

ESTTA Tracking number: **ESTTA561030**

Filing date: **09/24/2013**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Shiplely Do-Nut Flour and Supply Company, Inc.		
Entity	Corporation	Citizenship	TX
Address	5200 North Main Street Houston, TX 77009 UNITED STATES		

Name	Shiplely Franchise Company		
Entity	Corporation	Citizenship	TX
Address	5200 North Main Street Houston, TX 77009 UNITED STATES		

Attorney information	Gregory L. Maag Conley Rose, P.C. 1001 McKinney St., Suite 1800 Houston, TX 77002 UNITED STATES houstonpatmail@conleyrose.com Phone:713-238-8000		
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Applicant Information

Application No	85871616	Publication date	08/27/2013
Opposition Filing Date	09/24/2013	Opposition Period Ends	09/26/2013
Applicant	Panda Restaurant Group, Inc. 1683 Walnut Grove Avenue Rosemead, CA 91770 UNITED STATES		

Goods/Services Affected by Opposition

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

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	15 U.S.C. Â§ 1052(d) 15 U.S.C. Â§ 1125(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3321574	Application Date	05/03/2006
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Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	MAKE LIFE DELICIOUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2007/05/07 First Use In Commerce: 2007/05/07 Doughnuts, pastries, turnovers, cream-filled bakery bars, cinnamon rolls, eclairs, fillings of chocolate and cream nature for bakery products, flour, and doughnut and pastry icings		

U.S. Registration No.	873148	Application Date	02/05/1968
Registration Date	07/15/1969	Foreign Priority Date	NONE
Word Mark	SHIPLEY DO-NUTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U046 (International Class 030). First use: First Use: 1937/03/01 First Use In Commerce: 1949/11/25 DOUGHNUTS, PASTRIES, TURNOVERS, CREAM-FILLED BAKERY BARS, CINAMMON ROLLS, ECLAIRS, FILLINGS OF CHOCOLATE AND CREAM NATURE FOR BAKERY PRODUCTS, FLOUR, AND DOUGHNUT AND PASTRY ICINGS		

Attachments	3104-02500_TM_Opposition_(stylized_mark).pdf(283135 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	/gregory l. maag/
Name	Gregory L. Maag
Date	09/24/2013

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

In re Application Serial No. 85/871,616

Published: August 27, 2013 in the Official Gazette

Mark: PANDA EXPRESS: GOURMET CHINESE MAKE LIFE DELICIOUS (stylized)

SHIPLEY DO-NUT FLOUR AND SUPPLY	§	
COMPANY, INC., and	§	
SHIPLEY FRANCHISE COMPANY	§	
	§	
Opposers	§	OPPOSITION NO. _____
	§	
v.	§	
	§	
PANDA RESTAURANT GROUP, INC.	§	
	§	
Applicant.	§	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

SHIPLEY DO-NUT FLOUR AND SUPPLY COMPANY, INC. (“ShipleY Flour & Supply”) and SHIPLEY FRANCHISE COMPANY (“ShipleY Franchise”) (collectively “ShipleY” or “Opposers”), Texas corporations with their principal place of business at 5200 North Main Street, Houston, Texas 77009 believes that they will be damaged by PANDA RESTAURANT GROUP, INC.’s (“PRG” or “Applicant”) registration of the mark “PANDA EXPRESS: GOURMET CHINESE MAKE LIFE DELICIOUS” (stylized) in International Class 043 as shown in Application Serial No. 85/871,616.

As grounds for its opposition, Opposers allege that:

1. For more than 75 years, Shipley has owned, operated and/or franchised Shipley Do-Nut shops that serve hot do-nuts that are freshly made throughout the day. Shipley's famous do-nuts, pastries, and kolaches have become so popular that the business has grown from a single location in Houston, Texas to over 250 franchised Shipley Do-Nut shops throughout the South Central United States. Today, there are more than 90 Shipley Do-Nut shops operating in the Houston area alone.

2. Keys to the Shipley's success include the Shipley commitment to the use of high quality ingredients and recipes, the use of menus and paper goods that are consistent from store to store, and the application of high standards in qualifying and training operators. In Shipley's efforts to maintain consistent and high quality products, Shipley Flour & Supply is the exclusive provider of many of the basic ingredients used in making the Shipley products, including specially prepared do-nut mix, fillings and icings that are used by all of the Shipley Do-Nut shops. Authorized Shipley Do-Nut franchisees use bakery equipment of the highest quality and are provided comprehensive ongoing support to ensure that the food products served at Shipley Do-Nut shops are of excellent quality and that excellent customer service is consistently supplied.

