

ESTTA Tracking number: **ESTTA700826**

Filing date: **10/07/2015**

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	University of Southern California
Granted to Date of previous extension	10/07/2015
Address	University Park CampusADM 352 - Mail Cod Los Angeles, CA 90089-5013 UNITED STATES

Attorney information	Michael S Adler University of Southern California 1901 Avenue of the Stars, Suite 1000 Los Angeles, CA 90024 UNITED STATES madler@ta-llp.com Phone:310-734-8695
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**Applicant Information**

Application No	86504585	Publication date	06/09/2015
Opposition Filing Date	10/07/2015	Opposition Period Ends	10/07/2015
Applicant	Fogcutter Industries, Inc. 530 Alameda Del Prado #325 Novato, CA 94949 UNITED STATES		

**Goods/Services Affected by Opposition**

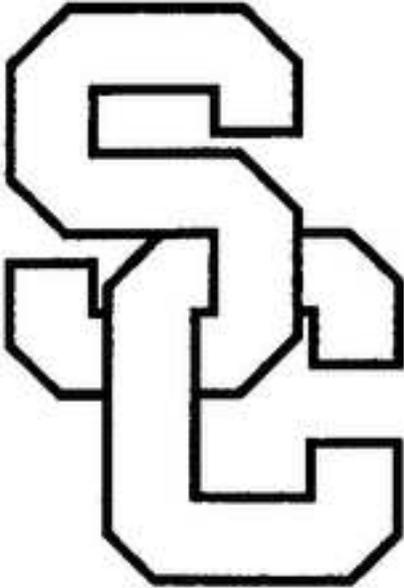
Class 033. First Use: 2009/06/03 First Use In Commerce: 2009/06/03 All goods and services in the class are opposed, namely: Rum
Class 043. First Use: 2009/06/03 First Use In Commerce: 2009/06/03 All goods and services in the class are opposed, namely: Bar and cocktail lounge services; Bar services; Cocktail lounge services

**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)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

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

U.S. Registration No.	2683137	Application Date	02/22/2002
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Registration Date	02/04/2003	Foreign Priority Date	NONE
Word Mark	S C		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Metal frames for metal license plates; and metallic car emblems</p> <p>Class 016. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Decals; folders; 3-ring binders; personal organizers; calendars; pencils; pens; [erasers; ] pencil sharpeners, [ pen or pencil holders; desktop business card holders; ] note paper; [ wrapping paper;] paper napkins; and paper tablecloths</p> <p>Class 018. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Umbrellas; luggage, namely, tote bags, hand luggage, garment bags and overnightbags; shoe bags for travel; fanny packs; toiletry bags sold empty; briefcases; backpacks; duffel bags; wallets; business card cases; luggage tags; animal leashes; and dog collars</p> <p>Class 021. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Porcelain and glass mugs; cups; drinking glasses; shot glasses; commemorative and decorative plates; coasters; paper plates; thermal insulated containers for food or beverage; portable beverage coolers; plastic sports bottles sold empty; and pet bowls</p> <p>Class 024. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Towels; stadium blankets; cloth pennants; and cloth flags</p> <p>Class 025. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Clothing, namely, t-shirts, sweatshirts, polo shirts, warm-up suits, jackets, rain ponchos, sweaters, jerseys, tank tops, shorts, sport shirts, baseball shirts, basketball jerseys, golf sweaters, night shirts, boxer shorts, socks, hats, caps, sport caps, visor caps, beanies and ties</p> <p>Class 028. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Sporting goods, namely, baseballs, footballs, golf balls, golf tees, golf bags, [putters, ] golf club covers, [ racketcovers, flying discs, ] and foam fingers; arcade-type electronic video games; playthings, namely, plush toys, and [ ride-on</p>		

