

ESTTA Tracking number: **ESTTA440690**

Filing date: **11/11/2011**

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

Proceeding	92053501
Party	Plaintiff Christian M. Ziebarth
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Date	11/11/2011
Attachments	Petitioner Opposition to Respondent Motion - NAUGLES.pdf (17 pages) (768370 bytes) Declaration in Support of Petitioner Opposition - NAUGLES.pdf (32 pages) (1819680 bytes)

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

Christian M. Ziebarth,
an individual residing in California,
Petitioner,

v.

Del Taco, LLC
a California limited liability company,
Respondent.

Cancellation No. 92053501

I hereby certify that this correspondence is being transmitted by electronic mail to the Trademark Trial and Appeal Board through its web site located at <http://estta.uspto.gov> on

November 11, 2011



Gregory B. Phillips

**PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER
RULE 2.120(E) AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S
RESPONSES TO ADMISSION REQUESTS UNDER RULE 2.120(H)**

I. INTRODUCTION

Petitioner Mr. Christian M. Ziebarth ("Petitioner") has sought to cancel U.S. Registration No. 1,043,729 for the mark NAUGLES based on the ground that Respondent Del Taco, LLC ("Respondent") abandoned the mark in connection with restaurant services several years ago. Naugles was a fast food restaurant serving a combination of American and Mexican themed foods and beverages. Petitioner's investigation revealed that the Naugles restaurant chain was converted into Del Taco restaurants and that the NAUGLES mark was phased out numerous years ago.

Based upon Petitioner's investigation and belief that Respondent had abandoned the NAUGLES mark, Petitioner began planning his own Naugles restaurant and sought a federal trademark registration for the mark NAUGLES. Petitioner's application was refused

registration, however, when the Examining Attorney cited Respondent's NAUGLES registration, which is the registration subject of this cancellation action. Petitioner thereafter filed a cancellation action in connection with Respondent's NAUGLES registration based on the ground of abandonment.

Respondent propounded on Petitioner (1) Respondent's First Set of Interrogatories [Nos. 1-15] and Requests for Production of Documents [Nos. 1-27] to Petitioner and (2) Respondent's First Set of Requests for Admission [Nos. 1-72] to Petitioner (collectively "Respondent's Discovery Requests"). All but one of Respondent's Discovery Requests sought information regarding Petitioner's use or planned use of the mark NAUGLES rather than anything having to do with Petitioner's claim that Respondent abandoned the NAUGLES mark. Petitioner objected to Respondent's Discovery Requests, including on the bases of relevance and that the requests were not reasonably calculated to lead to the discovery of admissible evidence.¹ Respondent has argued that Respondent's Discovery Requests are relevant in determining Petitioner's standing in this cancellation action and potential equitable defenses, including unclean hands. Petitioner's use or intent-to-use of the NAUGLES mark, however, has no bearing on Petitioner's standing in this matter and would not give rise to an alleged equitable defense, including unclean hands. Petitioner clearly has standing, based at least on Petitioner's refused federal application for the mark NAUGLES. Accordingly, the Trademark Trial and Appeal Board ("Board") should deny Respondent's Motion to Compel and Test the Sufficiency of Petitioner's Responses to Admission Requests ("Respondent's Motion").

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¹ Petitioner does not object on the basis of relevance to Respondent's Document Request No. 27, and Petitioner responded to this Document Request. Petitioner maintains its other objections to Document Request No. 27, which were not addressed in Respondent's Motion.

II. STATEMENT OF FACTS

Petitioner has sought to cancel Respondent's U.S. Registration No. 1,043,729 for the mark NAUGLES in connection with restaurant services, based on the ground of abandonment. Petitioner's investigation revealed that the Naugles restaurant chain was founded in the 1970s, and had various ownership changes during the 1980s before finally being acquired by Respondent and its predecessors in 1988. *See Phillips Decl.*, Ex. 1. Respondent also owns the Del Taco fast food restaurant chain. Petitioner's investigation revealed that beginning in 1989, Respondent began converting and changing its Naugles restaurants into Del Taco restaurants, phasing out the NAUGLES mark. *See id.* Petitioner believes based on its investigation that sometime in the early to mid-1990s, the transition from Naugles to Del Taco was complete and there were no longer restaurants called Naugles. *See id.*, Ex. 2. Petitioner thus concluded that Respondent had abandoned the NAUGLES mark in connection with restaurant services several years ago.

Based upon Petitioner's investigation and belief that Respondent had abandoned the NAUGLES mark, Petitioner began planning his own restaurant, which will be named Naugles. On May 17, 2010, Petitioner filed a federal trademark application for the mark NAUGLES in connection with cafeteria and restaurant services in Class 43, U.S. Serial No. 85/040,746. *See id.*, Ex. 3. Petitioner's application for the mark NAUGLES is based on Petitioner's intent-to-use the mark in connection with the designated services. On September 3, 2010, an Office Action issued in connection with Petitioner's NAUGLES application, wherein the Examining Attorney cited Respondent's NAUGLES registration, U.S. Reg. No. 1,043,729, which is the registration subject of this cancellation action. *See id.*, Ex. 4. On December 20, 2010, Petitioner filed a cancellation action in connection with Respondent's NAUGLES registration, stating that

Respondent had abandoned the mark numerous years earlier and that the registration should be cancelled to allow Petitioner's mark to proceed to registration. On January 10, 2011, a Final Office Action issued in connection with Petitioner's NAUGLES application, maintaining the refusal to register based on a likelihood of confusion with Respondent's NAUGLES mark. *See id.*, Ex. 5. On June 3, 2011, the U.S. Patent and Trademark Office ("PTO") suspended Petitioner's NAUGLES application pending a decision in this cancellation action. *See id.*, Ex. 6.

At the heart of this cancellation action is whether Respondent has abandoned the NAUGLES mark (*i.e.*, whether Respondent can show any use of the NAUGLES mark in connection with restaurant services since the mid-1990s). On April 20, 2011, Respondent propounded Respondent's Discovery Requests, which totaled 114 separate requests. *See* Respondent's Motion, Exs. 1 and 2. All but one of Respondent's Discovery Requests were directed at Petitioner's use or planned use of the mark NAUGLES, rather than anything having to do with Petitioner's claim that Respondent had abandoned the NAUGLES mark. Respondent is clearly using the discovery process in this cancellation action to harass Petitioner and gain highly sensitive information regarding Petitioner's planned restaurant business that will compete directly with Respondent's Del Taco chain of restaurants. Petitioner objected to Respondent's Discovery Requests, including specifically objecting that the requests seek information regarding Petitioner's use and intent-to-use of the NAUGLES mark are irrelevant and not calculated to lead to the discovery of admissible evidence in this cancellation action. *See id.*, Exs. 3 and 4.

Respondent has not submitted an acceptable reason why Respondent's Discovery Requests seeking information regarding Petitioner's use and intent-to-use of the NAUGLES mark are relevant or reasonably calculated to lead to the discovery of admissible evidence in this cancellation action. In Respondent's letter of August 11, 2011, Respondent claimed that

Respondent's Discovery Requests are relevant to Petitioner's standing to file the cancellation action. *See* Respondent's Motion, Ex. 5. In Petitioner's letter of August 21, 2011, Petitioner succinctly explained that Petitioner has standing for this cancellation action, based on at least Petitioner's refused application for the mark NAUGLES, and that Petitioner's use or intent-to-use of the NAUGLES mark is irrelevant in this matter. *See id.*, Ex. 6. Accordingly, the Board should deny Respondent's Motion.

