ESTTA Tracking number: **ESTTA275297**

Filing date: **03/31/2009**

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

Proceeding	91161954
Party	Plaintiff PABST BREWING COMPANY
Correspondence Address	WILLIAM B. NASH JACKSON WALKER L.L.P. 112 E. PECAN STREET, SUITE 2100 SAN ANTONIO, TX 78205 UNITED STATES bnash@jw.com
Submission	Brief on Merits for Plaintiff
Filer's Name	William B. Nash
Filer's e-mail	bnash@jw.com, mfassold@jw.com, llapidario@jw.com, lstuder@jw.com
Signature	/William B. Nash/
Date	03/31/2009
Attachments	2009-03-31 FILED Opposer's Trial Brief.pdf (39 pages)(2040490 bytes)

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

Pabst Brewing Company **Opposer,** **v.** **Lone Star Steakhouse & Saloon** **Applicant.**	)	**Opposition No. 91161954** **Opposition No. 91161955** **Serial Nos.: 75/883,254 and 75/883,253** **Mark: LONE STAR & Design, and LONE STAR**

OPPOSER'S TRIAL BRIEF

On the Brief:

William B. Nash,
Reg. No. 33,743
Jackson Walker, LLP
112 E. Pecan Street, Suite 2400
San Antonio, Texas 78205
(210) 978-7764
(210) 978-4620 (Fax)
bnash@jw.com

TABLE OF CONTENTS

I. PROCEDURAL HISTORY / EVIDENCE OF RECORD 1

A. Procedural History 1
B. Opposer's Evidence of Record: 2
C. Applicant's Evidence of Record: 4

II. ARGUMENT -- LIKELIHOOD OF CONFUSION 4

A. Analysis Of The *DuPont* Factors Demonstrates That Confusion Is Likely 8

1. 1st DuPont Factor. The Similarity Or Dissimilarity Of The Marks In Their Entireties As To Appearance, Sound, Connotation and Commercial Impression. 9
2. 2nd *DuPont* Factor. The Similarity Or Dissimilarity and Nature Of the Parties' Respective Goods 11
3. 3rd *DuPont* Factor. The Fame of the Prior Mark 20
4. 4th *DuPont* Factor: The Similarity or Dissimilarity of Established, Likely-To-Continue Trade Channels 27
5. 5th *DuPont* Factor: The Conditions Under Which And Buyers To Whom Sales Are Made 27
6. 6th *DuPont* Factor. The Number and Nature of Similar Marks In Use on Similar Goods 28
7. 7th *DuPont* Factor. The Nature And Extent Of Any Actual Confusion; and 8th *DuPont* Factor. The Length of Time During And Conditions Under Which There Has Been Concurrent Use Without Evidence Of Actual Confusion 28
8. 9th *DuPont* Factor. The Extent of Potential Confusion Is Substantial 32

III. CONCLUSION 33

TABLE OF AUTHORITIES

Cases:

Amoco Oil Co. v. Amerco, Inc. 192 USPQ 729 (TTAB 1976) 10

Black & Decker Mfg. Co., v. Bright Star Industries, 220 USPQ 890 (TTAB 1983) 26

Bose Corp. v. QSC Audio Products, Inc., 293 F3d 1367; 63 USPQ2d 1303 (Fed. Cir. 2005) 24

Century 21 Real Estate Corp. v. Century Life of America, 23 USPQ2d 1698 (CAFC 1992) 33

Chemetron Corp. v. Morris Coupling & Clamp Co., 203 USPQ 537 (TTAB 1979) 11

Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc. 526 F.2d 556, 188 USPQ 105 (CCPA 1975) 10

Esso Standard Oil Co. v. Sun Oil Co., 229 F2d 37, 108 USPQ 161 (D.C. Cir.) *cert. denied;* 351 U.S. 973, 109 USPQ 517 (1956) 11

Gor-Ray Ltd. v. Garay & Co., Inc., 167 USPQ 694 (TTAB 1970) 26

Guardian Products Co., Inc. v. Scott Paper Co., 200 USPQ 738 (TTAB 1978) 8, 12, 15

In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987) 10

In re August Storck KG, 218 USPQ 823 (TTAB 1983) 8

In re Big Pig, Inc., 81 USPQ2d 1436 (TTAB 2006) 31

In re Boyd Coffee Co., 25 USPQ2d 2052 (TTAB 1993) 32

In re Chemical Dynamics Inc., 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988) 30, 31

In re Corning Glass Works, 229 USPQ 65 (TTAB 1985) 12

In re Dixie Restaurants Inc., 41 USPQ2d 1531, 1533 (CAFC 1997) 8

In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) 7, 24

In re International Telephone & Telegraph Corp., 197 USPQ 910 (TTAB 1978) 8, 12

In re Jeep Corp., 222 USPQ 333 (TTAB 1984) 18

In re Library Restaurant, Inc., 194 USPQ 446 (TTAB 1977) 32

In re Mango Records, 189 USPQ 126 (TTAB 1975) 32

In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) 10, 12, 18

In re Miller Sports Inc., 51 USPQ2d 1059 (TTAB 1999) 30, 32

In Re Phillips-Van Heusen Corp., 228 USPQ 949, 951 (TTAB 1986) 17

In re Rexel Inc., 223 USPQ 830 (TTAB 1984) 12

In re Semans, 193 USPQ 727 (TTAB 1976) 30

In re Sperouleas, 227 USPQ 166 (TTAB 1985) 32

Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F2d 350, 22 USPQ2d 1453, (Fed. Cir., 1992), *cert. denied*, 506 U.S. 862 (1992) 24

Li & fung (B.V.I.) Limited v. Kenosha Ferrell, 2008 WL 4674609 at 4, (Trademark Tr. & App. Bd. 2008) 27

Octocom Systems Inc. v. Houston Computers Services Inc., 16 USPQ2d 1783 (CAFC 1990) 12, 15

On-line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) 18

Oxford Pendaflex Corp. v. Anixter Bros. Inc., 201 USPQ 851 (TTAB 1978) 12, 14, 26

Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772, 396 F3d 1369, 1374; 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) 24

Recot, Inc. v. M.C. Becton, 214 F3d 1322, 1327; 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) 24

Safety-Kleen Corp. v. Dresser Indus. Inc., 518 F.2d 1399, 186 USPQ 476 (C.C.P.A. 1975) 18

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975) 11

Visual Information Institute, Inc. v. Vicon Industries Inc., 209 USPQ 179 (TTAB 1980) 11

Warnaco, Inc. v. Adventure Knits, Inc., 210 USPQ 307 (TTAB1981) 12, 14, 15

George H. Zoes v. Brett Shevack, 2007 WL 1022714 at 7, (Trademark Tr. & App. Bd. 2007) 28

Statutes:

TMEP § 1207.01(b) 12

TMEP 1207.01(d)(iii) 3, 5, 17, 18, 28

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

Pabst Brewing Company **Opposer,**	)	**Opposition No. 91161954**
v.	)	**Serial Nos.: 75/883,254 and 75/883,253**
	)	**Mark: LONE STAR & Design and**
Lone Star Steakhouse & Saloon **Applicant.**	)	**LONE STAR**

OPPOSER'S TRIAL BRIEF

TO THE HONORABLE BOARD:

Opposer, Pabst Brewing Company, through its undersigned attorneys, Jackson Walker, LLP, respectfully requests that its opposition to Application Serial Nos. 75/883,254 and 75/883,253 be granted on the basis of likelihood of confusion.

