

ESTTA Tracking number: **ESTTA641308**

Filing date: **11/25/2014**

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	Booty's, LLC
Granted to Date of previous extension	11/26/2014
Address	800 Louisa Street New Orleans, LA 70117 UNITED STATES

Attorney information	Marie Breaux M Breaux Intellectual Property Law LLC 700 Camp Street Suite 418 New Orleans, LA 70130 UNITED STATES marie@mbipl.com, adriano@mbipl.com, al@speralaw.com, chad@andrewlegrandlaw.com Phone:(504) 975-1462
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**Applicant Information**

Application No	85839147	Publication date	07/29/2014
Opposition Filing Date	11/25/2014	Opposition Period Ends	11/26/2014
Applicant	Booties Restaurants LLC 1850 Bassett St. #501 Denver, CO 80202 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Restaurant services
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**Applicant Information**

Application No	85839153	Publication date	07/29/2014
Opposition Filing Date	11/25/2014	Opposition Period Ends	
Applicant	Booties Restaurants LLC 1850 Bassett St. #501 Denver, CO 80202 UNITED STATES		

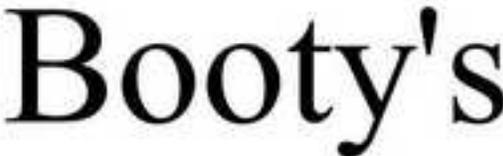
**Goods/Services Affected by Opposition**

Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Restaurant services
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## 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. Registration No.	4476287	Application Date	05/14/2012
Registration Date	01/28/2014	Foreign Priority Date	NONE
Word Mark	BOOTY'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2012/11/30 First Use In Commerce: 2012/11/30 Alcoholic aperitif bitters; Alcoholic cocktail mixes Class 043. First use: First Use: 2011/08/01 First Use In Commerce: 2011/08/01 Restaurant services, namely, providing of food and beverages for consumption on and off the premises		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Booty's		
Goods/Services	Restaurant services and related goods		

Attachments	85980764#TMSN.png( bytes ) BOOTIES Consol Opp TTAB.pdf(654668 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	/MBreaux/
Name	Marie Breaux
Date	11/25/2014

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

BOOTY’S, LLC Opposer	)	Opposition No.: _____
	)	
	)	Serial No.: 85/839147
	)	Mark: BOOTIES
v.	)	
	)	Serial No.: 85/839153
	)	Mark: BOOTIES and design
	)	
BOOTIES RESTAURANTS LLC Applicant	)	
_____	)	

**CONSOLIDATED NOTICE OF OPPOSITION**

Opposer Booty’s, LLC (“Booty’s” or “Opposer”), a Louisiana limited liability company, having its principal place of business at 800 Louisa Street, New Orleans, Louisiana 70117, will be damaged by the issuance of registrations for the following marks: (1) the word mark BOOTIES as applied for in Application Serial No. 85/839147, and (2) the word mark and design  as applied for in Application Serial No. 85/839153 (the “BOOTIES Marks”). The applications for both Opposed Marks were filed, and are owned by, Booties Restaurants LLC (“Applicant”).

Booty’s, having previously been granted an extension of time to oppose the BOOTIES Marks, hereby opposes same.

As grounds for opposition, Booty’s alleges:

1. On February 1, 2013, Applicant filed for registration of the BOOTIES Marks on the Principal Register as applied to “restaurant services” in International Class (“IC”) 43.
2. Since at least August 1, 2011 – well before the filing date of Applicant’s attempt to register the BOOTIES Marks – Opposer has provided restaurant services under the trade name

BOOTY'S. Opposer has common law trademark rights with respect to the mark BOOTY's as applied to restaurant services and related goods.

3. Opposer also owns and relies on U.S. Registration No. 4,476,287 issued on January 28, 2014 for the mark BOOTY'S as applied to "restaurant services, namely, providing of food and beverages for consumption on and off the premises" in IC 43 and to "alcoholic aperitif bitters; alcoholic cocktail mixes" in IC 33 (the "BOOTY'S Mark").

4. U.S. Registration No. 4,476,287 constitutes *prima facie* evidence of the validity and registration of the BOOTY'S Mark, of Opposer's ownership of the BOOTY'S Mark, and of Opposer's exclusive right to use the BOOTY'S Mark in commerce on or in connection with the goods and services specified in the registration.

5. Opposer's BOOTY'S Mark is a strong and inherently distinctive mark as used in connection with Opposer's goods and services.

6. Opposer has received considerable notice from local and national media, including "New Orleans' Best New Restaurant 2013" award from *New Orleans Magazine* and "So Hot Right Now" 2013 award from *Eater*. Additional local and national media notices include, *Vogue*, *Business Insider*, and *The Times-Picayune*, as well as substantial notice on social media sites. Opposer was also featured on the TV program "Bounce," a Big Freedia show on Fuse TV.

7. In addition to the local and national attention, Opposer has received considerable notice from international media as well, including *BBC Travel*, *Vogue France*, and *Harper's Bazaar Germany*. Opposer was also featured on the TV program "Rebel Without a Cause" on the Canadian Travel + Escape channel.

