

ESTTA Tracking number: **ESTTA531074**

Filing date: **04/08/2013**

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	DUCK DIVE, LP		
Entity	Partnership	Citizenship	California
Composed Of:	Doug Sondomowicz (USA), Thomas Winn (USA), Billy Ramirez (USA), Peter Cich (USA)		
Address	6796 Malachite Place Carlsbad, CA 92009 UNITED STATES		

Attorney information	Kristen N. Gonzales SAN DIEGO LAW FIRM 2828 University Ave. Suite 102 San Diego, CA 92104 UNITED STATES kgonzales@sandiegolawfirm.com Phone:619-794-0243		
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**Applicant Information**

Application No	85802943	Publication date	03/26/2013
Opposition Filing Date	04/08/2013	Opposition Period Ends	04/25/2013
Applicant	HEYDARI, MICHAELINE 28955 SELFRIDGE DRIVE MALIBU, CA 90265 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 043. All goods and services in the class are opposed, namely: Bar services; Restaurant services
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	No bona fide intent to use the mark at time of filing, pursuant to Trademark Act Â§ 1(b), 15 U.S.C. Â§ 1052(b).

**Marks Cited by Opposer as Basis for Opposition**

U.S. Application No.	85888258	Application Date	03/27/2013
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DUCK DIVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2012/03/30 First Use In Commerce: 2012/03/30 Baseball caps and hats; T-shirts Class 043. First use: First Use: 2012/03/30 First Use In Commerce: 2012/03/30 Bar services; Restaurant services		

U.S. Application No.	85889133	Application Date	03/28/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DUCK DIVE		
Design Mark			
Description of Mark	The mark consists of a stylized wave shape with lighter shading toward the outer right portion of the wave, encircled by an elongated oval with the words "DUCK DIVE" in stylized lettering cutting across the top portion of the elongated oval and extending beyond the oval itself. Within the oval shape, is the silhouette of a woman positioned toward the bottom of the oval holding a surfboard in the position of a "duck dive," appearing to dive under the wave inside the elongated oval.		
Goods/Services	Class 025. First use: First Use: 2012/03/30 First Use In Commerce: 2012/03/30 Baseball caps and hats; T-shirts Class 043. First use: First Use: 2012/03/30 First Use In Commerce: 2012/03/30 Bar services; Restaurant services		

Related Proceedings	Pending trademark 1(a) applications, Serial No.s: 85889133 and 85888258
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Attachments	85888258#TMSN.jpeg ( 1 page )( bytes ) 85889133#TMSN.jpeg ( 1 page )( bytes ) 001.2 Notice of Opposition X KNG.pdf ( 6 pages )(1286046 bytes ) 003 Exhibit 1.pdf ( 3 pages )(745073 bytes ) 004 Exhibit 2.pdf ( 2 pages )(813577 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	/kngonzales/
Name	Kristen N. Gonzales
Date	04/08/2013



CONNECTION BETWEEN APPLICANT'S AND OPPOSER'S MARKS

APPLICANT'S CONFUSINGLY SIMILAR MARK AND FALSELY SUGGESTED

- the State of California, with a business address of 6796 Malachite Place, Carlsbad, California 92009.
2. Opposer is the owner of a bar, restaurant and gastropub located in San Diego, California, with a business address of 4650 Mission Boulevard, San Diego, CA 92109. Opposer's restaurant/bar/gastropub has been continuously doing business under the name "DUCK DIVE" since on or about March 30, 2012, and which operates a website for the promotion of its business at [www.theduckdive.com](http://www.theduckdive.com). Additionally, Opposer sells t-shirts, and hats/baseball caps with the DUCK DIVE logo in connection with its restaurant/bar/gastropub.
3. Upon information and belief, Applicant had not used the mark THE DUCK DIVE in the United States for the services set out in Application Serial No. 85/802,943, prior to December 14, 2012, the date of filing of Applicant's intent-to-use application for the aforementioned mark.
4. Opposer is presently using, and has been continuously using the DUCK DIVE marks in the United States for the services/goods set out in Application Serial Nos. 85/888,258 and 85/889,133, prior to December 14, 2012, the date of filing of Applicant's intent-to-use application for this mark.
5. Moreover, on or about March 27 and March 28, 2013, Opposer filed with the United States Patent and Trademark Office use-based applications for registration on the Principal Register of the mark "DUCK DIVE" and design ("Opposer's Marks") under International Classes 25 and 43, respectively.
6. At all times from and after March 30, 2012, Opposer has adopted and actively and continuously used Opposer's Marks in interstate commerce in connection with bar and restaurant services, in addition to the aforementioned merchandise products. Opposer's business has been the subject of local press attention and throughout California in both industry publications and also mainstream media, and as such, has developed extensive goodwill in the restaurant/gastropub industries.