I. PROCEDURAL HISTORY / EVIDENCE OF RECORD

A. Procedural History

1. Applicant seeks to register the mark LONE STAR & Design as a trademark for "clothing, namely t-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps." Applicant filed its Application Serial No. 75/883,254 in International Class 25 on December 29, 1999, and the U.S. Patent and Trademark Office published the mark in the Official Gazette on March 23, 2004. Opposer filed its Notice of Opposition (Opposition No. 91161954) on August 26, 2004. Applicant filed its Answer and Affirmative Defenses on May 12, 2006.

2. Applicant also seeks to register the mark LONE STAR as a trademark for "clothing, namely t-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps." Applicant filed its Application Serial No. 75/883,253 in International Class 25 on December 29, 1999, and the U.S. Patent and Trademark Office published the mark in the *Official Gazette* on March 2, 2004. Opposer filed its Notice of Opposition (Opposition No. 91161955) on August 26, 2004. Applicant filed its Answer and Affirmative Defenses on May 12, 2006.

3. On April 27, 2006, the Board consolidated Opposition Nos. 91161954 and 91161955, with the instant Opposition No. 91161954 being the "parent" case. The two marks in question are referred to as "Opposed Marks."

4. Opposer filed various Notices of Reliance as evidence as listed below. Neither party took testimony depositions.

B. Opposer's Evidence of Record:

5. Opposer filed the following as evidence which is of record:

a. Opposer's First Notice of Reliance: The referenced First Notice of Reliance is comprised of a copy of Opposer's pleaded Trademark Registration No. 674,291 issued February 17, 1959 for the mark LONE STAR for "beer," Registration No. 2,191,783 issued September 29, 1998 for the mark LONE STAR for "alcoholic and nonalcoholic malt beverages," and Registration No. 3,264,576 for the mark LONE STAR for "beer."

b. Opposer's Second Notice of Reliance: The Second Notice of Reliance is comprised of Applicant's responses to Opposer's First Request for Admissions and Opposer's First Set of Interrogatories.

c. Opposer's Third Notice of Reliance: The Third Notice of Reliance is comprised of "live" third-party trademark registrations that recite both Class 32 (e.g.

"beer") and International Class 25 (e.g. "clothing") in the identification of goods. The third-party registrations show that goods from Class 32 and Class 25 tend to emanate from a single source such as Opposer. *See* TMEP 1207.01(d)(iii).

d. Opposer's Fourth Notice of Reliance. The Fourth Notice of Reliance is comprised of screen shots from the movie Urban Cowboy showing examples of men's and women's LONE STAR clothing, and a copy of the official movie poster showing John Travolta holding "the National Beer of Texas."

e. Opposer's Fifth Notice of Reliance. The Fifth Notice of Reliance is comprised of testimony in the form of Declarations from Gary Galecke and David Schield.

f. Opposer's Sixth Notice of Reliance. The Sixth Notice of Reliance is comprised of registrations showing the relationship between a company's use of its marks on clothing for advertising and marketing for its goods and services.

g. Opposer's Seventh Notice of Reliance. The Seventh Notice of Reliance is comprised of Applicant's Trademark Application and Specimens in the file of its pleaded Application Serial No. 75/883,254 filed on December 29, 1999.

h. Opposer's Eighth Notice of Reliance. The Eighth Notice of Reliance is comprised of Applicant's Trademark Application and Specimens in the file of its pleaded Application Serial No. 75/883,253 filed on December 29, 1999.

i. Opposer's Ninth Notice of Reliance. Opposer's Ninth Notice of Reliance is comprised of Applicant's Trademark Application and Specimens in the file of Application Serial No. 78/445,281 which issued on September 6, 2005 as U.S. Registration No. 2,992,302.

C. **Applicant's Evidence of Record:**

6. Applicant has not filed any Notices of Reliance.

II. ARGUMENT -- LIKELIHOOD OF CONFUSION

7. This is a case involving identical marks i.e., LONE STAR versus LONE STAR and LONE STAR & Design, used on identical goods, i.e., "clothing, namely, t-shirts, sport shirts, and caps." There is no issue as to priority as Opposer is the owner of U.S. Reg. No. 674,291 issued February 17, 1959 for beer which predates Applicant's claimed date of first use by 30 years, i.e., Applicant claims 1989 as date of first use.

LONE STAR

8. Opposer also owns U.S. Reg. No. 676,429 issued March 31, 1959 (now expired) for beer.

This shield with a 5 pointed star has been used by Opposer for over 50 years and is still being used.

9. By virtue of its efforts, the expenditure of considerable sums for promotional activities, and the excellence of its products, Opposer's mark LONE STAR for "beer" is famous and entitled to broad protection.

10. Opposer and its predecessors in title have, since at least 1940, used the mark LONE STAR on a variety of goods, including clothing, to advertise and promote its LONE STAR beer products in the United States.

11. Even if the prior use by Opposer on clothing is not persuasive, live third party registrations for "beer" and "clothing," all of which are based on use, are probative of the fact that the consuming public is aware that beer manufacturers place their trademarks on beer containers (i.e., the product sold) and on clothing (i.e., a means to advertise the product sold) and that the goods are of a type which may emanate from a single source.

12. The relationship between a company's use of its mark on clothing for advertising and marketing of its goods and services is so well known and common that a person encountering them are likely to assume that they originate at the same source or that there is some association between their sources. Even Applicant has registered the Opposed Marks for "restaurant and bar services;" i.e. LONE STAR, Reg. No. 2596707 for "restaurant and bar services" and LONE STAR & Design, Reg. No. 2596706 for "restaurant and bar services." (These two registrations and the two opposed applications were all filed on the same day.) This well known relationship is also evidenced by Applicant's other common registrations for restaurant and bar services and clothing:

13. LONE STAR STEAKHOUSE & SALOON & Design, Reg. No. 2229771 for "restaurant services;"

14. LONE STAR STEAKHOUSE & SALOON & Design, Reg. No. 1731247 for "clothing; namely, men's and women's sport shirts, sweat shirts, polo shirts and caps;"

15. LONE STAR STEAKHOUSE & SALOON, Reg. No 2997691 for "restaurant and bar services;"

16. LONE STAR STEAKHOUSE & SALOON, Reg. No 2992302 for "clothing, namely men's and women's shirts and caps;"

17. SULLIVAN'S STEAKHOUSE, Reg. No. 2529991 for "general restaurant and bar services;" and

18. SULLIVAN'S STEAKHOUSE, Reg. No. 2062637 for "clothing, namely, T-shirts, shirts, coats, sweaters, sweatshirts, pants, shorts, jackets, neckwear, bandanas, scarves and headwear."

