

ESTTA Tracking number: **ESTTA541864**

Filing date: **06/05/2013**

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	Morgans Group LLC
Granted to Date of previous extension	06/05/2013
Address	475 10th Avenue New York, NY 10018 UNITED STATES
Attorney information	Joseph T. Nabor, Sherri N. Blount FITCH EVEN TABIN & FLANNERY, LLP 120 S. LaSalle Street Suite 1600 Chicago, IL 60603-3407 UNITED STATES trademark@fitcheven.com Phone:312 577-7000

Applicant Information

Application No	85719757	Publication date	02/05/2013
Opposition Filing Date	06/05/2013	Opposition Period Ends	06/05/2013
Applicant	HUD-MOE LLC 233 East 69Th St, apt 9d New York, NY 10021 UNITED STATES		

Goods/Services Affected by Opposition

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

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. Application No.	85841151	Application Date	02/05/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HENRY HUDSON		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 043. First use: Hotel services; bar services; restaurant services; providing a website for making hotel and restaurant reservations; making hotel and restaurant reservations for others; providing personalized information about hotels via the internet; providing information in the field of restaurant dining via the internet; providing social meeting, banquet, social function, conference, exhibition and meeting facilities; catering services; spa services, namely, providing temporary accommodations and meals to clients of a health or beauty spa; consulting services in the field of hospitality

U.S. Application No.	85841172	Application Date	02/05/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HUDSON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 1942/00/00 First Use In Commerce: 1942/00/00 Hotel services		

Attachments	20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_1.tif(45924 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_2.tif(64160 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_3.tif(58758 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_4.tif(61950 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_5.tif(52536 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_6.tif(28546 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_7.tif(23408 bytes) 20044-130594 Morgans Group v HUD-MOE LLC Opposition_Page_8.tif(22524 bytes)
-------------	--

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	/Joseph T. Nabor/
Name	Joseph T. Nabor, Sherri N. Blount
Date	06/05/2013

File No.: 20044-130594

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

Morgans Group LLC,)	
Opposer,)	
)	Opposition No.
v.)	
)	
HUD-MOE LLC,)	
Applicant.)	
)	
)	
)	
Serial No.)	85/719757
Filed:)	September 4, 2012
Mark:)	HUDSON MALONE

NOTICE OF OPPOSITION

Morgans Group LLC, having a principal place of business at 475 10th Avenue, New York, NY 10018 (hereafter, “Morgans Group”) believes that it will be damaged by registration of the HUDSON MALONE mark, Application No. 85/719757 by HUD-MOE LLC (hereafter, “Applicant”) and hereby opposes the same upon the following grounds.

1. Morgans Group operates one of New York’s finest boutique hotels under the trade marks HUDSON and HENRY HUDSON (collectively, the “HUDSON Marks”).

2. Morgans Group uses a number of trade names which incorporate the term Hudson for a variety of hospitality related services such as Henry Hudson Senior Mezz LLC, Henry Hudson Holdings LLC, Hudson Managing Member LLC, Hudson Residual Interests, Inc., Hudson Leaseco LLC and Hudson Pledgor LLC.

3. Since at least as early as December 31, 1942, Morgans Group has used its HUDSON Marks in commerce in connection with hotel services; restaurant, catering, bar and

lounge services; provision of general-purpose facilities for meeting, conferences and exhibitions; and the provision of social function facilities for special occasions.

4. Over the years, the HUDSON Marks have become quite well known for use in connection with a wide variety of services, including but not limited to hotel services, restaurant services, bar and cocktail lounge services, provision of general-purpose facilities for meetings, conferences and exhibitions, and social function facilities.

5. Based on the longstanding, continuous, and extensive use of the HUDSON Marks in commerce, Morgans Group filed an application on February 5, 2013 covering “Hotel services” in International Class 43, Application No. 85/841172, which has use-based priority earlier than the priority date claimed by the Applicant in Application No. 85/719757.

6. In addition, since at least as early as 1942, Morgans Group has extensively used its HENRY HUDSON mark in connection with a wide variety of goods and services, including but not limited to hotel services, restaurant services, bar and cocktail lounge services, catering services, provision of general-purpose facilities for meetings, conferences and exhibitions, and social function facilities.

7. On February 5, 2013, Morgans Group filed an application for HENRY HUDSON covering “hotel services; bar services; restaurant services; providing a website for making hotel and restaurant reservations; making hotel and restaurant reservations for others; providing personalized information about hotels via the internet; providing information in the field of restaurant dining via the internet; providing social meeting, banquet, social function, conference, exhibition and meeting facilities; catering services; spa services, namely, providing temporary accommodations and meals to clients of a health or beauty spa; consulting services in the field of hospitality” in International Class 43, Application No. 85/841151, which has use-based priority earlier than the priority date claimed by the Applicant in Application No. 85/719757.

8. Morgans Group possesses extensive common law rights in the HUDSON Marks and trade names by virtue of its longstanding use of the marks and trade names.

9. Morgans Group has expended millions of dollars in marketing, advertising, and promoting goods and services in connection with its HUDSON Marks and trade names in the United States and as a result of such efforts and expenditures, as well as the quality of its services, Morgans Group has enjoyed substantial revenue from the sale of its goods and services associated with its HUDSON Marks.

10. By reason of Morgans Group's longstanding and extensive marketing, advertising, promotion, and resulting sales of its services in connection with the HUDSON Marks and trade names and the high quality of those services, the HUDSON Marks and trade names have acquired distinctiveness, recognition, and fame among the public long before Applicant can claim any priority in its HUDSON MALONE mark.

