

ESTTA Tracking number: **ESTTA448399**

Filing date: **12/27/2011**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Cool Cat Cafe LLC
Granted to Date of previous extension	12/31/2011
Address	658 Front Street, Ste. 160 Lahaina, HI 96761 UNITED STATES

Name	Cool Cat Cafe SLO, LLC
Granted to Date of previous extension	12/31/2011
Address	3165 Broad Street #102 San Luis Obispo, CA 93401 UNITED STATES

Attorney information	Seth M. Reiss Seth M Reiss, AAL, ALLLC 3770 Lurline Drive Honolulu, HI 96816 UNITED STATES seth.reiss@lex-ip.com, sethreiss@hawaii.rr.com Phone:808 521-7080
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Applicant Information

Application No	85309097	Publication date	11/01/2011
Opposition Filing Date	12/27/2011	Opposition Period Ends	12/31/2011
Applicant	The Gregory Group 377 Brookside Drive Orangeburg, SC 29115 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Restaurant

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	COOL CAT CAFE		
Goods/Services	restaurant services, clothing and logo items		

Attachments	Notice of Opposition.pdf (8 pages)(162163 bytes)
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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	/seth m reiss/
Name	Seth M. Reiss
Date	12/27/2011

2. Opposer Cool Cat Cafe SLO, LLC and Opposer Cool Cat Cafe LLC are related entities having common ownership. Each operates a theme style restaurant under the mark and brand COOL CAT CAFE and COOL CAT CAFE with Cat in Sunglasses Design.

3. Opposers' predecessor in interest first adopted and began using the word mark COOL CATE CAFE and the composite mark COOL CATE CAFE with Cat in Sunglasses Design (depicted below) in conjunction with the provision restaurant services, in interstate commerce, on or before February, 1993. Opposers, together with their predecessor in interest, have used the word mark COOL CAT CAFE and the composite mark COOL CATE CAFE with Cat in Sunglasses Design in conjunction with the provision of restaurant services, in interstate commerce, continuously since at least February, 1993.

4. Opposer Cool Cat Cafe SLO, LLC has together with its predecessor in interest operated since at least February, 1993 a restaurant in San Luis Obispo, California under the marks and brands COOL CAT CAFE and COOL CATE CAFE with Cat in Sunglasses Design, continuously since at least February, 1993. Opposer Cool Cat Cafe LLC has operated a restaurant in Lahaina, Hawaii under the marks and brands COOL CAT CAFE and COOL CAT CAFE with Cat in Sunglasses Design, continuously since at least August 2002.

5. Opposers have used their COOL CAT CAFE mark and brand and their COOL CAT CAFE with Cat in Sunglasses Design mark and brand on the Internet, in conjunction with the promotion of their quality restaurant services and related goods, since at least June 1998. Opposers have promoted their restaurants services and related goods through a website pointed to by the domain name <coolcatcafe.com> since at least June 1998.

6. Opposers have since at least 1993 sold logo items branded with the COOL CAT CAFE with Cat in Sunglasses Design mark to customers throughout the United States and Canada through the logo item page on its website currently located at http://www.coolcatcafe.com/index.php?option=com_virtuemart&Itemid=6&vmcchk=1&Itemid=

6. Such logo items include clothing, hats, toys, key chains, magnets, bags and gift cards.

7. Opposers' COOL CAT CAFE with Cat in Sunglasses Design branded restaurants have received over 300 favorable reviews received from customers all throughout the United States and Canada the great majority of which were received prior to April 30, 2011, the filing date of the Subject Trademark Application (as defined below).

8. Opposers' use the marks and brands COOL CAT CAFE and COOL CAT CAFE with Cat in Sunglasses Design to distinguish their goods and services from the goods and services of others. Due to their long and continuous use by Opposers, their use with the quality restaurant services provided by Opposers under the marks, and their promotional use on the Internet and with respect to logo items sold worldwide through the Internet, Opposers' COOL CATE CAFE word mark and brand as well as their COOL CATE CAFE with Cat in Sunglasses Design composite mark and brand have become well known and recognizable to customers not only from Hawaii and California but also by visitors to Hawaii and California from other states and other countries. Maui, Hawaii, for example, hosts over two million tourists each year many of whom frequent Opposer Cool Cat CAFE LLC's Lahaina restaurant. The marks and brands COOL CAT CAFE and COOL CAT CAFE with Cat in Sunglasses Design hold great value and goodwill to Opposers therefore.

9. On April 30, 2011, Applicant The Gregory Group filed an application to register the mark COOL CAT CAFE & Cat with Sunglasses Design in international class 043 for restaurant services, said application being designated serial no. 85/309097 (the “Subject Trademark Application”). The Subject Trademark Application is an “intent to use” application filed under Section 1(b) of the Trademark Act. Applicant makes no claim in the context of the application to have ever used the mark, although the website located at <http://www.thecoolcatcafe.com/> suggests that the mark was placed in use by Applicant several months ago. On November 1, 2011, the Subject Trademark Application was published in the Trademark Official Gazette.

