

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

In the Matter of Application Serial No. 76/172,481
Published in the *Official Gazette* on May 21, 2002 at TM 389



06-18-2002

U.S. Patent & TMOft/TM Mail Rcpt Dt. #74

551 Odgen, Inc.,

Opposer,

v.

Bone Daddy's Inc.

Applicant.

Opposition No.:

BOX TTAB

FEE

Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

NOTICE OF OPPOSITION

551 Ogden, Inc., a corporation organized and existing under the laws of the State of Illinois, having its principal place of business at 1641 West Kinzie Avenue, Chicago, Illinois 60622 ("Opposer") believes it will be damaged by registration of the mark shown in Serial No. 76/172,481 and hereby opposes the same.

As grounds of opposition, Opposer states:

1. Bone Daddy's Inc., ("Applicant") seeks to register BONE DADDY'S HOUSE OF SMOKE as a trademark in Class 25 for "clothing, namely, t-shirts, hats and apparels advertising applicant's restaurant and catering food services" (hereinafter "Applicant's goods"), as published in the Official Gazette of May 21, 2002 at TM 389.

2. Opposer filed an Intent to Use Application for the mark BONE DADDY in Class 42 on April 13, 1998. Opposer filed an Intent to Use Application for the BONE DADDY mark in Class 30 on November 8, 1999. Opposer has, since at least as early as December 23, 2000, used the family of BONE DADDY marks in connection with its restaurant and catering food services, with clothing bearing advertising for its restaurant services, as well as with its barbecue sauce and dry rub seasoning. These Intent to Use Applications have matured into registrations.

3. Opposer is the owner of the following two U.S. trademark registrations:

BONE DADDY, Registration No. 2,471,883 in Class 42, registered on July 24, 2001, with a date of first use of December 23, 2000, for restaurant and bar services.

BONE DADDY, Registration No. 2,478,567 in Class 30, registered on August 14, 2001, with a date of first use of December 23, 2000, for barbecue sauce and dry rub seasoning.

4. Applicant has unsuccessfully attempted to register BONE DADDY'S HOUSE OF SMOKE in Class 42. The application for that mark, serial number 76/172,482, was filed on November 28, 2000. As of April 18, 2001, an office action suspending further action on the application had been mailed.

5. The goods for which Applicant seeks to register the mark BONE DADDY'S HOUSE OF SMOKE are closely related to the goods and services actually provided by Opposer, as well as the registrations in Classes 30 and 42. Registration of Applicant's mark in Class 25 would create the same likelihood of confusion. This is particularly true because, according to its suspended 76/172,482 application, *supra*, Applicant operates a barbecue restaurant and bar. Moreover, the identification of goods in the present application (76/172,481) specifically indicates that the clothing is for the purpose of "advertising applicant's restaurant and catering food services."

6. Opposer's marks have priority over Applicant's mark. Opposer filed an Intent to Use Application for registration of BONE DADDY in Class 42 on April 13, 1998, and filed the same sort

of application in Class 30 on November 8, 1999. Applicant did not use its mark in commerce until January 1, 2000. Applicant also did not file its application for registration of BONE DADDY'S HOUSE OF SMOKE until November 28, 2000, over two and one half years after Opposer's initial filing. Accordingly, Opposer has priority.

7. Opposer has expended significant resources in the promotion and advertising of goods and services under the BONE DADDY marks and name. Opposer has built a substantial reputation, and its BONE DADDY marks and name have become widely known for denoting high quality goods and services in the barbecue restaurant industry.

8. Opposer's rights in and to its various BONE DADDY marks and names are superior to Applicant's rights in its BONE DADDY'S HOUSE OF SMOKE application by virtue of Opposer's prior registrations, and Opposer's longstanding use of the mark BONE DADDY in interstate commerce within the United States.

9. Applicant has substantially incorporated Opposer's mark BONE DADDY in its proposed mark BONE DADDY'S HOUSE OF SMOKE. Applicant's mark is intended to identify goods provided to the same type of customers, namely patrons of barbecue restaurants, as the goods and services provided by Opposer. BONE DADDY'S HOUSE OF SMOKE so nearly resembles Opposer's marks as to be likely to be confused with and mistaken for Opposer's marks. Applicant's mark is deceptively similar to Opposer's marks so as to cause confusion and lead to deception as to the origin of Applicant's goods associated with the mark.

10. If Applicant is permitted to use and register the subject mark for its goods as specified in Application serial number 76/172,482, it will cause confusion in trade, as well as damage and injury to the Opposer. Persons familiar with Opposer's marks would likely seek Applicant's goods as and for those of Opposer. Any such confusion in trade inevitably would result in loss of sales to

Opposer. Furthermore, any defect, objection, or fault found with Applicant's goods marketed under its mark would necessarily reflect upon and seriously injure the reputation that Opposer has established for the goods and services marketed under its marks.

11. If Applicant is granted the registration it seeks, it would have at least a *prima facie* exclusive right to use the mark BONE DADDY'S HOUSE OF SMOKE. Such registration would be a source of damage and injury to Opposer.

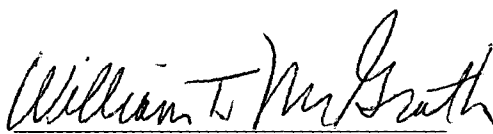
WHEREFORE, Opposer prays that the application Serial No. 76/172,482 be rejected, and that the mark therein sought for the services recited be denied and refused.

A duplicate copy of this Notice of Opposition and the fee of \$300.00 required under 37 C.F.R. §2.6(a)(17) are enclosed. The Commissioner is authorized to charge payment of any additional fees associated with this filing or credit any overpayment to Deposit Account No. 04-0257 (Davis, Mannix & McGrath).

Respectfully submitted,

551 Ogden, Inc.

By:



One of its attorneys

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Dated: 6-18-02

CERTIFICATE OF EXPRESS MAILING

"Express Mail" mailing label number: EV116572128US

Date of Deposit: 6/18/02

I hereby certify that the foregoing Notice of Opposition, along with the prescribed fee are being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to BOX TTAB/FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on the date indicated above.

6/18/02
Date of signature

Evan D. Brown
Signature

EVAN D. BROWN
Printed Name

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