

ESTTA Tracking number: **ESTTA978522**

Filing date: **06/05/2019**

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

Proceeding	91248292
Party	Plaintiff Borden Dairy Company, Comercializadora de Lácteos y Derivados, S.A. de C.V.
Correspondence Address	VINCENT C. LOMBARDOZZI VORYS SATER SEYMOUR AND PEASE LLP 1909 K STREET NW NINTH FLOOR WASHINGTON, DC 20006 UNITED STATES iplaw@vorys.com, ltgeyer@vorys.com, vclombardozz@vorys.com 202-467-8800
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Vincent C. Lombardozzi
Filer's email	iplaw@vorys.com, ltgeyer@vorys.com, vclombardozz@vorys.com
Signature	/vcl/
Date	06/05/2019
Attachments	Motion to File an Amended Notice of Opposition and Amended Notice.pdf(772146 bytes)

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

In the Matter of Serial Number 88022622.

Comercializadora de Lacteos y Derivados, S.A. de C.V.,
and

Borden Dairy Company,

Opposers,

Opposition No. 91248292

v.

1412 Broadway Rooftop LLC,

Applicant.

OPPOSERS' MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION

Pursuant to Fed. R. Civ. P. 15(a), 37 C.F.R. § 2.107 and TBMP §§315 and 507, Opposers Comercializadora de Lacteos y Derivados, S.A. de C.V. and Borden Dairy Company (“Opposers”) respectfully request leave to file an Amended Notice of Opposition (“Amended Notice”), a copy of which is attached as **Exhibit 1**. A redlined copy showing the changes to the original Notice is attached as **Exhibit 2**. The Amended Notice is to correct an inadvertently cited expired registration. The filing of this motion is timely because it is before Applicant has filed its Answer.

Respectfully submitted,



Laura T. Geyer
Vincent C. Lombardozzi
Vorys, Sater, Seymour and Pease LLP
1909 K Street, NW, Ninth Floor
Washington, DC 20006
Tel: 202-467-8800
iplaw@vorys.com
Attorneys for Opposers

Dated: June 5, 2019

EXHIBIT 1

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

In the Matter of Serial Number 88022622.

Comercializadora de Lacteos y Derivados, S.A. de C.V.,
and

Borden Dairy Company,

Opposers,

Opposition No. 91248292

v.

1412 Broadway Rooftop LLC,

Applicant.

AMENDED NOTICE OF OPPOSITION

Comercializadora de Lacteos y Derivados, S.A. de C.V. and Borden Dairy Company (each an “Opposer” and collectively the “Opposers”) believe they are and will continue to be damaged by registration of Application Serial No. 88022622 for the mark ELSIE, and therefore oppose the same. In support of this Amended Notice of Opposition, Opposers allege the following:

1. Comercializadora de Lácteos y Derivados, S.A. de C.V. (hereafter, “COMLADE”) is a Mexican *sociedad anónima de capital variable* with offices located at Parque Indus. Carlos A. Herrera Araluce, Calzada Carlos Herrera Araluce No. 185, Gómez Palacio, Durango, Mexico 35079.

2. Borden Dairy Company (hereafter “Borden”) is a Delaware corporation located at 8750 North Central Expressway, Suite 400, Dallas, Texas, United States 75231.

3. According to current TSDR records, Applicant 1412 Broadway Rooftop LLC (hereafter, “Applicant”) is a New York limited liability company located at 1178 Broadway, 5th Floor, New York, New York, United States 10001.

Factual Background

4. COMLADE is the owner of the mark ELSIE, which it and / or its predecessors-in-interest and / or licensees have used and promoted continuously throughout the United States in connection with a variety of *dairy and non-dairy foods and beverages* (the “ELSIE Goods”) since at least as early as 1954 (hereafter the “ELSIE Mark”). As a result of such continuous use, COMLADE owns strong common law rights in the ELSIE Mark in connection with the ELSIE Goods and related goods and services.

5. COMLADE also owns the following federal registration for the mark comprising the word ELSIE (hereafter the “ELSIE Registration”):

Mark	Reg. No.	Goods	Filing Date	Reg. Date
ELSIE	3271334	IC 29 – milk, cream, yogurt, evaporated and condensed milk, butter, cheese, cream-cheese, cottage cheese, sour cream, eggnog, powdered non-dairy coffee creamer	Oct. 19, 2006	July 31, 2007

A copy of the TSDR record for this registration is attached as **Exhibit A**.

6. The ELSIE Registration is incontestable.

7. Borden licenses rights from COMLADE to use the ELSIE Mark for a variety of dairy and non-dairy foods.

8. On July 2, 2018, Applicant filed Application Serial No. 88022622 to register the mark ELSIE for *bar and restaurant services* in International Class 43 (hereafter, the “ELSIE Application”).