10. To the best of Opposers’ knowledge, the current owner of the Subject Trademark Application is The Gregory Group whose address is 377 Brookside Drive, Orangeburg, South Carolina 29115-4505 and whose phone number is 803-928-2778, all as recorded on the trademark application in the records of the Trademark Office. There is no attorney of record that appears in the records of the Subject Trademark Application.

11. As recited in the Subject Trademark Application, Applicant’s identified restaurant services will be the same or closely to Opposers’ restaurant services, and can be expected to be advertised, promoted and/or sold through the same or similar channels of trade and to the same general class of purchasers. In addition, Applicant appears to be using its COOL CATE CAFE & Cat with Sunglasses Design mark in conjunction with the provision of restaurant services according to the information available from its website located at <http://www.thecoolcatcafe.com/>.

12. The design portion of Applicant's COOL CAT CAFE & Cat with Sunglasses

Design mark depicts a cat wearing sunglasses and holding a beverage, together with the words COOL CAT CAFE in a circular frame. The design portion of Opposers' COOL CATE CAFE with Cat in Sunglasses Design mark also depicts a cat wearing sunglasses, holding a burger instead of a beverage, framed together with the words COOL CAT CAFE in a circular frame. Side by side (which is not the test to be used in determining whether two marks are confusingly similar), the parties' respective composite marks appear as follows:

Applicant's COOL CAT CAFE & Cat with Sunglasses Design mark:



Opposers' COOL CATE CAFE with Cat in Sunglasses Design mark in two formats, the original logo which has been used in conjunction with Opposer's restaurant services and logo items since 1993, and a revised logo which has been in continuous use in conjunction with Opposer's restaurant service and logo items since March 2007:

Original Logo:



Revised Logo:



13. Applicant's COOL CAT CAFE & Cat with Sunglasses Design mark is confusingly similar to Opposers' COOL CAT CAFE mark as well as with Opposer's COOL CAT CAFE with Cat in Sunglasses Design mark. The word portions of the parties' respective marks are identical, and the design portions of the parties' respective marks project the same subject matter and general appearance.

14. In addition, the design portion of Applicant's mark does not distinguish Applicant's mark from the word only portion of Opposers' mark sufficiently to avoid likely confusion in the market place. This is so because (1) the word portions of the respective marks are identical and they are being used for identical or very closely related services; (2) the design portion of Applicant's mark is not dominant; and (3) the design portion of Applicant's mark depicts a "Cool Cat", an element already present in Opposers' word mark.

15. Opposers first became aware of Applicant and its COOL CAT CAFE & Cat with Sunglasses Design mark when Opposers received an email from a customer in South Carolina asking if Opposers were opening a restaurant in South Carolina

16. The parties' respective marks, when applied to the same, similar or related good and/or services, have and will continue to cause confusion and mistake and to deceive, with consequent injury to Opposers, the consuming public, and the trade.

17. Opposers have been and expect to continue to be damaged by the registration of Applicant's COOL CAT CAFE & Cat with Sunglasses Design mark because such registration will support and assist Applicant in confusing and misleading the public in relation to Opposers' COOL CATE CAFE and COOL CAT CAFE with Cat in Sunglasses Design mark and restaurants, and will or may give color and exclusive statutory right to Applicant in violation and derogation of the prior and superior right of Opposers as senior user, and by preventing Opposers from obtaining the common law benefits and rights accrued by virtue of Opposers' adoption and long term and continuous use of its COOL CAT CAFE and COOL CAT CAFE with Cat in Sunglasses Design mark and brand.

18. Applicant's COOL CAT CAFE & Cat with Sunglasses Design mark is barred from registration pursuant to Section 2(d) of the Trademark Act, 15 USC § 1052(d).

WHEREFORE, Opposers believe they will be damaged by the registration of the COOL CAT CAFE & Cat with Sunglasses Design mark of application Serial No. 85/309097, and pray that:

1. Judgment in the present opposition be entered in favor of Opposers;
2. The present opposition be sustained; and
3. Registration of application Serial No. 85/309097 be rejected and refused.

DATED: Honolulu, Hawaii, December 27, 2011.

By: /s/ Seth M. Reiss

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CERTIFICATE OF ESTTA FILING

I hereby certify that the foregoing NOTICE OF OPPOSITION is being filed electronically through ESTTA, pursuant to 37 CFR § 2.101(b), together with the appropriate fee for one class of goods/services, paid by credit card authorization, on December 27, 2011.

/s/ Seth M. Reiss

Seth M. Reiss