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

Proceeding	91184741
Party	Plaintiff Buffalo Brothers Inc. d/b/a Buffalo Brothers Pizza and Wings
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Date	03/19/2009
Attachments	Response to MSJ.pdf ( 14 pages )(434450 bytes )

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

**BUFFALO BROTHERS, INC. d/b/a** )  
**BUFFALO BROTHERS PIZZA AND** )  
**WINGS CO.,** )  
 )  
**Opposer,** )  
 )  
**v.** )  
 )  
**E&J BUFFALO BROTHERS, L.L.C.,** )  
 )  
**Applicant.** )

**Opposition No.: 91184741**  
**RESPONSE TO APPLICANT’S MOTION  
FOR SUMMARY JUDGMENT**

Opposer Buffalo Brothers, Inc. d/b/a buffalo Brothers Pizza and Wings Co., pursuant to Fed. R. Civ. P. 56 and TBMP § 528, files this Response to Applicant’s Motion for Summary Judgment.

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## ARGUMENT<sup>1</sup>

To prevail in a trademark opposition proceeding, the Opposer must show (i) superior rights in a mark, (ii) for which there is a likelihood of confusion with Applicant's pending mark. Superior rights may be demonstrated under § 2(d) of the Lanham Act<sup>2</sup> by prior use in the United States of a mark that has not been abandoned. *Venture Out Properties LLC v. Wynn Resorts Holdings, LLC*, 81 U.S.P.Q.2d 1887 (2007). It is undisputed that Opposer used the mark BUFFALO BROTHERS in association with pizza and wings restaurants, prior to Applicant's earliest use of the mark BUFFALO BROS. (Exhibit A). Likelihood of confusion between the marks is self-evidently manifest. Accordingly, the opposition should be maintained.

### Prior Use

Opposer's prior use of its mark is uncontested. Applicant's Motion for Summary Judgment makes much of the fact that such use has, to date, been confined to North Carolina, and places its reliance on *Weiner King, Inc. v. Weiner King Corp.*, 615 F.3d 512 (C.C.P.A. 1980). *Weiner King* was a concurrent use proceeding. Concurrent use is not before the Board. Applicant's registration application does not include any geographic limitation or statement of concurrent use. The dispute before the Board is an opposition proceeding. To prevail in an opposition, Opposer need only show prior use of a mark and likelihood of confusion. *C & N Corporation d/b/a Door Peninsula Winery v. Illinois River Winery, Inc.*, 2008 WL 4803896 (T.T.A.B. 2008).

*Arguendo*, even in a concurrent use proceeding, *Weiner King* is not conclusive precedent, as this Board explicitly stated in *Pinocchio's Pizza, Inc. v. Sandra Inc.*, 11 U.S.P.Q.2d 1227 (T.T.A.B. 1989):

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<sup>1</sup> Opposer's Response to Applicant's Motion for Summary Judgment is supported by Exhibits attached hereto, and incorporated herein by reference.

<sup>2</sup> 15 U.S.C. § 1052(d) (2007).

The Court in *Weiner King*, however, *rejected* a mechanical approach that always favors the first to register, stating that the policy favoring the first to register is sound when applied to the proper case, as determined by the particular facts and circumstances. . . . The Court noted that *actual use in a territory is not necessary to establish rights in that territory* and that the inquiry should focus on a number of factors, including the party's previous business activity, *previous expansion* (or lack thereof) and *presently planned expansion*.

*Id.*, at 1228-29 (emphasis added).

It is Opposer, not Applicant, who has a history of previous expansion, from a small restaurant with limited seating in the town of Cary NC, to a restaurant over three times as large in the major city of Raleigh, NC. (Exhibit A). It is Opposer, not Applicant, who has taken concrete steps toward a presently planned expansion, by securing significant funding, *Id.*, as opposed to Applicant's naked "dream" of nationwide expansion (Applicant's statement of fact #7). *Weiner King* itself thus supports Opposer's superior rights over Applicant's – *if* concurrent use were an issue.

