

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

In the Matter of Trademark Application
Serial No. 76/525,796 for the mark
FRIARS COMEDY CLUB

-----X
9900 Santa Monica, Inc., :
a California corporation, :
 :
Opposer, :
 :
-against- :
 :
The Friars National Association, Inc. :
A New York corporation, :
 :
Applicant. :
-----X

Opposition No. 91169250

ANSWER

Applicant The Friars National Association, Inc. ("Friars" or "Applicant"), by its attorneys, Pryor Cashman Sherman & Flynn LLP, as and for its Answer to the claims asserted in the Notice of Opposition ("Opposition") filed on behalf of Opposer 9900 Santa Monica, Inc. ("9900" or "Opposer"), denies that Opposer will be damaged by the registration of Applicant's mark FRIARS CLUB OF CALIFORNIA (the "FRIARS CLUB OF CALIFORNIA mark") as set forth in Appl. Ser. No. 76596594 ("Serial 765"). With respect to the specific assertions in the Opposition, Applicant respectfully responds as follows:

1. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 1 of the Opposition.
2. Applicant admits the allegations set forth in Paragraph 2 of the Opposition.
3. Applicant admits the allegations set forth in Paragraph 3 of the Opposition.

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4. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in Paragraph 4 of the Opposition, except to admit that Applicant at one time licensed certain rights to an entity called "Friars Club of California, Inc." which, upon information and belief, is no longer in existence.

5. Applicant denies the allegations set forth in Paragraph 5 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action which Applicant has been compelled to commence in California entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Moreover, to the extent that Opposer's purported "predecessor" utilized the name "Friars Club of California," it did so pursuant to a license agreement which has since expired and whose rights were not assignable.

6. Applicant denies the allegations set forth in Paragraph 6 of the Opposition.

7. Applicant denies the allegations set forth in Paragraph 7 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations,

has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action which Applicant has been compelled to commence in California entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, to the extent that there is a similarity between the FRIARS COMEDY CLUB mark, which is the subject of the instant opposition, and the purported mark used by Opposer, that merely constitutes evidence of Opposer's own trademark infringement.

8. Applicant denies the allegations set forth in Paragraph 8 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using the Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action which Applicant was compelled to commence in California entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, to the extent that there is a similarity between the good and services provided by Applicant and Opposer, that merely constitutes evidence of Opposer's own trademark infringement.

9. Applicant denies the allegations set forth in Paragraph 9 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to

have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using the Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action which Applicant was compelled to commence in California entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, to the extent that Applicant and Opposer offer similar goods and services to the same classes of customers through the same channels of trade, that merely constitutes evidence of Opposer's own trademark infringement.

10. Applicant denies the allegations set forth in Paragraph 10 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action Applicant was compelled to commence entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, to the extent that Applicant's mark is likely to be confused with Opposer's mark, so as to lead to deception as to source, sponsorship, or affiliation by the consuming public, that constitutes evidence of Opposer's own trademark infringement.

11. Applicant denies the allegations set forth in Paragraph 11 of the Opposition.

12. Applicant denies the allegations set forth in Paragraph 7 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action Applicant was compelled to commence entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, to the extent that Opposer claims any good will in its name, this merely reflects that Opposer has been improperly trading upon Applicant's name and trademarks.

13. Applicant denies the allegations set forth in Paragraph 13 of the Opposition.

14. Applicant denies the allegations set forth in Paragraph 14 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action Applicant was compelled to commence entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Indeed, it is clearly Opposer that has induced the public into falsely perceiving that it is affiliated with Applicant.

15. Applicant denies the allegations set forth in Paragraph 15 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action Applicant was compelled to commence in California entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, if anything, it is Opposer's conduct which has had the effect of diluting Applicant's trademarks.

16. Applicant denies the allegations set forth in Paragraph 16 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action Applicant was compelled to commence in California "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, if anything, it is Opposer whose conduct violates the Lanham Act.

17. Applicant denies the allegations set forth in Paragraph 17 of the Opposition. In particular, Applicant has been in business since 1904 and has been using the FRIARS CLUB

mark since that time. Starting in or around 1947, Applicant granted a limited license for the FRIARS CLUB mark to "The Friars Club of California, Inc." The Opposer, which claims to have derived rights from the Friars Club of California, Inc., which has since ceased operations, has no contractual relationship with Applicant, is using Friars' name and trademarks without permission, and is one of two defendants in a federal court trademark infringement action Applicant has been compelled to commence in California entitled "Friars National Association, Inc. v. 9900 Santa Monica, Inc. d/b/a The Friars of Beverly Hills and Darren Schaeffer." Thus, if anything, it is Opposer's own wrongful conduct which has damaged Applicant, not vice versa.

18. Applicant denies the allegations set forth in Paragraph 18 of the Opposition.

19. Applicant denies the allegations set forth in Paragraph 19 of the Opposition.

20. Applicant admits the allegations set forth in Paragraph 20 of the Opposition.

21. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 21 of the Opposition, except to admit that Friars' counsel wrote to the Assistant Commissioner of Trademarks on or about March 13, 2000 and to refer to the terms of that letter for the contents thereof.

22. Applicant denies the allegations set forth in Paragraph 22 of the Opposition except to admit that the USPTO allowed the applications for "Friars Club" and "Friars Frolic" to issue as registrations. Applicant further alleges that Opposer has no standing to enforce or invoke the terms of a settlement agreement to which it was not a party and in which it has no rights.

23. Applicant admits the allegations set forth in Paragraph 23 of the Opposition.

24. Applicant denies the allegations set forth in Paragraph 24 of the Opposition.

25. Applicant denies the allegations set forth in Paragraph 25 of the Opposition, except to admit that Applicant has continued to prosecute Applicant's mark before the USPTO.

FIRST AFFIRMATIVE DEFENSE

The Opposition fails to state any claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Applicant has prior rights in and to the FRIARS COMEDY CLUB mark inclusive of variations thereof.

THIRD AFFIRMATIVE DEFENSE

Opposer's claims are barred by the equitable doctrines of waiver, estoppel, acquiescence and/or unclean hands.

FOURTH AFFIRMATIVE DEFENSE

Opposer lacks standing to assert its claims.

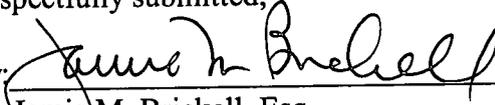
FIFTH AFFIRMATIVE DEFENSE

Opposer is itself a trademark infringer and, as such, has unclean hands and may not properly seek the relief requested.

WHEREFORE, Applicant respectfully requests that Opposition No. 91168643 be dismissed in its entirety.

Dated: March 9, 2006
New York, New York

Respectfully submitted,

By: 
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Attorneys for Applicant,
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I hereby certify that this original ANSWER plus one copy of the same are being deposited with the United States Postal Service "Express Mail" service under 37 C.F.R. § 1.10 on March 9, 2006, and is addressed to the attention of the Trademark Trial And Appeal Board of the U.S. Patent and Trademark Office at the address listed below:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
Attn: Trademark Trial and Appeal Board

Signed:

Name: Bethanie A. Simms



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I hereby certify that a true and correct copy of ANSWER is being served by "Express Mail" by depositing the same as Express Mail with the United States Postal Service and addressed to counsel of record for Opposer, on March 9, 2006 at the address listed below:

Buchalter Nemer
1000 Wilshire Boulevard, Suite 1500
Los Angeles, CA 90017-5704
Attn: Karin Peterka, Esq.

Signed:



Name: Bethanie A. Simms