III. MEMORANDUM OF LAW

A. The Board Should Deny Respondent's Motion

Respondent's Motion should be denied because Respondent did not make the required good faith attempt to resolve the discovery dispute. *See* 37 C.F.R. § 2.120(e); T.B.M.P. § 523.02. Here, Respondent sent only one letter to Petitioner regarding the dispute, consisting of only three paragraphs, which did not provide any authority on point to support Respondent's Discovery Requests seeking information regarding Petitioner's use or intent-to-use Petitioner's NAUGLES mark. Petitioner's letter in response discussed this issue, as well as other objections to Respondent's Discovery Request. Rather than continue the discussions, Respondent rushed to the Board with Respondent's Motion. Accordingly, Respondent did not provide a good faith attempt to resolve the parties' disputes and Respondent's Motion should be denied.

Furthermore, as detailed below, Petitioner's objections to Respondent's Discovery Requests, including objections based on relevance and that the requests are not calculated to lead to the discovery of admissible evidence, are proper. Therefore, Respondent's Motion should be denied.

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B. Petitioner's Objections to Respondent's Discovery Requests are Proper and Should be Sustained

As discussed above, Respondent abandoned its NAUGLES mark several years ago. Because Respondent's corresponding registration is blocking Petitioner's application for NAUGLES from maturing to registration, Respondent's registration should be cancelled. Petitioner's objections to Respondent's Discovery Requests are proper. Respondent's Motion addresses only Petitioner's objections that Respondent's Discovery Requests are neither relevant nor reasonably calculated to lead to the discovery of admissible evidence. Accordingly, Respondent does not dispute Petitioner's other objections to Respondent's Discovery Requests. As discussed below in the same order as in Respondent's Motion, Petitioner will show that, (1) all but one of Respondent's Discovery Requests are irrelevant and not calculated to lead to the discovery of admissible evidence and (2) Petitioner's objections to Respondent's Discovery Requests, based on relevance and that the requests are not reasonably calculated to lead to the discovery of admissible evidence, are proper and should be sustained.

1. Interrogatories Nos. 1-15, Document Requests Nos. 1-26, and Requests for Admissions Nos. 1-32

Petitioner objects to Respondent's Interrogatories Nos. 1-15, Document Requests Nos. 1-26, and Requests for Admissions Nos. 1-32, which seek information and documents regarding Petitioner's use or intent-to-use the NAUGLES mark in connection with restaurant services. Respondent's Motion only addresses Petitioner's objections that these discovery and admission requests are irrelevant and not calculated to lead to the discovery of admissible evidence. In Respondent's Motion, Respondent argues that, (1) Petitioner's adoption, selection and use of Petitioner's NAUGLES mark is discoverable, (2) Respondent's Discovery Requests are relevant

to Petitioner's standing in this cancellation action, and (3) if Petitioner does not have standing, Respondent's Discovery Requests are relevant to support an equitable defense of unclean hands. For the reasons set forth below, the information regarding Petitioner's use or intent-to-use of the NAUGLES mark is not discoverable in this cancellation action based on abandonment, Petitioner has standing and thus, the equitable defense of unclean hands is not available.

a. **Petitioner's Use or Intent-to-Use the Mark NAUGLES is Not Information within the Scope of Discovery for this Cancellation Action**

Respondent's Discovery Requests aimed at determining Petitioner's use or intent-to-use of the NAUGLES mark are irrelevant and not reasonably calculated to lead to the discovery of admissible evidence. Petitioner has sought to cancel Respondent's NAUGLES registration on the ground that Respondent had abandoned use of the NAUGLES mark several years ago. A rebuttable presumption of abandonment arises when Petitioner establishes a *prima facie* case by showing Respondent's nonuse of the mark for three consecutive years. 15 U.S.C. § 1127; *see also Cervecería Centroamericana S.A. v. Cervecería India Inc.*, 892 F.2d 1021, 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989). Respondent then has the burden of production to rebut the presumption of abandonment by showing use of the mark, or excusable nonuse and that, during the period of nonuse, Respondent maintained an intent to resume use of the mark. *See Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 U.S.P.Q.2d 1390 (Fed. Cir. 1990).

Although the scope of discovery in a cancellation action is broad, the scope of discovery is limited to nonprivileged matter that is *relevant* to any party's claim or defense. *See* Fed. R. Civ. P. 26(b)(1); T.B.M.P. § 402.01. Relevance is a critical limitation in the scope of discovery. "While the scope of discovery is therefore somewhat broad, parties may not engage in 'fishing

expeditions' and must act reasonably in framing discovery requests." T.B.M.P. § 402.01. Petitioner's use or intent-to-use of its NAUGLES mark is irrelevant to whether Respondent has abandoned its use of the mark NAUGLES. The petitioner in *Nirvana, Inc. v. Nirvana For Health Inc.*, n.4, 2010 WL 5099662 (T.T.A.B. Dec. 1, 2010) (not precedential) sought to cancel a registration based on abandonment. The petitioner submitted into evidence numerous documents regarding the petitioner's conception and use of its mark. *Id.* The Board stated that documents pertaining to the petitioner and the details of its business and mark are mostly irrelevant to the petitioner's abandonment claim, which "involves the nature and extent of *respondent's* use of its mark, *not* the nature and extent of *petitioner's* use of its own mark." *Id.* (emphasis added).

Respondent's Discovery Requests aimed at obtaining information and documents relating to Petitioner's use or intent-to-use of the NAUGLES mark are outside the scope of discovery in a cancellation action based on the ground of abandonment. How Petitioner has used or plans to use its NAUGLES mark is irrelevant to whether Respondent has abandoned its use of the NAUGLES mark or can rebut the presumption of abandonment. Respondent is merely staging a "fishing expedition" to harass Petitioner and obtain nonpublic information about Petitioner's planned restaurant that will compete directly with Respondent's Del Taco restaurants.

The authorities that Respondent cites in its Motion to support its theory that Petitioner's use or intent-to-use the mark is discoverable information are not on point. Respondent cites to T.B.M.P. § 414(4) for the authority that "information concerning a party's selection and adoption of its involved mark is generally discoverable." The cases cited in the footnote (Note 5) for T.B.M.P. § 414(4), however, do *not* pertain to a cancellation action based on abandonment. The cases cited in Note 5 involve, (1) an opposition based on geographical descriptiveness, (2) an opposition based on descriptiveness and (3) an opposition based on likelihood of confusion. *See*

Varian Assoc. v. Fairfield-Noble Corp., 188 U.S.P.Q. 581 (T.T.A.B. 1975); *Goodyear Tire & Rubber Co. v. Tyrco Indus.*, 186 U.S.P.Q. 207 (T.T.A.B. 1975); and *Volkswagenwerk Aktiengesellschaft v. MTD Prods. Inc.*, 181 U.S.P.Q. 471 (T.T.A.B. 1974). For each of these grounds, information regarding the applicant's adoption of its mark is directly relevant to the claims pleaded in the oppositions. In contrast, the petitioner's selection and adoption of its mark is irrelevant in a cancellation action based on the ground that the respondent abandoned its mark subject of the registration.

