

ESTTA Tracking number: **ESTTA1169525**

Filing date: **11/01/2021**

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	North American Herb and Spice Co. Ltd. LLC		
Entity	Limited Liability Company	Citizenship	Illinois
Address	13900 WEST POLO TRAIL DRIVE LAKE FOREST, IL 60045 UNITED STATES		
Attorney information	THEODORE JOSEPH CHIACCHIO NYMAN IP LLC 20 NORTH UPPER WACKER DRIVE, #1200 CHICAGO, IL 60606 UNITED STATES Primary Email: ted@nymanip.com Secondary Email(s): scott@nymanip.com, trademark@nymanip.com 312-919-2719		
Docket Number	311068.0016		

Applicant Information

Application No.	90500463	Publication date	10/19/2021
Opposition Filing Date	11/01/2021	Opposition Period Ends	11/18/2021
Applicant	Herbert H. Warren P.O. BOX 18748 ANAHEIM, CA 92817 UNITED STATES		

Goods/Services Affected by Opposition


Class 005. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Dietary supplements for animals made in whole or substantial part of oregano; Dietary and nutritional supplements made in whole or substantial part of oregano

Grounds for Opposition

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

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	6266438	Application Date	07/13/2020
Registration Date	02/09/2021	Foreign Priority Date	NONE

Word Mark	OREGAMAX
Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1993/12/31 First Use In Commerce: 1993/12/31 Nutritional supplements; non-medicated dietary and nutritional supplement for supporting digestive and immune systems

Attachments	90050252#TMSN.png(bytes) 2021.11.01 Notice of Opposition_MAX OREGANO.pdf(116781 bytes) Ex. 1 to NOO.pdf(99885 bytes)
-------------	--

Signature	/Theodore Joseph Chiacchio/
Name	Theodore Joseph Chiacchio
Date	11/01/2021

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

NORTH AMERICAN HERB AND SPICE CO. LTD. LLC,)	
)	
Opposer,)	Opposition No. TBA
v.)	Serial No. 90/500,463
)	
HERBERT H. WARREN,)	Trademark: MAX OREGANO
)	
Applicant.)	
)	
)	

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

North American Herb and Spice Co. Ltd. LLC (“NAHS” or “Opposer”), an Illinois limited liability company, located at 13900 West Polo Trail Drive, Lake Forest, Illinois 60045, by and through its undersigned counsel, hereby submits this Notice of Opposition challenging pending Trademark Application Serial Number 90/500,463 for the mark MAX OREGANO (the “Application”). Said application was filed by Herbert H. Warren (“Applicant”). NAHS will be harmed if the Application is allowed to mature into a registration and, therefore, files the instant Opposition. In support of this Opposition, NAHS alleges the following:

1. Applicant filed the Application for MAX OREGANO on January 31, 2021. The Application designates International Class 005 and lists the following goods: Dietary supplements for animals made in whole or substantial part of oregano; dietary and nutritional supplements made in whole or substantial part of oregano. Applicant filed the Application for registration on the Principal Register based on a purported bona fide intent to use the mark in interstate commerce.

The Application disclaims any exclusive right to use the word “oregano” apart from the MAX OREGANO mark.

2. Opposer NAHS holds a U.S. trademark registration for the trademark OREGAMAX (Registration No. 6,266,438; the “438 Registration”). OREGAMAX was registered on the U.S. Patent and Trademark Office’s (“USPTO”) Principal Register on February 9, 2021, based on Application Serial No. 90050252 (the “252 Application”). The ‘252 application was filed on July 13, 2020, which is prior to Applicant’s filing date for the Application.

3. The ‘438 Registration designates International Class 005 and identifies the following goods: Nutritional supplements; non-medicated dietary and nutritional supplement for supporting digestive and immune systems.

4. As reflected in the electronic records of the USPTO related to the ‘438 Registration, NAHS first used the OREGAMAX mark in commerce at least as early as December 31, 1993.

5. NAHS relies on its superior rights as compared to any rights that Applicant might have in MAX OREGANO, if any.

6. As reflected in the Parties’ respective identifications of goods set forth above, the goods set forth in the ‘438 Registration encompass the goods set forth in the Application.

7. Opposer NAHS’s mark is OREGAMAX. Applicant’s mark is MAX OREGANO. The Parties’ respective marks, thus, both contain “orega” and also both contain “max.” Therefore, there are significant similarities between the sound, meaning, appearance, and commercial impression of the Parties’ respective marks.

8. The ‘438 Registration is live currently. The ‘438 Registration is attached hereto as Exhibit 1.

9. NAHS would be harmed if the MAX OREGANO mark is allowed to mature to registration. Due to, among other factors and without limitation, similarities in the Parties’

respective goods as well as similarities in the marks themselves, there would be confusion among relevant consumers between the sources of the Parties' respective goods. Consumers would mistakenly believe that the goods associated with MAX OREGANO emanate from the same source as the goods associated with NAHS's OREGAMAX mark.

10. Applicant is, therefore, not entitled to register the MAX OREGANO mark.

For at least the reasons set forth above, Opposer NAHS respectfully requests that the Board refuse registration of MAX OREGANO.

Dated: November 1, 2021

**NORTH AMERICAN HERB AND SPICE
CO. LTD. LLC**

By: /Theodore J. Chiacchio/

Theodore J. Chiacchio

NYMAN IP LLC

20 North Wacker Drive, Ste. # 1200

Chicago, Illinois 60606

Tel: (312) 724-9938

Email: ted@nymanip.com

CERTIFICATE OF SERVICE

I hereby certify that on November 1, 2021, I caused a true and correct copy of the foregoing document to be served on Herbert H. Warren via electronic mail.

/Theodore J. Chiacchio/

EXHIBIT 1

United States of America

United States Patent and Trademark Office

OREGAMAX

Reg. No. 6,266,438

Registered Feb. 09, 2021

Int. Cl.: 5

Trademark

Principal Register

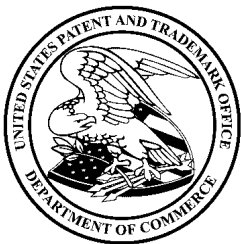
North American Herb and Spice Co. LTD. LLC (ILLINOIS LIMITED LIABILITY COMPANY)
13900 Polo Trail Drive
Lake Forest, ILLINOIS 60045

CLASS 5: Nutritional supplements; non-medicated dietary and nutritional supplement for supporting digestive and immune systems

FIRST USE 12-31-1993; IN COMMERCE 12-31-1993

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

SER. NO. 90-050,252, FILED 07-13-2020



Dennis H. H. H.

Performing the Functions and Duties of the
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office



REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*

What and When to File:

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.