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

IN THE MATTER OF APPLICATION SERIAL NO. 76/378,230
PUBLISHED IN THE OFFICIAL GAZETTE OF AUGUST 20, 2002

IN-N-OUT BURGERS)
)
OPPOSER)
)
v.)
)
TONY CHACHERE'S CREOLE)
FOODS OF OPELOUSAS, INC.)
)
APPLICANT)
_____)

OPPOSITION NO. 91154347



04-22-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #74

MOTION TO AMEND NOTICE OF OPPOSITION AND EXTEND THE DISCOVERY AND
OTHER PERIODS

Assistant Commissioner of Trademarks
BOX: TTAB
2900 Crystal Dr.
Arlington, VA 22202-3513

Sir:

Please find enclosed a Motion to Amend the Notice of Opposition and Extend the Discovery and Other Periods, together with an Amended Notice of Opposition (original plus one) with respect to Application Serial No. 76/378,230, "INSIDE AND OUT", published in the Official Gazette of August 20, 2002.

Edward O. Ansell

Attorney for Opposer In-N-Out Burgers

Date: April 18, 2003
Enc. a/s

449 W. Willamette Lane
Claremont, CA 991711-2646
Tel: (909) 625-1244; Fax: (909)624-1664
E-Mail: anselaw@att.net

cc: In-N-Out Burgers

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

IN THE MATTER OF APPLICATION SERIAL NO. 76/378,230
PUBLISHED IN THE OFFICIAL GAZETTE OF AUGUST 20, 2002

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TONY CHACHERE'S CREOLE)
FOODS OF OPELOUSAS, INC.)
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APPLICANT)
_____)

OPPOSITION NO. 91154347

OPPOSER'S MOTION TO AMEND NOTICE OF OPPOSITION AND EXTEND THE
DISCOVERY AND OTHER PERIODS

Opposer, by its attorney, hereby moves, pursuant to Trademark Rule 2.107 to amend its Notice of Opposition to add an additional ground for Opposition to Applicant's application Serial No. 76/378,230. Specifically, Opposer wishes to add as Paragraph 10, the descriptive nature of Applicant's mark being an additional basis of Opposition to registration. Further, Opposer hereby moves that if and when this motion is granted, times be reset to afford Applicant time to file a reply to the amended counterclaim, plus an additional sixty (60) days to afford Opposer an opportunity to propound additional Interrogatories/Requests for Admission to Applicant, and all other time periods to be reset accordingly.

In support of this Motion, Opposer asserts that a mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d

1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP §1209.01(b).

The applicant seeks registration of INSIDE AND OUT for spices and marinades. Applicant's advertising on its website <<http://www.tonychachere.com>> states: "Tony Chachere's Injectable marinades make everything taste great inside and out." (See three occasions at page 2 of Attachment A to the enclosed declaration.)

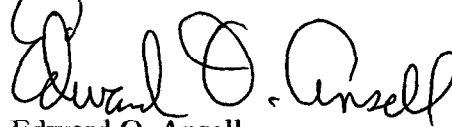
Applicant admits that advertising of its products includes the statement: "Tony Chachere's Injectable Marinades make everything taste great **inside and out!**" (See Request for Admission No. 11 and Response, Attachment B to the enclosed declaration.)

Applicant's advertisements and admission unambiguously explain and admit the function, feature, purpose and use of Applicant's goods. Accordingly, the proposed mark for said goods is merely descriptive thereof and registration should be refused under Section 2(e)(1) of the Trademark Act.

In view of the foregoing, and because this motion is filed before the end of the present discovery period, presently set to close on July 29, 2003, and because an extension of time for

discovery is also the subject of this motion, there is no prejudice to Applicant. Therefore, it is submitted that this motion is well taken and that the amended "Notice of Opposition" submitted herewith should be accepted and substituted for the original Notice of Opposition.

