

ESTTA Tracking number: **ESTTA481292**

Filing date: **07/02/2012**

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

Proceeding	91205303
Party	Defendant Steven D. Gunn DBA JJS Co.
Correspondence Address	STEPHEN L BAKER BAKER AND RANNELLS PA 575 ROUTE 28, STE 102 RARITAN, NJ 08869 UNITED STATES officeactions@br-tmlaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Pei-Lun Chang
Filer's e-mail	p.chang@br-tmlaw.com, r.mcgonigle@br-tmlaw.com, k.hnasko@br-tmlaw.com
Signature	/Pei-Lun Chang/
Date	07/02/2012
Attachments	motion to suspend 7.2.2012.pdf ( 22 pages )(697742 bytes )



Action No. 12-cv-04132-RZ). As demonstrated by Exhibit A hereto, a copy of the Amended Complaint filed in the civil action, the basis of Plaintiff's claim (Opposer herein) sounds in trademark infringement. The Federal Court action involves the same parties, common issues and the same underlying facts. As set forth in paragraphs 8 and 15 of the Amended Complaint, Opposer alleged ownership of the JESSE JAMES marks based on the alleged ownership of the same Federal Registration cited in this opposition. Also, reference to the mark "JESSE JAMES SAUCES" was clearly made in the Amended Complaint and the spirit of the same is clearly directed to Applicant's use of its mark.

37 CFR § 2.117 (a) provides that "[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding."

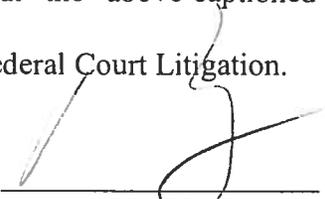
Clearly, given the Amended Complaint filed in the civil action, Opposer herein recognizes that the pending district court litigation may have bearing on the above-captioned opposition proceeding. Further, the Amended Complaint in the District Court seeks to enjoin the entirety of the trademark in issue in this proceeding, namely JESSE JAMES SAUCES.

The District Court proceeding and the TTAB proceeding will involve the same parties, common issues and the same underlying facts. If the district court enjoins Applicant's use of its trademark in its entirety, Applicant will be unable to maintain the application which is the subject of the instant opposition.

WHEREFORE, Applicant requests that the above-captioned opposition be suspended pending disposition of the pending Federal Court Litigation.

Dated: July 2, 2012

By:



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Ryan A. McGonigle  
Pei-Lun Chang  
BAKER and RANNELLS, PA  
575 Route 28, Suite 102  
Raritan, New Jersey 08869  
(908) 722-5640  
[r.mcgonigle@br-tmlaw.com](mailto:r.mcgonigle@br-tmlaw.com)  
[p.chang@br-tmlaw.com](mailto:p.chang@br-tmlaw.com)  
Attorney for Applicant  
Steven Gunn

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant's **MOTION TO SUSPEND PROCEEDING PENDING DISPOSITION OF AN ACTION PENDING IN THE FEDERAL DISTRICT COURT FOR THE CENTRAL DISTRICT OF CALIFORNIA** was forwarded by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this July 2, 2012, to the attorney for the Opposer at the following address:

Joseph A. Mandour III, Esq.  
Gordan E. Gray  
BEN T. LILA  
Mandour & Associates, APC  
16870 West Bernardo Drive, Suite 400  
San Diego, CA 92127  
Telephone: (858)487-9300  
Facsimile: (858)487-9390  
[Blila@Mandourlaw.com](mailto:Blila@Mandourlaw.com)



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Ryan A. McGonigle  
Pei-Lun Chang

# Exhibit A

1 JOSEPH A. MANDOUR, III (SBN 188896)  
2 BEN T. LILA (SBN 246808)  
3 MANDOUR & ASSOCIATES, APC  
4 16870 West Bernardo Drive, Suite 400  
5 San Diego, CA 92127  
6 Telephone: (858) 487-9300  
7 Facsimile: (858) 487-9390  
8 jmandour@mandourlaw.com

