

ESTTA Tracking number: **ESTTA66646**

Filing date: **02/15/2006**

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	9900 Santa Monica, Inc.
Granted to Date of previous extension	02/15/2006
Address	9900 Santa Monica Boulevard Beverly Hills, CA 90212 UNITED STATES

Attorney information	Karin Peterka Buchalter Nemer 1000 Wilshire Blvd., Suite 1500 Los Angeles, CA 90017-2457 UNITED STATES kpeterka@buchalter.com, msolmon@buchalter.com Phone:213-891-0700
----------------------	--

Applicant Information

Application No	76596594	Publication date	10/18/2005
Opposition Filing Date	02/15/2006	Opposition Period Ends	02/15/2006
Applicant	Friars National Association, Inc., The 57 East 55 Street New York, NY 10022 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: restaurant services
Class 045. All goods and services in the class are opposed, namely: private social club services

Related Proceedings	91168643
---------------------	----------

Attachments	Notice of Opposition - FRIARS CLUB OF CALIFORNIA.pdf (14 pages)
-------------	---

Signature	/Matthew S. Solmon/
Name	Matthew S. Solmon
Date	02/15/2006

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

In the matter of Trademark Application Serial Number 76/596,594
For the Mark: **FRIARS CLUB OF CALIFORNIA**

9900 Santa Monica, Inc.)	
a California corporation)	Opposition No. _____
)	
Opposer,)	
vs.)	
)	
The Friars National Association, Inc.)	
a New York corporation)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer, 9900 Santa Monica, Inc. (“Opposer”), a corporation duly organized and existing under the laws of the State of California, with a principal place of business at 9900 Santa Monica Boulevard, Beverly Hills, California 90212, believes that it will be damaged by registration of the “FRIARS CLUB OF CALIFORNIA” mark, as shown in the above-identified application in the name of Applicant, The Friars National Association, Inc. (“Applicant”), including as a result of dilution under Lanham Act §43(c), and hereby opposes the same.

As grounds for this notice of opposition, Opposer alleges as follows:

1. Opposer, 9900 Santa Monica, Inc., is a California corporation duly organized and existing under the laws of the State of California, with an address of 9900 Santa Monica Boulevard, Beverly Hills, California 90212. Opposer's predecessor in interest was Friars Club of California, Inc.

2. Applicant, The Friars National Association, Inc., is a New York corporation duly organized and existing under the laws of the State of New York, with an address of 57 East 55th Street, New York, New York 10022.

3. On June 10, 2004, Applicant filed intent to use application serial number 76/596,594 to register the "FRIARS CLUB OF CALIFORNIA" mark for "restaurant services," in International Class 43, and for "private social club services", in International Class 45, on the Principal Register ("Applicant's Mark"). A copy of Applicant's Mark as listed in the United States Patent and Trademark Office database is attached hereto as **Exhibit 1**.

4. Opposer's predecessor in interest, Friars Club of California, Inc., sold all of its assets, including the name and mark "FRIARS CLUB OF CALIFORNIA" to Opposer on or about February 2004. Commencing long prior to Applicant's filing date of June 18, 2003, and being in use continuously to the present, Opposer's predecessor in interest, and now Opposer, engaged in and engage in rendering private social club services, entertainment services, and related services in commerce, under the "FRIARS CLUB OF CALIFORNIA" mark. Since on or about 1947, Applicant has been aware of Opposer's predecessor and its use of the "FRIARS CLUB OF CALIFORNIA, INC." name and mark. In addition, the public has also referred to Opposer's predecessor, and also refers to Opposer, as "FRIARS CLUB" and "FRIARS" .

5. Opposer and Opposer's predecessor have adopted and continuously used the "FRIARS CLUB OF CALIFORNIA, INC." mark in commerce since at least as early as 1947, and the mark and name are recognized by the public as associated with Opposer and Opposer's

predecessor. Opposer has adopted and has continuously used its mark for “THE FRIARS OF BEVERLY HILLS and Design” in commerce since at least as early as March 10, 2004, in connection with private social club services and restaurant services, a date which is three months prior to Applicant’s June 10, 2004 filing date of its “FRIARS CLUB OF CALIFORNIA” application. Opposer has several currently pending applications for federal registration before the United States Patent and Trademark Office for and including the mark “THE FRIARS OF BEVERLY HILLS”. A copy of Opposer’s mark for “THE FRIARS OF BEVERLY HILLS and Design” as listed in the United States Patent and Trademark Office database is attached hereto as **Exhibit 2**. Opposer’s “FRIARS CLUB OF CALIFORNIA, INC.” and “THE FRIARS OF BEVERLY HILLS and Design” marks are collectively referred to herein as “Opposer’s Marks”.

