

ESTTA Tracking number: **ESTTA897856**

Filing date: **05/18/2018**

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	Dana Alexander Inc.
Granted to Date of previous extension	05/30/2018
Address	1111 Marcus Avenue Lake Success, NY 11042 UNITED STATES

Attorney information	Kristy Meringolo The Hain Celestial Group, Inc. 1111 Marcus Avenue Lake Success, NY 11042 UNITED STATES Email: IP@hain-celestial.com, melissa.schombs@hain.com Phone: 5165875171
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Applicant Information

Application No	87562384	Publication date	01/30/2018
Opposition Filing Date	05/18/2018	Opposition Period Ends	05/30/2018
Applicant	Trinidad Benham Corporation Suite 300 3650 South Yosemite Denver, CO 80237 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Protein enriched powdered starch, namely, powdered pea starch, powdered bean starch and powdered rice starch

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2288235	Application Date	02/03/1998
Registration Date	10/19/1999	Foreign Priority Date	NONE

Word Mark	TERRA BLUES
Design Mark	TERRA BLUES
Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 1998/12/00 First Use In Commerce: 1998/12/00 VEGETABLE BASED SNACK FOODS

U.S. Registration No.	2352461	Application Date	02/03/1998
Registration Date	05/23/2000	Foreign Priority Date	NONE
Word Mark	TERRA STIX		
Design Mark	TERRA STIX		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1999/06/01 First Use In Commerce: 1999/06/15 PROCESSED VEGETABLE SNACKS		

U.S. Registration No.	1778438	Application Date	02/05/1992
Registration Date	06/22/1993	Foreign Priority Date	NONE
Word Mark	TERRA		
Design Mark	TERRA		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1992/11/30 First Use In Commerce: 1992/11/30 snack chips made from yucca and other root vegetables; namely, sweet potato		

	andruby taro		
U.S. Registration No.	2424109	Application Date	07/19/1999
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	TERRA RED BLISS		
Design Mark	TERRA RED BLISS		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1999/09/15 First Use In Commerce: 1999/09/15 Snack chips made of vegetables		
U.S. Registration No.	2791319	Application Date	11/11/2002
Registration Date	12/09/2003	Foreign Priority Date	NONE
Word Mark	TERRA YUKON GOLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1996/06/00 First Use In Commerce: 1996/06/00 VEGETABLE BASED SNACK FOODS, NAMELY, POTATO CHIPS		
U.S. Registration No.	3869729	Application Date	03/16/2010
Registration Date	11/02/2010	Foreign Priority Date	NONE
Word Mark	TERRA		
Design Mark	TERRA		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1990/08/00 First Use In Commerce: 1990/08/00 Snack chips made of vegetables		

U.S. Registration No.	4270977	Application Date	02/10/2012
Registration Date	01/08/2013	Foreign Priority Date	NONE
Word Mark	TERRA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2011/08/00 First Use In Commerce: 2011/08/00 Dried fruit, dried fruit-based snack chips, fruit chips		

Attachments	75427909#TMSN.png(bytes) 75427983#TMSN.png(bytes) 74249000#TMSN.png(bytes) 75753456#TMSN.png(bytes) 77960099#TMSN.png(bytes) 85539998#TMSN.png(bytes) Notice of Opp 5.15.18.pdf(28347 bytes)
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Signature	/kristymeringolo/
Name	Kristy Meringolo
Date	05/18/2018

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

In the matter of Application Serial Number: 87/562,384
 By: Trinidad Benham Corporation
 Filed: August 9, 2017
 Published in the Official Gazette: January 30, 2018
 Mark: TERRA PROTEIN

Dana Alexander, Inc.

Opposer,

v.

Trinidad Benham Corporation

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Commissioner:

1. Dana Alexander, Inc. (“DANA” or “Opposer”), a New York corporation, having a place of business at 1111 Marcus Avenue, Lake Success, New York 11042, believes that it will be damaged by the registration of Trinidad Benham Corporation (“TBC” or “Applicant”) Application Serial Number 87/562,384 for TERRA PROTEIN in International Class 30 (“Applicant’s Mark”) and hereby opposes the same.

2. DANA owns the following trademark registrations issued by the United States Patent and Trademark Office (“USPTO”):

Mark	Registration Number	Registration Date	Goods
TERRA BLUES	2288235	October 19, 1999	(INT. CL. 29) vegetable based snack foods
TERRA STIX	2352461	May 23, 2000	(INT. CL. 29) vegetable based snacks
TERRA	1778438	June 22, 1993	(INT. CL. 29) snack chips made from yucca and other root vegetables; namely, sweet potato and ruby taro
TERRA RED BLISS	2424109	January 23, 2001	(INT. CL. 29) snack chips made of vegetables

Mark	Registration Number	Registration Date	Goods
TERRA YUKON GOLD	2791319	December 9, 2003	(INT. CL. 29) vegetable based snack foods, namely, potato chips
TERRA	3869729	November 2, 2010	(INT. CL. 29) snack chips made of vegetables
TERRA	4270977	January 8, 2013	(INT. CL. 29) Dried fruit, dried fruit-based snack chips, fruit chips

Copies of the DANA registrations referenced above are attached hereto. The DANA registrations, will be referred to hereafter as the “DANA Marks.”

3. DANA has used the mark TERRA for a variety of vegetable based snack food products (the "DANA Goods") since at least as early as November 1992 in United States interstate commerce.

4. DANA has extensively used the DANA Marks and has advertised, promoted, and offered the DANA Goods under the DANA Marks in interstate commerce through various channels of trade. As a result, DANA customers, potential customers, and the public in general have come to know and recognize the DANA Marks as identifying the DANA Goods as goods of high quality offered by DANA, and associates the DANA Marks with the DANA Goods. DANA has thus built up extensive and invaluable goodwill in connection with the sale of the DANA Goods offered under the DANA Marks.

