

ESTTA Tracking number: **ESTTA132576**

Filing date: **03/28/2007**

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	Outback/Flemings's LLC
Granted to Date of previous extension	03/28/2007
Address	2202 N. Westshore Blvd. 5th Floor Tampa, FL 33607 UNITED STATES

Attorney information	Rosanne T. Yang Baker & Hostetler LLP Capitol Square, Suite 2100, 65 East State Street Columbus, OH 43215 UNITED STATES clevelandip@bakerlaw.com, columbusip@bakerlaw.com, bgebhardt@bakerlaw.com Phone:(614) 228-1541
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Applicant Information

Application No	78486405	Publication date	11/28/2006
Opposition Filing Date	03/28/2007	Opposition Period Ends	03/28/2007
Applicant	Fleming Corporation of Kansas 4000 Parkview Drive Pittsburg, KS 66762 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Retail store services featuring convenience store items and gasoline

Attachments	Notice of Opposition - FLEMING x.pdf (7 pages)(405005 bytes) Exhibits.pdf (10 pages)(266395 bytes)
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Signature	/Brandt Gebhardt/
Name	Brandt W. Gebhardt
Date	03/28/2007

VIA ELECTRONIC SYSTEM FOR
TRADEMARK TRIALS AND APPEALS (“ESTTA”)
DATE OF FILING: MARCH 28, 2007

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

In The Matter Of Application Serial No. 78/486,405
Published In The *Official Gazette*, November 28, 2006

OUTBACK/FLEMING’S LLC,)	MARK:	FLEMING
)	CLASS:	035
Opposer,)	SERVICES:	Retail store services featuring
)		convenience store items and
vs.)		gasoline
FLEMING CORPORATION OF)	FILED:	September 20, 2004
KANSAS,)	NOTICE OF OPPOSITION	
Applicant.)		
Opposition No. _____)		
)		
)		
)		

Outback/Fleming’s LLC, a Delaware limited liability company whose principal address is 2202 N. Westshore Blvd. 5th Floor, Tampa, FL 33607, (“Fleming’s) believes that it will be damaged by the registration of the mark covered by Application Serial No. 78/486,405, and hereby opposes the registration of said mark. As grounds for the opposition it is alleged as follows:

THE FAMOUS FLEMING’S MARKS

1. The first Fleming’s Prime Steakhouse & Wine Bar opened in Newport Beach, California in 1998. Today, Fleming’s restaurants have grown to approximately fifty locations throughout the nation. Fleming’s restaurants market their services under various word and design marks, both registered and unregistered, incorporating FLEMING’S, FLEMING’S PRIME STEAKHOUSE & WINE BAR, and an “F” logo (the “FLEMING’S Marks).

2. Fleming's restaurants specialize in prime beef and also serve a variety of chops, seafood, chicken, salads, side dishes, and desserts. In addition to steaks, Fleming's restaurants emphasize their wine selection. Fleming's is committed to having the most patron-friendly wine list of comparable restaurants. Its wine list, known as the Fleming's 100, includes fine wines from around the world, all available by the glass. Beyond fine food and drink, Fleming's restaurants offer a comfortable environment and attentive service.

3. Fleming's restaurants have been continuously using and continuously expanding use of the FLEMING'S Marks for nearly a decade in connection with serving food and beverages. Several publications—including *Nation's Restaurant News*, *Food & Wine*, and *Wine Spectator*—have honored Fleming's with awards, and Fleming's restaurants have received numerous other favorable mentions in the press, some of which may be accessed through the Web page at http://www.flemingssteakhouse.com/press_coverage.htm.

4. Substantial expenditures have gone toward advertising and promoting the FLEMING'S Marks. Such promotion has included Fleming's Web site at <http://www.flemingssteakhouse.com/> since at least as early as 2001.

5. As a result of widespread promotion, advertising, and continuous use, the FLEMING'S Marks have acquired distinctiveness, fame, overwhelming brand recognition, and a valuable reputation. The FLEMING'S Marks have become widely and favorably known to the public throughout the United States and have become recognized by consumers, the food and beverage industry, and the public at large as identifying Fleming's celebrated restaurants. The FLEMING'S Marks are thus famous and strong marks through long-standing, far-reaching use.

