



TAB

05-17-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #71

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

In the Matter of Application Serial No. 78/030,882

Published in the OFFICIAL GAZETTE on July 24, 2001

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DaimlerChrysler AG, :
Opposer, :

v. : Opposition No.

CASUAL DINING, INC., :
Applicant. :

TRADEMARK TRIAL AND
APPEAL BOARD
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NOTICE OF OPPOSITION

DaimlerChrysler AG, a corporation organized and existing under the laws of Germany, located and doing business at 70546 Stuttgart, Germany, believes it will be damaged by registration of the mark shown in application Serial No. 78/030,882 and hereby opposes said application.

Opposer brings this opposition, pursuant to Section 13(a) of the Trademark Act of 1946, as amended, based on likelihood of confusion (Section 2(d)) and dilution (Section 43(c)). The grounds of this opposition are as follows:

1. Upon information and belief, Applicant is a corporation organized and existing under the laws of the State of Texas, located and doing business at 1260 Blalock, Suite 210, Houston, Texas 77055.

2. (a) On October 16, 2000, Applicant filed an intent-to-use application, SN 78/030,882, to register the mark MERCEDES BEANS, MOSTLY MEXICAN GRILL for "restaurant services."

(b) Upon information and belief, the opposed mark was not used by Applicant in the United States before October 16, 2000.

(c) Upon information and belief, the opposed mark has not been used by Applicant in the United States since October 16, 2000.

3. Opposer is, and has long been, a leading manufacturer and marketer of automobiles and automobile parts, accessories and services. Since long prior to the filing date of the opposed application, Opposer and its predecessors in business (hereinafter collectively referred to as "Opposer") have owned and used, throughout the United States, the famous and distinctive trademark, service mark and trade name

MERCEDES-BENZ in connection with the aforesaid automotive goods and services, and diverse other goods and services. Opposer's MERCEDES-BENZ goods and services are marketed in the United States through Opposer's indirect wholly-owned subsidiary, Mercedes-Benz USA, Inc. ("MB USA").

4. Since long prior to the filing date of the opposed application, Opposer has continuously and extensively marketed throughout the United States automobiles and automobile parts, accessories and services identified and distinguished by Opposer's famous and distinctive MERCEDES-BENZ mark.

5. A broad range of other consumer goods have been distributed and sold in the United States by MB USA and its authorized Mercedes-Benz dealers under Opposer's mark and trade name MERCEDES-BENZ since long prior to the filing date of the opposed application. These goods have included beverage mugs and tumblers, T-shirts, caps and other clothing items, sunglasses, luggage, briefcases, travel board games, teddy bears, golf bags and accessories, towels, blankets, umbrellas, watches, key rings, pens, bicycles, and toy model cars.

6. Since long prior to the filing date of the opposed application, MB USA has been providing hospitality services, including the provision of food and beverages to members of the public at MERCEDES-BENZ hospitality facilities at major auto shows and at numerous sporting, cultural and other events sponsored by MB USA in the United States. Opposer's MERCEDES-BENZ mark and trade name and/or its shortened form, MERCEDES, have been prominently used in connection with these events and have been displayed on promotional materials therefor which have announced the provision of food and beverages.

7. Opposer's trademark and service mark MERCEDES-BENZ is the subject of many registrations on the Principal Register in the United States Patent and Trademark Office, including:

- (a) No. 657,386 of Jan. 21, 1958
- (b) No. 1,060,986 of Mar. 8, 1977
- (c) No. 1,372,528 of Nov. 26, 1985
- (d) No. 1,372,641 of Nov. 26, 1985
- (e) No. 1,377,204 of Jan. 7, 1986
- (f) No. 1,419,449 of Dec. 2, 1986

(g) No. 1,424,048 of Jan. 6, 1987

A copy of each such registration is annexed hereto as Exhibits A through G, respectively. All these registrations are valid, subsisting and incontestable. Opposer is the owner of said registrations, the trademarks and service marks shown therein and of the good will of Opposer's business connected with and symbolized by said marks.

