

ESTTA Tracking number: **ESTTA333997**

Filing date: **02/24/2010**

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	Denihan Ownership Company, LLC
Granted to Date of previous extension	02/24/2010
Address	551 Fifth Avenue10th Floor New York, NY 10176 UNITED STATES
Attorney information	Irene E Hudson, Erin Hickey Fish & Richardson P.C. 601 Lexington Avenue52nd Floor New York, NY 10022 UNITED STATES hudson@fr.com, tmdocny@fr.com, drf@fr.com, hickey@fr.com Phone:2127655070

Applicant Information

Application No	77703573	Publication date	10/27/2009
Opposition Filing Date	02/24/2010	Opposition Period Ends	02/24/2010
Applicant	A&B Restaurant Group LLC 52 East 41st Street New York, NY 100176211 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2006/10/31 First Use In Commerce: 2006/10/31 All goods and services in the class are opposed, namely: restaurant, cocktail lounge, and bar services
--

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
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.	2317209	Application Date	04/16/1998
Registration Date	02/08/2000	Foreign Priority Date	NONE

Word Mark	THE BENJAMIN
Design Mark	THE BENJAMIN
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1999/04/16 First Use In Commerce: 1999/04/16 HOTEL SERVICES

U.S. Registration No.	3495430	Application Date	01/24/2008
Registration Date	09/02/2008	Foreign Priority Date	NONE
Word Mark	BB THE BENJAMIN		
Design Mark			
Description of Mark	The mark consists of a capitalized 'B' and a backward capitalized 'B' facing each other and touching. The Bs are surrounded by a box. The words ' The Benjamin' are under the box.		
Goods/Services	Class 043. First use: First Use: 1999/04/19 First Use In Commerce: 1999/04/19 Hotel services		

Attachments	75471421#TMSN.gif (1 page)(bytes) 77379990#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (8 pages)(279051 bytes) Exhibit A.pdf (2 pages)(638454 bytes) Exhibit B.pdf (2 pages)(577275 bytes) Exhibit C.pdf (2 pages)(603067 bytes)
-------------	--

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	/EMH/
Name	Erin M. Hickey
Date	02/24/2010

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

In the matter of Application Serial No. 77/703,573
For the Mark BENJAMIN STEAK HOUSE and Design
Published in the Official Gazette on October 27, 2009

DENIHAN OWNERSHIP COMPANY, LLC,

Opposer,

v.

A&B RESTAURANT GROUP LLC d/b/a
BENJAMIN STEAKHOUSE,

Applicant.

Opposition No.

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Denihan Ownership Company, LLC (hereafter, "Opposer"), a limited liability company duly organized and existing under the laws of New York, and having a principal place of business at 551 Fifth Avenue, 10th Floor, New York, New York 10176, believes that it will be damaged by the registration of the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 and, having previously filed for and been granted two extensions of time to oppose Application Serial No. 77/703,573, hereby opposes the same.

As grounds therefor, it is alleged that:

1. Opposer is now, and for many years past, and since long before October 31, 2006, the date upon which A&B Restaurant Group LLC d/b/a Benjamin Steakhouse (hereafter,

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 2

“Applicant”) claims to have first used the mark identified in Application Serial No. 77/703,573, and since long before any priority date that could be afforded to a registration resulting from Application Serial No. 77/703,573, has been offering and rendering award-winning hotel services under THE BENJAMIN trademark. An example of the current use of THE BENJAMIN trademark in connection with hotel services is annexed hereto as **Exhibit A**. The hotels with which such trademark has been used have also featured restaurant, cocktail lounge, and bar services since long before October 31, 2006.

2. Since at least as early as April 1999, and since long before October 31, 2006, the date upon which Applicant claims to have first used the mark identified in Application Serial No. 77/703,573, and since long before any priority date that could be afforded to a registration resulting from Application Serial No. 77/703,573, Opposer commenced use of the marks THE BENJAMIN and BB THE BENJAMIN and Design for hotel services, such hotels also featuring restaurant, cocktail lounge, and bar services (hereafter, the “BENJAMIN Marks”). Since the date of first use as aforesaid, Opposer has continuously used the BENJAMIN Marks for such hotel services.