THE FLEMING'S REGISTRATIONS

6. In addition to the common law rights detailed above, Fleming's owns U.S. Trademark Registration No. 2,354,237 ("the '237 Registration") for FLEMING'S PRIME

STEAKHOUSE & WINE BAR in Class 042 for use in connection with “restaurant and bar services. The ‘237 Registration, which issued on May 30, 2000, is based on first use of the mark in interstate commerce on October 1, 1998. A copy of the ‘237 Registration Certificate is attached hereto as Exhibit A.

7. Fleming’s owns U.S. Trademark Registration No. 2,379,146 (“the ‘146 Registration) for F FLEMING’S PRIME STEAKHOUSE & WINE BAR and Design in Class 042 for use in connection with “restaurant and bar services. The ‘146 Registration, which issued on August 22, 2000, is based on first use of the mark in interstate commerce October 1, 1998. By virtue of the filing and acceptance of an affidavit of continuous use under Section 15 of the Lanham Act, 15 U.S.C. § 1065, for the ‘146 Registration, Fleming’s exclusive rights to the registered mark in connection with restaurant and bar services have become incontestable. Copies of the ‘146 Registration Certificate and Notice of Acceptance and Acknowledgment are attached hereto as Exhibit B.

8. Fleming’s owns U.S. Trademark Registration No. 3,028,549 (“the ‘549 Registration) for F FLEMING’S and Design in Class 043 for use in connection with “restaurant and bar services. The ‘549 Registration, issued on December 13, 2005, is based on first use of the mark in interstate commerce on October 1, 1998. A copy of the ‘549 Registration Certificate is attached hereto as Exhibit C.

9. Fleming’s owns U.S. Trademark Registration No. 3,125,796 (“the ‘796 Registration) for F FLEMING’S PRIME STEAKHOUSE & WINE BAR and Design in Class 043 for use in connection with “restaurant and bar services. The ‘796 Registration, issued on August 8, 2006, is based on first use of the mark in interstate commerce on October 1, 1998. A copy of the ‘796 Registration Certificate is attached hereto as Exhibit D.

THE INFRINGING FLEMING APPLICATION

10. Applicant Fleming Corporation of Kansas (“Fleming KS”) seeks to register the mark FLEMING (Serial No. 78/486,405) in Class 035 for “retail store services featuring convenience store items and gasoline, as evidenced by the publication of said mark in the *Official Gazette* on November 28, 2006. Fleming KS’s application was filed on September 20, 2004.

11. Fleming KS filed its application to register the mark FLEMING on the basis of Section 1(b) of the Lanham Act, which provides for registration of marks where the applicant “has a bona fide intention . . . to use a trademark in commerce. 15 U.S.C. § 1051(b).

12. Upon information and belief, the services in connection with which Fleming KS has alleged an intention to use the mark FLEMING include the sale of food and beverages and are thus related to the restaurant and bar services marketed under the FLEMING’S Marks.

13. Upon information and belief, Fleming KS has alleged an intention to use the mark FLEMING in a manner that will expose consumers who are familiar with FLEMING’S Marks to Fleming KS’s infringing mark.

14. Upon information and belief, Fleming KS alleged its intention to use the FLEMING mark for the sale of food and beverages with full knowledge of the fame and distinctiveness of the FLEMING’S Marks, and with the intention of trading on the long-established goodwill built up in the FLEMING’S Marks.

15. There is no issue of priority. The FLEMING’S Marks were first used in commerce at least as early as October 1, 1998, and were first registered on May 30, 2000. Upon information and belief, Fleming KS has yet to use the FLEMING mark in commerce.

COUNT I

16. The mark sought to be registered by Fleming KS is likely to cause confusion in the minds of the public, erroneously leading the consuming public to believe that Fleming KS's services involving the sale of food and beverages have the same origin as Fleming's services involving the sale of food and beverages, or that Fleming KS's services are affiliated, connected, or associated with, or are sold, sponsored, or approved by Fleming's.

17. Fleming KS's use and registration of the FLEMING mark will cause damage to Fleming's within the meaning of Section 13 of the Lanham Act, 15 U.S.C. § 1063.

COUNT II

18. Fleming KS's proposed FLEMING mark is likely to cause dilution by blurring and/or tarnishment with respect to Fleming's distinctive and famous FLEMING'S Marks and to the goodwill and reputation associated therewith.

19. Fleming KS's use and registration of the FLEMING mark will cause damage to Fleming's within the meaning of Section 13 of the Lanham Act, 15 U.S.C. § 1063.

WHEREFORE, Fleming's prays that its opposition be sustained and that registration of Application Serial No. 78/486,405 be denied.