9. The ELSIE Application is based on Applicant’s intent to use the mark in commerce.

10. On information and belief, Applicant currently uses its applied-for mark ELSIE in connection with a bar located at 1412 Broadway, 25th Floor, New York, NY, United States 10018.

11. On information and belief, Applicant formed on February 26, 2016 (the “Formation Date”) and did not exist prior to the Formation Date.

12. On information and belief, Applicant registered the website domain www.elsierooftop.com on July 1, 2018 and did not use that website prior to the Website Registration Date.

13. On information and belief, Applicant did not use the mark ELSIE in connection with bar or restaurant services prior to the Formation Date.

14. The ELSIE Application published for opposition on November 20, 2018.

15. On December 18, 2018, Opposers each filed a request for a 90-day extension of the deadline to oppose the ELSIE Application, which requests were granted.

16. On March 19, 2019 Opposers each filed a request for an additional 60-day extension of the deadline to oppose the ELSIE Application, which requests were granted.

Standing

17. Opposers have standing in this proceeding because they believe they are and will be damaged by registration of the applied-for mark ELSIE appearing in the ELSIE Application by virtue of Opposers' prior common law rights and the priority of the ELSIE Registration.

Claim One - Likelihood of Confusion

18. Opposers re-allege and incorporate by reference Paragraphs 1 through 17.

19. Applicant's applied-for mark ELSIE appearing in the ELSIE Application is likely to cause consumer confusion with Opposers' ELSIE Mark and the mark appearing in Opposers' ELSIE Registration.

20. Applicant's applied-for mark ELSIE is identical to Opposers' ELSIE Mark and the mark appearing in Opposers' ELSIE Registration.

21. The *bar and restaurant services* claimed in the ELSIE Application are related to Opposers' ELSIE Goods because *bar and restaurant services* involve the provision of foods and beverages.

22. Opposers have not consented to the use of the mark ELSIE by Applicant.

23. Opposers have not consented to Applicant's filing of the ELSIE Application.

24. Opposers and / or their predecessors-in-interest and /or licensees have used and promoted the ELSIE Mark continuously in the United States since before the application filing date of the ELSIE Application.

25. Opposers and / or their predecessors-in-interest and /or licensees have used and promoted the ELSIE Mark continuously in the United States since before Applicant first used its applied-for mark ELSIE.

26. The application filing date of the ELSIE Registration precedes the application filing date of the ELSIE Application.

27. The application filing date of the ELSIE Registration precedes the first use date of the applied-for mark ELSIE by Applicant.

28. As a result of Opposers' prior use of the ELSIE Mark and the prior application date of the ELSIE Registration, Opposers have prior rights with respect to both the ELSIE Application and use of the applied-for mark ELSIE by Applicant.

29. Therefore, the mark appearing in the ELSIE Application so resembles a mark previously used and / or registered by Opposers as to be likely, when used on or in connection with food, beverages and related services, to cause confusion, mistake or deception among the consuming public and should be refused under 15 U.S.C. § 1052(d).

Claim Two – Likelihood of Dilution

30. Opposers re-allege and incorporate by reference Paragraphs 1 through 17.

31. Through extensive use and promotion, Opposers' distinctive ELSIE Mark, by itself and as embodied in the ELSIE Registration, has become famous as defined under 15 U.S.C. § 1125(c).

32. Opposers' ELSIE Mark, by itself and as embodied in the ELSIE Registration, became famous before the July 2, 2018 filing date of the ELSIE Application.

33. Opposers' ELSIE Mark, by itself and as embodied in the ELSIE Registration, became famous before the Formation Date of Applicant.

34. Therefore, the mark appearing in the ELSIE Application is likely to dilute the distinctiveness of Opposers' ELSIE Mark, by itself and as embodied in the ELSIE Registration, and should be refused under 15 U.S.C. § 1125(c).

Relief Sought

For the foregoing reasons, this opposition should be sustained and Application Serial No. 88022622 should be refused. The required fees accompany this Notice of Opposition. Should the fees be found insufficient for any reason, please charge any additional fees to Deposit Account No. 50-6424. Please direct all correspondence to counsel for Opposer at the address indicated below.

