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07-12-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #26

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

|                                |   |
|--------------------------------|---|
| APPLEBEE'S INTERNATIONAL, INC. | ) |
|                                | ) |
| Opposer,                       | ) |
|                                | ) |
| v.                             | ) |
|                                | ) |
| THE STOUFFER CORPORATION       | ) |
|                                | ) |
| Applicant.                     | ) |

Opposition No. 111,517  
SKILLET SENSATIONS

TRADEMARK TRIAL AND  
APPEAL BOARD  
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BOX TTAB - NO FEE  
Asst. Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**REPLY BRIEF IN SUPPORT OF MOTION TO STRIKE**

Applicant, The Stouffer Corporation, hereby submits the following reply brief in support of its motion to strike. This reply brief is necessary because certain arguments against the motion should be answered so as to assist the Board in ruling on the motion.

It appears that opposer, Applebee's International, Inc., misunderstands the arguments raised by applicant in its motion to strike. The position taken by applicant that the term "skillet sensations" is merely descriptive of opposer's goods is not an affirmative defense. Rather, applicant briefed this issue to show that opposer, as the plaintiff in this opposition proceeding, failed to meet its burden of proof in its case-in-chief.

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In an opposition founded on § 2(d), opposer first must prove that it has a proprietary right in the term it relies upon and then it must prove that its right in the term is senior to that of the applicant. *See generally* J. Thomas McCarthy, *Trademarks and Unfair Competition*, § 20.15 (4<sup>th</sup> ed. 2002). Where, as here, the opposer relies upon an unregistered term to argue likelihood of confusion, it must show, in its case-in-chief, distinctiveness of the term, either by inherent distinctiveness or acquired distinctiveness. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (C.C.P.A. 1981). Thus, it is clear that opposer, in its case-in-chief, must prove secondary meaning in a descriptive term, such as “skillet sensations” for a sensational meal served in a restaurant on a hot skillet.


A review of the record in this case reveals that opposer did not allege inherent or acquired distinctiveness of “skillet sensations” in its notice of opposition, nor did it present testimony to establish such distinctiveness in its case-in-chief. Not surprisingly, opposer failed to argue distinctiveness in its opening brief. Indeed, it was in its reply brief that opposer first suggested that the term “skillet sensations” for its goods had distinctiveness. This late argument effectively precluded applicant from responding and, thus, prejudiced applicant. Opposer’s reply brief must be confined to rebutting applicant’s main brief, not proving its case. *See* TBMP § 801.03.

The element of distinctiveness, regardless of whether it was raised by applicant in the pleadings (which it was), is opposer’s burden. It was not considered in opposer’s opening testimony nor in its opening brief. The first offer of proof consisted of mere arguments in the last procedural event in this opposition, *i.e.*, opposer’s reply brief, so it could not be answered by applicant. Such

tactic is improper, unfair and prejudicial. For these reasons, opposer's motion to strike should be granted.

Respectfully submitted,

VICKERS, DANIELS & YOUNG

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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing REPLY BRIEF IN SUPPORT OF MOTION TO STRIKE was served on opposer, APPLEBEE'S International, Inc., by First Class U.S. Mail, postage prepaid, this 10<sup>th</sup> day of July, 2002, to the attorneys for Applebee's International, Inc. at the address below:

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