Respectfully submitted,
IN-N-OUT BURGERS



Edward O. Ansell
Attorney for Opposer

Date: April 18, 2003

- Enclosures: 1. Amended Notice of Opposition
2. Declaration of Edward O. Ansell

PROOF OF SERVICE

I hereby certify that on 04/09/2003, a copy of the foregoing document is being deposited with the U.S. Postal Service, first class mail, postage prepaid, addressed to:

Thomas W. Brooke
Holland & Knight, L.L.P.
2099 Pennsylvania Ave., N.W., #100
Washington, DC 20006-6801
Attorney for Applicant



HANNIS ANSELL

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

In the Matter of Trademark Application Serial No. 76/378,230
For the Mark INSIDE AND OUT
Published in the Official Gazette on August 20, 2002

In-N-Out Burgers)
Opposer)
)
v.)
)
Tony Chachere's Creole Foods)
of Opelousas, Inc.)
)
Applicant)
_____)

NOTICE OF OPPOSITION

Opposer, In-N-Out Burgers, a California Corporation, with a business address of 4199 Campus Drive, 9th Floor, Irvine, CA 92612, hereby opposes registration of the mark INSIDE AND OUT that is the subject of application 76/374,230, published in the Official Gazette of August 20, 2002, and requests that registration to Applicant be refused.

As grounds in support of the opposition, Opposer asserts as follows:

1. Opposer, for many years and since long prior to any date of application or first use, if any, upon which Applicant can rely, has adopted and continuously used the term IN-N-OUT for its restaurant services, and food items associated with its restaurant services;
2. Opposer is the owner of registrations for the mark IN-N-OUT, for restaurant services and carry-out restaurant services, each of said registrations being valid,

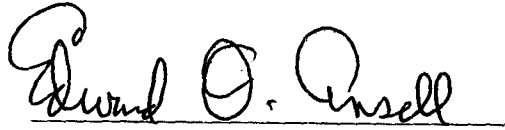
- subsisting, unrevoked and uncanceled, namely registrations 1,085,163, 1,522,799, and 1,525,982;
3. Opposer is the owner of registrations 1,101,628, 1,101,638, 1,522,799, and 1,525,982 for the mark IN-N-OUT for food items associated with its restaurant services, namely cheeseburgers, hamburgers, French fried potatoes, hot coffee, milk, milkshakes, lemonade and soft drinks, each of said registrations being valid, subsisting, unrevoked and uncanceled;
 4. Opposer provides condiments, including spices, for use with food items purchased by members of the public in the performance of Opposer's restaurant services;
 5. Opposer is the owner of Registration 930,203, IN'N'OUT, registered February 29, 1972, for retail grocery services, said Registration being valid, subsisting, unrevoked and uncanceled.
 6. Said Registration 930,203 is in use by controlled licensees, pursuant to agreement, in connection with retail grocery services, including the sale of spices, marinades and related items.
 7. Applicant has filed an intent-to-use application to register the mark INSIDE AND OUT for spices and marinades. That application was filed on March 4, 2002, and assigned Serial No. 76/378,230.
 8. Applicant's mark so resembles Opposer's previously used and registered marks IN-N-OUT, and IN'N'OUT as to be likely, when used in connection with the goods set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

9. Applicant's mark so resembles Opposer's previously used, registered, and famous marks IN-N-OUT and IN'N'OUT as to be likely, when used in connection with the goods set forth in Applicant's application, to lessen the capacity of Opposer's said marks to identify and distinguish Opposer's services and goods, regardless of the presence or absence of competition between Opposer and Applicant, or likelihood of confusion, mistakes or deception.
10. Applicant's mark is merely descriptive of the goods to which it relates because it describes a characteristic, function, feature, purpose and use of the specified goods.

WHEREFORE, Opposer prays that the opposition be sustained and that registration to Applicant be refused.

Respectfully submitted,
In-N-Out Burgers

By



Edward O. Ansell
Attorney for Opposer

Date:

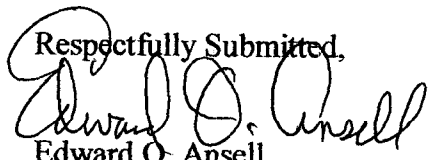
April 18, 2003

449 Willamette Lane, Claremont, Ca 91711
Tel: (909)625-1244; Fax: (909)624-1664
E-mail: anselaw@att.net

DECLARATION OF EDWARD O. ANSELL

I, EDWARD O. ANSELL do hereby declare and state:

1. I am a citizen of the United States, a member of the bar of the United States District Court in the central District of California, and a resident of the County of Los Angeles in the State of California. I am an attorney of record for Petitioner/Opposer in the above entitled action, and my business address for this Opposition is 449 W. Willamette Lane, Claremont, CA 91711-2746.
2. Attachment "A" is a page containing Applicant's Response to Opposer's Request for Admission number 11, a part of Opposer's First Request for Admissions, served February 10, 2003, said Response being received by Declarant on April 17, 2003.
3. Attachment "B" is a three-page advertisement for Applicant's Products including Marinades which the Declarant downloaded from the World-Wide Web on April 18, 2003 at <<http://www.tonychachere.com>>.
4. I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Respectfully Submitted,