#### Likelihood of Confusion

The marks BUFFALO BROTHERS and BUFFALO BROS are self-evidently confusingly similar. Applicant attempts to distinguish the term BROS from BROTHERS by sight, sound, and number of syllables. However, the term "bros." has precisely one meaning in the English language: it is an abbreviation for "brothers." The American Heritage® Dictionary of the English Language (4<sup>th</sup> ed. 2004). <http://www.answers.com/topic/bros>, accessed March 17, 2009. (Exhibit B). Applicant admits as much in its statement of fact #4.

The rest of Applicant's likelihood of confusion analysis rests on the current geographic separation between the parties' restaurants. This is improper analysis, as a matter of law. The Board must look *solely* to the identification of goods and services set forth in Applicant's

registration application to decide issues such as channels of trade or class of purchasers. The parties' actual operations – including current geographic separation – are irrelevant.

The issue in an opposition is the right of an applicant to register the mark depicted in the application for the goods identified therein. The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

*Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 942 (Fed. Cir. 1990) (citations to ten cases omitted). *See also, Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 1337 (C.C.P.A. 1981) (“Here, appellant seeks to register . . . its mark without any restrictions reflecting the facts in its actual use which it argues on this appeal prevent likelihood of confusion. We cannot take such facts into consideration *unless set forth in its application.*”) (emphasis added), *Venture Out Properties LLC v. Wynn Resorts Holdings, LLC*, 81 U.S.P.Q.2d 1887, 1893 (T.T.A.B. 2007) (“It is well settled that the determination of whether there is a likelihood of confusion must be based on the goods and services *as they are identified in applicant's opposed applications.*”) (emphasis added), *J & J Snack Foods Corp. v. McDonald's Corp.*, 18 U.S.P.Q.2d 1889, 1882 (Fed. Cir. 1991) (“The likelihood of confusion, mistake, or deception is determined by assessing the appropriate evidentiary factors, including the similarity or dissimilarity of the marks; the similarity or dissimilarity of the goods *as described in the application*, compared with the goods with which the prior mark is associated . . . ) (emphasis added).

Where likelihood of confusion is asserted by an opposer with respect to a trademark for which an application for registration has been filed, the issue must be resolved on the basis of not only a comparison of the involved marks, but also on consideration of the goods named in the application and in opposer's registration and, in the absence of specific limitations in the application and registration, on consideration of the *normal and usual channels of trade* and methods of distribution. The description of the goods

in an application for registration is critical because any registration that issues will carry that description. Moreover, although a registrant's current business practices may be quite narrow, *they may change at any time* from, for example, industrial sales to individual consumer sales.

*Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat. Ass'n*, 811 F.2d 1490, 1492 (Fed. Cir. 1987) (emphasis added). Obviously, either or both of Opposer and Applicant may change their “current business practices” from wide geographic separation to closer operation. The *Pinocchio* court recognized this fact, and properly framed the question of likelihood of confusion:

It is clear that the marks are virtually identical, the only difference being the insignificant inclusion of an apostrophe in registrant's “PINOCCHIO'S” mark. Moreover, the services are identical and we conclude that confusion in the marketplace, *if the marks are used in the same geographical area*, is not only likely but certain.

*Pinocchio's Pizza, Inc. v. Sandra Inc.*, 11 U.S.P.Q.2d 1227, 12128 (T.T.A.B. 1989) (emphasis added).

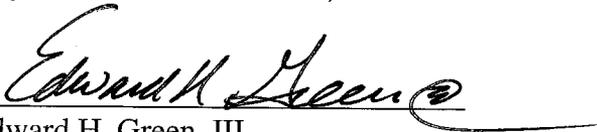
Conducting the likelihood of confusion analysis using the geographic extent, channels of trade, and classes of users identified in Applicant’s registration application (no restrictions) is both legally proper and fundamentally fair. Applicant seeks nation-wide rights in its mark, including the right to use the mark in and near North Carolina – in Opposer’s “back yard.” Applicant should not be allowed to evade the manifest likelihood of confusion with Opposer’s prior mark by focusing on the parties’ *current* geographic separation. Because the opposed registration application includes no geographic limitations, the proper questions is as the *Pinocchio* court framed it: “Are the marks BUFFALO BROTHERS and BUFFALO BROS confusingly similar, *if the marks were used in the same geographical area*? The answer, as in *Pinocchio*, is that “confusion in the marketplace . . . is not only likely but certain.” *Id.*

**CONCLUSION**

Applicant's prior use of mark BUFFALO BROTHERS is uncontested. Considering, as it must, the description of goods, channels of trade, customers, and the like, as recited in Applicant's registration application – that is, with no consideration of current geographic separation – likelihood of confusion between the marks is self-evidently manifest. Accordingly, the opposition should be sustained.

