

ESTTA Tracking number: **ESTTA1112153**

Filing date: **02/03/2021**

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	A. SAMBADO & SON, INC.
Granted to Date of previous extension	02/03/2021
Address	8077 N. TULLY ROAD LINDEN, CA 95236 UNITED STATES

Correspondence information	THOMAS A. DIRKSEN ATTORNEY AT LAW 4607 LAKEVIEW CANYON ROAD SUITE 117 WESTLAKE VILLAGE, CA 91361 UNITED STATES Primary Email: trademarks@dirksenlaw.com 8053709100
----------------------------	---

Applicant Information

Application No.	88828983	Publication date	10/06/2020
Opposition Filing Date	02/03/2021	Opposition Period Ends	02/03/2021
Applicant	Albert Uster Imports, Inc. 9211 GAITHER ROAD GAITHERSBURG, MD 20877 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 2001/06/01 First Use In Commerce: 2001/06/01 All goods and services in the class are opposed, namely: Candied fruit; fruit-based filling for pie, tarts, pastry, or confections; dried fruits in powder form; jam; jellies; jelly fruit décor not being confectionary; marmalade; fruit curds; pressed fruit paste
Class 030. First Use: 2001/06/01 First Use In Commerce: 2001/06/01 All goods and services in the class are opposed, namely: Extracts used as food flavoring not including essential oils; food flavorings, other than essential oils; fruit compounds; fruit gels in the nature of fruit-flavored gelatins; fruit paste for flavouring of food; vanilla beans; mirror glaze for baked goods; pastry glaze for baked goods

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1046970	Application Date	07/30/1975
Registration Date	08/24/1976	Foreign Priority Date	NONE
Word Mark	PRIMA FRUTTA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 031. First use: First Use: 1975/05/26 First Use In Commerce: 1975/05/26 FRESH CHERRIES		

U.S. Registration No.	3334633	Application Date	01/26/2006
Registration Date	11/13/2007	Foreign Priority Date	NONE
Word Mark	PRIMA FRUTTA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 031. First use: First Use: 1975/05/26 First Use In Commerce: 1975/05/26 Fresh fruits, *, namely, cherries, apples and pears * [; Fresh vegetables]		

Related Proceedings	91267422
---------------------	----------

Attachments	2021_0203_notice_opposition_frutta_prima_FINAL.pdf(248000 bytes)
-------------	---

Signature	/thomas a dirksen/
Name	THOMAS A. DIRKSEN
Date	02/03/2021

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

A. SAMBADO & SON, INC.

Opposer

Opposition No. _____

v.

NOTICE OF OPPOSITION

ALBERT USTER IMPORTS, INC.

Mark: FRUTTA PRIMA

Application Ser. No. 88-828983

Applicant

FRUTTA PRIMA



A. SAMBADO & SON, INC., a California corporation, located and doing business at 8077 N. Tully Road, Linden, CA 95236 (“Opposer”), believes that it will be damaged by the registration of the trademark FRUTTA PRIMA & DESIGN in Int’l Classes 029 and 030 (the “Applied-for Mark”), which is set forth in U.S. Appl. Ser. No. 88–828983, (the “Application”), owned by ALBERT USTER IMPORTS, INC., (the “Applicant”) and hereby opposes registration of the Application.

As grounds for this opposition, Opposer alleges:

1. Opposer is a grower and distributor of cherries and other fresh fruits.
2. Opposer adopted and first used its PRIMA FRUTTA trademarks (collectively, Opposer’s Marks”) on or in connection with cherries and other fresh fruit since at least 1965. Opposer’s use of Opposer’s Marks has been continuous and ongoing at least before and since each the March 10, 2020 filing date of the Application and the June 1, 2001 dates of first use claimed within the “Application.”
3. Opposer owns many trademarks, including, but not limited to, the following distinctive trademarks (the “Opposer’s Marks”):

Reg. No.	Mark	Goods	Filing Date	Reg. Date	First Use
1046970	<i>Prima Frutta</i>	Fresh cherries	07/30/1975	08/24/1976	5/26/1975
3334633	PRIMA FRUTTA	Fresh fruits, namely cherries apples and pears	01/26/2006	11/13/2007	5/26/1975

4. Opposer intends to establish priority of its rights in the Opposer's Marks by relying on its registrations thereof, including but not limited to those identified in Exhibit A, all of which are valid, subsisting, and owned by Opposer.

5. Opposer also intends to establish priority of its rights in the Opposer's Marks by relying on its common law uses, all of which predate the March 10, 2020 filing date of the application and the June 1, 2001 first use dates claimed within the Application.

6. Opposer has sold millions of dollars' worth of goods in connection with Opposer's Marks.

7. By virtue of the popularity of Opposer's goods offered in connection with Opposer's Marks, Opposer has built and owns extremely valuable goodwill symbolized by, and associated with, Opposer's Marks.

8. In its Application, Applicant applied for registration of the FRUTTA PRIMA DESIGN Mark in Int'l Class 029 and Int'l Class 030. The Applied-for Mark is identical to the Opposer's Marks. The reverse word order does not make the Applied-for Mark any less identical to Opposer's Marks.

9. Applicant's application to register and claimed use of the Applied-for Mark for "Candied fruit; fruit-based filling for pie, tarts, pastry, or confections; dried fruits in powder form; jam; jellies; jelly fruit décor not being confectionary; marmalade; fruit curds; pressed fruit paste

extensions” in Int’l Class 029 and “Extracts used as food flavoring not including essential oils; food flavorings, other than essential oils; fruit compounds; fruit gels in the nature of fruit-flavored gelatins; fruit paste for flavouring of food; vanilla beans; mirror glaze for baked goods; pastry glaze for baked goods” (collectively “Applicant’s Goods”) is without Opposer’s consent or permission.