3. Since long before October 31, 2006, the date upon which Applicant claims to have first used the mark identified in Application Serial No. 77/703,573, and since long before any priority date that could be afforded to a registration resulting from Application Serial No. 77/703,573, Opposer has extensively advertised and promoted its BENJAMIN Marks in connection with its hotel services, and has achieved significant sales of such services under and in connection with its BENJAMIN Marks throughout the United States.

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 3

4. By virtue of such advertising and promotion, together with the long and continuous use of the BENJAMIN Marks, and the quality of the services rendered under and in connection with the BENJAMIN Marks, Opposer's BENJAMIN Marks are now well known marks recognized throughout the United States.

5. In addition to its longstanding common law rights in the BENJAMIN Marks, Opposer owns the following federal service mark registrations for the BENJAMIN Marks in connection with hotel services:

a. Registration No. 2,317,209 for the mark THE BENJAMIN, which has a priority date of April 16, 1998, and which has now achieved incontestable status (Annexed hereto as **Exhibit B** is a true and correct copy of the Certificate of Registration for Registration No. 2,317,209.); and

b. Registration No. 3,495,430 for the mark BB THE BENJAMIN and Design, which claims a date of first use of April 19, 1999, and which issued September 2, 2008 (Annexed hereto as **Exhibit C** is a true and correct copy of the Certificate of Registration for Registration No. 3,495,430.).

The above-identified registrations are valid and subsisting, and are in full force and effect. Opposer is the owner of the registrations and the marks shown therein, and of the entire business and goodwill connected therewith and symbolized thereby.

6. Applicant applied to register the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 on March 31, 2009 for "restaurant, cocktail lounge, and bar services" in International Class 43, claiming use of the mark in connection with

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 4

such services in United States commerce since at least as early as October 31, 2006. Applicant has disclaimed exclusive rights to “steak house” apart from the mark as whole.

7. Opposer’s common law and statutory priority rights in and to the BENJAMIN Marks precede October 31, 2006, the date upon which Applicant claims to have first used the mark identified in Application Serial No. 77/703,573, and precede any priority date that could be afforded to a registration resulting from Application Serial No. 77/703,573.

8. Opposer’s BENJAMIN Marks are distinctive and well known, and its BENJAMIN Marks became famous long before October 31, 2006, the date upon which Applicant claims to have first used the mark identified in Application Serial No. 77/703,573, and since long before any priority date that could be afforded to a registration resulting from Application Serial No. 77/703,573.

9. The primary and dominant element of the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 is the element BENJAMIN and, as such, the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 is closely similar to Opposer’s previously used and registered BENJAMIN Marks.

10. Applicant’s restaurant, cocktail lounge, and bar services are, upon information and belief, offered and rendered in a hotel and, as such, are likely to be advertised in the same types of media as Opposer’s hotel services which also feature restaurant, cocktail lounge, and bar services and are likely to be offered and rendered to the same types of customers who purchase

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 5

Opposer's hotel services offered and rendered under its previously used and registered BENJAMIN Marks.

11. Registration of the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 should be refused under Section 2(a) of the United States Trademark Act, 15 U.S.C. § 1052, on the grounds that Applicant's use of the mark BENJAMIN STEAK HOUSE and Design, which so closely resembles Opposer's previously used and registered BENJAMIN Marks, creates the false and misleading impression that the restaurant, cocktail lounge, and bar services offered and rendered by Applicant in a hotel under the mark BENJAMIN STEAK HOUSE and Design are related to or come from the same source as the hotel services offered and rendered by Opposer under the BENJAMIN Marks, resulting in injury to Opposer, the trade, and to the public.

12. Registration of the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 should be refused under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052, on the grounds that Applicant's mark BENJAMIN STEAK HOUSE and Design so closely resembles Opposer's previously used and registered BENJAMIN Marks as to be likely, when used in connection with Applicant's restaurant, cocktail lounge, and bar services offered and rendered in a hotel, to cause confusion, to cause mistake, and to deceive, resulting in injury to Opposer, the trade, and to the public.

13. Registration of the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573 should be refused under Section 43(c) of the United States

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 6

Trademark Act, 15 U.S.C. § 1125(c), on the grounds that the mark BENJAMIN STEAK HOUSE and Design so closely resembles Opposer's previously used and registered BENJAMIN Marks that it is likely to cause dilution of Opposer's previously used and registered BENJAMIN Marks, resulting in injury to Opposer, the trade, and to the public.