8. Launching in a city noted for its culinary offerings, Opposer's restaurant has found a new niche for diners to explore, namely, street food from around the world and globally-inspired

cocktails. The location of Opposer’s first “Booty’s” restaurant in New Orleans – a destination for tourists and people with an avid interest in new food experiences (commonly called “foodies”) – has amplified the effects of Opposer’s favorable media attention and brought Opposer fame.

**Priority**

9. Applicant filed its applications to register both of the BOOTIES Marks on an “intent to use” basis.

10. Applicant may only assert “constructive” use of the BOOTIES Marks as of February 1, 2013, well after Opposer had adopted its BOOTY’S trade name and begun use of its BOOTY’S Mark.

11. BOOTY’S constitutes a trade name “previously used in the United States by another and not abandoned.”

12. Also, Opposer’s BOOTY’S Mark is valid and enforceable as shown in **Exhibit A**.

13. Opposer has priority over Applicant with respect to restaurant services and related goods and, therefore, the registration of the BOOTIES Marks is improper under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

**Likelihood of Confusion**

14. Applicant’s BOOTIES Marks so resemble Opposer’s registered BOOTY’S Mark and trade name as to be likely to cause confusion, or to cause mistake, or to deceive when used in connection with the “restaurant services” identified in the applications for registration:

- a. Applicant’s BOOTIES Marks are phonetically identical to Opposer’s BOOTY’S Mark and trade name;
- b. The spelling and appearance of Applicant’s Marks are substantially similar to Opposer’s Mark and trade name, with the first four letters being identical (“B-O-O-T”) and the last letter also being identical (Applicant’s Marks are pluralized and end in “s” while Opposer’s Mark is possessive and ends in “s”);

- c. Applicant's and Opposer's services are identical (restaurant services);
- d. The meaning of "Booties" and "Booty's" is also identical as dictionary entries show that the two are alternative spellings of the same word signifying "a person's buttocks" (although Opposer uses the word "booty" in its meaning of "valuable goods). See **Exhibit B**.

15. Opposer has no connection to Applicant or its services. However, if Applicant were to use its proposed BOOTIES Marks in connection with restaurant services in IC 43, a connection to Opposer (and Opposer's BOOTY'S Mark) would likely occur as a result of consumer confusion.

16. Given the substantial similarity between Applicant's BOOTIES Marks and Opposer's BOOTY'S Mark and trade name and given the resulting likelihood of consumer confusion, Applicant is not entitled to federal registration of its BOOTIES Marks under to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

#### **Dilution**

17. Applicant's BOOTIES Marks will dilute the distinctiveness of Opposer's BOOTY'S Mark and common law trademark rights and should therefore also be denied registration under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

18. Opposer's BOOTY'S Mark and restaurant services have gained fame and enjoy widespread recognition, with people coming from across the country to eat at Opposer's restaurant as evidenced by the nation- and worldwide comments posted on social media sites as well as national and international press reviews.

19. Given the degree of similarity between Applicant's and Opposer's marks and services, registration of Applicant's BOOTIES Marks will cause dilution by blurring.

20. Applicant's BOOTIES Marks will also cause dilution by tarnishment since Applicant styled its design mark in a manner to emphasize the risqué meaning of "booty" (the

mark in Application Serial No. 85/839153 is described as a “stylized depiction of the word "BOOTIES", where the letters "OO" in said depiction depict a person's buttocks”).

21. Registration of the Applicant’s BOOTIES Marks will damage the fame and reputation of the services provided by Opposer under its BOOTY’S Mark and common law trademarks by changing the perception of the BOOTY’S Mark from a thing of value to one of an overtly sexualized nature, thereby portraying the mark in a negative light.

WHEREFORE, Booty’s, LLC respectfully prays that this Consolidated Opposition be sustained and that Application Serial Nos. 85/829147 and 85/839153 be refused registration.

Opposer submits herewith the requisite filing fee of \$600.00 for opposition of the two separate marks.

Respectfully submitted,

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/MBreaux/

Marie Breaux  
Adriano Pacifici  
M Breaux Intellectual Property Law LLC  
700 Camp Street, Suite 418  
New Orleans, LA 70130  
(504) 975-1462  
marie@mbipl.com; adriano@mbipl.com

Andrew Legrand  
Chadwick Tobler  
Andrew Legrand Law, LLC  
4035 Washington Avenue  
New Orleans, Louisiana 70125  
(504) 300-9938  
al@andrewlegrandlaw.com

*Attorneys for Opposer Booty’s, LLC*

## **CERTIFICATE OF MAILING**

I hereby certify that a copy of the attached CONSOLIDATED NOTICE OF OPPOSITION (together with all exhibits and a copy of this Certificate) was served this 25th day of November 2014 by US Mail and email to:

Douglas Burda  
Burda IP  
P.O. Box 1532  
La Jolla, CA 92038  
douglas@burda.co

Dated: November 25, 2014

/s/ Marie Breaux

# **Exhibit A**



**Owner** (REGISTRANT) Booty's LLC DBA Booty's LIMITED LIABILITY COMPANY LOUISIANA 800  
Louisa Street New Orleans LOUISIANA 70117

