

ESTTA Tracking number: **ESTTA564843**

Filing date: **10/14/2013**

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	John Wayne Enterprises, LLC		
Entity	limited liability company	Citizenship	California
Address	210 62nd Street Newport Beach, CA 92663 UNITED STATES		

Attorney information	Ronald P. Oines, Lindsay J. Hulley Rutan & Tucker, LLP 611 Anton Boulevard Suite 1400 Costa Mesa, CA 92626 UNITED STATES roines@rutan.com, lhulley@rutan.com, trademarks@rutan.com Phone:714-641-5100		
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### Applicant Information

Application No	85827441	Publication date	09/24/2013
Opposition Filing Date	10/14/2013	Opposition Period Ends	10/24/2013
Applicant	One Good Arrow, Inc. 15 Cuttermill Rd. #222 Great Neck, NY 11021 UNITED STATES		

### Goods/Services Affected by Opposition

Class 032. All goods and services in the class are opposed, namely: Brewed malt-based alcoholic beverage in the nature of a beer
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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)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3245232	Application Date	06/12/2001
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	DUKE'S PLACE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2003/04/00 First Use In Commerce: 2003/04/00 BAR AND RESTAURANT SERVICES

U.S. Application No.	85184102	Application Date	11/23/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE DUKE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: Clothing, namely, activewear, outerwear, jeans, shorts, shirts, suits, swimwear, boating wear, beachwear, belts, gloves, neckwear, bags, footwear and headgear, namely, caps, cowboy hats, beanies, berets, military caps, boater hats and fedoras, all in connection with indicia denoting the late internationally known movie star John Wayne, who is also known as The Duke		

Related Proceedings	newly filed notice of opposition against Serial No. 85/827,438, filed on October 14, 2013.
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Attachments	JWE - DAISY DUKE (beer) - Notice of Opposition.pdf(141133 bytes ) Registration for DUKE'S PLACE.pdf(92096 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	/Lindsay J. Hulley/
Name	Ronald P. Oines, Lindsay J. Hulley
Date	10/14/2013

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

John Wayne Enterprises, LLC,

Opposer,

v.

One Good Arrow, Inc.,

Applicant.

Opposition No.: TO BE ASSIGNED

Application Serial No. 85/827,441

For the trademark: DAISY DUKE

Filed: January 18, 2013

Published: September 24, 2013

**NOTICE OF OPPOSITION**

Opposer, John Wayne Enterprises, LLC (“Opposer”), a California limited liability company having a place of business at 210 62<sup>nd</sup> Street, Newport Beach, California 92663, believes that it will be damaged by registration of the mark shown in U.S. Application Serial No. 85/827,441 (“Application”), filed by One Good Arrow, Inc. (“Applicant”), and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer holds the rights in the name of the deceased legendary American celebrity and movie actor, John Wayne, also known as Duke Wayne, Duke Morrison, Duke, and The Duke, as well as all commercial licensing and merchandising and allied rights relating to the use of John Wayne’s name, image and likeness, including but not limited to rights of association, publicity, sponsorship and/or endorsement, including among other indicia, DUKE and THE DUKE.

2. Opposer is the owner of U.S. Registration No. 3,245,232 for the mark DUKE’S PLACE in International Class 42 for bar and restaurant services, which was filed June 12, 2001 and registered on May 22, 2007. Opposer has filed Section 8 & 15 Affidavits, which have been accepted and acknowledged by the USPTO, rendering the registration incontestable under Section 15 of the Lanham Act. A copy of said registration is attached hereto.

3. Opposer applied to register Serial No. 85/184,102 for the mark THE DUKE in International Class 25 on November 23, 2010. The application date for THE DUKE precedes the filing date of the Application.

4. The names DUKE and THE DUKE are recognized in the United States as identifying the late actor John Wayne.

5. Since long prior to the filing of the Application, Opposer has used in commerce the marks DUKE, THE DUKE, and DUKE'S PLACE (collectively, "the DUKE Marks") in connection with a variety of goods and services offered by Opposer and its licensees and is using the mark DUKE in connection with alcoholic products.

6. Sales of products and services under the DUKE Marks have been extensive.

7. The DUKE Marks have been extensively and prominently advertised in a variety of media.

8. As a result of the successful sales, extensive advertising and promotional activities, the DUKE Marks have become well-known and famous.

#### **Applicant's Trademark Application**

9. Upon information and belief, Applicant filed the Application on January 18, 2013 to register the mark DAISY DUKE under a Section 1(b) basis ("Applicant's Mark").

10. As published on September 24, 2013, the Application covers "Brewed malt-based alcoholic beverage in the nature of a beer" in International Class 32.

#### **FIRST CLAIM FOR RELIEF Likelihood of Confusion Section 2(d) of The Lanham Act; 15 U.S.C. §1052(d)**

11. Opposer hereby incorporates the foregoing paragraphs as fully set forth herein.

12. Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), prohibits registration on the principal register of a mark that consists of or comprises a mark which so resembles a mark previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

13. Upon information and belief, the goods identified in the Application are closely related and/or complementary to the goods and services offered under the DUKE Marks.

