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

Proceeding	91221759
Party	Defendant Brookshire Grocery Company
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Date	07/08/2015
Attachments	91221759 - Answer to Ntc of Opposition.pdf(93373 bytes )

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

HERSHEY CANADA INC.,

Opposer,

vs.

BROOKSHIRE GROCERY COMPANY,

Applicant.

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Opposition No. 91221759

Mark: **BROOKSHIRE'S & Design**  
(Serial No: 86199666)

The logo for Brookshire's, featuring the word "Brookshire's" in a bold, sans-serif font. The letter "i" in "Brookshire's" has a small leaf-like graphic above it.

Publication Date: January 27, 2015

**APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES  
TO OPPOSER'S NOTICE OF OPPOSITION**

As and for its Answer and Affirmative Defenses to the Notice of Opposition ("**Opposition**") filed by Hershey Canada, Inc. ("**Opposer**"), Applicant, Brookshire Grocery Company ("**Applicant**" or "**Brookshire**"), through its attorneys, alleges as follows, with the paragraphs herein below being numbered to correspond with the like-numbered paragraphs of the Opposition:

As to the introductory paragraph preceding paragraph 1 of the Opposition, Applicant denies that Opposer will be damaged by the registration of the mark BROOKSHIRE'S and Design which is the subject of Application Serial No. 86/199,666. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in the introductory paragraph and, therefore, denies same. Applicant generally denies the claims and allegations set forth in the Opposition and as more fully stated herein.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 1 of the Opposition and, therefore, denies same.

2. Applicant denies that Opposer's alleged "BROOKSIDE trademarks" asserted in the Opposition are famous and well known. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 2 of the Opposition and, therefore, denies same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 3 of the Opposition and, therefore, denies same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 4 of the Opposition and, therefore, denies same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 5 of the Opposition and, therefore, denies same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 6 of the Opposition and, therefore, denies same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 7 of the Opposition and, therefore, denies same.

8. Applicant denies all the allegations set forth in Paragraph 8 of the Opposition.

9. Applicant admits only that it filed an application to register BROOKSHIRE'S and Design for the goods and services listed in U.S. Application Serial No. 86199666 and that it has adopted the mark BROOKSHIRE'S for a variety of goods and services, including grocery store services which it has rendered to consumers since at least as early as 1928, well before Opposer adopted or registered the marks asserted in its Opposition. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 9 of the Opposition, and, therefore, denies same.

10. Applicant denies that Opposer's mark has priority over Applicant's mark BROOKSHIRE'S. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 10 of the Opposition and, therefore, denies same.

11. Applicant denies all the allegations set forth in Paragraph 11 of the Opposition.

12. Applicant denies all the allegations set forth in Paragraph 12 of the Opposition.

13. Applicant admits only that it sells certain goods of Opposer marketed under the "BROOKSIDE" mark through some of its 150 stores where numerous other items are on display in various departments and aisles on multiple levels of shelf space. Applicant otherwise is without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 13 of the Opposition and, therefore, denies the same.

14. Applicant denies all the allegations set forth in Paragraph 14 of the Opposition, including, but not limited to, all its subparts.

15. Applicant denies all the allegations set forth in Paragraph 15 of the Opposition.

16. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations that "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” and, therefore, denies same. Applicant denies all the remaining allegations set forth in Paragraph 16 of the Opposition.

17. Applicant denies all the allegations set forth in Paragraph 17 of the Opposition.

In response to Opposer’s prayer for relief, Applicant denies the entirety of the allegations set forth in the first conclusory paragraph following Paragraph 17 of the Opposition, and submits that the Opposition should be dismissed in its entirety with prejudice.

The final paragraph preceding the signature of the Opposer’s counsel concerns instructions to the Patent and Trademark Office and the Trademark Trial and Appeal Board to which no response is required. To the extent a response is required, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in the final paragraph preceding the signature of Opposer’s counsel, including the sufficiency of funds in the deposit account necessary to institute this proceeding, and, therefore, denies same.

#### **AFFIRMATIVE DEFENSES**

Pursuant to Federal Rule of Civil Procedure 8, Applicant asserts the following defenses to the Opposition. By setting forth these affirmative defenses, Applicant does not assume the burden of proving any fact, issue, or element of a cause of action where such burden properly belongs to Opposer. Nothing herein is intended or shall be construed as an admission that any particular issue or subject matter is relevant to Opposer’s allegations. Applicant has not knowingly and intentionally waived any applicable defenses, and it hereby reserves all rights to

assert and rely upon other defenses and affirmative defenses that become available as discovery proceeds.

As separate and distinct affirmative defenses, Applicant states as follows:

**First Affirmative Defense**  
*(Failure to State a Claim)*

1. The Opposition fails to state a claim upon which relief can be granted, based, in part, on Opposer's lack of standing and priority over Applicant, the absence of any likelihood of confusion, mistake, deception or false connection, and the lack of fame of the marks allegedly owned and asserted in the Opposition by Opposer.