19. As an affirmative defense, Applicant argues that since Opposer did not oppose Applicant's prior applications for LONE STAR STEAKHOUSE & SALOON, including Reg. No. 1731247 issued Nov. 10, 1992 for clothing items that it is barred by laches, acquiescence, waiver and/or estoppel from contesting these applications. This is disingenuous because Applicant is not registering a variation of Reg. Nos. 1731247 or 2992302 (shown below)

but is in fact attempting to register a mutilation of the composite mark (Applicant's LONE STAR & Design mark shown below).

20. This mutilation is apparent on its face and also because the Applicant is using the exact same clothing specimens it used to register the composite mark to claim that it is using the

mutilated mark for support of use of the Opposed Marks.[1] Applicant's LONE STAR and LONE STAR & Design marks have not been used as a trademark for the Opposed Marks' listed goods. Applicant has only used the composite mark. Applicant hid this fact from the examiner when it failed to tell the examiner that it was using the same specimens it had previously submitted to obtain and maintain the composite registrations Reg. Nos. Reg. 1731247 and 2992302.

21. Applicant's LONE STAR and LONE STAR & Design applications should not be issued due to a likelihood of confusion with Opposer's LONE STAR mark based on the following reasons: 1) the similarity of the marks, i.e., Opposer's LONE STAR mark is identical to Applicant's LONE STAR mark and LONE STAR & Design mark; 2) Opposer has used the LONE STAR on clothing prior to the alleged use by Applicant for clothing items; (3) Opposer's LONE STAR mark for "beer" is famous and entitled to broad protection; (4) even if Opposer's LONE STAR mark for "beer" is not deemed to be famous, it is undisputed that Opposer has used the LONE STAR mark for beer prior to Applicant's use for "clothing" and there is a close association and nature of the goods in question, i.e. "beer" and "clothing" -- beer manufacturers commonly use clothing items to promote, market, and advertise beer; (5) the similarity of established, likely-to-continue trade channels in that Applicant uses the clothing items to promote, market, and advertise its restaurant and bar services and Opposer's LONE STAR beer is commonly sold in restaurants and bars; (6) the mark as applied for is a mutilation of the composite mark LONE STAR STEAKHOUSE & SALOON which has already been registered for clothing using the same specimen as those submitted to support Applicant's LONE STAR and LONE STAR & Design applications; and (7) the failure of Applicant to use the Opposed Marks as a trademark for the listed goods.

[1] *See* Exhibit A attached to Opposer's Eighth Notice of Reliance.

22. As further demonstrated below, confusion is likely, thereby irreparably damaging Opposer.

A. Analysis Of The *DuPont* Factors Demonstrates That Confusion Is Likely

23. In *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the Court of Customs and Patent Appeals ("CCPA") established thirteen (13) factors that must be considered in testing to determine the likelihood of consumer confusion. Any one or more of the factors may control a particular case. *See In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (CAFC 1997).

24. In order to determine whether there is a likelihood of confusion, the examining attorney must: 1) analyze the marks for similarities in appearance, sound, connotation and commercial impression, *In re DuPont;* 2) compare the goods and services to determine if they are related or if the marketing activities are such that they are likely to be encountered by the same persons under circumstances that would cause the mistaken belief that they originate from the same source. *See also In re August Storck KG,* 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.,* 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.,* 200 USPQ 738 (TTAB 1978).

25. In this case, the primary and controlling factors of record are: (1) the similarity of the marks, i.e., Opposer's LONE STAR mark is identical to Applicant's LONE STAR mark and LONE STAR & Design mark; 2) Opposer has used the LONE STAR on clothing prior to the alleged use by Applicant for clothing items; 3) Opposer's LONE STAR mark for "beer" is famous and entitled to broad protection; (4) even if Opposer's LONE STAR mark for "beer" is not deemed to be famous, it is undisputed that Opposer has used the LONE STAR mark for beer prior to Applicant's use for "clothing" and there is a close association and nature of the goods in question, i.e. "beer" and "clothing" -- beer manufacturers commonly use clothing items to

promote, market, and advertise beer; and (5) the similarity of established, likely-to-continue trade channels in that Applicant uses the clothing items to promote, market, and advertise its restaurant and bar services and Opposer's LONE STAR beer is commonly sold in restaurants and bars.

26. These primary factors, as well as the remaining relevant factors of record overwhelmingly favor Opposer to such a degree that there must be a finding of likelihood of confusion and the registration of the Opposed Marks must be denied.

1. **1st DuPont Factor: The Similarity or Dissimilarity of the Marks in Their Entireties as to Appearance, Sound, Connotation and Commercial Impression.**

27. The marks in issue are as follows:

Opposer's registered mark is: LONE STAR.

Opposer has used the LONE STAR mark in various different formats including but not limited to:

LONE STAR

Applicant's first mark is: LONE STAR.

Applicant's second mark is: LONE STAR & Design.

28. In it's Responses to Opposer's Request for Admissions,[2] Applicant admits the following:

Response to:	Applicant's Admission:
RFA # 19	Opposer's Mark and Applicant's LONE STAR Mark contain the same words.
RFA # 20	Opposer's Mark and Applicant's LONE STAR & Design Mark contain the same words.
RFA # 21	Opposer's Mark and Applicant's LONE STAR Mark are similar in sound.
RFA # 22	Opposer's Mark and Applicant's LONE STAR & Design Mark are similar in sound.
RFA # 23	Opposer's Mark and Applicant's LONE STAR Mark are similar in meaning.
RFA # 24	Opposer's Mark and Applicant's LONE STAR & Design Mark are similar in meaning.

29. Applicant admits that the subject marks contain the same words, are similar in sound, and are similar in meaning.

30. Additionally, adding the design element of a star, to Applicant's mark does not obviate the similarity between the marks and, in fact, increases the similarity with Opposer's marks because of Opposer's long use of a 5 pointed star. *See Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.* 526 F.2d 556, 188 USPQ 105 (CCPA 1975). Indeed, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed on the public's memory and to be used in calling for the goods or services. *See In re Appetito Provisions Co.,* 3 USPQ2d 1553 (TTAB 1987), *Amoco Oil Co. v. Amerco, Inc.* 192 USPQ 729 (TTAB 1976).

31. When word marks are identical or nearly identical and neither suggestive nor descriptive of the goods associated with them, the first *DuPont* factor weighs heavily against an

[2] *See* Opposer's Second Notice of Reliance (Exhibit B).

applicant. *See*, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566, 223 USPQ 1289, 1290 (Fed. Cir. 1984). This primary *DuPont* factor favors Opposer.

