

ESTTA Tracking number: **ESTTA425412**

Filing date: **08/16/2011**

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	Whataburger Partnership
Granted to Date of previous extension	08/17/2011
Address	300 Concord Plaza Drive San Antonio, TX 78216 UNITED STATES

Attorney information	William G. Barber Pirkey Barber LLP 600 Congress Ave., Suite 2120 Austin, TX 78701 UNITED STATES bbarber@pirkeybarber.com, wlarson@pirkeybarber.com, jmcdaniel@dmtechlaw.com, eolson@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512.322.5200
----------------------	---

Applicant Information

Application No	85178487	Publication date	04/19/2011
Opposition Filing Date	08/16/2011	Opposition Period Ends	08/17/2011
Applicant	Franco's Pizza, LLC Suite 104 1365 Grayson Hwy Lawrenceville, GA 30017 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2010/10/05 First Use In Commerce: 2010/10/15 All goods and services in the class are opposed, namely: T-shirts
Class 043. First Use: 2010/10/05 First Use In Commerce: 2010/10/05 All goods and services in the class are opposed, namely: Pizza parlors

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.	652137	Application Date	06/07/1954
Registration Date	09/24/1957	Foreign Priority	NONE

		Date	
Word Mark	WHATABURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U046 (International Class 030). First use: First Use: 1950/01/01 First Use In Commerce: 1953/02/10 HAMBURGER SANDWICH		

U.S. Registration No.	891082	Application Date	02/20/1968
Registration Date	05/12/1970	Foreign Priority Date	NONE
Word Mark	WHATABURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U100 (International Class 042). First use: First Use: 1950/01/01 First Use In Commerce: 1953/02/10 RESTAURANT SERVICES AND DRIVE IN RESTAURANT SERVICES		

U.S. Registration No.	1011927	Application Date	11/29/1972
Registration Date	05/27/1975	Foreign Priority Date	NONE
Word Mark	WHATABURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U045 (International Class 032). First use: First Use: 1972/07/18 First Use In Commerce: 1972/07/28 SOFT DRINKS		

	<p>Class U046 (International Class 029, 030). First use: First Use: 1972/07/18 First Use In Commerce: 1972/07/28 HAMBURGERS, CHEESEBURGERS, FRENCH FRIED POTATOES, [POTATO CHIPS, CORN CHIPS,] FRIED PIES, ONION RINGS, MALT AND SHAKE BEVERAGES, AND FRANKFURTER SANDWICHES</p> <p>Class U100 (International Class 042). First use: First Use: 1972/07/18 First Use In Commerce: 1972/07/28 RESTAURANT AND DRIVE-IN RESTAURANT SERVICES</p>
--	--

U.S. Registration No.	1011928	Application Date	11/29/1972
Registration Date	05/27/1975	Foreign Priority Date	NONE
Word Mark	W WHATABURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class U045 (International Class 032). First use: First Use: 1972/07/18 First Use In Commerce: 1972/07/28 SOFT DRINKS</p> <p>Class U046 (International Class 029, 030). First use: First Use: 1972/07/18 First Use In Commerce: 1972/07/28 HAMBURGERS, CHEESEBURGERS, FRENCH FRIED POTATOES, [POTATO CHIPS, CORN CHIPS,] FRIED PIES, ONION RINGS, MALT AND SHAKE BEVERAGES, AND FRANKFURTER SANDWICHES</p> <p>Class U100 (International Class 042). First use: First Use: 1972/07/28 First Use In Commerce: 1972/07/28 RESTAURANT AND DRIVE-IN RESTAURANT SERVICES</p>		

U.S. Registration No.	2335590	Application Date	04/05/1999
Registration Date	03/28/2000	Foreign Priority Date	NONE
Word Mark	WHATABURGER		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 042. First use: First Use: 1950/01/01 First Use In Commerce: 1953/02/10 restaurant services		
----------------	---	--	--

U.S. Registration No.	2757109	Application Date	10/31/2001
-----------------------	---------	------------------	------------

Registration Date	08/26/2003	Foreign Priority Date	NONE
-------------------	------------	-----------------------	------

Word Mark	WHATABURGER		
-----------	-------------	--	--

Design Mark			
-------------	--	--	--

Description of Mark	NONE		
---------------------	------	--	--

Goods/Services	Class 036. First use: First Use: 2001/10/05 First Use In Commerce: 2001/10/05 Charitable fundraising services		
----------------	---	--	--

U.S. Registration No.	1014196	Application Date	11/26/1973
-----------------------	---------	------------------	------------

Registration Date	06/24/1975	Foreign Priority Date	NONE
-------------------	------------	-----------------------	------