9 Attorneys for plaintiff,  
10 AMERICAN OUTLAW SPIRITS, INC.

2012 MAY 21 PM 12:43  
CLERK U.S. DISTRICT COURT  
CENTRAL DIST. OF CALIF.  
LOS ANGELES  
BY 

FILED

11 UNITED STATES DISTRICT COURT  
12 CENTRAL DISTRICT OF CALIFORNIA

13 AMERICAN OUTLAW SPIRITS, INC., a	)	Civil Case No. CV 12-04132-RZ
14 Georgia Corporation,	)	
15 Plaintiff,	)	<b>FIRST AMENDED COMPLAINT FOR</b>
16 v.	)	<b>TRADEMARK INFRINGEMENT,</b>
17 STEVEN GUNN, an individual,	)	<b>FALSE DESIGNATION OF ORIGIN</b>
18 Defendant.	)	<b>AND OTHER RELIEF</b>
19	)	<b>DEMAND FOR JURY TRIAL</b>
20	)	

21 Plaintiff AMERICAN OUTLAW SPIRITS, INC. (hereinafter "plaintiff" or "AOS"), by  
22 and through its counsel, alleges against defendant STEVEN GUNN hereinafter ("defendant" or  
23 "Gunn") as follows:

24 **NATURE OF THE ACTION**

25 1. This is an action for trademark infringement and false designation of origin  
26 under the Lanham Act 15 U.S.C. § 1051, *et seq.* and unfair competition under state law and  
27 common law.

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Civil Case No. CV 12-04132-RZ  
FIRST AMENDED COMPLAINT FOR TRADEMARK INFRINGEMENT, FALSE DESIGNATION OF ORIGIN  
AND OTHER RELIEF; DEMAND FOR JURY TRIAL

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**THE PARTIES**

2. Plaintiff American Outlaw Spirits, Inc. is a Georgia corporation with a principal place of business in Kennesaw, Georgia.

3. On information and belief, defendant STEVEN GUNN ("Gunn") is or at all relevant times was an individual residing in the state of Texas at: 232 Pope Bend Rd S., Cedar Creek, TX 78612.

**JURISDICTION AND VENUE**

4. This Court has subject matter jurisdiction over this lawsuit under 28 U.S.C. § 1338 because the action arises under the trademark laws of the United States, and pendant jurisdiction of any and all state causes of action under 28 U.S.C. § 1367.

5. This Court has personal jurisdiction over defendant because defendant has transacted business in the Central District of California. Further, on information and belief, the defendant systematically and continuously directs business activities toward and into the Central District of California. Namely, defendant Gunn sells its products on the publically accessible website JesseJamesSauces.com. Moreover, defendant has or intends to soon market its products throughout California. Attached hereto as **Exhibit A** are materials from Rizor Foods of Vina, CA indicating that defendant seeks to sell its "Jesse James Sauces" product "throughout California."

6. Venue is proper and reasonable in this district under 28 U.S.C. § 1391(b)(2) because a substantial part of the events or omissions giving rise to this claim for false designation of origin and unfair competition occurred in this district and defendant has significant contacts with the district.

**FACTS**

7. AOS is a Georgia corporation operating in the beer and spirits industry with a principal place of business at: 1480 Old Highway 41 NW, Kennesaw, GA 30152.

8. AOS is the owner of the JESSE JAMES trademark. AOS holds all rights to enforce the JESSE JAMES trademark which is the subject of U.S. Trademark Registration No. 3,355,112. A copy of said trademark registration is attached here to as **Exhibit B**. AOS sells

1 beer, whiskey and clothing products using the JESSE JAMES trademark. Exemplary images of  
2 the JESSE JAMES trademark as used in commerce are attached hereto as **Exhibit C**. AOS and  
3 its predecessors in interest began using the JESSE JAMES trademark in commerce as a source  
4 designator at least as early as 2006. As such, they have established priority of use.

5 9. The JESSE JAMES trademark is inherently distinctive and recognized by the  
6 relevant consuming public as plaintiff's marks. Exemplary image of the plaintiff's products  
7 comprising the JESSE JAMES trademark is attached hereto as **Exhibit D**.

8 10. Defendant Steven Gunn also operates in the spirits industry and sells sauces,  
9 cocktail mixers and beef jerky products.