**Second Affirmative Defense**  
*(Laches, Estoppel by Acquiescence, Equitable Estoppel)*

2. Opposer's claims in the Opposition are barred under the doctrines of estoppel by laches, estoppel by acquiescence and/or equitable estoppel

3. Applicant and Opposer have concurrently used their respective marks BROOKSHIRE'S and BROOKSIDE since at least as early as 1991, as well as in connection with goods in Classes 29 and 30 since 2012. The respective marks at issue have co-existed for many years without any known instances of actual confusion.

4. Since 1991, and during the 24 years of concurrent use, Opposer has not objected to Applicant's use in connection with any goods or services identified by BROOKSHIRE'S or variants, including, but not limited to the following: BROOKSHIRE'S; BROOKSHIRE'S &

Design, depicted as ; and BROOKSHIRE'S FOOD &

PHARMACY & Design, depicted as . Indeed, Opposer or its

affiliated entities provides various products, under brands and marks other than BROOKSIDE or

variants, to Applicant for resale on a regular basis and has done so for many years, and has not objected to Applicant's use of BROOKSHIRE'S and variants for more than a decade.

5. Should Opposer proceed with its claims in the Opposition, Applicant will have relied to its detriment on Opposer's acquiescence, inaction and delay to enforce its alleged rights, insofar as Applicant will have invested substantial time, effort and resources in selecting, adopting, and using BROOKSHIRE'S and variants thereof for many years. On information and belief, Opposer knew or should have known of Applicant's BROOKSHIRE'S marks long before the filing date of the Opposition. As a result, Applicant has detrimentally relied on Opposer's delay, inaction, and acquiescence and will be damaged if the Opposition is sustained because it will be denied the benefits associated with and granted by a federal trademark registration for the mark and goods and services identified in the application at issue. Therefore, Opposer should be barred from proceeding with this Opposition.

**Third Affirmative Defense**

*(No Likelihood of Confusion, Mistake, Deception, or False Connection)*

6. Applicant's mark BROOKSHIRE'S & Design is not likely to cause confusion, mistake or deception with any of Opposer's purported marks based, in part, on the overall differences between the parties respective marks in appearance, pronunciation and commercial impression and the distinct contexts and manners of use.

7. On information and belief, Opposer has used and/or registered its asserted marks subsequent to and concurrently with Alexander & Hornung, Inc.'s use of the mark BROOKSIDE BRAND & Design for goods in Class 29, which are the subject of U.S. Reg. No. 4228921, which identifies a date of first use at least as early as August 1970. If there is no likelihood of confusion arising from marks that use the identical term BROOKSIDE for products in the same class, consumers are not likely to be confused by the registration of the two marks at issue here.

8. On information and belief, as a result of the parties' long coexistence in the marketplace, it is reasonable to conclude that relevant consumers have been conditioned to distinguish between the parties respective marks due, in part, to the differences between the marks in overall appearance, pronunciation and/or commercial impression and distinct contexts and manners of use.

9. Applicant's use and registration of the BROOKSHIRE'S & Design mark on the Principal Register of the USPTO is not likely to cause consumers to believe that Applicant, or its products and services identified by such mark, are in any way associated with, or sponsored or approved by Opposer, or falsely suggest a connection with Opposer or its marks.

**Fourth Affirmative Defense**  
*(Lack of Damages or Injury)*

10. On information and belief, Opposer has not and is not likely to suffer any injury or damage as a result of Applicant's use and registration of the mark BROOKSHIRE'S & Design which is the subject of U.S. Application Serial No. 86199666.

Applicant reserves the right to rely on any and all further affirmative defenses that become available or appear during discovery in this matter, and reserves the right to amend this Answer for the purpose of asserting any such affirmative defenses.

**WHEREFORE**, Applicant requests that Opposition No. 91221759 be dismissed in its entirety, with prejudice, and that registration be granted on its U.S. Application Serial No. 86199666.



Respectfully submitted this the 8th day of July, 2015.

A handwritten signature in cursive script that reads "Paul J. Reilly". The signature is written in black ink and is positioned above a horizontal line.

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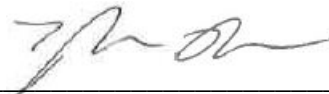
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**ATTORNEYS FOR APPLICANT  
BROOKSHIRE GROCERY COMPANY**

**CERTIFICATE OF SERVICE**

I hereby certify that on this the 8th day of July, 2015, I served, via email and Federal Express overnight courier, a true and correct copy of the foregoing APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO OPPOSER'S NOTICE OF OPPOSITION to:

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Tyler M. Beas