

ESTTA Tracking number: **ESTTA419505**

Filing date: **07/13/2011**

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	KELLOGG NORTH AMERICA COMPANY
Granted to Date of previous extension	07/13/2011
Address	One Kellogg Square PO Box 3599 Battle Creek, MI 49016 UNITED STATES
Correspondence information	DAVID A HERDMAN ASSISTANT SECRETARY/CORPORATE COUNSEL KELLOGG NORTH AMERICA COMPANY One Kellogg Square PO Box 3599 Battle Creek, MI 49016 UNITED STATES trademarks@kellogg.com Phone:269-961-2170

Applicant Information

Application No	85062781	Publication date	03/15/2011
Opposition Filing Date	07/13/2011	Opposition Period Ends	07/13/2011
Applicant	World Free Press Institute 231 Market Place #174 San Ramon, CA 945834743 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. First Use: 2010/02/03 First Use In Commerce: 2010/04/04
All goods and services in the class are opposed, namely: Clothing products, namely, t-shirts; and headgear, namely, hats for consumers of all ages

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1979527	Application Date	05/01/1995
Registration Date	06/11/1996	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1992/11/16 First Use In Commerce: 1992/11/16 clothing, namely T-shirts, sweatshirts, nightshirts, pajamas and caps

U.S. Registration No.	2029603	Application Date	05/01/1995
Registration Date	01/14/1997	Foreign Priority Date	NONE
Word Mark	TOUCAN SAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/11/16 First Use In Commerce: 1992/11/16 clothing, namely T-shirts, sweatshirts, nightshirts and caps		

U.S. Registration No.	3187342	Application Date	03/01/2006
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	TOUCAN SAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1964/06/00 First Use In Commerce: 1964/06/00 CEREAL-DERIVED FOOD PRODUCT TO BE USED AS A BREAKFAST FOOD SNACK FOOD OR INGREDIENT FOR MAKING FOOD		

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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

Signature	/DAVID A HERDMAN/
Name	DAVID A HERDMAN
Date	07/13/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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KELLOGG NORTH AMERICA COMPANY)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	Serial No. 85/062,781
WORLD FREE PRESS INSTITUTE)	Mark: TOUCAN Bird & Design
)	Filing Date: June 15, 2010
Applicant.)	Publication Date: March 15, 2011
)	
)	

NOTICE OF OPPOSITION

Kellogg North America Company, a Delaware corporation, located and doing business at One Kellogg Square, P.O. Box 3599, Battle Creek, Michigan 49016, (hereinafter called “Opposer”), believes that it will be damaged by the registration of the mark shown in Application Serial No. 85/062,781 in Class 25, filed by World Free Press Institute (hereinafter “Applicant”) on June 15, 2010, and opposes Application Serial No. 85/062,781.

The grounds for this opposition are as follows:

1. Commencing long prior to Applicant’s filing date, Opposer and Opposer’s predecessor in interest, Kellogg Company, have engaged, and Opposer is now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of food products, including breakfast cereal and cereal based snack foods and fruit snacks, as well as a wide range of licensed and promotional goods and services, including clothing.

2. Commencing long prior to Applicant’s filing date, Opposer and Opposer’s predecessor in interest, Kellogg Company, have used, and Opposer is now using Opposer’s registered TOUCAN SAM and TOUCAN DESIGN trademarks as well as various common law “TOUCAN” marks (hereinafter sometimes referred to as “Opposer’s Marks”) in connection with

food products, including breakfast cereal and cereal based snack foods, as well as a wide range of licensed and promotional goods and services distributed and sold by Opposer in commerce, including clothing. Opposer and Opposer's predecessor in interest have also licensed the use of Opposer's Marks for various other food and non-food products.

3. Opposer is the owner of, and will rely herein upon, the following Federal Trademark registrations:

MARK	REG. NO.	ISSUE DATE	GOODS
TOUCAN Bird Design (Standing Design)	1,979,527	06/11/1996	Clothing, namely t-shirts, sweatshirts, nightshirts, pajamas and caps
TOUCAN SAM	2,029,603	01/14/1997	Clothing, namely t-shirts, sweatshirts, nightshirts and caps
TOUCAN SAM	3,187,342	12/19/2006	Cereal-derived food product to be used as a breakfast food or ingredient for making food

(hereafter collectively referred to as "Opposer's Registered Marks"). Registration of Opposer's Registered Marks is valid, subsisting and conclusive evidence of Opposer's exclusive right to use Opposer's Registered Marks in commerce on the goods specified in said registrations.

