

ESTTA Tracking number: **ESTTA234738**

Filing date: **09/04/2008**

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	Sizzler USA Franchise, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	6101 W. Centinela Ave., Suite 300 Culver City, CA 90230 UNITED STATES		

Attorney information	Jessica C. Bromall Jeffer, Mangels, Butler & Marmaro LLP 1900 Ave. of the Stars 7th Floor Los Angeles, CA 90067-4308 UNITED STATES trademarkdocket@jmbm.com		
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Applicant Information

Application No	77427433	Publication date	08/05/2008
Opposition Filing Date	09/04/2008	Opposition Period Ends	09/04/2008
Applicant	Icon Burger Development Company, LLC Tower 1, Suite 1000 1515 Arapahoe Street Denver, CO 80202 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Carry-out restaurants; Restaurant, bar and catering services; Self-service restaurants

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	882633	Application Date	04/22/1969
Registration Date	12/16/1969	Foreign Priority Date	NONE
Word Mark	SIZZLER		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class U100 (International Class 042). First use: First Use: 1957/01/26 First Use In Commerce: 1963/09/02 RESTAURANT SERVICES

U.S. Registration No.	888458	Application Date	04/22/1969
Registration Date	03/24/1970	Foreign Priority Date	NONE
Word Mark	SIZZLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U101 (International Class 035). First use: First Use: 1961/07/05 First Use In Commerce: 1963/09/02 RENDERING TECHNICAL ASSISTANCE IN THE ESTABLISHMENT AND OPERATION OF RESTAURANTS FOR OTHERS		

U.S. Registration No.	976493	Application Date	09/21/1972
Registration Date	01/08/1974	Foreign Priority Date	NONE
Word Mark	SIZZLER FAMILY STEAK HOUSE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1968/10/00 First Use In Commerce: 1968/10/00 RESTAURANT SERVICES		

U.S. Registration No.	1384530	Application Date	07/26/1982
Registration Date	02/25/1986	Foreign Priority Date	NONE
Word Mark	SIZZLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1957/01/26 First Use In Commerce: 1963/09/02 PREPARED MENU ITEM, NAMELY TOAST FOR CONSUMPTION ON AND OFF THE PREMISES		

U.S. Registration No.	1462078	Application Date	09/02/1980
Registration Date	10/20/1987	Foreign Priority Date	NONE
Word Mark	SIZZLER		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 029. First use: First Use: 1957/01/26 First Use In Commerce: 1963/09/02 PREPARED MENU ITEMS NAMELY, STEAKS, AND DINNERS CONSISTING OF STEAK, POTATOES AND TOAST FOR CONSUMPTION ON AND OFF THE PREMISES		
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U.S. Registration No.	1795103	Application Date	02/08/1993
Registration Date	09/28/1993	Foreign Priority Date	NONE
Word Mark	SIZZLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1981/12/31 First Use In Commerce: 1981/12/31 clothing; namely, golf shirts, aprons, T-shirts, caps, jackets [and ties]		

U.S. Registration No.	2294706	Application Date	12/18/1997
Registration Date	11/23/1999	Foreign Priority Date	NONE
Word Mark	SIZZLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/05/11 First Use In Commerce: 1997/05/11 RESTAURANT SERVICES		

U.S. Registration No.	2862488	Application Date	07/03/2002
Registration Date	07/13/2004	Foreign Priority Date	NONE
Word Mark	SIZZLER UNITED STEAK LOVERS OF AMERICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/01/07 First Use In Commerce: 2003/01/07 CLOTHING, NAMELY T-SHIRTS AND SHIRTS; HEADWAEAR		

U.S. Registration No.	3056206	Application Date	07/18/2003
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	SIZZLER SS		
Design Mark			
Description of Mark	The mark consists of SIZZLER SS.		
Goods/Services	Class 016. First use: First Use: 2005/11/03 First Use In Commerce: 2005/11/03 STATIONERY; WRITING PAPER; COUPONS; NEWSLETTERS IN THE FIELD OF FOOD AND RESTAURANTS Class 029. First use: First Use: 2005/11/03 First Use In Commerce: 2005/11/03		