10 11. Sometime after AOS's JESSE JAMES trademark became well known, Gunn  
11 adopted a confusingly similar trademark for its bourbon whiskey product under the name  
12 JESSE JAMES BOURBON WHISKEY. Gunn further adopted the trademark JESSE JAMES  
13 for sauces, cocktail mixers and beef jerky products after plaintiff's earliest date of first use. An  
14 exemplary photo of Gunn's products that infringe the JESSE JAMES trademark is attached  
15 hereto as **Exhibit E**.

16 12. On July 31, 2008, Gunn filed U.S. Trademark Application Serial No. 77/535,750  
17 with the USPTO for the mark JESSE JAMES STEAK SAUCE in international class 030 for  
18 "Condiment, namely, pepper sauce" and alleging a date of first use in commerce of February 1,  
19 2009.

20 13. On August 15, 2009, Gunn filed U.S. Trademark Application Serial No.  
21 77/805,433 with the USPTO for the mark JESSE JAMES BEEF JERKY in international class  
22 029 for "Meat-based snack foods" and alleging a date of first use in commerce of February 11,  
23 2010.

24 14. On August 17, 2009, Gunn filed U.S. Trademark Application Serial No.  
25 77/806,420 with the USPTO for the mark JESSE JAMES BLOODY MARY MIX in  
26 international class 030 for "Sauce mixes" on an intent-to-use basis.

27 15. On March 3, 2010, Gunn filed U.S. Trademark Application Serial No.  
28 77/949,206 with the USPTO for the mark JESSE JAMES SAUCES in international class 030

1 for "Barbeque sauce; Chili sauce; Dipping sauces; Sauces; Sauces for barbecued meat; Steak  
2 sauce; Worcestershire sauce" and alleging a date of first use in commerce of March 25, 2009.

3 16. On July 25, 2011, Gunn filed U.S. Trademark Application Serial No.  
4 85/379,698 with the USPTO for the mark JESSE JAMES BOURBON WHISKEY in  
5 international class 033 for "whiskey" and alleging a date of first use in commerce of February  
6 14, 2011.

7 17. Both plaintiff's and Gunn's respective products are likely to appear in the same  
8 types of stores, are marketed, distributed and sold in the same channels of commerce and are  
9 sold to nearly identical consumers.

10 18. Defendant's unlawful use of the JESSE JAMES BOURBON WHISKEY  
11 trademark is likely to cause confusion amongst consumers and initial interest confusion as to the  
12 origin of their respective products and services. Consumers are likely to be misled that Gunn's  
13 products are licensed by, sponsored by or otherwise affiliated with AOS.

14 19. On information and belief, defendant has adopted the designation JESSE JAMES  
15 in a willful attempt to piggyback off of plaintiff's goodwill and reputation and to divert business  
16 away from plaintiff and to defendant.

17 20. Additionally, defendant is likely to cause reverse confusion amongst consumers,  
18 namely consumers may falsely believe that plaintiff is the junior user of the JESSE JAMES  
19 trademark.

20 21. Plaintiff has been irreparably harmed and has suffered economic loss as well as  
21 the loss of goodwill from defendant's unlawful and willful acts. Because damages will  
22 constitute an insufficient remedy, plaintiff requires equitable relief in the form of a permanent  
23 injunction restraining defendant's continued activity regarding the AOS source designation.

24 22. The JESSE JAMES trademark is a strong, fanciful and inherently distinctive  
25 trademark and a source identifier for plaintiff. The JESSE JAMES trademark is well known to  
26 consumers as being associated with plaintiff and has developed secondary meaning.

27 ///

28 ///

1 **CLAIMS FOR RELIEF**

2 **First Claim for Relief**

3 **(False Designation of Origin and Trademark Infringement under the Lanham Act)**

4 23. Plaintiff repeats and incorporates by reference the statements and allegations in  
5 paragraphs 1 to 22 of the Complaint as though fully set forth herein.

6 24. Defendant's unauthorized use of the JESSE JAMES and JESSE JAMES  
7 BOURBON WHISKEY trademarks causes a likelihood of confusion among consumers and  
8 falsely indicates to consumers that defendant's goods and services originate from, are approved  
9 by, are sponsored by, are licensed by, or are affiliated with plaintiff or plaintiff's goods and  
10 services.