6. Since initial use of Opposer’s Marks, Opposer has used, advertised, promoted, and offered Opposer’s services under Opposer’s Marks to the public through various channels of trade in commerce, with the result that Opposer’s customers and the public in general have come to know, rely upon, and recognize Opposer’s Marks and associate Opposer’s Marks with Opposer as the source of the services rendered by Opposer. Opposer has devoted substantial time, money, and effort in the establishment of the goodwill, consumer recognition, and reputation of its Marks, and such Marks are symbolic of the extensive goodwill, consumer recognition, and reputation built up by Opposer in connection with the rendering of the services in connection with Opposer’s Marks. Thus, Opposer has an exceedingly valuable goodwill established in its Marks.

Likelihood of Confusion

7. Applicant’s Mark is substantially identical in appearance, sound, and connotation to Opposer’s Marks. Applicant’s Mark so resembles Opposer’s Marks as to be likely, when used in connection with the goods and services identified in the application for Applicant’s Marks, to cause confusion, to cause mistake, or to deceive the consuming public, and Applicant’s Mark

should be found to be unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d), as amended.

8. Opposer and Applicant are both engaged in rendering related services in connection with their respective Marks. Purchasers are likely to consider the services of Applicant sold or intended to be sold under Applicant's "FRIARS CLUB OF CALIFORNIA" mark as emanating from Opposer and confuse such services as those of the Opposer, resulting in loss of sales to Opposer. Moreover, purchasers are likely to consider the services of Applicant under the "FRIARS CLUB OF CALIFORNIA" mark as emanating from Opposer. Concurrent use of Opposer's Marks and Applicant's Mark may result in irreparable damage to Opposer's reputation and goodwill, if the services sold or intended to be sold by Applicant are of an inferior quality or objectionable, in comparison to the services used with Opposer's Marks, since purchasers are likely to attribute the source of Applicant's services to Opposer.

9. Applicant's services and Opposer's services are offered to the same classes of customers through the same channels of trade, and Applicant's Mark is likely to be confused with and mistaken for Opposer's Marks, so as to cause confusion and lead to deception as to source, sponsorship, or affiliation by the consuming public.

10. Due to the similarities in Applicant's Mark and Opposer's Marks, the similarities in the services used with the respective Marks, the overlap in the channels of trade used with the respective Marks, and the overlap in customers who use the services used with the respective Marks, Applicant's Mark is likely to be confused with and mistaken for Opposer's Marks, so as to cause confusion and lead to deception as to source, sponsorship, or affiliation by the consuming public.

11. Opposer believes it will be damaged by the registration of Applicant's Mark because such registration would give Applicant at least a *prima facie* exclusive right to use Applicant's confusingly similar Mark in commerce in the United States, in derogation of Opposer's rights in Opposer's Marks. To the extent that Opposer has priority of use of

Opposer's Marks, Applicant will obtain a federal registration to which it is not entitled, and which is inconsistent with Opposer's prior rights.

Dilution

12. As the result of Opposer's prior, continuous, and extensive use of Opposer's Mark for "FRIARS CLUB OF CALIFORNIA, INC.," which use has not been abandoned, such Mark of Opposer has become widely and favorably known to the purchasing as identifying Opposer as a particular source for Opposer's services. As a result of Opposer's long and extensive use, sales, and advertising since at least 1947 of its Mark, Opposer's "FRIARS CLUB OF CALIFORNIA, INC." Mark has become, and is, famous and is recognized among consumers and members of the trade as indicating the reputation of the services offered by Opposer. The "FRIARS CLUB OF CALIFORNIA, INC." Mark, and its respective goodwill, are assets of immense value to Opposer.

13. Opposer's Mark is famous and distinctive, and it is well known to the public and to the trade. Opposer's "FRIARS CLUB OF CALIFORNIA, INC." Mark became famous before Applicant's filing date of its "FRIARS CLUB OF CALIFORNIA" application of June 10, 2004.

14. Applicant has marketed, sold, advertised and promoted its goods and services under Applicant's Mark so as to induce the public into perceiving that Applicant's goods and services are associated with Opposer's services. Applicant's acts described herein have diluted, and are diluting, the distinctive quality of Opposer's Marks, thereby violating Opposer's rights pursuant to the Lanham Act §43(c), 15 U.S.C. § 1125(c).

15. Applicant's use of Applicant's Mark dilutes the distinctive quality of Opposer's famous "FRIARS CLUB OF CALIFORNIA, INC." Mark and lessens the ability of Opposer's "FRIARS CLUB OF CALIFORNIA, INC." Mark to distinguish the services of Opposer. Thus, Applicant should not be allowed a registration for Applicant's Mark.

