

ESTTA Tracking number: **ESTTA403117**

Filing date: **04/11/2011**

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	SBE Hotel Licensing, LLC
Granted to Date of previous extension	04/10/2011
Address	8000 Beverly Boulevard Los Angeles, CA 90048 UNITED STATES
Party who filed Extension of time to oppose	SBE Entertainment Group, LLC
Relationship to party who filed Extension of time to oppose	Opposer is the assignee of the mark.

Attorney information	Lee J Eulgen Neal, Gerber & Eisenberg LLP 2 North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES apeterson@ngelaw.com, leulgen@ngelaw.com, khinner@ngelaw.com
----------------------	--

Applicant Information

Application No	85057352	Publication date	10/12/2010
Opposition Filing Date	04/11/2011	Opposition Period Ends	04/10/2011
Applicant	LAROSE INDUSTRIES, LLC Building 5, 1578 Sussex Turnpike Randolph, NJ 07869 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Writing instruments, namely, markers, pens, pencils, colored pencils, mechanical pencils, and highlighter pens

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3570468	Application Date	06/15/2007
Registration Date	02/03/2009	Foreign Priority Date	NONE
Word Mark	SLS HOTELS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2008/06/24 First Use In Commerce: 2008/11/01 Hotel services; Hotel services for preferred customers; Hotel, bar and restaurant services; Hotels; Resort hotels		

U.S. Registration No.	3616676	Application Date	06/26/2007
Registration Date	05/05/2009	Foreign Priority Date	NONE
Word Mark	SLS		
Design Mark			
Description of Mark	The mark consists of a chandelier design with monkeys sitting on it and the letters "SLS" on the body of the chandelier.		
Goods/Services	Class 043. First use: First Use: 2008/06/24 First Use In Commerce: 2008/11/01 Hotel services; hotel services for preferred customers; hotel, bar and restaurant services; hotels; resort hotels		

U.S. Registration No.	3689950	Application Date	10/23/2007
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	SLS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 2008/11/01 First Use In Commerce: 2008/11/01 Hotel services; Hotel services for preferred customers; Hotel, bar and restaurant services; Hotels; Resort Hotels

Attachments	77207312#TMSN.jpeg (1 page)(bytes) 77215934#TMSN.jpeg (1 page)(bytes) 77311393#TMSN.jpeg (1 page)(bytes) Notice_of_Opposition_SLS.pdf (5 pages)(12031 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	/Lee J Eulgen/
Name	Lee J Eulgen
Date	04/11/2011

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

In re Application Serial No.: 85/057,352)	
)	
Mark: SLS)	
)	
Published in the Official Gazette)	
On October 12, 2010)	Opposition No. _____
)	
SBE HOTEL LICENSING, LLC,)	
)	
Opposer,)	
v.)	
)	
LAROSE INDUSTRIES, LLC)	
)	
Applicant.)	

NOTICE OF OPPOSITION

This Notice of Opposition is submitted in the matter of Application Serial No. 85/057,352, by which Larose Industries, LLC (“Applicant”) seeks to register the trademark SLS for use in connection with writing instruments, namely, markers, pens, pencils, colored pencils, mechanical pencils, and highlighter pens in International Class 16. The subject application was published for opposition in the Official Gazette on October 12, 2010. SBE Hotel Licensing, LLC, a limited liability company organized under the laws of California with a place of business at 8000 Beverly Boulevard, Los Angeles, California 90048, (“SBE”) believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. Along with its predecessors and affiliates, SBE is a renowned operator of premier hotels, restaurants and bars. Several years ago, SBE began offering hotel, restaurant, and bar services and related goods under its SLS name and marks at its luxury hotel located in Beverly

Hills, California. SBE is also currently developing another hotel to be located in South Beach Miami, Florida. SBE's SLS hotels provide numerous products to guests, including skin and hair products, bath robes and other clothing, and, notably, writing instruments.