Word Mark	WHATABURGER JR.		
-----------	-----------------	--	--

Design Mark			
-------------	--	--	--

Description of Mark	NONE		
---------------------	------	--	--

Goods/Services	Class 029. First use: First Use: 1973/04/01 First Use In Commerce: 1973/08/29 PREPARED HAMBURGER SANDWICH FOR CONSUMPTION ON OR OFF THE PREMISES		
----------------	--	--	--

U.S. Registration No.	1116918	Application Date	01/20/1978
-----------------------	---------	------------------	------------

Registration Date	04/24/1979	Foreign Priority Date	NONE
-------------------	------------	-----------------------	------

Word Mark	WHATAMEAL		
-----------	-----------	--	--

Design Mark			
-------------	--	--	--

Description of Mark	NONE		
---------------------	------	--	--

Goods/Services	Class 030. First use: First Use: 1975/07/01 First Use In Commerce: 1975/07/01 PREPARED MEAL CONSISTING OF A HAMBURGER SANDWICH, FRENCH FRIES AND A BEVERAGE FOR CONSUMPTION ON OR OFF THE PREMISES		
----------------	--	--	--

U.S. Registration No.	1206344	Application Date	08/10/1979
-----------------------	---------	------------------	------------

Registration Date	08/24/1982	Foreign Priority Date	NONE
-------------------	------------	-----------------------	------

Word Mark	WHATACATCH		
-----------	------------	--	--

Design Mark			
-------------	--	--	--

Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 1978/10/14 First Use In Commerce: 1979/04/01 Breaded Fish Fillets Suitable for Fish Sandwiches Class 030. First use: First Use: 1978/10/14 First Use In Commerce: 1979/04/01 Prepared Fish Sandwich for Consumption On or Off the Premises

U.S. Registration No.	2160285	Application Date	03/24/1997
Registration Date	05/26/1998	Foreign Priority Date	NONE
Word Mark	WHATACHICK'N		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1984/01/01 First Use In Commerce: 1984/01/01 chicken sandwich		

U.S. Registration No.	2372372	Application Date	03/05/1999
Registration Date	08/01/2000	Foreign Priority Date	NONE
Word Mark	WHATAKIDS		
Design Mark	WHATAKIDS		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/11/00 First Use In Commerce: 1999/02/15 Clothing for children, namely, shirts, polo shirts, t-shirts, dresses, overalls, onesies, baseball caps and hats		

U.S. Registration No.	2432191	Application Date	02/22/1999
Registration Date	02/27/2001	Foreign Priority Date	NONE
Word Mark	WHATAKIDS		
Design Mark	WHATAKIDS		
Description of	NONE		

Mark	
Goods/Services	Class 042. First use: First Use: 1999/04/01 First Use In Commerce: 1999/04/01 restaurant services

U.S. Registration No.	2424846	Application Date	09/16/1999
Registration Date	01/30/2001	Foreign Priority Date	NONE

Word Mark	WHATA LOTTA HOT
-----------	-----------------

Design Mark	WHATA LOTTA HOT
-------------	------------------------

Description of Mark	NONE
---------------------	------

Goods/Services	Class 042. First use: First Use: 1995/02/00 First Use In Commerce: 1995/02/00 Restaurant services
----------------	---

U.S. Registration No.	2418380	Application Date	05/06/1999
Registration Date	01/02/2001	Foreign Priority Date	NONE

Word Mark	WHATAGUY
-----------	----------

Design Mark	WHATAGUY
-------------	-----------------

Description of Mark	NONE
---------------------	------

Goods/Services	Class 042. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 restaurant services
----------------	---

U.S. Registration No.	3376301	Application Date	11/24/2004
Registration Date	01/29/2008	Foreign Priority Date	NONE

Word Mark	WHATAPALS
-----------	-----------

Design Mark	WHATAPALS		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2003/01/04 First Use In Commerce: 2003/01/04 Restaurant services		

U.S. Registration No.	2534527	Application Date	03/10/1999
Registration Date	01/29/2002	Foreign Priority Date	NONE
Word Mark	WHATAPLACE! WHATATASTE!		
Design Mark	WHATAPLACE! WHATATASTE!		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1998/10/11 First Use In Commerce: 1998/10/11 restaurant services		

U.S. Registration No.	2519854	Application Date	01/02/2001
Registration Date	12/18/2001	Foreign Priority Date	NONE
Word Mark	WHATACOMIX		
Design Mark	WHATACOMIX		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2000/01/01 First Use In Commerce: 2000/01/01 comic books and children's activity books		

U.S. Registration No.	2846139	Application Date	12/06/2002
-----------------------	---------	------------------	------------

Registration Date	05/25/2004	Foreign Priority Date	NONE
Word Mark	WHATABLENDER		
Design Mark	WHATABLENDER		
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2002/09/04 First Use In Commerce: 2002/11/04 milk shake drinks, bases for milk shake drinks and candy flavored toppings therefor		

