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

Proceeding	92061951
Party	Defendant Great Concepts, LLC
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Attachments	2016-01-25_Great_Concepts_s_Motion_for_Summary_Judgment_re_Res_Judicata.PDF(96970 bytes) 2016-1-25_Declaration_of_Frederick_Taylor_ISO_Great_Concepts_s_Motion_for_Summary_Judgment_re_Res_Judicata.PDF(32055 bytes) Exhibit A - Great Concept's Registration.pdf(47229 bytes) Exhibit B - Petition to Cancel from Prior Cancellation Proceeding-1.pdf(1660813 bytes) Exhibit C - Combined Declaration under Sections 8 and 15.pdf(3515202 bytes) Exhibit D - Combined Notice of Acceptance and Acknowledgement of Declaration.pdf(18433 bytes) Exhibit E - Request to Remove Suspension of Proceedings.pdf(1393247 bytes) Exhibit F - Order to Resume Prior Cancellation Proceedings.pdf(39868 bytes) Exhibit G - Certificate of Service or Request to Remove Suspension of Proceedings.pdf(17356 bytes) Exhibit H - Order to Show Cause Why Prior Cancellation Proceeding Should Not Be Dismissed.pdf(24529 bytes) Exhibit I - Order Dismissing Prior Cancellation Proceeding.PDF(21892 bytes) Exhibit J - Section 8 and 15 Declaration from S Industries v. Covington Industries case.pdf(252237 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHUTTER, INC.,	)	
	)	
Petitioner,	)	CANCELLATION NO. 92061951
	)	
v.	)	
	)	
GREAT CONCEPTS, LLC,	)	
	)	
Registrant.	)	

GREAT CONCEPTS, LLC'S MOTION FOR SUMMARY JUDGMENT UNDER FED.R.CIV.P. 56 REGARDING CHUTTER, INC.'S PETITION TO CANCEL

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Registrant Great Concepts, LLC ("Registrant") respectfully submits the following motion for summary judgment based on the doctrine of res judicata with respect to Petitioner Chutter, Inc.'s ("Petitioner") Petition to Cancel Registration No. 2,929,764 (the "Registration").

I. INTRODUCTION

Nearly ten years ago, Petitioner's predecessor-in-interest, Dan Tana ("predecessor-in-interest" or "Tana") brought a prior petition to cancel the Registration before the Trademark Trial and Appeal Board (the "Board"). That petition to cancel was suspended temporarily while the Petitioner's predecessor-in-interest pursued a civil action in the Northern District of Georgia for infringement against Registrant. While the petition to cancel and the civil action were still pending, Registrant publicly filed a combined declaration of continued use and incontestability relating to its Registration with the USPTO, and the USPTO publicly issued a Combined Notice of Acceptance and Acknowledgement of the declaration. After the Northern District of Georgia granted summary judgment in favor of Registrant and the U.S. Court of Appeals for the Eleventh Circuit affirmed, the petition to cancel resumed. However, despite being specifically ordered by the Board to amend its petition in light of the decision in the civil action, Petitioner's predecessor-in-interest demonstrated an "apparent loss of interest" and the Board terminated the

petition to cancel.

Now, in an effort to pursue the legal strategy that its predecessor-in-interest opted to forgo, Petitioner has filed the present Petition to Cancel the Registration. Petitioner now asserts a cause of action based on the alleged fraud in Registrant's filing an incorrect combined declaration of use and incontestability under Sections 8 and 15. Although Registrant strongly disputes the merits of both the intent and materiality aspects of this fraud cause of action, Petitioner's claim to cancel the Registration precluded by the doctrine of res judicata. Petitioner's predecessor-in-interest had at least constructive or inquiry notice of the publicly filed declaration of use and incontestability, particularly since the declaration was filed while the Tana was actively litigating against the Registration in both the civil action and the prior cancellation proceeding. Despite having such notice, Petitioner allowed the Board to dismiss its claim against Registrant with prejudice due to its "apparent loss of interest."

Petitioner should not be permitted to have this improper second bite at the apple. There are no genuine issues of material fact allowing the Petitioner to re-litigate its precluded claim, and Registrant respectfully requests that the Board dismiss the present Petition to Cancel.

II. FACTUAL AND PROCEDURAL BACKGROUND

The United States Patent and Trademark Office issued Registration No. 2,929,764 to Registrant for the mark DANTANNA'S in connection with steak and seafood restaurants in International Class 43 (the "Registration") on March 1, 2005. Declaration of Frederick K. Taylor ("Taylor Decl."), ¶ 3; Petition to Cancel, ¶ 9.

On June 6, 2006, Petitioner's predecessor-in-interest Tana filed with the Board a petition to cancel the Registration, Cancellation No. 92045947 (the "Prior Cancellation Proceeding"), which involved Registrant's right to register and use the mark DANTANNA'S for "restaurant services." Taylor Decl., ¶ 3; Petition to Cancel, ¶¶ 1, 10. Petitioner's predecessor-in-interest Tana then commenced a civil action for infringement against Registrant on March 13, 2008, in the United States District Court for the Northern District of Georgia, Civil Action No. 1:08-CV-

975-TWT (the "Civil Action"), which also involved Registrant's right to register and use the mark DANTANNA'S for "restaurant services." Taylor Decl., ¶ 5; Petition to Cancel, ¶ 10.

On March 8, 2010, while the Prior Cancellation Proceeding and the Civil Action were still pending, Registrant's counsel, Frederick K. Taylor, signed and filed with the USPTO on behalf of Registrant a "Combined Declaration of Use and Incontestability under Sections 8 & 15" (the "Declaration") with respect to the Registration. Taylor Decl., ¶ 6; Petition to Cancel, ¶ 22. The Declaration incorrectly stated that, at the time, there were no pending proceedings involving Registrant's rights in the Registration. Petition to Cancel, ¶¶ 23, 28. The USPTO issued a combined Notice of Acceptance (as to Section 8) and Notice of Acknowledgement (as to Section 15) (the "Combined Notice") with respect to the Registration on March 26, 2010, which was over eight months before the Board dismissed the Prior Cancellation Proceeding on December 14, 2010. Taylor Decl., ¶ 7; Petition to Cancel, ¶ 37.

The Civil Action subsequently ended after the U.S. Court of Appeals for the Eleventh Circuit issued a mandate on August 13, 2010 for its opinion affirming the district court's judgment and order granting summary judgment in favor of Registrant. Taylor Decl., ¶ 8; Petition to Cancel, ¶¶ 13-16.

On September 1, 2010, Registrant filed a request with the Board to resume the Prior Cancellation Proceeding against the Registration. Taylor Decl., ¶ 9; Petition to Cancel, ¶¶ 18, 35. The Board issued an order on September 7, 2010 to resume the Prior Cancellation Proceeding, in which the Board instructed Petitioner to amend its petition to cancel from the Prior Cancellation Proceeding. Taylor Decl., ¶ 10. Registrant served a copy of Registrant's Request to Remove Suspension of Proceedings to counsel for the Petitioner on September 8, 2010. Taylor Decl., ¶ 11.

Despite having at least constructive or inquiry notice of the Declaration filed on March 8, 2010, Petitioner's predecessor-in-interest Tana made no attempt to amend its petition in the Prior Cancellation Proceeding to include fraud as a ground for cancellation. Taylor Decl., ¶ 12; Petition to Cancel, generally.

On October 26, 2010, the Board issued an "order to show cause why [the Prior Cancellation Proceeding] should not be dismissed with prejudice based on petitioner's apparent loss of interest." Taylor Decl., ¶ 13. Subsequently, the Prior Cancellation Proceeding ended when the Board entered an Order terminating the proceeding on December 14, 2010, as a result of default by Petitioner's predecessor-in-interest Tana. Taylor Decl., ¶ 14; Petition to Cancel, ¶ 19. The Board's order stated as follows: "In view of petitioner's failure to respond to the order to show cause that the Board issued on October 26, 2010, the petition to cancel is dismissed with prejudice based on petitioner's apparent loss of interest." Taylor Decl., ¶ 14, Exhibit I.

Despite the fact that the Northern District of Georgia and the Eleventh Circuit both ruled against Petitioner in the Civil Action (Petition to Cancel, ¶¶ 13, 16), and the fact that the Board dismissed Petitioner's Prior Cancellation Proceeding with prejudice (Petition to Cancel, ¶ 19), Petitioner has since filed application Serial No. 86-452,290 for the mark DAN TANA'S for "restaurant services" in International Class 43 on November 12, 2014. Petition to Cancel, ¶ 6.

Finally, on July 29, 2015, Petitioner filed the present Petition to Cancel Registrant's Registration on the ground of fraud. *See* Petition to Cancel, ¶ 45.

III. <u>LEGAL STANDARD</u>

Entry of summary judgment is appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts on summary judgment; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme*

Foods, 22 USPQ2d at 1542.

Once a moving party demonstrates the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law, the burden shifts to the nonmoving party to present sufficient evidence to show an evidentiary conflict as to one or more material facts in issue. *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc*., 60 USPQ2d 1733, 1739 (TTAB 2001). In countering a motion for summary judgment, more is required than mere assertions of counsel. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc*., 739 F.2d 624, 626-27 (Fed. Cir. 1984). The non-movant may not rest on its conclusory pleadings but, under Rule 56, must set out, usually in an affidavit by one with knowledge of specific facts, what specific evidence could be offered at trial. *Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd*., 731 F.2d 831, 836, 221 USPQ 561, 564 (Fed.Cir.1984). A non-movant runs the risk of a grant of summary judgment by failing to disclose the evidentiary basis for its claim. *Pure Gold*, 739 F.2d at 627.

IV. ANY CLAIM PETITIONER COULD HAVE BROUGHT REGARDING REGISTRANT'S MARK FOR "RESTAURANT SERVICES" IS PRECLUDED UNDER THE DOCTRINE OF RES JUDICATA.

Petitioner is unable to bring a Petition to Cancel based on its application for the mark DAN TANA's for "restaurant services," through application Serial No. 86-452,290 or any other application to register such a mark, because of the doctrine of res judicata. Petitioner already raised – and lost on the merits – the same claim against Registrant in its predecessor-in-interest Tana's "Prior Cancellation Proceeding."

Under the doctrine of res judicata or claim preclusion, the entry of a final judgment "on the merits" of a claim (i.e., cause of action) in a proceeding serves to preclude the re-litigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where prior judgment was the result of a default or consent. *See Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); *Chromalloy American Corp. v. Kenneth Gordon, Ltd*., 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); and *Flowers Industries, Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987). A second suit will be barred by claim preclusion if there is: (1) identity of parties (or their privies); (2) an earlier final judgment

on the merits of a claim; and (3) a second claim based on the same set of transactional facts as the first. *Jet Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000).

A. **Petitioner Does Not and Cannot Dispute That the Parties to the Prior Cancellation Proceeding Were the Same as the Ones in the Present Petition to Cancel.**

The first element of claim preclusion is met because the parties to the "Prior Cancellation Proceeding" were the same parties as those in the present Petition to Cancel. Notably, Petitioner did not dispute in either its Petition to Cancel or in its Opposition to Registrant's Motion to Dismiss the Petition to Cancel that the parties or their privities are the same between the Prior Cancellation Proceeding and the present cancellation proceeding.

As alleged by Petitioner in its present Petition to Cancel, "Petitioner is the owner, by assignment from its predecessor Dan Tana ("Tana"), of all rights in and to the mark DAN TANA'S for restaurant services." Petition to Cancel, ¶ 1. Therefore, Petitioner (the party seeking the cancellation in this action) is in privity with Tana (the party that sought cancellation in the Prior Cancellation Proceeding). Moreover, Petitioner alleged that both "Petitioner's predecessor Tana and Registrant were engaged in [the Prior Cancellation Proceeding] in which Registrant's right to register and use the mark DANTANNA'S for restaurant services were involved." Petition to Cancel, ¶ 10. Accordingly, it is undisputed that both Petitioner and Registrant were parties to both the Prior Cancellation Proceeding and the present Petition to Cancel.

B. **Petitioner Does Not and Cannot Dispute That There Was a Final Judgment on the Merits in the Prior Cancellation Proceeding.**

Similarly, the second element of claim preclusion is met, because there was a final judgment on the merits in the Prior Cancellation Proceeding. Again, Petitioner did not dispute in either its Petition to Cancel or in its Opposition to Registrant's Motion to Dismiss the Petition to Cancel that the Prior Cancellation Proceeding resulted in a dismissal with prejudice based on Petitioner's failure to respond to the Board's order to show cause and Petitioner's "apparent loss

of interest."

Whether the judgment in the prior proceeding was the result of a dismissal with prejudice or even default, it is a final judgment on the merits for claim preclusion purposes. *The Urock Network, LLC*, 115 U.S.P.Q.2d 1409 (TTAB 2015) (citing *Morris v. Jones*, 329 U.S. 545, 550-51 (1947) ("A judgment of a court having jurisdiction of the parties and of the subject matter operates as res judicata, in the absence of fraud or collusion, even if obtained upon a default.") (citation omitted); *Wells Cargo, Inc. v. Wells Cargo, Inc.*, 606 F.2d 961, 203 USPQ 564, 566 (CCPA 1979) ("Default judgments generally operate as res judicata….") (citations omitted); *see also Orouba Agrifoods Processing Co. v. United Food Import*, 97 USPQ2d 1310, 1314-15 (TTAB 2010) (granting summary judgment to registrant on claim preclusion where petitioner's prior opposition had been dismissed with prejudice for failure to prosecute the case). Here, the Prior Cancellation Proceeding resulted in a dismissal with prejudice based on Petitioner's failure to respond to the Board's order to show cause and "apparent loss of interest." Petition to Cancel, ¶ 19; Taylor Decl., ¶ 14. Therefore, the Prior Cancellation Proceeding would qualify as an earlier final judgment on the merits for purposes of claim preclusion.

In Petitioner's Opposition to Registrant's Motion to Dismiss, Petitioner claimed without support that its Prior Cancellation Proceeding was dismissed only on "procedural grounds" and never adjudicated on the merits. However, Federal Circuit and Board precedent clearly hold that there is no requirement for the actual litigation of issues for claim preclusion, which instead operates by virtue of a final judgment, including by default, consent, or dismissal with prejudice. *Young Engineers v. US Intern. Trade Com'n*, 721 F.2d 1305, 1314 (Fed. Cir. 1983); *The Urock Network, LLC v. Umberto Sulpasso*, 115 U.S.P.Q.2d 1409, at *4 (TTAB 2015) ("Notwithstanding [Petitioner's] contention that claim preclusion is inapplicable here because the prior proceeding was ended by a 'technical procedure,' whether the judgment in the prior proceeding was the result of a dismissal with prejudice or even default, for claim preclusion purposes, it is a final judgment on the merits."). Since it is undisputable that the Prior Cancellation Proceeding was dismissed with prejudice based on Petitioner's "apparent loss of

interest," the "final judgment on the merits" element of res judicata is clearly met.

C. **The Present Petition to Cancel Is Based on the Same Set of Transactional Facts as the Prior Cancellation Proceeding, and Petitioner Had at Least Constructive or Inquiry Notice of the Possible Cause of Action for Fraud.**

Finally, the third element of claim preclusion is met because the present Petition to Cancel is based on the same set of transactional facts as the Prior Cancellation Proceeding. Both cancellation actions have sought the cancellation of Registration Number 2,929,764. Petition to Cancel, p. 1 and ¶ 10. Thus, at a minimum, the Prior Cancellation Proceeding precludes Petitioner from bringing any claim to cancel the Registration that stems from Petitioner's application to register the DAN TANA's mark for restaurant services in International Class 43. Petition to Cancel, ¶ 6. However, the doctrine of res judicata bars not only the claims that were raised, but also those that "could have been raised" in the action. *Rivet v. Regions Bank of La.*, 522 U.S. 470, 476 (1998). Despite having notice of the Declaration filed on March 8, 2010, Petitioner's predecessor-in-interest Tana made no attempt to amend its petition in the Prior Cancellation Proceeding to include fraud in the Declaration as a ground for cancellation. Taylor Decl., ¶ 12; *see also* Petition to Cancel, generally. Therefore, as Petitioner even alleges that the Prior Cancellation Proceeding involved "Registrant's right to register and use the mark DANTANNA'S for restaurant services" generally (Petition to Cancel, ¶ 10), Petitioner is likewise precluded from bringing any claim to cancel Registrant's right to register and use the mark DANTANNA'S on the ground of fraud, including a claim stemming from Petitioner's application Serial No. 86-452,382 for marinara sauce. Petition to Cancel, ¶ 6. Consequently, the entire Petition to Cancel is precluded under the doctrine of res judicata.

1. **The Prior Cancellation Proceeding Involved the Same Transactional Facts as the Present Cancellation Proceeding.**

Petitioner has contended that the Prior Cancellation Proceeding did not involve the same transactional facts as the present proceeding, even though: (i) both were petitions to cancel Registrant's Registration No. 2,929,764 for the mark DANTANNA's for restaurant services; (ii) in which Petitioner claimed damages to its own DAN TANA'S mark for restaurant services; (iii)

resulting from the USPTO's issuing Office Actions refusing Petitioner's applications to register its mark because of a likelihood of confusion with Registrant's mark under § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). *See* Taylor Decl., Exhibit B at p. 1-2; Petition to Cancel, p. 1-3.[1] Thus, the subject and prayer for relief of the petitions are the same, the claimed damages are the same, and the cause of the damages are the same. *Id.* These compose the same core or nucleus of operative facts, notwithstanding Petitioner's attempt to distinguish its second petition to cancel by pointing to its new ground of fraud, which it could have raised in the first petition to cancel.

Contrary to the Petitioner's suggestion, neither the specific ground of fraud nor the specific facts on which the claim is based need to have been actually raised in the Prior Cancellation Proceeding. Rather, "[t]his bar extends to relitigation of 'claims that were raised *or could have been raised*' in an earlier action. *The Urock Network*, 115 U.S.P.Q.2d 1409, at *4 (TTAB 2015) (citing *Allen v. McCurry*, 449 U.S. 90, 94 (1980); *Migra v. Warren City School Dist. Bd. of Educ.*, 465 U.S. 75, 77 n.1 (1984)) (emphasis in original). Thus, "[c]laim preclusion refers to the effect of a judgment in foreclosing litigation of a matter that never has been litigated, because of a determination that it should have been advanced in an earlier suit." *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 1362 (Fed. Cir. 2000). While the Board and the Federal Circuit recognize that an infringement action in district court generally differs from a cancellation proceeding before the Board for claim preclusion purposes, such a distinction does not exist if a plaintiff's two actions shared a common basis and pursued the same prayer for relief to prevent the defendant's ability to register its mark. *Sharp Kabushiki Kaisha a/k/a Sharp Corp.*, 91154103, 2012 WL 2930648, at *2-3 (TTAB 2012) (contrasting *Jet*, 223 F.3d at 1364).

As recognized by Petitioner, the Federal Circuit is guided by the Restatement (Second) of Judgments in determining whether a plaintiff's claim in a particular case is barred by claim

[1] Moreover, Petitioner repeatedly notes that both the Prior Cancellation Proceeding and the Civil Action involved "Registrant's right to register and use the mark DANTANNA'S for restaurant services" and "Registrant's right to register and use the mark that is the subject of the Registration and to keep the mark on the register." Petition to Cancel, ¶¶ 10, 26, 27, 32. This is again the subject of the present cancellation proceeding.

preclusion. *The Urock Network*, 115 U.S.P.Q.2d 1409, at *5 (TTAB 2015); *Young Engineers*, 721 F.2d at 1314. The Restatement provides that:

> (1) When a valid and final judgment rendered in an action extinguishes the plaintiff's claim pursuant to the rules of merger or bar . . . the claim extinguished includes ***all rights*** of the plaintiff to remedies against the defendant ***with respect to all or any part of the transaction, or series of connected transactions***, out of which the action arose.
>
> (2) What factual grouping constitutes a "transaction", and what grouping constitutes a "series", are to be ***determined pragmatically***, giving weight to such considerations as whether the facts are related in time, space, origin or motivation, whether they form a convenient trial unit, and whether their treatment as a unit conforms to the parties' expectations or business understanding or usage.