**Attorney of Record** Andrew Legrand

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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Mark: BOOTY'S

Booty's

US Serial Number: 85980764      Application Filing Date: May 14, 2012  
US Registration Number: 4476287      Registration Date: Jan. 28, 2014  
Filed as TEAS Plus: Yes      Currently TEAS Plus: Yes  
Register: Principal  
Mark Type: Trademark, Service Mark  
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.  
Status Date: Jan. 28, 2014  
Publication Date: Mar. 19, 2013      Notice of Allowance Date: May 14, 2013

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### Mark Information

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Mark Literal Elements: BOOTY'S  
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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### Related Properties Information

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Claimed Ownership of US Registrations: 85624236  
Child Of: 85624236

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### Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [.] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "\*" identify additional (new) wording in the goods/services.

For: Alcoholic aperitif bitters; Alcoholic cocktail mixes

International Class(es): 033 - Primary Class

U.S Class(es): 047, 049

Class Status: ACTIVE

Basis: 1(a)

First Use: Nov. 30, 2012

Use in Commerce: Nov. 30, 2012

For: Restaurant services, namely, providing of food and beverages for consumption on and off the premises

International Class(es): 043 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 01, 2011

Use in Commerce: Aug. 01, 2011

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### Basis Information (Case Level)

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Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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### Current Owner(s) Information

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Owner Name: Booty's LLC  
DBA, AKA, Formerly: DBA Booty's

Owner Address: 800 Louisa Street  
New Orleans, LOUISIANA 70117  
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: LOUISIANA

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## Attorney/Correspondence Information

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### Attorney of Record

Attorney Name: Andrew Legrand  
Attorney Primary Email Address: [al@andrewlegrandlaw.com](mailto:al@andrewlegrandlaw.com)

Attorney Email Authorized: Yes

### Correspondent

Correspondent Name/Address: Andrew Legrand  
Andrew Legrand Law, LLC  
4035 Washington Avenue  
New Orleans, LOUISIANA 70125  
UNITED STATES  
Phone: (504) 300-9938  
Correspondent e-mail: [al@andrewlegrandlaw.com](mailto:al@andrewlegrandlaw.com)

Fax: (504) 684-8505

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

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## Prosecution History

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Date	Description	Proceeding Number
Jan. 28, 2014	REGISTERED-PRINCIPAL REGISTER	
Dec. 21, 2013	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Dec. 20, 2013	LAW OFFICE REGISTRATION REVIEW COMPLETED	68171
Dec. 20, 2013	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Dec. 12, 2013	STATEMENT OF USE PROCESSING COMPLETE	70565
Nov. 11, 2013	USE AMENDMENT FILED	70565
Dec. 12, 2013	DIVISIONAL PROCESSING COMPLETE	
Nov. 11, 2013	DIVISIONAL REQUEST RECEIVED	
Dec. 09, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	70565
Nov. 11, 2013	TEAS REQUEST TO DIVIDE RECEIVED	
Nov. 11, 2013	TEAS STATEMENT OF USE RECEIVED	
Nov. 05, 2013	TEAS POST PUBLICATION AMENDMENT RECEIVED	
May 14, 2013	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Mar. 19, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Mar. 19, 2013	PUBLISHED FOR OPPOSITION	
Feb. 27, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Feb. 13, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Feb. 13, 2013	ASSIGNED TO LIE	68171
Feb. 04, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 01, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jan. 31, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jan. 31, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 10, 2012	NOTIFICATION OF PRIORITY ACTION E-MAILED	6326
Sep. 10, 2012	PRIORITY ACTION E-MAILED	6326
Sep. 10, 2012	PRIORITY ACTION WRITTEN	82104
Sep. 05, 2012	ASSIGNED TO EXAMINER	82104
May 18, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 17, 2012	NEW APPLICATION ENTERED IN TRAM	

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## TM Staff and Location Information

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TM Staff information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 20, 2013

# **Exhibit B**

# booty



4 ENTRIES FOUND:

- booty
- bootee
- bootle

<sup>1</sup>boo·ty *noun* \ˈbū-tē\

*plural* booties

**Definition of BOOTY**

2-1

- 1 : plunder taken (as in war); *especially* : plunder taken on land as distinguished from prizes taken at sea
- 2 : a rich gain or prize

**Origin of BOOTY**

modification of Middle French *butin*, from Middle Low German *būte* exchange  
 First Known Use: 15th century

**Rhymes with BOOTY**

beauty, Cloutie, cootie, cutie, duty, fluty, fruity, hooty, rooty, snooty, tuttl, zooty

<sup>2</sup>booty *noun* \ˈbū-tē\

*plural* booties

**Definition of BOOTY**

*slang*

: BUTTOCK

**Variants of BOOTY**

booty also boo·tie *n*

**Origin of BOOTY**

alteration of an English-based creole word, ultimately from Early Mod English *\*bottie* buttocks, perhaps from *bottom* + *-ie*  
 First Known Use: 1928