

ESTTA Tracking number: **ESTTA669737**

Filing date: **04/30/2015**

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	Hershey Canada Inc.
Granted to Date of previous extension	05/27/2015
Address	5750 Explorer Drive Mississauga, ON L4W 0B1 CANADA

Attorney information	Paul C. Llewellyn Kaye Scholer LLP 250 West 55th Street New York, NY 10019-9710 UNITED STATES paul.llewellyn@kayescholer.com, tmdocketing@kayescholer.com, john.rynkiewicz@kayescholer.com Phone:212-836-7828
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Applicant Information

Application No	86199666	Publication date	01/27/2015
Opposition Filing Date	04/30/2015	Opposition Period Ends	05/27/2015
Applicant	Brookshire Grocery Company 1600 W Southwest Loop 323 Tyler, TX 75701 UNITED STATES		

Goods/Services Affected by Opposition


Class 029. First Use: 2012/09/14 First Use In Commerce: 2012/09/14 Opposed goods and services in the class: nut based snack bars; snack mixes consisting primarily of processed nuts; snack mix consisting primarily of processed fruits, processed nuts, dried fruits, and chocolate; snack mix consisting primarily of seeds; snack mix consisting primarily of processed fruits, processed nuts, dried fruits, chocolate, and peanut butter confectionery chips
Class 030. First Use: 2012/09/10 First Use In Commerce: 2012/09/10 Opposed goods and services in the class: ready to eat cereals; processed cereals; cookies; crackers; frozen desserts consisting of fruit or cream or cream substitutes; frozen desserts, namely, freezer pops, banana pops, push pops, fudge bars, fruit bars, ice cream bars, ice cream sandwiches, ice cream cups, ice cream, sundae ice cream cones; popcorn; snack mixes consisting primarily of crackers, pretzels and/or popped corn, granola snack bars


Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2411662	Application Date	12/02/1997
Registration Date	12/12/2000	Foreign Priority Date	NONE
Word Mark	BROOKSIDE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 029. First use: First Use: 1997/12/01 First Use In Commerce: 1997/12/01 [Fruit fillings for bakery goods; lemon curd, orange curd and raspberry curd fillings for bakery goods]</p> <p>Class 030. First use: First Use: 1991/00/00 First Use In Commerce: 1991/00/00 candy, chocolate covered nuts; chocolate chips, chocolate covered fruit chips; yogurt flavored wafers; chocolate coatings for other manufacturers; chocolate covered almonds; chocolate covered peanuts; dark and light chocolate</p>		

U.S. Registration No.	4286013	Application Date	06/25/2012
Registration Date	02/05/2013	Foreign Priority Date	NONE
Word Mark	BROOKSIDE		
Design Mark			
Description of Mark	<p>The mark consists of a stylized tree in the color black, centered over the words "BROOKSIDE" in black letters; the tree is in front of a blue mountain range. The tree is casting a black shadow to the front of the tree and is surrounded by a green design in the shape of a "B" representing a grassy area, next to a blue stream.</p>		
Goods/Services	<p>Class 030. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Candy; Chocolate covered fruit; Chocolate covered nuts</p>		

U.S. Registration No.	4416727	Application Date	01/18/2012
Registration Date	10/15/2013	Foreign Priority Date	07/21/2011
Word Mark	BROOKSIDE		
Design Mark			
Description of Mark	The mark consists of the word "BROOKSIDE" and an image including mountains, a tree and a winding brook.		
Goods/Services	Class 030. First use: First Use: 2010/01/01 First Use In Commerce: 2010/01/01 Candy; chocolate and chocolate-based confectionery, namely, chocolate-covered nuts and chocolate-covered fruit confectionery		

Attachments	75398888#TMSN.png(bytes) 85660057#TMSN.png(bytes) 85519673#TMSN.png(bytes) 4.30.15 - NOA SN 86199666.pdf(29144 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	/paul c. llewellyn/
Name	Paul C. Llewellyn
Date	04/30/2015

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

HERSHEY CANADA INC.,

Opposer,

v.

BROOKSHIRE GROCERY COMPANY,

Applicant.

Opposition No. _____

Mark: BROOKSHIRE'S

Stylized

Serial No: 86/199,666

Filed: February 20, 2014

Published: January 27, 2015

NOTICE OF OPPOSITION


Opposer Hershey Canada Inc. ("Opposer"), a Canadian corporation located and doing business at 5750 Explorer Drive, Suite 500, Mississauga, Ontario, Canada, will be damaged by the registration of the mark BROOKSHIRE'S shown in Application Serial No. 86/199,666, and opposes the same.


As grounds for opposition, Opposer alleges that:

1. Opposer is a wholly-owned subsidiary of The Hershey Company, one of the largest North American manufacturers of quality chocolate and non-chocolate confectionery products. (The Hershey Company is referred together with Opposer and The Hershey Company's other affiliates herein as "Hershey"). Hershey is the owner of a number of trademarks for candy, chocolate, confectionery and related products, which it and its licensees use on a variety of candy, confectionery, food and other products.

2. Opposer is the owner of the famous and well known BROOKSIDE trademarks described herein, which Hershey uses for various products distributed in the United States of America and abroad. Opposer has used the BROOKSIDE marks on candy, chocolate, confectionery, cocoa and related products, since at least 1991.

3. Opposer is the owner of U.S. Trademark Registration No. 2,411,662 on the Principal Register for the trademark BROOKSIDE covering “Candy, chocolate covered nuts; chocolate chips, chocolate covered fruit chips; yogurt flavored wafers; chocolate coatings for other manufacturers; chocolate covered almonds; chocolate covered peanuts; dark and light chocolate” in International Class 30.