Id. (emphasis added). Although Petitioner stresses the fact that it is bringing a different "cause of action" in the present Petition to Cancel, the "*Restatement* speaks in terms of *claims* and does not make reference to 'causes of action,'" since "generally, reference to a 'cause of action' in this connection leads to consideration of what have come to be regarded as irrelevant matters." *Young Engineers*, 721 F.2d at 1314 n.6 (emphasis in original). For instance, a party may be precluded from bringing a petition to cancel on the theory or cause of action of abandonment even when its earlier petition to cancel was based on a theory or cause of action for fraud. *See Vitaline Corp. v. Gen. Mills, Inc.*, 891 F.2d 273, 275 (Fed. Cir. 1989).

The facts of this case closely resemble those in *S Industries, Inc. and Central Mfg. Co. v. Covington Industries, Inc.*, in which the Board precluded a petition to cancel on the grounds of fraud and abandonment that "could have been brought together" with a previous petition to cancel on the ground of likelihood of confusion under Section 2(d). *S Industries, Inc. and Central Mfg. Co. v. Covington Industries, Inc*. 69, 2002 WL 31651761, at *5 (TTAB 2002). The Board concluded that the claims in these two petitions were "the same" since "[b]oth petitions seek the same relief (the cancellation of the same registration) for at least overlapping reasons (petitioner is the owner of the same registration and that petitioner will be damaged by the continuing presence of that registration on the register)." *Id.* Although the Board in *S Industries* ultimately precluded only the abandonment claim and not the fraud claim, this was because the

petitioner "could not have" raised the fraud claim in the first cancellation action since it was based on an affidavit submitted on December 9, 1994, *i.e.*, well ***after*** the first cancellation was dismissed with prejudice on April 28, 1993. *See S Indus., Inc.*, 69, 2002 WL 31651761, at *5, 8 (TTAB 2002); *see also* Taylor Decl., Exhibit J.[2] Thus, the only reason the fraud cause of action was not precluded like the abandonment cause of action in that case was because the petitioner truly had no claim yet. Here, however, Petitioner easily "could have raised" the fraud claim at issue in the present Petition to Cancel well before the Prior Cancellation Proceeding was dismissed with prejudice. Unlike in *S Industries*, the USPTO issued the Combined Notice of the Declaration on March 26, 2010 over eight months ***before*** the Board dismissed the Prior Cancellation Proceeding on December 14, 2010. Petition to Cancel, ¶¶ 19, 37; Taylor Decl., ¶ 7, Exhibit D.

Thus, it is immaterial to the claim preclusion analysis that Petitioner is now bringing a cause of action for fraud when it previously brought a cause of action for likelihood of confusion. Both causes of action are part of the same claim for cancellation of the Registration based upon alleged damages to Petitioner's mark.

2. Petitioner Had Either Constructive or Inquiry Notice of the Cause of Action for Fraud During the Prior Cancellation Proceeding.

Because Petitioner had either constructive or inquiry notice of the Declaration over eight months prior to when the Prior Cancellation Proceeding was terminated, it could easily have amended its previous petition to cancel to include the cause of action for fraud. A party is charged with "constructive notice" of a public record of a registration on the principal register. *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 1362 (Fed. Cir. 2001); *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 U.S.P.Q.2d 1203, at *9 (TTAB 2006). Additionally, a party is charged with "inquiry notice" when circumstances would lead a reasonable person to begin investigating the possibility that his legal rights had been infringed. *See Merck & Co., Inc. v. Reynolds*, 130 S. Ct. 1784, 1797 (2010). A

[2] The Board may take notice of filings in other TTAB proceedings. *The Urock Network*, 115 U.S.P.Q.2d 1409, at *6 n.10 (TTAB 2015) (citing *Kraft, Inc. v. Balin*, 209 USPQ 877, 881 n.8 (TTAB 1981)).

party's "constructive or inquiry notice" of publicly recorded documents "renders any claims stemming from these documents as barred by res judicata, as such claims could have and should have been brought" in the first action. *See Carlisle v. Matson Lumber Co.*, 186 F. App'x 219, 224 (3d Cir. 2006).

Although Petitioner insists it did not have notice of the Combined Declaration such that it "could have raised" its cause of action for fraud in the Prior Cancellation Proceeding, Petitioner had at least constructive notice or inquiry notice of it when the USPTO issued its public record of the Combined "Notice" of the Declaration. *See* Petition to Cancel, ¶ 37; Taylor Decl. ¶ 7; *see also In re Shell Oil Co.*, 992 F. 2d 1204, 1207 n.3 (Fed. Cir. 1993) (the Board may take judicial notice of agency action relating to declarations under Sections 8 and 15, since it is an adjudicative fact of a "public record"). Petitioner had at least constructive notice of both the Declaration and the Combined Notice of the Declaration when they were publicly recorded by the USPTO. Petitioner also had inquiry notice of both the Declaration and the Combined Notice, since it was actively seeking to cancel the Registration at the time when the Declaration and the Combined Notice were publicly recorded and had a motivation to track any filings pertaining to the Registration.

Petitioner had this constructive or inquiry notice of the Declaration and the Combined "Notice" for over eight months before the Board dismissed the Prior Cancellation Proceeding with prejudice. *See* Petition to Cancel, ¶¶ 19, 37; Taylor Decl., ¶ 7. In fact, on September 7, 2010, the Board even issued an order roughly five months after the Combined Notice that instructed Petitioner to amend its petition to cancel from the Prior Cancellation Proceeding for other grounds. *See* Petition to Cancel, ¶37; Taylor Decl., ¶ 10, Exhibit F. The Board then issued a subsequent order on October 26, 2010 for Petitioner to show cause why the Prior Cancellation Proceeding should not be dismissed with prejudice. Taylor Decl., ¶ 13, Exhibit H. Instead of taking any action, however, Petitioner displayed an "apparent loss of interest," and the Board dismissed its Prior Cancellation Proceeding with prejudice. Taylor Decl., ¶ 14, Exhibit I. Petitioner cannot argue that it had no notice of the resumption of the Prior Cancellation

Proceeding, since Registrant served a copy of its request to remove the suspension of the proceedings to the Petitioner. Taylor Decl., ¶ 11, Exhibit G; Petition to Cancel, ¶ 18.

Accordingly, given the ample amount of time the Board afforded to the Petitioner to amend its petition in the Prior Cancellation Proceeding, as well as the clear motivation that Petitioner had to track the status of the Registration it was actively seeking to cancel, Petitioner easily "could have" amended its petition to include the cause of action raised in the present Petition to Cancel. Petitioner's claim for fraud is thus precluded under the doctrine of res judicata.

V. CONCLUSION

Based on the foregoing, Registrant respectfully requests that the Board dismiss the Petitioner's Petition to Cancel.

Respectfully submitted,

PROCOPIO, CORY, HARGREAVES
& SAVITCH LLP

Dated: January 25, 2016

By: /Lisel M. Ferguson/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing GREAT CONCEPTS, LLC'S MOTION FOR SUMMARY JUDGMENT UNDER FED.R.CIV.P. 56 REGARDING CHUTTER, INC.'S PETITION TO CANCEL is being mailed via United States mail, postage prepaid and sent electronically, on January 25, 2016 to the counsel for Registrant as follows:

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Dated: January 25, 2016

By: /Lisel M. Ferguson/
Lisel M. Ferguson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CHUTTER, INC.,	)	
	)	
Petitioner,	)	CANCELLATION NO. 92061951
	)	
v.	)	
	)	
GREAT CONCEPTS, LLC,	)	
	)	
Registrant.	)	

DECLARATION OF FREDERICK K. TAYLOR IN SUPPORT OF GREAT CONCEPTS, LLC'S MOTION FOR SUMMARY JUDGMENT UNDER FED.R.CIV.P. 56 REGARDING CHUTTER, INC.'S PETITION TO CANCEL

I, Frederick K. Taylor, declare as follows:

1. I am an attorney duly licensed to practice before all courts in the State of California and this Court. I am a partner with the law firm of Procopio Cory Hargreaves & Savitch LLP, attorneys of record herein for Registrant Great Concepts, LLC ("Registrant").

2. I have personal knowledge of the facts set forth herein and if called as a witness, I would and could competently testify to the truth thereof.

3. On March 1, 2005, the United States Patent and Trademark Office issued Registration No. 2,929,764 to Registrant for the mark DANTANNA'S in connection with steak and seafood restaurants in International Class 43 (the "Registration"). Attached hereto as "Exhibit A" is a true and correct copy of Registration No. 2,929,764.

4. On June 6, 2006, Petitioner's predecessor-in-interest, Dan Tana ("Tana"), filed Cancellation No. 92045947 (the "Prior Cancellation Proceeding") with the Trademark Trial and Appeal Board (the "Board"), which involved Registrant's right to register and use the mark DANTANNA'S for "restaurant services." Attached hereto as "Exhibit B" is a true and correct copy of the Petition to Cancel from the Prior Cancellation Proceeding.

5. On March 13, 2008, Petitioner's predecessor-in-interest Tana commenced a civil action for infringement against Registrant in the United States District Court for the Northern

District of Georgia, Civil Action No. 1:08-CV-975-TWT (the "Civil Action"), which also involved Registrant's right to register and use the mark DANTANNA'S for "restaurant services."

6. On March 8, 2010, while the Prior Cancellation Proceeding and the Civil Action were still pending, Registrant's counsel, Frederick K. Taylor, signed and filed with the USPTO on behalf of Registrant a "Combined Declaration of Use and Incontestability under Sections 8 & 15" (the "Declaration") with respect to the Registration. Attached hereto as "Exhibit C" is a true and correct copy of the Declaration.

7. On March 26, 2010, the USPTO issued a Combined Notice of Acceptance (as to Section 8) and Notice of Acknowledgement (as to Section 15) (the "Combined Notice") with respect to the Registration, which was over eight months before the Board dismissed the Prior Cancellation Proceeding on December 14, 2010. Attached hereto as "Exhibit D" is a true and correct copy of the Combined Notice.

8. The Civil Action subsequently ended after the U.S. Court of Appeals for the Eleventh Circuit issued a mandate on August 13, 2010 for its opinion affirming the district court's judgment and order granting summary judgment in favor of Registrant.

9. On September 1, 2010, Registrant filed a Request to Remove Suspension of Proceedings relating to the Prior Cancellation Proceeding. Attached hereto as "Exhibit E" is a true and correct copy of the Request to Remove Suspension of Proceedings.

10. On September 7, 2010, the Board issued an order to resume the Prior Cancellation Proceeding, in which the Board instructed Petitioner to amend its petition to cancel from the Prior Cancellation Proceeding. Attached hereto as "Exhibit F" is a true and correct copy of the Board's Order to resume the Prior Cancellation Proceeding.

11. On September 8, 2010, I served a copy of Registrant's Request to Remove Suspension of Proceedings to counsel for the Petitioner. Attached hereto as "Exhibit G" is a true and correct copy of Certificate of Service regarding Registrant's Request to Remove Suspension of Proceedings.

12. Despite having at least constructive or inquiry notice of the Declaration filed on March 8, 2010, Petitioner's predecessor-in-interest Tana made no attempt to amend its petition in

the Prior Cancellation Proceeding to include fraud as a ground for cancellation.

13. On October 26, 2010, the Board issued an "order to show cause why [the Prior Cancellation Proceeding] should not be dismissed with prejudice based on petitioner's apparent loss of interest." Attached hereto as "Exhibit H" is a true and correct copy of the Board's Order to Show Cause.

14. Subsequently, the Prior Cancellation Proceeding ended when the TTAB entered an Order terminating the proceeding on December 14, 2010, as a result of default by Petitioner's predecessor-in-interest Tana. Attached hereto as "Exhibit I" is a true and correct copy of the Board's Order Dismissing Cancellation No. 92045947 with Prejudice on December 14, 2010.

15. Attached hereto as "Exhibit J" is a true and correct copy of the combined Section 8 and 15 Affidavit for Registration No. 1,516,448, which was the subject of a similar case, *S Industries, Inc. and Central Mfg. Co. v. Covington Industries, Inc*. 69, 2002 WL 31651761 (TTAB 2002).

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed this 25th day of January, 2016 in San Diego, California.

/Frederick K. Taylor/
Frederick K. Taylor

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing DECLARATION OF FREDERICK K. TAYLOR IN SUPPORT OF GREAT CONCEPTS, LLC'S MOTION FOR SUMMARY JUDGMENT UNDER FED.R.CIV.P. 56 REGARDING CHUTTER, INC.'S PETITION TO CANCEL is being mailed via United States mail, postage prepaid and sent electronically, on January 25, 2016 to the counsel for Registrant as follows:

Bruce W. Baber
King & Spalding LLP
1180 Peachtree Street
Atlanta, Georgia 30309
Telephone: 404-572-4600
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Kathleen E. McCarthy
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Dated: January 25, 2016

By: /Lisel M. Ferguson/
Lisel M. Ferguson

EXHIBIT “A”

United States Patent and Trademark Office

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Typed Drawing

Word Mark	DANTANNA'S
Goods and Services	IC 043. US 100 101. G & S: Steak and Seafood Restaurant. FIRST USE: 20030930. FIRST USE IN COMMERCE: 20030930
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	78259855
Filing Date	June 9, 2003
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	February 3, 2004
Registration Number	**2929764**
Registration Date	March 1, 2005
Owner	(REGISTRANT) Great Concepts, LLC LIMITED LIABILITY JOINT STOCK COMPANY GEORGIA P. O. Box 2937 Duluth GEORGIA 30096
Attorney of Record	Lisel M. Ferguson
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20141121.
Renewal	1ST RENEWAL 20141121
Live/Dead Indicator	LIVE

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EXHIBIT "B"

TTAB

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COUNSELORS AT LAW
160 EAST 84TH STREET
NEW YORK, NEW YORK 10028
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AFSCHINEH LATIFI (NY, CA & D.C.)
ALI R. LATIFI
CORY M. BAKER

100 JERICHO QUADRANGLE
SUITE 236
JERICHO, NY 11753
(516) 942-5300
(516) 932-6050 FAX

June 7, 2006

BY EXPRESS MAIL
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attn: TTAB

Re: Dan Tana – Cancellation Proceeding of Reg. No. 2,929,764

Dear Sir:

Attached for filing please find duplicate original *Petitions for Cancellation* of Registration Number 2,929,764 for the mark DANTANNA'S based on the fact that the Registration was obtained fraudulently by registrant Great Concepts, LLC. Also attached is a credit card payment form in the amount of $300.00 to cover the required filing fee.

Please file the attached Petitions and acknowledge receipt thereof by date stamping and returning the self – addressed enclosed post card.

Respectfully submitted,

AFSCHINEH LATIFI

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

DAN TANA

Petitioner,

Cancellation No.

-against-

GREAT CONCEPTS, LLC

Respondent.

PETITION FOR CANCELLATION

Petitioner, Dan Tana ("Petitioner"), believes that he will be damaged by the continued registration of U.S. Trademark Registration Number 2,929,764 for the mark DANTANNA'S for restaurant services in International Class 43 and hereby petitions for the cancellation thereof.

The grounds for cancellation are as follows:

1. Petitioner is an individual with an office and place of business located at Dan Tana's, 9071 Santa Monica Boulevard, Los Angeles, California 90069.

2. Upon information and belief, Respondent, Great Concepts, LLC ("Respondent") is a Georgia limited liability company with an office and place of business located at 10500 NW 5th Manor, Plantation, Florida 33324, is listed with the U.S. Patent & Trademark Office ("PTO") records as the alleged current owner of Registration Number 2,929,764 of March 1, 2005 for the mark DANTANNA'S for restaurant services in International Class 43.

DAN TANA, since as early as 1964. Consequently, DAN TANA'S restaurant has not only become an establishment in Los Angeles but it has achieved national and international fame and notoriety as a result of the frequent patronage by celebrities to this restaurant and the unsolicited media coverage Petitioner continuously receives for his restaurant.

5. In fact, the press has referred to Petitioner's restaurant as "a legendary Hollywood hotspot", "a rare place", "the ultimate LA hangout" and a "shrine" and to Dan Tana as a "preeminent restaurateur". Attached hereto and collectively identified as *Exhibit 1* are copies of some of the unsolicited press coverage Petitioner has received for his famous restaurant.

6. Interestingly, by the 1970's Petitioner's namesake restaurant had gained such fame and notoriety, not only in Hollywood, but throughout the country, that Petitioner was approached by the famous producer, Aaron Spelling, seeking to use the DAN TANA name as the name of the lead character for the television series VEGAS.

7. The Vegas television series successfully ran for several years, providing Petitioner and his DAN TANA'S restaurant with even more fame and recognition.

8. There is no doubt that over the years, DAN TANA'S restaurant has become an institution and its owner, Dan Tana, a legend. In fact, Dan Tana is probably as famous as the celebrity stars, such as George Clooney, Matt Damon and Brad Pitt, who frequent his DAN TANA'S restaurant.

9. After 42 years in continuous operation and numerous unsolicited newspaper and magazine articles, consumers and restaurant goers readily identify DAN TANA'S restaurant with its owner and Petitioner herein, Dan Tana.

10. On December 31, 2005, the PTO issued an Office Action in connection with Petitioner's DAN TANA'S Application, which contained a refusal to register the mark

DAN TANA'S restaurant.

Respondent's Mark Should Not Have Been Registered Pursuant to Section 2(a) of the Lanham Act

12. Section 2(a) of the Lanham Act clearly states that:

"No trademark... shall be refused registration ... unless it consists of or comprises ... matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, ...". Lanham Act § 2(a), 15U.S.C.A. § 1052(a).

13. The Trademark Board has further expanded on Section 2(a) by enumerating the following four elements of a successful § 2(a) claim that an applicant's mark falsely suggests a connection with another person. The four elements enumerated by the Trademark Board are: (i) the marks are the same as, or a close approximation of, the name or identity of another person; (ii) the mark points uniquely and unmistakably to the other person; (iii) the person named by the mark is not connected with the activities of applicant; and, (iv) the prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods. In re Wielinski, 49 U.S.P.Q.2d 1754 (T.T.A.B. 1998); In re Sauer, 27 U.S.P.Q.2nd 1073 (T.T.A.B. 1993), aff'd, 26 F.3d 140 (Fed. Cir. 1994) ("Bo Jackson has achieved great fame and notoriety, so that when his nickname is used as part of the "Bo Ball" and design mark on applicant's goods, purchasers will likely make a connection between him and applicant's products").

14. In the instant matter, (i) Respondent's DANTANNA'S mark is identical to

DANTANNA'S restaurant; and, (iv) as evidenced by the unsolicited press coverage, a fraction of which is submitted herewith, it is clear that Petitioner's person and his restaurant are of sufficient fame and reputation, where any use by Respondent of the DANTANNA'S mark is readily associated with Petitioner.

15. There is no doubt that Respondent's initial application to register the DANTANNA'S mark would have been refused under Section 2(a) had Respondent truthfully listed the source of its mark --- Petitioner's DAN TANA name.

Respondent's Registration Was Obtained Fraudulently

16. As already stated above, a review of the original application filed by Respondent on June 9, 2003 in the U.S. PTO reveals that Respondent did not claim the name DANTANNA'S to identify the name or names of living individuals. In fact, it is evident that Respondent in an attempt to overcome the discovery after a search by the PTO examiner that DAN TANA is the name of a famous restaurant and its owner decided to combine the first and last name of the famous restaurateur to avoid having to state whether or not the mark identifies the name of a living individual.

17. In fact, a cursory search through google by simply searching for the name DAN TANA provides 883,000 hits, all of which concern the famed restaurateur and his famous DAN TANA'S restaurant. Annexed hereto and identified as *Exhibit 2* is a copy of the initial google search pages.