10. Opposer timely filed an Extension of Time to Oppose the Application with the Trademark Trial and Appeal Board on November 1, 2020. An opposition to the Application must be filed by February 3, 2021. Therefore, this Notice of Opposition is being timely filed.

11. Opposer has rights in and to Opposer’s Marks long prior to the first actual or constructive use of the Applied-for Mark.

12. The Applied-for Mark so resembles Opposer’s Marks as to be likely, when used on or in connection with Applicant’s Goods, to cause confusion, to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), as amended. The Applied-for Mark also conveys the same commercial impression as Opposer’s Marks.

13. Applicant’s Goods are similar and related to the goods used in connection with Opposer’s Marks. Applicant’s use and registration of the Applied-for Mark in connection with the Applicant’s Goods is likely to cause confusion, deception and/or mistake among the relevant public.

14. The relevant purchasing public is likely to be led to believe that goods bearing the Applied-for Mark emanate from or are approved, licensed, sponsored by, or in some other way legitimately connected with or affiliated with, Opposer or that Applicant and its business are owned by or are affiliated with Opposer and its business.

15. If Applicant is permitted to use the Applied-for Mark as specified in the Application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the Applied-for Mark and Opposer’s Marks. Consumers familiar with

Opposer's Marks would be likely to believe Applicant's Goods are provided by Opposer or provided with Opposer's authorization or approval. Furthermore, any defect, objection or fault found with Applicant's Goods sold under the Applied-for Mark would necessarily injure Opposer's reputation and goodwill Opposer has established in Opposer's Marks.

16. Opposer believes it will be damaged by registration of the Applied-for Mark because such registration would give Applicant at least a prima facie exclusive right to use the Applied-for Mark in commerce in the United States, in derogation of Opposer's senior rights in Opposer's Marks.

17. Applicant's use and registration of the Applied-for Mark will damage Opposer, its business and its goodwill.

18. Filed herewith is Opposer's payment via credit card of the requisite filing fee for two classes in the amount of \$1200.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that the Appl. Ser. No. 88-828983 be denied registration and that such other and further relief as is deemed just and proper be granted.

Respectfully submitted,

A. SAMBADO & SON, INC.

By Thomas A. Dirksen

Thomas A. Dirksen
Attorney for Opposer
4607 Lakeview Canyon Rd., Suite 117
Westlake Village, California 91361
Tel. (805) 370-9100
Fax (805) 435-1795
Email: trademarks@dirksenlaw.com

DATED this 3rd day of February, 2021

Certificate of Electronic Transmission

I hereby certify that the foregoing notice of opposition is being transmitted electronically to the United States Patent and Trademark Office's Trademark Trial and Appeal Board on February 3, 2021.

By: Thomas A. Dirksen
Thomas A. Dirksen
Attorney for Opposer
4607 Lakeview Canyon Rd., Suite 117
Westlake Village, California 91361
Tel. (805) 370-9100
Fax (805) 435-1795
Email: trademarks@dirksenlaw.com

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record including, without limitation, by email to nyipdocketing@venable.com, ksruisi@venable.com, mballard@venable.com, at VENABLE LLP, 1270 AVENUE OF THE AMERICAS, 24TH FLOOR, NEW YORK, NEW YORK 10020. on this 3rd day of February 2021.

By: Thomas A. Dirksen
Thomas A. Dirksen
Attorney for Opposer
4607 Lakeview Canyon Rd., Suite 117
Westlake Village, California 91361
Tel. (805) 370-9100
Fax (805) 435-1795
Email: trademarks@dirksenlaw.com

EXHIBIT A

Int. Cl.: 31

Prior U.S. Cl.: 46

United States Patent Office

Reg. No. 1,046,970

Registered Aug. 24, 1976

TRADEMARK

Principal Register

Prima Frutta

A. Sambado & Sons (partnership)
8421 N. Tully Road
Linden, Calif. 95236

For: FRESH CHERRIES, in CLASS 31 (U.S. CL. 46).
First use May 26, 1975; in commerce May 26, 1975.
No claim is made to exclusive use of the word
"Frutta" apart from the mark as shown.
The trademark "Prima Frutta" may be translated to
mean "first fruit."

Ser. No. 59,164, filed July 30, 1975.

R. M. ROSS, Examiner

United States of America

United States Patent and Trademark Office

PRIMA FRUTTA

Reg. No. 3,334,633

Registered Nov. 13, 2007

Amended Sep. 04, 2018

Int. Cl.: 31

Trademark

Principal Register

A. SAMBADO & SON, INC. (CALIFORNIA CORPORATION)
8077 N. Tully Road
Linden, CALIFORNIA 95236

CLASS 31: Fresh fruits, *, namely, cherries, apples and pears * [; Fresh vegetables]

FIRST USE 5-26-1975; IN COMMERCE 5-26-1975

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

OWNER OF U.S. REG. NO. 1046970

No claim is made to the exclusive right to use the following apart from the mark as shown:
"FRUTTA"

The foreign wording in the mark translates into English as FIRST FRUITS.

SER. NO. 78-800,307, FILED 01-26-2006



Andrei Iancu

Director of the United States
Patent and Trademark Office