Edward O. Ansell
Attorney for Petitioner/Opposer

Date: April 18, 2003
Edward O. Ansell
Attorney-at-Law
449 W. Willamette Lane
Claremont, CA 91711-2746
Phone: (909) 625-1244
Fax: (909) 624-1664
E-mail anselaw@att.net

RESPONSE

Applicant states that the document attached speaks for itself and admits that its website did feature the graphics and text on this page at least for a time and that all information appearing on this page was at that time true.

10. The attached three-page document captioned "Tony Chachere's Products" and Marinades & Frying Kits" is a genuine copy of a World-Wide-Web advertisement by Applicant for marinades, and the facts contained therein are true;

RESPONSE

Applicant states that the document attached speaks for itself and admits that its website did feature the graphics and text on this page at least for a time and that all information appearing on this page was at that time true.

11. Applicant's advertising of its products includes the statement: "Tony Chachere's Injectable Marinades make everything taste great inside and out!"

RESPONSE

Admitted.

Respectfully Submitted,

TONY CHACHERE'S CREOLE
FOODS OF OPELOUSAS, INC.



Donald Chachere, Jr.



Tony Chachere's products

- products
- our company
- what's new
- store finder
- fun stuff
- free vacation

Marinades & Frying Kits

26 Quart Turkey Fry Kit



Almost 20 years after Mr. Tony fist published his original injectable marinade recipe for fried turkey, we now introduce *Tony Chachere's 26 Quart Turkey Fry Kit*. Everything you need to prepare moist, delicious turkey for your family and friends. This kit includes a burner, 26-quart pot, turkey stand, regulator hose, thermometer and Tony Chachere's Creole Marinade Injector. It also comes with *Tony Chachere's NEW Creole Butter Flavor Injectable Marinade* and our world famous *Original Creole Seasoning*.

To see the assembly instructions [click here](#).

Price : \$89.95

Product ID 04026
 Manufacturer Tony Chachere's

Quantity:

add item(s) to order

30 qt. Turkey Fry Kit



Tony Chachere's 30 Quart Turkey Fry Kit is perfect for deep frying moist, delicious turkey or boiling your favorite seafood. Everything you need to boil or fry is contained in this kit.

To see the assembly instructions [click here](#).

Price : \$99.95

Product ID 04030
 Manufacturer Tony Chachere's Creole Foods

Quantity:

add item(s) to order

Creole Butter and Jalapeno

Marinate any meat in only 5 minutes with *Tony Chachere's Injectable Marinades*. This unique way of marinating will save you time and money. Great for turkey, chicken, beef, pork,



fish and even vegetables. Try it once and you will never marinate any other way! *Tony Chachere's Injectible Marinades* make everything taste great inside and out!

Price : \$5.99

Product ID 50002

Manufacturer Tony Chachere's Creole Foods

Quantity:

add item(s) to order

Creole Butter Bacon



Marinate any meat in only 5 minutes with *Tony Chachere's Injectible Marinades*. This unique way of marinating will save you time and money. Great for turkey, chicken, beef, pork, fish and even vegetables. Try it once and you will never marinate any other way! *Tony Chachere's Injectible Marinades* make everything taste great inside and out!

Price : \$5.99

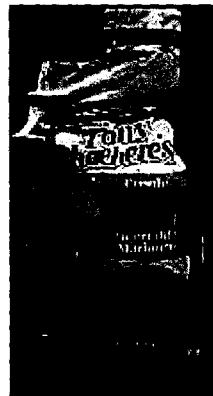
Product ID 50001

Manufacturer Tony Chachere's Creole Foods

Quantity:

add item(s) to order

Creole Honey Bacon BBQ



Marinate any meat in only 5 minutes with *Tony Chachere's Injectible Marinades*. This unique way of marinating will save you time and money. Great for turkey, chicken, beef, pork, fish and even vegetables. Try it once and you will never marinate any other way! *Tony Chachere's Injectible Marinades* make everything taste great inside and out!

Price : \$5.99

Product ID 50006

Manufacturer Tony Chachere's Creole Foods

Quantity:

add item(s) to order

Page 2

creole@cajunspice.com Order online or call 1-800-551-9066

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