Furthermore, T.B.M.P. § 414(5), which states that "information concerning a party's first use of its involved marks is discoverable," does not support Respondent's Motion. The cases cited in the footnote (Note 6) for T.B.M.P. § 414(5) involve oppositions and a cancellation action that are all based on the ground of likelihood of confusion. *See Georgia-Pacific Corp. v. Great Plains Bag Co.*, 109 U.S.P.Q. 193 (T.T.A.B. 1976); *Miller & Fink Corp. v. Servicemaster Hospital Corp.*, 184 U.S.P.Q. 495 (T.T.A.B. 1975); and *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609 (T.T.A.B. 1991). In a likelihood of confusion analysis, the parties' respective first use dates are critical to establish which party has priority for the mark. Here, in a cancellation action based on the ground of abandonment, there is no issue regarding whether Petitioner or Respondent has priority to the NAUGLES mark.

Overall, Respondent's Discovery Requests seeking information regarding Petitioner's use or intent-to-use of the NAUGLES mark are irrelevant and not reasonably calculated to lead to the discovery of admissible evidence, and Respondent has cited to no authority to support its position to the contrary. As discussed below, information regarding Petitioner's use or intent-to-use of the NAUGLES mark is also irrelevant to the issue of standing and thus has no bearing on Respondent's proposed equitable defense of unclean hands.

b. Petitioner Has Established Standing

Petitioner has standing for this cancellation action. Pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064, a party has standing to file a cancellation action if it believes it will be damaged by the registration of a mark. In *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185, 188 (C.C.P.A. 1982), the Court determined that a party has standing to oppose or petition to cancel “if that party can demonstrate a real interest in the proceeding.” The Court in *Lipton* stated that, “[t]he purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, where a plaintiff, petitioner or opposer, is no more than an intermeddler.” *Lipton*, 213 U.S.P.Q. at 189. Thus, a petitioner in a cancellation action meets the standing requirement by showing a real interest in the proceeding. *See id.*

The Board has determined that a real interest in the proceeding is shown, and thus standing established, when the opposer or petitioner owns a federal application that is refused registration in light of the application or registration subject of the opposition or cancellation action. *See Life Zone Inc. v. Middleman Group Inc.*, 87 U.S.P.Q.2d 1953, 1959 (T.T.A.B. 2008). In *Life Zone*, the Board ruled that the opposer had a real interest in the dispute because the record showed that opposer’s federal trademark application was refused registration on the basis of a likelihood of confusion with the mark subject of the opposed application. *Id.* Standing for a cancellation action is analyzed in the same manner as standing for an opposition matter. *See Ritchie v. Simpson*, 170 F.3d 1092, n.2, 50 USPQ2d 1023, n.2 (Fed. Cir. 1999). Standing in an opposition or cancellation action is interpreted quite liberally. *See Lipton*, 213 U.S.P.Q. at 190 (“the public interest is served, contrary to appellant’s view, in broadly interpreting the class of persons Congress intended to be allowed to institute cancellation proceedings”).

Here, Petitioner has standing to bring this cancellation action against Respondent's registration. As detailed in the Petition for Cancellation, Petitioner states that it is the owner of U.S. Serial No. 85/040,746 for the mark NAUGLES in connection with cafeteria and restaurant services, and that Petitioner's application was refused registration based on a likelihood of confusion with the NAUGLES mark subject of Respondent's registration. See Petition for Cancellation, ¶¶ 1, 2 and 11. Petitioner has produced to Respondent a copy of the file history for Petitioner's NAUGLES application, which includes a copy of the Office Actions refusing registration of Petitioner's application. Petitioner will enter into the record copies of its refused application and the aforementioned Office Actions during the testimony period. Petitioner clearly has standing in this proceeding.

There is no authority in Respondent's Motion to support a theory that Petitioner's use or intent-to-use of the NAUGLES mark at the time Petitioner filed its application is relevant to the issue of standing in a cancellation action based on abandonment. Respondent's strained argument is that, if Respondent can prove that Petitioner did not have the *bona fide* intent-to-use the NAUGLES mark at the time Petitioner filed its federal application for the NAUGLES mark, then Respondent could somehow invalidate Petitioner's application, which would then possibly end Petitioner's standing in this cancellation action. Respondent cites no authority that discusses the relevance of a petitioner's use or intent-to-use of its mark in connection with a cancellation action based on the ground of abandonment. Rather, Respondent cites two cases, *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503 (T.T.A.B. 1993) and *The Saul Zaentz Company dba Tolkien Enterprises v. Joseph M. Bumb*, 95 U.S.P.Q.2d 1723 (T.T.A.B. 2010), that involve oppositions that are based on the grounds of, *inter alia*, fraud due to the respective applicant's lack of a *bona fide* intent-to-use its mark at the time the application was

filed. Here, there is no claim of fraud against Petitioner's mark and therefore, the cases cited in Respondent's Motion are not on point.

Furthermore, even assuming arguendo that, (1) Petitioner's use or intent-to-use of the NAUGLES mark is relevant in this cancellation action, and (2) Petitioner cannot prove it had a *bona fide* intent-to-use the mark at the time Petitioner filed its application (although Petitioner can prove it had a *bona fide* intent-to-use), Respondent has not cited to any authority to show that Respondent could then invalidate Petitioner's application, which is currently suspended pending a decision in this cancellation action. Accordingly, Petitioner's use or intent-to-use of its NAUGLES mark is irrelevant to the issue of standing in this cancellation action based on Respondent's abandonment of its NAUGLES mark.

c. Respondent Has Shown No Conduct by Petitioner that Would Support an Equitable Defense of Unclean Hands

Petitioner has not conducted itself in a manner that would give rise to an equitable defense of unclean hands for Respondent. "The doctrine [of unclean hands] bars relief to a plaintiff who has violated conscience, good faith or other equitable principles in his prior conduct, as well as to a plaintiff who has dirtied his hands in acquiring the right presently asserted," and the alleged misconduct by plaintiff must related directly to plaintiff's claims in the suit at hand. *See Dollar Sys., Inc. v. Avcar Leasing Sys., Inc.*, 890 F.2d 165, 173 (9th Cir. 1989). "[U]nclean hands does not constitute 'misconduct in the abstract, unrelated to the claim to which it is asserted as a defense.'" *See Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 841 (9th Cir. 2002) (citing *Republic Molding Corp. v. B.W. Photo Utilities*, 319 F.2d 347, 349 (9th Cir. 1963)). Here, Respondent argues that if Petitioner did not have the *bona fide* intent-to-use the NAUGLES mark at the time Petitioner filed its trademark application, Petitioner's

application is then arguably invalid and Petitioner's act of petitioning to cancel Respondent's registration would arguably give rise to the equitable defense of unclean hands. Respondent has submitted no other conduct by Petitioner that would give rise to an equitable defense of unclean hands for Respondent.

As Respondent states in Respondent's Motion, page 4, "the issue of standing is a threshold issue which must be established by a petitioner in *every inter partes* case." If Respondent could somehow eliminate Petitioner's standing by invalidating Petitioner's application for the NAUGLES mark (which as discussed *supra* Respondent can not), then Petitioner would lack standing and the cancellation action would be dismissed. Accordingly, there would be no need for Respondent to allege an equitable defense of unclean hands. Therefore, Respondent's Discovery Requests seeking information regarding Petitioner's use or intent-to-use the mark are irrelevant and are not reasonably calculated to lead to discovery of admissible evidence on the issue of an equitable defense of unclean hands.