Date: March 28, 2007

BAKER & HOSTETLER LLP

/Brandt Gebhardt/

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*Attorneys for Opposer
Outback/Fleming's LLC*

EXHIBIT

A

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,354,237

United States Patent and Trademark Office Registered May 30, 2000

**SERVICE MARK
SUPPLEMENTAL REGISTER**

FLEMING'S PRIME STEAKHOUSE & WINE BAR

OUTBACK/FLEMING'S LLC (DELAWARE LIMITED LIABILITY COMPANY)
455 NEWPORT CENTER DRIVE
NEWPORT BEACH, CA 92660 BY ASSIGNMENT
STEAKHOUSE CONCEPTS, LLC (ARIZONA LIMITED LIABILITY COMPANY) PHOENIX, AZ 85018

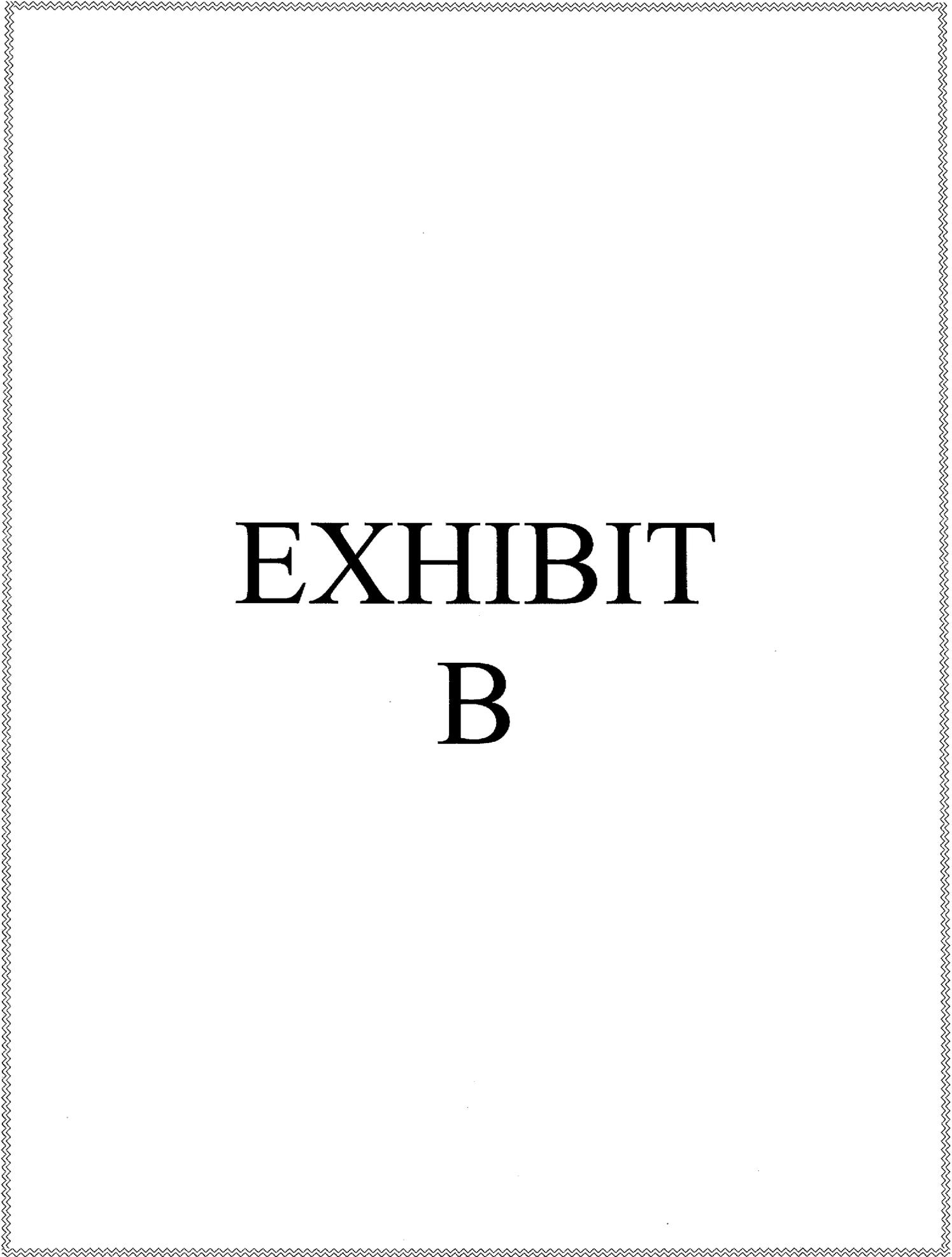
FOR: RESTAURANT AND BAR SERVICES , IN CLASS 42 (U.S. CLS. 100 AND 101).
FIRST USE 10-1-1998; IN COMMERCE 10-1-1998.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PRIME STEAKHOUSE & WINE BAR", APART FROM THE MARK AS SHOWN.