11 25. Defendant's unauthorized use of the JESSE JAMES and JESSE JAMES  
12 BOURBON WHISKEY trademarks as described herein is likely to cause confusion, to cause  
13 mistake, or to deceive customers and potential customers of the parties by suggesting some  
14 affiliation, connection, or association of defendant with plaintiff. On information and belief,  
15 defendant intentionally induced, caused, or materially contributed to others infringing the  
16 JESSE JAMES trademark or continued to produce or distribute a product knowing or having  
17 reason to know the product infringed plaintiff's JESSE JAMES trademark. Further on  
18 information and belief, defendant had the right, authority, and ability to control others infringing  
19 JESSE JAMES trademark and received a financial benefit of the infringement.

20 26. Defendant's actions, as set forth herein, constitute false designation of origin and  
21 trademark infringement in violation of the Lanham Act, 15 U.S.C. §§ 1114, 1125 and related  
22 sections and are deliberate, willful infringement, egregious in nature with blatant and callous  
23 disregard for the rights of plaintiff.

24 **Second Claim for Relief**

25 **(State Law Unfair Competition)**

26 27. Plaintiff repeats and incorporates by reference the statements and allegations in  
27 paragraphs 1 to 26 of the Complaint as though fully set forth herein.

28 28. Defendant's acts, as set forth above, constitute unfair competition as defined in

1 California Business and Professions Code § 17200, *et seq.*, all to the damage of plaintiff as  
2 previously alleged.

3 **Third Claim for Relief**

4 **(Common Law Unfair Competition)**

5 29. Plaintiff repeats and incorporates by reference the statements and allegations in  
6 paragraphs 1 to 28 of the Complaint as though fully set forth herein.

7 30. Defendant's acts, as set forth above, constitute unfair competition as defined  
8 under California common law, all to the damage of plaintiff as previously alleged.

9 **Fourth Claim for Relief**

10 **(Denial of Trademark Applications and/or Cancellation of Trademark Registrations**

11 **pursuant to 15 U.S.C. § 1119)**

12 31. Plaintiff repeats and incorporates by reference the statements and allegations in  
13 paragraphs 1 to 30 of the Complaint as though fully set forth herein.

14 32. Gunn's United States Trademark Serial Numbers 85/379,698, 77/949,206,  
15 77/806,420, 77/805,433 and 77/535,750 constitute trademarks that are confusingly similar to  
16 plaintiff's senior trademark use of JESSE JAMES.

17 33. For the reasons stated herein, plaintiff requests the Court order that United States  
18 Trademark Serial Numbers 85/379,698, 77/949,206, 77/806,420, 77/80,5433 and 77/535,750  
19 be denied registration for violation of 15 U.S.C. § 1051, *et seq.* pursuant to 15 U.S.C. § 1119.

20  
21 **PRAYER FOR RELIEF**

22 WHEREFORE, Plaintiff asks that this Court grant judgment against defendant for the  
23 following:

24 A. Defendant, its officers, agents, servants, employees, and attorneys, and all  
25 persons in active concert or participation with any of them, be temporarily restrained, and  
26 preliminarily and permanently enjoined from their continuing wrongful acts, including but not  
27 limited to the following:

28 i. Using the JESSE JAMES trademark or any other confusingly similar

1 designation, in connection with any products.

2 ii. Competing unfairly with plaintiff in any manner, including unlawfully  
3 adopting or infringing on JESSE JAMES trademark or adopting or using any other  
4 marks or designations that are confusingly similar to the JESSE JAMES trademark.

5 iii. Conspiring with, aiding, assisting, or abetting any other person or entity  
6 in engaging in or performing any of the activities referred to in subparagraphs (i) and (ii)  
7 above.

8 B. Defendant, its officers, agents, servants, employees, and attorneys, and all  
9 persons in active concert or participation with any of them, deliver for destruction, or show  
10 proof of destruction of, any and all products, labels, signs, prints, packages, wrappers,  
11 receptacles, and advertisements, and any other materials in their possession or control that  
12 depict or reference the JESSE JAMES trademark or any other confusingly or substantially  
13 similar trademark, and any materials or articles used for making or reproducing the same, as  
14 provided by 15 U.S.C. § 1118.