Furthermore, Respondent does not cite to any authority that, (1) supports an argument that an applicant's lack of a *bona fide* intent-to-use of the mark constitutes an act giving rise to an unclean hands defense, or (2) that the equitable defense of unclean hands is proper in a cancellation action based on the ground of abandonment. Respondent's Motion cites to the following cases for support: *Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 U.S.P.Q.2d 1701 (Fed. Cir. 1992); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 U.S.P.Q.2d 1067 (T.T.A.B. 1987); and *Heisch v. Katy Bishop Productions Inc.*, 45 U.S.P.Q.2d 1219 (N.D. Ill. 1997). In *Lincoln Logs*, 23 U.S.P.Q.2d at 1704, an opposition case, only the defenses of laches and estoppel were discussed, and the Court stated that it was "unpersuaded that discovery concerning these defenses would serve any useful

purpose.” In *Midwest*, 5 U.S.P.Q.2d at 1067, petitioner sought to cancel respondent’s certification mark, claiming that respondent had not properly controlled the certification mark. The Court denied respondent’s motion for leave to file an amended answer to add the defense of unclean hands, stating that “no specific allegation of conduct by petitioner, if proved, would prevent petitioner from prevailing on its claim.” *Id.*, 5 U.S.P.Q.2d at 1069. Finally, in *Heisch*, 45 U.S.P.Q.2d at 1221, a copyright infringement case, the Court granted the plaintiff’s motion to strike the defendant’s affirmative defenses, although unclean hands was not alleged in this case. Accordingly, Respondent has not submitted any authority to support a theory that the equitable defense of unclean hands is proper in a cancellation action based on abandonment.

d. Conclusion

For all of these reasons, Petitioner respectfully submits that Respondent’s Motion with respect to Respondent’s Interrogatories Nos. 1-15, Document Requests Nos. 1-26 and Requests for Admissions Nos. 1-32 should be denied.

2. Requests for Admissions Nos. 33-67

Petitioner objects to Respondent’s Requests for Admissions Nos. 33-67, which seek admissions regarding whether Petitioner is the owner and/or operator of numerous social media sites and whether Petitioner has discussed Petitioner’s intended or current use of Petitioner’s NAUGLES mark on these sites. Respondent’s Motion only addresses Petitioner’s objections that Requests for Admissions Nos. 33-67 are irrelevant and not calculated to lead to the discovery of admissible evidence. In Respondent’s Motion, Respondent argues that Petitioner’s ownership and/or operation of numerous social media sites and whether Petitioner discussed Petitioner’s intended or current use of Petitioner’s NAUGLES mark on these sites are relevant to, (1) Petitioner’s *bona fide* intent-to-use Petitioner’s NAUGLES mark and, (2) potential

equitable defenses for Respondent. As outlined above, Petitioner's *bona fide* intent-to-use Petitioner's NAUGLES mark is irrelevant to the claims and defenses alleged in this cancellation action based on the ground of Respondent's abandonment of the its NAUGLES mark. Furthermore, as also discussed above, Respondent has submitted no act by Petitioner that would support an equitable defense of unclean hands. Respondent's Motion does not list any other equitable defenses with respect to Requests for Admissions Nos. 33-67 and accordingly, Petitioner submits that none exist.

Based on the above, Petitioner respectfully submits that Respondent's Motion with respect to Requests for Admissions Nos. 33-67 should be denied.

3. **Requests for Admissions Nos. 68-72**

Petitioner objects to Respondent's Requests for Admissions Nos. 68-72, which seek admissions regarding whether Petitioner's knowledge of Del Taco's ownership of the NAUGLES mark, Del Taco's corresponding NAUGLES registration, and whether the filing of Petitioner's application was with such knowledge. Respondent's Motion only addresses Petitioner's objections that Requests for Admissions Nos. 68-72 are irrelevant and not calculated to lead to the discovery of admissible evidence. In Respondent's Motion, Respondent argues that Petitioner's knowledge of Del Taco's ownership of the NAUGLES mark, Del Taco's corresponding NAUGLES registration, and whether the filing of Petitioner's application was with such knowledge are relevant to, (1) Petitioner's standing to bring this proceeding, and (2) potential equitable defenses, including unclean hands, for Respondent. As outlined above, Petitioner has standing in this cancellation action and Petitioner's *bona fide* intent-to-use Petitioner's NAUGLES mark is irrelevant to the claims and defenses alleged in this cancellation action based on the ground of Respondent's abandonment of its NAUGLES mark. Furthermore,

as also discussed above, Respondent has submitted no act by Petitioner that would support an equitable defense of unclean hands. Respondent's Motion does not list any other equitable defenses with respect to Requests for Admissions Nos. 68-72 and accordingly, Petitioner submits that none exist.

Based on the above, Petitioner respectfully submits that Respondent's Motion with respect to Requests for Admissions Nos. 68-72 should be denied.

IV. CONCLUSION

For the reasons set forth above, Petitioner respectfully requests that the Board deny Respondent's Motion and to lift the suspension of the cancellation proceedings.

Respectfully submitted,

Dated: November 11, 2011

By: 

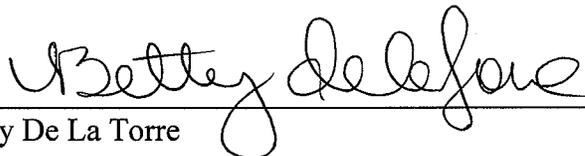
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Ziebarth

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E) AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO ADMISSION REQUESTS UNDER RULE 2.120(H)** upon Respondent's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid on November 11, 2011, addressed as follows:

April L. Besl, Esq.
DINSMORE & SHOHL LLP
255 East Fifth Street
Cincinnati, OH 45202


Betty De La Torre

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

Christian M. Ziebarth,
an individual residing in California,
Petitioner,
v.
Del Taco, LLC
a California limited liability company,
Respondent.

Cancellation No. 92053501

I hereby certify that this correspondence is being transmitted by electronic mail to the Trademark Trial and Appeal Board through its web site located at <http://estta.uspto.gov> on

November 11, 2011



Gregory B. Phillips

**DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF
PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER
RULE 2.120(E) AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S
RESPONSES TO ADMISSION REQUESTS UNDER RULE 2.120(H)**

I, Gregory B. Phillips, declare as follows:

1. I am an associate with Knobbe, Martens, Olson & Bear, LLP, counsel for Petitioner, Mr. Christian M. Ziebarth ("Petitioner"), in the above-identified Cancellation proceedings. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. On May 17, 1989, The Orange County Register published an article titled "Adios to Naugles; Fast-food chain to switch to Del Taco," which discussed Respondent Del Taco, LLC converting its Naugles restaurants into Del Taco restaurants. Attached hereto as Exhibit 1 is a true and correct printout of The Orange County Register article.

3. Respondent Del Taco, LLC released a publication titled "Del Taco The Story of a Rising Brand," which stated that, "1990 proved to be a watershed year for Del Taco. With new management and the Naugles-to-Del Taco transition complete, . . . ". Attached hereto as Exhibit 2 is a true and correct copy of Respondent's publication.

