

ESTTA Tracking number: **ESTTA1293801**

Filing date: **06/27/2023**

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	Request Foods, Inc.
Granted to date of previous extension	06/28/2023
Address	3460 JOHN F. DONNELLY DRIVE HOLLAND, MI 49424 UNITED STATES
Attorney information	BRIAN D. WASSOM WARNER NORCROSS + JUDD LLP 45000 RIVER RIDGE DR., STE. 300 CLINTON TWP, MI 48038 UNITED STATES Primary email: bwassom@wnj.com Secondary email(s): dkeilch@wnj.com, trademarks@wnj.com 5863034139
Docket no.	

**Applicant information**

Application no.	90650718	Publication date	02/28/2023
Opposition filing date	06/27/2023	Opposition period ends	06/28/2023
Applicant	Quest Nutrition, LLC 777 S. AVIATION BLVD, STE. 100 EL SEGUNDO, CA 90245 UNITED STATES		

**Goods/services affected by opposition**

Class 030. First Use: None First Use In Commerce: None  
Opposed goods and services in the class: breakfast pastries; breakfast cereals; granola; frozen breakfast items, namely, waffles, pancakes, crepes and muffins

**Grounds for opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
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**Marks cited by opposer as basis for opposition**

U.S. registration no.	2680254	Application date	10/19/2001
Register	Principal		

Registration date	01/28/2003	Foreign priority date	NONE
Word mark	REQUEST FOODS		
Design mark			
Description of mark	NONE		
Goods/services	Class 029. First use: First Use: Jul 27, 1990 First Use In Commerce: Jul 27, 1990 [FROZEN PREPARED MEALS CONSISTING PRIMARILY OF MEATS AND POULTRY ] [ FISH ] [ ENTREES ] Class 030. First use: First Use: Jul 27, 1990 First Use In Commerce: Jul 27, 1990 FROZEN PREPARED MEALS CONSISTING PRIMARILY OF PASTA [OR RICE]		

U.S. registration no.	2680260	Application date	10/19/2001
Register	Principal		
Registration date	01/28/2003	Foreign priority date	NONE
Word mark	REQUEST		
Design mark			
Description of mark	NONE		
Goods/services	Class 029. First use: First Use: Jul 27, 1990 First Use In Commerce: Jul 27, 1990 [FROZEN PREPARED MEALS CONSISTING PRIMARILY OF MEATS, AND POULTRY ] [FISH ] [ ENTREES ] Class 030. First use: First Use: Jul 27, 1990 First Use In Commerce: Jul 27, 1990 FROZEN PREPARED MEALS CONSISTING PRIMARILY OF PASTA [OR RICE]		

U.S. registration no.	2728949	Application date	07/23/2002
Register	Principal		
Registration date	06/24/2003	Foreign priority date	NONE
Word mark	R		
Design mark			
Description of mark	NONE		
Goods/services	Class 030. First use: First Use: Sep 15, 1990 First Use In Commerce: Sep 15, 1990 FOODS, namely, PROCESSED MACARONI ENTREES [, SPAGHETTI ENTREES, AND RAVIOLI ENTREES ]		

U.S. application no.	97479055	Application date	06/28/2022
Registration date	NONE	Foreign priority date	NONE

Word mark	REQUEST FOODS
Design mark	
Description of mark	The mark consists of a stylized image of a kettle in red adjacent to the stylized words "REQUEST FOODS" in black with the leg in the letter "Q" in red.
Goods/services	Class 030. First use: First Use: None First Use In Commerce: None Packaged meals consisting primarily of pasta or rice

U.S. application no.	97479099	Application date	06/28/2022
Registration date	NONE	Foreign priority date	NONE
Word mark	REQUEST FOODS		
Design mark			
Description of mark	The mark consists of a stylized image of a kettle in red above the stylized word "REQUEST" in black above the stylized word "FOODS" in black with the leg in the letter Q in red.		
Goods/services	Class 030. First use: First Use: None First Use In Commerce: None Packaged meals consisting primarily of pasta or rice		

Attachments	Request - Quest - NOO.pdf(209927 bytes )
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Signature	/Brian D. Wassom/
Name	BRIAN D. WASSOM
Date	06/27/2023

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

REQUEST FOODS, INC.,

Opposition No.:

Mark: QUEST

Opposer,

Serial No. 90650718

v.