2. **2nd *DuPont* Factor: The Similarity or Dissimilarity and Nature of the Parties' Respective Goods.**

a) USPTO's Prior Refusal of Opposed Marks

32. On or about June 20, 2003, the examining attorney Ketherine Stoides refused the registration of Applicant's Serial No. 75/883,253 for the mark LONE STAR and 75/883,254 for the mark LONE STAR & Design under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) "because the applicant's mark, when used on the identified goods, is likely to be confused with the registered mark in U.S. Registration No. 2,589,026 [for the mark LONE STAR CLASSIC]. TMEP section 1207."[3]

33. In both Office Actions in the application files of Applicant's Serial Nos. 75/883,253 and 75/883,254, the examining attorney determined that the contemporaneous use of Applicant's marks LONE STAR and LONE STAR & Design and Registrant's mark LONE STAR CLASSIC "as applied to clothing, would be likely to cause confusion for the following reasons"[4]:

> "Application of the above standards clearly indicates that the dominant feature of the marks is the same terminology LONE STAR. When the applicant's mark is compared to a registered mark, 'the points of similarity are of greater importance than the points of difference.' *See Esso Standard Oil Co. v. Sun Oil Co.*, 229 F2d 37, 108 USPQ 161 (D.C. Cir.) *cert. denied;* 351 U.S. 973, 109 USPQ 517 (1956). The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The issue is whether the marks create the same overall impression. *Visual Information Institute,*

[3] *See* Office Action by Katherine Stoides and Registration No. 2,589,026 for LONE STAR CLASSIC) in the Application File for Application Serial No. 75/883,253 – Exhibit A attached to Opposer's Eighth Notice of Reliance and Office Action by Katherine Stoides and Registration No. 2,589,026 for LONE STAR CLASSIC) in the Application File for Application Serial No. 75/883,254 – Exhibit A attached to Opposer's Seventh Notice of Reliance.

[4] *Id.*, Office Action, pg. 2 ¶ 2.

> *Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP § 1207.01(b)."[5]
>
> "Both parties identify clothing. The applicant is advised that the goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some matter, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from some common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works,* 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978)."[6]

34. If the examiner had known about the Opposer's prior use of LONE STAR for clothing items, it is clear she would not have approved Applicant's Opposed Marks for publication. Therefore, for the same reasons and incorporating by reference the evidence, authority and rationale asserted by said examining attorney, Applicants' proposed marks LONE STAR and LONE STAR & Design must be refused registration.

b) Similarity of Goods – Identical Clothing Items

35. The Board must assess this factor (i.e., similarity of the goods) by comparing Applicant's goods as recited in his application with Opposer's goods. *See Warnaco, Inc. v. Adventure Knits, Inc.*, 210 USPQ 307, 314-315 (TTAB1981). *See also*; *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 855 (TTAB 1978); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 16 USPQ2d 1783, 1787-1788 (CAFC 1990).

---

[5] *Id.* pg. 2 ¶ 4.

[6] *Id.* pg. 3 ¶ 3.

36. Applicant identifies its goods as "clothing, namely t-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps." Opposer and its predecessors in title have, since at least 1940, used the mark LONE STAR on a variety of goods, including clothing to advertise and promote its LONE STAR beer products in the United States.

37. Because of the passage of time and different owners, it has been difficult to get physical evidence of use back to 1940. However, as the filed declarations and photographs establish, Opposer has used the LONE STAR mark on "clothing, namely t-shirts, sport shirts, polo shirts, and caps" continuously since at least as early 1988 which is before Applicant's claimed date of first use of October 12, 1989.

Product Catalog of 1995 LONE STAR Wearables (*See* Exhibit 1-D attached to Opposer's Fifth Notice of Reliance).

38. As further evidence of the use of LONE STAR for clothing below is a picture of shirt in which the mark is shown in substantially the same format and font as U.S. Reg. No. 674,291 issued February 17, 1959 for "beer."

39. As such, since the goods are identical, except sweat shirts, and the marks are identical, this second *DuPont* factor favors Opposer.

c) <u>Similarity of Goods – Closely Related and From Same Source</u>

40. The Board must assess this factor (i.e., similarity of the goods) by comparing Applicant's goods as recited in his application with Opposer's goods as recited in Opposer's registration of record (i.e., "beer"). *See Warnaco, Inc. v. Adventure Knits, Inc.*, 210 USPQ 307, 314-315 (TTAB1981). *See also*; *Oxford Pendaflex Corp. v. Anixter Bros. Inc.*, 201 USPQ 851, 855 (TTAB 1978); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 16 USPQ2d 1783, 1787-1788 (CAFC 1990).

41. There are no restrictions or limitations in the Applicant's recitation of goods in the application in issue and there are no restrictions or limitation in Opposer's recitation of goods in its registration made of record. As such, for purposes of this proceeding the following legal presumptions apply: (1) Applicant's Opposed Marks for "clothing, namely t-shirts, men's and women's sport shirts, sweat shirts, polo shirts and caps" in International Class 25 encompass the same types of promotional clothing goods which Opposer uses to promote its "beer", (2) the parties' goods move or will move through all of the same channels of trade suitable for the offering and sale of beer and t-shirts; and (3) the parties' products reach or will reach the same potential users and/or customers. *See Warnaco, supra*, at 210 USPQ 314-315; and *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 741 (TTAB 1978).

i. **Live Third Party Registrations Prove Beer and Clothing Items are Closely Related**

42. The parties' goods are closely related. Even without the above legal presumptions, it is common knowledge (i.e., judicially noticeable knowledge[7]) that beer and t-shirts promoting beer products emanate from the same source and sold to consumers in all channels of trade suitable for the offering and sale of such goods (e.g., liquor stores, bars, restaurants, et al). *See* TMEP 1207.01(d)(iii). Beer and clothing, namely t-shirts are both sold at bars, microbreweries and restaurants. Beer manufacturers use clothing to market their trademarks and products. *See* TMEP 1207.01(d)(iii).

43. As further evidence of the relatedness of the goods in issue in this case, Opposer's Third Notice of Reliance is comprised of representative examples (i.e., 20 registrations) of "live"

[7] The Board may take judicial notice of how seemingly unrelated goods are marketed to determine their relatedness. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) ("[I]t was not error for the Board to take notice of the fact that [sellers] 'display bread and rolls in close proximity to the cold cuts and cheeses purveyed there.'").

third party trademark registrations that recite both "beer(s)" and "clothing, namely t-shirts" in the identification of goods. The following list is comprised of registrations from the referenced Third Notice of Reliance:

International Class 32 (Beer)	International Class 25 (Clothing)
Registration No. 3,241,389 for Budweiser mark for beer	Registration No. 3,230,687 for Budweiser mark for clothing, namely t-shirts
Registration No. 3,183,865 for Zima mark for beer	Registration No. 3,183,865 for Zima mark for clothing, namely t-shirts, golf shirts, sweatshirts, etc.
Registration No. 1,707,097 for Dos Equis mark for beer	Registration No. 1,677,719 for Dos Equis mark for clothing for men, women and children, namely t-shirts, sweatshirts, golf shirts, etc.
Registration No. 1,846,907 for Heineken mark for beer	Registration No. 1,342,529 for Heineken mark for jackets, t-shirts, athletic jerseys, sports caps, visors, hats, etc.
Registration No. 1,257,788 for Michelob mark for beer	Registration No. 1,354,391 for Michelob mark for clothing
Registration No. 672,613 Molson mark for beer	Registration No. 2,336,948 for Molson mark for pants, aprons, caps, t-shirts, sweatshirts, jackets, shirts, etc.
Registration No. 1,511,184 for Moosehead mark for beer	Registration No. 1,598,511 for Moosehead mark for clothing, names sweaters, football jerseys, mesh ball caps, winter ball caps, painter hats, aprons, golf shirts, sports shirts, t-shirts, etc.
Registration No. 866,540 for Schlitz mark for beet	Registration No. 1,923,780 for Schlitz mark for clothing, namely shirts, t-shirts, hats, shorts, etc.
Registration No. 1,666,892 for Tecate mark for beer	Registration No. 1,700,633 for Tecate mark for clothing for men, women and children, namely t-shirts, sweatshirts, golf shirts, jackets, etc.
Registration No. 1,707,093 for Carta Blanca mark for beer	Registration No. 1,731,199 for Carta Blanca mark for clothing, for men, women, and children, namely t-shirts, sweatshirts, golf shirts, jackets, etc.