4. On May 17, 2010, Petitioner filed a federal trademark application for the mark NAUGLES in connection with cafeteria and restaurant services, U.S. Serial No. 85/040,746 (“Petitioner’s Application”). Attached hereto as Exhibit 3 is a true and correct printout from the U.S. Patent and Trademark Office’s TARR database for Petitioner’s Application, which was produced to Respondent.

5. On September 3, 2010, an Office Action issued in connection with Petitioner’s Application, refusing registration of Petitioner’s NAUGLES mark on the basis of, *inter alia*, likelihood of confusion with Respondent’s NAUGLES mark, subject of U.S. Reg. No. 1,043,729. Attached hereto as Exhibit 4 is a true and correct copy of the Office Action, without attachments, issued on September 3, 2010, which was produced to Respondent.

6. On January 10, 2011, a Final Office Action issued in connection with Petitioner’s Application, maintaining the refusal to register Petitioner’s NAUGLES mark on the basis of a likelihood of confusion with Respondent’s NAUGLES mark, subject of U.S. Reg. No. 1,043,729. Attached hereto as Exhibit 5 is a true and correct copy of the Final Office Action, without attachments, issued on January 10, 2011, which was produced to Respondent.

7. On June 3, 2011, a Suspension Notice issued in connection with Petitioner’s Application, suspending the application pending the disposition of the subject cancellation action, Cancellation No. 92053501. Attached hereto as Exhibit 6 is a true and correct copy of the Suspension Notice, which was produced to Respondent.

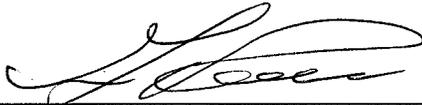
I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States

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Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

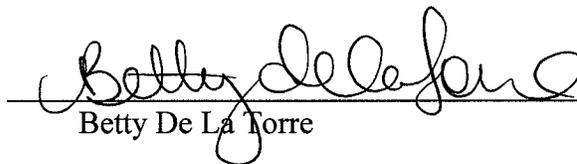
Dated: November 11, 2011

By: 
Gregory B. Phillips

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the forgoing **DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E) AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO ADMISSION REQUESTS UNDER RULE 2.120(H)** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on November 11, 2011, addressed as follows:

April L. Besl, Esq.
DINSMORE & SHOHL LLP
255 East Fifth Street
Cincinnati, OH 45202


Betty De La Torre

12261392

TTAB Cancellation No. 92053501
Ziebarth v. Del Taco, LLC

EXHIBIT 1

**DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF PETITIONER'S
OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E)
AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO
ADMISSION REQUESTS UNDER RULE 2.120(H)**

1 of 1 DOCUMENT

THE ORANGE COUNTY REGISTER

May 17, 1989 Wednesday EVENING EDITION

Adios to Naugles; Fast-food chain to switch to Del Taco

BYLINE: Jeff Rowe, The Register

SECTION: BUSINESS; Pg. C01

LENGTH: 758 words

DATELINE: NEWPORT BEACH, CA

Hola Del Taco, adios Naugles.

Restaurant magnate Anwar Soliman, who owns both chains, said Tuesday he will convert most of the 171 Naugles restaurants into Del Tacos by the end of the summer.

Soliman said the Del Taco name has a stronger Mexican food connotation than Naugles, which was named for its founder, Richard Naugle.

Soliman's company, AWR II Acquisition Corp., converted two Naugles, at 2300 N. Tustin Avenue in Santa Ana and in Long Beach, about two months ago as a test.

Conversion of the other Naugles restaurants is under way, said Soliman. He is chairman and chief executive of both AWR II and American Restaurant Group, which operates about 360 other restaurants, including the Velvet Turtle, Black Angus, Spoons and Grandy's chains.

AWR II has not quite figured out what to do with the approximately 20 Naugles that are near Del Taco outlets. For the immediate future, those will remain Naugles, Soliman said.

Menus from the two restaurants already have been combined, and thus the egg burrito, Naugles' breakfast staple, will continue at Del Taco.

Many other items from Naugles' menu will either survive or be reformulated for the Del Taco menu.

Soliman said an ad campaign focusing on the quality of Del Taco and Naugles food will continue. A strategy for announcing the change has not been decided.

AWR II purchased Naugles and the 202 Del Taco outlets in February 1988.

"The first thing we worked on was the combination of the menu, and that is done," Soliman said.

Next, the company formed its management team, naming Wayne

CZIEB0000120

Adios to Naugles; Fast-food chain to switch to Del Taco THE ORANGE COUNTY REGISTER May 17, 1989
Wednesday

Armstrong, president of Del Taco, as president of the combined company, which operates out of Del Taco headquarters in Costa Mesa.

Soliman declined to discuss how much it will cost to renovate the Naugles restaurants, which will include new signs and seating.

In the fast-food world of burgers, tacos and chicken nuggets, Del Taco will have one of the largest menus.

The new Del Taco menu has several varieties of tacos, burritos, fajitas, quesadillas, nachos, salads and burgers. In addition, there are complete meal platters, designed to lure customers for supper, and a self-service drink bar, popularized in recent years at Carl's Jr. restaurants.

Coming up with all these menu concoctions was a difficult task, Soliman insisted.

"It took almost eight months to make the menu adjustments," he said. "For example, with the fajitas, you keep tasting and testing. You put in a little more of this, a little more of that, then another item. By the time you are finished, you have tried nine of them. I gained 30 pounds in the test kitchen.

"But I lost it all," he added.

Soliman was president of the W.R. Grace Restaurant Group in 1977 when it bought the rights to expand Del Taco outside of California. Del Taco was founded in the early 1960s and, like Naugles, its outlets are concentrated in California.

Grace also owned Naugles -- which was founded in the early 1970s -- but sold it in 1980. Naugles then went public but foundered when it expanded too rapidly. Collins Foods International purchased a majority stake in the company in 1985 and bought the remaining shares in 1987.

Del Taco will still be a distant second in the Mexican fast-food business behind Taco Bell, which has about 2,700 restaurants and an estimated 57 percent of the nation's \$ 2.3 billion Mexican fast-food market.

As both Naugles and Del Taco did, the reborn Del Taco will focus on its larger menu and what it describes as better-quality food.

In discussing his prime competition, Soliman did not mention Taco Bell by name but rather referred to the taco giant as "the elephant."

"We're not in the business of price discounting," Soliman said.

"Have you ever had their 59-cent taco?" he asked, referring to Taco Bell's recent campaign for the low-priced taco. "It's worth 59 cents, believe me."

Taco Bell did not return phone calls.

LOAD-DATE: April 10, 1997

LANGUAGE: ENGLISH

GRAPHIC: BLACK & WHITE PHOTO; This Santa Ana Del Taco restaurant was converted from a Naugles in a test program. Now, the entire chain will change over.

CZIEB0000121

Adios to Naugles;Fast-food chain to switch to Del Taco THE ORANGE COUNTY REGISTER May 17, 1989
Wednesday

Copyright 1989 Orange County Register

CZIEB0000122

TTAB Cancellation No. 92053501
Ziebarth v. Del Taco, LLC

EXHIBIT 2

**DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF PETITIONER'S
OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E)
AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO
ADMISSION REQUESTS UNDER RULE 2.120(H)**



25521 Commercentre Drive
Lake Forest, CA 92630
949.462.9300

Del Taco

The Story of a Rising Brand

Del Taco first opened its doors back in 1961, when Ed Hackbarth's taco stand and hamburger stand combined to form a business that has served its customers and owners well ever since. By serving freshly prepared, value for the money Mexican and American favorites, Del Taco's unique business model positioned it to grow to over 500 restaurants in 16 states, making it the second largest quick-service restaurant concept in the Mexican category.