QUEST NUTRITION, LLC,

Respondent.

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**NOTICE OF PARTIAL OPPOSITION**

Opposer Request Foods, Inc. (“Opposer”), by its attorneys Warner Norcross + Judd LLP, for its Notice of Partial Opposition against Respondent Quest Nutrition, LLC (“Applicant”), alleges as follows:




**Parties**

1. Opposer is a Michigan corporation with an address at 3460 John F. Donnelly Drive, Holland, MI 49424.
2. Applicant is a Delaware corporation with an address at 777 S. Aviation Blvd, Ste. 100, El Segundo, CA 90245.
3. Opposer believes that it will be damaged by registration of the mark QUEST (“Applicant’s Mark”). Therefore, pursuant to Lanham Act §13(a), 15 U.S.C. § 1063(a), Opposer has standing to oppose Applicant’s Application No. 90650718 (the “Application”).

**Opposer and Its Well-Known REQUEST® Trademarks**

4. Founded in 1988, Request Foods produces nearly 500 different custom entrées, side dishes, appetizers, sauces and desserts — each recipe formulated to meet a specific customer requirement, whether foodservice, private label or national brand. Today, Request Foods is consistently ranked as a Tier 1 frozen food processor in volume, capabilities and breadth of products.

5. On the strength of this strong marketplace recognition, Opposer has obtained the following U.S. Registrations and Applications, among others:

<b>U.S. Reg. No.</b>	<b>Mark</b>	<b>Goods</b>
2680254	REQUEST FOODS	IC 30: Frozen prepared meals consisting primarily of pasta
2680260	REQUEST	IC 30: Frozen prepared meals consisting primarily of pasta
2728949		IC 30: Foods, namely, processed macaroni entrees
97479055		IC 30: Packaged meals consisting primarily of pasta or rice
97479099		IC 30: Packaged meals consisting primarily of pasta or rice

6. Each of these registrations is incontestable. Collectively, the foregoing registrations and applications, as well as related common law rights in these marks used by Opposer, its affiliates, and its licensees, will be referred to herein as “Opposer’s Marks,” and the goods and services provided in connection therewith by Opposer, its affiliates, and/or its licensees (the goodwill in which all accrues to Opposer’s benefit) are “Opposer’s Goods and Services.”

7. Opposer's Goods and Services provided under Opposer's Marks have been extensively and continuously sold, marketed, advertised and promoted throughout the United States. As a result of the quality of Opposer's Goods and Services and the widespread promotion thereof under Opposer's Marks, the goods have met with great commercial success and widespread consumer and media recognition. In addition, Opposer's Marks have become symbols of Opposer and its related companies. Opposer's Goods and Services, and Opposer's goodwill, had come to be associated with Opposer prior to any use in commerce by Applicant.

**Applicant and Its Application to Register QUEST**

8. Applicant's Application, filed Apr. 16, 2021, seek to register Applicant's Mark for use with goods described as "*cookies; protein-enriched pizza, protein-enriched frozen pizza; protein-enriched pizza snacks, protein-enriched frozen pizza snacks; chocolates and chocolate-based ready to eat candies and snacks; peanut butter cups; high protein, low carbohydrate chocolate-based bars and snacks; snack crackers; candy chews; gummy candies; nutritional candy bars; snack cakes; cake pops; chocolate powders; ice cream; ice cream novelties being ice cream desserts; frozen confections; breakfast pastries; breakfast cereals; granola; frozen breakfast items, namely, waffles, pancakes, crepes and muffins; coffee-based beverages; high-protein, low-carbohydrate dairy-protein based pastries*" in International Class 30 ("Applicant's Goods"), among other goods in International Classes 5 and 29.

9. Applicant has filed its Application under Section 1(b) of the Lanham Act, and therefore has not claimed use anywhere or in commerce.

10. Applicant also claims ownership of multiple prior trademark registrations of the mark QUEST for use with various type of goods. Importantly to this proceeding, however,

Applicant does not own any other registrations for Applicant's Mark for use with the following goods: "breakfast pastries; breakfast cereals; granola; frozen breakfast items, namely, waffles, pancakes, crepes and muffins" (the "Opposed Goods").