Respectfully submitted,



Dated: June 5, 2019

Laura T. Geyer
Vincent C. Lombardozzi
Vorys, Sater, Seymour and Pease LLP
1909 K Street, NW, Ninth Floor
Washington, DC 20006
Tel: 202-467-8800
iplaw@vorys.com

Attorneys for Opposer

SERVICE

I, Vincent C. Lombardozi, certify that a true and correct copy of the foregoing OPPOSERS' MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION was served on counsel for Applicant by electronic mail at the following addresses:

charles.aini@gmail.com

charlyo23@aol.com

Dated: June 5, 2019



Vincent C. Lombardozi
Vorys, Sater, Seymour and Pease LLP
1909 K Street, NW, Ninth Floor
Washington, DC 20006
Tel: 202-467-8800
iplaw@vorys.com
Attorney for Opposer

EXHIBIT A

Generated on: This page was generated by TSDR on 2019-05-20 09:50:06 EDT

Mark: ELSIE

ELSIE

US Serial Number: 77025330

Application Filing Date: Oct. 19, 2006

US Registration Number: 3271334

Registration Date: Jul. 31, 2007

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Feb. 11, 2018

Publication Date: May 15, 2007

Mark Information

Mark Literal Elements: ELSIE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 0810861, 2464457

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [..] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: milk, cream, yogurt, [powdered,] evaporated and condensed milk, butter, cheese, cream-cheese, cottage cheese, sour cream, eggnog, [liquid and] powdered non-dairy coffee creamer [, mincemeat]

International Class(es): 029 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(a)

First Use: 1954

Use in Commerce: 1954

For: [frozen yogurt, sorbet,] [ice cream]

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: 1954

Use in Commerce: 1954

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently 44D: No
Currently 44E: No
Currently 66A: No
Currently No Basis: No

Amended 44D: No
Amended 44E: No

Current Owner(s) Information

Owner Name: COMERCIALIZADORA DE LACTEOS Y DERIVADOS, S.A. DE C.V.

Owner Address: Industrial Carlos A Herrera Araluce
Calzada Carlos Herrera Araluce No. 185
Gómez Palacio, Durango 35079
MEXICO

Legal Entity Type: SOCIEDAD ANONIMA DE CAPITAL VARIABLE: **State or Country** MEXICO
MEXICO **Where Organized:**

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Laura T. Geyer **Docket Number:** 70615-2
Attorney Primary Email Address: iplaw@vorys.com **Attorney Email Authorized:** Yes

Correspondent

Correspondent Name/Address: Laura T. Geyer
Vorys, Sater, Seymour and Pease LLP
P.O. Box 2255
IPLaw@Vorys
Columbus, OHIO 43216-2255
UNITED STATES
Phone: (202) 467-8800 **Fax:** (202) 533-9099
Correspondent e-mail: iplaw@vorys.com **Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 11, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 - E-MAILED	
Feb. 11, 2018	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	30004
Feb. 11, 2018	REGISTERED - SEC. 9 GRANTED/CHECK RECORD FOR SEC. 8	30004
Feb. 11, 2018	REGISTERED - PARTIAL SEC. 8 (10-YR) ACCEPTED	30004
Feb. 02, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	30004
Jan. 11, 2018	TEAS SECTION 8 & 9 RECEIVED	
Jul. 20, 2017	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Jul. 20, 2017	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Jul. 31, 2016	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Mar. 28, 2016	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 28, 2016	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Feb. 25, 2015	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 23, 2014	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 16, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Aug. 16, 2013	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	77315
Jul. 31, 2013	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	77315
Aug. 15, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Jul. 31, 2013	TEAS SECTION 8 & 15 RECEIVED	
Dec. 03, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Dec. 01, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 31, 2007	REGISTERED-PRINCIPAL REGISTER	
May 15, 2007	PUBLISHED FOR OPPOSITION	

Apr. 25, 2007	NOTICE OF PUBLICATION	
Mar. 20, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	78289
Mar. 19, 2007	ASSIGNED TO LIE	78289
Feb. 22, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 22, 2007	ASSIGNED TO EXAMINER	73703
Oct. 25, 2006	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jul. 31, 2017

Change in Registration: Yes

TM Staff and Location Information

TM Staff Information - None File Location

Current Location: TMO LAW OFFICE 116 **Date in Location:** Feb. 11, 2018

Assignment Abstract Of Title Information

Summary

Total Assignments: 4 **Registrant:** Hexion Specialty Chemicals, Inc.