3. Shipley Flour & Supply began using the word mark SHIPLEY in connection with do-nuts and related food products at least as early as March of 1937. On July 15, 1969, the United States Patent and Trademark Office ("USPTO") issued to Shipley Flour & Supply United States Trademark Registration No. 873,147 for the word mark SHIPLEY as used in connection with doughnuts, pastries, turnovers, cream-filled bakery bars, cinnamon rolls, eclairs, fillings of chocolate and cream nature for bakery products, flour, and doughnut and pastry icings. Shipley

Flour & Supply has owned and, through its licensees, has used the word mark SHIPLEY continuously since registration on the principal register. Shipley Flour & Supply has renewed the registration for the SHIPLEY word mark, paid all associated fees, and, pursuant to 15 U.S.C. § 1065, the registration has become incontestable.

4. Shipley Flour & Supply began using the stylized mark SHIPLEY DO-NUTS in connection with do-nuts and related food products at least as early as March of 1937. The stylized SHIPLEY DO-NUTS mark is shown below:



5. On July 15, 1969, the USPTO issued to Shipley Flour & Supply United States Trademark Registration No. 873,148 for the stylized mark SHIPLEY DO-NUTS as used in connection with doughnuts, pastries, turnovers, cream-filled bakery bars, cinnamon rolls, eclairs, fillings of chocolate and cream nature for bakery products, flour, and doughnut and pastry icings. Shipley Flour & Supply has owned and, through its licensees, has used the stylized SHIPLEY DO-NUTS mark continuously since registration on the principal register. Shipley Flour & Supply has renewed the registration for the stylized SHIPLEY DO-NUTS mark, paid all associated fees, and, pursuant to 15 U.S.C. § 1065, the registration has become incontestable.

6. Shipley Flour & Supply began using the word mark MAKE LIFE DELICIOUS in connection with do-nuts and related food products at least as early as May of 2007. On October 23, 2007, the USPTO issued to Shipley Flour & Supply United States Trademark Registration No. 3,321,574 for the word mark MAKE LIFE DELICIOUS as used in connection with doughnuts, pastries, turnovers, cream-filled bakery bars, cinnamon rolls, eclairs, fillings of

chocolate and cream nature for bakery products, flour, and doughnut and pastry icings. Shipley Flour & Supply has owned and, through its licensees, has used the word mark MAKE LIFE DELICIOUS continuously since at least as early as May 2007. Shipley Flour & Supply has renewed the registration for the MAKE LIFE DELICIOUS word mark, paid all associated fees, and, pursuant to 15 U.S.C. § 1065, the registration has become incontestable.

7. Beginning on about June 2007, Shipley adopted and began using the following stylized marks incorporating MAKE LIFE DELICIOUS in connection with do-nuts and related food products:



Since their adoption, the above-identified stylized MAKE LIFE DELICIOUS marks have been used continuously by Shipley and their licensees in connection with doughnuts, pastries, turnovers, cream-filled bakery bars, cinnamon rolls, eclairs, fillings of chocolate and cream nature for bakery products, flour, and doughnut and pastry icings. Shipley Flour & Supply has owned and, through its licensees, has used stylized MAKE LIFE DELICIOUS marks continuously since their adoption.

8. Shipley Flour & Supply has licensed Shipley Franchise to use the MAKE LIFE DELICIOUS word mark and the MAKE LIFE DELICIOUS stylized marks (collectively, the Shipley Trademarks) in the operation and franchising of Shipley Do-Nut shops. In turn, and with the authorization and license of Shipley Flour & Supply, Shipley Franchise has licensed the

ShIPLEY Trademarks to ShIPLEY franchisees for their use in the advertising, marketing and sale of ShIPLEY food products. During this period, ShIPLEY Flour & Supply has preserved all good will in the ShIPLEY Trademarks by ensuring strict quality control and supervision over all uses of the ShIPLEY Trademarks. By their efforts, ShIPLEY Flour & Supply and ShIPLEY Franchise have maintained continuous and exclusive use of the ShIPLEY Trademarks and preserved all goodwill associated therewith.

9. By virtue of ShIPLEY's extensive advertising, sales, and close quality control, the ShIPLEY Trademarks have become well known and famous as an indication of quality products and services that emanate from a single source. The ShIPLEY Trademarks have become important assets of substantial value as symbols of ShIPLEY's identities and their longstanding business activities. As such, the public has come to know the ShIPLEY Trademarks as indicators of goods and services that originate from Opposers.