U.S. Registration No.	3185230	Application Date	01/07/2005
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	WHATASIZE		
Design Mark	WHATASIZE		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 1998/00/00 First Use In Commerce: 1998/00/00 Restaurant services featuring a prepared meal containing french fries and a soft drink for consumption on or off the premises		

U.S. Registration No.	3926573	Application Date	10/23/2009
Registration Date	03/01/2011	Foreign Priority Date	NONE
Word Mark	W WHATABURGER SERVES		
Design Mark			
Description of Mark	The mark consists of a simulated hand painted orange heart with a white Flying "W" and with the stylized letters "WHATABURGER SERVES" in orange.		
Goods/Services	Class 043. First use: First Use: 2009/10/23 First Use In Commerce: 2009/10/23 fast-food restaurants		

U.S. Registration No.	3188132	Application Date	03/31/2005
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	WHATABURGER FIELD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/04/06 First Use In Commerce: 2005/04/06 providing stadium facilities for sporting events, exhibitions, conventions, community festival events and concerts		

U.S. Registration No.	3188136	Application Date	04/01/2005
Registration Date	12/19/2006	Foreign Priority Date	NONE
Word Mark	WHATABURGER FIELD CORPUS CHRISTI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2005/04/06 First Use In Commerce: 2005/04/06 providing stadium facilities for sporting events, exhibitions, conventions, community festival events and concerts		

Attachments	71667794#TMSN.gif (1 page)(bytes) 72291496#TMSN.gif (1 page)(bytes) 72442464#TMSN.gif (1 page)(bytes) 72442465#TMSN.gif (1 page)(bytes) 75674147#TMSN.gif (1 page)(bytes) 76332382#TMSN.gif (1 page)(bytes) 75654525#TMSN.gif (1 page)(bytes)
-------------	---

	75647561#TMSN.gif (1 page)(bytes) 75802439#TMSN.gif (1 page)(bytes) 75698642#TMSN.gif (1 page)(bytes) 76621979#TMSN.gif (1 page)(bytes) 75657290#TMSN.gif (1 page)(bytes) 76188399#TMSN.gif (1 page)(bytes) 76473190#TMSN.jpeg (1 page)(bytes) 76627124#TMSN.gif (1 page)(bytes) 77856341#TMSN.jpeg (1 page)(bytes) 78598999#TMSN.jpeg (1 page)(bytes) 78599894#TMSN.jpeg (1 page)(bytes) noo 007.pdf (8 pages)(1085146 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	/WCL/
Name	Wendy C. Larson
Date	08/16/2011

4. In addition to its extensive use and promotion of the WHATABURGER Mark, Opposer has adopted and used a family of WHATA marks for a variety of goods and services, including restaurant services and clothing. Opposer's WHATA family of marks includes at least the following marks (collectively, the "WHATA Marks"):

Restaurant Services

WHATABURGER
WHATAPLACE! WHATATASTE!
WHATASIZE
WHATAKIDS
WHATAPALS
WHATAGUY
WHATA LOTTA HOT
WHATABURGER SERVES

Other Services

WHATABURGER
WHATASTORE
WHATABURGER SERVES
WHATABURGER FIELD

Food Products

WHATABURGER
WHATABURGER JR.
WHATACHICK'N
WHATA CATCH
WHATABLENDER
WHATAMEAL

Other Products

WHATABURGER
WHATAKIDS
WHATAPALS
WHATAGUY
WHATA COMIX

5. Opposer has widely advertised and promoted its goods and services under the WHATA Marks, and has received significant publicity for such goods and services. Opposer also has established and maintains an official website at www.whataburger.com that makes extensive use of the WHATA Marks.

6. Opposer's WHATA Marks are inherently distinctive, serving to identify and indicate the source of Opposer's goods and services to the consuming public, and to distinguish Opposer's goods and services from those of others.

7. Additionally, as a result of Opposer's use and promotion of its WHATA Marks, the marks have become distinctive and are recognized by consumers. Opposer has invested significant effort and resources in advertising and promoting its WHATA Marks and the goods and

services sold under these marks, with the result that the purchasing public has come to know, rely on, and recognize the goods and services of Opposer by these marks. Opposer has established valuable goodwill in its WHATA Marks.