18. Based on the unsolicited press coverage Petitioner has and continues to receive for its famous restaurant, there is no doubt that not only consumers but people in the restaurant business are aware of the origins of DAN TANA'S restaurant and know that it is owned

DANTANNA'S name to mislead the public into believing that its restaurant is in some way associated with the famed DAN TANA'S, when in fact it is not.

20. Upon information and belief, there is no other explanation at to why out of a wealth of marks available to be used in connection with the designation of a restaurant, Respondent chose a famed name that was already associated with a well known persona and an established restaurant.

21. Upon information and belief, Respondent committed fraud on the U.S. Trademark Office in obtaining its Registration No. 2,929,764 for the DANTANNA'S mark.

22. It is Petitioner's position that Respondent's initial application for the DANTANNA'S mark should have been refused by the PTO based on Lanham Act § 2(a), 15U.S.C.A. § 1052(a).

23. Since the application mistakenly matured into a registration, Petitioner herein respectfully moves for the cancellation of Respondent's U.S. Registration No. 2,929,764 for the DANTANNA'S mark on the basis that Respondent obtained its Registration fraudulently.

24. Petitioner further maintains that the continued registration of Respondent's Registration No. 2,292,754 will cause injury and damage to Petitioner by confusing consumers into believing that Respondent's restaurant is somehow sponsored by or associated with Petitioner and by barring the registration of Petitioner's rightful name, DAN TANA'S, under its Application Serial No. 78/648306 on the U.S. Trademark Registry.

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WHEREFORE, Petitioner hereby respectfully prays that said Registration Number 2,929,764 be cancelled with prejudice, and for such other and further relief as may be deemed adequate and proper by the Board.

Dated: New York, New York
June 7, 2006

Respectfully submitted,

Afschineh Latifi, Esq.
Tucker & Latifi, LLP
160 East 84th Street
New York, NY 10028
(212) 472-6262
Alatifi@tuckerlatifi.com

Attorneys for Petitioner

Certificate of Service

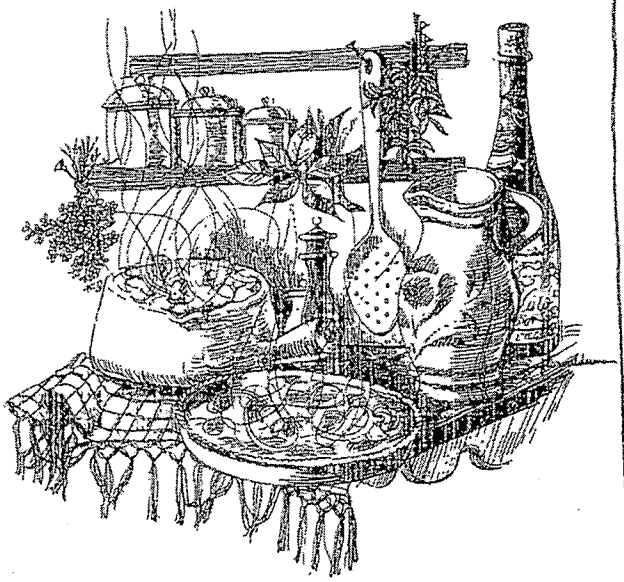
I hereby certify that two originals of the attached document are being deposited on June 7, 2006 with the U.S. Postal Service as "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, Attn: TTAB.

Afschineh Latifi, Esq.

ED943945254US

"Express Mail" Mailing Label Number

Dan Tana's



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OUR ANNUAL RESTAURANT ISSUE!

LOS ANGELES

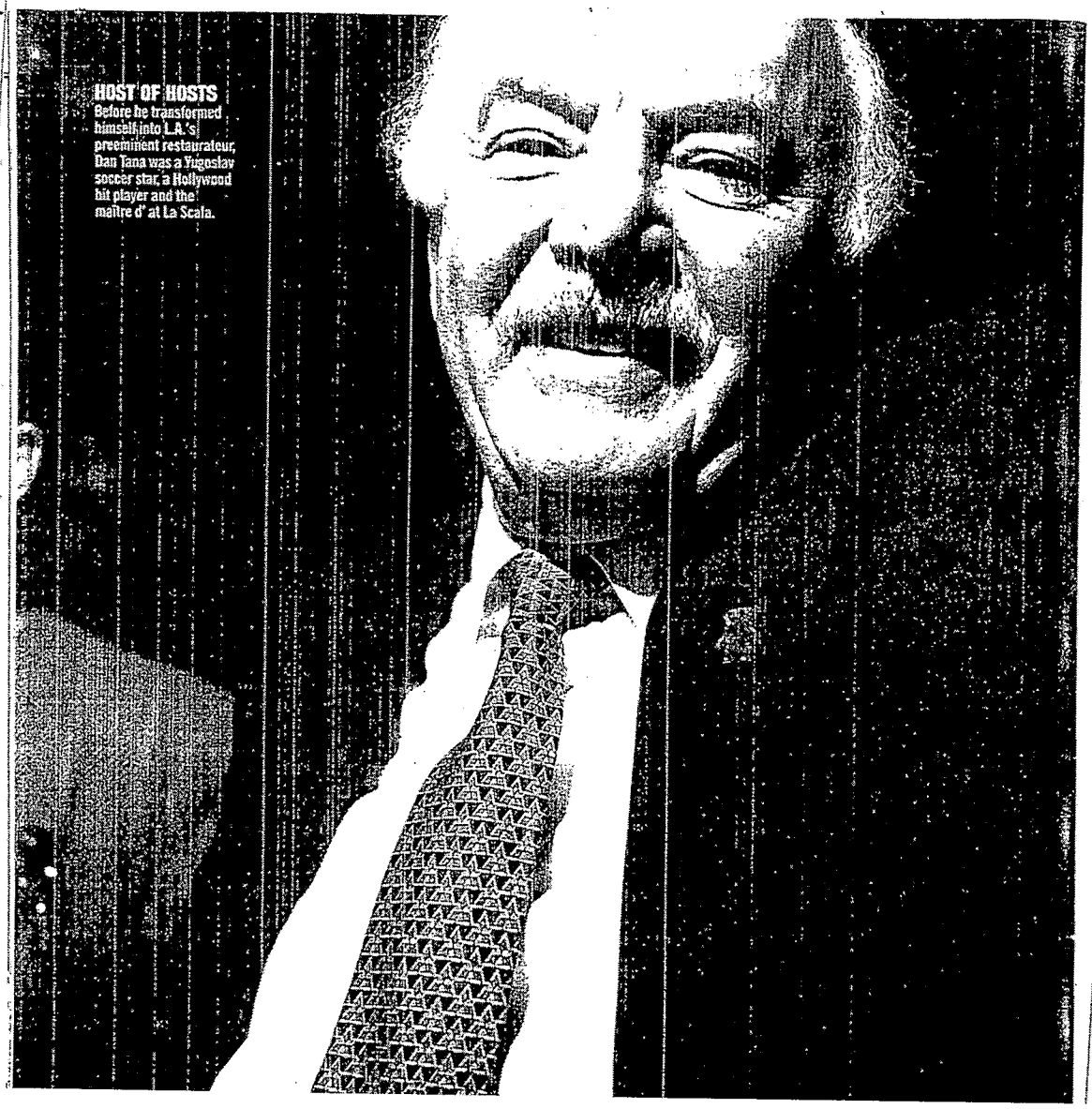
magazine

ENJOY LOVES L.A.

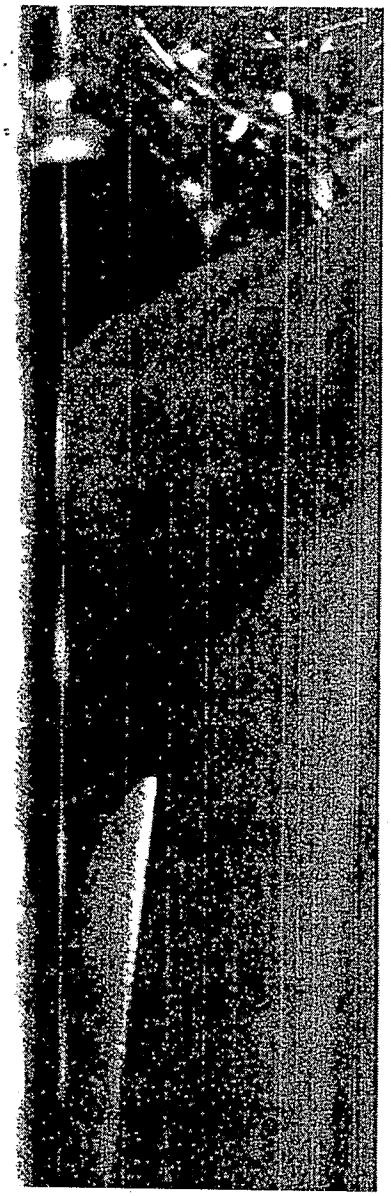
Top Ten New Restaurants

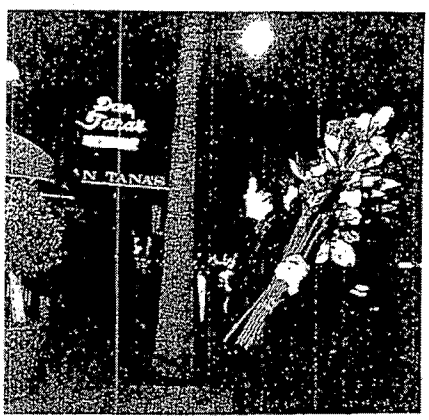
Cheap Eats: The Best for Less

What Makes a



HOST OF HOSTS
Before he transformed himself into L.A.'s preeminent restaurateur, Dan Tana was a Yugoslav soccer star, a Hollywood hit player and the maître d' at La Scala.





It's not trendy, it's not pretty, but it will always be cool. More than a restaurant, Tana's is the ultimate L.A. hangout

EVERYBODY COMES TO DAN TANA'S

FRED ASTAIRE ATE THERE ONCE A WEEK AND RAN A tab. John Belushi dined there the night he died. Dan Tana's was an insider's place when it opened in 1964, and it's an insider's place now. Tana's never changes, where there have been improvements over time.

is that neither of them knows who anybody is.

Andrea. Just inside the door, next to several restaurant awards, there's a picture of Dan with actor Robert Urich, who starred in the TV series *Vegas*. The show's producers were regulars, so Urich's character was named Dan Tana. There's also a large poster from Bob Rafelson's remake of *The Postman Always Rings Twice*—the sexy one with Jessica Lange on the kitchen table pulling her skirt up to her waist. One of Dan's daughters wanted him to take it down, but Rafelson is an old friend. Anyway, the picture confirms the slightly naughty, Rat Pack spirit of the place.

When the restaurant opens at five o'clock, you can hear the soothing classical music that's always on in the background, but by six it's been drowned out by the sounds of glass, metal and human voices. For all the din, the acoustics are still unexpectedly good—one reason Tana's is such a great date place and Valentine's Day is booked solid a year in advance.

There are other reasons. Two are the little language—like that of all old-style professional waiters—belies an intense romanticism, and out on the floor, they do *everything* possible to make a date go well, especially when the couple is young and coming to Tana's is obviously a big deal. There's no hovering, no leering, no condescension, but the boy will feel like he's one of the *machers* at Table 1.

The two maître d's play a vital role in making sure that the Tana Way is maintained even when the owner is not around. Jimmy is at the front from Tuesday through Saturday, while Sunday and Monday, Michael, the manager, takes his place. Michael is a Yugoslav, like Dan. He has a full head of bouffant white hair and a distracted air, as if he were thinking about the [illegible] about a late delivery

The most important thing about both maître d's is that neither knows who *anybody* is. Jerry Seinfeld was surprised not to be recognized one night and asked Jimmy, "Do you know who Jerry Seinfeld is?" Without a trace of apology, Jimmy said no. As he likes to explain, "I don't watch TV except for sports, and I don't go to movies." Of course, Jimmy and Michael have people they consider VIPs, but only because they are regulars.

Occasionally, Dan himself or one of his daughters will whisper in Jimmy's ear that so-and-so is an immensely powerful or famous person and ought to be accommodated if at all possible. But there are many, many tales of Tana maître d's putting celebrities in their place. One Sunday evening, White House chief of staff Alexander Haig phoned the restaurant to say that President Nixon wanted to speak to John Wayne, who was dining there that night. On hearing that the president of the United States was calling, the maître d' said, "And I'm George

Gabriel Byrne and friend

Arturo, the captain

Kurt, the captain

A serious gambler, Dan once won $100,000 at

He turned up on a busy night, date in tow, with no reservation, and was told that he could have a table in two hours. "Do you know who I am?" Travolta asked the maître d'. "No," came the reply.

Daniel, the cook

"I am *John Travolta*."

"Well, for you, Mr. Travolta, it will be *three* hours."

On the other hand, no celebrity is ever hassled at Tana's. Autograph hounds and paparazzi cannot stand up without a waiter or busboy intercepting them like a Patriot missile. That's the way things are done there. That's why three generations of Barrymores, from John to Lionel right down to Drew, have patronized Tana's.

REGULARS ALWAYS TAKE PRECEDENCE

known for his ponytail, a woman who runs an upscale safari company, a beauty in her late fifties who was once the world's highest-paid model, a sloe-eyed actress and a handsome Yugoslav who everybody says is a gigolo.

The second shift is slightly upsier, slightly crazier and slightly more diverse. An X-rated comedienne called Glitter. Luis the 911 operator. A smooth African-American banker named Robert. A movie producer with a sideline in coke. A professional golfer. A rich kid in his late twenties who was a hockey star in college. Then, on different nights, the Irish exiles, the Yugoslavs, and the

Casey Wasserman and his girlfriend

a practicing Catholic. Mike dropped out of high school, but he sent two children to college here in America.

Jimmy hired Craig, an actor, to take Mike's place on Sundays and Mondays. "He told me he'd never poured a drink in his life," Jimmy recalls. "I told him I could teach him that, but I couldn't teach the personality. So I brought him in, set up some bottles of water and told him, 'Look at me and pour a shot with your right hand and then your left, without looking at it.' I can teach anyone how to wait on tables in two

Lew Wasserman and Tana

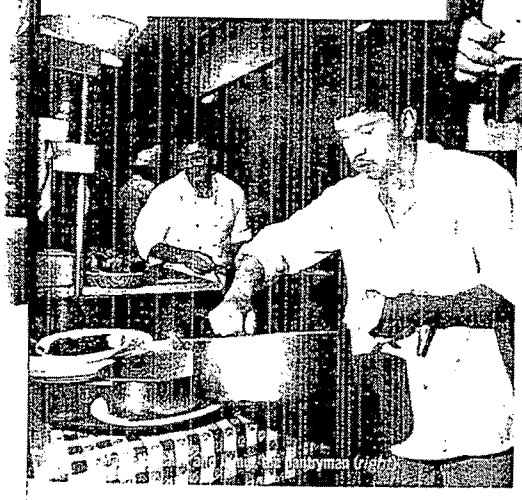
hours, but it's the personality that makes you an asset to the place. For example, Mike is an excellent bartender, but more important, he's rough and tough and rude and crude, and people like that."

Despite the presence of the TV above the bar, the banter is continuous and gets raunchier as the evening draws on. The set is always silent, and Mike controls the clicker. Invariably, it is tuned to a sports

the track and shared it with the entire staff.

Robert—a rugged-looking writer in his fifties—goes into the kitchen every day to question Mate, the chef, about his odds for the evening games. Mate (pronounced *meh-TAY*) is a Croatian. He speaks very little English, but he's an expert on the NBA and the NHL.

Tana's has always been a favorite of professional athletes and team owners. Vlade Divac was a regular (with a dish named after him), and Magic Johnson celebrated his return to the Lakers there. Wilt Chamberlain accumulated a goodly portion of those 10,000 women at the bar, and there are signed and framed Lakers and Rams uniform shirts on two walls in the non-smoking room. Dan says that one of these days he's going to take down the Rams shirt because he is disgusted by their departure from the city.



Dan and Ettore, the captain (right)

Mate

Dan Tana's partyman (right)

MAN GAVE UP SOCCER FOR GOLF LONG ago, but he's in great shape for a man

He was born Dobrivoje Tanasijevic in Belgrade in 1933. His father owned two successful restaurants in the city but made the mistake of supporting the monarchist partisans rather than the communists during the war. When peace came, both restaurants were nationalized by Marshal Tito, and though Dan's father stayed on as manager, his son had no intention of joining the business. Instead, he became a teenage soccer star for the country's top team, Red Star Belgrade.

Dan defected from Yugoslavia to Belgium in 1952 when the team was on a tour of that country. He stayed there for six months, playing for the soccer team Anderlecht, then went to Germany to play for Hannover, one of their top teams, then moved to Canada, where he led a Jewish soccer club called Hakoah. He finally came to the States in 1956 when he joined a Yugoslav-American soccer team in

I always got killed, and I never got to kiss the girl." He appeared in *The Enemy Below* with Curt Jurgens and Robert Mitchum and also in *Rin Tin Tin*, *The Untouchables* and *Peter Gunn*.

When not working on movies, Dan worked in restaurants and clubs. For a while, he was a partner at Peppermint West, the city's first strictly-for-dancing nightclub. ("It introduced the twist to Hollywood," he says.) But soon after he married Andrea Wiesenthal (they are now divorced), he left Peppermint West to become the maître d' at La Scala. It was there that he first decided to start his own restaurant.

When Dan Tana's opened in 1964, it was just a neighborhood spaghetti joint with Mussolini's former cook as first chef. With the help of industry friends and by keeping the restaurant open long after his competitors had closed, Dan gradually transformed Tana's into an institution.

"I never expected it," Dan says of his

DAN TANA'S

(continued from page 61)

Michael Caine. On his lapel he wears a tiny brown teddy bear; his daughter, filmmaker Gabriella Tana, gave him 1,000 of them a few years ago. His manners are old world: He is one of the few men who can carry off kissing a woman's hand. He does it swiftly, smoothly and without hesitation, the same way he lights your cigarette. It's one of the things that gives him his tremendous charm and enables him to get along with anybody and everybody. He speaks Russian, German and Italian and has the air of a man who has embraced America but in the past has played by the rules of a much harsher society. Everyone who works in the restaurant has the same quality.

Dan is a serious gambler and impulsively generous. He once won $100,000 at the track and shared it with the staff. In return, he enjoys ferocious loyalty from friends and employees. On August 1, 1980, the restaurant was all but destroyed by a mysterious fire while Dan was vacationing in Yugoslavia. He flew back and was told that it would take seven months to a year to rebuild.

He still enjoys telling the story of what happened next: "Usually, it takes seven weeks to get a permit to start building, but it only took us a couple of days." It didn't hurt that then governor Jerry Brown was a regular at the time, along with his then girlfriend, singer Linda Ronstadt. "On the front door, there were all kinds of notes and flowers: 'Please don't change it, leave it the way it was. This is our home.' People asked, 'Do you want any money?' It was very heartwarming."

Work proceeded at an incredibly rapid pace. "We got a builder. He was Yugoslav. He said, 'I will have a heart attack, but I'll do it as quickly as I can.'" Every day, the one of them is not Big Nino, the deputy chef. If the bar is Tana's heart, then the kitchen is its soul.

Favorite customers (and a few Tana family members) who always eat the same thing or have contributed their own recipes sometimes have dishes named after them. This has replaced metal nameplates on the backs of chairs, a system that provoked too much jealousy and was abandoned after the 1980 fire. Actor James Woods loves the veal florentine, so it's now called Veal Jimmy Woods. The menu offers Steak Dabney Coleman and Chicken Karl Malden. Producers Sidney Beckerman and Dino Conti have Potatoes Beckerman (fried German style with onions) and Swordfish à la Dino Conti (grilled with olive oil, basil and garlic).

