

ESTTA Tracking number: **ESTTA381528**

Filing date: **12/02/2010**

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

Proceeding	91197089
Party	Defendant A. Stein Meat Products, Inc.
Correspondence Address	ROBERT T. MALDONADO COOPER & DUNHAM LLP 30 ROCKEFELLER PLZ NEW YORK, NY 10112-0015  Rmaldonado@cooperdunham.com
Submission	Answer and Counterclaim
Filer's Name	Robert T. Maldonado
Filer's e-mail	RMaldonado@cooperdunham.com
Signature	/Robert T. Maldonado/
Date	12/02/2010
Attachments	Answer to Notice of Opposition and Counterclaims To Cancel.pdf ( 10 pages ) (50358 bytes )

**Registrations Subject to the filing**

Registration No	1562301	Registration date	10/24/1989
Registrant	LOS ANGELES DODGERS LLC 1000 ELYSIAN PARK AVENUE LOS ANGELES, CA 90012 UNITED STATES		
Grounds for filing	The registration was obtained contrary to Trademark Act section 2(a)		

**Goods/Services Subject to the filing**

Class 025. First Use: 1985/10/24 First Use In Commerce: 1985/10/24 All goods and services in the class are requested, namely: CLOTHING, NAMELY, T-SHIRTS
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Registration No	1571978	Registration date	12/19/1989
Registrant	LOS ANGELES DODGERS LLC 1000 ELYSIAN PARK AVENUE LOS ANGELES, CA 90012 UNITED STATES		
Grounds for filing	The registration was obtained contrary to Trademark Act section 2(a)		

**Goods/Services Subject to the filing**

Class 021. First Use: 1983/10/00 First Use In Commerce: 1983/10/00 All goods and services in the class are requested, namely: BEVERAGE CONTAINERS, NAMELY, MUGS
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Registration No	1859757	Registration date	10/25/1994
Registrant	LOS ANGELES DODGERS LLC 1000 ELYSIAN PARK AVENUE LOS ANGELES, CA 90012		

	UNITED STATES
Grounds for filing	The registered mark has been abandoned.
	The registration was obtained contrary to Trademark Act section 2(a)

### Goods/Services Subject to the filing

Class 025. First Use: 1939/00/00 First Use In Commerce: 1939/00/00 All goods and services in the class are requested, namely: clothing; namely, shirts and uniform jerseys
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Registration No	3633244	Registration date	06/02/2009
Registrant	Los Angeles Dodgers LLC Dodger Stadium 1000 Elysian Park Avenue Los Angeles, CA 90012 UNITED STATES		

### Goods/Services Subject to the filing

Class 025. First Use: 1985/10/24 First Use In Commerce: 1985/10/24 All goods and services in the class are requested, namely: Clothing, namely, caps, hats, shirts, T-shirts, baseball uniforms, jerseys, sweatshirts, jackets, socks, hosiery
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Registration No	3797654	Registration date	06/01/2010
Registrant	Los Angeles Dodgers LLC Dodger Stadium 1000 Elysian Park Avenue Los Angeles, CA 90012 UNITED STATES		

### Goods/Services Subject to the filing

Class 025. First Use: 2010/03/22 First Use In Commerce: 2010/03/22 All goods and services in the class are requested, namely: Clothing, namely, shirts, T-shirts
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4. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 4, and therefore denies same. Further, to the extent that Opposer has not defined with specificity “Opposer’s BROOKLYN Marks,” Applicant is unable to respond.

5. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 5, and therefore denies same.

6. Applicant denies the allegations of paragraph 6.

7. Applicant admits the allegations of paragraph 7, except denies that Applicant filed the Application for “hamburger patties.”

8. Applicant admits the allegations of paragraph 8.

9. Applicant denies the allegations of paragraph 9.

10. Applicant denies the allegations of paragraph 10.

11. Applicant denies the allegations of paragraph 11.

#### **AFFIRMATIVE DEFENSES**

12. There is no likelihood of confusion between Applicant’s use of its mark BROOKLYN BURGER (Stylized) for hamburger patties, and Opposer’s use, if any, of the marks which are the subject of U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654.

13. Opposer’s U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 are invalid under 15 U.S.C. § 1052(a), because they are geographically deceptive.

14. Opposer's U.S. Trademark Registration Nos. 3,633,244 and 3,797,654 are invalid under 15 U.S.C. § 1052(e), because they are geographically deceptively misdescriptive.

15. Opposer's U.S. Trademark Registration No. 1,859,757 is invalid because it has been abandoned.

16. Opposer's marks which are the subject of U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 are entitled only to a narrow scope of protection. *See Major League Baseball v. Sed Non Olet Denarius*, 817 F. Supp. 1103, 1133 (S.D.N.Y. 1993), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994).

17. Opposer's claim is barred by the doctrines of laches, estoppel and acquiescence in view of Applicant's longstanding, continuous use of the subject mark in interstate commerce since 2006.

#### COUNTERCLAIMS

18. Applicant A. Stein Meat Products, Inc. is a New York corporation having a place of business at 5600 First Avenue, Brooklyn, New York 11220.

19. Applicant has used the mark BROOKLYN BURGER (Stylized),



in interstate commerce continuously since at least as early of June 1, 2006.

20. Opposer is a Delaware limited liability company with offices at Dodger Stadium, 1000 Elysian Park Avenue, Los Angeles, California 90012.

21. Opposer claims to own U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 for various trademarks including the word BROOKLYN ("Opposer's Trademark Registrations").

22. Applicant believes that it will be damaged by the Opposer's Trademark Registrations and hereby seeks cancellation of same.