14. Opposer will be damaged by the registration sought herein by Applicant because such registration will support and assist Applicant in the confusing, misleading, and deceptive use of the mark BENJAMIN STEAK HOUSE and Design identified in Application Serial No. 77/703,573, and will give color of exclusive statutory rights in Applicant in violation and derogation of the prior and superior rights of Opposer in its previously used and registered BENJAMIN Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's designation BENJAMIN STEAK HOUSE and Design and prays that it not be allowed.

Please charge Deposit Account No. 06-1050, Order No. 13259-0099PP1 for the filing fee for this Notice of Opposition, and for any other fees that may be due.

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 7

Dated: February 24, 2010

Respectfully submitted,

FISH & RICHARDSON P.C.

By: Erin M. Hickey

David R. Francescani

Irene E. Hudson

Erin M. Hickey

601 Lexington Avenue

New York, New York 10022

Telephone: (212) 765-5070

Facsimile: (212) 258-2291

E-mail: francescani@fr.com, HUDSON@fr.com,
hickey@fr.com, and tmdoctc@fr.com

Attorneys for Opposer

DENIHAN OWNERSHIP COMPANY, LLC

Applicant : A&B Restaurant Group LLC d/b/a Benjamin Steakhouse
Serial No. : 77/703,573
Filed : March 31, 2009
Mark : **BENJAMIN STEAK HOUSE and Design**
Page : 8

CERTIFICATE OF SERVICE

This is to certify that, on this 24th day of February 2010, a true copy of the foregoing **NOTICE OF OPPOSITION** has been sent by first-class mail, postage prepaid, to Applicant's attorneys of record:

Meyer . Gross, Esq.
Michael A. Cornman, Esq.
LADAS & PARRY LLP
26 West 61st Street, 4th Floor
New York, New York 10023

FISH & RICHARDSON P.C.