	<p>toys; playing cards ]</p> <p>Class 035. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 On-line retail store services featuring men's, women's and children's clothing, footwear, hats, accessories, sporting goods, gifts and novelty items</p> <p>Class 041. First use: First Use: 1993/00/00 First Use In Commerce: 1994/00/00 Entertainment services, namely, conducting athletic competitions; organizing intercollegiate, community and national sporting and cultural events; sports instruction; and providing musical, band, dance, theatrical and dramatic performances</p>
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U.S. Registration No.	1844953	Application Date	09/05/1990
Registration Date	07/12/1994	Foreign Priority Date	NONE
Word Mark	SC		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1926/00/00 First Use In Commerce: 1978/00/00 keyrings of non-precious metals; decorative emblems or plates of non-precious metal, for attachment to autos; [ art work statuary of non-precious metals, ] all goods being offered and sold to persons through university authorized channels of trade</p> <p>Class 018. First use: First Use: 1926/00/00 First Use In Commerce: 1987/00/00 umbrellas, hand luggage, tote bags, luggage; namely, tote bags, hand luggage, garment bags for travel, and small traveling bags for overnight trips, fanny packs, toiletry bags sold empty, briefcases, back packs, all goods being offered and sold to persons through university authorized channels of trade</p> <p>Class 024. First use: First Use: 1926/00/00 First Use In Commerce: 1987/00/00 towels, blankets, cloth pennants, and cloth flags, all goods being offered and sold to persons through university authorized channels of trade</p> <p>Class 025. First use: First Use: 1926/00/00 First Use In Commerce: 1987/00/00 sweatshirts and T-shirts, all goods being offered and sold at university-controlled outlets</p>		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SC		
Goods/Services	<p>Opposer University of Southern California has used various forms of the SC Mark (including but not limited to the "baseball" form of SC) for a wide variety of collegiate-related goods and services, both directly and through licensees.</p>		

Attachments	<p>76374729#TMSN.png( bytes )</p> <p>2015-10-07 Opposition to Smugglers Cove.pdf(140116 bytes )</p>
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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	/Michael S. Adler/
Name	Michael S Adler
Date	10/07/2015

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

UNIVERSITY OF SOUTHERN  
CALIFORNIA,

Opposer,

v.

FOGCUTTER INDUSTRIES, INC. DBA  
SMUGGLER'S COVE

Applicant.

Opposition No.

Serial No. 86/504,585

Mark: SC

Filed: January 15, 2015

Published: June 9, 2015

**NOTICE OF OPPOSITION**

Opposer, the University of Southern California, a California non-profit corporation located at University Park, ADM 352, Los Angeles, California hereby files this Notice of Opposition against the captioned application (the "SMUGGLER'S COVE SC Application"), alleging as follows:

1. Based on Opposer's previous request to extend the time in which to oppose the SMUGGLER'S COVE SC Application, the deadline to file a Notice of Opposition is October 7, 2015.

2. On knowledge and belief, the SMUGGLER'S COVE SC Application is owned by Fogcutter Industries, Inc. d/b/a Smuggler's Cove, a corporation under the laws of the State of California having a principal address of 530 Alameda Del Prado #325, Novato, California 94949.

3. According to the current records of the United States Patent and Trademark Office, the SMUGGLER'S COVE SC Application is an application for registration a design mark

that consists of two concentric circles with three broken horizontal lines equally spaced apart inside the inner circle depicting the top of a wooden barrel as viewed from above with a stylized "SC" in the center of the inner circle on top of the horizontal lines. The stylized "S" and stylized "C" are woven within each other. The application seeks to register the design mark in International Class 33 for rum and in International Class 43 for "Bar and cocktail lounge services; Bar services; Cocktail lounge services."