8. Since long prior to the filing date of the opposed application, large sums of money and considerable effort have been expended in advertising, promoting and popularizing Opposer's mark and trade name MERCEDES-BENZ. By reason thereof, and by reason of the long continued and extensive use of, and vast nationwide publicity received by, said mark and trade name, and the excellence of the goods, services and activities identified thereby, a good will and reputation of inestimable value has been built up in Opposer's nationally famous and distinctive MERCEDES-BENZ mark and trade name for said goods, services and activities identified and distinguished thereby.

9. The mark MERCEDES BEANS, MOSTLY MEXICAN GRILL shown in the opposed application SN 78/030,882 so closely

resembles Opposer's prior MERCEDES-BENZ mark and trade name as to be likely, when applied to the services of Applicant, to cause confusion, or to cause mistake, or to deceive. Such use by Applicant will cause the public to mistakenly believe that Applicant's services originate with, or are approved or licensed by Opposer, or are otherwise connected or associated with Opposer.

10. Since long prior to the filing date of the opposed application and continuing to the present, Opposer's distinctive mark and trade name MERCEDES-BENZ has been famous throughout the United States to the public at large, including potential customers for Applicant's restaurant services.

11. The mark MERCEDES BEANS, MOSTLY MEXICAN GRILL shown in the opposed application SN 78/030,882, when used for the services of Applicant, would cause dilution of the distinctive quality of Opposer's famous mark MERCEDES-BENZ.

12. All the acts complained of herein by Opposer have occurred without its consent.

13. If Applicant were granted registration of the mark MERCEDES BEANS, MOSTLY MEXICAN GRILL, it would obtain the prima facie right to use said mark and all marks likely to be confused therewith, for the services specified in the opposed application and all related goods and services. Such registration would thus be a source of damage and injury to Opposer.

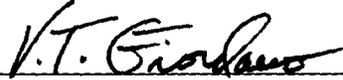
14. Opposer cannot control the quality of Applicant's services. The use of the mark opposed herein would, therefore, place in jeopardy the valuable reputation that Opposer has built up in its long prior, famous, and distinctive MERCEDES-BENZ mark and trade name.

WHEREFORE, Opposer prays that application SN 78/030,882 be rejected and that the registration of the opposed mark MERCEDES BEANS, MOSTLY MEXICAN GRILL for the

services therein specified be refused and denied.

VON MALTITZ, DERENBERG, KUNIN,
JANSSEN & GIORDANO

By



V. T. Giordano
A Member of the Firm
60 East 42nd Street
New York, NY 10165
Telephone: 212-661-1400
Attorneys for Opposer

May 17, 2002

United States Patent Office

657,386

Registered Jan. 21, 1958

PRINCIPAL REGISTER Trademark

Ser. No. 23,779, filed Feb. 5, 1957

MERCEDES-BENZ

Daimler-Benz Aktiengesellschaft (German corporation)
Mercedes-Strasse 136
Stuttgart, Germany

For (based on use in commerce): AUTOMOBILES,
MOTOR TRUCKS, AND PARTS THEREOF, SKI-
HOLDERS FOR USE ON AUTOMOBILES AND
REAR-VIEW MIRRORS, in CLASS 19.

For (based on German registration): VEHICLES
FOR USE ON LAND, IN THE AIR AND IN THE
WATER AND PARTS OF ALL OF SUCH GOODS,
in CLASS 19.

First use 1926; in commerce 1927; 1896 as to "Benz"
and 1900 as to "Mercedes."

Owner of German Reg. No. 375,067, dated Oct. 10,
1927; and U. S. Reg. Nos. 41,127, 94,066, and others.