The Yugoslavs all speak some Spanish, and the Mexicans and Central Americans have picked up some Serbo-Croat.

There is constant tension between the kitchen staff and the staff out front. When a dish is ready, one of the cooks puts it on a butcher block for pickup. If the waiter isn't right there, chef Mate bangs on a little bell. It drives him crazy if waiters don't pick up a dish within seconds, and he slams on the brunt of his anger. But they stand their ground and insist that he give them another steak.

Friends often pop in to see Dan in the office upstairs and then stop by the kitchen. Like many of the regulars, they know just about everyone. Dan's golfing buddy, Roger, a Beverly Hills dentist, has treated Mate, who suffers frequently from toothaches. Mate is remarkably thin for a chef; he doesn't like to eat very much, and he drinks only mineral water with lemon juice. (While researching this article, I worked at Tana's for a month, and one day Mate yelled at me for eating my lunch outside on a step while reading the paper. "Come inside and sit at the table," he said. "And put the paper away. Eat like a man." It was one of the longest things I ever heard him say.)

In contrast to Mate, his deputy Nino is an enormous man, strong as an ox. Nino comes from Split in Croatia, but he is half Serb. Though it is hard to believe from looking at him, he was once a top water-polo player. He has a fearsome voice, but when he shouts he is almost always just kidding around.

In the kitchen, Mate is clearly in charge. At one time, he did all the cooking himself, and he is still such a control freak that he stays long beyond his shift to make sure no one is screwing up. He comes in at 10 or so every morning and starts to concoct the marinara and meat sauces, which are made fresh every day and take hours to prepare. If it is Thursday, he lovingly makes osso buco, a favorite of many of the regulars. He is assisted in the mornings by Paco, who cleans and cuts an enormous amount of whitefish, squid and chicken before setting to work peeling garlic.

Tana's serves only dinner, so the first shift usually arrives around lunchtime. Mike the bartender comes in around two to make

deputies, usually Daniel or David, comes in around the same time to make alfredo sauce, fry breaded eggplant slices and see that things are ready to go at five.

Some nights it gets busy right away. But even if it doesn't, you can feel the rhythm of the kitchen speeding up by seven. Between seven-thirty and eight, the orders start flooding in on pink slips of paper that the waiters stick on a spike. If they include salads, the waiter shouts *"una gringa!"* (one green salad) or *"dos Cesares!"* (two Caesars) to Filomeno in the back. Regulars rave about the salad dressing at Tana's, and it is Filomeno who prepares it according to a secret Dan Tana recipe.

All four cooks on the line are equally responsible for the orders. If one puts a pan on the stove and has to turn away to deal with something else, the next guy watches it for him and takes it off when it's ready, all without a word being said. As they bend to take stuff out of the ovens or reach to put a steak on the grill or throw a handful of salt over another's arm, not a single movement is wasted—they could be gymnasts or a team of Navy Seals.

TO THE OUTSIDER, THE LANGUAGE OF the kitchen and the wait staff is a raucous Esperanto. Listen carefully, and you realize you are hearing Spanish and Serbo-Croat mixed with heavily accented English. The Yugoslavs all speak some Spanish, and the Mexicans and Central Americans have picked up some Serbo-Croat. Mostly curse words, of course, but other phrases, too. Danny the busboy, who is Mexican, will often shout *"Gospodi Sedeli!"* at Nick the waiter, pointing at the slightly too long sleeves of Nick's tux. It means "Hey, Mr. Country Boy" in Serbo-Croat. And they both double over laughing.

One might expect that a restaurant owned by a Serb who employs members of every Balkan ethnic group—from Bosnian

"If you really want to be successful with a restaurant, you can have only one. It's like a wife."

after finishing out their contracts, then called Dan Tana, whom he knew from the island of Hvar in the Adriatic, where Dan has a summerhouse. Dan gave him a job and put them up until they found their own feet.

Another young Yugoslav exile named Dushko works as a busboy. His father was a leading journalist in the old Yugoslavia and lived for a while in London. Dushko speaks heavily accented but very rapid English and talks to anyone who will listen, particularly about films, though he has a Frenchman's contempt for "Hollywood" movies. He'll drop off some plates in the kitchen and ask, "Tell me, do you know this film with Julie Christie?" only to have Nino the cook cut in with "Get the f—outta here, I'm sick of you talking. You're like a sports commentator—talk, talk, talk. Get out of my kitchen!"

The war in the Balkans and the breakup of Yugoslavia have been painful for Dan. His beloved vacation villa is on a beautiful island that is now part of Croatia. He designed the house himself and over the years has made it available to hundreds of friends. (When Wilt Chamberlain arrived on the island accompanied by two gorgeous Swedish girlfriends, he was the

very loudly, "What the hell is that damned Serb doing here?"

CONVENTIONAL RESTAURANT WISDOM holds that the owner of a restaurant must be there all the time. But Dan's duties with UEFA, the European soccer federation, and with the Yugoslav World Cup team take him away for weeks at a stretch. When he returns, things tighten up, the pace in the kitchen quickens, and the service seems slightly more polished. Even customers can feel the difference in the air.

Dan comes through the small, crowded kitchen several times a day. They are casual visits—he doesn't check the sauces because he and Mate have worked together for nearly two decades—yet he notices *everything*. If Dan thinks people are getting sloppy, he becomes an avenging angel, all geniality extinguished, eyes flashing. "Clean this up! Put that away! What the hell do you think you are doing?" (I saw him do this only once, but everyone in the kitchen was fearful and subdued. A half hour later, the city health inspector arrived for a spot check.)

Still, Dan's absences are just as important to the smooth running of the restaurant. If he were there all the time, the staff would be too nervous. When he's away, the place breathes and stretches and trundles right along. For Mike the manager and Jimmy the maître d', the Tana Way is almost second nature. But without Dan at the helm, the personality of the place, its whole culture, begins to undergo subtle, almost undetectable changes, like a ship veering ever so slightly off course. In the short term, it doesn't matter; in the long term, it could be dangerous. Dan knows this, and he always comes back within six weeks. "When I'm in town, I'm in the restaurant every night—even if I eat somewhere else,"

INDULGENCES

Where the men o

Matt Damon is among the many celebs who come in. "He's like family," says owner Dan Tana. "This place is like a private club without the membership."

"George once went on TV wearing our T-shirt, and he was asked to take it off. He told them, 'If you want one, it's with the shirt — I won't take it off,'" says Dan.

Brad loves it in for the star, Neno says. George does

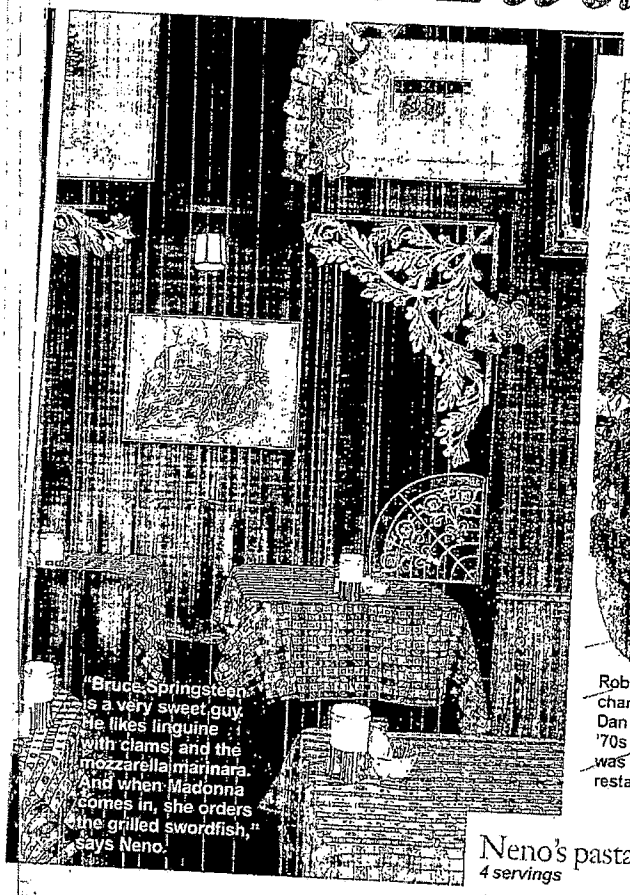
At Dan Tana's, a legendary Hollywood hotspot, everyone is a star!

Thanks to the success of *Ocean's Eleven* — and his new hit *Ocean's Twelve* — George Clooney and his on-screen posse have reinvented Frank Sinatra's Rat Pack. And offscreen, they carry on the tradition at the same LA restaurant, Dan Tana's, that Frank and his friends visited for classic Italian

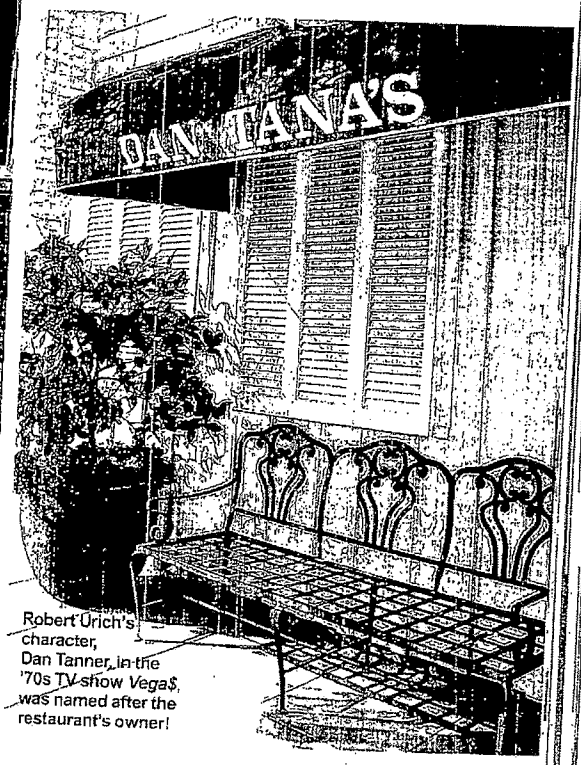
most popular dishes is pasta bolognese. But it's the *Ocean's* crowd, led by restaurant regulars George and his co-star Brad Pitt, who've added a dash of glamour to the stellar scene. "Brad and George are usually with a group of friends," says Neno. "Nobody bothers them, and they feel at home and safe."

there that they wanted Dan Tana's to be represented in *Ocean's Twelve* — they got maitre d' Craig Susser to play a waiter in the film. "I know all the boys, so it was fun," says Craig. "It was like a paid vacation. What I really love doing is running

Ocean's Twelve dine



"Bruce Springsteen is a very sweet guy. He likes linguine with clams, and the mozzarella marinara. And when Madonna comes in, she orders the grilled swordfish," says Neno.



Robert Urich's character, Dan Tanner, in the '70s TV show *Vega$*, was named after the restaurant's owner!

Neno's pasta bolognese

4 servings

1 large onion, peeled and diced
½ cup olive oil
1 lb. ground beef
1 lb. ground veal
¼ cup chopped parsley

spoon, stir in tomato paste and oregano. Cook 2 min. Stir in wine and cook (partially covered) 45 min., stirring occasionally. Meanwhile, prepare pasta according to package

Army Archerd

JUST FOR VARIETY

GOOD MORNING: When the Demo convention blasts off in Boston July 26-29, Robert Altman and his "Tanner on Tanner" troupe will be there. He and scripter Garry Trudeau will be lensing an impressive list of the top politicos as part of three new segs of the series which first aired on HBO in 1988 "Tanner'88." It has returned on the Sundance Channel with up-to-date wrap-arounds by the three principals — Michael Murphy, Pamela Reed and Cynthia Nixon — explaining the current re-entry into the political fray. Filming of the new segs starts July 12 in N.Y. with locations including Elaine's, one of Altman's favorite hangouts. Among those already committed to appear are Robert Redford (who will next star in "The Candidate" for WB), Mario Cuomo, Madeleine Albright, Martin Scorsese, Harry Belafonte, Rev. Al Sharpton, Carl Bernstein, Al Franken, Ron Reagan. At the convention, Altman also hopes to tape Bill Clinton, Al Gore and John Kerry (whom Altman knows "quite well") giving political advisories. In the first series, among those on camera were Pat Robertson, Bob Dole, and Gary Hart. About the new, renewed project, Altman tells me, "Everyone is even more supportive than [illegible] I couldn't be more thrilled." He We give them freedom in our fiction so we never know how it'll turn out." The new segs will be delivered in October for airing pre-election, natch. Wren Arthur and Matthew Seig produce for Altman's banner ... Michael Murphy ("Tanner") also stars in John Sayles' upcoming feature "Silver City," this time playing a right wing senator from Colorado who is positioning his son (Chris Cooper) to run for governor. "Does that ring a bell?" Murphy asked me. The "Silver City" trailer is skedded to run on "Fahrenheit 9/11" screens. Murphy also stars in the Canadian series "H20" — about a U.S. takeover of Canada — well as the CBC series, "The Wonderland."

Altman

ALEXANDRA KERRY, award-winning grad of AFI, is in London talking to prospective backers for two new dramatic scripts. She tells me she has also been shooting a documentary during the campaign and yes, she does know Altman. "He is my idol." She wings in from England Friday as she and sister Vanessa join up with their father on the campaign trail in Minnesota, Wisconsin and Iowa for the Fourth of July weekend. Vanessa, who wound classes Tuesday at Harvard Medical School, tells me she's taking three months off to campaign after which she moves to London to get a degree in global health. The Kerry sisters then wing to L.A. to head the Tuesday's [illegible] Fonda was a staunch Demo-supportive thesp and I once traveled with him on a campaign trail for Harry Truman. The program at the Fonda to get out the young vote will boast appearances by Leonardo DiCaprio, Christina Applegate, Colin Hanks, Jon Lovitz, Scarlett Johansson, Jason Biggs, Lucas Haas and William H. Macy and performances including Tenacious D, Liz Phair and Dave Grohl. The show's music is produced by Mitchell Frank of the Silver Lake nitery Spaceland and Ben Cooley; overall producer is Kristina Schake. The Kerry sisters tell me their lifelong friend Nancy Baker Cahill of Boston was instrumental in launching this show. Ducats at $150 can be obtained on www.concertsforkerry.org.

THE 31ST ANNUAL VISION Awards, held Sunday at the BevHilton, raised $400,000 to help find a cure for Retinitis Pigmentosa. KTLA's Mindy Barbano graciously agreed to co-host with me when another had to bow out at the last moment. Among the many awardees, Laurence Fishburne reminded all, "We're so fortunate as visual artists to have the opportunity to dream, not only to have vision, but to actually see these things come to life." SAG president and honoree Melissa Gilbert was introduced by her sister, Sara Gilbert. Other presenters included Bob Saget, Paul Michael Glaser, Hank Azaria, Kasi Lemmons, Alan Thicke, Anthony Anderson, Jeffrey Kwatinetz, Debra Wilson and Diane Ladd. ... Vincent Sherman, who directed Ronald Reagan, Patricia Neal and Richard Todd in "The Hasty Heart" in

Army Archerd

JUST FOR VARIETY

GOOD MORNING: Gena Rowlands suffered a fractured shoulder on a rainy and muddy set of Universal's "The Skeleton Key" Monday night in New Orleans. She was taken to Tulane U.'s hospital, where doctors decided not to perform surgery, but rather to examine her healing progress — as she has a five-week hiatus from her role in the pic with Kate Hudson and John Hurt for director Iain Softley ... It's a 10th grandchild for Richard Zanuck: Luke Harrison Zanuck was born Tuesday to Harrison and Patricia Z. at Cedars-Sinai Medical Center. Richard winged in from London's Pinewood preparations on "Charlie and the Chocolate Factory" starring Johnny Depp, Tim Burton directing. Nestle's Chocolate will be a factor in the merchandising of the high-tech pic, which will boast rivers and waterfalls of chocolate ... The Zanucks, pere et fils, are awaiting word from the Sci Fi Channel on their pilot "Dead Lawyers," in which attorneys return from the dead to redo dastardly deeds. "I don't think any lawyer will speak to us afterwards," Dick Z. allowed. He and David Brown also are awaiting a go from DreamWorks on "The Ninth Man," which Todd Field would direct. Also on the Zanuck family's sked is "Journey to the Center of the Earth" ... Add Hollywood celebrations: Jackie Cooper called to happily report he and wife Barbara celebrate their 50th wedding anniversary. They were married on a day off from "King of Hearts," in which he was starring on B'way. Cooper, 81, started his career in films at the age of 3 and was Oscar-nominated (the youngest ever) for "Skippy" in 1931. As he tells it, Lionel Barrymore beat him for the Oscar with his perf in "A Free Soul." "And at the awards dinner at the Biltmore Hotel, he (Barrymore) came over to our table and said, 'This really belongs to you — they gave it to me because they thought I was going to die'!" Cooper went on to do 64 films (his favorite: "The Return of Frank James" with Henry Fonda). Cooper segued to television, where he produced, starred in two series and directed countless segs, for which he won several Emmys. He retired from the biz 12 years ago, and he and wife Barbara live in the Wilshire corridor.

ON WB'S "OCEAN'S TWELVE" location in Chicago Wednesday, Carl Reiner, repeating his role, was being served by a waiter in the "most WASPish men's club in town." The waiter was Dan Tana's maitre d' Craig Susser. Exec producers Jerry Weintraub and Susan Eakins are regulars at Tana's in West Hollywood — as are the pic's co-stars George Clooney, Brad Pitt and Scott Caan. The affable Susser also recently wound a role in MGM's "Be Cool," the sequel to "Get Shorty." "Cool" producer Stacey Sher and the studio's Chris McGurk are also regulars at Tana's ... Well, that's one way to be sure of a table at the always busy Tana's, which Oct. 1 marks its 40th year on the same site ... With all the legal problems on "Winnie the Pooh" settled, I found Disney Live's "Winnie the Pooh and the Perfect Day" troupe rehearsing at the U. of Miami Convocation Center as they ready for a global tour of the unique live presentation. Director B.T. McNicholl, with B'way credits including "Cabaret" and "A Funny Thing Happened on the Way to the Forum," said the show "will have the feeling of happening before your eyes. It's truly interactive, live and immediate with the audience. The audience will help motivate turns in the plot — like dancing with Tigger — or someone in the audience helping to pull Pooh out of the hole." The show will bow June 16 in New Zealand, with dates to follow in Australia, Asia and Europe. The permanent cast of 14 performs 14 songs, among 'em those by the Sherman brothers from the Disney film, plus new additions. The characters are Pooh, Piglet, Eeyore, Tigger, Owl and Kanga, with comic characters called "Honey Helpers" adding narration — but no Christopher Robin. McNicholl assured me the "Pooh" production is nothing like "Snow White" at Disneyland. It has two acts and runs 90 minutes. The show is produced by Kenneth Feld Entertainment.

Reiner

DOLORES HART'S FRIENDS in Hollywood, who have been addressing her as Mother Dolores since her elevation at the Abbey of Regina Laudis, may now have to address her as "Doctor Mother Dolores": She will receive an honorary doctorate of law May 23 from Fairfield U. in Connecticut. The degree's in recognition of her contributions to both religion and the arts and her ability to bring those two worlds together. Also receiving an honorary degree that day will be Cokie Roberts ... On May 24, To
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HOLLYWOOD
Celebrity Soup

By Jill Cameski

Party Time...

Happy 40th Dan Tana!
Still Super Cool and...
In With the "In" Crowd!

Dan Tana's was an insider's place 40 years ago and it's still an insider's place—catering to every generation of Hollywood elite. Fred Astaire ate there, John Belushi had dinner delivered from there the night he died. John Wayne received a call from President Nixon while eating and Lionel and John Barrymore loved the food...now so does Drew. Lloyd Bridges was a regular as are sons, Jeff and Beau. From *The Eagles* and *Red Hot Chili Peppers* to Larry King, Nicole Kidman, Cameron Diaz, Rod

Dan Tana

Cameron

men, spectacular women, movie stars and moguls...thick steaks, stiff drinks... no wonder it's lasted! It has something for everyone—yummy food!