16. Applicant's use or intended use in commerce of the "FRIARS CLUB OF CALIFORNIA" mark, which is confusingly similar to Opposer's famous Mark, and such use or intended use in the promotion, advertising and sale of Applicant's goods and services, which use began after Opposer's Marks had become famous, has caused the dilution of the distinctive quality of Opposer's Mark and constitutes dilution under Lanham Act §43(c), 15 U.S.C. § 1125(c).

17. Applicant's misappropriation, use, and infringement of Opposer's "FRIARS CLUB OF CALIFORNIA, INC." Mark debase and cheapen Opposer's Mark and create dilution of the distinctive quality thereof and injure Opposer's business, reputation, and the goodwill associated with its services and Mark. Due to the similarities between Applicant's Mark and Opposer's "FRIARS CLUB OF CALIFORNIA, INC." Mark, the similarities in the goods and services used with the respective Marks, the overlap in the channels of trade used with the respective Marks, and the overlap in customers who use the services used with the respective Marks, Applicant's Mark is blurring and tarnishing Opposer's famous, distinctive, and well-established "FRIARS CLUB OF CALIFORNIA, INC." Mark, so as to cause dilution of Opposer's Mark.

Fraud on the USPTO

18. Applicant knowingly and intentionally made a false, material representation to the United States Patent and Trademark Office ("USPTO") that no other person, firm, corporation or association has the right to use the mark "FRIARS CLUB OF CALIFORNIA". Despite Applicant's knowledge of Opposer's prior "FRIARS CLUB OF CALIFORNIA, INC." mark, and Opposer's prior "THE FRIARS OF BEVERLY HILLS and Design" mark, Applicant has continued to prosecute Applicant's Mark before the USPTO.

19. Applicant has committed fraud on the USPTO in violation of 18 U.S.C. §1001.

20. On May 17, 1999, Applicant filed a lawsuit in the Southern District of New York, against Opposer's predecessor, Friars Club of California, Inc., for, *inter alia*, trademark

infringement, entitled *Friars National Association v. Friars Club of California*, numbered 99 Civ. 3615 (JGK). On or about February 18, 2000, Applicant and Opposer's predecessor settled this litigation. One of the express terms of the settlement was that Applicant would "immediately withdraw its pending trademark applications" for "Friars Frolic" (Serial No. 75/776052), "Friars Club Celebrity Roast" (Serial No. 75/775684), and "Friars Club" (Serial No. 75/775988).

21. On or about March 13, 2000, Jamie Brickell, counsel for Applicant, wrote a letter with enclosures of letters and express abandonments of the "Friars Frolic" (Serial No. 75/776052), "Friars Club Celebrity Roast" (Serial No. 75/775684), and "Friars Club" (Serial No. 75/775988) applications purported to be sent to the Assistant Commissioner of Trademarks. Opposer's predecessor was satisfied that the applications would not move forward based on its reasonable reliance on Applicant's counsel's representation that the enclosures were mailed to the Assistant Commissioner of Trademarks.

22. The application for "Friars Club Celebrity Roast" was properly withdrawn as per the settlement. However, the USPTO allowed the applications for "Friars Club" and "Friars Frolic" to issue as registrations. Applicant improperly allowed the USPTO to issue trademark registrations for "Friars Club" and "Friars Frolic", in derogation of the settlement agreement, and when Applicant received trademark registrations for "Friars Club" and "Friars Frolic", Applicant did not notify the USPTO and did not file express abandonments of the registrations. Thus, Applicant acted in bad faith and allowed the USPTO to register the "Friars Club" and "Friars Frolic" marks and represented to the consuming public that these registrations were valid. In or about February 2004, Opposer purchased the assets of Opposer's predecessor relying on the settlement, and as such, is a third party beneficiary, thereunder.

23. Applicant filed a lawsuit in United States District Court Central District of Los Angeles, CV05-4109, on May 31, 2005, against Opposer alleging trademark infringement, dilution and unfair competition involving marks for "Friars Club". Opposer filed a counterclaim

against Applicant on November 14, 2005. This lawsuit is currently pending as of the date of this notice of opposition.

24. Applicant willfully withheld from the USPTO material information or facts, including the May 17, 1999 lawsuit and subsequent settlement, and failure to notify the USPTO that the “Friars Club” and “Friars Frolic” marks should not have issued as registrations, as discussed above, which, if disclosed, would have resulted in the disallowance of the registration sought under Applicant’s Mark by the USPTO. Moreover, Applicant willfully withheld from the USPTO material information of facts involving the May 31, 2005 lawsuit filed by Applicant against Opposer, which, if disclosed, would have resulted in disallowance of the registration sought under Applicant’s Mark by the USPTO.

25. Specifically, despite Applicant’s knowledge of the May 17, 1999 lawsuit and subsequent settlement, and the May 31, 2005 lawsuit, Applicant has continued to prosecute Applicant’s Mark before the USPTO.