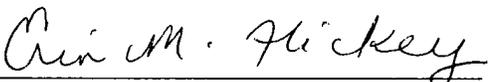
By: 
Erin M. Hickey

Exhibit A



THE BENJAMIN

THE BENJAMIN EXPERIENCE

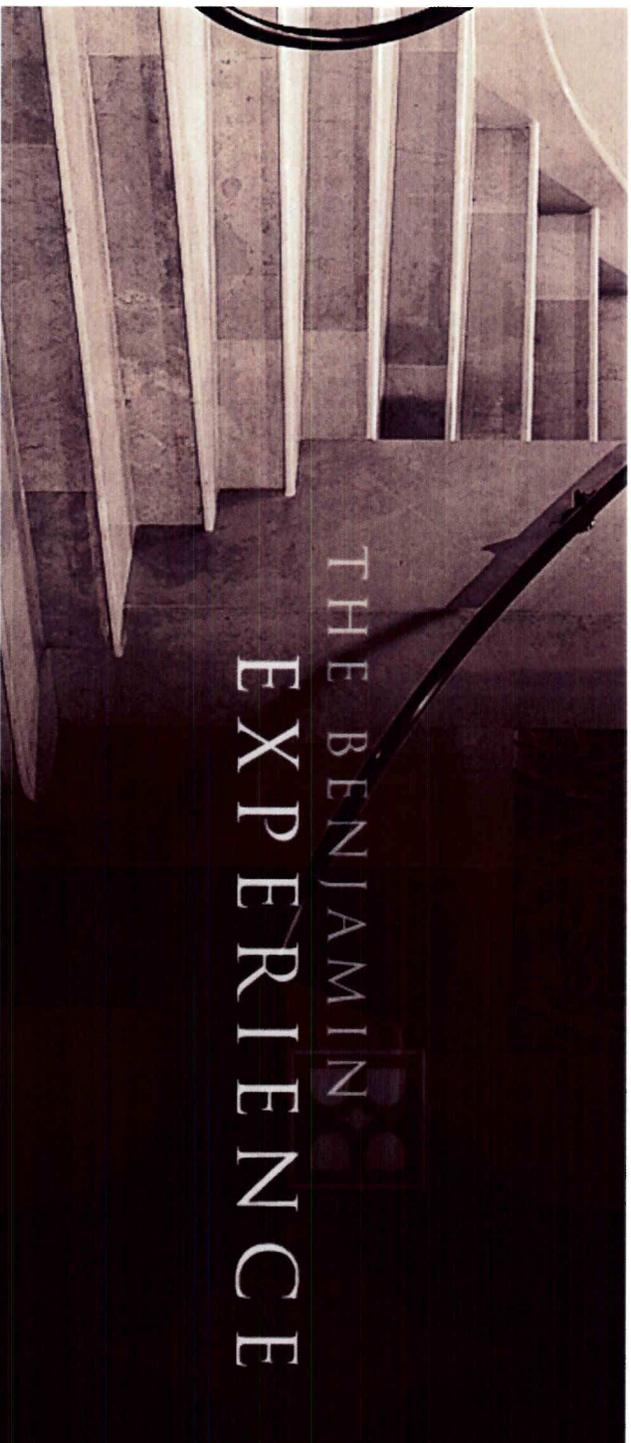
HOTELS

SELF

LUXURY ESCAPES

MEETINGS AND EVENTS

RESERVATIONS | CONCIERGE | SEARCH | PRESS | LOGIN



TAKE THE BENJAMIN HOME | DREAM DDG™ | SPA | RESTAURANT

CLICK HERE TO SEE OUR [US Open Commercial!](#)

[SHARE THIS PAGE WITH A FRIEND](#)
 [SIGN UP FOR SPECIAL OFFERS](#)

[Home](#) | [DHG | Affinia Hotels](#) | [The James](#) | [Press Room](#) | [Careers](#) | [Sitemap](#) | [Privacy](#) | [Terms of Use](#) | [Contact Us](#) | [Hotel Partners](#)

The Benjamin - New York Luxury Hotel
Located in Midtown Manhattan, The Benjamin stands alone among other New York luxury hotels. Enter the front doors of this 1927 building and step into the lobby. Restored to its original grandeur, The Benjamin is catered to the discerning Manhattan travelers seeking hotel rooms and suites.

Luxurious Boutique Manhattan Style

With exquisite boutique styling, this luxurious hotel in Manhattan is located on the corner of East 50th and Lexington Ave. Designed to help its guests work and relax, The Benjamin offers the finest amenities and a world services that is hard to replicate by other leading hotels.

The Benjamin Hotel Specials - NY Hotel Reservations

Looking for NY hotel specials? The Benjamin has many luxurious packages to pick from online. View our specials page to learn more about available hotel specials offered from The Benjamin. Ready to reserve? Book your [hotel reservations](#) online, or call us (US): 1-866-222-8888 (1-866-222-2365), International: 1-212-905-1472.

Arrival	Nights	Adults	Children
Feb <input type="text"/>	24 <input type="text"/>	1 <input type="text"/>	1 <input type="text"/>
Promotion Code	Group Code		
<input type="text"/>	<input type="text"/>		
CHECK AVAILABILITY >>>			

Exhibit B

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,317,209

United States Patent and Trademark Office

Registered Feb. 8, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

THE BENJAMIN

125 EAST 50TH CO., LLC (NEW YORK LIMITED LIABILITY COMPANY)
500 WEST 37TH STREET
NEW YORK, NY 10018

FIRST USE 4-16-1999; IN COMMERCE
4-16-1999.

SN 75-471,421, FILED 4-16-1998.

FOR: HOTEL SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

SUE KASTRINER, EXAMINING ATTORNEY

Exhibit C

Int. Cl.: 43

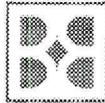
Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 3,495,430

Registered Sep. 2, 2008

SERVICE MARK
PRINCIPAL REGISTER



THE BENJAMIN

DENIHAN OWNERSHIP COMPANY, LLC (NEW
YORK LTD LIAB CO)
500 WEST 37TH STREET
NEW YORK, NY 10018

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

FIRST USE 4-19-1999; IN COMMERCE 4-19-1999.

OWNER OF U.S. REG. NOS. 2,317,209 AND
2,517,780.

THE MARK CONSISTS OF A CAPITALIZED 'B'
AND A BACKWARD CAPITALIZED 'B' FACING
EACH OTHER AND TOUCHING. THE BS ARE
SURROUNDED BY A BOX. THE WORDS ' THE
BENJAMIN' ARE UNDER THE BOX.

SER. NO. 77-379,990, FILED 1-24-2008.

KOURTNEE HODGES, EXAMINING ATTORNEY