7. Upon information and belief, Applicant Michaele Heydari, is an individual located in the state of California, and also a member of The Duck Dive Gastropub, Inc. a California corporation.
8. On or about December 14, 2012, Applicant filed under Trademark Act Section 1(b) an intent-to-use application for the registration of the mark THE DUCK DIVE in International Class 43 for Bar and Restaurant Services.
9. The mark THE DUCK DIVE was deliberately selected by Applicant in an attempt to appropriate Opposer's highly desirable and imaginative name, and to trade upon the reputation and goodwill developed in the DUCK DIVE name by Opposer, which name is associated by the public exclusively with the goods/services and reputation of Opposer. Applicant seeks to capitalize on the goodwill established by Opposer to help launch her restaurant in a nearby territory (Malibu, California). Applicant seeks to confuse actual and potential customers into the belief that the services provided under Applicant's proposed mark originate with, are sponsored by or are associated with or approved by Opposer, which continues to operate under the common law service mark DUCK DIVE and on which Opposer also maintains pending Trademark Application Serial Numbers 85/888,258 and 85/889,133.
10. The likelihood of consumer confusion, mistake, and deception is further heightened, because the services identified under Class 43 and provided under THE DUCK DIVE mark are identical to that of Opposer's Marks, and because Applicant's mark is identical in its dominant elements and in sound, meaning, and commercial impression to Opposer's Mark.
11. Further, it is not only likelihood of confusion with which Opposer is concerned, but also the actual confusion that is already occurring between the two establishments by media outlets, as evidenced by a recent publication identifying Applicant's location as being a second location of Opposer's restaurant/gastropub.
12. THE DUCK DIVE is confusingly and deceptively similar to the service mark and trade name used in the United States by, and not abandoned by Opposer, such that the use of THE DUCK

name THE DUCK DIVE, but instead intended on pursuing a different application for DUCK DIVE Applicant responded in writing, conveying that Applicant had no intent to operate her business under the (representatives), and informed Applicant of the confusion and Opposer's prior use of an identical mark.

16. Shortly thereafter, Opposer contacted Applicant (by way of their respective legal Opposer first learned of Applicant's pending registration. future, there was not yet a second location opening. It was upon being contacted by this media outlet that in Malibu, California. While Opposer had plans to expand into the Los Angeles territory in the near was contacted by a local media outlet asking for information relating to their "second location" opening "THE DUCK DIVE" in standard characters on December 14, 2012. On or about March, 2013, Opposer provided in her application. As previously mentioned, Applicant filed its intent to use application for and believes that Applicant has no bona fide intent to use THE DUCK DIVE mark for the services

15. In addition to the marks being confusingly similar to one another, Opposer is informed

#### APPLICANT'S LACK OF BONA FIDE INTENT TO USE THE MARK

THE DUCK DIVE and DUCK DIVE restaurants/bars are related. the cities of Los Angeles (Malibu) and San Diego, it is highly likely that consumers will believe that location," specifically referring to Opposer's existing San Diego location. Due to the proximity between new restaurant in Malibu, California, and referenced that Applicant's restaurant/bar was a "second Diego DUCK DIVE location, as a reporter indicated in a news article concerning Applicant's intended 14. Moreover, Opposer is informed and believes that Applicant was aware of Opposer's San provided) by Opposer and Applicant and the identical channels of trade.