WHEREFORE, Opposer believes and avers that it will be damaged by the registration of Applicant's Mark, including damage as a result of dilution under Lanham Act §43(c), and prays for judgment sustaining this opposition and refusing the registration of Applicant's Mark, and that such other and further relief as is deemed just and proper be granted.

Please charge the filing fee of \$600.00 for the opposition of one trademark application in two classes to Deposit Account No. 500977 and direct all correspondence in connection with this opposition to the undersigned.

Respectfully submitted,
BUCHALTER NEMER
A Professional Corporation

Date: February 15, 2006

By: Karin E. Peterka

Karin Peterka
Michael Wachtell
Richard Ormond
Jason Fisher
Matthew Solmon
Buchalter Nemer
1000 Wilshire Boulevard, Suite 1500
Los Angeles, California 90017-5704
Telephone: (213) 891-0700
Facsimile: (213) 896-0400

Attorneys for Opposer
9900 Santa Monica, Inc.

EXHIBIT 1



United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System(Tess)

TESS was last updated on Tue Feb 14 04:17:51 EST 2006

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG BOTTOM HELP

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

TARR Status ASSIGN Status TDR TTAB Status (Use the "Back" button of the Internet Browser to return to TESS)

FRIARS CLUB OF CALIFORNIA

Word Mark	FRIARS CLUB OF CALIFORNIA
Goods and Services	IC 043. US 100 101. G & S: restaurant services
	IC 045. US 100 101. G & S: private social club services
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Design Search Code	
Serial Number	76596594
Filing Date	June 10, 2004
Current Filing Basis	1B
Original Filing Basis	1B
Published for Opposition	October 18, 2005
Owner	(APPLICANT) Friars National Association, Inc., The CORPORATION NEW YORK 57 East 55 Street New York NEW YORK 10022
Attorney of Record	Stephen B. Rodner
Prior Registrations	2387620
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CLUB OF CALIFORNIA" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT SEARCH OG TOP HELP

[.HOME | SITE INDEX | SEARCH | eBUSINESS | HELP | PRIVACY POLICY

EXHIBIT 2



United States Patent and Trademark Office

Home | Site Index | Search | FAQ | Glossary | Guides | Contacts | eBusiness | eBiz alerts | News | Help

Trademarks > Trademark Electronic Search System(Tess)

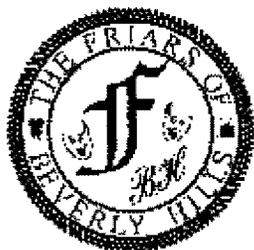
TESS was last updated on Wed Feb 15 04:12:49 EST 2006

- [TESS HOME](#)
- [NEW USER](#)
- [STRUCTURED](#)
- [FREE FORM](#)
- [BROWSE DICT](#)
- [SEARCH OG](#)
- [BOTTOM](#)
- [HELP](#)
- [PREV LIST](#)
- [CURR LIST](#)
- [NEXT LIST](#)
- [FIRST DOC](#)
- [PREV DOC](#)
- [NEXT DOC](#)
- [LAST DOC](#)

Please logout when you are done to release system resources allocated for you.

List At: _____ OR to record: **Record 3 out of 7**

(Use the "Back" button of the Internet Browser to return to TESS)



Word Mark	THE FRIARS OF BEVERLY HILLS F B.H.
Goods and Services	IC 045. US 100 101. G & S: Private social club services. FIRST USE: 20040310. FIRST USE IN COMMERCE: 20040310 IC 043. US 100 101. G & S: Restaurant services. FIRST USE: 20040310. FIRST USE IN COMMERCE: 20040310
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	04.09.01 - Face Masks, costume; Masks, Halloween; Masks, theatrical masks 16.01.03 - CB radios; Projection screens (television); Radios; Remote controls, television; Screens, projection; Screens, television; Television sets 16.03.01 - Cameras; Cameras, motion picture; Cameras, video; Lenses, photographic 26.01.07 - Circles with a decorative border, including scalloped, ruffled and zig-zag edges 26.01.08 - Circles having letters or numerals as a border; Circles having punctuation as a border; Letters, numerals or punctuation forming or bordering the perimeter of a circle 26.01.18 - Circles, three or more concentric; Concentric circles, three or more; Three or more concentric circles
Serial Number	76619051
Filing Date	November 3, 2004
Current Filing Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) 9900 Santa Monica, Inc. CORPORATION CALIFORNIA 9900 Santa Monica Boulevard Beverly Hills CALIFORNIA 90212
Attorney of	

Record Karin E. Peterka
Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE Beverly Hills and BH APART FROM THE MARK AS SHOWN
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#) [PREV LIST](#) [CURR LIST](#) [NEXT LIST](#) [FIRST DOC](#)
[PREV DOC](#) [NEXT DOC](#) [LAST DOC](#)

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)