2. On June 15, 2007, SBE's predecessor in interest, SBE Entertainment Group, LLC, filed U.S. Trademark Application Serial No. 77/207,312. On February 3, 2009, that Application was registered as U.S. Registration No. 3,570,468 for the mark SLS HOTELS for use in connection with hotel services; hotel services for preferred customers; hotel, bar and restaurant services; hotels; resort hotels in International Class 43. That Registration is now owned by SBE.

3. On June 26, 2007, SBE's predecessor in interest, SBE Entertainment Group, LLC, filed U.S. Trademark Application Serial No. 77/215,934. On May 5, 2009, that Application was registered as U.S. Registration No. 3,616,676 for the mark SLS and Design for use in connection with hotel services; hotel services for preferred customers; hotel, bar and restaurant services; hotels; resort hotels in International Class 43. That Registration is now owned by SBE.

4. On October 23, 2007, SBE's predecessor in interest, SBE Entertainment Group, LLC, filed U.S. Trademark Application Serial No. 77/311,393. On September 29, 2009, that Application was registered as U.S. Registration No. 3,689,950 for the mark SLS for use in connection with hotel services; hotel services for preferred customers; hotel, bar and restaurant services; hotels; resort hotels in International Class 43. That Registration is now owned by SBE.

5. On June 8, 2010, after SBE or its predecessors filed the foregoing SLS applications (Application Serial Nos. 77/207,312; 77/215,934; and 77/311,393 covering services in International Class 43) and after SBE began to utilize its SLS marks in connection with products such as writing instruments, Applicant filed an application to register the mark SLS in

connection with “writing instruments, namely, markers, pens, pencils, colored pencils, mechanical pencils, and highlighter pens” in International Class 16.

6. On October 12, 2010, Applicant’s mark published for opposition. On November 9, 2010, SBE filed a timely request for a 90-day extension of time in which to oppose the subject application, which was granted by the Trademark Trial and Appeal Board in its November 9, 2010 Order. On February 8, 2011, SBE filed a timely request for a further 60-day extension of time in which to oppose the subject application with Applicant’s consent, which was granted by the Trademark Trial and Appeal Board in its February 8, 2011 Order.

7. SBE is the prior user of the SLS mark in connection with writing instruments and other products, and it has priority over Applicant’s use of the subject mark.

8. SBE is concerned that Applicant’s substantially identical mark comprised of the term SLS is likely to cause confusion or mistake, or deceive purchasers, in that purchasers would be likely to believe that the goods covered by Applicant’s application are in some way legitimately connected with, sponsored by or approved by SBE. SBE is likewise concerned that Applicant’s registration of its mark would result in damage to SBE, and on that basis, SBE opposes registration of Applicant’s mark.

WHEREFORE, SBE requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

SBE requests that the requisite filing fee of \$300.00 be charged to the deposit account of Neal, Gerber & Eisenberg LLP, Account No. 502261.

Please address all communications to Lee J. Eulgen and Kristi J. Hinner, Neal, Gerber & Eisenberg LLP, 2 North LaSalle Street, Suite 2200, Chicago, Illinois, 60602.

Respectfully submitted,

Date: April 11, 2011

By: /Lee J. Eulgen/
One of the Attorneys for Opposer,
SBE Hotel Licensing, LLC

Lee J. Eulgen
Kristi J. Hinner
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 2200
Chicago, Illinois 60602-3801
(312) 269-8000

CERTIFICATE OF SERVICE

I, Kristi J. Hinner, an attorney, state that, pursuant to 37 CFR §§ 2.101 and 2.119, I caused a copy of the foregoing Notice of Opposition to be served upon:

ROBERT W. SMITH
MCCARTER & ENGLISH, LLP
100 MULBERRY ST
FOUR GATEWAY CENTER
NEWARK, NJ 07102-4096

Via First Class Mail, postage prepaid, on April 11, 2011.

/Kristi J. Hinner/
Kristi J. Hinner