**FIRST COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,562,301  
UNDER 15 U.S.C § 1052(a)**

23. Opposer repeats and realleges the allegations set forth in paragraphs 18-22, as if fully set forth herein.

24. Opposer is the owner of record of U.S. Trademark Registration No. 1,562,301 for the mark BROOKLYN DODGERS (Stylized) for clothing, namely, t-shirts, in International Class 25, which issued October 24, 1989.

25. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 1,562,301 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

26. The continued presence of Registration No. 1,562,301 on the Principal Register has caused and is causing damage to Applicant.

**SECOND COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,571,978  
UNDER 15 U.S.C § 1052(a)**

27. Opposer repeats and realleges the allegations set forth in paragraphs 18-26, as if fully set forth herein.

28. Opposer is the owner of record of U.S. Trademark Registration No. 1,571,978 for the mark BROOKLYN DODGERS (Stylized) for beverage containers, namely, mugs, in International Class 21, which issued December 19, 1989.

29. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 1,571,978 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

30. The continued presence of Registration No. 1,571,978 on the Principal Register has caused and is causing damage to Applicant.

**THIRD COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,859,757  
UNDER 15 U.S.C § 1052(a)**

31. Opposer repeats and realleges the allegations set forth in paragraphs 18-30, as if fully set forth herein.

32. Opposer is the owner of record of U.S. Trademark Registration No. 1,859,757 for the mark BROOKLYN (Stylized) for clothing, namely, t-shirts and uniform jerseys, in International Class 25, which issued October 25, 1994.

33. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 1,859,757 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

34. The continued presence of Registration No. 1,859,757 on the Principal Register has caused and is causing damage to Applicant.

**FOURTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,859,757  
UNDER 15 U.S.C § 1064(3)**

35. Opposer repeats and realleges the allegations set forth in paragraphs 18-34, as if

fully set forth herein.

36. Opposer is the owner of record of U.S. Trademark Registration No. 1,859,757 for the mark BROOKLYN (Stylized) for clothing, namely, t-shirts and uniform jerseys, in International Class 25, which issued October 25, 1994.

37. Upon information and belief, the mark which is the subject of U.S. Trademark Registration No. 1,859,757 has been widely used by third parties without Opposer's authorization or consent.

38. Opposer has abandoned the mark which is the subject of U.S. Trademark Registration No. 1,859,757, due to a course of conduct that has caused the mark to lose significance as an indication of source, pursuant to 15 U.S.C. § 1064(3).

39. The continued presence of Registration No. 1,859,757 on the Principal Register has caused and is causing damage to Applicant.

**FIFTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,633,244  
UNDER 15 U.S.C § 1052(a)**

40. Opposer repeats and realleges the allegations set forth in paragraphs 18-39, as if fully set forth herein.

41. Opposer is the owner of record of U.S. Trademark Registration No. 3,633,244 for the mark BROOKLYN DODGERS for clothing, namely, caps, hats, shirts, t-shirts, baseball uniforms, jerseys, sweatshirts, jackets, socks, hosiery, in International Class 25, which issued June 2, 2009.

42. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,633,244 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. §

1052(a).

43. The continued presence of Registration No. 3,633,244 on the Principal Register has caused and is causing damage to Applicant.

**SIXTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,633,244  
UNDER 15 U.S.C § 1052(e)**

44. Opposer repeats and realleges the allegations set forth in paragraphs 18-43, as if fully set forth herein.

45. Opposer is the owner of record of U.S. Trademark Registration No. 3,633,244 for the mark BROOKLYN DODGERS for clothing, namely, caps, hats, shirts, t-shirts, baseball uniforms, jerseys, sweatshirts, jackets, socks, hosiery, in International Class 25, which issued June 2, 2009.

46. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,633,244 is primarily geographically deceptively misdescriptive, pursuant to 15 U.S.C. § 1052(e).

47. The continued presence of Registration No. 3,633,244 on the Principal Register has caused and is causing damage to Applicant.

**SEVENTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,797,654  
UNDER 15 U.S.C § 1052(a)**

48. Opposer repeats and realleges the allegations set forth in paragraphs 18-47, as if fully set forth herein.

49. Opposer is the owner of record of U.S. Trademark Registration No. 3,797,654 for the mark BROOKLYN ROBINS for clothing, namely, t-shirts, in International Class 25, which

issued June 1, 2010.

50. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,797,654 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

51. The continued presence of Registration No. 3,797,654 on the Principal Register has caused and is causing damage to Applicant.

**EIGHTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,797,654  
UNDER 15 U.S.C § 1052(e)**

52. Opposer repeats and realleges the allegations set forth in paragraphs 18-51, as if fully set forth herein.

53. Opposer is the owner of record of U.S. Trademark Registration No. 3,797,654 for the mark BROOKLYN ROBINS for clothing, namely, t-shirts, in International Class 25, which issued June 1, 2010.

54. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,797,654 is primarily geographically deceptively misdescriptive, pursuant to 15 U.S.C. § 1052(e).

55. The continued presence of Registration No. 3,797,654 on the Principal Register has caused and is causing damage to Applicant.

WHEREFORE, Applicant respectfully requests that Opposer's Notice of Opposition be dismissed, and that U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 be cancelled.

Applicant submits herewith the fee of \$1,500 for filing this Petition. If this amount is improper or the check is missing, please charge any amount due to deposit Account No. 03-3125.

COOPER & DUNHAM LLP

/Robert T. Maldonado/

Dated: December 2, 2010

By: \_\_\_\_\_  
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Attorneys for Applicant  
A. STEIN MEAT PRODUCTS, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS FOR CANCELLATION** was served on this 2nd day of December, 2010 by First Class mail on the following attorney for Opposer:

Mary L. Kevlin, Esq.  
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/Robert T. Maldonado/

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