

ESTTA Tracking number: **ESTTA375483**

Filing date: **10/27/2010**

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	Walgreen Co,		
Entity	Corporation	Citizenship	Illinois
Address	200 Wilmot Road Deerfield, IL 60015 UNITED STATES		

Attorney information	Linda A. Kuczma Banner & Witcoff, Ltd. 10 S. Wacker Dr. 30th Floor Chicago, IL 60606 UNITED STATES bwptotm@bannerwitcoff.com,bwlitdocket@bannerwitcoff.com,lkuczma@bannerwitcoff.com,amullenholz@bannerwitcoff.com Phone:312 463-5000
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Applicant Information

Application No	85037348	Publication date	09/28/2010
Opposition Filing Date	10/27/2010	Opposition Period Ends	10/28/2010
Applicant	Wegmans Food Markets, Inc. 1500 Brooks Avenue, P.O. Box 30844 Rochester, NY 14603 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. First Use: 2008/12/00 First Use In Commerce: 2008/12/00 All goods and services in the class are opposed, namely: Retail grocery stores; Retail stores featuring alcoholic beverages

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. Application No.		Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			

Description of Mark	NONE		
Goods/Services			
U.S. Registration No.	3303249	Application Date	05/01/2006
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	WALGREENS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2006/06/18 First Use In Commerce: 2006/06/18 Retail pharmacy, retail drug store, and general consumer merchandise store services		

Attachments	76659733#TMSN.gif (1 page)(bytes) 504395.00020_Not of Opp.pdf (5 pages)(13781 bytes) 504395.00020_Exhibit A to Walgreen Co.'s Notice of Opposition.pdf (5 pages)(22505 bytes)
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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 First Class Mail on this date.

Signature	/Linda A. Kuczma/
Name	Linda A. Kuczma
Date	10/27/2010

provided services and sold products under the WALGREENS Script Logo® trademark throughout the United States prior to Applicant's filing date and its alleged date of first use of the mark identified in its Application.

2. Opposer is the owner of U.S. Registration No. 3,303,249, issued on October 2, 2007, for the mark WALGREENS Script Logo® for retail pharmacy, retail drug store, and general consumer merchandise store services in International Class 35.

3. Opposer's Registration is valid, subsisting, and enforceable. A copy of the TARR report for the foregoing Registration is attached as Exhibit A.

4. As a result of the use and promotion of Opposer's WALGREENS Script Logo® mark for the goods and services identified above, Opposer's trademark has acquired significant goodwill and become famous prior to Applicant's use of its mark and/or the filing date of its application. Opposer's WALGREENS Script Logo® trademark identifies and distinguishes its goods and services from the goods and services of others and identifies the source and origin thereof to purchasers.

5. On May 13, 2010, Applicant filed an application for the registration of the mark WEGMANS (Stylized) for retail grocery stores; retail stores featuring alcoholic beverages in International Class 35.

6. The similarity of Applicant's WEGMANS (Stylized) mark to Opposer's WALGREENS Script Logo® mark is evident from a simple comparison of the marks, and the services for which Applicant's mark is intended to be used, and/or is used, are related to the Opposer's goods and services, and may be encountered in the market by the same purchasers.

7. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion or to cause mistake or to deceive.

8. The use of the mark sought to be registered by Applicant is likely to cause confusion or mistake in the minds of purchasers and lead purchasers and prospective purchasers to believe Applicant's goods and services as designated are the goods and services of Opposer, or in some way backed by, sponsored by, franchised by, approved by, associated with, or otherwise connected with the good name and reputation of Opposer, to the damage and injury of the purchasing public, and to the damage and injury of Opposer and its goodwill in the WALGREENS Script Logo® mark.

9. Registration and use by Applicant of its proposed mark will cause dilution of the distinctive qualities of Opposer's trademark. Such dilution will likely cause irreparable harm and injury to the widespread reputation and goodwill developed as a result of Opposer's substantial efforts.