Speaking of steaks, Dan Tana buys his beef from a special purveyor in Kansas City and it arrives daily. The beef is cut by the chef as needed and is so expensive, Dana Tana says he makes zero profit, but would never considered another source or a change in portion size.

George

Robert Mitchum's film *"Enemy Below."* He had another small part in *"The Untouchables."* Recently, Dan Tana's Maitre'd appeared in *"Ocean's 12"* and producers Jerry Weintraub and Suzy Ekins thought it would be great to feature Craig Susser in the movie, since he mingles with *"New Rat Packers"* and Hollywood legends. Craig is also featured in *"Be Cool"* the *"Get Shorty"* sequel, a role that came because Chris McGurk and Michael Nathanson at *MGM* and Stacy Sher (*"The Producers"*) are regulars at *Dan Tana's* as is the film's star, Vince Vaughn. George Clooney, Brad Pitt and Matt Damon duck in for drinks and dinner and so does Red Buttons, Stefanie Powers and Debbie Reynolds. Dan Tana got started in the restaurant business working as the Maitre'd at *La Scala*, then as a partner at *Peppermint Twist*. He opened *Dan Tana's* in 1964.

Brad

EXHIBIT “C”

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CITY	Duluth
STATE	Georgia
ZIP/POSTAL CODE	30097
COUNTRY	United States
PHONE	305-461-2228
FAX	305-461-2231
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CITY	Duluth
STATE	Georgia
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COUNTRY	United States

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NUMBER OF CLASSES	1
NUMBER OF CLASSES PAID	1
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TOTAL FEE PAID	300
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SIGNATORY'S NAME	Frederick K. Taylor
SIGNATORY'S POSITION	Senior Counsel
DATE SIGNED	03/08/2010
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SUBMIT DATE	Mon Mar 08 14:28:19 EST 2010
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REGISTRATION DATE: 03/01/2005

MARK: DANTANNA'S

The owner, Great Concepts, LLC, having an address of
2515 Highbrooke Trail
Duluth, Georgia 30097
United States
is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 043, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

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Specimen File1
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Converted PDF file(s) (1 page)
Specimen File1

The registrant hereby appoints Frederick K. Taylor of Procopio Cory Haregreaves & Savitch
530 B Street, Suite 2100
San Diego, California 92101
United States
to file this Combined Declaration of Use and Incontestability under Sections 8 & 15 on behalf of the registrant.

A fee payment in the amount of $300 will be submitted with the form, representing payment for 1

class(es), plus any additional grace period fee, if necessary.

Declaration

The mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce. There has been no final decision adverse to the owner's claim of ownership of such mark, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.

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Signature: /Fred Taylor/ Date: 03/08/2010
Signatory's Name: Frederick K. Taylor
Signatory's Position: Senior Counsel

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DINNER MENU

DANTANNA'S DOWNTOWN

SOUPS

SHE CRAB SOUP - $5/$8 CHICKEN & SAUSAGE GUMBO - $5/$8 SOUP OF THE SEASON - $4/$6 DANTANNA'S CHILI - $5/$8

APPETIZERS

BEEF CARPACCIO* - $14 Creekstone Farms raw beef tenderloin drizzled with olive oil & fresh lemon juice; topped with fried capers & imported Parmesan

MONSTER PORTABELLA QUESADILLA - $10 With caramelized onions

SPICY BLUE CRAB FINGERS - $12 Flash fried; with Cajun butter sauce

DANTANNA'S BUFFALO WINGS - $9 Mild, medium or hot; with blue cheese

KEY WEST WINGS - $9 Tossed in sweet & spicy mango-habanero glaze

PEPPERED CALAMARI - $9 With artichoke hearts, olives, garlic aioli & sweet chili dipping sauce

BLUE CHEESE ARTICHOKE HEARTS - $9 Stuffed with blue cheese, Panko coated, flash fried & served with spicy remoulade

CAJUN CHICKEN EGG ROLLS - $10 With Creole mustard dipping sauce

FRIED FRESH MOZZARELLA - $9 With fried basil and balsamic romesco

CRAB & ARTICHOKE DIP - $14 With crisp corn tortillas

MEDITERRANEAN MUSSELS - $12 With fresh tomato sauce, lemon, white wine, capers, artichoke hearts & pepperoncinis

JUMBO PRAWN COCKTAIL - $14 With caper cocktail sauce

CHEESEBURGER EMPANADAS - $10 Seasoned Creekstone Farms ground beef, cheese & pickles; flash fried in a flaky pastry & served with Coca Cola ketchup

GRILLED SAUSAGE SAMPLER - $10 Chef's daily selections with spicy mustards & warm cabbage & bacon salad

SALADS

CAPRESE - $9 Fresh mozzarella, tomatoes, basil, olive oil & balsamic reduction

CAESAR* - $9 Add NY strip - $8 Add chilled grilled chicken - $6

CLASSIC GREEK - $10 With red wine vinaigrette - Add seafood salad- $5

DANTANNA'S WEDGE - $8 With diced tomatoes, bacon, Great Hills blue cheese crumbles & blue cheese dressing - Add buffalo chicken to make it a "Scheel" - $6

SPINACH - $10 Oranges, almonds, blue cheese, tomatoes & red onions; with champagne-lime vinaigrette - Add chili glazed shrimp - $7

SPICY BEEF* - $15 Creekstone Farms all-natural beef tenderloin tossed with ginger, soy & Sambal chili glaze; chilled & served over spring mix and peanut-soba noodles

LUMP CRAB & FRESH BERRY - $16 Lump crab, fresh berries & tropical fruit over organic baby field greens; with raspberry vinaigrette

ASIAN CHICKEN - $11 Pineapple-teriyaki chicken, carrots, sprouts, snow peas & water chestnuts; with rosemary-ginger vinaigrette

FRIED CHICKEN - $11 With avocado, tomatoes, black olives & red onions; available buffalo style or with chilled grilled chicken breast

AGED STEAKS & CHOPS*

USDA certified Choice, Creekstone Farms Black Angus Beef aged a minimum of 28 days. Served with your choice of two side items.
Add a small house or Caesar salad for $3.

DIJON-GARLIC HANGER STEAK - $19 Grilled, sliced and served with sweet onion-vodka demi glace

FILET MIGNON 8 oz. - $28 12 oz. - $41

RIBEYE 14 oz. - $27

COWBOY CUT RIBEYE 20 oz. - $36 Bone-in

NEW YORK STRIP 14 oz. - $27

DANTANNA'S STRIP 22 oz. - $43 Bone-in New York Strip

FLAT IRON STEAK 8oz - $19

NIMAN RANCH PORK CHOP 12 oz. - $22 Organic rib chop with Granny Smith-bourbon sauce

RACK OF LAMB - $32 Roasted; served with fresh cherry demi glace

HOUSE SPECIALTIES

Served with your choice of two side items.
Add a small house or Caesar salad for $3

ROSEMARY ROASTED CHICKEN - $19 Leg, thigh & breast of Springer Mountain free range, organic chicken with rosemary demi glace

PEPPERED SALMON FILLET* - $19 Crusted in peppercorns & pan seared; with brandy-ginger cream

FISH & CHIPS - $14 With spicy rémoulade & house fries

BEER BATTERED SHRIMP - $18 With spicy rémoulade & caper cocktail sauce

ZINFANDEL SHORT RIBS - $19 With blackberry BBQ sauce

BRAISED LAMB SHANK - $24 With tomato, garlic & oregano

GRILLED DUCK BREAST* - $22 With Georgia peach & blueberry infused reduction

WASABI TUNA* - $24 Rubbed with wasabi & Panko, pan seared; with lump crab & shiitake-soy glaze

SANDWICHES

Served with your choice of house fries or red bliss potato salad

THE DANTANNA BURGER* - $9 USDA certified Choice, Creekstone Farms Black Angus Beef | 100% meatless Veggie Burger also available

Cheeses: American, Swiss, cheddar, provolone, pepper jack, blue, brie

Other toppings: Portabella mushrooms, button mushrooms, grilled onions, bacon, jalapeño peppers | (Add $.50 per cheese and topping; add $1 for bacon)

GRILLED ORGANIC CHICKEN - $10 Springer Mountain free range chicken breast with lettuce, tomato, onion & herbed goat cheese

REUBEN - $9 Corned beef or peppered turkey, Swiss, sauerkraut & Russian dressing on grilled rye

DANTANNA'S "FREUBEN" - $10 Fried tilapia, cabbage slaw, Swiss cheese & Russian dressing

ROAST BEEF* - $12 Rare, Italian-style roast beef served chilled on a pretzel bun with creamy horseradish sauce

PHILLY RIBEYE OR CHICKEN CHEESESTEAK - $14 Thin sliced Creekstone Farms aged prime rib or Springer Mountain organic chicken topped with sautéed onions & provolone cheese on a toasted sub roll

FRIED MOZZARELLA & FINOCCHIONI SANDWICH - $14 Sliced fennel salami, Panko coated, flash fried fresh mozzarella, sliced tomato, pesto vinaigrette & field greens on a toasted sub roll

SURF & TURF COMBOS

Create your perfect combo. To any entree add;

SHRIMP (5) - $7

GRILLED JUMBO PRAWN - $7

FRESH MAINE LOBSTER TAIL - $M/P

DRY RUBS & SIGNATURE SAUCES

DRY RUBS:
Dantanna's blend
Cajun
Pepper blend
Garlic

SIGNATURE SAUCES:
Mushroom demi glace - $3
Zinfandel-blackberry BBQ sauce - $2
Cabernet & brie sauce - $3
Classic Béarnaise - $2

SIDE ITEMS

Asparagus - $5
Sautéed mushrooms - $5
Sautéed garlic spinach - $5
Aromatic rice pilaf - $3
Rosemary roasted red potatoes - $4
Mashed sweet potatoes - $4
Roasted garlic mashed potatoes - $4
Blue cheese mashed potatoes - $5
House fries - $4
Loaded jumbo baked potato - $6

*Consuming raw or undercooked meats, poultry, seafood, shellfish, or eggs may increase your risk of foodborne illness

EXECUTIVE CHEF/PARTNER – BILL HOGAN | SOUS CHEF – VICTOR AMATO

ROUTING SHEET TO POST REGISTRATION (PRU)

Registration Number: 2929764

Serial Number: 78259855

RAM Sale Number: 691

RAM Accounting Date: 20100309

Total Fees: $300

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

Transaction	Fee Code	Transaction Date	Fee per Class	Number of Classes	Number of Classes Paid	Total Fee
§8 affidavit	7205	20100308	$100	1	1	$100
§15 affidavit	7208	20100308	$200	1	1	$200

Physical Location: 900 - FILE REPOSITORY (FRANCONIA)

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

Transaction Date: 20100308

EXHIBIT “D”

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

REGISTRATION NO: 2929764 SERIAL NO: 78/259855 MAILING DATE: 03/26/2010
REGISTRATION DATE: 03/01/2005
MARK: DANTANNA'S
REGISTRATION OWNER: Great Concepts, LLC

CORRESPONDENCE ADDRESS:
Frederick K. Taylor
Procopio Cory Haregreaves & Savitch
530 B Street, Suite 2100
San Diego CA 92101

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(1)

THE COMBINED AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

****

NOTICE OF ACKNOWLEDGEMENT

15 U.S.C. Sec. 1065

THE AFFIDAVIT FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 15 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1065.

ACCORDINGLY, THE SECTION 15 AFFIDAVIT IS ACKNOWLEDGED.

****

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
043.

PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

ORIGINAL

REQUIREMENTS FOR MAINTAINING A FEDERAL TRADEMARK REGISTRATION

I) SECTION 8: AFFIDAVIT OF CONTINUED USE

The registration shall remain in force for 10 years, except that the registration shall be canceled for failure to file an Affidavit of Continued Use under Section 8 of the Trademark Act, 15 U.S.C. Sec. 1058, at the end of each successive 10-year period following the date of registration.

Failure to file the Section 8 Affidavit will result in the cancellation of the registration.

II) SECTION 9: APPLICATION FOR RENEWAL

The registration shall remain in force for 10 years, subject to the provisions of Section 8, except that the registration shall expire for failure to file an Application for Renewal under Section 9 of the Trademark Act, 15 U.S.C. Sec. 1059, at the end of each successive 10-year period following the date of registration.

Failure to file the Application for Renewal will result in the expiration of the registration.

NO FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS WILL BE SENT TO THE REGISTRANT BY THE PATENT AND TRADEMARK OFFICE. IT IS RECOMMENDED THAT THE REGISTRANT CONTACT THE PATENT AND TRADEMARK OFFICE APPROXIMATELY ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.

EXHIBIT “E”

ESTTA Tracking number: **ESTTA366190**
Filing date: **09/01/2010**

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

Proceeding	92045947
Party	Defendant Great Concepts, LLC
Correspondence Address	R. Milton Crouch Shapiro Fussell, LLP 1360 Peachtree St., Suite 1200 Atlanta, GA 30309 UNITED STATES mcrouch@shapirofussell.com, docketing@procopio.com, lmf@procopio.com, mlf@procopio.com, fkt@procopio.com
Submission	Other Motions/Papers
Filer's Name	Frederick K. Taylor
Filer's e-mail	docketing@procopio.com, fkt@procopio.com, tma@procopio.com,
Signature	/Frederick K. Taylor/
Date	09/01/2010
Attachments	Request_to_Remove_Stay_of_Proceedings.pdf (5 pages)(20406 bytes) Exhibit 1.pdf (34 pages)(1456182 bytes)

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

DAN TANA,	)	
	)	
Petitioner,	)	Cancellation No. 92045947
	)	
v.	)	Registration No. 2929764
	)	
GREAT CONCEPTS, LLC,	)	Mark: Dantannas
	)	
Registrant.	)	
	)	

GREAT CONCEPTS' REQUEST TO REMOVE SUSPENSION OF PROCEEDINGS

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir/Madam:

PLEASE TAKE NOTICE that Registrant Great Concepts, LLC ("Registrant"), hereby requests that the Suspension on the Cancellation Proceeding issued by this Board on February 4, 2010, be removed, and that new dates be set for Registrant's Motion for Summary of Judgment as outlined below.

I. Introduction

Petitioner Dan Tana ("Petitioner") initially filed this cancellation proceeding on June 6, 2006. Once Petitioner was faced with a motion for summary judgment from Registrant, in what this Board called an "apparent response to the motion for summary judgment," Petitioner filed a copy of the complaint in the civil action, styled *Dan Tana v. Dantanna's, Great Concepts, LLC, et al.*, Case No. CV 07-05532-ABC (JwJx), in the United States District Court for the Central District of California on August 23, 2007.

On September 12, 2007, a mere two weeks after Registrant filed its Motion for Summary Judgment in this proceeding, Petitioner filed his Motion to Stay the Cancellation Proceeding, pending the U.S. District Court's resolution of Petitioner's federal suit. Petitioner had filed its Motion to Stay without seeking the consent of Registrant. Petitioner even neglected to serve Registrant with a copy of his Motion to Stay. Registrant only had knowledge of the motion when the Board sent a notice of non-compliance to Petitioner a few days after the motion was filed. This Board eventually granted Petitioner's Motion to Stay on September 20, 2007.

Registrant then filed a Motion to Dismiss for Lack of Personal Jurisdiction in the U.S. District Court action on November 19, 2007. Petitioner opposed on December 3, 2007, and Registrant replied on December 10, 2007. On February 12, 2008, the U.S. District Court issued an order granting Registrant's Motion to Dismiss for Lack of Personal Jurisdiction with prejudice to refilling this action in California.

Petitioner then filed another lawsuit in federal district court. Petitioner filed an action styled *Dan Tana v. Dantanna's, Great Concepts, LLC, et al.*, Case No. CV 08-CV- 0975 TWT in the United States District Court for the Northern District of Georgia. The complaint in that action alleged claims of False Designation of Origin Under the Lanham Act § 43(a), 15 U.S .C . § 1125(a)), and related claims under Georgia statutes.

On February 26, 2009, after a full period of discovery, the same party which is the Registrant to this proceeding, Great Concepts, LLC, filed a motion for summary judgment. On September 15, 2009, the court granted Great Concepts' motion dismissing the action. On October 7, 2009, Petitioner filed a notice of appeal to the United States Court of Appeals for the Eleventh Circuit, Case No. 09-15123.

Both the Petitioner and Great Concepts fully briefed the issues raised on appeal. On July 15, 2010, the Court of Appeals issued an order, published opinion and judgment affirming the trial court's grant of the motion for summary judgment. A true and correct copy of that Court's Order, published opinion and Judgment are attached herein as Exhibit "1."

In granting affirming the district court's granting of summary judgment, the court stated, with regard to the likelihood of confusion:

> Viewing the likelihood-of-confusion factors as a whole, there is minimal evidence of a likelihood of confusion between Plaintiff's and Defendants' restaurants aside from the initial similarity of their names and the fact that they both provide restaurant services. The remaining factors all weigh against a likelihood of confusion, some overwhelmingly so. There are stark differences between the two restaurants' cuisine and ambiance. There is virtually no evidence of confusion in advertising channels. No reasonable jury could find that Defendants intended to trade on Plaintiffs mark, and there is negligible evidence of any actual confusion between the two restaurants.

See, *Exhibit 1, Order and Opinion,* p. 29. Accordingly, despite the similarity in names, the Court ultimately upheld the dismissal of Petitioner's action.

II. <u>Discussion</u>

The Code of Federal Regulations which governs Motions to Suspend in TTAB actions states the following in pertinent part:

> Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, *proceedings before the Board may be suspended until termination of the civil action* or the other Board proceeding.
>
> 37 CFR § 2.117(a) (emphasis added).

Given that the civil action before the U.S. District Court has now been terminated, and all matters before that Court are now disposed, Registrant hereby requests that this Board remove the suspension on proceedings. Registrant further requests that; new dates be set for Registrant's

Motion for Summary Judgment; that Petitioner's opposition to the same be due thirty days after the Order removing the Suspension of Cancellation Proceedings; and for Registrant's reply to said opposition be set seven days before the hearing on the summary judgment motion. Moreover, pursuant to this Board's suspension order of February 4, 2010, Registrant hereby notifies the Board of the disposition of District Court Case No. CV 07-05532-ABC (JwJx) and United States Court of Appeals Case No. 09-15123, and requests that this case may be called up for appropriate action.

III. Conclusion

Registrant respectfully requests that this Board remove the Suspension on the Cancellation Proceeding, and further, that this Board reset dates for the decision on Registrant's Motion for Summary Judgment, Petitioner's opposition, and Registrant's reply to the same.

Respectfully submitted,

Procopio Cory Hargreaves & Savitch LLP

Dated: September 1, 2010

By: /Frederick K. Taylor/

Fredrick K. Taylor
Lisel M. Ferguson
530 B Street, Suite 2100
San Diego, CA 92101
Telephone: (619) 515-3279
Facsimile: (619) 235-0398
Email: fkt@procopio.com

Milton Crouch
Shapiro Fussell, LLP
1360 Peachtree St., Suite 1200, Midtown Plaza
Atlanta, GA 30309

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **REQUEST TO REMOVE SUSPENSION of PROCEEDINGS** is being emailed on September 1, 2010 to the attorney for Petitioner as follows:

Afschineh Latifi
Tucker & Latifi, LLP
160 East 84th Street
New York, New York 10028
Email: alatifi@tuckerlatifi.com

Dated: September 1, 2010 By: /Frederick K. Taylor/
Frederick K. Taylor

EXHIBIT 1

FILED IN CLERK'S OFFICE
U.S.D.C. Atlanta
AUG 1 6 2010
JAMES N. HATTEN, CLERK
By: Deputy Clerk

United States Court of Appeals

For the Eleventh Circuit

No. 09-15123

District Court Docket No.
08-00975-CV-TWT-1

FILED
U.S. COURT OF APPEALS
ELEVENTH CIRCUIT
Jul 15, 2010
JOHN LEY
CLERK

DAN TANA,

Plaintiff-Appellant,

versus

DANTANNA'S,
an unknown business entity,
GREAT CONCEPTS, L.L.C.,
a Georgia Limited Liability Company,
DANTANNA'S CNN CENTER, LLC,
a Georgia limited liability company,

Defendants-Appellees.

