

# TTAB

MCINNE 10.2A-001

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

Jersey Mike's Franchise Systems, Inc.	:	
	:	Mark: RESTAURANT MIKES
Opposer,	:	RESTAURANT & Design
v.	:	
	:	Serial No.: 76/433,515
Mikes Restaurants Inc. Les Restaurants Mikes	:	
Inc.	:	Opposition No. 160,452
	:	
Applicant.	x	

**ANSWER TO NOTICE OF OPPOSITION  
AND PETITION FOR CANCELLATION**

Applicant, Mike's Restaurants Inc. Les Restaurants Mikes Inc. ("Mikes Restaurant"), for its answer to the Notice of Opposition, alleges as follows:

1. Applicant admits the allegation of paragraph 1.
2. Applicant admits the allegation of paragraph 2.
3. Applicant admits that Jersey Mike's is listed as the owner of Registration No. 1,993,658 and that a copy of the registration certificate with information from a website regarding the current status are attached as Exhibit A to the Notice of Opposition, but is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 3 and therefore denies them.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 4 and therefore denies them.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Trademarks, Trademark Trial & Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3514 on July 14, 2004.

  
\_\_\_\_\_  
(Signature)

Charles P. Kennedy  
\_\_\_\_\_  
(Typed or Printed Name of Person Signing Certificate)



5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 5 and therefore denies them.

6. Applicant denies the allegations of paragraph 6.

7. Applicant admits that Opposer's Registration No. 1,993,658 covers "restaurant services," that some of the services covered by Applicant's Application Serial No. 76/433,515 are also "restaurant services," and that Applicant's Application Serial No. 76/433,515 covers as goods "pepperoni" and "frozen pizza," but denies all other allegations of paragraph 7.

8. Applicant does not understand the meaning of paragraph 8 in reference to the distribution of services and therefore denies the allegations of paragraph 8.

9. Applicant denies the allegations of paragraph 9.

10. Applicant denies the allegations of paragraph 10.

**FIRST AFFIRMATIVE DEFENSE**

11. The Notice of Opposition fails to state a claim upon which relief can be granted.

**COUNTERCLAIMS -  
Cancellation of Registration No. 1,993,368**

1. Petitioner, Mikes Restaurants Inc./Les Restaurants Mikes Inc. ("Mikes Restaurant"), is a Canadian corporation having its principal place of business at 8250 Decarie Boulevard, Suite 310, Montreal, Quebec, Canada H4P 2P5, and is also the applicant in Opposition No. 160,452.

2. Respondent, Jersey Mike's Franchise Systems, Inc. ("Jersey Mike's") is a New Jersey corporation with a principal place of business at 2251 Landmark Place, Manasquan, New Jersey 08736, and is also the opposer in Opposition No. 160,452.

3. Jersey Mike's is the owner of record of Registration No. 1,993,658 for the mark MIKES in Submarine Sandwich Design, lined for the colors orange and red, for "restaurant services."

4. Mikes Restaurants has filed Application Serial No. 76/433,515 to register the mark RESTAURANT MIKES RESTAURANT and Design for "pepperoni" in class 29; "frozen pizza and tomato sauce" in class 30; "meal delivery services" in class 39; and "restaurant services and restaurant takeout services" in class 43. Mikes Restaurants has a *bona fide* intention to use its design mark RESTAURANT MIKES RESTAURANT and Design for these goods and services.

5. Based on its Registration No. 1,993,658, Jersey Mike's has filed Opposition No. 160,452 against Mikes Restaurant's Serial No. 76/433,515, and has requested that such application be denied registration.

6. Jersey Mike's Registration No. 1,993,658 for the mark MIKES in Submarine Sandwich Design resulted from Application No. 75/002,271 filed on October 6, 1995, attesting that the service mark "was first used in connection with the services on August 16, 1978; was first used in interstate commerce in connection with the services on November 11, 1980; and is now in use in such commerce in connection with such services." The application also attested that the mark "is used in advertisements and promotional materials for the services and in other ways customary to the trade . . . ."

7. On information and belief, at the time that Jersey Mike's filed Application Serial No. 75/002,271, Jersey Mike's had not made *bona fide* use of the MIKES in Submarine Sandwich Design mark as a service mark for restaurant services, and was not then using such

mark through *bona fide* use in interstate commerce, but had only a display of the mark on a cluttered menu board merely to reserve rights in the mark.

8. Registration No. 1,993,658 should be canceled because it was applied for and registered contrary to the provisions of 15 U.S.C. § 1051, because it was not a trademark used in commerce.

9. On or about August 12, 2002, Jersey Mike's filed a combined declaration of use and incontestability under Sections 8 and 15 of the Trademark Act for Registration No. 1,993,658. In the affidavit, Jersey Mike's attested that the MIKES in Submarine Sandwich Design mark was still in use in commerce in connection with the services, and had been in continuous use in commerce for five years after the date of registration. Based on Jersey Mike's affidavit and the statements made in that affidavit, the United States Patent and Trademark Office on October 8, 2002 accepted the Section 8 affidavit and acknowledged the Section 15 affidavit.

10. On information and belief, contrary to the affidavits submitted by Jersey Mike's, as of August 12, 2002, Jersey Mike's was not making *bona fide* use of the MIKES in Submarine Sandwich Design mark for restaurant services and had not made *bona fide* use of that mark for the five years after the date of registration, but had only a display of the mark on a cluttered menu board merely to reserve rights in the mark.

11. Registration No. 1,993,658 should be denied incontestable status because the subject mark did not have *bona fide* and continuous use as a service mark in commerce for five years after the date of registration.

12. On information and belief, since the date of issuance of Registration No. 1,993,658 for the mark MIKES in submarine sandwich design, Jersey Mike's has, for a

period of time continuing to the present, not used the mark as a *bona fide* service mark for restaurant services, and has abandoned all rights to the mark covered by Registration No. 1,993,658.

13. The registration for which cancellation is hereby petitioned has created statutory rights in the respondent Jersey Mike's that are in violation and derogation of the rights of Mikes Restaurant and the ability of Mikes Restaurants to obtain a registration for its Serial No. 76/433,515, and will result in detriment and damage to the petitioner Mikes Restaurant.

14. Three copies of this petition for cancellation are enclosed. Please charge the fee of \$300 to our Deposit Account No. 12-1095.

WHEREFORE, petitioner Mikes Restaurant requests (1) for the petition to cancel, that Registration No. 1,993,658 owned by Jersey Mike's be canceled, and (2) for its answer to the Notice of Opposition, that the Notice of Opposition be dismissed and that Mikes Restaurant Serial No. 76/433,515 be allowed.

Respectfully submitted,

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Dated: July 14, 2004

By: 

Charles P. Kennedy

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the within ANSWER TO NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION was served upon the following counsel of record this 14 day of July 2004, as follows:

**VIA FIRST-CLASS MAIL:**

Kathleen T. Gallagher-Duff  
COVINGTON & BURLING  
1201 Pennsylvania Avenue, N.W.  
Washington, DC 20004-2401

*Attorneys for Opposer  
Jersey Mike's Franchise Systems, Inc.*

  
\_\_\_\_\_  
Charles P. Kennedy

File No.: MCINNE 10.2A-001  
Opposition No. 91160452