Becoming a Regional Icon

Months after the first restaurant opened, a second opened in Corona, California with a significant addition -- a drive-thru window which was to become an enduring feature of the Del Taco brand. On average today, more than 70 percent of the business is drive thru. The 1960's and 70's saw Del Taco expand across Southern California as it quickly became a cult-like phenomenon with locals and visitors alike. No doubt the brand's locations near the region's colleges, beaches, parks and military bases helped Del Taco become a favorite of the young and hungry.

The 50th Del Taco restaurant opened in February 1977, and the 100th restaurant followed just 19 months later. Franchising became part of the company's expansion plans, and its founder Ed Hackbarth, went on to become one of the company's most successful franchisees.

The 1980's saw Del Taco grow by leaps and bounds. By the end of the decade, Del Taco acquired Southern California-based rival Naugles. The two concepts combined to become one of the strongest competitors in the fast-food industry.

1990 proved to be a watershed year for Del Taco. With new management and the Naugles-to-Del Taco transition complete, the brand redoubled its efforts to ensure customer value and operator opportunity. Aggressive new programs were implemented in brand marketing and promotions, and the company sought improved efficiencies for better and faster customer service.

Setting the National Stage

As a result of these efforts, by the end of the 1990's, Del Taco achieved the Mexican QSR industry's highest annual unit volume (AUV) of more than \$900,000, exceeding Taco Bell's per unit sales. Within two years, that figure jumped to more than \$1 million, making Del Taco a serious contender in the quick serve industry.

By 2006, the company had nearly doubled in size and was acquired by privately-held Sagittarius Brands. In 2008, Del Taco opened its 500th restaurant, expanded to 16 states and achieved system-wide sales of \$563 million.



25521 Commercentre Drive
Lake Forest, CA 92630
949.462.9300

Growing Into the Future

Del Taco has successfully positioned itself for accelerated expansion across the country. The company has signed development agreements that will increase the Del Taco brand by an additional 75 franchised restaurants over the next few years. These new agreements will expand Del Taco's presence in strategically chosen markets from coast to coast.

In order to support this growth, Del Taco has brought in new leadership that is focused on operations, developing marketing strategies relevant to the 21st Century, and designing a fleet of facility types through which Del Taco and its franchisees can expand and succeed. Most importantly, the franchise team is committed to the infrastructure of support franchisees need as they pioneer the brand in new markets nationwide.

At the same time, Del Taco is growing its company-owned restaurant presence and continues to operate more than half of the system's restaurants. This hands-on restaurant commitment continues to give Del Taco both top and bottom line perspective. And because Del Taco has built its business combining value-oriented offerings with premium items, Del Taco has a recipe for thriving no matter the economic climate.

With the tradition of being a family-friendly environment, people of all ages have come to enjoy the flavors of Del Taco, generation after generation. With a solid leadership team in place and a long-term plan for continued growth, Del Taco is poised to combine your entrepreneurial expertise with a brand whose best days have yet to come.

TTAB Cancellation No. 92053501
Ziebarth v. Del Taco, LLC

EXHIBIT 3

**DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF PETITIONER'S
OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E)
AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO
ADMISSION REQUESTS UNDER RULE 2.120(H)**

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-07-06 23:15:24 ET

Serial Number: 85040746 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

NAUGLES

(words only): NAUGLES

Standard Character claim: Yes

Current Status: An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2011-06-03

Filing Date: 2010-05-17

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

Attorney Assigned:
DUBRAY KATHERINE M

Current Location: L5X -TMEG Law Office 105 - Examining Attorney Assigned

Date In Location: 2011-06-03

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Ziebarth, Christian M.

Address:

Ziebarth, Christian M.
183 Alicante Aisle
Irvine, CA 92614
United States

Legal Entity Type: Individual

Country of Citizenship: United States

Phone Number: (949) 387-1457

GOODS AND/OR SERVICES

International Class: 043

Class Status: Active

Cafeteria and restaurant services

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-06-03 - Notification Of Letter Of Suspension E-Mailed

2011-06-03 - LETTER OF SUSPENSION E-MAILED

2011-06-03 - Suspension Letter Written

2011-01-10 - Notification Of Final Refusal Emailed

2011-01-10 - Final refusal e-mailed

2011-01-10 - Final Refusal Written

2010-12-20 - Applicant amendment prior to exam entered

2010-12-20 - TEAS Voluntary Amendment Received

2010-09-24 - Attorney Revoked And/Or Appointed

2010-09-24 - TEAS Revoke/Appoint Attorney Received
2010-09-03 - Notification Of Non-Final Action E-Mailed
2010-09-03 - Non-final action e-mailed
2010-09-03 - Non-Final Action Written
2010-08-30 - Assigned To Examiner
2010-05-21 - New Application Office Supplied Data Entered In Tram
2010-05-20 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Gregory B. Phillips

Correspondent

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Fax Number: 949-760-9502

TTAB Cancellation No. 92053501
Ziebarth v. Del Taco, LLC

EXHIBIT 4

**DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF PETITIONER'S
OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E)
AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO
ADMISSION REQUESTS UNDER RULE 2.120(H)**

To: Ziebarth, Christian M. (ChristianZ@netscape.net)
Subject: U.S. TRADEMARK APPLICATION NO. 85040746 - NAUGLES - N/A
Sent: 9/3/2010 8:50:48 PM
Sent As: ECOM105@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85040746

MARK: NAUGLES

85040746

CORRESPONDENT ADDRESS:

ZIEBARTH, CHRISTIAN M.
ZIEBARTH, CHRISTIAN M.
183 ALICANTE AISLE
IRVINE, CA 92614-8552

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Ziebarth, Christian M.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

N/A

CORRESPONDENT E-MAIL ADDRESS:

ChristianZ@netscape.net

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 9/3/2010

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SUMMARY OF ISSUES that applicant must address:

CZIEB0000093

- Likelihood of Confusion Refusal
- Surname Refusal
- Clarification of Applicant's Entity Required

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 1043729. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

The Marks are the Same

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

Applicant is seeking registration of the mark NAUGLES. The cited registration is for the identical mark NAUGLES. Because the marks are identical, they share the same appearance, pronunciation, meaning and commercial impression. Consequently, consumer confusion is likely.

The Services are the Same

The application covers the cafeteria and restaurant services. The cited registration covers restaurant services. Additionally, a cafeteria is a type of restaurant. Because the services are identical it is presumed that they are provided to the same consumers in the same channels of trade. Thus, the marks will be encountered by these same consumers and, because the marks are the same, they are likely to think that the services are being provided by a single entity.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265,

62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Because the marks and the services are identical, consumer confusion is likely and registration is refused under Section 2(d) of the Trademark Act.

Applicant should note the following additional ground for refusal.

SECTION 2(e)(4) REFUSAL – PRIMARILY MERELY A SURNAME

Registration is refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *see* TMEP §§1211, 1211.01.

Please see the attached evidence from the Lexis-Nexis database, establishing the surname significance of the surname NAUGLES. This evidence shows the applied-for mark appearing thirty times as a surname in a nationwide telephone directory of names.