	<p>PREPARED ENTREES CONSISTING PRIMARILY OF MEAT, POULTRY AND/OR VEGETABLES; VEGETABLE AND FRUIT SALADS; AND EXCLUDING SAUSAGES</p> <p>Class 030. First use: First Use: 2005/11/03 First Use In Commerce: 2005/11/03</p> <p>PREPARED ENTREES CONSISTING PRIMARILY OF PASTA AND/OR RICE; SPICES; SAUCES; BAKERY GOODS; BREADS</p>
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Attachments	<p>72325145#TMSN.gif (1 page)(bytes)</p> <p>74356566#TMSN.gif (1 page)(bytes)</p> <p>75407367#TMSN.gif (1 page)(bytes)</p> <p>78141337#TMSN.gif (1 page)(bytes)</p> <p>78276261#TMSN.jpeg (1 page)(bytes)</p> <p>Notice of Opposition - Icon.pdf (8 pages)(62537 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/jessica c. bromall/
Name	Jessica C. Bromall
Date	09/04/2008

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

SIZZLER USA FRANCHISE, INC., Opposer, v. ICON BURGER DEVELOPMENT COMPANY, Applicant.	Opposition No.: _____ Application Serial No.: 77/427,433 Mark: SMASH SMASH.SIZZLE.SAVOR. & Design Published for Opposition: August 5, 2008 Atty. Ref. No.: 59243-9074
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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Opposer Sizzler USA Franchise, Inc., a Delaware corporation, ("Opposer"), having the address of 6101 W. Centinela Ave., Suite 300, Culver City, California 90230, believes that it will be damaged by the registration on the Principal Register of SMASH SMASH.SIZZLE.SAVOR. & Design, in connection with "carry-out restaurants; restaurant, bar, and catering services; self-service restaurants" in International Class 43. The mark SMASH SMASH.SIZZLE.SAVOR. & Design is the subject of federal trademark application Serial No. 77/427,433, allegedly owned by Icon Burger Development Company ("Applicant"), and Opposer hereby opposes registration thereof.

As grounds for this Opposition, it is alleged that:

1. Opposer is the owner of record of Registration No. 882,633, issued on December 16, 1969, for the mark SIZZLER, as well as of the business and goodwill connected therewith.

Opposer has been using the SIZZLER mark in commerce in connection with "restaurant services" in International Class 42, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

2. Opposer is the owner of record of Registration No. 888,458, issued on March 3, 1970, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "rendering technical assistance in the establishment and operation of restaurants for others" in International Class 35, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

3. Opposer is the owner of record of Registration No. 976,493, issued on January 8, 1974, for the mark SIZZLER FAMILY STEAK HOUSE, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER FAMILY STEAK HOUSE mark in commerce in connection with "restaurant services" in International Class 42, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

4. Opposer is the owner of record of Registration No. 1,384,530, issued on February 25, 1986, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "prepared menu item, namely toast, for consumption on and off the premises" in International Class 30, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

5. Opposer is the owner of record of Registration No. 1,462,078, issued on October 20, 1987, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "prepared menu

items, namely, steaks, and dinners consisting of steak, potatoes and toast for consumption on and off the premises" in International Class 29, as identified in the aforementioned registration.

Opposer's registration is unrevoked and uncanceled.

6. Opposer is the owner of record of Registration No. 1, 795,103, issued on September 28, 1993, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "clothing, namely golf shirts, aprons, T-shirts, caps, jackets, and ties" in International Class 25, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

7. Opposer is the owner of record of Registration No. 2,294,706, issued on November 11, 1999, for the mark SIZZLER & design, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER & design mark (shown below) in commerce in connection with "restaurant services" in International Class 42, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.



8. Opposer is the owner of record of Registration No. 2,862,488, issued on July 13, 2004, for the mark SIZZLER UNITED STEAK LOVERS OF AMERICA & design, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER UNITED STEAK LOVERS OF AMERICA & design mark (shown below) in commerce in connection with "clothing, namely t-shirts and shirts, headwear" in International Class 25, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.



9. Opposer is the owner of record of Registration No. 3,056,206, issued on January 31, 2006, for the mark SIZZLER SS & Design, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER SS & design mark (shown below) in commerce in connection with "stationary, writing paper, coupons, newsletters in the field of food and restaurants" in International Class 16, "prepared entrees consisting primarily of meat, poultry and/or vegetables; vegetable and fruit salads, and excluding sausages" in International Class 29, and "prepared entrees consisting primarily of pasta and/or rice, spices, sauces, bakery goods, breads" in International Class 30, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncancelled.