~~Sec. 8 affid. accepted~~

~~Sec. 15 affid. filed~~

Renewed in 1978 for:

AUTOMOBILES, MOTOR TRUCKS, AND PARTS THEREOF,
SKI-HOLDERS FOR USE ON AUTOMOBILES, REAR-VIEW
MIRRORS, VEHICLES FOR USE ON LAND AND PARTS OF
SUCH GOODS, ~~AND PARTS OF VEHICLES FOR USE IN
THE WATER~~

EXHIBIT A

Int. Cl.: 37

Prior U.S. Cl.: 103

United States Patent Office

Reg. No. 1,060,986

Registered Mar. 8, 1977

SERVICE MARK

Principal Register

MERCEDES-BENZ

Daimler-Benz Aktiengesellschaft (German corporation)
7000 Stuttgart 60
Unterturkheim, Germany

For: REPAIR, RECONDITIONING, REPLACEMENT AND SERVICING OF MOTORS, PARTS THEREOF AND ACCESSORIES THERETO, AND THE REPAIR, RECONDITIONING AND SERVICING OF MOTOR VEHICLES, PARTS THEREOF AND ACCESSORIES THERETO, in CLASS 37 (U.S. CL. 103).

First use at lease as early as 1954; in commerce at least as early as 1954.

Owner of Reg. Nos. 41,127, 743,756, and others.

Ser. No. 89,866, filed June 11, 1976.

J. P. WILLIAMSON, Examiner

EXHIBIT B

Sec. 8 affdat. accepted

Sec. 15 affdat. filed

Int. Cl.: 16

Prior U.S. Cl.: 37

United States Patent and Trademark Office

Reg. No. 1,372,528

Registered Nov. 26, 1985

**TRADEMARK
PRINCIPAL REGISTER**

MERCEDES-BENZ

DAIMLER-BENZ AKTIENGESELLSCHAFT
(FED REP GERMANY CORPORATION)
STUTTGART 60
UNTERTURKHEIM, FED REP GERMANY

FIRST USE 0-0-1979; IN COMMERCE
0-0-1979.
OWNER OF U.S. REG. NOS. 285,557, 657,386
AND OTHERS.

SER. NO. 542,831, FILED 6-13-1985.

FOR: NOTE PAD BLOCKS AND PENS, IN
CLASS 16 (U.S. CL. 37).

TERESA M. RUPP, EXAMINING ATTORNEY

Sec. 8 affdt.
accepted

Sec. 15 affdt.
filed

EXHIBIT C

Int. Cl.: 21

Prior U.S. Cl.: 30

Reg. No. 1,372,641

United States Patent and Trademark Office Registered Nov. 26, 1985

**TRADEMARK
PRINCIPAL REGISTER**

MERCEDES-BENZ

DAIMLER-BENZ AKTIENGESELLSCHAFT
(FED REP GERMANY CORPORATION)
7000 STUTTGART 60
UNTERTURKHEIM, FED REP GERMANY

FIRST USE 0-0-1983; IN COMMERCE
0-0-1983.
OWNER OF U.S. REG. NOS. 285,557, 657,386,
AND 681,158.

FOR: PORCELAIN DRINKING MUGS, POR-
CELAIN TANKARDS, AND PORCELAIN CUPS
AND SAUCERS, IN CLASS 21 (U.S. CL. 30).

SER. NO. 542,919, FILED 6-13-1985. A
TERESA M. RUPP, EXAMINING ATTORNEY

Sec. 8 affdt.
accepted
Sec. 15 affdt.
filed

EXHIBIT D

Int. Cl.: 18

Prior U.S. Cls.: 3 and 41

United States Patent and Trademark Office

Reg. No. 1,377,204

Registered Jan. 7, 1986

**TRADEMARK
PRINCIPAL REGISTER**

MERCEDES-BENZ

DAIMLER-BENZ AKTIENGESELLSCHAFT
(FED REP GERMANY CORPORATION)
STUTT GART 60, FED REP GERMANY 7000

FIRST USE 0-0-1969; IN COMMERCE
0-0-1969.

SER. NO. 542,918, FILED 6-13-1985.

FOR: ALL-PURPOSE SPORTS BAGS, SHOUL-
DER BAGS, TOTE BAGS AND UMBRELLAS,
IN CLASS 18 (U.S. CLS. 3 AND 41).