A True Copy - Attested
Clerk U.S. Court of Appeals,
Eleventh Circuit
By: Deputy Clerk
Atlanta, Georgia

Appeal from the United States District Court
for the Northern District of Georgia

JUDGMENT

It is hereby ordered, adjudged, and decreed that the attached opinion included herein by reference, is entered as the judgment of this Court.

Entered: July 15, 2010
For the Court: John Ley, Clerk
By: Patch, Jeffrey

ISSUED AS MANDATE
AUG 1 3 2010
U.S. COURT OF APPEALS
ATLANTA GA

[PUBLISH]

IN THE UNITED STATES COURT OF APPEALS

FOR THE ELEVENTH CIRCUIT

No. 09-15123

D. C. Docket No. 08-00975-CV-TWT-1

FILED
U.S. COURT OF APPEALS
ELEVENTH CIRCUIT
JULY 15, 2010
JOHN LEY
CLERK

DAN TANA,

Plaintiff-Appellant,

versus

DANTANNA'S,
an unknown business entity,
GREAT CONCEPTS, L.L.C.,
a Georgia Limited Liability Company,
DANTANNA'S CNN CENTER, LLC,
a Georgia limited liability company,

Defendants-Appellees.

Appeal from the United States District Court
for the Northern District of Georgia

(July 15, 2010)

Before EDMONDSON, CARNES and ANDERSON, Circuit Judges.

ANDERSON, Circuit Judge:

This trademark infringement action concerns two restaurants, situated on opposite sides of the country, that share very similar names. Dan Tana, owner of Dan Tana's restaurant in Hollywood, California ("Plaintiff"), brought this action against the two limited liability companies that own and operate the Dantanna's restaurants in Atlanta, Georgia—Great Concepts, L.L.C., and Dantanna's CNN Center, LLC ("Defendants"). Plaintiff's complaint alleges that David Clapp, founder of the Dantanna's restaurants and managing member of the Defendants, intentionally selected and registered as a federal trademark a name for his restaurants that is confusingly similar to the name of Plaintiff's restaurant in Hollywood. The claims forming the basis of Plaintiff's complaint are false designation of origin, a theory of federal trademark infringement arising under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (Count I); deceptive trade practices under Georgia's Uniform Deceptive Trade Practices Act, O.C.G.A. § 10-1-370 et seq. (Count II); fraud pursuant to O.C.G.A. § 23-2-55 (Count III); and the unauthorized appropriation of likeness, an invasion-of-privacy tort recognized under Georgia law (Count IV).[1]

The district court granted summary judgment in favor of Defendants on all

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[1] Plaintiff's complaint also included, and the district court also rejected, a state-law claim for unjust enrichment (Count V), which Plaintiff chose not to appeal in this action.

counts. Plaintiff now appeals, arguing that triable issues of fact remain as to whether there is a likelihood of confusion between the two restaurants and whether Defendants intentionally appropriated the name of his restaurant. Because we conclude that Plaintiff has not adduced sufficient evidence giving rise to a genuine issue of material fact on the issue of likelihood of confusion or Defendants' knowing appropriation of his likeness, we affirm the district court's grant of summary judgment in favor of Defendants.

I. FACTS AND PROCEDURAL HISTORY

Plaintiff Dan Tana is a self-described former Yugoslav soccer star, prominent restaurateur, film producer, and actor. He opened his Italian-themed restaurant, Dan Tana's, in West Hollywood, California, in 1964. Since that time, the restaurant has enjoyed a storied history, attracting Hollywood celebrities and insiders to the restaurant's intimate and romantic setting. Dan Tana's serves traditional Italian fare, and it resembles an old-world Italian trattoria with red-and-white checkered table cloths and straw-colored wine flasks hanging from the ceiling. Plaintiff, who has been the sole owner of the restaurant since its inception, figures prominently into its ambiance, personally greeting and welcoming his patrons. The Press has referred to Dan Tana's as a "legendary Hollywood hotspot" and the ultimate "LA hangout," and the restaurant has been featured in numerous

newspapers, magazines, and books. The name "Dan Tanna" received significant publicity in the 1970s when producer Aaron Spelling asked Plaintiff for the use of his name for the lead character in his television series "Vega$."

Despite the notoriety of Plaintiff's restaurant, Plaintiff did not attempt to register the name "Dan Tana's" with the Patent and Trademark Office ("PTO") until June 2005, forty-one years after his restaurant's opening. The PTO denied his application in December 2005 on the basis of the existing registration of the trademark "Dantanna's" in the same category of restaurant services sought by Plaintiff. Defendants had opened the first of two Dantanna's locations in Atlanta in 2003, applied for a federal registration in June 2003, and obtained federal registration of the name "Dantanna's" in March 2005, claiming a date of first use of September 30, 2003.[2]

The Dantanna's restaurants are upscale sports restaurants serving contemporary American cuisine with a "surf and turf" theme. The restaurants' large open floor plans boast big screen televisions tuned to sports channels on surrounding walls. According to its website, Dantanna's specializes in providing a sophisticated and elegant venue for the viewing of sporting events and strives to

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[2] At the time Plaintiff filed this lawsuit, Defendants operated only one location of Dantanna's in Atlanta's Buckhead neighborhood. They have since expanded to a second location in downtown Atlanta.

emulate the feeling of sitting in a "private box at your favorite game."

In June 2006, Plaintiff filed a Petition for Cancellation of Defendants' mark with the PTO's Trademark Trial and Appeal Board, alleging that Defendants sought to mislead the public into believing their restaurant was associated with Dan Tana's Hollywood. Subsequently, Plaintiff filed a federal trademark infringement suit in United States District Court for the Central District of California, which was ultimately dismissed for lack of personal jurisdiction over one of the Defendants. After Plaintiff filed his federal lawsuit, he moved to suspend the trademark cancellation proceeding pending before the PTO. The PTO stayed the proceeding in September 2007.

Plaintiff then filed this lawsuit in the Northern District of Georgia in March 2008, pleading the federal and Georgia trademark infringement, fraud, and tort claims at issue in this appeal. Plaintiff's complaint seeks a permanent injunction enjoining Defendants from all future use of the "Dantanna's" mark and the cancellation of Defendants' federal trademark registration, among other relief. Defendants moved for summary judgment arguing that, as a matter of law, Plaintiff could not establish the likelihood of confusion necessary to subject them to liability under § 43(a) of the Lanham Act, Georgia's Uniform Deceptive Trade Practices Act, or fraud under Georgia law, nor could Plaintiff establish the intentional

appropriation of likeness required to impose liability under Georgia tort law. The district court agreed, granting summary judgment in favor of Defendants as to all counts. This appeal ensued.

II. DISCUSSION

We review the grant of summary judgment de novo, applying the same legal standards as the district court. Harrison v. Benchmark Elecs. Huntsville, Inc., 593 F.3d 1206, 1211 (11th Cir. 2010). In so doing, we view all evidence and draw all reasonable inferences in favor of the non-moving party. Id. Summary judgment is proper where "the pleadings, the discovery and disclosure materials on file, and any affidavits show that there is no genuine issue as to any material fact and that the movant is entitled to summary judgment as a matter of law." Fed. R. Civ. P. 56(c).

Plaintiff appeals the district court's disposition of four counts of his federal complaint: (1) false designation of origin under § 43(a) of the Lanham Act, (2) deceptive trade practices under Georgia's Uniform Deceptive Trade Practices Act, (3) fraud under O.C.G.A. § 23-2-55, and (4) appropriation of likeness under Georgia tort law. However, we need not separately address whether Defendants were entitled to summary judgment on Plaintiff's deceptive trade practices or fraud claims. The district court held that the Georgia Uniform Deceptive Trade Practices Act and § 23-2-55 require a plaintiff to prove the same elements as a claim for

federal trademark infringement under the Lanham Act. Because this is a question of state law that the parties do not challenge on appeal, we treat the district court's holding as correct and merely determine whether the district court properly decided the Lanham Act count. See Jellibeans, Inc. v. Skating Clubs of Ga., Inc., 716 F.2d 833, 839 (11th Cir. 1983). "If we determine that the district court decided the Lanham Act count properly, we will also affirm its decision on the Georgia deceptive trade practices [and fraud] counts." Id. Thus, we first address Plaintiff's Lanham Act claim and then consider his Georgia appropriation-of-likeness claim.

A. Trademark Infringement under § 43(a) of the Lanham Act

Trademarks are "any word, name, symbol, or device, or any combination thereof [used] to identify and distinguish [one's] goods . . . from those manufactured or sold by others and to indicate the source of the goods." 15 U.S.C. § 1127.[3] Section 43(a) of the Lanham Act creates a federal cause of action for

[3] The parties consistently refer to this case as involving registered and common law "trademarks" throughout their appellate briefs, but, because both parties use their marks in association with services in addition to goods bearing the restaurants' names, their marks are also properly characterized as "service marks." 15 U.S.C. § 1127 (Service marks are "any word, name, symbol, or device, or any combination thereof [used] . . . to identify and distinguish the services of one person . . . from the services of others and to indicate the source of the services . . . ."). The analysis is the same for service mark and trademark infringement. Frehling Enters., Inc. v. Int'l Select Group, Inc., 192 F.3d 1330, 1334 n.1 (11th Cir. 1999) ("The infringement analysis is the same under both standards and courts thus treat the two terms as interchangeable in adjudicating infringement claims."). For simplicity and consistency, however, we will continue to refer to this action as one for trademark, as opposed to service mark and trademark, infringement.

unfair competition by prohibiting the use in interstate commerce of any "word, term, name, symbol or device, . . . or any false designation of origin . . . which is likely to cause confusion . . . as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 15 U.S.C. § 1125(a).[4] To establish a prima facie case of trademark infringement under § 43(a), a plaintiff must show "(1) that it had trademark rights in the mark or name at issue and (2) that the other party had adopted a mark or name that was the same, or confusingly similar to its mark, such that consumers were likely to confuse the two." Lone Star Steakhouse & Saloon, Inc. v. Longhorn Steaks, Inc., 106 F.3d 355, 358 (11th Cir. 1997).[5] Plaintiff's allegation under the Lanham Act is that "Dan Tana's" is a trade

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[4] Section 43(a) of the Lanham Act provides:

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
>
> (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

[5] In its summary judgment order, the district court erroneously stated that Plaintiff brought this action under § 32(a) of the Lanham Act, 15 U.S.C. § 1114(1), rather than § 43(a), 15

name in which he has common-law trademark rights and that Defendants are unlawfully infringing on those rights by using and registering the name "Dantanna's" in connection with the operation of their Atlanta restaurants.

To satisfy the first element of § 43(a)—proof of a valid trademark—a plaintiff need not have a registered mark. We have recognized that "the use of another's unregistered, i.e., common law, trademark can constitute a violation of § 43(a) where the alleged unregistered trademarks used by the plaintiff are so associated with its goods that the use of the same or similar marks by another company constitutes a false representation that its goods came from the same source." Conagra, Inc. v. Singleton, 743 F.2d 1508, 1512–13 (11th Cir. 1984) (internal quotations and citations omitted). However, only those marks that are capable of distinguishing the owner's goods from those of others, i.e., that are sufficiently "distinctive," are eligible for federal registration or protection as

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U.S.C. § 1125(a). Section 32(a) creates a cause of action for the infringement of a registered mark, whereas § 43(a) protects qualifying unregistered trademarks. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S. Ct. 2753, 2757 (1992). This error is irrelevant, however, because the district court based its grant of summary judgment on the likelihood-of-confusion prong of § 32(a), which requires the consideration of the same seven factors as § 43(a)'s likelihood-of-confusion test, and therefore applied the correct legal analysis to Plaintiff's infringement claim. See Ross Bicycles, Inc. v. Cycles USA, Inc., 765 F.2d 1502, 1503–04 (11th Cir. 1985) ("The factors relevant to establishing [a likelihood of confusion with respect to false designation of origin under 15 U.S.C. § 1125(a)] are identical to the factors relevant to establishing a likelihood of confusion with respect to trademark infringement under 15 U.S.C. § 1114." (citation omitted)).

common law marks under the Lanham Act. 15 U.S.C. § 1052(e), (f); Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768, 112 S. Ct. 2753, 2757 (1992); Coach House Rest., Inc. v. Coach & Six Rests., Inc. 934 F.2d 1551, 1559 (11th Cir. 1991).

Our circuit recognizes four categories of distinctiveness, listed in ascending order of strength: "(1) generic—marks that suggest the basic nature of the product or service; (2) descriptive—marks that identify the characteristic or quality of a product or service; (3) suggestive—marks that suggest characteristics of the product or service and require an effort of the imagination by the consumer in order to be understood as descriptive; and (4) arbitrary or fanciful—marks that bear no relationship to the product or service, and the strongest category of trademarks." Gift of Learning Found., Inc. v. TGC, Inc., 329 F.3d 792, 797–98 (11th Cir. 2003). Suggestive and arbitrary or fanciful marks are deemed "inherently distinctive" because "their intrinsic nature serves to identify a particular source of a product" and are generally entitled to trademark protection. Two Pesos, 505 U.S. at 768, 112 S. Ct. at 2757. Generic marks, on the other hand, are generally incapable of receiving trademark protection and may never be registered as trademarks under the Lanham Act. Welding Servs., Inc. v. Forman, 509 F.3d 1351, 1358 (11th Cir. 2007); Coach House Rest., 934 F.2d at 1560. Descriptive marks, though not inherently distinctive, may become sufficiently distinctive to enjoy trademark

protection by acquiring "secondary meaning." 15 U.S.C. § 1052(f); Coach House Rest., 934 F.2d at 1560. "A name has acquired secondary meaning when the primary significance of the term in the minds of the consuming public is not the product but the producer." Welding Servs., 509 F.3d at 1358 (internal quotation and citation omitted).

"Names—both surnames and first names—are regarded as descriptive terms and therefore one who claims federal trademark rights in a name must prove that the name has acquired a secondary meaning." Perini Corp. v. Perini Constr., Inc., 915 F.2d 121, 125 (4th Cir. 1990); 815 Tonawanda St. Corp. v. Fay's Drug Co., Inc., 842 F.2d 643, 648 (2d Cir. 1988) (same); see also 15 U.S.C. § 1052(e) (providing that if a mark is "primarily merely a surname" the PTO may deny it federal registration); Conagra, 743 F.2d at 1513 (requiring a showing of secondary meaning for a surname to give rise to enforceable trademark rights). However, Defendants presumed the validity of Plaintiff's mark in their summary judgment motion below and only contested the second element of Plaintiff's trademark infringement claim—the likelihood of confusion between the two marks. The district court disposed of Plaintiff's suit solely on this ground, never reaching the issue of trademark validity. Therefore, we also proceed on the assumption that Plaintiff holds valid common-law trademark rights in the name "Dan Tana's" and

turn to the second element of Plaintiff's Lanham Act claim, the likelihood of confusion.[6]

i. Likelihood of Confusion

In evaluating whether there is a likelihood of confusion between two marks, our court applies a multifactor test, evaluating the following seven factors: (1) strength of the mark alleged to have been infringed; (2) similarity of the infringed and infringing marks; (3) similarity between the goods and services offered under the two marks; (4) similarity of the actual sales methods used by the holders of the marks, such as their sales outlets and customer base; (5) similarity of advertising methods; (6) intent of the alleged infringer to misappropriate the proprietor's good will; and (7) the existence and extent of actual confusion in the consuming public. Welding Servs., 509 F.3d at 1360. On appeal, Plaintiff argues that there is a material issue of fact on the likelihood of confusion between his and Defendants' mark, precluding summary judgment, and that the district court erred in considering the geographical proximity of the parties' use of their marks as an additional

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[6] Nonetheless, we revisit the issue of secondary meaning in evaluating the first factor in our circuit's likelihood-of-confusion test because secondary meaning is relevant to both elements of a Lanham Act claim. Whether a mark is generic, descriptive, suggestive, or arbitrary also plays into its strength, which is the first factor of our likelihood-of-confusion inquiry. See Welding Servs., 509 F.3d at 1360; J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:82 (4th ed. 2010) (explaining that secondary meaning is an issue of validity for noninherently distinctive marks and also an issue of strength/distinctiveness in the likelihood-of-confusion analysis for any kind of mark).

relevant factor in its likelihood-of-confusion analysis. Plaintiff cannot prevail on either argument.[7]

We agree with the district court that the only factors that could plausibly support a finding of a likelihood of confusion are the similarity of the marks (factor two) and the undisputed similarity of the parties' sales methods (factor four). Plaintiff's and Defendants' marks share an identical spelling but for a single letter and the use of a space, an identical use of the possessive, and an identical

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[7] We also summarily dismiss Plaintiff's argument that the district court misapplied Rule 56(c)'s summary judgment standard by improperly weighing the evidence, as evidenced by the court's statements that certain likelihood-of-confusion factors "weighed" in favor of Plaintiff or "weighed" in favor of Defendants. See Latimer v. Roaring Toyz, Inc., 601 F.3d 1224, 1237 (11th Cir. 2010) (In reviewing motions for summary judgment, "[n]either we nor the district court are to undertake credibility determinations or weigh the evidence."). Although likelihood of confusion is a question of fact, it may be decided as a matter of law. Welding Servs., 509 F.3d at 1361; Alliance Metals, Inc. v. Hinely Indus., Inc., 222 F.3d 895, 907 (11th Cir. 2000). And our circuit has routinely "weighed" the likelihood-of-confusion factors on summary judgment. See, e.g., Welding Servs., 509 F.3d at 1361 (explaining that "[o]verwhelming visual dissimilarity can defeat an infringement claim, even where the other six factors all weigh in favor of the plaintiff" and concluding that "[t]he next three factors weigh in favor of Welding Services" (emphasis added)); Dippin' Dots, Inc. v. Frosty Bites Distrib., LLC, 369 F.3d 1197, 1208 & n.12 (11th Cir. 2004) (holding that no reasonable jury could find that the two logos are confusingly similar because although "the second factor weighs in favor of FBD," "the remaining six factors all weigh in favor of DDI," and "the lack of visual similarity between the two designs is overwhelming" (emphasis added)).

Plaintiff points to no instance in which the district court improperly weighed conflicting evidence in assessing the likelihood of confusion between the parties' marks. Rather, it appears that Plaintiff is arguing that if any one factor suggests that there could be a likelihood of confusion, summary judgment is improper. This is not the law. The likelihood-of-confusion multifactor test presupposes that various factors will point in opposing directions. The role of the court in reviewing a motion for summary judgment is to determine the ultimate question of whether, in light of the evidence as a whole, there is sufficient proof of a likelihood of confusion to warrant a trial of the issue. See Welding Servs., 509 F.3d at 1361.

pronunciation, and both parties sell food prepared and served in retail restaurant establishments.[8] However, both of these factors merely suggest a threshold potential for confusion and are thus entitled to little weight. An analysis of the remaining factors demonstrates no real likelihood of confusion in the consuming public.

With respect to the strength of Plaintiff's mark (factor one), we conclude that "Dan Tana's" is a relatively weak mark for restaurant services outside of the Los Angeles area. The weaker the mark, the less likelihood of confusion. Welding Servs., 509 F.3d at 1361. As discussed above, determining the strength of a mark requires a consideration of the mark's inherent distinctiveness. If the mark is merely descriptive, such as a personal or surname, its strength depends on whether it has acquired secondary meaning. See Perini Corp., 915 F.2d at 125; 815 Tonawanda St. Corp., 842 F.2d at 648; Conagra, 743 F.2d at 1513. A descriptive mark with secondary meaning is a relatively strong mark. Dieter v. B & H Indus. of Sw. Fla., Inc., 880 F.2d 322, 329 (11th Cir. 1989).