10. The goodwill embodied in the ShIPLEY Trademarks, and consequently ShIPLEY's valuable reputation and credibility in the food industry and among consumers, depends on the integrity of the ShIPLEY Trademarks as identification exclusively of ShIPLEY, and not of any other source.

11. On March 8, 2013, Applicant filed U.S. Trademark Application Serial No. 85/871,616 based upon its intent to use the mark identified below and incorporating the phrase "MAKE LIFE DELICIOUS," on or in connection with "restaurant services featuring Asian food" in International Class 043.



12. Shipley has recently become aware that Applicant has begun to use MAKE LIFE DELICIOUS as a trademark in marketing its food products in interstate and intrastate commerce. A screen shot of an online advertisement accessible from the home page of Applicant's Panda Express web site (<http://www.pandaexpress.com/>) is shown below:



13. Applicant's stylized MAKE LIFE DELICIOUS mark contains identical text and incorporates in full Shipley's MAKE LIFE DELICIOUS word mark.

14. Applicant's stylized MAKE LIFE DELICIOUS mark contains a circular logo and the text "MAKE LIFE DELICIOUS" below the circular logo, and thus is highly similar to Shipley's stylized MAKE LIFE DELICIOUS mark.

15. Applicant sells food products, and advertises those products as being "served fast and hot." Applicant sells its food products from shopping centers, malls, strip centers and freestanding locations to members of the public desiring fast food. Applicant promotes itself as being a "pioneer in the quick service" food market. As such, Applicant markets to and serves the same customer base that is served by Shipley.

16. Applicant's Goods and Services are closely related to the goods and services identified in Shipley's Registration No. 3,321,574, which is for the mark MAKE LIFE DELICIOUS that Shipley has been using for many years.

17. Prior to the earlier of Applicant's first actual use in commerce or first constructive use in commerce of its stylized MAKE LIFE DELICIOUS mark, Shipley had already 1) applied to register its MAKE LIFE DELICIOUS word mark in connection with its goods and services; 2) commenced use in commerce of the Shipley Trademarks in connection with its goods and services; and 3) acquired fame in the Shipley Trademarks for its goods and services by virtue of the recognition of the general consuming public in the United States.

18. The Shipley Trademarks, including its MAKE LIFE DELICIOUS mark, have priority over Applicant's use of MAKE LIFE DELICIOUS as a product identifier.

19. As a result of the similarity between the Shipley Trademarks and Applicant's stylized MAKE LIFE DELICIOUS mark, as well as the highly related nature of the parties' respective goods and services and customer base, Applicant's stylized MAKE LIFE DELICIOUS 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.

20. As a result of the similarity between the Shipley Trademarks and Applicant's stylized MAKE LIFE DELICIOUS mark, the degree of recognition of the Shipley Trademarks, and the length and substantially exclusive nature of Shipley's use in commerce of the Shipley Trademarks, registration of Applicant's stylized MAKE LIFE DELICIOUS mark is likely to cause dilution of Shipley's famous Shipley Trademarks.

21. On September 6, 2013, based on the conduct outlined above and other facts, Shipley filed suit against Applicant in the United States District Court for the Southern District

of Texas, Houston Division, C.A. No. 4:13-cv-02618. In that suit, Applicant's conduct has been alleged to constitute trademark infringement, dilution, and unfair competition and to have caused damage to Shipley. The case is pending.

22. Pursuant to the allegations stated above, registration of Applicant's stylized MAKE LIFE DELICIOUS mark shown in the opposed Application will result in damage to Shipley under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

23. If the Application is permitted to register, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the stylized MAKE LIFE DELICIOUS mark. Such registration would cause confusion among consumers as to the separate and distinct sources of Applicant's goods and Shipley's goods and services and the relationship of Shipley to Applicant, thereby damaging Shipley's goodwill in the Shipley Trademarks, diluting the value thereof, and resulting in irreparable harm to Shipley's business and reputation, all to the detriment of Shipley who has expended considerable sums and effort in promoting the Shipley Trademarks.

WHEREFORE, Shipley prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 85/871,616 be denied.

Please charge any necessary fee regarding this opposition to the Deposit Account of Conley Rose, P.C., 03-2769, and credit any overpayment to such deposit account.

Please direct all notices, pleadings, and process regarding this matter to:

Gregory L. Maag
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Respectfully submitted,

Conley Rose, P.C.

Dated: September 24, 2013

By: _____
Gregory L. Maag
Attorney for Opposers