THE PARM!" (and Design) for "cheese, namely, parmesan."

15. Applicant's registration of the term IT'S IN THE PARM! is likely to cause confusion with the Consorzio's registered certification marks PARMIGIANO REGGIANO in that the relevant public would understand the mark to primarily refer to a class of goods, cheese, for which Parma is well known, and for which the Parma region is one of the principal geographic locations in which PARMIGIANO REGGIANO cheese is produced.

16. The applicant's proposed use of the term "IT'S IN THE PARM" is a primarily geographically descriptive designation because Parma is a city in the Italian province of Parma, which city and province are known for the production of Parmesan cheese certified by the Consorzio by the authorized use of their registered certification mark PARMIGIANO REGGIANO.

17. On information and belief, Applicant has no presence or connection with the Parma/Reggio Emilia region of Italy. Furthermore, on information and belief, Applicant's goods do not originate from the Parma/Reggio Emilia region of Italy. Applicant's proposed use of the term "IT'S IN THE PARM" is geographically misdescriptive.

18. If Applicant is permitted to obtain the registration herein opposed, Applicant will receive the prima facie exclusive right to use in commerce the term IT'S IN THE PARM! on the goods identified in the application. Such registration would be a source of damage and injury to Opposer.

**WHEREFORE**, Opposer prays that the Opposition be sustained and that the registration be denied to Applicant on its Application Serial No. 85/198,201.

Dated: October 31, 2012

Respectfully submitted,

CONSORZIO DEL FORMAGGIO  
PARMIGIANO-REGGIANO

By:



August E. Roehrig, Jr.  
Registration No. 22,667  
Stephen D. Adams  
Registration No. 67,581  
Attorneys for Opposer

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