Assignment 1 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4265/0188](#) **Pages:** 36

Date Recorded: Aug. 23, 2010

Supporting Documents: [assignment-tm-4265-0188.pdf](#)

Assignor

Name: [HEXION SPECIALTY CHEMICALS, INC.](#) **Execution Date:** May 21, 2010

Legal Entity Type: CORPORATION **State or Country Where Organized:** NEW JERSEY

Assignee

Name: [IBE BUSINESS ENTERPRISE AG](#)

Legal Entity Type: CORPORATION **State or Country Where Organized:** SWITZERLAND

Address: BAARERSTRASSE 86
6300 ZUG, SWITZERLAND

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255
IPLAW@VORYS
COLUMBUS, OH 43216-2255

Domestic Representative

Domestic Representative Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Domestic Representative Address: 1909 K STREET NW
NINTH FLOOR
WASHINGTON, DC 20006-1152

Assignment 2 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5324/0300](#)

Pages: 43

Date Recorded: Jul. 17, 2014

Supporting Documents: [assignment-tm-5324-0300.pdf](#)

Assignor

Name: [IBE BUSINESS ENTERPRISE AG](#)

Execution Date: Dec. 18, 2013

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

Assignee

Name: [LALA BRANDED PRODUCTS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: TEXAS

Address: 8750 NORTH CENTRAL EXPRESSWAY
SUITE 400
DALLAS, TEXAS 75231

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255
IPLAW@VORYS ATTN CORY M. AMRON
COLUMBUS, OH 43216-2255

Domestic Representative - Not Found

Assignment 3 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5324/0467](#)

Pages: 40

Date Recorded: Jul. 17, 2014

Supporting Documents: [assignment-tm-5324-0467.pdf](#)

Assignor

Name: [LALA BRANDED PRODUCTS, INC.](#)

Execution Date: Mar. 24, 2014

Legal Entity Type: CORPORATION

State or Country Where Organized: TEXAS

Assignee

Name: [INTERNATIONAL BUSINESS ENTERPRISE, S.DE R.L.DE C.V.](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: MEXICO

Address: CALZADA LAZARO CARDENAS 185
PARQUE INDUSTRIAL LAGUNERO
GOMEZ PALACIO, DURANGO 35070, MEXICO

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255
IPLAW@VORYS ATTN: CORY M. AMRON
COLUMBUS, OH 43216-2255

Domestic Representative

Domestic Representative Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Domestic Representative Address: P.O. BOX 2255
IPLAW@VORYS
COLUMBUS, OH 43216-2255

Assignment 4 of 4

Conveyance: MERGER EFFECTIVE 12/31/2014

Reel/Frame: [5463/0620](#)

Pages: 4

Date Recorded: Feb. 20, 2015

Supporting Documents: [assignment-tm-5463-0620.pdf](#)

Assignor

Name: [INTERNATIONAL BUSINESS ENTERPRISE, S. DE R.L. DE C.V.](#)

Execution Date: Dec. 31, 2014

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: MEXICO

Assignee

Name: [COMERCIALIZADORA DE LACTEOS Y DERIVADOS, S.A. DE C.V.](#)

Legal Entity Type: SOCIEDAD ANONIMA DE CAPITAL VARIABLE: MEXICO

State or Country Where Organized: MEXICO

Address: CALZADA LAZARO CARDENAS #185
PARQUE INDUSTRIAL LAGUNERO
GOMEZ PALACIO, DURANGO, MEXICO 35077

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255 -- IPLAW@VORYS
ATTN: CORY M. AMRON, ESQ.
COLUMBUS, OH 43216-2255

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91208929](#)

Filing Date: Jan 18, 2013

Status: Terminated

Status Date: Jun 14, 2013

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Lieberman Companies, Inc.

Correspondent Address: JOEL D LEVITON
FISH & RICHARDSON PC
PO BOX 1022
MINNEAPOLIS MN , 55440-1022
UNITED STATES

Correspondent e-mail: jd@fr.com , tmdoct@fr.com , kmo@fr.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ELSIE'S	Registered	85560950	4593294

Plaintiff(s)

Name: IBE Business Enterprise AG

Correspondent Address: CORY M AMRON
VORYS SATER SEYMOUR AND PEASE LLP
P.O. BOX 2255
COLUMBUS OH , 43216-2255
UNITED STATES

Correspondent e-mail: CMAmron@vorys.com , iplaw@vorys.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
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ELSIE	REGISTERED AND RENEWED	72231036	810861
ELSIE	REGISTERED AND RENEWED	77025330	3271334
ELSIE BORDEN	REGISTERED AND RENEWED	77034096	3271357
ELSIE BORDEN	Cancelled - Section 8	77104776	3323199
ELSIE BORDEN	REGISTERED AND RENEWED	77202537	3380947
FRIENDS OF ELSIE	Cancelled - Section 8	77476878	3709689
FRIENDS OF ELSIE	Cancelled - Section 8	77484822	3709705
BORDEN ELSIE	Section 8 and 15 - Accepted and Acknowledged	77778412	4190983
BORDEN ELSIE	Section 8 and 15 - Accepted and Acknowledged	85218992	4011916
BORDEN ELSIE	Section 8 and 15 - Accepted and Acknowledged	85413453	4135324
ELSIE THE COW	Abandoned - No Statement Of Use Filed	85687504	
ELSIE BORDEN	REGISTERED AND RENEWED	75747000	2464457