Respectfully submitted, this the 19<sup>th</sup> day of March, 2009.

**COATS & BENNETT, PLLC**  
**Attorneys for Buffalo Brothers, Inc.**

By:   
Edward H. Green, III  
N.C. State Bar No.: 26,843  
1400 Crescent Green, Suite 300  
Cary, North Carolina 27518  
Telephone: (919) 854-1844  
Facsimile: (919) 854-2084

**CERTIFICATE OF SERVICE**

I hereby certify that on this the 19<sup>th</sup> day of March, 2009 a true copy of the foregoing **RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT** was served upon opposing counsel via United States mail, postage prepaid, and addressed as follows:

David R. Childress  
Whitaker, Chalk, Swindle & Sawyer, L.L.P.  
301 Commerce St., Suite 3500  
Fort Worth, TX 76102-4186

A handwritten signature in black ink, reading "Edward H. Green, III". The signature is written in a cursive style with a long, sweeping underline that extends to the right.

Edward H. Green, III  
Attorney for Buffalo Brothers, Inc.

# EXHIBIT A

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

**BUFFALO BROTHERS, INC. d/b/a** )  
**BUFFALO BROTHERS PIZZA AND** )  
**WINGS CO.,** )

**Opposer,** )

**v.** )

**E&J BUFFALO BROTHERS, L.L.C.,** )

**Applicant.** )

**Opposition No.: 91184741**

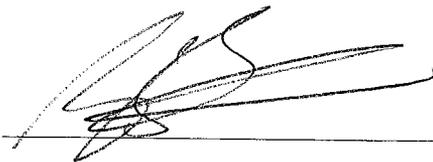
**AFFIDAVIT OF Matthew Boyd**

Affiant states:

1. I am a resident of Raleigh, NC, am above the age of eighteen years, and am not subject to any legal disabilities. I make the following statements on my personal knowledge.
2. My partner Matthew R. Gray and I have been in the restaurant business since opening a pizzeria in Batavia, NY in 1997.
3. On Feb. 6, 2003 we opened the Buffalo Brothers Pizza & Wing Company restaurant in Cary, NC.
4. The Cary restaurant, located in a strip mall, was approximately 1,600 square feet, and offered both dine-in and take-out/delivery service.
5. Average annual sales in the Cary restaurant were approximately \$375,000.
6. The Cary restaurant was identified by prominent use of the mark **BUFFALO BROTHERS** on signage, menus, pizza boxes, and the like.
7. Due to a tenant association restriction on size and number of letters in window signs, the abbreviated mark **BUFFALO BROS.** was used in a window display.

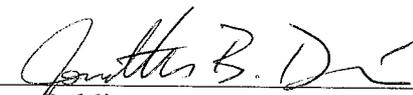
8. During five years of continuous operation, to my knowledge not a single customer ever made inquiry or expressed any confusion about the concurrent use of the marks BUFFALO BROTHERS and BUFFALO BROS. to identify the same restaurant.
9. The Cary restaurant was sold on June 17, 2007, and the name changed.
10. On July 3, 2004, we opened the Buffalo Brothers Pizza & Wing Company restaurant on Capital Blvd. in Raleigh, NC.
11. The Raleigh restaurant is a free-standing building of approximately 5,600 square feet, offering dine-in service only (no delivery).
12. The Raleigh restaurant has a seating capacity of 200, with a full bar.
13. Average annual sales in the Raleigh restaurant are approximately \$2,000,000.
14. The Raleigh restaurant is identified by prominent use of the mark BUFFALO BROTHERS on signage, menus, and the like.
15. On June 6, 2007, we bought Alex's Place Steak & Seafood restaurant in Batavia, NY.
16. The Batavia restaurant is approximately 5,500 square feet, offering dine-in service.
17. The Batavia restaurant has a seating capacity of 130, with a full bar.
18. Average annual sales in the Batavia restaurant are approximately \$2,500,000.
19. We have plans to open another Buffalo Brothers restaurant in North Carolina in late 2009. In pursuit of these plans, we have secured a \$90,000 line of credit at Bank of America, and a \$500,000 line of credit at Balboa Capital.
20. We have plans to eventually open a Buffalo Brothers restaurant in New York.

