

ESTTA Tracking number: **ESTTA479080**

Filing date: **06/20/2012**

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	Cheeseburger Restaurants, Inc. and Cheeseburger In Paradise, Inc.		
Entity	Corporation	Citizenship	California
Address	73875 Highway 70 Portola, CA 96122 UNITED STATES		

Attorney information	Steven J. Nataupsky Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@kmob.com Phone:949-760-0404		
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Applicant Information

Application No	85499539	Publication date	05/22/2012
Opposition Filing Date	06/20/2012	Opposition Period Ends	06/21/2012
Applicant	Barron, Ellington 13002 Weiss Drive Bowie, MD 20715 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Hats; Jackets; Jeans; Scarves; Shoes; Sweaters; T-shirts; Wristbands

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.	1765057	Application Date	08/30/1991
Registration Date	04/13/1993	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER IN PARADISE		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/10/25 First Use In Commerce: 1989/10/25 restaurant and bar services		

U.S. Registration No.	2951966	Application Date	11/02/1999
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1989/10/25 First Use In Commerce: 1989/10/25 HEADWEAR; [FOOTWEAR;] AND CLOTHING, NAMELY, CAPS, SHIRTS, T-SHIRTS, TANKTOPS, [BLOUSES, JACKETS, COATS, SWEATERS,] SWEATSHIRTS, [SHORTS, PANTS, BEACHWEAR, SWIMWEAR, SWIMSUITS, PAREOS, CAPS,] VISORS, AND HATS		

U.S. Registration No.	2795196	Application Date	11/02/1999
Registration Date	12/16/2003	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 021. First use: First Use: 1990/02/01 First Use In Commerce: 1990/02/01 [HOUSEHOLD UTENSILS, NAMELY, POTS, FRYING PANS, SPATULAS, SERVING SPOONS, AND MIXING SPOONS; CONTAINERS FOR HOUSEHOLD OR KITCHEN USE; TRIVETS; COASTERS NOT OF PAPER OR TABLE LINEN; DISHES;] BEVERAGE GLASSWARE; [WATER BOTTLES SOLD EMPTY;] AND MUGS</p> <p>Class 026. First use: First Use: 1990/02/01 First Use In Commerce: 1990/02/01 [PROMOTIONAL MERCHANDISE, NAMELY, ORNAMENTAL NOVELTY PINS, ORNAMENTAL NOVELTY BUTTONS]</p>		

U.S. Registration No.	2810903	Application Date	11/02/1999
Registration Date	02/03/2004	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1990/02/01 First Use In Commerce: 1990/02/01 RESTAURANT AND BAR SERVICES		

U.S. Registration No.	2418610	Application Date	09/15/1998
Registration Date	01/09/2001	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER IN PARADISE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/10/25 First Use In Commerce: 1989/10/25 RESTAURANT AND BAR SERVICES		

U.S. Registration No.	2950754	Application Date	11/13/1997
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	CHEESEBURGER IN PARADISE IS A STATE OF MIND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/00/00 First Use In Commerce: 1991/00/00 RESTAURANT AND BAR SERVICES		

Attachments	74199369#TMSN.gif (1 page)(bytes) 75981924#TMSN.gif (1 page)(bytes) 75981923#TMSN.gif (1 page)(bytes) 75838294#TMSN.gif (1 page)(bytes) 75553386#TMSN.gif (1 page)(bytes) 2012-06-20 Notice of Opposition-CHSBRGR.081M.PDF (7 pages)(239310 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	/Steven J. Nataupsky/
Name	Steven J. Nataupsky
Date	06/20/2012



Mark:
Serial No.: 85/499,539
Filing Date: December 20, 2011
Publication Date: May 22, 2012
Services: Hats; Jackets; Jeans; Scarves; Shoes; Sweaters; T-shirts; Wristbands, in International Class 25

As grounds for opposition, it is alleged:

1. Since at least as early as 1989, Opposer has used a family of names and marks containing the term PARADISE and/or a Palm Tree Logo, including the marks set forth in Paragraphs 2 through 7 below (collectively, the "CHEESE BURGER Marks").

2. Opposer is the owner of and relies on U.S. Trademark Registration No. 1,765,057



(the "'057 Registration") for the mark CHEESE BURGER for "restaurant and bar services" in International Class 42. The '057 Registration was filed on August 30, 1991 and issued on April 13, 1993. Thus, both the filing date and date of registration of the '057 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the



CHEESE BURGER mark shown in the '057 Registration is incontestable.

3. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,951,966



(the "'966 Registration") for the mark CHEESE BURGER for "headwear; and clothing, namely, caps, shirts, t-shirts, tanktops, sweatshirts, visors, and hats" in International Class

25. The '966 Registration was filed on November 2, 1999 and issued on May 17, 2005. Thus, both the filing date and date of registration of the '966 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15

U.S.C. § 1065, Opposer's right to use the CHEESE  BURGER mark shown in the '966 Registration is incontestable.

4. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,795,196

(the "'196 Registration") for the mark CHEESE  BURGER for "beverage glassware; and mugs" in International Class 21. The '196 Registration was filed on November 2, 1999 and issued on December 16, 2003. Thus, both the filing date and date of registration of the '196 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the

CHEESE  BURGER mark shown in the '196 Registration is incontestable.

5. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,810,903

(the "'903 Registration") for the mark CHEESE  BURGER for "restaurant and bar services" in International Class 42. The '903 Registration was filed on November 2, 1999 and issued on February 3, 2004. Thus, both the filing date and date of registration of the '903 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the

CHEESE  BURGER mark shown in the '903 Registration is incontestable.

6. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,418,610 (the "'610 Registration") for the mark **CHEESE BURGER IN PARADISE** for "restaurant and bar

services” in International Class 42. The ’610 Registration was filed on September 15, 1998 and issued on January 9, 2001. Thus, both the filing date and date of registration of the ’610 Registration are prior to the filing date and alleged first use date of Applicant’s Application. By virtue of Opposer’s compliance with the provisions of 15 U.S.C. § 1065, Opposer’s right to use the **CHEESE BURGER IN PARADISE** mark shown in the ’610 Registration is incontestable.

7. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,950,754 (the “’754 Registration”) for the mark **CHEESEBURGER IN PARADISE IS A STATE OF MIND** for “restaurant and bar services” in Class 42. The ’754 Registration was filed on November 13, 1997 and issued on May 17, 2005. Thus, both the filing date and date of registration of the ’754 Registration are prior to the filing date and alleged first use date of Applicant’s Application.

8. The ’057, ’966, ’196, ’903, ’610, and ’754 Registrations are valid, subsisting, unrevoked and uncanceled; as such they constitute prima facie evidence of the validity of the registered marks and of the registrations thereof, and of Opposer’s ownership of the marks shown therein and Opposer’s exclusive right to use the marks in commerce in connection with the goods and services named therein, without condition or limitation. The ’057, ’966, ’196, ’903, ’610, and ’754 Registrations also constitute notice to Applicant of Opposer’s claim of ownership of the marks shown therein; all as provided in Section 7(b), 22 and 33(a) of the Trademark Act of 1946, as amended.

9. In view of the substantial similarity of the respective marks and the related nature of the goods and services of the respective parties Applicant’s mark so resembles the registered **CHEESE BURGER** Marks, previously used and registered in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive.

10. If Applicant is permitted to register the mark shown in Applicant’s Application,



Applicant's corresponding prima facie exclusive right to use the mark in nationwide commerce will conflict with Opposer's lawful and prima facie exclusive right to use the CHEESE BURGER Marks nationwide.

11. Since a date well prior to the filing date of Applicant's Application, Opposer has used the CHEESE BURGER Marks in connection with the provision and advertisement of Opposer's goods and services, including, but not limited to clothing items. Such use has been valid and continuous, and has not been abandoned. As a result of this use, the relevant class of the public has come to associate Opposer with the family of CHEESE BURGER Marks.

12. By reason of Opposer's widespread and continuous use of the CHEESE BURGER Marks, in addition to the protection afforded to Opposer by the '057, '966, '196, '903, '610, 'and '754 Registrations, Opposer has extensive, non-registered statutory and common law rights in the CHEESE BURGER Marks.

13. In view of Opposer's prior statutory and common law rights in the CHEESE BURGER



Marks, Applicant is not entitled to register the mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Applicant's use and registration of the mark in U.S. Trademark Application Serial No. 85/499,539 causes, and will continue to cause, dilution of the distinctive quality of the

CHEESE BURGER Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c), and will lessen the ability of the CHEESE BURGER Marks to distinguish the goods and services of Opposer.

15. By reason of the foregoing, Opposer will be gravely damaged by registration of the mark shown in Applicant's Application because registration of this mark would be in violation of Opposer's trademark and trade name rights.

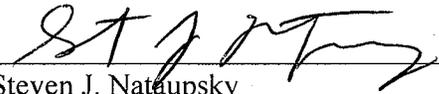
WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 85/499,539 be rejected and stricken, that no registration be issued thereon to Applicant, and this opposition be sustained in favor of Opposer.

Please charge Deposit Account No. 11-1410 for any fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 20, 2012

By: 

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 20, 2012, addressed as follows:

ELLINGTON BARRON
13002 WEISS DR
BOWIE, MD 20715-1338


Amber Molle

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