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 18, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 18, 2013	Feb 27, 2013
3	PENDING, INSTITUTED	Jan 18, 2013	
4	STIPULATION FOR AN EXTENSION OF TIME	Feb 20, 2013	
5	EXTENSION OF TIME GRANTED	Feb 20, 2013	
6	STIP FOR EXT	Mar 28, 2013	
7	EXTENSION OF TIME GRANTED	Mar 28, 2013	
8	STIP FOR EXT	Apr 22, 2013	
9	EXTENSION OF TIME GRANTED	Apr 22, 2013	
10	W/DRAW OF OPPOSITION	May 20, 2013	
11	P CHANGE OF CORRESP ADDRESS	May 24, 2013	
12	BD DECISION: DISMISSED W/O PREJ	Jun 14, 2013	
13	TERMINATED	Jun 14, 2013	

EXHIBIT 2

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

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1. Comercializadora de Lácteos y Derivados, S.A. de C.V. (hereafter, “COMLADE”) is a Mexican *sociedad anónima de capital variable* with offices located at Parque Indus. Carlos A. Herrera Araluce, Calzada Carlos Herrera Araluce No. 185, Gómez Palacio, Durango, Mexico 35079.

2. Borden Dairy Company (hereafter “Borden”) is a Delaware corporation located at 8750 North Central Expressway, Suite 400, Dallas, Texas, United States 75231.

3. According to current TSDR records, Applicant 1412 Broadway Rooftop LLC (hereafter, “Applicant”) is a New York limited liability company located at 1178 Broadway, 5th Floor, New York, New York, United States 10001.

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4. COMLADE is the owner of the mark ELSIE, which it and / or its predecessors-in-interest and / or licensees have used and promoted continuously throughout the United States in connection with a variety of *dairy and non-dairy foods and beverages* (the “ELSIE Goods”) since at least as early as 1954 (hereafter the “ELSIE Mark”). As a result of such continuous use, COMLADE owns strong common law rights in the ELSIE Mark in connection with the ELSIE Goods and related goods and services.

5. COMLADE also owns the following federal registrations for the marks comprising the word ELSIE (hereafter the “ELSIE Registrations”):

Mark	Reg. No.	Goods	Filing Date	Reg. Date
ELSIE	810861	IC 29—ice cream	Oct. 22, 1965	July 5, 1966
ELSIE	3271334	IC 29 – milk, cream, yogurt, evaporated and condensed milk, butter, cheese, cream-cheese, cottage cheese, sour cream, eggnog, powdered non-dairy coffee creamer	Oct. 19, 2006	July 31, 2007

~~Copies~~ A copy of the TSDR records for ~~these~~ these registrations ~~are~~ is attached as **Exhibit A**.

6. The ELSIE Registrations ~~are~~ is incontestable.

7. Borden licenses rights from COMLADE to use the ELSIE Mark for a variety of dairy and non-dairy foods.

8. On July 2, 2018, Applicant filed Application Serial No. 88022622 to register the mark ELSIE for *bar and restaurant services* in International Class 43 (hereafter, the “ELSIE Application”).

9. The ELSIE Application is based on Applicant’s intent to use the mark in commerce.

10. On information and belief, Applicant currently uses its applied-for mark ELSIE in connection with a bar located at 1412 Broadway, 25th Floor, New York, NY, United States 10018.

11. On information and belief, Applicant formed on February 26, 2016 (the “Formation Date”) and did not exist prior to the Formation Date.

12. On information and belief, Applicant registered the website domain www.elsierooftop.com on July 1, 2018 and did not use that website prior to the Website Registration Date.

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14. The ELSIE Application published for opposition on November 20, 2018.

15. On December 18, 2018, Opposers each filed a request for a 90-day extension of the deadline to oppose the ELSIE Application, which requests were granted.

16. On March 19, 2019 Opposers each filed a request for an additional 60-day extension of the deadline to oppose the ELSIE Application, which requests were granted.

Standing

17. Opposers have standing in this proceeding because they believe they are and will be damaged by registration of the applied-for mark ELSIE appearing in the ELSIE Application by virtue of Opposers' prior common law rights and the priority of the ELSIE Registrations.

Claim One - Likelihood of Confusion

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20. Applicant's applied-for mark ELSIE is identical to Opposers' ELSIE Mark and the marks appearing in Opposers' ELSIE Registrations.