Although “NAUGLES” appears to be a relatively rare surname, a rare surname may be unregistrable under Trademark Act Section 2(e)(4) if its primary significance to purchasers is that of a surname. *E.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006); *see* TMEP §1211.01(a)(v). There is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. *See* TMEP §1211.02(b)(i); *see, e.g., In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

Because the proposed mark NAUGLES is a surname that appears to have no meaning other than as a surname, registration on the Principal Register must be refused under Section 2(e)(4) of the Trademark Act.

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

ISSUE REGARDING APPLICANT’S ENTITY TYPE

Applicant is identified in the application as a sole proprietorship named “Ziebarth, Christian M.”, organized in California. In addition to the applicant name and U.S. state or country of organization provided, however, applicant must also specify the name and national citizenship of the individual person who is the sole proprietor. TMEP §803.03(a).

The following format for identifying a sole proprietorship should be used: “Ziebarth, Christian M., a California sole proprietorship, composed of Christian M. Ziebarth, a citizen of [please identify country of citizenship of sole proprietor, e.g., USA].” TMEP §803.03(a). The name of the sole proprietorship and the name of the individual can be the same.

If, rather than a sole proprietorship, applicant is instead an individual person, then the following format should be used: “Ziebarth, Christian M., a citizen of [please provide country of citizenship].” TMEP

CZIEB0000095

§§803.02(a), 803.04.

RESPONSE GUIDELINES FOR TEAS PLUS APPLICANTS

For this application to proceed toward registration, applicant must explicitly address each refusal and/or requirement raised in this Office action. If the action includes a refusal, applicant may provide arguments and/or evidence as to why the refusal should be withdrawn and the mark should register. Applicant may also have other options for responding to a refusal and should consider such options carefully. To respond to requirements and certain refusal response options, applicant should set forth in writing the required changes or statements and request that the Office enter them into the application record.

In addition, applicant filed a TEAS Plus application and therefore must respond online using the Trademark Electronic Application System (TEAS) at <http://www.uspto.gov/teas/index.htm> to avoid incurring an additional fee. *See* 37 C.F.R. §2.23(a)(1), (b).

Applicant's response must be properly signed by (1) the individual applicant (for joint individual applicants, both must sign) or (2) someone with legal authority to bind a juristic applicant (e.g., a corporate officer or general partner). *See* 37 C.F.R. §§2.62(b), 2.193(a), (e)(2)(ii); TMEP §§611.03(b), 611.06 *et seq.*, 712.01. If applicant retains an attorney, the attorney must sign the response. 37 C.F.R. §2.193(e)(2)(i); TMEP §§611.03(b), 712.01. The individual(s) signing must personally sign or personally enter his/her electronic signature. *See* 37 C.F.R. §2.193(a), (e)(2)(ii); TMEP §§611.01(b), 611.02.

If applicant does not respond to this Office action within six months of the issue/ mailing date, or responds by expressly abandoning the application, the application process will end, the trademark will fail to register, and the application fee will not be refunded. *See* 15 U.S.C. §1062(b); 37 C.F.R. §§2.65(a), 2.68(a), 2.209(a); TMEP §§405.04, 718.01, 718.02. In such case, applicant's only option would be to file a timely petition to revive the application, which, if granted, would allow the application to return to live status. *See* 37 C.F.R. §2.66; TMEP §1714. There is a \$100 fee for such petitions. *See* 37 C.F.R. §§2.6, 2.66(b)(1).

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

If applicant has questions about the application or this Office action, please telephone the assigned trademark examining attorney at the telephone number below.

/Kate DuBray/
Trademark Examining Attorney, Law Office 105
Tel: 571-272-4815
Email: katherine.dubray@uspto.gov

CZIEB0000096

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

CZIEB0000097

TTAB Cancellation No. 92053501
Ziebarth v. Del Taco, LLC

EXHIBIT 5

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AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO
ADMISSION REQUESTS UNDER RULE 2.120(H)**

To: Ziebarth, Christian M. (efiling@kmob.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85040746 - NAUGLES - CZIEB.000GEN
Sent: 1/10/2011 6:17:05 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85040746

MARK: NAUGLES

85040746

CZIEB0000060

CORRESPONDENT ADDRESS:

Gregory B. Phillips
Knobbe, Martens, Olson & Bear, LLP
14th Floor
2040 Main Street
Irvine CA 92614

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Ziebarth, Christian M.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

CZIEB.000GEN

CORRESPONDENT E-MAIL ADDRESS:

efiling@kmob.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/10/2011

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on December 20, 2010. Applicant has clarified its entity for the record. TMEP §§713.02, 714.04. The communication did not address the remaining refusals therefore the examining attorney is issuing this final action. TMEP §718.03.

The following refusals are made FINAL: likelihood of confusion refusal under Trademark Act Section 2(d) with respect to U.S. Registration No. 1043729; and (2) surname refusal under Trademark Act Section 2(e)(4). See 15 U.S.C. §§1052(d), (e)(4); TMEP §§1207.01, 1211; 37 C.F.R. §2.64(a).

SUMMARY OF ISSUES that applicant must address:

- Likelihood of Confusion Refusal
- Surname Refusal

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Applicant is seeking registration of the mark NAUGLES in connection with cafeteria and restaurant services. The cited registration, Reg. No. 1043729, is for the identical mark NAUGLES and covers restaurant services. Registration has been refused under Trademark Act Section 2(d) on the grounds that the marks are likely to be confused.

Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476

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F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

In the present case, applicant's mark is NAUGLES and the registrant's mark is NAUGLES. The marks are identical in appearance, sound, meaning and commercial impression.

Applicant has not made any attempt to distinguish the marks. In fact, because the marks consist of the same word spelled in the same way, they are not distinguishable.

Comparison of the Services

Where the marks of the respective parties are identical or virtually identical, there need be only a viable relationship between the relevant goods and/or services to support a finding of likelihood of confusion. See, e.g., *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202 (TTAB 2009); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009); *In re Wilson*, 57 USPQ2d 1863, 1867 (TTAB 2001); see also *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993).

In the present circumstances, the services are also identical. The application covers cafeteria and restaurant services. A cafeteria is a type of restaurant. Please see attached definition. The registration covers restaurant services. Because the services and the marks are identical, consumers are likely to believe that applicant's and registrant's services are being provided by the same entity.

The Trademark Act not only guards against the misimpression that the senior user is the source of the junior user's goods and/or services, but it also protects against "reverse confusion," that is, the junior user is the source of the senior user's goods and/or services. *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993); *Fisons Horticulture, Inc. v. Vigoro Indust., Inc.*, 30 F.3d 466, 474-75, 31 USPQ2d 1592, 1597-98 (3d Cir. 1994); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 490-91, 6 USPQ2d 1187, 1190-91 (2d Cir. 1988).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. See *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); see *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Because the marks and the services are identical, consumer confusion is likely and registration is refused under Section 2(d) of the Trademark Act.

If the mark in the cited registration has been assigned to applicant, applicant can provide evidence of ownership of the mark by satisfying one of the following:

- (1) Record the assignment with the Office's Assignment Services Branch (ownership transfer documents such as assignments can be filed online at <http://etas.uspto.gov>) and promptly notify the trademark examining attorney that the assignment has been duly recorded;
- (2) Submit copies of documents evidencing the chain of title; or

(3) Submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant is the owner of U.S. Registration No. 1043729.”**

TMEP §812.01; *see* 15 U.S.C. §1060; 37 C.F.R. §§2.193(e)(1), 3.25, 3.73; TMEP §502.02(a).