DEBORAH S. COHN, EXAMINING ATTORNEY

Sec. 8 applt.
accepted

Sec. 15 applt.
filed

EXHIBIT E

Int. Cls.: 36 and 39

Prior U.S. Cls.: 102 and 105

United States Patent and Trademark Office

Reg. No. 1,419,449

Registered Dec. 2, 1986

**SERVICE MARK
PRINCIPAL REGISTER**

MERCEDES-BENZ

DAIMLER-BENZ AKTIENGESELLSCHAFT
(FED REP GERMANY CORPORATION)
STUTTGART (UNTERTURKHEIM), FED REP
GERMANY

FOR: SALES FINANCING OF MOTOR VEHI-
CLES, ~~AND ADMINISTERING INSURANCE~~
~~PLANS FOR OTHERS~~, IN CLASS 36 (U.S. CL.
102).

FIRST USE 12-1-1982; IN COMMERCE
12-1-1982.

FOR: LEASING OF MOTOR VEHICLES , IN
CLASS 39 (U.S. CL. 105).

FIRST USE 5-2-1983; IN COMMERCE
5-2-1983.

OWNER OF U.S. REG. NOS. 657,386, 1,060,985
AND OTHERS.

SER. NO. 592,576, FILED 4-10-1986.

R. ELLSWORTH WILLIAMS, EXAMINING AT-
TORNEY

Sec. 8 affdt.
accepted

Sec. 15 affdt.
filed

EXHIBIT F

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,424,048

Registered Jan. 6, 1987

**TRADEMARK
PRINCIPAL REGISTER**

MERCEDES-BENZ

DAIMLER-BENZ AKTIENGESELLSCHAFT
(FED REP GERMANY CORPORATION)
STUTTGART 60
UNTERTURKHEIM, FED REP GERMANY

FOR: ~~WOMEN'S SCARFS; MEN'S AND
WOMEN'S SPORT SHIRTS; MEN'S AND
WOMEN'S SWEATERS; MEN'S AND WOMEN'S
T-SHIRTS; MEN'S OUTER JACKETS AND
VESTS; MEN'S AND WOMEN'S WARM-UP
SUITS; MEN'S AND WOMEN'S SHORTS; MEN'S~~

AND WOMEN'S HATS AND TENNIS VISORS,
IN CLASS 25 (U.S. CL. 39).

FIRST USE 0-0-1970; IN COMMERCE
0-0-1970.

OWNER OF U.S. REG. NOS. 285,557, 1,389,007
AND OTHERS.

SER. NO. 604,621, FILED 6-16-1986.

RICHARD B. GORDON, EXAMINING ATTOR-
NEY

Sec. 8 affdt.
accepted

Sec. 15 affdt.
filed

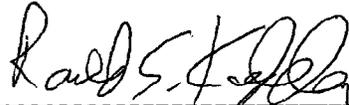
EXHIBIT G

Notice of Opposition by DaimlerChrysler AG
Against Application Serial No. 78/030,882
Filed by Casual Dining, Inc.

CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

"Express Mail" Mailing Label Number EV008598911US
Date of Deposit: May 17, 2002

I hereby certify that this Notice of Opposition and fee, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Box TTAB/FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.



For Von Maltitz, Derenberg,
Kunin, Janssen & Giordano

05-17-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #71 **ON MALTITZ, DERENBERG, KUNIN, JANSSEN & GIORDANO**

60 EAST 42ND STREET
NEW YORK, N. Y. 10165

TELEPHONE (212) 661-1400
FAX (212) 370-1819

May 17, 2002

Box TTAB/FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

In the matter of the Opposition by DaimlerChrysler AG against Application Serial No. 78/030,882 filed by Casual Dining, Inc. and published in the Official Gazette on July 24, 2001, we enclose the following:

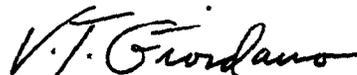
- (1) Original and duplicate original of the opposition;
- (2) Our check in the amount of \$300.00 in payment of the statutory fee; and
- (3) Acknowledgment postcard.

Please stamp and return the postcard as your acknowledgment of safe receipt.

Also, please charge our Patent and Trademark Office Deposit Account No. 22-0560 for any additional fees that may be required.

All correspondence or communications concerning this opposition should be directed to the undersigned.

Very truly yours,



V. T. Giordano

VTG/am
Enc.