10. On information and belief, Applicant has a principal address of Tower 1, Suite 1000, 1515 Arapahoe Street, Denver, Colorado 80202.

11. On information and belief, Applicant is the owner of record of trademark application Serial No. 77/427,433 for registration of the mark SMASH SMASH.SIZZLE.SAVOR. & Design ("Applicant's Mark") for use in connection with "carry-out restaurants; restaurant, bar, and catering services; self-service restaurants" in International Class 43 ("Applicant's Services").

12. As set forth in Opposer's Reg. Nos. 882,633, 888,458, 1,384,530, 1,462,078, Opposer has used the mark SIZZLER in connection with its restaurant services and menu items, as well as in connection with its provision of assistance in establishing and operating restaurants, since as least as early as September 2, 1963. Opposer's use of SIZZLER has been continuous since 1963.

13. As set forth in Opposer's Reg. No. 2,294,706, Opposer has used the mark SIZZLER & design in connection with its restaurant services, since at least as early as May 11, 1997. Opposer's use of the SIZZLER & design mark has been continuous since 1997.

14. As set forth in Opposer's Reg. No. 3,056,206, Opposer has used the mark SIZZLER SS & design in connection with *inter alia*, prepared entrees since at least as early as November 3, 2005. Opposer's use of the SIZZLER SS & design mark has been continuous since 2005.

15. As set forth in Opposer's Reg. No. 976,493, Opposer has used the mark SIZZLER FAMILY STEAK HOUSE in connection with its restaurant services since at least as early as October of 1968. Opposer's use of SIZZLER FAMILY STEAK HOUSE has been continuous since 1968.

16. As set forth in Opposer's Reg. No. 1,795,103, Opposer has also used the mark SIZZLER in connection with clothing, namely golf shirts, aprons, t-shirts, caps, jackets, and ties, since at least as early December 31, 1981. Opposer's use of SIZZLER has been continuous since 1981.

17. As set forth in Opposer's Reg. No. 2,862,488, Opposer has also used the mark SIZZLER UNITED STEAK LOVERS OF AMERICA & design in connection with clothing, including t-shirts, shirts, and headwear, since at least as early as January 7, 2003.

18. Since long prior to March 20, 2008, the filing date of Applicant's application, Opposer has widely advertised and promoted each of its marks identified above (collectively referred to herein, as the "SIZZLER Marks") in connection with its goods and services with the result that the SIZZLER Marks have become well known and associated with Opposer in the United States. Because of these efforts, and by virtue of the excellence and success of the goods and services offered and provided by Opposer under the SIZZLER Marks, Opposer has built up a valuable reputation and tremendous goodwill in its SIZZLER Marks belonging exclusively to Opposer.

19. Applicant's Mark so resembles the SIZZLER Marks as to be likely, when used in connection with Applicant's Services, as to cause confusion, or mistake, or deception. Applicant's Mark, therefore, creates a confusingly similar commercial impression. Thus, consumers will likely believe that Applicant's use of Applicant's Mark in connection with Applicant's Services is in some way associated or connected with or sponsored, authorized, or warranted by Opposer. Any objection or fault with Applicant's Services offered in connection with Applicant's Mark would reflect upon and seriously injure Opposer's reputation in connection with goods and services offered under the SIZZLER Marks.

20. Opposer's SIZZLER Marks are famous and were famous before March 20, 2008, the filing date of Applicant's application. Applicant's Mark so resembles Opposer's SIZZLER Marks as to be likely, when used in connection with Applicant's Services, as to cause dilution of Opposer's SIZZLER Marks.

21. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to use of the mark SMASH SMASH.SIZZLE.SAVOR. & Design in connection with the goods and services identified in

application Serial No. 77/427,433. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, in accordance with Section 13 of the Trademark Act (15 U.S.C. § 1063), Opposer prays that this Opposition be sustained and that application Serial No. 77/427,433 be refused.

Respectfully submitted,

Dated: September 4, 2008

/s/ Jessica C. Bromall

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CERTIFICATE OF SERVICE

It is hereby certified that on **September 4, 2008**, a copy of the foregoing NOTICE OF OPPOSITION has been sent by first class mail, postage prepaid to Opposer at the correspondence address of record in the Patent and Trademark Office:

Scott S. Havlick
HOLLAND & HART LLP
P.O. Box 8749
Denver, Colorado 80201-8749

Joel Drake