5. Notwithstanding DANA's exclusive and long-standing rights in and to the DANA Marks, on August 9, 2017, Applicant filed an application under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051 (b), with the USPTO for registration of the trademark TERRA PROTEIN that was assigned Serial number 87/459522 (hereinafter the “Application”) for “*Powdered starch, namely powered pea starch, powdered bean starch and powdered rise starch*”, International Class 30 (“Applicant’s Goods”) based on Intent to Use 1(b).

6. There is no issue as to priority. Opposer's use of the DANA Marks started prior to the Application filed by the Applicant and Opposer obtained registrations for its DANA Marks prior to the filing date of the Application.

7. Upon information and belief, Applicant knew or had reason to know of the DANA Marks when Applicant filed the Application.

8. DANA has used the DANA Marks continuously on or in connection with the DANA Goods in interstate commerce prior to the filing date of the Application.

9. DANA's USPTO registrations for the DANA Marks identified above provide, at the very least, constructive notice to Applicant of DANA rights in and to the DANA Marks.

LIKELIHOOD OF CONFUSION
Section 2(d) of the Lanham Act, 15 U.S.C § 1052(d)

10. Opposer re-alleges the allegations contained in Paragraphs 1 through 9 of this Notice of Opposition.

11. The trademark that Applicant seeks to register so resembles DANA Marks in appearance, sound, meaning, and commercial impression that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's Goods in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and will injure and damage DANA and the goodwill and reputation symbolized by the DANA Marks. In fact, the Applicant's designation TERRA PROTEIN is nearly identical to Opposer's mark TERRA.

12. Likelihood of confusion is enhanced by the fact that the DANA Marks are strong, famous, well-known, and entitled to a broad scope of protection.

13. Likelihood of confusion is also enhanced by the fact that Applicant's mark TERRA PROTEIN is visually similar to the DANA Marks.

14. Applicant is not affiliated or connected with DANA and has not been endorsed or sponsored by DANA, nor has DANA approved any of the goods offered or sold or intended to be sold by Applicant under the designation TERRA PROTEIN.

15. Applicant has never sought or obtained DANA's permission to use the designation TERRA PROTEIN or any other mark, nor has DANA approved any of the goods offered by Applicant under the designation TERRA PROTEIN.

16. Opposer would be injured and damaged caused by the likelihood of confusion if Applicant is permitted to use and register its TERRA PROTEIN mark for the Applicant's Goods, by reason of the similarity between the TERRA PROTEIN designation and the DANA Marks. The aforesaid confusion would generate the erroneous impression that the Applicant's Goods originate with Opposer or that Applicant's Goods are authorized, licensed or endorsed by, or are connected or associated in some way with Opposer or the DANA Goods. Thus, any fault found with Applicant or its goods under the TERRA PROTEIN designation would reflect adversely upon and damage Opposer's TERRA Marks and the valuable goodwill associated therewith.

DILUTION BY BLURRING
Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c)

17. DANA re-alleges the allegations contained in Paragraphs 1 through 17 of this Notice of Opposition.

18. In light of the strength of the DANA Marks, the length and extent of Opposer's continuous use and advertising of its DANA Marks, the widespread use of the DANA Marks, and the degree of recognition of the DANA Marks, one or more of the DANA Marks have become famous.

19. The DANA Marks became well-known and famous before Applicant made any use of or applied to register the designation TERRA PROTEIN.

20. Applicant's designation TERRA PROTEIN is likely to cause dilution by blurring of the distinctive quality of the famous DANA Marks.

21. It is likely that Applicant's designation TERRA PROTEIN, when applied to Applicant's Goods, will dilute Opposer's DANA Marks because the dominant portion of Applicant's designation are the term "TERRA," which is exactly the same in appearance and overall commercial impression to Opposer's DANA Marks, and for use with related goods. Registration of Applicant's designation TERRA PROTEIN will lessen the capacity of DANA's famous DANA Marks to identify and distinguish the DANA Goods.

23. If Applicant obtains such rights as conferred under the Principal Register of the Lanham Act, it will obtain at least a *prima facie* exclusive right to use its trademark, and DANA will be subjected to great and irreparable damage, while Applicant will enjoy unlawful gain and advantage to which it is not entitled under the Lanham Act.

WHEREFORE, DANA believes and avers that it is being, and will continue to be, damaged by the registration of the Application, and respectfully requests that the USPTO reject the Application, not issue any registration thereon to Applicant, and sustain the Opposition in favor of DANA.

Dana Alexander, Inc., continues to appoint its parent company, The Hain Celestial Group Inc., to transact all business in the USPTO in connection with this Opposition proceeding and hereby revokes all previous powers of attorney herein and requests that the correspondent name/address be updated to the below.

Please address all correspondence to:

Kristy Meringolo, Esq.
The Hain Celestial Group Inc.
Senior Vice President and General Counsel
1111 Marcus Avenue
Lake Success, New York 11042
Email: IP@hain-celestial.com
Phone: 516-587-5010

The filing fee for this opposition, in the amount of \$400.00, is hereby electronically transferred with the submission of the Notice of Opposition.

Dated: May 18, 2018

Respectfully submitted,

By: /s/Kristy Meringolo/

Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the *Notice of Opposition* has been served via electronic transmission and overnight mail to the attorneys for Applicant the below on this 18th day of May 2018.

DAVID F. DOCKERY
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Filed with the TTAB via ESTTA on May 18, 2018