4. Opposer also is the owner of U.S. Trademark Registration No. 4,286,013 on the Principal Register for the trademark  **BROOKSIDE** covering “Candy; chocolate covered fruit; chocolate covered nuts” in International Class 30.

5. Opposer also is the owner of U.S. Trademark Registration No. 4,416,727 on the Principal Register for the trademark  **BROOKSIDE** covering “Candy; chocolate and chocolate-based confectionery, namely, chocolate-covered nuts and chocolate-covered fruit confectionery” in International Class 30.

6. Said registrations are valid and subsisting and Opposer hereby gives notice in accordance with Trademark Rule of Practice 2.122(d)(2) that it will rely thereon as evidence in this proceeding, and a status copy thereof showing present title will be introduced into evidence on its behalf during Opposer’s testimony period.

7. As a result of long use, promotion and advertising, the BROOKSIDE trademarks are and have become distinctive of Opposer’s products, have become valuable assets of Opposer, serving as a symbol for Opposer’s goods and services and of the goodwill which is associated with those goods and services.

8. Opposer's BROOKSIDE mark is famous within the meaning of Section 43(c) of the Lanham Act, as amended, 15 U.S.C. § 1125(c).

9. Despite Opposer's long prior common law and statutory rights in the BROOKSIDE trademark, Applicant, with at least constructive notice of Opposer's federal registrations, and long after Opposer established rights in and to the mark BROOKSIDE, adopted and filed an application for registration of the mark BROOKSHIRE'S for a variety of products in various classes, including:

- a. in International Class 29, the following goods to which Opposer objects:
“nut based snack bars; snack mixes consisting primarily of processed nuts; snack mix consisting primarily of processed fruits, processed nuts, dried fruits, and chocolate; snack mix consisting primarily of seeds; snack mix consisting primarily of processed fruits, processed nuts, dried fruits, chocolate, and peanut butter confectionery chips” and
- b. in International Class 30, the following goods to which Opposer objects:
“ready to eat cereals; processed cereals; cookies; crackers; frozen desserts consisting of fruit or cream or cream substitutes; frozen desserts, namely, freezer pops, banana pops, push pops, fudge bars, fruit bars, ice cream bars, ice cream sandwiches, ice cream cups, ice cream, sundae ice cream cones; popcorn; snack mixes consisting primarily of crackers, pretzels and/or popped corn, granola snack bars”.

10. Opposer's mark has priority over Applicant's mark because the filing date of Opposer's first trademark application covering BROOKSIDE was December 2, 1997, and the

date of first use in commerce was in 1991, many years prior to the priority date of Applicant's application.

11. Opposer's BROOKSIDE trademark became famous long before the November 12, 2013 filing date of Applicant's intent-to-use trademark application.

12. Applicant's BROOKSHIRE'S mark is highly and confusingly similar to Opposer's BROOKSIDE mark.

13. Opposer believes and therefore alleges that Applicant's goods set forth in Paragraph 9 above, as described in its application opposed herein, are or would be offered through the same or similar channels of trade to the same or similar customers or users as those goods rendered by Opposer and its licensees under the BROOKSIDE mark, and are highly related to the goods of Opposer and its licensees.

14. Opposer believes and therefore alleges that use and registration of the mark covered by Application Serial No. 86/199,666 will damage Opposer, for the following reasons among others:

- a. customers and purchasers of the respective goods would be confused, mistaken, or deceived as to the source and origin of Applicant's goods rendered under the applied-for mark;
- b. customers and purchasers of the respective goods will assume, contrary to fact, that Applicant's goods come from, are associated with, sponsored by, approved by, or otherwise related to or affiliated with Opposer or the source of Hershey's BROOKSIDE products; and
- c. Applicant's use of the applied-for mark is likely to dilute the distinctive quality of the famous BROOKSIDE mark.

15. Applicant's applied-for mark so resembles Opposer's previously used and registered mark BROOKSIDE as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d).

16. Opposer previously has used in commerce, in connection with its BROOKSIDE products, the trademark and name BROOKSIDE, such that BROOKSIDE became a name or identity of substantial reputation that is closely identified with Opposer. Applicant's applied-for mark BROOKSHIRE'S is highly similar to Opposer's previously used and registered BROOKSIDE mark, so as to be likely, when applied to the goods set forth in the application at issue, to point uniquely to Opposer and to falsely suggest a connection with Opposer within the meaning of 15 U.S.C. § 1052(a).

17. Applicant's applied-for mark is likely to dilute the distinctive quality of Opposer's famous, distinctive and federally-registered mark BROOKSIDE within the meaning of 15 U.S.C. § 1125(c)(1).

WHEREFORE, Opposer respectfully prays that this Opposition be sustained and that registration to Applicant be refused.

The Patent and Trademark Office and Trademark Trial and Appeal Board are hereby authorized to collect any fees necessitated by this Notice of Opposition from the deposit account of Hershey's attorneys, Kaye Scholer LLP, Deposit Account No. 11-0228.

Dated: April 30, 2015

Respectfully submitted,

/Paul C. Llewellyn/
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Attorneys for Opposer Hershey Canada Inc.

CERTIFICATE OF SERVICE

I certify that the foregoing Notice of Opposition is being electronically filed with the United States Patent and Trademark Office on April 30, 2015, and that a true and correct copy of the foregoing Notice of Opposition was served by first-class mail, postage prepaid, on the attorney of record for the Applicant, namely:

Elizabeth K. Stanley, Esq.
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Dallas, Texas 75201-2900

Attorney for Brookshire Grocery Company

/Jennifer Worksman/