**Likelihood of Confusion, 15 U.S.C. §1052(d)**

11. Opposer incorporates herein by reference each of the foregoing paragraphs.

12. Opposer has priority based on its valid and subsisting registrations for Opposer's Marks and based on its prior and continuous use of Opposer's Marks in commerce in connection with Opposer's Goods and Services long before the filing date of the opposed Application and before any use in commerce of the Opposed Goods alleged by Applicant.

13. Applicant's Mark is highly similar to Opposer's Marks in appearance and commercial impression. Both consist of the word "Quest," with only difference being that Opposer's Mark adds the prefix "Re-." Therefore, the parties' respective marks are similar in both appearance and commercial impression.

14. Applicant's Opposed Goods, as described in its Application, are highly similar to Opposer's Goods and Services.

15. In 2014, in lieu of Opposer filing a Notice of Opposition in response to one of Applicant's earlier applications to register Applicant's Mark, the parties reached a Trademark Co-Existence Agreement. In 2019, they replaced that document with an "Amended and Restated Trademark Coexistence Agreement" (the "Agreement").<sup>1</sup> The Agreement remains in force today.

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<sup>1</sup> Opposer incorporates the Agreement herein by reference, but does not attach it because it is already in the possession of both parties, and in order to avoid unnecessary disclosure of the Agreement's terms. Section 8 of the Agreement deems the Agreement confidential, but makes an exception for "any action brought by either party to enforce this Agreement," such as this one.

16. The purpose of the Agreement was to preserve sufficient distinction between Opposer's Goods and Services and Applicant's Goods to avoid creating a likelihood of confusion between Opposer's Marks and Applicant's Mark. In broad strokes, the Agreement provides Opposer's consent to Applicant's use of Applicant's Mark with the goods listed in Applicant's prior registrations, snack foods, and similar goods. Further, Applicant also agreed not to attempt to register or use Applicant's Mark with "prepared meals, pre-packaged meals, prepared entrees, or pre-packaged entrees," among other things.

17. The Opposed Goods exceed the scope of use permitted by the Agreement for Applicant's Mark. Specifically, "breakfast pastries; breakfast cereals; granola; frozen breakfast items, namely, waffles, pancakes, crepes and muffins" are not the "snack" foods reserved for Applicant under the Agreement, but are much more akin to the "meals and entrees" that the Agreement designates exclusively for sale under Opposer's Marks. Indeed, Opposer currently prepares frozen breakfast meals, including pancakes. Therefore, Applicant's Opposed Goods would be perceived by the consuming public as materially similar to Opposer's Goods and Services, causing a likelihood of confusion.

18. The Agreement is valid and enforceable. It creates a demarcation in the marketplace between the parties' marks and products that has reliably avoided customer confusion. The parties' coexistence under this Agreement for the past 10 years demonstrates that this approach has been effective. The Agreement is also persuasive evidence relevant to the 10<sup>th</sup> *duPont* factor, *i.e.*, "the market interface between the applicant and the owner of a prior mark." The Board should defer to this proven arrangement and prohibit Applicant from registering Applicant's Mark in



connection with the Opposed Goods, which would upset the balance the parties carefully crafted 10 years ago.

19. Opposer's Marks are or have been used in a wide variety of mainstream channels of trade, and are marketed generally across virtually all ages and demographic lines. Consumers of Opposer's Goods and Services are likely to be among those who may purchase or see advertisements for Applicant's Opposed Goods, and Applicant's Application do not place any limits on the consumers to whom Applicant's Goods are marketed or provided.

20. Applicant's Opposed Goods, customers, and marketing channels so closely overlap with Opposer's Goods and Services as to be highly likely to cause confusion or mistake, or to deceive consumers under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. §1052(d).

WHEREFORE, Opposer prays that Application Serial No. 90650718 be refused registration as to the Opposed Goods only, and that this opposition be sustained in favor of Opposer.

A filing fee for the Notice of Opposition in the appropriate amount is being submitted herewith via electronic funds transfer.

Respectfully submitted,

Date: June 27, 2023

By: Brian D. Wassom  
Brian D. Wassom  
Warner Norcross + Judd LLP  
45000 River Ridge Dr., Ste. 300  
Clinton Township, MI 48038  
586.303.4139  
bwassom@wnj.com

## **CERTIFICATE OF TRANSMITTAL**

I hereby certify that on June 27, 2023, this correspondence is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA).

/Denise Keilch/