As a preliminary matter, we do not find persuasive Plaintiff's argument that

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[8] Despite Defendants' concession of the similarity of the parties' marks before the district court, they now contest this factor on appeal, arguing that "there are differences in spelling, syllabus, and pronunciation." This position is inconsistent with that taken by Defendants below, and we decline to entertain it. In any event, any such differences are negligible.

because his mark is derived from his full name, as opposed to his personal or surname, it is an inherently distinctive and, therefore, strong mark. The policy reasons for requiring secondary meaning for the use of a personal or surname as a mark extend equally to the use of full names. See Peaceable Planet, Inc. v. Ty, Inc., 362 F.3d 986, 989–90 (7th Cir. 2004) (identifying the particular reasons for considering names merely descriptive marks: (1) "a reluctance to forbid a person to use his own name in his own business"; (2) a recognition that "some names are so common . . . that consumers will not assume that two products having the same name therefore have the same source"; and (3) the concern that "preventing a person from using his name to denote his business may deprive consumers of useful information"). Although some full names are indeed unique, the majority are shared by numerous individuals across diverse communities and markets. We decline to create a blanket rule distinguishing full names from personal and surnames with respect to the secondary-meaning requirement.

Thus, "Dan Tana's" is merely a descriptive mark, the strength of which is dependent upon the showing of secondary meaning. We consider four factors in assessing secondary meaning: (1) "the length and nature of the name's use," (2) "the nature and extent of advertising and promotion of the name," (3) "the efforts of the proprietor to promote a conscious connection between the name and the

business," and (4) "the degree of actual recognition by the public that the name designates the proprietor's product or service." Welding Servs., 509 F.3d at 1358. In light of Plaintiff's continuous use of his mark in the same West Hollywood neighborhood for over four decades, as well as the record evidence of the significant press coverage he receives in Los Angeles publications, it is likely that Dan Tana's has obtained secondary meaning in Los Angeles. However, Dan Tana alleges a likelihood of confusion between his restaurant and an establishment thousands of miles away. Therefore, the relevant inquiry is whether Plaintiff's mark is strong enough outside of Los Angeles to give rise to a likelihood of confusion among consumers of Dantanna's restaurant services in Atlanta. See Brennan's, Inc. v. Brennan's Rest., L.L.C., 360 F.3d 125, 132 (2d Cir. 2004) ("[T]o achieve the status of a strong mark, plaintiff must demonstrate distinctiveness in the relevant market . . . . In this case, the relevant market is the pool of actual and potential customers of Terrance Brennan's, for it is those patrons whose potential confusion is at issue."). The record fails to establish such widespread secondary meaning.

Plaintiff does not advertise nationally or in the Atlanta area specifically, though he has enjoyed free advertising from articles in national publications such as the New York Times, Forbes Traveler, and USA Today. Although these articles

suggest some notoriety among food critics and travel writers of nationwide publications, they do not constitute record evidence of any effort by Plaintiff to "create a conscious connection" in the nationwide public's mind between the name Dan Tana's and his restaurant. See Welding Servs., 509 F.3d at 1358; see also Brennan's, 360 F.3d at 132 (Articles and reviews discussing Brennan's New Orleans in the context of the City of New Orleans or a trip to New Orleans "in no way demonstrate that potential diners in New York City who find the word Brennan's on a restaurant awning will have any reason to think the restaurant is connected with Brennan's New Orleans, or even will have heard of Brennan's New Orleans."). Even the use of the name "Dan Tanna" in the television series "Vega$," which aired for a few years in the late 1970s and early 1980s, suggests nothing more than that the name "Dan Tana's" may have a familiar ring to a discrete group of television enthusiasts who viewed the program twenty to thirty years ago, not that present-day patrons of Dantanna's Atlanta would specifically associate the name with Plaintiff's restaurant.

Moreover, the two affidavits submitted by Plaintiff as evidence of the national notoriety of his restaurant—one authored by Plaintiff himself and the other authored by his attorney—make only generalized self-serving statements as to Plaintiff's reputation and add no material evidence to the record that is relevant to

the secondary-meaning inquiry. Cf. Conagra, 743 F.2d at 1513–14 (holding plaintiff had established secondary meaning in its mark because it had "prominently displayed the Singleton name on virtually all of its seafood products for over 25 years," distributed promotional films widely, expended over $400,000 annually in worldwide markets on its promotion, and included market surveys in the record strongly identifying the company name with its products). In sum, Plaintiff has failed to establish widespread secondary meaning of the name "Dan Tana's" sufficient to demonstrate that he holds a strong mark in restaurant services so as to cause a likelihood of confusion among consumers in Atlanta.[9] In light of the weakness of Plaintiff's mark in the context of this infringement suit (factor one), the conceded similarity between the two marks (factor two) adds little weight to Plaintiff's effort to show likelihood of confusion.

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[9] We also dismiss Plaintiff's attempt to circumvent the relevance of secondary meaning by arguing that his complaint alleges both trademark infringement and false endorsement, and that no secondary meaning is required to establish trademark rights in false endorsement cases. In support of this argument, Plaintiff relies on a Ninth Circuit case, Downing v. Abercrombie & Fitch, 265 F.3d 994 (9th Cir. 2001), which sets forth a distinct set of factors for evaluating "celebrity cases" of false endorsement in that circuit. Not only has our circuit never endorsed the Ninth Circuit's Downing factors, but we have also never recognized a separate claim of false endorsement, distinct from trademark infringement under § 43(a) and exempt from our secondary-meaning inquiry. Moreover, a reading of Downing reveals that secondary meaning is indeed relevant to the Ninth Circuit's likelihood-of-confusion inquiry in celebrity cases. See id. at 1007 (listing as the first likelihood-of-confusion factor "the level of recognition that the plaintiff has among the segment of the society for whom the defendant's product is intended"). In any event, in light of Plaintiff's complaint, which alleges only one Lanham Act count—a classic claim of false designation of origin under § 43(a)—this argument has no basis in the pleadings.

A comparison of the goods and services offered under the parties' marks (factor three) reveals overwhelming evidence that consumers would be unlikely to confuse the two restaurants. The goods and services provided in the parties' restaurants are strikingly dissimilar, and the record belies Plaintiff's assertion that Dantanna's in Atlanta provides "nearly identical" cuisine and ambiance to his Hollywood restaurant. In fact, the only apparent commonality between the two restaurants is that they are both fine-dining establishments serving meat and fish. Dan Tana's is an old-world-style Italian restaurant where mustached waiters dressed in tuxedos serve classic Italian dishes off a menu embellished with Italian language. The ambiance is cozy, intimate, romantic, low-lit, and the restaurant caters to Hollywood's elite and to celebrities seeking a safe haven from paparazzi. In stark contrast, Dantanna's in Atlanta is an upscale sports restaurant, targeting sports enthusiasts and serving contemporary American cuisine in a modern setting decorated with flat-screen televisions. Cf. Coach House Rest., 934 F.2d at 1562 (finding that "the registrant's restaurant was modeled to emulate the same ambiance and provide the same cuisine" as plaintiff's restaurant, which contributed to the court's finding of a material issue of fact on the likelihood of confusion between the two marks).

The stark differences between the parties' restaurants, described in the

preceding paragraph, also demonstrate that their customers are dissimilar, which is an aspect of the similarity of the parties' actual sales methods (factor four). The district court accepted Defendants' concession that the two parties have identical sales outlets (the other consideration in evaluating the similarity of sales methods), in that they both serve food in retail restaurant establishments, but did not compare the restaurants' customer base. Thus, viewing factor four in its entirety, it adds little weight to the possibility of a likelihood of confusion.

Additionally, Plaintiff and Defendants do not engage in similar methods of advertising (factor five). Plaintiff admittedly relies solely on free publicity to advertise his restaurant, aside from maintaining a website. Defendants, by contrast, both maintain a website and purchase advertising at sporting events and in various local and national publications. Thus, the only similarity in the advertising channels used by the two parties is their maintenance of websites on the World Wide Web. This similarity would dispel rather than cause confusion, however, because the websites are separate and distinct, suggesting two completely unrelated business entities.

There is also scant evidence of any intention of Defendants to misappropriate Plaintiff's mark (factor six). Plaintiff asserts, in a rather conclusory fashion, that Defendants knew of the Dan Tana's restaurant prior to adopting the name

"Dantanna's" for their own because Clapp previously lived in Los Angeles and worked in the restaurant business there. Although this fact gives rise to an inference that Clapp could have encountered the Dan Tana's restaurant during his time in California, it does not contradict Defendants' evidence of an independent and innocent origin of the Dantanna's mark: that the name "Dantanna's" was derived from the names of Clapp's two children, Daniel and Anna by shortening Daniel to "Dan" and connecting the two names with a "+" sign, which was eventually converted into a "t." Moreover, Clapp testified in his deposition that he did not learn of Plaintiff's restaurant until sometime in 2003, after he had already selected the name of his restaurant and begun the trademark registration process. Aside from Plaintiff's bald assertion that Clapp fabricated this story, the affidavit and his testimony remain uncontroverted by any material evidence. In fact, Plaintiff testified in his deposition before the PTO that he had no reason to believe that Clapp's story was not true. Where a story of the creation of a mark is undisputed and shows an innocent origin, we have concluded that there is no intent of misappropriation contributing to a likelihood of confusion. See Welding Servs., 509 F.3d at 1361.

Additionally, and perhaps most significantly, Plaintiff is unable to identify any credible motive for Defendants to trade on the name of his restaurant in

Atlanta. There is no evidence of any secondary meaning associated with Plaintiff's mark in the Atlanta area; there is no competition between the two restaurants; and the restaurants fulfill entirely different niches in the food services market. Finally, a factfinder is less likely to find intentional infringement where a defendant uses his own name in creating his mark. See Conagra, 743 F.2d at 1515 n.9. Although the record indicates that Clapp used his children's as opposed to his own name for his restaurant, the source of the name is personal and familial and further support for our conclusion that no reasonable jury could find intentional infringement on these facts.

The last factor, actual confusion in the consuming public, is the most persuasive evidence in assessing likelihood of confusion. Alliance Metals, Inc. v. Hinely Indus., Inc., 222 F.3d 895, 907 (11th Cir. 2000). Again, Plaintiff's evidence is nominal. In fact, the only evidence adduced by Plaintiff as to actual confusion was an affidavit by Kenneth McGuire, a Los Angeles resident and patron of Dan Tana's Hollywood, who claimed that he chose to patronize Dantanna's on a visit to Atlanta because of the similarity of the two restaurants' names, which led him to believe they had an affiliation. McGuire attested that upon entry he was struck by "the signage and the decor in the Atlanta's Dantanna's," which "was so close to the decor as the Dan Tana's in Hollywood" that it strengthened his belief of the

restaurants' association. The district court concluded that the McGuire affidavit was simply not credible in light of the record evidence of the striking dissimilarities between the restaurants' interiors, menus, and ambiance and was therefore entitled to little weight. See 10A Charles Alan Wright, Arthur R. Miller, & Mary Kay Kane, Federal Practice and Procedure § 2727 (3d ed. 2008) (Under Federal Rule of Civil Procedure 56, "the court may disregard an offer of evidence that is too incredible to be believed."). Even if we declined to completely disregard the affidavit, this evidence of actual confusion is so minimal as to be practically insignificant.

The only other evidence of actual confusion is Defendants' admission that there have been two incidents in which customers have inquired as to the restaurants' possible affiliation with Dan Tana's Hollywood since Dantanna's opened in 2003. This evidence of actual confusion is also weak; in considering actual confusion we look not only to the existence but also to the extent of such confusion. Welding Servs., 509 F.3d at 1360. Dantanna's has served over one million customers in the five years between its opening and the filing of this lawsuit; no reasonable jury would conclude that an inquiry by only two customers of a possible connection between the restaurants demonstrates actual confusion in the consuming public. Our cases finding relevant actual confusion have concerned

much more significant evidence. Cf. Alliance Metals, 222 F.3d at 908 (finding "ample undisputed evidence" of actual confusion where plaintiff attached copies of more than a dozen checks plaintiff received from customers for goods bought from defendants and seven invoices from vendors billing plaintiff under a confusing combination of plaintiff's and defendant's names); Conagra, 743 F.2d at 1515 (finding relevant actual confusion where the evidence demonstrated "numerous" instances where people assumed an affiliation between the parties' businesses, including inquiries by distributors to plaintiff about services provided by defendant).

ii. The Relevance of Geographic Proximity of Use

We also reject Plaintiff's argument that the district court erred as a matter of law in considering the geographic proximity of the use of the parties' marks. Our circuit has recognized that "new factors may merit consideration" in determining whether there is a likelihood of confusion. Swatch Watch, S.A. v. Taxor, Inc., 785 F.2d 956, 958 (11th Cir. 1986). And our case law already establishes that geographic considerations may be relevant to the likelihood-of-confusion analysis, even where we have not articulated this consideration as a separate factor. See, e.g., St. Luke's Cataract & Laser Inst., P.A. v. Sanderson, 573 F.3d 1186, 1209 (11th Cir. 2009) (considering the fact that the two companies worked in "the same

geographical market" in holding that there was a clear likelihood of confusion of the parties' service marks to sustain the jury verdict); Alliance Metals, 222 F.3d at 908 (considering the undisputed evidence that both companies distributed prefinished aluminum sheets and sign blanks in the "same territory" in concluding that there was a likelihood of confusion).

We have already discussed the relevance of geography in our evaluation of the strength of Plaintiff's mark under the first factor of our existing seven-factor likelihood-of-confusion test. Where the secondary meaning acquired by a descriptive mark dictates its strength and distinctiveness, as here, the geographic remoteness of a mark's use may be relevant to the likelihood-of-confusion inquiry. Because Plaintiff seeks to establish a likelihood of confusion with a restaurant in Atlanta, the geographically remote use of his mark in West Hollywood weighs against a finding of nationwide secondary meaning, leaving him with only a weak mark unlikely to cause a likelihood of confusion in Atlanta.

Geographic considerations are also particularly relevant where a plaintiff holds only common-law trademark rights in a mark because it is well-established that the scope of protection accorded his mark is coextensive only with the territory throughout which it is known and from which it has drawn its trade. Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 416, 36 S. Ct. 357, 361 (1916), superseded

by statute in irrelevant part as stated in Park 'N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 105 S. Ct. 658 (1985). The owner of a registered mark, in contrast, enjoys the unlimited right to use the mark nationwide, and federal registration affords the registrant priority over all future users of confusingly similar marks. 15 U.S.C. § 1057(c); Coach House Rest., 934 F.2d at 1564. Therefore, a Lanham Act plaintiff asserting common-law trademark rights under § 43(a) against the owner of a registered mark, as here, bears the burden of establishing the right to use its mark by actual use in a given territory. Emergency One, Inc. v. Am. Fire Eagle Engine Co., 332 F.3d 264, 269 (4th Cir. 2003). And because registration constitutes constructive nationwide notice of the registrant's priority of use of a mark, 15 U.S.C. § 1072, only actual use occurring prior to such registration gives rise to enforceable common-law trademark rights, 15 U.S.C. § 1065. Thus, federal registration has the practical effect of freezing a prior user's enforceable trademark rights thereby terminating any right to future expansion beyond the user's existing territory. Allard Enters., Inc. v. Advanced Programming Res., Inc., 249 F.3d 564, 572 (6th Cir. 2001) ("In the case in which a junior user applies for registration, . . . the extent of the senior user/non-registrant's territory is frozen as of the date of

actual registration to the junior user.").[10]

Accordingly, because Plaintiff continued to operate only a single location of Dan Tana's at the time Defendants registered their mark, his trademark rights in the "Dan Tana's" name are limited to the Los Angeles market. Furthermore, the record also establishes that Defendants currently operate restaurants only in the Atlanta area and that the mark of neither party is known by the customers in the other's market. Thus, at present, the parties' restaurants coexist in remote markets, geographically and otherwise. On such a record, geographic considerations are indeed relevant and demonstrate a smaller likelihood of confusion. See Coach House Rest., 934 F.2d at 1564–65 (explaining that in an action for trademark

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[10] See also Peaches Ent. Corp. v. Ent. Repertoire Assocs., Inc., 62 F.3d 690, 693 (5th Cir. 1995); Thrifty Rent-A-Car Sys., Inc. v. Thrift Cars, Inc., 831 F.2d 1177, 1181 (1st Cir. 1987) (applying the same principle to the related context in which the senior user obtains registration and yet the junior user established market penetration in a discrete area prior to such registration). For this reason, it is irrelevant to our likelihood-of-confusion analysis that Plaintiff testified in this lawsuit (and after Defendants' registration) about an intent to expand his restaurant into other markets in other parts of the country. Moreover, even if Defendants did not enjoy the benefit of a federal registration, the record contains no evidence demonstrating that Atlanta, Georgia, would be considered within Plaintiff's "zone of natural expansion." See Tally-Ho, Inc. v. Coast Cmty. Coll. Dist., 889 F.2d 1018, 1027–28 (11th Cir. 1989) (explaining the common-law expansion doctrine, which provides a senior user with "some limited 'breathing space' in which to expand beyond its current actual use" based on the nature of the senior user's use at the time of the junior user's first use). A senior user that has constantly expanded its business prior to the junior user's adoption of the mark may be entitled to exclusive rights in a zone of natural expansion, even if that zone ousts a junior user from its current territory. Id. (citing J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 26:8 (2d ed. 1984)). However, where a "senior user is static, and has restricted use to only one small area, such as one city, a good-faith junior user may expand into a nationwide use of the mark, subject only to an exception in the small area occupied by the senior user." Id. at 1028 (citing McCarthy, supra, at § 26:8).

infringement, as opposed to a cancellation proceeding, brought by a prior user of an unregistered mark, there is no presumption that the mark is being used nationwide, and therefore where the two parties "operate in discrete, remote areas, there is a smaller likelihood that there will be confusion"); Brennan's, 360 F.3d at 134 ("In the restaurant industry, especially where individual restaurants rather than chains are competing, physical separation seems particularly significant to the inquiry into consumer confusion."). We therefore hold that the geographic remoteness of the parties' restaurants is particularly relevant to our likelihood-of-confusion analysis where a plaintiff bases a trademark infringement claim on common-law trademark rights. The district court did not err in considering the geographic proximity of use as an eighth factor demonstrating the unlikelihood of confusion.[11]

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[11] We decline to consider Plaintiff's argument that the underlying action is a cancellation proceeding rather than a trademark infringement action, so as to make geographic proximity of use irrelevant to the likelihood-of-confusion inquiry. See Coach House Rest., 934 F.2d at 1564 (explaining that where a prior user seeks to cancel a registrant's mark, there is a presumption that the registered mark is being used nationwide, i.e., it is already encroaching upon the prior user's market—wherever that may be—and therefore "geographical remoteness is irrelevant to this likelihood of confusion inquiry"). The district court squarely held in its order granting Defendants summary judgment: "This is not . . . a cancellation proceeding." And our review of Plaintiff's brief to the district court persuades us that the district court was warranted in treating this case only as an infringement action. Plaintiff failed to present his case to the district court as a cancellation proceeding; Plaintiff only argued that he was "seeking" to cancel Defendants' mark pursuant to 15 U.S.C. § 1119, not that this prayer for relief transformed his § 43(a) trademark infringement action into a cancellation proceeding.