21. The *bar and restaurant services* claimed in the ELSIE Application are related to Opposers' ELSIE Goods because *bar and restaurant services* involve the provision of foods and beverages.

22. Opposers have not consented to the use of the mark ELSIE by Applicant.

23. Opposers have not consented to Applicant's filing of the ELSIE Application.

24. Opposers and / or their predecessors-in-interest and /or licensees have used and promoted the ELSIE Mark continuously in the United States since before the application filing date of the ELSIE Application.

25. Opposers and / or their predecessors-in-interest and /or licensees have used and promoted the ELSIE Mark continuously in the United States since before Applicant first used its applied-for mark ELSIE.

26. The application filing dates of the ELSIE Registrations precedes the application filing date of the ELSIE Application.

27. The application filing dates of the ELSIE Registrations precedes the first use date of the applied-for mark ELSIE by Applicant.

28. As a result of Opposers' prior use of the ELSIE Mark and the prior application dates of the ELSIE Registrations, Opposers have prior rights with respect to both the ELSIE Application and use of the applied-for mark ELSIE by Applicant.

29. Therefore, the mark appearing in the ELSIE Application so resembles a mark previously used and / or registered by Opposers as to be likely, when used on or in connection with food, beverages and related services, to cause confusion, mistake or deception among the consuming public and should be refused under 15 U.S.C. § 1052(d).

Claim Two – Likelihood of Dilution

30. Opposers re-allege and incorporate by reference Paragraphs 1 through 17.

31. Through extensive use and promotion, Opposers' distinctive ELSIE Mark, by itself and as embodied in the ELSIE Registrations, has become famous as defined under 15 U.S.C. § 1125(c).

32. Opposers' ELSIE Mark, by itself and as embodied in the ELSIE Registrations, became famous before the July 2, 2018 filing date of the ELSIE Application.

33. Opposers' ELSIE Mark, by itself and as embodied in the ELSIE Registrations, became famous before the Formation Date of Applicant.

34. Therefore, the mark appearing in the ELSIE Application is likely to dilute the distinctiveness of Opposers' ELSIE Mark, by itself and as embodied in the ELSIE Registrations, and should be refused under 15 U.S.C. § 1125(c).

Relief Sought

For the foregoing reasons, this opposition should be sustained and Application Serial No. 88022622 should be refused. The required fees accompany this Notice of Opposition. Should the fees be found insufficient for any reason, please charge any additional fees to Deposit Account No. 50-6424. Please direct all correspondence to counsel for Opposer at the address indicated below.

Respectfully submitted,



Dated: ~~May 20~~June 5, 2019

Laura T. Geyer
Vincent C. Lombardozzi
Vorys, Sater, Seymour and Pease LLP
1909 K Street, NW, Ninth Floor
Washington, DC 20006
Tel: 202-467-8800
iplaw@vorys.com

Attorneys for Opposer

SERVICE

~~Pursuant to 37 C.F.R. § 2.105 and TBMP § 309.02(c)(1), service of this Notice of Opposition will be provided by the Board in conjunction with the issuance of the Notice of Institution. I, Vincent C. Lombardozi, certify that a true and correct copy of the foregoing OPPOSERS' MOTION FOR LEAVE TO FILE AN AMENDED NOTICE OF OPPOSITION was served on counsel for Applicant by electronic mail at the following addresses:~~

~~charles.aini@gmail.com~~

~~charlyo23@aol.com~~



~~Dated: June 5, 2019~~

~~Vincent C. Lombardozi
Vorys, Sater, Seymour and Pease LLP
1909 K Street, NW, Ninth Floor
Washington, DC 20006
Tel: 202-467-8800
iplaw@vorys.com
Attorney for Opposer~~

EXHIBIT A

Generated on: This page was generated by TSDR on 2019-05-20 09:50:06 EDT

Mark: ELSIE

ELSIE

US Serial Number: 77025330

Application Filing Date: Oct. 19, 2006

US Registration Number: 3271334

Registration Date: Jul. 31, 2007

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Feb. 11, 2018

Publication Date: May 15, 2007

Mark Information

Mark Literal Elements: ELSIE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 0810861, 2464457

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: milk, cream, yogurt, [powdered,] evaporated and condensed milk, butter, cheese, cream-cheese, cottage cheese, sour cream, eggnog, [liquid and] powdered non-dairy coffee creamer [, mincemeat]

International Class(es): 029 - Primary Class

U.S Class(es): 046

Class Status: ACTIVE

Basis: 1(a)

First Use: 1954

Use in Commerce: 1954

For: [frozen yogurt, sorbet,] [ice cream]

International Class(es): 030 - Primary Class

U.S Class(es): 046

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: 1954

Use in Commerce: 1954

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently 44D: No
Currently 44E: No
Currently 66A: No
Currently No Basis: No

Amended 44D: No
Amended 44E: No

Current Owner(s) Information

Owner Name: COMERCIALIZADORA DE LACTEOS Y DERIVADOS, S.A. DE C.V.