13. The likelihood of confusion between Opposer's Marks and Applicant's proposed mark is further heightened as a result of the identical services provided (or in the case of Applicant, to be the bar, restaurant, and gastropub industries when used in connection with Applicant's services. DIVE by Applicant is likely to (and already has) cause confusion, mistake and deception of consumers in

19. Based on the written communication received from Applicant on or about April 1, 2013, Applicant did not intend to operate her bar/restaurant/gastropub under THE DUCK DIVE mark as represented to the United States Patent and Trademark Office when she filed her intent-to-use application on or about December 14, 2013. Instead, Applicant's correspondence in conjunction with her filing of an

### FRAUD

18. Based on the written representations of Applicant by and through her Attorney of Record, and in conjunction with her affirmative action of filing an intent-to-use application for DUCK DIVE GASTROPUB MALIBU, Opposer is informed and believes that Applicant has no further intent to make any bona fide use of THE DUCK DIVE mark in commerce, and as such has effectively abandoned her pending intent-to-use application for THE DUCK DIVE. Moreover, Opposer is informed and believes that Applicant adopted her mark in bad faith, as she was aware of the San Diego DUCK DIVE location prior to filing her intent-to-use application.

17. On March 29, 2013, Applicant, by way of her newly formed corporation, Duck Dive Gastropub, Inc. filed an additional intent to use application for DUCK DIVE GASTROPUB MALIBU with Application Serial No. 85/890,380, as referenced in **EXHIBIT 1**. Opposer is informed and believes that Applicant is the primary member and owner of Duck Dive Gastropub, Inc., based upon representations made by counsel for Applicant in **EXHIBIT 1**: "I represent Michaele Heydari and the corporation The Duck Dive Gastropub, Inc."

verifying the authenticity and date on which the letter (**EXHIBIT 1**) was received.  
 Numbers: *DD Notice of Opposition - 000004-5*), is an Affidavit of Authenticity by Opposer's attorney, received by Applicant's attorney of record. Additionally, attached hereto as **EXHIBIT 2** (Bates **EXHIBIT 1** (Bates Numbers: *DD Notice of Opposition 000001-3*) is a true and correct copy of the letter contested and continues to contest registrability of either confusingly similar mark. Attached hereto as GASTROPUB MALIBU, as that was the real name under which she intended to do business. Opposer

additional intent-to-use application suggests that her bar/restaurant/gastropub was really going to offer its bar/restaurant services under the name DUCK DIVE GASTROPUB MALIBU. Thus, Opposer alleges that Applicant committed fraud in procurement of her trademark for THE DUCK DIVE, when Applicant knowingly made a false, material representation of fact in connection with her intent-to-use application for THE DUCK DIVE.

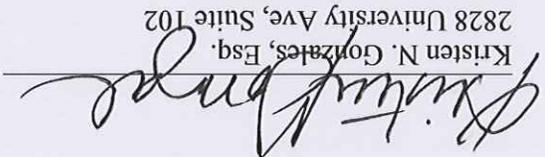
WHEREFORE, Opposer respectfully requests that the Notice of Opposition be sustained and the registration of THE DUCK DIVE to Applicant be refused registration.

**PAYMENT OF FILING FEES**

Payment of \$300.00 is being made herewith to cover the required filing fee.

Respectfully submitted,

SAN DIEGO LAW FIRM

By:  Kristin N. Gonzales, Esq.  
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Date: April 8, 2013

Attorneys for Opposer, DUCK DIVE, LP

# EXHIBIT 1

*Law Offices of*

**MICHAELINE A. RÉ**

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MICHAELINE A. RÉ

April 1, 2013

Kristen N. Gonzales, Esq.  
SAN DIEGO LAW FIRM  
2828 University Avenue, Suite 102  
San Diego, CA 92104  
Via U.S. Mail and Facsimile (619) 794-0253

Re: The Duck Dive, LP.'s THE DUCK DIVE Mark vs. Michaeline Heydaria's application for THE DUCK DIVE and DUCK DIVE GASTROPUB MALIBU

Dear Ms. Gonzales:

This letter is to advise you that I represent Michaeline Heydari and the corporation The Duck Dive Gastropub, Inc. a California corporation and just received a copy of your letters dated March 27, 2013. The company and Ms. Heydari are very respectful of the trademarks and intellectual property rights of others.