Merely recording a document with the Assignment Services Branch does not constitute a response to an Office action. TMEP §503.01(d).

Applicant should note the following additional ground for refusal.

SECTION 2(e)(4) REFUSAL – PRIMARILY MERELY A SURNAME

Registration is also refused because the applied-for mark is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); *see* TMEP §1211. The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975); *In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009); *see* TMEP §§1211, 1211.01.

Evidence of the surname significance of the term NAUGLES was included with the original Office Action. Additional evidence consisting of a representative sample of excerpts from a database of news articles showing that the surname NAUGLES appears to be used throughout the United States is also attached, along with printouts from an online directory of names showing that the name appears 62 times in a nationwide directory of names.

There is no rule as to the kind or amount of evidence necessary to make out a *prima facie* showing that a term is primarily merely a surname. This question must be resolved on a case-by-case basis. TMEP §1211.02(a); *see, e.g., In re Monotype Corp. PLC*, 14 USPQ2d 1070 (TTAB 1989); *In re Pohang Iron & Steel Co.*, 230 USPQ 79 (TTAB 1986). The entire record is examined to determine the surname significance of a term. The following are examples of evidence that is generally considered to be relevant: telephone directory listings, excerpted articles from computerized research databases, evidence in the record that the term is a surname, the manner of use on specimens, dictionary definitions of the term and evidence from dictionaries showing no definition of the term. TMEP §1211.02(a).

Because the term NAUGLES appears to be primarily merely a surname, registration on the Principal Register is refused under Section 2(e)(4) of the Trademark Act.

Although an amendment to the Supplemental Register would normally be an appropriate response to this refusal, such a response is not appropriate in the present case. The instant application was filed under Trademark Act Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76(b), (c) has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(e) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03. In addition, the undersigned trademark examining attorney will conduct a new search of the Office records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

To amend the application filing basis from an intent-to-use application under Trademark Act Section 1(b) to a use in commerce basis under Section 1(a), applicant must file, prior to approval of the mark for

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publication, an amendment to allege use that satisfies the requirements of 37 C.F.R. §2.76. *See* 15 U.S.C. §1051(c); 37 C.F.R. §2.35(b)(8); TMEP §§806.01(b), 1103.

The following must be submitted in an amendment to allege use in order to amend an application to use in commerce under Section 1(a):

- (1) The following statement: “ **Applicant is believed to be the owner of the mark and that the mark is in use in commerce;**”
- (2) The date of first use of the mark anywhere on or in connection with the goods and/or services;
- (3) The date of first use of the mark in commerce as a trademark or service mark;
- (4) A specimen showing actual use of the mark in commerce for each class of goods and/or services for which use is being asserted. If a single specimen supports multiple classes, applicant should indicate which classes the specimen supports rather than providing multiple copies of the same specimen;
- (5) A filing fee of \$100 per class for each international class of goods and/or services for which use is being asserted (current fee information should be confirmed at <http://www.uspto.gov/>); and
- (6) Verification of the above (1) through (3) requirements in an affidavit or signed declaration under 37 C.F.R. §2.20.

See 37 C.F.R. §§2.6(a)(2), 2.56, 2.76(b), 2.193(e)(1); TMEP §§1104.08, 1104.09(e).

Amendments to allege use can be filed online at <http://www.uspto.gov/teas/index.html>. Filing an amendment to allege use does not extend the deadline for filing a response to an outstanding Office action. TMEP §1104.

Please note, an amendment to the Supplemental Register will not overcome the refusal under Section 2(d).

Although applicant’s mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

RESPONSE GUIDELINES FOR FINAL ACTIONS

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner’s amendment

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will not incur this additional fee.

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

If applicant has questions about the application or this Office action, please telephone the assigned trademark examining attorney at the telephone number below.

/Kate DuBray/
Trademark Examining Attorney, Law Office 105
Tel: 571-272-4815
Email: katherine.dubray@uspto.gov

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

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TTAB Cancellation No. 92053501
Ziebarth v. Del Taco, LLC

EXHIBIT 6

**DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF PETITIONER'S
OPPOSITION TO RESPONDENT'S MOTION TO COMPEL UNDER RULE 2.120(E)
AND MOTION TO TEST THE SUFFICIENCY OF PETITIONER'S RESPONSES TO
ADMISSION REQUESTS UNDER RULE 2.120(H)**

To: Ziebarth, Christian M. (efiling@kmob.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85040746 - NAUGLES - CZIEB.000GEN
Sent: 6/3/2011 4:47:53 PM
Sent As: ECOM105@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85040746

MARK: NAUGLES

85040746

CORRESPONDENT ADDRESS:

Gregory B. Phillips
Knobbe, Martens, Olson & Bear, LLP
14th Floor
2040 Main Street
Irvine CA 92614

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Ziebarth, Christian M.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

CZIEB.000GEN

CORRESPONDENT E-MAIL ADDRESS:

efiling@kmob.com

SUSPENSION NOTICE: NO RESPONSE NEEDED

ISSUE/MAILING DATE: 6/3/2011

The trademark examining attorney is suspending action on the application for the reason(s) stated below. See 37 C.F.R. §2.67; TMEP §§716 *et seq.*

The USPTO will periodically conduct a status check of the application to determine whether suspension remains appropriate, and the trademark examining attorney will issue as needed an inquiry letter to applicant regarding the status of the matter on which suspension is based. TMEP §§716.04, 716.05. Applicant will be notified when suspension is no longer appropriate. See TMEP §716.04.

No response to this notice is necessary; however, if applicant wants to respond, applicant should use the "Response to Suspension Inquiry or Letter of Suspension" form online at <http://teasroa.uspto.gov/rsi/rsi>.

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Action on this application is suspended pending the disposition of:

- Cancellation No(s). **92053501**

The proceeding(s) above pertains to one or more of the following: (1) a registration cited as a bar to applicant's registration under Section 2(d) of the Trademark Act, (2) a pending application(s) that could present a future bar to registration under Section 2(d) if it matured into a registration, and/or (3) the registrability of applicant's mark. 15 U.S.C. §1052. Therefore, action is suspended pending the final disposition of this proceeding(s). See 37 C.F.R. §2.83; TMEP §§716.02(a), (c) and (d), 1208 et seq. Any refusal(s) made under Section 2 is herein maintained.

The following refusal(s)/requirement(s) is/are continued and maintained:

- Refusal Under Section 2(e)(4) – Mark is Primarily Merely a Surname

/Kate DuBray/
Trademark Examining Attorney, Law Office 105
Tel: 571-272-4815
Email: katherine.dubray@uspto.gov

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To: Ziebarth, Christian M. (cfiling@kmob.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85040746 - NAUGLES - CZIEB.000GEN
Sent: 6/3/2011 4:47:56 PM
Sent As: ECOM105@USPTO.GOV
Attachments:

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

**USPTO LETTER (AN OFFICE ACTION) HAS ISSUED ON 6/3/2011 FOR
SERIAL NO. 85040746**

Please follow the instructions below:

TO READ OFFICE LETTER: Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office letter

PLEASE NOTE: The Office letter may not be immediately available but will be viewable within 24 hours of this e-mail notification.

HELP: For *technical* assistance in accessing the Office correspondence, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office letter.

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