10. Opposer will be injured and damaged by the granting to Applicant of the registration for the mark for which registration is sought because such mark, when used in connection with the services of Applicant, is likely to:

(a) cause confusion or to cause mistake or to deceive as to some association between Applicant and Opposer and/or the products and services provided by each;

(b) falsely suggest a connection or association with Opposer and/or its products and services;

(c) damage Opposer's valuable goodwill in its WALGREENS Script Logo® trademark;

(d) threaten Opposer's rights to expand the scope of use of its trademark to related, analogous or equivalent items or services and results in injury to Opposer's established rights in and to its mark; and

(e) dilute the distinctive qualities of Opposer's WALGREENS Script Logo® trademark.

WHEREFORE, Opposer files this Notice of Opposition and requests that registration of Application Serial No. 85/037,348 for the mark WEGMANS (Stylized) be denied and that this Opposition be sustained in favor of Opposer.

Please charge the \$300 payment of the filing fee and charge any additional amounts or credit any overpayments to Deposit Account No. 19-0733.

Respectfully submitted,

WALGREEN CO.

Date: October 27, 2010

By: Linda A. Kuczma
Linda A. Kuczma, Esq.
Scott A. Burow, Esq.
Erin Bryan, Esq.
Banner & Witcoff, Ltd.
10 South Wacker Drive, Suite 3000
Chicago, Illinois 60606
(312) 463-5000

Attorneys for Opposer

Enclosure: Copy of TARR Report for Reg. No. 3,303,249

(14255948)

CERTIFICATE OF SERVICE

I hereby certify that on October 27, 2010, a copy of the foregoing Notice of Opposition was served on Applicant, by first class mail, postage prepaid, addressed as follows:

Kristen M. Walsh, Esq.
NIXON PEABODY LLC
1100 Clinton Square
Rochester, NY 14604-1792

/Linda A. Kuczma/
Linda A. Kuczma

EXHIBIT A

WALGREEN CO. v. WEGMANS FOOD MARKETS, INC.
Serial No. 85/037,348

Exhibit A to Walgreen Co.'s Notice of Opposition

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-10-26 14:52:53 ET

Serial Number: 76659733 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3303249

Mark



(words only): [WALGREENS](#)

Standard Character claim: [No](#)

Current Status: [Registered](#).

Date of Status: [2007-10-02](#)

Filing Date: [2006-05-01](#)

Transformed into a National Application: [No](#)

Registration Date: [2007-10-02](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 104](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2007-08-24](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Walgreen Co.](#)

Address:

[Walgreen Co.](#)
[200 Wilmot Road](#)

Deerfield, IL 60615

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Illinois

Phone Number: (847) 315-4640

GOODS AND/OR SERVICES

International Class: 035

Class Status: Active

Retail pharmacy, retail drug store, and general consumer merchandise store services

Basis: 1(a)

First Use Date: 2006-06-18

First Use in Commerce Date: 2006-06-18

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Section 2(f)

Prior Registration Number(s):

1057249

1065969

1777461

1801715

2013991

2077524

2096551

2113779

2259878

2548077

2631095

2659167

2721089

2806482

2810183

2876500

2944628

2946608

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document

Retrieval" shown near the top of this page.

2007-10-02 - Registered - Principal Register

2007-08-24 - Law Office Registration Review Completed

2007-08-24 - Assigned To LIE

2007-07-14 - Allowed for Registration - Principal Register (SOU accepted)

2007-07-06 - Statement Of Use Processing Complete

2007-03-23 - Use Amendment Filed

2007-06-12 - Assigned To Examiner

2007-05-23 - Assigned To Examiner

2007-03-23 - PAPER RECEIVED

2007-03-06 - NOA Mailed - SOU Required From Applicant

2006-12-12 - Published for opposition

2006-11-22 - Notice of publication

2006-10-17 - Law Office Publication Review Completed

2006-10-13 - Assigned To LIE

2006-10-10 - Approved For Pub - Principal Register

2006-10-04 - Assigned To Examiner

2006-10-04 - Amendment From Applicant Entered

2006-09-25 - Communication received from applicant

2006-09-29 - Assigned To Examiner

2006-09-25 - PAPER RECEIVED

2006-09-21 - Priority Action Mailed

2006-09-21 - Priority Action Written

2006-09-19 - Assigned To Examiner

2006-05-19 - Application Filing Receipt Mailed

2006-05-15 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Francis C. Kowalik

Correspondent

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WALGREEN CO.

104 WILMOT ROAD -M.S. #1425

DEERFIELD, IL 60015

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