Prior to the company making its application, we conducted a search for similar marks with the USPTO. Your client's mark did not come up and apparently you are claiming common law rights to your mark.

Through an Internet search I have been able to find only one restaurant owned and operated by your client in San Diego, California. While a reporter claimed that this was a second location, my clients gave this reporter that information.

My clients intend to operate their bar and restaurant only under the name DUCK DIVE GASTROPUB MALIBU. I have had them look at your web site to see if their restaurant design or logo is similar to your client's and they assure me that it is not. We believe that the likelihood of confusion is slim to non for the following reasons:

- 1) The services are not offered in or near the San Diego region. These two markets are very different and if the law allowed you to operate on restaurant in one location and stop restaurants throughout the United States that would clearly be a restraint on trade. There are Burger King restaurants operating in places with no affiliation to the chain.
- 2) The marks are not identical and are easily distinguished.

## EXHIBIT 1

- 3) There are multiple uses of the word "duck" which describes a particular animal in restaurants throughout the United States within the restaurant name.
- 4) There are multiple uses of the word "dive" in restaurant names throughout the United States and in the industry this word is used to describe a particular type of bar or restaurant that is typically relaxed, informal, conversational atmosphere.

In the 9<sup>th</sup> Circuit, the court whose rules apply here, eight factors are considered by the court to determine if there is a likelihood of confusion. These factors, arising from *AMF v. Sleekcraft Boats*, 599 F.2d 341 (9<sup>th</sup> Cir. 1979), having been paraphrased and summarized by *McCarthy on Trademarks and Unfair Competition*, Fourth Edition, vol. 3, pages 23-70 and 23-71, are as follows:

1. The degree of resemblance between the conflicting designations;
2. The similarity of the marketing methods and channels of distribution;
3. The characteristics of the prospective purchasers and the degree of care they exercise;
4. The degree of distinctiveness of the senior user's mark;
5. Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user;
6. Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory;
7. The intent of the junior user; and
8. Evidence of actual confusion."

The USPTO list 522 live applications and/or registrations including the mark DUCK and 250 including the mark DIVE. By deleting "The" and adding "GASTROPUB MALIBU" the mark is easily distinguished from the other applications and registrations. Since the trademark office has indicated that their examination of the application for THE DUCK DIVE found no similar marks we believe that a similar examination of DUCK DIVE GASTROPUB MALIBU will pass examination.

As you know the strength and fame, or knowledge of third parties of the marks is a factor. Your client has only been in business for a year. You operated in a different geographical location and no one buyer would buy both services because of this.

While you advertise on the Internet, the courts have held that all business in today's market use this advertising method and this does not constitute overlapping marketing channels. See *Entrepreneur Media Inc. v. Smith* (9<sup>th</sup> Cir. 2002) 279 F3d. 1123.

In the past we have worked with companies where we did not believe there was a chance of confusion to enter into coexistence agreements. We are willing to consider this in this matter so that both companies are protected. We are willing to abandon THE DUCK DIVE application but will proceed with DUCK DIVE GASTROPUB MALIBU. My client is also willing to agree not to open a restaurant with this name in San Diego County so long as your client agrees not to

## EXHIBIT 1

open a restaurant in Los Angeles County.

Please discuss this with your client and get back to me. I can draft a simple co-existence agreement which should protect both companies.

Very truly yours,



Michaeline A. Ré

MAR:md

cc: Michaeline Heydari

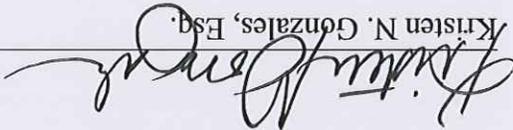


EXHIBIT 2

in both letters are identical, except for the signature, which Ms. Re provided in the hard copy version, only. The letter received from Ms. Re's office was dated after her client's second intent-to-use application had already been filed.

5. I hereby declare under penalty of perjury under the laws of the United States, that the foregoing is true and correct. Further, I certify that I am qualified and authorized to file this Affidavit of Authenticity. Executed on the below referenced date.

Dated: April 8, 2013

  
Kristen N. Gonzales, Esq.