15 C. Defendant file with the court and serve on plaintiff, within 30 days after the entry  
16 and service on defendant of an injunction, a report in writing and attested to under penalty of  
17 perjury setting forth in detail the manner and form in which defendant has complied with the  
18 provisions of subparagraphs (A) and (B) above.

19 D. United States Trademark Application Serial Numbers 85/379,698, 77/949,206,  
20 77/806,420, 77/80,5433 and 77/535,750 be denied registration and/or registrations cancelled.

21 E. Plaintiff recover all damages it has sustained as a result of defendant's acts and  
22 omissions.

23 F. An accounting be directed to determine defendant's profits resulting from their  
24 acts and omissions, and that the profits be paid over to plaintiff, increased as the court  
25 determines is appropriate to the circumstances of this case.

26 G. The Court declare this case an exceptional case and award plaintiff its reasonable  
27 attorneys' fees for prosecuting this action.

28 H. Plaintiff be awarded enhanced damages to the full extent allowed by law.

1 I. Plaintiff be awarded punitive damages pursuant to California common law,  
2 Business and Professions Code § 14250, or any other relevant statute.

3 J. Plaintiff receive all other relief the court deems appropriate.

4 K. Plaintiff recover its costs of this action and pre-judgment and post-judgment  
5 interest to the full extent allowed by law.

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7

**DEMAND FOR JURY TRIAL**

8 Plaintiff hereby demands a trial by the jury on its claims herein and all issues and claims  
9 so triable in this action.

10

Respectfully submitted,

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Dated: May 21, 2012

MANDOUR & ASSOCIATES, APC

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13

/s/ Ben T. Lila

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Ben T. Lila (SBN 246808)

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blila@mandourlaw.com

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Attorneys for plaintiff,

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AMERICAN OUTLAW SPIRITS, INC.

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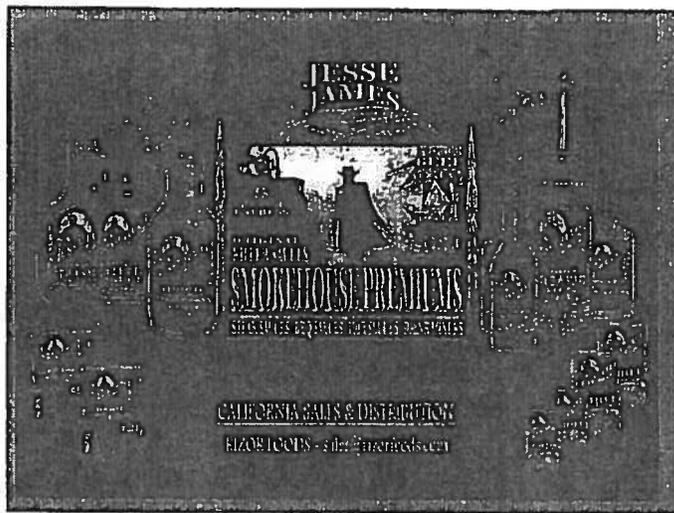
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**EXHIBIT A**



**INDEPENDENT DISTRIBUTOR'S NEEDED / GROUND FLOOR OPPORTUNITY! - VINA, CA 95092**

Posted in Category: Jobs  
Position: Employment (N/A)  
Contact Name: Tony Medina  
Detailed Email: [jobs@franchise.com](mailto:jobs@franchise.com)  
Website: <http://www.franchise.com>  
Location: VINA, CA 95092 ( View Map )  
Date Posted: March 23rd, 2012  
Expires: 04/11/12

More Details:

**INDEPENDENT DISTRIBUTOR'S NEEDED / GROUND FLOOR OPPORTUNITY!**

(CALIFORNIA ALL AREAS)

Looking for Independent Distributors throughout California for a brand new premium sauce brand that is second to none in quality, flavor and has the very well known brand name of JESSE JAMES SAUCES. We are looking for independent distributors that are highly motivated and are experienced in wholesale food distribution within the grocery industry. This is a true in a lifetime opportunity to get in on the ground floor as a distributor and wholesaler, and potentially if you are the right candidate you could become the exclusive broker for the entire State of California where this candidate could secure their profit margins!

