

ESTTA Tracking number: **ESTTA484555**

Filing date: **07/20/2012**

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	LFP IP, LLC
Granted to Date of previous extension	07/28/2012
Address	8484 Wilshire Boulevard, Suite 900 Beverly Hills, CA 90211 UNITED STATES

Attorney information	Jonathan W. Brown Lipsitz Green Scime Cambria LLP 42 Delaware Avenue, Suite 120 Buffalo, NY 14202 UNITED STATES ip@lglaw.com Phone:716-849-1333, Ext. 371
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Applicant Information

Application No	85505221	Publication date	05/29/2012
Opposition Filing Date	07/20/2012	Opposition Period Ends	07/28/2012
Applicant	Sanders, Timothy Stephen 5994 Milam Dr Sw Mableton, GA 30126 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Caps; T-shirts

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
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.	2689852	Application Date	10/16/2000
Registration Date	02/25/2003	Foreign Priority Date	NONE

Word Mark	HUSTLER
Design Mark	HUSTLER
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/12/03 First Use In Commerce: 1998/12/03 clothing, namely, beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits, jumpers, leg warmers, leggings, lingerie, lounge wear, neckwear, pants, scarves, shirts, ski wear, slacks, sleep wear, tank tops, socks, vests

U.S. Registration No.	2001594	Application Date	11/03/1995
Registration Date	09/17/1996	Foreign Priority Date	NONE
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1993/12/31 First Use In Commerce: 1993/12/31 providing a computer on-line magazine relating to adult entertainment and adult subject matter		

U.S. Registration No.	2679483	Application Date	10/16/2000
Registration Date	01/28/2003	Foreign Priority Date	NONE
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1999/09/20 First Use In Commerce: 1999/09/20 men's and women's jewelry, namely, rings, necklaces, bracelets, watches Class 021. First use: First Use: 2000/10/01 First Use In Commerce: 2000/10/01 glassware, namely, shot glasses, mugs, beer steins		

U.S. Registration No.	3149102	Application Date	03/11/2003
Registration Date	09/26/2006	Foreign Priority Date	NONE
Word Mark	HUSTLER		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2006/06/10 First Use In Commerce: 2006/06/10 footwear, namely, all types of shoes, boots, slippers, thongs and socks

U.S. Registration No.	3166771	Application Date	08/09/2005
Registration Date	10/31/2006	Foreign Priority Date	NONE
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 026. First use: First Use: 2004/04/30 First Use In Commerce: 2004/04/30 (Based on Use in Commerce) Men's and women's belt buckles not of precious metal Class 034. First use: First Use: 2005/10/28 First Use In Commerce: 2005/10/28 Cigarette lighters not of precious metal		

U.S. Registration No.	3918404	Application Date	07/13/2007
Registration Date	02/15/2011	Foreign Priority Date	NONE
Word Mark	HUSTLER		

Design Mark	HUSTLER
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2008/01/31 First Use In Commerce: 2008/01/31 Motorcycle helmets

U.S. Registration No.	2453938	Application Date	06/22/1999
Registration Date	05/22/2001	Foreign Priority Date	NONE
Word Mark	HUSTLER XXX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/04/04 First Use In Commerce: 2000/04/04 pre-recorded [video tapes and] discs in the field of adult entertainment		

U.S. Registration No.	2448315	Application Date	05/20/1999
Registration Date	05/01/2001	Foreign Priority Date	NONE
Word Mark	HUSTLER XXX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/09/21 First Use In Commerce: 1999/09/21 publications, namely, an adult entertainment magazine		

U.S. Registration No.	2716466	Application Date	10/17/2001
Registration Date	05/13/2003	Foreign Priority	NONE

		Date	
Word Mark	HUSTLER XXX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2002/12/04 First Use In Commerce: 2002/12/04 providing on-line entertainment, photographs, images, education, information and editorial content via the internet, World Wide Web and other electronic and telecommunications transmission systems, miscellaneous computer services and all other services in the field of adult entertainment		

U.S. Registration No.	3658478	Application Date	10/19/2006
Registration Date	07/21/2009	Foreign Priority Date	NONE
Word Mark	NATURAL BORN HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/05/13 First Use In Commerce: 2003/05/13 Clothing, namely, work shirts, men's and women's jackets, sweatshirts, hats		

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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	/Jonathan W. Brown/
Name	Jonathan W. Brown
Date	07/20/2012

As grounds for opposition, LFP alleges:

1. Opposer LFP is the owner of the famous HUSTLER brand used in connection with various goods and services. LFP is the owner of, is currently using, and has itself and through its licensees and predecessors-in-interest, continuously used in U.S. commerce for approximately 40 years the famous HUSTLER mark.