44. The above referenced marks are probative to show that the listed goods (i.e., beer and clothing, namely t-shirts, golf shirts, and caps) are related in that they tend to emanate from a single source. *See* TMEP 1207.01(d)(iii).

45. The established marketing practices used by the parties' identical marks on seemingly unrelated goods and services could result in a likelihood of confusion. *See In Re Phillips-Van Heusen Corp.,* 228 USPQ 949, 951 (TTAB 1986) ("The licensing of commercial trademarks for use on 'collateral' products (such as clothing, glassware, linens, etc.) that are unrelated in nature to those goods or services on which the marks are normally used, has become common practice in recent years."). Because of established marketing practices of beer companies, including Pabst Brewing Company, to use goods (i.e. clothing, namely t-shirts, glassware, steins) to promote their beer products, Applicant's use of identical marks on its goods (clothing, namely t-shirts, shirts and caps) could result in the likelihood of confusion as to the source of the goods. Opposer's Lone Star mark and Applicant's marks convey a similar commercial impression because both contain the words "LONE STAR."

46. Further, beer products and restaurant services are related as evidenced by the fact that: 1) microbreweries exist at which restaurant its beer and restaurant and bar services are offered, 2) beer companies use clothing, namely t-shirts, to promote their beer products, and 3) many beer companies have obtained registrations for beer and simultaneously obtained registrations for the related goods such as clothing used for promotional activities proving that "beer" and "clothing" commonly emanate from a singe source such as Opposer.[8]

47. Goods do not have to be identical or even competitive for there to be a determination that there is a likelihood of confusion. Instead, the question is whether the goods

[8] *See* Opposer's Third Notice of Reliance.

are related, not identical. *See Safety-Kleen Corp. v. Dresser Indus. Inc.,* 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is sufficient that the goods of the Applicant and the Registrant are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. *See On-line Careline Inc. v. America Online Inc.,* 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000) (ON-LINE TODAY for Internet connection services held likely to be confused with ONLINE TODAY for Internet content); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984) (MARTIN'S for wheat bran and honey bread held likely to be confused with MARTIN'S for cheese); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM for a buffered solution equilibrated to yield predetermined dissolved gas values in a blood gas analyzer held likely to be confused with CONFIRMCELLS for diagnostic blood reagents for laboratory use); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984) (LAREDO for land vehicles and structural parts therefore held likely to be confused with LAREDO for pneumatic tires). Here, consumers are likely to assume that Opposer's Lone Star beer goods and Applicant's Lone Star Steakhouse & Saloon's clothing *et al.*, emanated from the same source. *See* TMEP 1207.01(d)(iii).

ii. **Applicant's Prior Registrations Suggest that Beer and Clothing Items are Closely Related**

48. The close relationship between a company's use of its mark on clothing for promoting, advertising and marketing of its goods and services is so well known and common that a person encountering them are likely to assume that they originate at the same source or that there is some association between their sources. Even Applicant has registered the Opposed Marks LONE STAR and LONE STAR & Design for "restaurant and bar services;" i.e. LONE STAR, Reg. No. 2596707 for "restaurant and bar services" and LONE STAR & Design, Reg. No. 2596706 for "restaurant and bar services." (These two registrations and the two opposed applications were all filed on the same day.)[9]

49. This well known relationship is also evidenced by Applicant's other common registrations for restaurant and bar services and clothing[10]:

International Class 42 (Restaurant and Bar services)	**International Class 25 (Clothing)**
LONE STAR STEAKHOUSE & SALOON & Design, Reg. No. 2229771 for "restaurant services;"	LONE STAR STEAKHOUSE & SALOON & Design, Reg. No. 1731247 for "clothing; namely, men's and women's sport shirts, sweat shirts, polo shirts and caps;"
LONE STAR STEAKHOUSE & SALOON, Reg. No 2997691 for "restaurant and bar services	LONE STAR STEAKHOUSE & SALOON, Reg. No 2992302 for "clothing, namely men's and women's shirts and caps
SULLIVAN'S STEAKHOUSE, Reg. No. 2529991 for "general restaurant and bar services;	SULLIVAN'S STEAKHOUSE, Reg. No. 2062637 for "clothing, namely, T-shirts, shirts, coats, sweaters, sweatshirts, pants, shorts, jackets, neckwear, bandanas, scarves and headwear

[9] *See* Exhibit A and Exhibit B attached to Opposer's Sixth Notice of Reliance.

[10] *See* Exhibits C through J attached to Opposer's Sixth Notice of Reliance.

50. The evidence of record in this case supports a finding that Opposer's and Applicant's goods are related. This 2nd *DuPont* factor favors Opposer.