4. In addition to Opposer's Marks and Opposer's Registered Marks specified above, Opposer shall rely herein upon its and its predecessor in interest's common law usage of their other TOUCAN Marks and TOUCAN related marks for various promotional and licensed products, including clothing, (all hereafter collectively referred to as "Opposer's TOUCAN Marks"). Given the fame and widespread favorable public recognition of Opposer's TOUCAN Marks use on these other products and services is a natural extension of Opposer's earlier usage on food products.

5. Opposer and Opposer's predecessor in interest, Kellogg Company, have made substantial investment in advertising and promoting their goods under Opposer's TOUCAN

Marks since their initial use. Opposer and Opposer's predecessor in interest, Kellogg Company, have extensively used, advertised, promoted and offered Opposer's goods bearing Opposer's TOUCAN Marks to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's TOUCAN Marks and associate the same with Opposer and/or the goods sold by Opposer.

6. As a result of the aforesaid advertising, promotion and sales, Opposer's TOUCAN Marks are famous and distinctive and became famous and distinctive well prior to the filing of this application and/or well prior to the Applicant's actual use or intended use of the alleged mark.

7. Upon information and belief, notwithstanding Opposer's rights in and to Opposer's TOUCAN marks, on June 15, 2010, Applicant filed an application for registration of the proposed TOUCAN BIRD DESIGN trademark for "t-shirts; and headgear, namely, hats for consumers of all ages" in International Class 25. Said application was assigned Serial No. 85/062,781, and was published for Opposition in the Official Gazette of March 15, 2011.

8. Applicant's TOUCAN BIRD DESIGN mark so resembles Opposer's TOUCAN marks as to be likely, when applied to the goods of Opposer, including Opposer's wide range of licensed goods, including clothing, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment of Opposer and its reputation. In this regard, it should be noted that Opposer's TOUCAN SAM Marks are frequently displayed in connection with depictions of a jungle theme including Mayan temples and surrounding vegetation. Thus, use of the Mayan pyramid in the Applicant's TOUCAN BIRD DESIGNS is likely to further strengthen the public's connection of Applicant's design with Opposer's famous TOUCAN equities.

9. Opposer, upon information and belief, avers that its customers, and the general public, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed goods of Application Serial Number 85/062,781 to be marketed under Applicant's proposed TOUCAN BIRD DESIGN mark and misled into believing that such goods emanate from, are licensed by, or are in some way directly or indirectly associated with, approved by or sponsored by Opposer, to the damage and detriment of Opposer and its reputation.

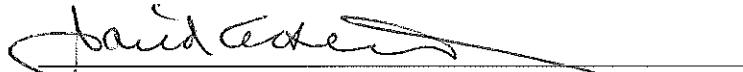
10. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the proposed TOUCAN BIRD AND FRUIT DESIGN trademark, as set forth in Applicant's Trademark Application Serial No. 85/062,781, in that the mark is substantially similar to Opposer's TOUCAN Marks and common law rights and will be used in connection with goods that, as described in Applicant's application, would directly compete with Opposer's own clothing items offered to the public by Opposer and/or its controlled licensees.

11. Opposer, upon information and belief, also avers that it will be damaged by the registration by Applicant of the proposed TOUCAN BIRD DESIGN trademark, as set forth in Applicant's Trademark Application Serial No. 85/062,781, in that the alleged mark will dilute the distinctiveness of Opposer's famous TOUCAN Marks within the meaning of the provisions of the Federal Trademark Dilution Act of 1995, as amended by the Trademark Revision Act of 2006.

Wherefore, this Opposer, Kellogg North America Company, believes and avers that it is being and will continue to be damaged by registration of the proposed TOUCAN BIRD DESIGN trademark as aforesaid, prays that the said Application Serial No. 85/062,781 be rejected in

accordance with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully Submitted,
KELLOGG NORTH AMERICA COMPANY

A handwritten signature in cursive script, appearing to read "David Herdman", written over a horizontal line.

David Herdman
Assistant Secretary/Corporate Counsel
Kellogg North America Company
One Kellogg Square
P.O. Box 3599
Battle Creek, MI 49016-3599

Date: July 13, 2011

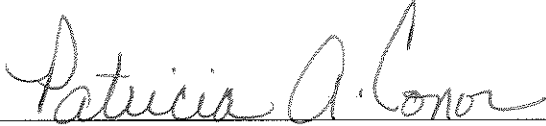
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on the following Attorney of Record and Correspondent for WORLD FREE PRESS INSTITUTE as listed on the TARR website of the United States Patent and Trademark Office by emailing (service by email having previously been approved) said copy on July 13, 2011, to:

Raj Abhyanker
Raj Abhyanker, P.C.
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Mountain View, CA 94040
trademarks@rajpatent.com



Patricia A. Conor