Notwithstanding the district court's clear characterization of this suit as a trademark infringement action, and resolution thereof as a § 43(a) infringement claim, Plaintiff's briefs on appeal fail to fairly raise this issue for our review, which is a necessary predicate to Plaintiff's invocation of Coach House. "Under our case law, a party seeking to raise a claim or issue on

Viewing the likelihood-of-confusion factors as a whole, there is minimal evidence of a likelihood of confusion between Plaintiff's and Defendants' restaurants aside from the initial similarity of their names and the fact that they both provide restaurant services. The remaining factors all weigh against a likelihood of confusion, some overwhelmingly so. There are stark differences between the two restaurants' cuisine and ambiance. There is virtually no evidence of confusion in advertising channels. No reasonable jury could find that Defendants intended to trade on Plaintiff's mark, and there is negligible evidence of any actual confusion between the two restaurants. Moreover, in light of the vast geographical distance between the two markets currently used by the parties, a

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appeal must plainly and prominently so indicate. Otherwise, the issue . . . will be considered abandoned." United States v. Jernigan, 341 F.3d 1273, 1283 n.8 (11th Cir. 2003).

Plaintiff did not include the issue of the district court's mischaracterization of his suit in his statement of the issues; he does not discuss it in his summary of the argument; and he does not list it in his table of contents. In fact, he failed to even include a table of contents. His standard-of-review section does not list the standard for reviewing questions of law, such as this one. Nowhere in his brief, or in his submissions to the district court, does he even list the elements of a claim for cancellation. Most importantly, Plaintiff failed to argue how his complaint sufficiently alleged such a claim under federal notice pleading standards, failed to elucidate the relationship between a trademark infringement action and a cancellation proceeding, and failed to provide support for the proposition that merely praying for cancellation as a remedy for infringement is sufficient to convert an infringement action into a cancellation action or a dual infringement and cancellation action.

Plaintiff's only argument on appeal with respect to the district court's characterization of his suit as one for trademark infringement, as opposed to cancellation, appears in the context of his discussion of the relevance of geographic proximity of use in a trademark infringement action. Because Plaintiff proceeds throughout his appeal as if this action is one for trademark infringement under § 43(a) of the Lanham Act and has failed to "plainly and prominently" indicate his intent to appeal to our court to correct any mischaracterization of his suit by the district court, we deem this argument abandoned.

likelihood of confusion is highly unlikely. In sum, Plaintiff has failed to adduce sufficient evidence upon which a reasonable jury could find a likelihood of confusion between Plaintiff's and Defendants' marks. Accordingly, we affirm the district court's grant of summary judgment to Defendants on Plaintiff's Lanham Act count.

Because neither party contests the district court's conclusion that the elements to establish deceptive trade practices under Georgia's Uniform Deceptive Trade Practices Act and fraud under O.C.G.A. § 23-2-55 are identical to those required to prevail on Plaintiff's federal infringement claim, we also affirm the district court's grant of summary judgment on these state law claims. See Jellibeans, 716 F.2d at 839.

B. Appropriation of Likeness

We now turn to Plaintiff's second issue on appeal: that the district court erred in granting summary judgment on his appropriation-of-likeness tort claim. To prove an appropriation of likeness under Georgia law, a plaintiff must establish that the defendant invaded his privacy by appropriating, for the defendant's benefit, use or advantage, the plaintiff's name or likeness. Cabaniss v. Hipsley, 151 S.E.2d 496, 500 (Ga. Ct. App. 1966). Plaintiff asserts on appeal that an appropriation of likeness need not be intentional to be an actionable invasion of privacy. This

position is wholly without merit.

An appropriation of likeness without an intent to use the likeness for one's benefit fails to meet the very definition of the tort itself. Furthermore, Georgia case law plainly establishes that summary judgment is proper where a plaintiff fails to show an intentional or knowing appropriation of likeness. Blakey v. Victory Equip. Sales, Inc., 576 S.E.2d 288, 292 (Ga. Ct. App. 2002) (holding that the district court properly awarded summary judgment to defendant on plaintiff's appropriation-of-likeness claim for the sole reason that "[t]here [was] no evidence . . . that defendants ever knowingly took Blakely's identity for their purposes").

As discussed in Part II.A., Plaintiff also fails to present any material evidence that calls into question the truthfulness of Clapp's claim of origin for his restaurant's name aside from the general assertion that Clapp's experience working in Los Angeles may have resulted in his knowledge of the "Dan Tana's" restaurant. Without any evidence to contradict Clapp's account that his restaurant is named after his own two children, as opposed to Plaintiff's restaurant in Hollywood, and without any evidence of a motive for Defendants to trade on the name of Plaintiff's restaurant, there can be no intentional appropriation of Plaintiff's name or likeness. In sum, the district court did not err in granting summary judgment to Defendants on Plaintiff's appropriation-of-likeness claim.

CONCLUSION

Because Plaintiff failed to produce sufficient evidence raising a genuine issue of material fact on the likelihood of confusion between Plaintiff's and Defendants' marks, the district court did not err in granting summary judgment to Defendants on Plaintiff's federal and state trademark infringement claims and his claim of fraud arising under Georgia law. We also uphold the district court's grant of summary judgment to Defendants on Plaintiff's appropriation-of-likeness claim due to the absence of any evidence of an intentional appropriation of Plaintiff's likeness.

AFFIRMED.

A True Copy - Attested
Clerk U.S. Court of Appeals
Eleventh Circuit
By: _____
Deputy Clerk
Atlanta, Georgia

EXHIBIT “F”

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 7, 2010

Cancellation No. 92045947

Dan Tana

v.

Great Concepts, LLC

Andrew P. Baxley, Interlocutory Attorney:

On September 1, 2010, respondent filed a submission in which it stated that the civil action styled *Dan Tana v. Dantanna's, Great Concepts, LLC, et al.,* Case No. 08-CV-0975, filed in United States District Court for the Northern District of Georgia, which prompted the suspension of this case, has been finally determined with petitioner's claim of false designation of origin under Trademark Act Section 43(a), 15 U.S.C. Section 1125(a), being dismissed.[1] Accordingly, proceedings herein are resumed. Further briefing on respondent's motion for summary judgment is deferred pending resolution of the following.

In view of the decision by the Board's reviewing court in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed.

[1] Respondent served its submission upon petitioner's former attorney. Respondent is directed to re-serve its submission on petitioner's current attorney, i.e., Brent Blakely, Blakely Law Group, 915 North Citrus Avenue, Hollywood, CA 90038.

Cir. 2009), the Board has *sua sponte* reviewed petitioner's petition to cancel and finds that both of petitioner's claims are insufficiently pleaded.[2] See Fed. R. Civ. P. 12(b)(6); TBMP Section 503.02 (2d ed. rev. 2004).

Regarding petitioner's claim that respondent's mark falsely suggests a connection with petitioner under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a), such claims evolved out of the right to privacy, as opposed to trademark infringement. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ 505 (Fed. Cir. 1983). A claim of false suggestion of a connection under Section 2(a), requires allegation of facts from which it may be inferred: (1) that respondent's mark points uniquely to petitioner, as an entity, i.e., that applicant's mark is opposer's identity or persona; (2) that purchasers would assume that services rendered under respondent's mark are connected with petitioner; and (3) that, prior to respondent's use of its mark, either (a) petitioner used respondent's mark, or an equivalent thereof, as a designation of his identity or persona, or (b) respondent's mark was associated with petitioner. See *Miller Brewing Co.*

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[2] Petitioner has adequately pleaded his standing by alleging facts which demonstrate a real interest in the outcome of this proceeding in paragraphs 1 through 10 of the petition to cancel. See *Ritchie v. Simpson*, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028, 213 USPQ 185, 189 (CCPA 1982).

v. Anheuser-Busch Inc., 27 USPQ2d 1711 (TTAB 1993). In the petition to cancel, petitioner alleges that respondent's DANTANNA'S mark is identical to petitioner's DAN TANA mark, instead of his identity or persona.[3] Paragraph 14(i). Petitioner also alleges that petitioner's DAN TANA mark, instead of respondent's involved DANTANNA'S mark, points directly and unique to petitioner. Paragraph 14(ii).

In addition, petitioner contends that respondent's application for the involved registration should have been refused under Section 2(a). However, in determining claims in *inter partes* proceedings, the issue is not whether the examining attorney should have refused registration of respondent's mark. The Board does not supervise examining attorneys. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989). Rather, Board proceedings are based upon a plaintiff's belief of damage from the registration of a mark and involve determinations of whether cancellation or refusal of a registration is warranted, based on specific pleaded grounds. See Trademark Act Sections 13 and 14, 15 U.S.C. Section 1063 and 1064; Trademark Rules 2.101(b) and 2.111(b). Based on the

[3] A claim based on an assertion that respondent's mark is confusingly similar to petitioner's previously used mark is properly raised under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

foregoing, petitioner's Section 2(a) false suggestion claim is legally insufficient.

Regarding petitioner's pleaded fraud claim, fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of fact in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it is otherwise not entitled.[4] *See Torres v. Cantine Torresella S.r.l.,* 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

Petitioner has failed to identify clearly any specific false, material representations of fact that respondent made in the *ex parte* examination of the application for its involved registration with the intent of obtaining a registration to which respondent was not entitled. While the declaration in an application must be truthful,

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[4] Because intent is a required element to be pleaded for a claim of fraud, allegations that a party made material representations of fact that it "knew or should have known" were false or misleading are insufficient. See *In re Bose Corp., supra*. There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). Unless a party alleging fraud can point to clear and convincing evidence that supports drawing an inference of deceptive intent, it will not be entitled to judgment on a fraud claim. *In re Bose Corp., supra* at 1942. Any doubt must be resolved against the party making a claim of fraud. *Id.* at 1939.

respondent was not required to investigate and report all other possible users of an identical or confusingly similar mark either as part of its application or during *ex parte* examination of that application.[5] See *Rosso and Mastracco, Inc. v. Giant Food Inc.*, 219 USPQ 1050 (Fed. Cir. 1983); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). In addition, a review of the registration file indicates that respondent was not asked during such examination to explain whether its involved DANTANNA'S mark had any meaning or significance in the relevant trade or

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[5] In the declaration contained in the application for respondent's involved registration, respondent's attorney averred that "**to the best of his/her knowledge and belief** no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." (emphasis added) To the extent that petitioner intends to assert that respondent committed fraud in that declaration, petitioner must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to the applicant's; (3) the applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from the applicant's use of its mark or had no reasonable basis for believing otherwise; and that (4) the applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). Otherwise stated, petitioner must plead (and later prove) not only that respondent's declaration was literally false (i.e., that respondent did not have superior rights in the mark), but also that respondent knew that its assertion of exclusive rights in the mark was false. *Am. Sec. Bank v. Am. Sec. & Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 (CCPA 1978) ("Appellant misreads the cited statute and rules. They require the statement of *beliefs* about exclusive rights, not their actual possession.").

industry or whether the mark identifies a living individual. The Board will not penalize respondent for not providing an explanation that the examining attorney did not request. See *Marshall Field & Co. v. Mrs. Fields Cookies, supra.* Further, petitioner's fraud allegations are unacceptably made "[u]pon information and belief" without setting forth specific facts upon which the belief is reasonably based. See *Asian and Western Classics B.V. v. Selkow,* 92 USPQ2d 1478 (TTAB 2009). Based on the foregoing, petitioner's fraud claim is also legally insufficient.

Notwithstanding the foregoing, the Board generally allows plaintiffs whose pleadings have been found insufficient an opportunity to file a corrected pleading. See TBMP Section 503.03. Therefore, petitioner is allowed until thirty days from the mailing date set forth in this order to file an amended petition to cancel.[6] Respondent is allowed until sixty days from the mailing date set forth in this order to file an answer to the amended petition to cancel and either a revised motion for summary judgment or a submission indicating that it wishes to go forward with its pending motion for summary judgment.[7] Petitioner is allowed

[6] If petitioner does not file an amended petition to cancel, the Board may issue an order to show cause why the Board should not dismiss the petition to cancel with prejudice based on petitioner's apparent loss of interest in this case.

[7] The revised motion for summary judgment should include all supporting exhibits. If respondent files a revised motion for

until ninety-five days from the mailing date set forth in this order to file a brief in response to respondent's operative motion for summary judgment. Respondent's reply brief in support of its operative motion for summary judgment is due in accordance with Trademark Rules 2.119(c) and 2.127(e)(1).

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summary judgment, the revised motion for summary judgment will become the operative summary judgment motion herein, and its pending motion for summary judgment will receive no consideration.

EXHIBIT “G”

ESTTA Tracking number: **ESTTA367423**
Filing date: **09/09/2010**

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

Proceeding	92045947
Party	Defendant Great Concepts, LLC
Correspondence Address	R. Milton Crouch Shapiro Fussell, LLP 1360 Peachtree St., Suite 1200 Atlanta, GA 30309 UNITED STATES mcrouch@shapirofussell.com, docketing@procopio.com, lmf@procopio.com, mlf@procopio.com, fkt@procopio.com
Submission	Other Motions/Papers
Filer's Name	Frederick K. Taylor
Filer's e-mail	docketing@procopio.com, fkt@procopio.com, tma@procopio.com
Signature	/Frederick K. Taylor/
Date	09/09/2010
Attachments	PROOF_OF_SERVICE.pdf (1 page)(10358 bytes)

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing filed **REQUEST TO REMOVE SUSPENSION of PROCEEDINGS** is being emailed on September 8, 2010 to the attorney for Petitioner as follows:

Brent H. Blakely
Blakely Law Group
915 North Citrus Avenue
Hollywood CA 90038
Tel: (323) 464-7400
Fax: (323) 464-7410
Email: bblakely@blakelylawgroup.com

Dated: September 8, 2010 By: /Frederick K. Taylor/
Frederick K. Taylor

EXHIBIT “H”

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: October 26, 2010

Cancellation No. 92045947

Dan Tana

v.

Great Concepts, LLC

Andrew P. Baxley, Interlocutory Attorney:

In view of petitioner's failure to file an amended petition to cancel in compliance with the Board's September 7, 2010 order, petitioner is allowed until thirty days from the mailing date set forth in this order to show cause why this proceeding should not be dismissed with prejudice based on petitioner's apparent loss of interest. See September 7, 2010 order at footnote 6.

Proceedings herein are otherwise suspended.

EXHIBIT “I”

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: December 14, 2010

Cancellation No. 92045947

Dan Tana

v.

Great Concepts, LLC

By the Trademark Trial and Appeal Board:

In view of petitioner's failure to respond to the order to show cause that the Board issued on October 26, 2010, the petition to cancel is dismissed with prejudice based on petitioner's apparent loss of interest.

EXHIBIT “J”

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

REGISTRATION NO. 1516448 SERIAL NO. 73/679230 PAPER NO.
MAILING DATE: 09/05/95

MARK: STEALTH WEAR

REGISTRANT: COVINGTON INDUSTRIES, INC.

CORRESPONDENCE ADDRESS:
PETER G. MACK
FOLEY & LARDNER
3000 K STREET, N.W.
P.O. BOX 25696
WASHINGTON, DC 20007-8696

Please furnish the following in all correspondence:

1. Your phone number and zip code.
2. Mailing date of this action.
3. Affidavit-Renewal Examiner's name.
4. The address of all correspondence not containing fees should include the words "Box 5".
5. Registration No.

RECEIPT IS ACKNOWLEDGED OF THE SUBMITTED REQUEST UNDER:

SECTION 8 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.161-2.166.

SECTION 15 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.167-2.168.

YOUR REQUEST FULFILLS THE STATUTORY REQUIREMENTS AND HAS BEEN ACCEPTED.

PATRICIA ANN EVERETT
AFFIDAVIT-RENEWAL EXAMINER
TRADEMARK EXAMINING OPERATION
(703) 308-9500 EXT. 42

MAIL ROOM
DEC 9 1994
PAT & TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Registrant: Covington Industries, Inc.
Registration No.: 1,516,448
Registration Date: December 13, 1988
Mark: STEALTH WEAR

TRANSMITTAL LETTER

TO THE ASSISTANT COMMISSIONER OF TRADEMARKS
2900 Crystal Drive, Arlington, VA 22202-3513:

Sir:

Registrant is submitting the following materials in connection with the above-identified Trademark registration:

1. Combined Declaration Under Sections 8 and 15;
2. 1 Specimen* (label)
3. Check ($200.00)

Please charge any additional fees due to Deposit Account No. 19-0741. A duplicate of this letter is attached for this purpose.

Respectfully submitted,

December 9, 1994
Date

PETER G. MACK

Foley & Lardner
Suite 500
3000 K Street, N.W.
P.O. Box 25696
Washington, D.C. 20007-8696

* Specimen shows the name "GAME WINNER", which is a wholly owned subsidiary of the registrant, Covington Industries, Inc. The parent company completely owns the subsidiary, use of the mark inures to the registrant's benefit as a matter of course; in addition, because the registrant wholly owns the party whose name appears on the specimen, control over the nature and quality of the goods is implicit by virtue of the relationship itself.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Registrant: Covington Industries, Inc.
Registration No.: 1,516,448
Registration Date: December 13, 1988
Mark: STEALTH WEAR

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Suite 500
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P.O. Box 25696
Washington, D.C. 20007-8696

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200.00 - 374

PRU

6

TRADEMARK MAILROOM
REC'D
DEC 0 9 1994
45
US PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

COMBINED DECLARATION OF USE AND INCONTESTABILITY OF A MARK UNDER SECTIONS 8 AND 15

Mark: STEALTH WEAR

Registration No.: 1,516,448

Class No.: 25

Registrant: Covington Industries, Inc.

Address: 2625 Cumberland Parkway
Atlanta, GA 30339

Incorporated Under the Laws of Alabama

TO THE ASSISTANT COMMISSIONER OF TRADEMARKS
2900 Crystal Drive, Arlington, VA 22202-3513:

The undersigned being hereby warned 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 Code and that such willful false statements may jeopardize the validity of this document declares that Covington Industries, Inc. owns the above-identified registration issued December 13, 1988, as shown by records in the Patent and Trademark Office; that the mark shown therein has been in continuous use in interstate commerce for five consecutive years from the date of the registration to the present, on or in connection with all of the goods which are stated in the registration; that such mark is still in use in interstate commerce; that such mark is still in use as evidenced by the specimen enclosed showing the mark as currently used; that there has been no final decision adverse to registrant's

150 TD 01/11/95 1516448 0 374 200.00 CK

claim of ownership of such mark for such goods, or to registrant's right to register the same or to keep the same on the register; that there is no proceeding involving said rights pending and not disposed of either in the Patent and Trademark Office or in the courts; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

POWER OF ATTORNEY

Registrant hereby appoints Arthur Schwartz, Registration No. 22,155; Donald D. Jeffery, Registration No. 19,980; Richard L. Schwaab, Registration No. 25,479; Peter G. Mack, Registration No. 26,001; David A. Blumenthal, Registration No. 26,257; John J. Feldhaus, Registration No. 28,822; Stephen A. Bent, Registration No. 29,768 and Bernard D. Saxe, Registration No. 28,665 Sybil Meloy, Registration No. 22,749 of Foley & Lardner, Suite 500, 3000 K Street, N.W., P.O. Box 25696, Washington, D.C. 20007-8696, as registrant's attorneys with full power of association, substitution and revocation, and to take any and all other actions with regard to this mark and registration.

Registration No. 1,516,448

Please direct all future correspondence to:

PETER G. MACK, ESQUIRE
FOLEY & LARDNER
3000 K Street, N.W.
P.O. Box 25696
Washington, DC 20007-8696
Telephone: (202) 672-5300

Respectfully submitted,

Covington Industries, Inc.

Date: DECEMBER 7, 1994 By: Jerry L. Chitwood
Jerry L. Chitwood
Vice President

Form PTO - 184
(Rev. 12-82)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

PAPER No.

18434

BRIEF OF INTER PARTES CASE

PROCEEDING No. _____

SERIAL No. _____ FILED _____

APPLICANT _____

REGISTRATION No. 1,516,448 DATED 12-13-88

REGISTRANT Covington Industries, Inc.

ADVERSE PARTY Stealth Industries, Inc.

DECISION

SUPERVISORY EXAMINER _____ DATED _____

TRADEMARK TRIAL AND APPEAL BOARD [illegible] DATED 4-28-93

COURT _____ DATED _____

REMARKS