11. By reason of the extensive marketing, advertising, and promotion, and public recognition of Morgans Group's services in connection with the HUDSON Marks and trade name and the high quality of those services, the HUDSON Marks and trade names have come to represent extremely valuable goodwill to Morgans Group.

12. Notwithstanding Morgans Group's long prior established rights in its HUDSON Marks, Applicant filed an intent-to-use Application Serial No. 85/719757, filed September 4, 2012 and published for opposition February 5, 2013 for the mark HUDSON MALONE for "Restaurant Services" in International Class 43.

13. On information and belief, the earliest date of actual or constructive use for the services specified in the subject application upon which the Applicant can rely is September 4, 2012, the filing date of Application No. 85/719757.

14. On information and belief, the Applicant has not used the mark HUDSON MALONE in interstate commerce on the services specified in the Application.

15. Applicant's proposed adoption and alleged use of the HUDSON MALONE mark has been without the consent or permission of Morgans Group.

16. Upon information and belief, the Applicant's proposed adoption and use of its HUDSON MALONE mark has been with actual or constructive knowledge of the prior use of the HUDSON Marks in connection with Morgans Group's services.

17. The specified services for which the Applicant seeks registration of the HUDSON MALONE mark are similar and/or closely related to the services Morgans Group provides in connection with its HUDSON mark and its trade names.

18. The services for which the Applicant seeks registration of the HUDSON MALONE mark are likely to be through the same channels of trade in which Morgans Group provides its services with its HUDSON mark and its HUDSON trade names.

19. The Applicant's HUDSON MALONE mark is substantially and confusingly similar to Morgans Group's HUDSON Marks and the HUDSON trade names.

20. The Applicant's proposed HUDSON MALONE mark and use thereof by the Applicant in connection with the services specified in Application No. 85/719757 is likely to cause confusion, mistake, or deception that Applicant's services are those of Morgans Group's or are otherwise endorsed, sponsored, or approved by Morgans Group, whereby Morgans Group will be damaged by the registration of Applicant's proposed HUDSON MALONE mark on the Principal Register of the United States Patent and Trademark Office.

21. If the Applicant is granted registration of its proposed HUDSON MALONE mark as set forth in Application No. 85/719757, the Applicant will thereby obtain the *prima facie* exclusive right to use such mark, and such registration will damage, impair, diminish, and dilute

Morgans Group's goodwill and rights in its HUDSON Marks and trade name causing irreparable injury to Morgans Group.

COUNT I - Likelihood of Confusion

22. Morgans Group hereby incorporates the allegations contained in paragraph nos. 1-21 by reference herein.

23. Morgans Group has used its HUDSON Marks in commerce before the September 4, 2012 filing date of the opposed application, and any date of first use alleged by the Application.

24. Applicant's HUDSON MALONE mark is substantially similar in sound, appearance, connotation, and overall commercial impression to Morgans Group's HUDSON Marks. Among other things, both marks contain the term, "HUDSON," which is the dominant portion of Applicant's mark. Further, Morgans Group's HUDSON mark is encompassed in its entirety in Applicant's HUDSON MALONE mark.

25. The opposed application covers restaurant services, which are identical and/or closely related and complementary to Morgans Group's goods and services for its HUDSON mark and trade names.

26. Applicant's HUDSON MALONE mark so resembles Morgans Group's previously used HUDSON Marks and trade names and earlier filed applications as to be likely, when applied to the parties' identical and/or closely related goods and services, to cause confusion, mistake, or deception or cause consumers to believe that Applicant's services are otherwise endorsed, sponsored, or approved by Morgans Group, whereby Morgans Group will be damaged by the registration of Applicant's proposed mark on the Principal Register of the United States Patent and Trademark Office.

COUNT II - Dilution

27. Morgans Group hereby incorporates the allegations contained in paragraph nos. 1-26 by reference herein.

28. Morgans Group's HUDSON Marks and trade names are widely recognized by the general consuming public of the United States as a designation of source of Morgans Group's services.

29. Morgans Group's HUDSON Marks are famous as the term is defined in 15 U.S.C § 1125(c) and were famous prior to the filing of the subject application or prior to any use of the mark by the Applicant.

30. Applicant's HUDSON MALONE mark is likely to cause dilution and impairing the distinctiveness of Morgans Group's famous HUDSON Marks, and trade names whereby Morgans Group will be damaged by the registration of Applicant's proposed mark on the Principal Register of the United States Patent and Trademark Office.

PRAYER FOR RELIEF

WHEREFORE, Morgans Group believes that it is being and will be damaged by the registration of the mark shown in Application Serial No. 85/719757, and respectfully requests that the Opposition be sustained and that registration of the mark HUDSON MALONE mark be refused.

Respectfully submitted,

June 5, 2013



Joseph T. Nabor
Sherri N. Blount
FITCH, EVEN, TABIN & FLANNERY, LLP
120 South LaSalle, Suite 1600
Chicago, Illinois 60603

Telephone 312.577.7000
Facsimile 312.577.7007

Attorneys for Opposer

CERTIFICATE OF SERVICE

I, Joseph T. Nabor, Attorney for Opposer, hereby certify that copies of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

HUD-MOE LLC
233 E 69th St Apt 9D
New York, NY 10021-5445

on this 5th day of June 2013.

FITCH, EVEN, TABIN & FLANNERY, LLP



Joseph T. Nabor
Sherri N. Blount
FITCH, EVEN, TABIN & FLANNERY, LLP
120 South LaSalle, Suite 1600
Chicago, Illinois 60603

Telephone 312.577.7000
Facsimile 312.577.7007

Attorneys for Opposer