THE MARK IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT IS OF RECORD.

SER. NO. 75-713,550, FILED P.R. 5-25-1999; AM. S.R. 1-13-2000.

REBECCA SMITH, EXAMINING ATTORNEY



EXHIBIT

B

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,379,146

United States Patent and Trademark Office

Registered Aug. 22, 2000

**SERVICE MARK
PRINCIPAL REGISTER**



Fleming's

PRIME STEAKHOUSE & WINE BAR

OUTBACK/FLEMING'S LLC (DELAWARE LIMITED LIABILITY COMPANY)
455 NEWPORT CENTER DRIVE
NEWPORT BEACH, CA 92660 , BY ASSIGNMENT
STEAKHOUSE CONCEPTS, LLC (ARIZONA LIMITED LIABILITY COMPANY) PHOENIX, AZ 85018

FOR: RESTAURANT AND BAR SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).
FIRST USE 10-1-1998; IN COMMERCE 10-1-1998.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PRIME STEAKHOUSE & WINE BAR", APART FROM THE MARK AS SHOWN.

THE MARK IDENTIFIES A LIVING INDIVIDUAL WHOSE CONSENT IS OF RECORD.

SER. NO. 75-713,552, FILED 5-25-1999.

REBECCA SMITH, EXAMINING ATTORNEY



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

REGISTRATION NO: 2379146 SERIAL NO: 75/713552 MAILING DATE: 01/03/2006
REGISTRATION DATE: 08/22/2000
MARK: F FLEMING'S PRIME STEAKHOUSE & WINE BAR
REGISTRATION OWNER: OUTBACK/FLEMING'S LLC

CORRESPONDENCE ADDRESS:

Kelly Lefferts
Outback Steakhouse, Inc.
2202 N. Westshore Blvd. 5th Floor
Tampa FL 33607

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(1)

THE COMBINED AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF ACKNOWLEDGEMENT

15 U.S.C. Sec. 1065

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 15 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1065.

ACCORDINGLY, THE SECTION 15 AFFIDAVIT IS ACKNOWLEDGED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):

042.

ROBERTS, SHARON YVONNE
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION
ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

EXHIBIT

C

Int. Cl.: 43

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,028,549

Registered Dec. 13, 2005

**SERVICE MARK
PRINCIPAL REGISTER**



OUTBACK/FLEMING'S, LLC (DELAWARE LTD
LIAB CO)
2202 N. WESTSHORE BLVD 5TH FLOOR
TAMPA, FL 33607

OWNER OF U.S. REG. NOS. 2,329,744, 2,354,237,
AND 2,379,146.

FOR: RESTAURANT AND BAR SERVICES, IN
CLASS 43 (U.S. CLS. 100 AND 101).

SER. NO. 78-505,012, FILED 10-25-2004.

FIRST USE 10-1-1998; IN COMMERCE 10-1-1998.

ROBERT LORENZO, EXAMINING ATTORNEY

EXHIBIT

D

Int. Cl.: 43

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,125,796

Registered Aug. 8, 2006

SERVICE MARK
PRINCIPAL REGISTER



OUTBACK/FLEMING'S, LLC (DELAWARE LTD
LIAB CO)

2202 N. WESTSHORE BLVD 5TH FLOOR

TAMPA, FL 33607

FOR: RESTAURANT AND BAR SERVICES, IN
CLASS 43 (U.S. CLS. 100 AND 101).

FIRST USE 10-1-1998; IN COMMERCE 10-1-1998.

OWNER OF U.S. REG. NOS. 2,329,744, 2,354,237,
AND 2,379,146.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "PRIME STEAKHOUSE AND WINE
BAR", APART FROM THE MARK AS SHOWN.

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-
TURE(S) SHOWN IN THE MARK IDENTIFIES
PAUL M. FLEMING, WHOSE CONSENT(S) TO
REGISTER IS SUBMITTED.

SER. NO. 78-505,038, FILED 10-25-2004.

ROBERT LAVACHE, EXAMINING ATTORNEY