8. The WHATABURGER Mark is famous pursuant to 15 U.S.C. § 1125.

9. In addition to the strong common law rights Opposer has developed in the WHATA Marks, Opposer is the owner of the following United States Trademark Registrations, among others:

MARK	REG. NO.	INTERNATIONAL CLASS/ GOODS AND SERVICES
WHATABURGER (Stylized)	652,137	030 - Hamburger sandwich
WHATABURGER (Stylized)	891,082	042 - Restaurant services and drive in restaurant services
WHATABURGER (Stylized)	1,011,927	029 - Hamburgers, cheeseburgers, french fried potatoes, fried pies, onion rings, malt and shake beverages, and frankfurter sandwiches 032 - Soft drinks 042 - Restaurant and drive-in restaurant services
WHATABURGER & W and Design 	1,011,928	029 - Hamburgers, cheeseburgers, french fried potatoes, fried pies, onion rings, malt and shake beverages, and frankfurter sandwiches 032 - Soft drinks 042 - Restaurant and drive-in restaurant services
WHATABURGER	2,335,590	042 - Restaurant services
WHATABURGER	2,757,109	036 - Charitable fundraising services
WHATABURGER JR.	1,014,196	029 - Prepared hamburger sandwich for consumption on or off the premises
WHATAMEAL	1,116,918	030 - Prepared meal consisting of a hamburger sandwich, french fries and a beverage for consumption on or off the premises
WHATACATCH	1,206,344	029 - Breaded fish fillets suitable for fish sandwiches 030 - Prepared fish sandwiches for consumption on or off the

		premises
WHATA CHICK'N	2,160,285	030 – Chicken sandwich
WHATA KIDS	2,372,372	025 - Clothing for children, namely, shirts, polo shirts, t-shirts, dresses, overalls, onesies, baseball caps and hats
WHATA KIDS	2,432,191	042 – Restaurant services
WHATA LOTTA HOT	2,424,846	042 – Restaurant services
WHATA GUY	2,418,380	042 – Restaurant services
WHATA PALS	3,376,301	042 – Restaurant services
WHATA PLACE! WHATA TASTE!	2,534,527	042 – Restaurant services
WHATA COMIX	2,519,854	016 - Comic books and children's activity books
WHATA BLENDER	2,846,139	030 - Milk shake drinks, bases for milk shake drinks and candy flavored toppings therefor
WHATA SIZE	3,185,230	043 - Restaurant services featuring a prepared meal containing french fries and a soft drink for consumption on or off the premises
WHATA BURGER SERVES & W and Design 	3,926,573	043 - Fast food restaurants
WHATA BURGER FIELD	3,188,132	041 - Providing stadium facilities for sporting events, exhibitions, conventions, community festival events and concerts
WHATA BURGER FIELD CORPUS CHRISTI & Design 	3,188,136	041 - Providing stadium facilities for sporting events, exhibitions, conventions, community festival events and concerts

Each of the registrations listed in the chart above is valid and subsisting. Further, nearly all of the above registrations have become incontestable pursuant to 15 U.S.C. § 1065.

10. Applicant Franco's Pizza, LLC ("Applicant") is a Georgia limited liability company with a principal business address of 698 Anchorage Avenue, Lawrenceville, GA 30017.

11. Applicant filed Application Serial No. 85/178,487 (the "Application") on a use-in-commerce basis pursuant to 15 U.S.C. § 1051(a) on November 16, 2010 for the mark



FRANCO'S WHATTAPIZZA and Design ("Applicant's Mark") for "T-shirts" in International Class 25 and "Pizza parlors" in International Class 43. In the Application, Applicant alleges that it first used Applicant's Mark for these goods and services in October 2010.

12. Opposer has priority based on its prior use and registration of its WHATA Marks in the United States.

13. Opposer's WHATABURGER Mark became famous long prior to the date Applicant first used or applied to register Applicant's Mark.

14. Applicant's Mark is confusingly similar to Opposer's WHATA Marks.

15. The goods and services covered in the Application directly compete with, or are similar or related to, the goods and services for which Opposer uses and has registered its WHATA Marks.

16. Opposer has not given Applicant permission or approval to use or register Applicant's Mark.

17. Applicant's Mark so resembles Opposer's WHATA Marks as to be likely, when used on or in connection with the identified goods and services in the Application, to cause confusion, or

to cause mistake, or to deceive. Purchasers or prospective purchasers are likely to believe that the goods and services of Applicant sold under Applicant's Mark are sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its marks or goods or services. Registration therefore should be refused under 15 U.S.C. §§ 1052(d) and 1063.

18. Applicant's Mark is likely to cause dilution by blurring of Opposer's famous WHATABURGER Mark, and registration should also be refused under 15 U.S.C. § 1125(c).

19. Registration of Applicant's Mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations and common law and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 85/178,487 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/WHAT:007/WGB, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: 8/16/11



William G. Barber
Wendy C. Larson
PIRKEY BARBER LLP
600 Congress Avenue, Suite 2120
Austin, Texas 78701
(512) 322-5200

Jeff A. McDaniel
Kirby Cronin
DAFFER MCDANIEL LLP
700 Lavaca Street, Suite 720
Austin, Texas 78701
(512) 476-1400
(512) 703-1250 FAX

ATTORNEYS FOR OPPOSER

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail on August 16, 2011 on Applicant:

Franco's Pizza, LLC
1365 Grayson Highway, Suite 104
Lawrenceville, GA 30045-6760