4. Opposer is the oldest private research university in the Western United States, with a national and international reputation. Opposer has not only provided a wide variety of collegiate goods and services on its own account, but Opposer has also licensed various goods and services under the SC mark and various related marks for decades. Opposer and its authorized licensees have used the SC mark and various related marks including SC in commerce continuously since at least 1900. Opposer's SC mark is a highly distinctive collegiate mark and through extensive advertising and use, the SC mark has become strongly associated with Opposer's goods and services. In particular, without limitation:

5. Opposer is the owner of Federal Registration 2,683,137 for the mark "SC" in International Classes 12, 16, 18, 21, 24, 25, 28, 35, and 41. Registration No. 2,683,137 is valid, subsisting, and incontestable. Opposer has used the SC mark and various related marks in connection with the goods and services in that registration continuously since at least 1994.

6. Opposer is also the owner of Federal Registration 1,844,953 for the mark "SC" in International Classes 6, 18, 24, and 25. Registration No. 1,844,953 is valid, subsisting, and incontestable. Opposer has used the SC mark and various related marks in connection with the goods in that registration continuously since at least 1987.

7. Opposer is also the owner of common law rights in the name SC and various related marks arising from Opposer's educational and athletic programs beginning as early as 1880. This includes Opposer's "Baseball Interlock," which is an interlocking form of the SC Mark that Opposer has used continuously since at least 1954. In addition to Opposer's own use, Opposer has licensed the SC Mark to numerous third parties for goods and services, and the use of the SC name and related marks (whether by Opposer or its licensees) inures to the benefit of Opposer and provides Opposer with additional common law rights upon which Opposer relies in this Opposition.

8. As a result of extensive advertisement, promotion, and sale of goods and services using the SC mark, the mark has gained widespread and favorable public acceptance and recognition. The University of Southern California's SC mark (and related marks) are associated with and identify Opposer.

9. Opposer has developed valuable good will with respect to the SC mark.

10. The SC mark is a famous and distinctive mark, and represents an asset of incalculable value as a symbol of Opposer, the University of Southern California, its quality goods and services, and its goodwill.

11. Opposer believes that it will be damaged by the registration of the Applicant's proposed mark both because an appreciable number of members of the consuming public may improperly assume that applicant's services are associated with, endorsed by, or affiliated with Opposer and further because registration of the Applicant's proposed mark would lead to tarnishment and/or dilution of Opposer's established registration and common law rights in SC and various related marks. Opposer therefore has a real interest and a direct stake in the outcome of the proceeding and Opposer opposes the registration in whole.

12. Opposer's trademark rights in the SC mark are valid, subsisting and have not been abandoned. Applicant's application was filed claiming a first use date of June 2009, and as such, Opposer's right have priority.

13. Opposer's SC mark and its related marks are similar to the dominant part of Applicant's mark in sight and sound. Although Applicant's mark may not create confusion when used inside of Opposer's existing bar in Northern California, Applicant's proposed national application would create a confusingly similar mark.

14. The Applicant's application includes goods and services which are similar to goods and services which are already provided by Opposer and/or its licensees. For example, Opposer operates numerous food service operations, and while Opposer does not produce alcoholic beverages, Opposer does sell and/or license numerous beverages.

15. If Applicant were granted the registration herein opposed, Applicant would thereby obtain at least a *prima facie* exclusive right to use the mark across the nation. Such registration would cause damage and injury to Opposer.

16. Opposer further alleges on information and belief that Applicant has not continuously produced its own brand of rum, and that the application is improper and fraudulent as to Class 33.

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Wherefore, Opposer prays that the application Serial Number 86/504,585 be rejected, and that the mark therein sought for the services specified above in International Classes 33 and 43 be denied and refused.

Dated: October 7, 2015

Respectfully submitted,

TANTALO & ADLER, LLP

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Michael S. Adler  
1901 Avenue of the Stars, Suite 1000  
Los Angeles, CA 90067  
Telephone: (310) 734-8694

Attorneys for Opposer  
University of Southern California

Reference no. 93107-00125

Opposition

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was placed in the United States mail, first class, postage pre-paid, addressed to the following on this 7<sup>rd</sup> day of October, 2015.

Mark Rennie

870 Market Street, Ste 1260

San Francisco, CA 94102-2917

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Gina Sohn