Our initial product line consists of Premium BBQ Sauce, a Full line of Premium BBQ Sauces, a Full line of Premium Hot Sauces, premium flavors of Premium Dry Rubs, and a line of Premium Carrots that has won many awards as the Best Chef in the USA! In addition to these products, our brand is continuing to expand into additional categories with the same well known brand name.

In order to qualify for this opportunity, you must either have a hot kitchen or hot winter and at least 2 years experience with sales and distribution to grocery markets as well as e-commerce and food service. DBO experience and an Established Order/Contract portfolio is also a plus. While our corporate offices will obtain these for you in the future for our distributors, you will also be required to conduct grocery routes in your assigned/protected territory to introduce our premium sauces and products in order to increase your territory sales volume, which will also increase your income.

**Qualifications include:**

- Strong product knowledge of the California Wholesale Grocery Industry
- Must be capable of building and maintaining relationships through excellent customer service.
- Demonstrate the ability to successfully manage a territory, your own territory, with little or no supervision.
- Highly motivated, results driven with an entrepreneurial attitude & problem-solving skills since you will need to manage your account base and be able to work in the competitive grocery industry.
- Good experience selling and marketing sauces or other similar grocery products. Established clientele portfolio a major plus.
- Excellent financial and business acumen.
- Must have your own reliable transportation for acquisition, a clean driving record and the ability to provide excellent customer service.

If you are interested in learning more about this career opportunity, please email us your resume, references and a list of references (including the grocery retailers that you have had experience with) to [jobs@franchise.com](mailto:jobs@franchise.com). If we feel like you have what we are looking for we will contact you to schedule a convenient time to talk.

Thank you for your consideration in our Independent Distribution Opportunity! We look forward to hearing from you in the near future!



Click image to view full sized

Keywords: Independent Distributor, Distributor, Route Sales, DBO, Grocery, Retailer, Food

**EXHIBIT B**

Int. Cl.: 32

Prior U.S. Cls.: 45, 46 and 48

United States Patent and Trademark Office

Reg. No. 3,355,112

Registered Dec. 18, 2007

TRADEMARK  
PRINCIPAL REGISTER

JESSE JAMES

BIG BALLS BREWING, LLC (FLORIDA LTD  
LIAB CO)  
480 OLD HIGHWAY 41 NW  
KELNLEAW, GA 30132

FOR: BEER, IN CLASS 32 (U.S. CLS. 45, 46 AND 48)

FIRST USE 8-1-2006; IN COMMERCE 8-1-2006.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

"THE NAME(S), PORTRAIT(S), AND/OR SIGNA-  
TURE(S) SHOWN IN THE MARK IDENTIFIES  
JESSE JAMES DUPRE, WHOSE CONSENT(S) TO  
REGISTER IS SUBMITTED."

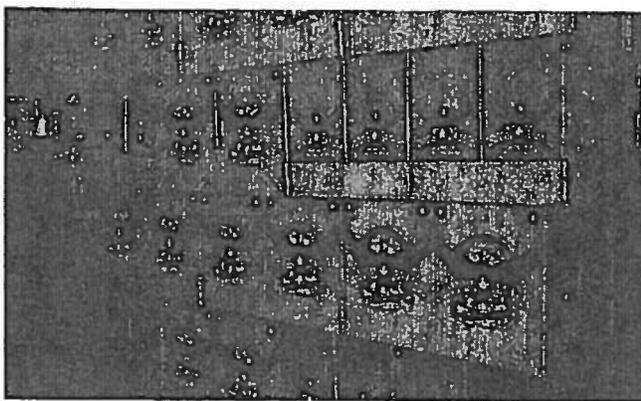
SER. NO. 77-089,513, FILED 2-5-2007.

KEVIN CORWIN, EXAMINING ATTORNEY

**EXHIBIT C**



**EXHIBIT D**



**EXHIBIT E**

**EXHIBIT E**