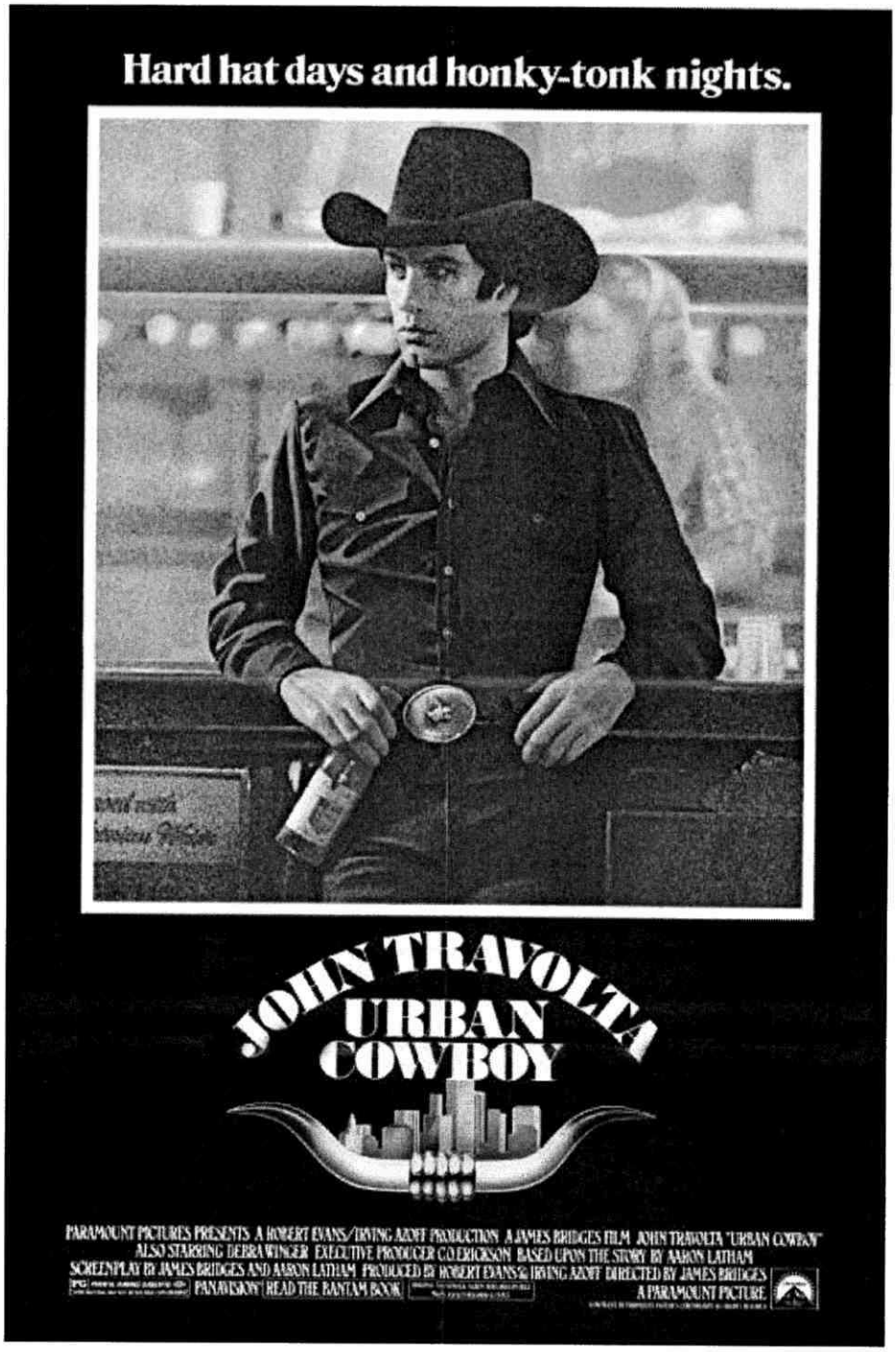
3. **3rd *DuPont* Factor: The Fame of the Prior Mark.**

a) Opposer's LONE STAR Mark is Famous

51. Lone Star beer is iconic. It has been dubbed the "National Beer of Texas."

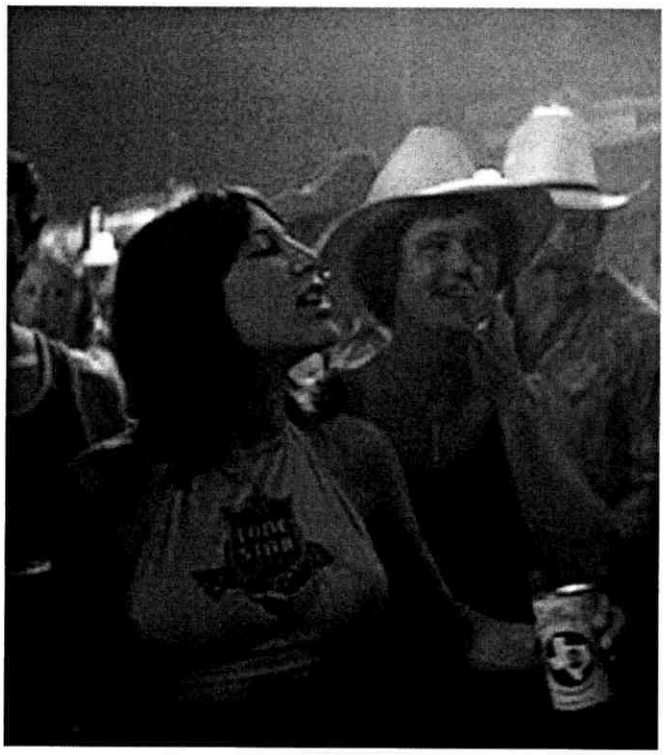
John Travolta drank LONE STAR beer leaning against the bar at Gilley's in the movie Urban Cowboy, released on June 6, 1980. The scene of John Travolta holding a Lone Star beer was even the movie's official poster.[11]

[11] *See* Exhibit D attached to Opposer's Fourth Notice of Reliance.

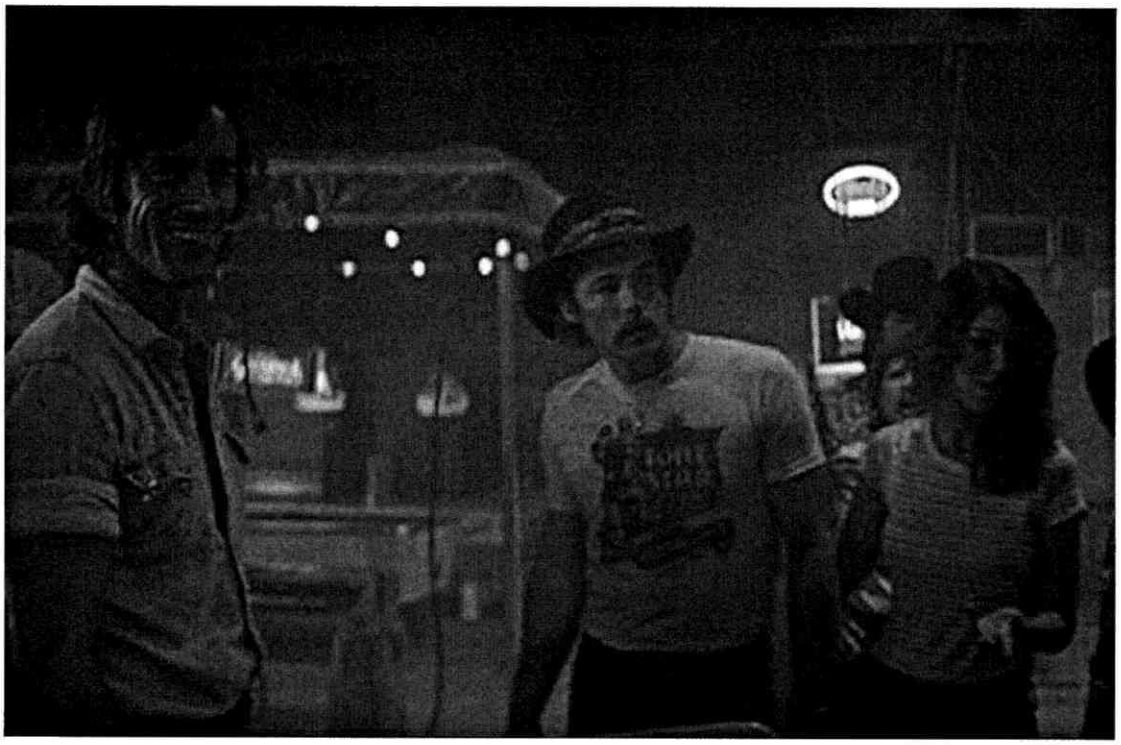


52. Throughout the movie, examples of men's and women's LONE STAR clothing is featured. Below are just a few such uses:

See Exhibit B attached to Opposer's Fourth Notice of Reliance.



See Exhibit B attached to Opposer's Fourth Notice of Reliance.



See Exhibit C attached to Opposer's Fourth Notice of Reliance.