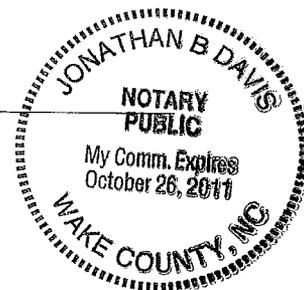
Affiant sayeth nothing further.

  
\_\_\_\_\_

WAKE COUNTY, NORTH CAROLINA

Sworn to and subscribed before me on this  
the 12<sup>th</sup> day of MARCH, 2009 by  
MATTHEW JOHN BOYD.

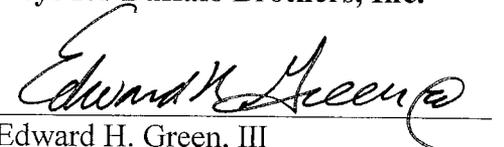
  
\_\_\_\_\_  
Notary Public



My commission expires: OCT 26<sup>th</sup> 2011

Respectfully submitted, this the 19 day of MARCH, 2009

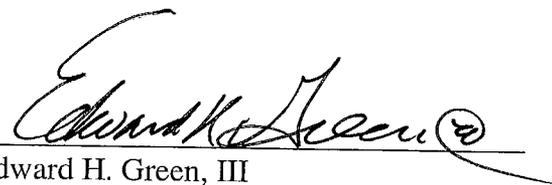
**COATS & BENNETT, PLLC**  
**Attorneys for Buffalo Brothers, Inc.**

By:   
\_\_\_\_\_  
Edward H. Green, III  
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Cary, North Carolina 27518  
Telephone: (919) 854-1844  
Facsimile: (919) 854-2084

## CERTIFICATE OF SERVICE

I hereby certify that on this the 19<sup>th</sup> day of March, 2009 a true copy of the foregoing **AFFIDAVIT OF Matthew Boyd** was served upon opposing counsel via United States mail, postage prepaid, and addressed as follows:

David R. Childress  
Whitaker, Chalk, Swindle & Sawyer, L.L.P.  
301 Commerce St., Suite 3500  
Fort Worth, TX 76102-4186

A handwritten signature in black ink, appearing to read "Edward H. Green, III", is written over a horizontal line. The signature is stylized and includes a circled mark at the end.

Edward H. Green, III  
Attorney for Buffalo Brothers, Inc.



# bros.

**Did you mean:** Bros (Rock Band, '80s, '90s), Brs, bro, bros. (abbreviation), Michal Broš, Brown & Brown Inc, sibling, Bro's, brother, Bro. (abbreviation)

Dictionary: bros.

abbr.

brothers

Translations: **Translations for:** Bros.

[Top](#)

Dansk (Danish)  
abbr. - brødre

Français (French)  
abbr. - (abrév = Brothers) (Comm) Frères

Deutsch (German)  
abbr. - Gebrüder

Ελληνική (Greek)  
n. pl., -  
abbr. - Αδελφοί

Português (Portuguese)  
n. pl., -  
abbr. - irmãos (m pl)

Русский (Russian)  
братья (в имени семейной фирме)

Español (Spanish)  
abbr. - hermanos

Svenska (Swedish)  
n. pl. - Bröderna  
abbr. - Bröderna

中文 (简体) (Chinese (Simplified))  
兄弟, 兄弟共同经营的公司行号

中文 (繁體) (Chinese (Traditional))  
n. pl. - 兄弟  
abbr. - 兄弟共同經營的公司行號

한국어 (Korean)  
n. pl. - 형제, 스미스 형제 상회(Smith Bros & Co)  
abbr. - brothers(형제)

日本語 (Japanese)  
abbr. - 兄弟商会

עברית (Hebrew)  
n. pl. - קיצור: אחים  
abbr. - קיצור של 'אחים', ביחוד בשם של חברה מסחרית

If you are unable to view some languages clearly, click [here](#).

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Shopping: bros.

[Mario Bros](#) [baum bros](#)  
[Warner Bros.](#) [mario bros](#)

[Top](#)