2. Opposer owns numerous federal registrations on the Principal Register for its HUSTLER and various related and composite marks, including HUSTLER XXX and without limitation the following, many of which have become incontestable within the meaning of the Lanham Act:

Trademark	Reg. No.	First Use	Goods or Services
HUSTLER	2689852	1998	clothing, namely, beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits, jumpers, leg warmers, leggings, lingerie, lounge wear, neckwear, pants, scarves, shirts, ski wear, slacks, sleep wear, tank tops, socks, vests
HUSTLER	2001594	1993	providing a computer on-line magazine relating to adult entertainment and adult subject matter
HUSTLER	2679483	1999 2000	men's and women's jewelry, namely, rings, necklaces, bracelets, watches; and glassware, namely, shot glasses, mugs, beer steins
HUSTLER	3149102	2006	footwear, namely, all types of shoes, boots, slippers, thongs and socks
HUSTLER	3166771	2004	cigarette lighters not of precious metal
HUSTLER	3918404	2008	motorcycle helmets
HUSTLER XXX	2453938	2000	pre-recorded [video tapes and] discs in the field of adult entertainment
HUSTLER XXX	2448315	1999	publications, namely, an adult entertainment magazine

HUSTLER XXX	2716466	2002	providing on-line entertainment, photographs, images, education, information and editorial content via the internet, World Wide Web and other electronic and telecommunications transmission systems, miscellaneous computer services and all other services in the field of adult entertainment
NATURAL BORN HUSTLER	3658478	2003	clothing, namely, work shirts, men's and women's jackets, sweatshirts, hats

3. LFP's marks referred to hereinabove will be collectively referred to as the "HUSTLER Marks" or "LFP's Marks."

4. Opposer and its predecessors-in-interest have expended substantial amounts of money, time and effort in advertising, promoting, and popularizing its HUSTLER Marks over many years and in preserving the goodwill associated therewith.

5. By virtue of its extensive use and promotion of the HUSTLER Marks, LFP has established valuable goodwill in the Marks, and the public has come to associate the HUSTLER Marks with LFP and LFP's famous founder, Larry Flynt. As such, the HUSTLER Marks have become distinctive and the public has come to know the HUSTLER Marks as an indication of goods and services that originate from Opposer.

6. On December 28, 2011, Applicant filed U.S. Trademark Application Serial No. 85,505,221, based on his asserted intent to use the mark "SWEETHEARTHUSTLERXXX.COM" in connection with "Caps; T-shirts." Applicant's mark referred to hereinabove will be referred to collectively as "Applicant's Mark" on the "Application."

7. Applicant's goods as described in the Application include certain apparel items. Applicant's proposed goods are identical to the goods identified in the registrations and applications for HUSTLER Marks.

8. The goods identified in the Application are likely to be sold and/or distributed through the same channels of trade and to the same class of purchasers as Opposer's goods sold and/or distributed under its HUSTLER Marks.

9. Applicant's "SWEETHEARTHUSTLERXXX.COM" mark includes and incorporates LFP's entire HUSTLER and HUSTLER XXX marks.

10. On information and belief, Applicant selected the HUSTLER and/or HUSTLERXXX portion of the mark as a direct reference to Opposer's HUSTLER XXX mark and/or LFP's famous HUSTLER mark. Applicant intends to profit from LFP's name and goodwill by creating a misleading association between Applicant's goods and those of Opposer, thereby diluting the HUSTLER Marks, and creating a misleading association between Opposer and Applicant.

11. As set forth in more detail above, LFP began use of its HUSTLER Marks in connection with its goods and services prior to Applicant's December 28, 2011 filing date for the Application.

12. Opposer's HUSTLER Marks are famous and distinctive within the meaning of the Lanham Act.

13. Opposer's HUSTLER Marks became famous long prior to the filing date of the Application.

14. As a result of the similarity between the HUSTLER Marks and Applicant's mark, and the identical nature of the goods, Applicant's mark is likely to

cause confusion, mistake or deception in the trade and among purchasers as to the source, origin or sponsorship of the parties' respective goods and services.

15. Registration of the mark in the Application and use of Applicant's mark is likely to dilute LFP's famous HUSTLER Marks.

16. Registration of Applicant's mark would result in damage to LFP pursuant to the provisions of 15 U.S.C. §§ 1114, 1115, and 1125, pursuant to the allegations stated above, and registration should be denied pursuant to 15 U.S.C. § 1052(d).

17. If the Application is permitted to register, the registration would presumptively entitle Applicant to prima facie exclusive ownership and rights to the "SWEETHEARTHUSTLERXXX.COM" mark. Such registration would cause confusion among consumers as to: (1) the separate and distinct sources of Applicant's goods and services and LFP's goods and services; and (2) the relationship of LFP to Applicant. This would thereby damage LFP's goodwill in the HUSTLER Marks, diluting the value thereof, and resulting in irreparable harm to LFP's business and reputation, all to the detriment of LFP who has expended considerable sums and effort in promoting the HUSTLER Marks.

18. Registration of the highly similar Applicant's mark will lessen the capacity of Opposer's famous and distinctive HUSTLER Marks to distinguish and identify Opposer's goods and services from those of others, thereby diluting the distinctive quality of Opposer's HUSTLER Marks in violation of 15 U.S.C. § 1125(c), and causing damage to Opposer within the meaning of 15 U.S.C. § 1063.

19. Opposer would be damaged by registration of Applicant's Mark because registration would grant Applicant statutory rights under the Trademark Act of 1946, and

would tend to restrict, interfere with, and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, Opposer prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 85,505,221 be denied.

Dated: July 20, 2012

Respectfully submitted,

LFP IP, LLC, by its counsel
Lipsitz Green Scime Cambria LLP

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CERTIFICATE OF FILING AND SERVICE

I, Lori Vangelov, hereby certify that on July 20, 2012, I caused a true copy of the foregoing Notice of Opposition to be filed electronically with the United States Patent and Trademark Office and served upon Applicant, Timothy Stephen Sanders, by United States First Class Mail, addressed to 5994 Milam Dr. SW, Mableton, GA 30126.

Dated: July 20, 2012

By: /Lori Vangelov/