53. In addition to cameo appearances in movies, LONE STAR beer has apparently saved lives, to wit, the following song by Red Steagall:

> "My yellow rose of Texas packed up and left this mornin'
> I don't know where she's gone and most of all I don't know why
> I only know I've got the blues I've never been this lonesome
> It's enough to make a man lay down and die
>
> Lone Star Beer and Bob Wills music
> When I hear Faded Love I feel at home
> Lone Star Beer and Bob Wills music
> Have kept my heart alive since you've been gone
>
> Got a pocket full of quarters to feed to that old jukebox
> Bob Wills music helps to keep that woman off my mind
> Bartender kept that Lone Star comin' long as I got money
> Cause I plan to being here till closing time
>
> Lone Star Beer and Bob Wills music...
> Lone Star Beer and Bob Wills music
> Have kept my heart alive since you've been gone."

This CD, released in 2000, includes the Lone Star beer song from the original 1976 collection entitled "Lone Star Beer and Bob Willis Music.

54. As evidenced by the above iconic nature of Opposer's LONE STAR beer, Opposer has expended considerable sums for promotional activities and by virtue of the excellence of its products, Opposer has gained a valuable reputation under the LONE STAR mark and the LONE STAR mark is famous.

55. The fame of a registered mark is a factor to be considered in determining likelihood of confusion. *See In re E.I. DuPont de Nemours & Co.,* 476 F2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Famous marks enjoy a wide latitude of legal protection because they are more likely to be remembered and associated in the public mind than a weaker mark. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772,* 396 F3d 1369, 1374; 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Bose Corp. v. QSC Audio Products, Inc.,* 293 F3d 1367; 63 USPQ2d 1303 (Fed. Cir. 2005)(Trademark Trial and Appeal Board erred in discounting the fame of Opposer's marks Acoustic Wave and Wave); *Recot, Inc. v. M.C. Becton,* 214 F3d 1322, 1327; 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)(Board erred in limiting the weight accorded to the fame of Opposer's Frito-Lay mark); *Kenner Parker Toys, Inc. v.*

Rose Art Industries, Inc., 963 F2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir., 1992), *cert. denied*, 506 U.S. 862 (1992)(Board erred in discounting the fame of Opposer's mark Play-Doh).

b) Opposer's LONE STAR Mark has Priority

56. Opposer is the owner of U.S. Registration No. 674,291 for the mark LONE STAR for "beer"[12] in International Class 32 which issued February 17, 1959. The application for the referenced registration was filed by Opposer on April 25, 1958.

57. Opposer is the owner of U.S. Registration No. 2,191,783 for the mark LONE STAR for "alcoholic and nonalcoholic malt beverages"[13] in International Class 32 which issued September 29, 1998. The application for the referenced registration was filed by Opposer on October 7, 1996.

58. Opposer is the owner of U.S. Registration No. 3,264,576 for the mark LONE STAR for "beer."[14]

59. Applicant's Application Serial No. 75/883,253 for the mark LONE STAR for "[c]lothing, namely T-shirts, men's and women's sports shirts, sweat shirts, polo shirts and caps in International Class 25." was filed on December 29, 1999. The application (Application Serial No. 75/883,254) is for the mark LONE STAR & Design for "[c]lothing, namely T-shirts, men's and women's sports shirts, sweat shirts, polo shirts and caps in International Class 25." The referenced application was filed on December 29, 1999.

60. Priority is not an issue in this proceeding. First, Opposer may rely upon the filing date of its applications for registration of U.S. Registration No. 674,291 and U.S Registration

[12] *See* Opposer's First Notice of Reliance, Exhibit A.

[13] *See* Opposer's First Notice of Reliance, Exhibit B.

[14] *See* Opposer's First Notice of Reliance, Exhibit C.

2,191,783, which filing dates predate the filing date of the applications at issue. *See*, *Gor-Ray Ltd. v. Garay & Co., Inc.*, 167 USPQ 694, 695 (TTAB 1970).

61. Secondly, Opposer has proven ownership of trademark U.S. Registration Nos. 674,291, NO. 2,191,783 and 3,264,576 for the mark LONE STAR for "beer." *See Oxford Pendaflex Corp. Anixter Bros. Inc.*, 201 USPQ 851, 853 (TTAB 1978) ("priority is not a factor in an opposition proceeding wherein opposer has established ownership of [an] existing registration for the mark on which it relies in support of its claim of damage"); also, *Black & Decker Mfg. Co., v. Bright Star Industries*, 220 USPQ 890 (TTAB 1983). As such, and this being an opposition proceeding, Opposer has priority as a matter of law.

62. Third, Applicant has admitted the following in its Response to Opposer's Request for Admissions[15]:

[15] *See* Exhibit A attached to Opposer's Second Notice of Reliance.

Response to:	Applicant's Admission:
RFA # 1	Prior to February 17, 1959, Applicant made no commercial use of Applicant's LONE STAR Mark in the United States for the goods listed in Serial No. 75883253.
RFA # 2	Prior to February 1977, Applicant made no commercial use of Applicant's LONE STAR Mark in the United States for the goods listed in Serial No. 75883253.
RFA # 3	Prior to October 1989, Applicant made no commercial use of Applicant's LONE STAR Mark in the United States for the goods listed in Serial No. 75883253.
RFA # 4	Prior to February 17, 1959, Applicant made no commercial use of Applicant's LONE STAR & DESIGN Mark in the United States for the goods listed in Serial No. 75883254.
RFA # 5	Prior to February 1977, Applicant made no commercial use of Applicant's LONE STAR & DESIGN Mark in the United States for the goods listed in Serial No. 75883254.
RFA # 6	Prior to October 1989, Applicant made no commercial use of Applicant's LONE STAR & DESIGN Mark in the United States for the goods listed in Serial No. 75883254.
RFA # 10	Applicant was generally aware of Opposer's use of LONE STAR.
RFA # 11	Applicant was generally aware of Opposer's use of LONE STAR in commerce for beer.
RFA # 15	Applicant was generally aware of Opposer's use of LONE STAR in commerce since October 1989 for beer.

4. **4th *DuPont* Factor: The Similarity or Dissimilarity of Established, Likely-To-Continue Trade Channels.**

63. There is really no issue that the trade channels are the same. Applicant has several registrations for "restaurant and bar services" for the identical mark. Applicant will be selling the LONE STAR clothing at its restaurant and bar. Likewise, Opposer's LONE STAR beer is sold at restaurants and bars.

64. As such this *DuPont* factor favors Opposer.

5. **5th DuPont Factor: The Conditions under which and Buyers to whom Sales are Made.**

65. Purchasers of t-shirts, caps, and polo shirts and other promotional clothing items are not discriminating purchasers. Much of the time the purchase is on impulse by purchasers who were not very discriminating or sophisticated purchasers. *See Li & fung (B.V.I.) Limited v.*

Kenosha Ferrell, 2008 WL 4674609 at 4, (Trademark Tr. & App. Bd. 2008) (finding that t-shirts and caps are purchased on impulse and without a great deal of care by the public at large); *George H. Zoes v. Brett Shevack,* 2007 WL 1022714 at 7, (Trademark Tr. & App. Bd. 2007) (finding that t-shirts are sold to "all classes of consumers, including ordinary consumers" and are inexpensive suggesting that t-shirts are bought on impulse).