Owner Address: Industrial Carlos A Herrera Araluce
Calzada Carlos Herrera Araluce No. 185
Gómez Palacio, Durango 35079
MEXICO

Legal Entity Type: SOCIEDAD ANONIMA DE CAPITAL VARIABLE: **State or Country** MEXICO
MEXICO **Where Organized:**

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Laura T. Geyer **Docket Number:** 70615-2
Attorney Primary Email Address: iplaw@vorys.com **Attorney Email Authorized:** Yes

Correspondent

Correspondent Name/Address: Laura T. Geyer
Vorys, Sater, Seymour and Pease LLP
P.O. Box 2255
IPLaw@Vorys
Columbus, OHIO 43216-2255
UNITED STATES
Phone: (202) 467-8800 **Fax:** (202) 533-9099
Correspondent e-mail: iplaw@vorys.com **Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 11, 2018	NOTICE OF ACCEPTANCE OF SEC. 8 - E-MAILED	
Feb. 11, 2018	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	30004
Feb. 11, 2018	REGISTERED - SEC. 9 GRANTED/CHECK RECORD FOR SEC. 8	30004
Feb. 11, 2018	REGISTERED - PARTIAL SEC. 8 (10-YR) ACCEPTED	30004
Feb. 02, 2018	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	30004
Jan. 11, 2018	TEAS SECTION 8 & 9 RECEIVED	
Jul. 20, 2017	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Jul. 20, 2017	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Jul. 31, 2016	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Mar. 28, 2016	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 28, 2016	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Feb. 25, 2015	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 23, 2014	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 16, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Aug. 16, 2013	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	77315
Jul. 31, 2013	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	77315
Aug. 15, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Jul. 31, 2013	TEAS SECTION 8 & 15 RECEIVED	
Dec. 03, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Dec. 01, 2010	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 31, 2007	REGISTERED-PRINCIPAL REGISTER	
May 15, 2007	PUBLISHED FOR OPPOSITION	

Apr. 25, 2007	NOTICE OF PUBLICATION	
Mar. 20, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	78289
Mar. 19, 2007	ASSIGNED TO LIE	78289
Feb. 22, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 22, 2007	ASSIGNED TO EXAMINER	73703
Oct. 25, 2006	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jul. 31, 2017

Change in Registration: Yes

TM Staff and Location Information

TM Staff Information - None File Location

Current Location: TMO LAW OFFICE 116 **Date in Location:** Feb. 11, 2018

Assignment Abstract Of Title Information

Summary

Total Assignments: 4 **Registrant:** Hexion Specialty Chemicals, Inc.

Assignment 1 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4265/0188](#) **Pages:** 36

Date Recorded: Aug. 23, 2010

Supporting Documents: [assignment-tm-4265-0188.pdf](#)

Assignor

Name: [HEXION SPECIALTY CHEMICALS, INC.](#) **Execution Date:** May 21, 2010

Legal Entity Type: CORPORATION **State or Country Where Organized:** NEW JERSEY

Assignee

Name: [IBE BUSINESS ENTERPRISE AG](#)

Legal Entity Type: CORPORATION **State or Country Where Organized:** SWITZERLAND

Address: BAARERSTRASSE 86
6300 ZUG, SWITZERLAND

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255
IPLAW@VORYS
COLUMBUS, OH 43216-2255

Domestic Representative

Domestic Representative Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Domestic Representative Address: 1909 K STREET NW
NINTH FLOOR
WASHINGTON, DC 20006-1152

Assignment 2 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5324/0300](#)

Pages: 43

Date Recorded: Jul. 17, 2014

Supporting Documents: [assignment-tm-5324-0300.pdf](#)

Assignor

Name: [IBE BUSINESS ENTERPRISE AG](#)

Execution Date: Dec. 18, 2013

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

Assignee

Name: [LALA BRANDED PRODUCTS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: TEXAS

Address: 8750 NORTH CENTRAL EXPRESSWAY
SUITE 400
DALLAS, TEXAS 75231

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255
IPLAW@VORYS ATTN CORY M. AMRON
COLUMBUS, OH 43216-2255

Domestic Representative - Not Found

Assignment 3 of 4

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5324/0467](#)

Pages: 40

Date Recorded: Jul. 17, 2014

Supporting Documents: [assignment-tm-5324-0467.pdf](#)

