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Attorney Docket No. 3540-500001

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

**TRADEMARK**

In the matter of Application Serial No. 78/077,187  
Filed: August 2, 2001  
For the mark: BONEFISH GRILL & Design  
Published in the Official Gazette on January 8, 2002

U.S. Patent & TMO/c/TM Mail Rcpt. Dt. #57



05-08-2002

INTERNATIONAL MARKET PLACE, )  
INC. )

Opposer )

Opposition No. \_\_\_\_\_ )

vs. )

BONEFISH GRILL, LLC )

Applicant )

TRADEMARK TRIAL AND  
APPEAL BOARD  
02 MAY 18 AM 12:49

**NOTICE OF OPPOSITION**

In the matter of the above-identified application to register the mark "BONEFISH GRILL & Design" for restaurant services in International Class 42, filed on August 2, 2001, and published for opposition in the Trademark Official Gazette of January 8, 2002, Vol. 1254 No. 2, at page TM 673, the Opposer, International Market Place, Inc., believes it will be damaged by registration of the alleged mark, and hereby opposes same.

As grounds for opposition, it is alleged as follows:

1. Opposer, International Market Place, Inc. ("International Market Place"), is a corporation duly organized under the laws of Michigan, and is located at 400 Monroe Street, Suite 480, Detroit, Michigan 48226. Upon information and belief, Applicant, Bonefish Grill, LLC

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("Bonefish Grill"), is a Limited Liability Company organized under the laws of Florida, and is located at 5901 4<sup>th</sup> Street North, St. Petersburg, Florida 33702.

2. Commencing long prior to the January 31, 2000 date of first use anywhere set forth in the application opposed herein, International Market Place has, and now is, engaged in the restaurant business in commerce in the United States. The services of the Opposer are well-known and enjoy a widespread reputation in the United States.

3. Commencing long prior to the January 31, 2000 date of first use anywhere set forth in the application opposed herein, International Market Place adopted, and commenced using, and has continuously used in commerce, directly and through one or more licensees, its distinctive marks FISHBONE'S and FISHBONE'S RHYTHM KITCHEN CAFE ("FISHBONE MARKS"), in connection with Opposer's restaurant services.

4. Since Opposer International Market Place's initial use of its FISHBONE MARKS, Opposer has made substantial investment in said marks and the services provided thereunder. Opposer has extensively used, promoted and offered its services under its FISHBONE MARKS through various channels of trade and commerce, with the result that Opposer's customers, and the public generally, have come to know and recognize Opposer's marks and to associate same with Opposer. Opposer has thus developed extensive goodwill in connection with its services, under its FISHBONE MARKS.

5. Opposer is the owner of and will rely upon herein Registration No. 1,702,336 for the mark FISHBONE'S and Registration No. 1,710,606 for the mark FISHBONE'S RHYTHM KITCHEN CAFE. Both are registered in connection with restaurant services. Opposer has long used and continues to use its FISHBONE MARKS in connection with restaurant services and has

established prior and superior rights in marks incorporating the term FISHBONE'S.

6. Opposer's above recited registrations are registered on the Principal Register in International Class 42 and are valid, subsisting, unrevoked, and uncanceled. Pursuant to 15 U.S.C. § 1115(b), Opposer's Registrations are incontestable and serve as conclusive evidence that the registrations are valid, owned by Opposer and entitle Opposer to the exclusive right to use the same in commerce, subject only to certain defenses and exceptions.

7. Notwithstanding Opposer's long standing prior rights to its FISHBONE MARKS, on August 2, 2001, Applicant filed an application for registration of the confusingly similar mark BONEFISH GRILL & Design for restaurant services in International Class 42. This application was published for opposition in the Trademark Official Gazette of January 8, 2002, Vol. 1254 No. 2, at page TM 673.

8. The mark BONEFISH GRILL & Design which Applicant seeks to register is confusingly similar in pronunciation, cadence and appearance to and is a colorable imitation of Opposer's FISHBONE MARKS.

9. On information and belief, Applicant's services will be sold and promoted and therefore move in the same channels of trade and commerce as Opposer's services and therefore, as a result of the use of said confusingly similar mark, Applicant's services may be associated in the minds of the consuming public with Opposer's services.

10. The BONEFISH GRILL & Design mark sought to be registered by Applicant, if used in connection with the services identified in the application opposed herein, is likely to cause confusion, mistake or deception as to the source or origin of said services, and will tend to mislead consumers and the public alike into believing that such services are distributed by, emanate from

Opposer, and/or that such services or the Applicant in some way, directly or indirectly, are associated with the Opposer and/or its services, to the damage and detriment of Opposer, its FISHBONE MARKS as well as its goodwill and reputation.

11. Opposer International Market Place thus believes that it will be damaged by the use and registration by Applicant of the BONEFISH GRILL & Design mark, as set forth in the application therefor, Serial No. 78/077,187.

12. If Applicant is granted the registration opposed herein and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, as amended, Applicant will obtain unlawful gain and advantage to which it is not entitled, and, upon information and belief, Opposer International Market Place will be subjected to great and irreparable damage.

WHEREFORE, Opposer prays that this Opposition be sustained and the Application Serial Number 78/077,187 be refused with prejudice, and that no registration be issued to Applicant.

Respectfully submitted,

Dated: May 8, 2002

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By:



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May 8, 2002

Box TTAB Fee  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Sir:

**EXPRESS MAILING CERTIFICATE**

Opposer: International Market Place, Inc.  
Trademark: BONEFISH GRILL & Design  
Docket: 3540-500001  
Attorney: Paul A. Keller

"Express Mail" Mailing Label Number .....EV 034 137 833 US

Date of Deposit.....May 8, 2002

I hereby certify and verify that the accompanying Transmittal Letter (in duplicate), Notice of Opposition (3 Pages In Duplicate), Check in the amount of \$300.00, Express Mailing Certificate and Return Postcard (is) are being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 C.F.R. 1.10 on the date indicated above and (is) are addressed to Box TTAB Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

  
\_\_\_\_\_  
Signature of Person Mailing Document(s)

HARNES, DICKEY & PIERCE, P.L.C.

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05-08-2002

May 8, 2002

BOX TTAB FEE

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Re: Notice of Opposition for the mark: **BONEFISH GRILL & Design**  
Attorney Docket No. 3540-500001

Sir:

Enclosed herewith is a Notice of Opposition (in duplicate), check in the amount of \$300.00 to cover the Notice of Opposition fee for one class, Transmittal Letter (in duplicate), Express Mailing Certificate #EV 034 137 833 US and Return Postcard.

Attention is directed to the fact that the address of this Firm has been designated as the correspondence address for this opposition.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayments to Deposit Account No. 08-0750. A duplicate copy of this letter is enclosed herewith for this purpose.

Respectfully submitted,

HARNES, DICKEY & PIERCE, P.L.C.  
Attorney for Applicant

By: 

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Registration No. 40,344

TM