66. As such this *DuPont* factor favors Opposer.

6. **6th DuPont Factor: The Number and Nature of Similar Marks in Use on Similar Goods**

67. The attachments to Opposer's Third Notice of Reliance are third-party registrations that cover a number of different goods in class 32 and class 25 proving that "beer" and clothing tend to emanate from a single source such as Opposer because beer manufacturer's, as a matter of long standing industry practice, market their products and brands on clothing to such extent that same my be judicially noticed.[16] *See* TMEP 1207.01(d)(iii).

68. This *DuPont* factor favors Opposer.

7. **7th *DuPont* Factor; The Nature and Extent of any Actual Confusion; and 8th *DuPont* Factor. The Length of Time During and Conditions under which There Has Been Concurrent Use Without Evidence Of Actual Confusion.**

69. For purposes of this proceeding, there has been no evidence submitted of actual confusion between Opposer's LONE STAR for clothing and beer and Applicant's use of LONE STAR BEER for clothing. The reason is not there is no likelihood of confusion, but rather that contrary to Applicant's declaration it has not used the Opposed Marks. Instead it has used only a mutilation of the composite mark. Nowhere has it used just the words LONE STAR. All uses by Applicant have been of:

[16] *See* Opposer's Third Notice of Reliance (Exhibit C).

LONE STAR
STEAKHOUSE
&
SALOON

See Exhibit A attached to Opposer's Seventh Notice of Reliance.

70. This specimen is no different than that used by Applicant to support its LONE STAR STEAKHOUSE & SALOON, Reg. No. 2992302.

See Exhibit A attached to Opposer's Ninth Notice of Reliance.

71. The specimens attached to the subject applications show a composite mark that does not evidence the applied for marks. In an application under §1 of the Trademark Act, the mark on the drawing must be a complete mark, as evidenced by the specimen. When the representation on a drawing does not constitute a complete mark, it is sometimes referred to as "mutilation." This term indicates that essential and integral subject matter is missing from the drawing. An incomplete mark may not be registered. *See In re Chemical Dynamics Inc.*, 839 F.2d 1569, 5 USPQ2d 1828 (Fed. Cir. 1988); *In re Miller Sports Inc.*, 51 USPQ2d 1059 (TTAB

1999); *In re Boyd Coffee Co.*, 25 USPQ2d 2052 (TTAB 1993); *In re Semans*, 193 USPQ 727 (TTAB 1976).

72. Application 75/883,253 seeks registration of the mark LONE STAR. The specimen attached in support shows a mark LONE STAR STEAKHOUSE & SALOON and design. The specimen's LONE STAR text is arched – the applied for mark has no such text. The specimen's LONE STAR words are separated by a star design – the applied for mark includes no such design. The specimen's mark contains the words STEAKHOUSE & SALOON – the applied for mark does not. The specimen's mark contains horizontal lines -- the applied for mark does not. The specimen's mark consists of three textual lines – the applied for mark consists of one textual line.

73. Application 75/883,254 seeks registration of the mark LONE STAR and design – the design being a star between the words of the mark. The specimen attached in support shows a mark LONE STAR STEAKHOUSE & SALOON and design. The specimen's mark contains the words STEAKHOUSE & SALOON – the applied for mark does not. The specimen's mark contains horizontal lines -- the applied for mark does not. That is, the specimen's mark contains additional design elements that the applied for mark does not. The specimen's mark consists of three textual lines – the applied for mark consists of one textual line.

74. As such, the specimens attached to the respective applications do not evidence the applied for marks because the specimens create a separate commercial impression from the applied for marks. The specimens indicate that essential and integral subject matter is missing from the applied for marks. As such, the applied for marks are incomplete and may not be registered. *See In re Chemical Dynamics Inc.*, *supra* (registration of design of medicine dropper and droplet properly refused, where the proposed mark is actually used as an integral part of a

unified mark that includes a design of a watering can, and does not create a separate commercial impression); *In re Big Pig, Inc.*, 81 USPQ2d 1436 (TTAB 2006) ("PSYCHO" creates a separate commercial impression apart from additional wording and background design that appears on the specimen, where the word "PSYCHO" is displayed in a different color, type style and size, such that it stands out); *In re Miller Sports Inc.*, *supra* (proposed mark comprising the letter "M" and skater design properly refused, where the "M" portion of applicant's "Miller" logo is so merged in presentation with remainder of logo that it does not create a separate commercial impression); *In re Boyd Coffee Co.*, *supra* (proposed mark comprising cup and saucer design properly refused as mutilation of mark actually used, which includes the cup and saucer design as well as a sunburst design, since the cup and saucer design does not create a separate and distinct commercial impression apart from the sunburst design); *In re Sperouleas*, 227 USPQ 166 (TTAB 1985) (design unregisterable apart from wording that appears on specimen, where the words are not only prominent but are also physically merged with the design, such that the design does not make a separate commercial impression); *In re Library Restaurant, Inc.*, 194 USPQ 446 (TTAB 1977) (the words "THE LIBRARY" are so intimately related in appearance to other elements of the mark actually used that it is not possible to conclude that the pictorial features by themselves create a separate commercial impression); *In re Mango Records*, 189 USPQ 126 (TTAB 1975) (the typed mark "MANGO" is so uniquely juxtaposed with the pictorial elements of the composite that it is not a substantially exact representation of the mark as used on the specimen

75. As such, this *DuPont* factor weighs in Opposer's favor.

8. **9th *DuPont* Factor: The Extent of Potential Confusion Is Substantial.**

76. When one considers:

a. The fact that the parties' marks are nearly identical in look and are identical in sound, meaning and commercial impression;

b. That the goods involved are closely related;

c. That by the channels of trade and ultimate consumers necessarily overlap; and

d. The failure to Applicant to use the Opposed Mark on its goods --

the Board can only conclude, based upon the evidence of record, that there is a likelihood of confusion.

77. Finally, "any doubts about likelihood of confusion ... must be resolved against Applicant, the newcomer." *Centur y 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698, 1701 (CAFC 1992) (and cases cited therein).

III. CONCLUSION

78. For the foregoing reasons, the opposition should be granted and registrations refused to the Applicant.

Dated: March 31, 2009

Respectfully submitted,

/s/ William B. Nash
William B. Nash, Reg. No. 33,743
Jackson Walker, L.L.P.
112 East Pecan St., Suite 2400
San Antonio, Texas 78205
(210) 978-7700
(210) 978-7790 (Fax)
Attorneys For Opposer

CERTIFICATE OF SERVICE

This is to certify that on this 31st day of March, 2009, a true and correct copy of the foregoing Opposer's Trial Brief was served by e-mail to:

Phillip L. Free, Jr., OBA #15765
Marie S. Johnston, OBA # 19847
Crowe & Dunlevy, P.C.
20 North Broadway, Suite 1800
Oklahoma City, OK 73102-8273

Attorney for Lone Star Steakhouse & Saloon

/s/ William B. Nash
William B. Nash, Reg. No. 33,743