Assignor

Name: [LALA BRANDED PRODUCTS, INC.](#)

Execution Date: Mar. 24, 2014

Legal Entity Type: CORPORATION

State or Country Where Organized: TEXAS

Assignee

Name: [INTERNATIONAL BUSINESS ENTERPRISE, S.DE R.L.DE C.V.](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: MEXICO

Address: CALZADA LAZARO CARDENAS 185
PARQUE INDUSTRIAL LAGUNERO
GOMEZ PALACIO, DURANGO 35070, MEXICO

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255
IPLAW@VORYS ATTN: CORY M. AMRON
COLUMBUS, OH 43216-2255

Domestic Representative

Domestic Representative Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Domestic Representative Address: P.O. BOX 2255
IPLAW@VORYS
COLUMBUS, OH 43216-2255

Assignment 4 of 4

Conveyance: MERGER EFFECTIVE 12/31/2014

Reel/Frame: [5463/0620](#)

Pages: 4

Date Recorded: Feb. 20, 2015

Supporting Documents: [assignment-tm-5463-0620.pdf](#)

Assignor

Name: [INTERNATIONAL BUSINESS ENTERPRISE, S. DE R.L. DE C.V.](#)

Execution Date: Dec. 31, 2014

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: MEXICO

Assignee

Name: [COMERCIALIZADORA DE LACTEOS Y DERIVADOS, S.A. DE C.V.](#)

Legal Entity Type: SOCIEDAD ANONIMA DE CAPITAL VARIABLE: MEXICO

State or Country Where Organized: MEXICO

Address: CALZADA LAZARO CARDENAS #185
PARQUE INDUSTRIAL LAGUNERO
GOMEZ PALACIO, DURANGO, MEXICO 35077

Correspondent

Correspondent Name: VORYS, SATER, SEYMOUR AND PEASE LLP

Correspondent Address: P.O. BOX 2255 -- IPLAW@VORYS
ATTN: CORY M. AMRON, ESQ.
COLUMBUS, OH 43216-2255

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91208929](#)

Filing Date: Jan 18, 2013

Status: Terminated

Status Date: Jun 14, 2013

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Lieberman Companies, Inc.

Correspondent Address: JOEL D LEVITON
FISH & RICHARDSON PC
PO BOX 1022
MINNEAPOLIS MN , 55440-1022
UNITED STATES

Correspondent e-mail: jd@fr.com , tmdoct@fr.com , kmo@fr.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ELSIE'S	Registered	85560950	4593294

Plaintiff(s)

Name: IBE Business Enterprise AG

Correspondent Address: CORY M AMRON
VORYS SATER SEYMOUR AND PEASE LLP
P.O. BOX 2255
COLUMBUS OH , 43216-2255
UNITED STATES

Correspondent e-mail: CMAmron@vorys.com , iplaw@vorys.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
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ELSIE	REGISTERED AND RENEWED	72231036	810861
ELSIE	REGISTERED AND RENEWED	77025330	3271334
ELSIE BORDEN	REGISTERED AND RENEWED	77034096	3271357
ELSIE BORDEN	Cancelled - Section 8	77104776	3323199
ELSIE BORDEN	REGISTERED AND RENEWED	77202537	3380947
FRIENDS OF ELSIE	Cancelled - Section 8	77476878	3709689
FRIENDS OF ELSIE	Cancelled - Section 8	77484822	3709705
BORDEN ELSIE	Section 8 and 15 - Accepted and Acknowledged	77778412	4190983
BORDEN ELSIE	Section 8 and 15 - Accepted and Acknowledged	85218992	4011916
BORDEN ELSIE	Section 8 and 15 - Accepted and Acknowledged	85413453	4135324
ELSIE THE COW	Abandoned - No Statement Of Use Filed	85687504	
ELSIE BORDEN	REGISTERED AND RENEWED	75747000	2464457

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 18, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 18, 2013	Feb 27, 2013
3	PENDING, INSTITUTED	Jan 18, 2013	
4	STIPULATION FOR AN EXTENSION OF TIME	Feb 20, 2013	
5	EXTENSION OF TIME GRANTED	Feb 20, 2013	
6	STIP FOR EXT	Mar 28, 2013	
7	EXTENSION OF TIME GRANTED	Mar 28, 2013	
8	STIP FOR EXT	Apr 22, 2013	
9	EXTENSION OF TIME GRANTED	Apr 22, 2013	
10	W/DRAW OF OPPOSITION	May 20, 2013	
11	P CHANGE OF CORRESP ADDRESS	May 24, 2013	
12	BD DECISION: DISMISSED W/O PREJ	Jun 14, 2013	
13	TERMINATED	Jun 14, 2013	