14. Applicant's Mark so resembles the DUKE Marks, as to be likely, when used in connection with Applicant's goods, to cause confusion, to cause mistake, or to deceive.

**SECOND CLAIM FOR RELIEF**  
**False Suggestion of a Connection**  
**Section 2(a) of The Lanham Act; 15 U.S.C. §1052(a)**

15. Opposer hereby incorporates the foregoing paragraphs as fully set forth herein.

16. Section 2(a) of the Lanham Act, 15 U.S.C. §1052(a), prohibits registration on the principal register of a mark which disparages or falsely suggests a connection with persons, living or dead, institutions, beliefs or national symbols, or which brings them into contempt or disrepute.

17. Applicant's Mark falsely suggests a connection with the late actor John Wayne, known as DUKE or THE DUKE, and has a potential to disparage, bring into contempt or disrepute John Wayne or otherwise invade upon rights of privacy and publicity which Opposer seeks to defend.

18. Applicant's Mark is the same as, or a close approximation of the name or identity of John Wayne, also known as DUKE or THE DUKE.

19. Applicant's Mark would be recognized as identifying or falsely suggesting a connection with John Wayne, also known as DUKE or THE DUKE, in that it points uniquely and unmistakably to him.

20. Neither Opposer nor John Wayne is connected with the goods sold by Applicant under Applicant's Mark.

21. The name and identity of John Wayne, also known as DUKE and THE DUKE, are of sufficient fame and reputation such that when Applicant's Mark is used in connection with brewed malt-based alcoholic beverages in the nature of beer, a connection with John Wayne and Opposer would be presumed by the consuming public, all causing harm to Opposer.

22. Thus, Applicant's Mark falsely suggests a connection in violation of Lanham Act §2(a), and is not entitled to registration.

**THIRD CLAIM FOR RELIEF**  
**Trademark Dilution**  
**Section 43(c) of The Lanham Act; 15 U.S.C. §1125(c)**

23. Opposer hereby incorporates the foregoing paragraphs as fully set forth herein.

24. The DUKE Marks have become famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

25. The DUKE Marks became famous prior to the filing date of the Application.

26. The DUKE Marks will be diluted by the registration of Applicant's Mark.

27. Opposer would be damaged by the registration of Applicant's Mark for the reasons noted above and because Applicant's Mark is likely to interfere with Opposer's use and exploitation of the DUKE Marks, to tarnish John Wayne's and Opposer's reputation and that of the DUKE Marks, and to diminish and dilute Opposer's rights in said marks and the distinctive quality thereof and the goodwill associated, which inures to the benefit of Opposer.

WHEREFORE, Opposer prays that Serial No. 85/827,441 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Please recognize Ronald P. Oines and Lindsay J. Hulley and the law firm of Rutan & Tucker, LLP, as attorneys for Opposer in this proceeding and address all communications to Mr. Oines at the address below. This Notice of Opposition is being submitted electronically through ESTTA. The required fee is authorized to be charged against the Deposit Account of the Attorney for Opposer.

Respectfully submitted,

Dated: October 14, 2013

By: /Ronald P. Oines/  
Ronald P. Oines  
Lindsay J. Hulley  
Rutan & Tucker, LLP  
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Costa Mesa, California 92626  
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roines@rutan.com  
lhulley@rutan.com  
Attorneys for Opposer,  
John Wayne Enterprises, LLC

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that she is one of the attorneys for Opposer John Wayne Enterprises, LLC, in the above-captioned Opposition proceeding and that on the date which appears below, she caused a copy of the foregoing **NOTICE OF OPPOSITION** to be served on the following with the United States Postal Service with fully pre-paid postage by first class mail service:

**Applicant's Counsel of Record:**

Arnie Herz  
Arnie Herz, Attorney at law  
14 Vanderventer Ave., Ste. 255  
Port Washington, NY 11050-3777

Dated: October 14, 2013  
Costa Mesa, California

/Lindsay J. Hulley/  
Lindsay J. Hulley

**EXHIBIT A**

**Int. Cl.: 42**

**Prior U.S. Cls.: 100 and 101**

**United States Patent and Trademark Office**

**Reg. No. 3,245,232**

Registered May 22, 2007

**SERVICE MARK  
PRINCIPAL REGISTER**

**DUKE'S PLACE**

WAYNE ENTERPRISES, LP (CALIFORNIA LIMITED PARTNERSHIP)  
881 DOVER DRIVE, STE. 150  
NEWPORT BEACH, CA 92663

FIRST USE 4-0-2003; IN COMMERCE 4-0-2003.

SN 76-270,478, FILED 6-12-2001.

FOR: BAR AND RESTAURANT SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

VERNA BETH RIRIE, EXAMINING ATTORNEY