

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

TTAB

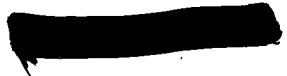
-----	x	
Arcor S.A.I.C.,	:	
	:	
Petitioner,	:	Cancellation No.:
	:	
-v-	:	Registration No.: 3,121,201 #76 577 101
	:	
Paris Gourmet of New York, Inc.,	:	Issued: July 25, 2006
	:	
	:	Trademark: CACAO NOEL
Respondent.	:	
	:	
-----	x	

PETITION FOR CANCELLATION

Petitioner, Arcor S.A.I.C. ("Petitioner"), a corporation duly organized and existing under the laws of Argentina, and having its principal place of business at Maipu 1210 Pisos 2 y 3, Buenos Aires, Argentina, 1006, believes that it will be damaged by the continued existence of the above-identified registration for the trademark CACAO NOEL in the name of Paris Gourmet of New York, Inc. ("Respondent") on the Principal Register, and hereby petitions to cancel the same.

As grounds for this Cancellation, Petitioner relies upon the rights developed by it and by its predecessors in interest, and alleges on knowledge as to itself and otherwise upon information and belief, as follows:

1. Petitioner produces, distributes, and sells pickles, spices, preserved vegetables, ~~01/03/2007 HPAM1 0000001 76577101~~ ~~01/03/2007 HPAM1 0000001 76577101~~ jam, quince paste, ~~01/03/2007 HPAM1 0000001 76577101~~ ~~01/03/2007 HPAM1 0000001 76577101~~ armalade, a composition having a basis of milk sugar, quince jelly, jam, quince paste, sweet potato cream, cookies, biscuits, pound cakes, and fruit cakes under the mark NOEL.



2. Petitioner commenced use of the mark NOEL in commerce with the United States in connection with foods at least as early as 1917 in connection with “pickles, spices, preserved vegetables, and milk marmalade, a composition having a basis of milk sugar” and at least as early as December 31, 1996 in connection with “quince jelly, jam, quince paste, sweet potato cream, cookies, biscuits, pound cakes, and fruit cakes.”

3. Petitioner has expended substantial amounts of time and effort in advertising and promoting its calling cards under the NOEL mark. As a result of such advertising and promotional activities, the NOEL mark has become well known, the relevant public has come to associate and identify the NOEL mark with Petitioner and Petitioner derives substantial goodwill from such identification by consumers.

4. On March 25, 1947, Petitioner obtained Registration No. 428,373 for the mark NOEL in connection with “pickles, spices, preserved vegetables, and milk marmalade, a composition having a basis of milk sugar” in International Class (“IC”) 30 (the “NOEL Registration”).

5. On July 25, 2006, Respondent obtained Registration No. 3,121,201 for the mark CACAO NOEL, which covers “chocolate” in International Class 30 (the “CACAO NOEL Registration”). The CACAO NOEL Registration claims March 2, 2006 as the date of first use of the mark CACAO NOEL. Respondent is the owner of record for the CACAO NOEL Registration.

6. On January 13, 2006, Petitioner filed an application to register the trademark NOEL (Ser. No. 78/791,105) for “quince jelly, jam, quince paste and sweet potato cream” in IC 29 and “cookies, biscuits, pound cakes and fruit cakes” in IC 30 (the “NOEL Application”).

7. On July 13, 2006, the PTO issued an Office Action suspending further action on the NOEL Application based on the possibility that confusion could be likely between the mark NOEL and the CACAO NOEL Registration, which at that time had not yet issued to registration.

Count: Likelihood of Confusion

8. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 7 hereof as if fully set forth herein.

9. The CACAO NOEL Registration, as set forth in the registrations opposed herein, is substantially similar in commercial impression to Petitioner's mark NOEL. Respondent's mark CACAO NOEL and Petitioner's mark NOEL both contain the term "noel." The marks have nearly identical meanings. The marks differ only by the presence of the term "cacao" in Petitioner's mark, which term has been disclaimed and does not serve to distinguish the CACAO NOEL Registration from Petitioner's mark NOEL. The CACAO NOEL Registration and Petitioner's mark NOEL cover chocolate or foods containing chocolate. The Examining Attorney has determined that the goods covered by the NOEL Application may be related to "chocolate."

10. Accordingly, Respondent's mark is likely to cause confusion, mistake, or to deceive the public into believing that Respondent's goods are somehow affiliated or associated with, connected to or sponsored by Petitioner, in violation of Section 2(d) of the Lanham Act.

11. Petitioner's Mark has an earlier date of first use and therefore has priority over Respondent's Mark.

12. Petitioner will be damaged by the continued existence of the CACAO NOEL Registration on the Register because it gives color of rights to Respondent in the mark CACAO

NOEL, infringes Petitioner's mark NOEL, and will continue to be an impediment to Petitioner's ability to register the mark NOEL.

WHEREFORE, Petitioner prays that this petition to cancel be granted and that Reg. No. 3,121,201 for the mark CACAO NOEL be cancelled.

Dated: New York, New York
December 21, 2006

Respectfully submitted,
HUGHES HUBBARD & REED LLP

By: Perla M. Kuhn
Perla M. Kuhn
Russell W. Jacobs
One Battery Park Plaza
New York, New York 10004
(212) 837-6000

Attorneys for Petitioner

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

on December 21, 2006

HUGHES HUBBARD & REED LLP

Dated: 12/21/06 By: Cecilia Kahene

Name: