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

In the matter of trademark application Serial No. 78110344
Filed on: February 22, 2002
For the mark "Superfreaks Funky Disco Revue"
Published in the Official Gazette on December 17, 2002

Joe J. Alfaro, Jr.
v.
Guy A. Hoffmann



01-15-2003

U.S. Patent & TMOfo/TM Mail Ropt. Dt. #40

Opposition No. _____

NOTICE OF OPPOSITION

Joe J. Alfaro, Jr., Owner of the band "The Superfreaks"
481 W. Blaine Street, Riverside, CA 92507

The above-identified Opposer believes that he will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1) **Not a Bona Fide Offering of Goods or Services.** Joe J. Alfaro, Jr., Opposer, asserts that because the Applicant was well aware of Opposer's superior rights in the mark, and purposely failed to disclose the existence of Opposer's prior use, Applicant's application cannot be found to be a bona fide offering of goods or services. The Applicant used to perform with Opposer's band "The Superfreaks" but was dismissed in late 2001. Applicant became very disgruntled swearing to get "PAYBACK" from the Opposer. Excerpt from an e-mail that Applicant sent on September 10, 2002 (wording is exactly as it appears in e-mail) to Opposer's friend David W. Hickam Gulley (please see affidavit authenticating e-mail),

"BUT DON'T THINK I'M DONE WITH JOE BY A LONG SHOT. F* NO!!!
LOSING THE CRAZYHORSE IS ONLY THE BEGINNING OF HIS PAYBACK FROM
ME", . . . "WHEN I'M DONE, HE WON'T HAVE TIME TO WORRY ABOUT DISCO
AT ALL 'CAUSE HE'LL BE WORRYING ABOUT WHERE TO LIVE & HOW TO EAT
(JUST LIKE HE MADE ME DO) OH, WELL !!!"**

Since his dismissal, Applicant submitted this unauthorized "Intent to Use" application with the United States Patent & Trademark Office. Four days later, Applicant filed a small claims suit in Superior Court of California, in the County of Riverside, against the Opposer for an alleged "breach of contract" concerning his participation in Opposer's band "The Superfreaks" - the very service mark name that is the subject of this opposition. The judge ruled in favor of the Opposer. Applicant's case was so frivolous and without merit that the judge told the Opposer that he did not have to hear from him at all because there was nothing to defend. The judge also strongly suggested to the Applicant that he just "move on" (Please see judgement). Prior to the small claims court hearing, Applicant had harassed the Opposer, band members, and third party venues, which prompted the Opposer to file a counter claim for Applicant's "intentional interference" with the Opposer's livelihood (see Opposer's counter claim). The judge told the Opposer that he could only rule in Opposer's favor when the Opposer actually lost a job due to Applicant's interference. In other words, there were no actual monetary damages, at that time, as a result of Applicant's intentional interference with third parties. After losing his case in small claims court, Applicant harassed some of Opposer's new clients. Applicant harassed members of the band by showing up to a venue where the band was performing. Applicant also committed fraud upon the office of the USPTO, and upon Opposer's clients, by falsely claiming to be the owner of a Federal Registration of the Service Mark "The Superfreaks" (please see affidavit from Timmy Daniels). Through all of these actions, Applicant has shown malicious intent. Applicant has been persistent in his attempts to disrupt, defame, and cause injury to the Opposer's band because Applicant wants, in his own words, "PAY BACK" from Opposer for being dismissed from the band.

2) **Bad Faith Use and Registration**: Applicant has filed his application in bad faith. The Opposer contends that the applicant's malicious conduct evidences bad faith registration and use of the disputed mark. Specifically, Applicant's bad faith is evidenced by:

- (a) the applicant's filing of a false oath in his USPTO "Intent to Use" Federal Registration application by purposely failing to identify the conflicting rights of Opposer in the

mark. Applicant filed an application to register a mark which he knew infringed on the superior rights of the Opposer. Specifically, paragraph of the declaration expressly states as follows:

he/she believes the applicant to be entitled to use such mark in commerce; 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, . . . (see application serial # 78110344 dated 2/22/02)

(b) Applicant adopted the Opposer's service mark name in a bad faith attempt to take advantage of the excellent reputation, popularity, and goodwill that is associated with the Opposer's service mark "The Superfreaks".

(c) Applicant ignored Opposer's "cease and desist" letter, mailed on September 12, 2002, by not withdrawing his fraudulent application with the USPTO (see copy of "cease and desist" letter).

(d) Applicant committed fraud upon the office of the USPTO, and upon Opposer's clients, when he falsely claimed to be the owner of a Federal Registration of the Service Mark "The Superfreaks" for the purpose of disrupting the Opposer's business. At the time that Applicant made his claim of ownership of a Federal Registration, his application was still pending and had merely been assigned to an examining attorney at the USPTO.

(e) Applicant made several phone calls and mailed notices to the Opposer's clients, and the Opposer, claiming to be the owner of a Federal Trademark for the Service Mark "The Superfreaks". Applicant demanded that these clients stop hiring the Opposer's band and warned them that it was unlawful to continue to hire the Opposer's band. Applicant was trying to intimidate the band's clients so that they would be afraid to continue to hire the band thus hurting the Opposer's business.

3) Prior Use. Opposer, asserts common law superior rights of ownership of the Service Mark "The Superfreaks". Operating as owner, Opposer founded his band "The Superfreaks" in August of 1999. Opposer, inspired by the popular Rick James song "Superfreak," named his

band "The Superfreaks". Opposer is the owner of a Certificate of Registration from the State of California (see State Reg. No. 056707 for Class: Int'l. 41) for the Service Mark "The Superfreaks." Opposer has used the Service Mark "The Superfreaks" exclusively and continuously since August of 1999. The band's first paid gig was on October 15, 1999. Opposer used the Service Mark "The Superfreaks" in interstate commerce for the first time on December 31, 1999 in Laughlin, Nevada. Opposer is, and has always been, solely responsible for all of the band's expenses; including all costs related to marketing, legal expenses, promotion, advertising, back-line, P.A./sound equipment, banners, stage props, etc. In addition, Opposer is solely responsible for reporting income earned to the Internal Revenue Service through the filing of 1099's for each musician. Opposer has always had sole discretion and control over both the nature and quality of the band's performances, as well as, the use of the service mark "The Superfreaks."

4) Applicant is Not the Owner of the Mark: Per 15 U.S.C. s1051; TMEP 1201, application must be declared void. Only the owner of the mark, or the person entitled to use the mark in commerce as of the application filing date, may file an application for its registration. An application filed by a person who is not the owner of the mark, or not entitled to use the mark in commerce, will be declared void. Generally, the person who uses or controls the use of the mark, and controls the nature and quality of the goods to which it is affixed, or the services for which it is used, is the owner of the mark. The best evidence of "control" is illustrated by the Applicant's failed small claims action wherein he subpoenaed "The Superfreaks" various records which were all in the possession and control of Opposer (see copy of Applicant's small claims subpoena and notarized affidavits from each of "The Superfreaks" band members).

5) Fraudulent USPTO Application: Applicant knowingly made willfull, false, material misrepresentations of fact in his application to Federally Register Opposer's Service Mark "The Superfreaks." The Applicant had an obligation to disclose the existence of the Opposer's band and rights in the mark. Just four days after submitting his unauthorized "Intent to Use" application, in which Applicant was required to submit a signed declaration stating that

Applicant knew of no other person who had the right to use the name in commerce. Applicant filed a small claims suit against Opposer for an alleged breach of contract concerning his participation in the Opposer's band "The Superfreaks" - the very mark that is the subject of this opposition. The Applicant made willfull false statements to the USPTO when he filed fraudulent declarations in his "Intent to Use" application, and during the examination process, with each communication that Applicant submitted to the USPTO (see application for serial # 78110344 dated 2/22/02 and responses to office actions dated 7/21/02, and 9/30/02 in Applicant's file). Applicant made fraudulent claims to Opposer's clients, committing fraud upon the office of the USPTO and Opposer's clients, when he asserted that he was the owner of a Federal Registration for the Service Mark "The Superfreaks" though he clearly was not. Because of this and Applicant's other malicious efforts against the Opposer, Applicant's failure to identify the Opposer's superior rights in the Service Mark "The Superfreaks" cannot be interpreted as a misunderstanding, an inadvertance or a mere negligent omission. As shown through his pattern of various malicious actions outlined in this opposition, Applicant has spent most of the past year trying to disrupt and defame the Opposer's business while attempting to profit from the Opposer's strong goodwill in it's service mark "The Superfreaks."

6) No Rights: Opposer contends that the Applicant has no rights in the Service Mark "The Superfreaks" because the Applicant's application was filed solely based on "Intent to Use" and there is no record of competent evidence of actual use of the mark prior to the filing date of his application.

7) Likelihood of Confusion: Opposer asserts that Applicant's proposed service mark, when applied to Applicant's services, is identical (except for the descriptive words "funky disco revue") to Opposer's previously used service mark "The Superfreaks" for "entertainment services in the nature of live disco music from the '70s and '80s as performed by live musicians," as to be

likely to cause confusion, under Section 2(d) of the Trademark Act. Proof of the descriptive nature of the words “funky disco revue” is the fact that these same words are often used by the Opposer to describe its services when promoting the band’s performances (ex; The Superfreaks will keep you groovin’ to the funky disco beat). The applicant’s USPTO service mark application is identical to the Opposer’s service mark in every way: same classification of service - Int’l. 41, same geographic area (both parties are based in Riverside County), both perform Disco, Funk, and ‘80s hits wearing costumes from the Disco era and both appeal to the same class of consumers; casinos, nightclubs, private events, birthday parties, etc. Given all of these facts, it is inevitable that reasonable consumers would be confused. As further proof of likelihood of confusion is a phone conversation held on September 13, 2002, between the Applicant and Opposer’s attorney Chris J. Connolly, the same day that Applicant received Opposer’s “cease and desist” letter (see enclosed copy of letter). Applicant stated that there was confusion among the venues and alleged that he had lost “7 to 8 jobs” because, when he called to inquire about gigs at various venues, he was told that they’d already spoken to the Opposer’s band “The Superfreaks”. Applicant could have used any other name, but instead chose to use the Opposer’s name in order to take advantage of the Opposer’s strong goodwill in the mark while disrupting the Opposer’s livelihood. Opposer has expended significant time, money, and labor in building goodwill resulting in the success of the band. Just a few examples of the success that “The Superfreaks” band has enjoyed: an extended engagement at one of Orange County’s most popular nightclubs The Crazy Horse in Irvine; entertaining audiences of between 800 - 1000 people every single weekend consistently (live broadcast on popular Orange County radio station COOL 94.3 FM) for 1 year & 8 months, also the band has spent the past year performing twice a month at one of Southern California’s most popular casinos Pala Casino in San Diego. Pala Casino also chose “The Superfreaks” to perform as the featured entertainment on “New Year’s Eve” for two consecutive years. This year as part of Pala Casino’s promotion for their “New Year’s Eve” celebration, a color photo of “The Superfreaks” band was displayed on the casino’s large vegas-style electronic billboard that stands in front of the casino. The

billboard is easily viewed by, not only, the casino's patrons but everyone who drives by the casino which is approximately 10,000 cars a day, (according to an article re: local traffic, published in the North County Times newspaper on 4/02/02). The Opposer's band is so popular that the Pala Indian's Tribal Chief hand-picked "The Superfreaks" to perform at his own wedding reception in 2002. "The Superfreaks" service mark name has also been heard over the radio in ads and seen in newspaper print ads purchased by venues, as well as the Opposer, to promote the band's performances in the last year. The Applicant is motivated by all of these facts regarding the Opposer's band's strong goodwill and reputation in its service mark. Using a name that is well-established, popular and well-known in commerce would make it much easier for the Applicant to get work.

8) Unfair Competition: Opposer contends that it would be unfair competition to allow the Applicant to receive the benefit of the Opposer's significant time (nearly 3 1/2 years), money, and labor spent in building goodwill in the Service Mark "The Superfreaks". The Opposer's band has built solid goodwill in its service mark through it's many performances including extended engagements at popular venues like: The Crazy Horse in Irvine (1 year & 8 months of consistent weekly performances), The Promenade Mall "Live at The Plaza" entertainment series (bi-monthly performances for two consecutive years), Pala Casino in San Diego, (bi-monthly performances for the past year including two New Year's Eve performances and a special performance for Pala Casino's VIP's), in addition to the many private events, weddings, corporate functions, birthdays, etc. Applicant's intention is to profit from the goodwill and reputation of the Opposer's service mark while disrupting Opposer's business by fraudulently obtaining Federal Registration of Opposer's service mark.

9) Deceptive Trade Practices: Opposer contends that the Applicant is attempting to deceive and mislead the public by using Opposer's well-known service mark "The Superfreaks" in order to obtain work and disrupt Opposer's business. Because the name of the Opposer's band "The Superfreaks" is already well-known and established for its quality entertainment services, which

would facilitate Applicant's ability to get work, the Applicant has chosen to fraudulently seek registration of Opposer's mark. Since both bands perform in costume, it would be even easier to deceive the consumer into believing that Applicant's band was the same as Opposer's well-known band "The Superfreaks."

By Joe J. Alfaro, Jr. Date 1-15-03
Joe J. Alfaro, Jr.
Owner of the band "The Superfreaks"

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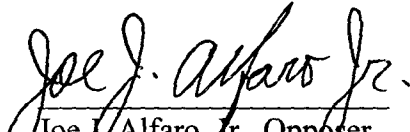
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For the mark "**Superfreaks Funky Disco Revue**" ✓
Published in the Official Gazette on **December 17, 2002**
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Applicant: **Guy A. Hoffmann**


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NOTICE OF OPPOSITION
(including affidavits and exhibits)
filed by **Joe J. Alfaro, Jr., Opposer**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as "Express Mail" in an envelope addressed, Box TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on the date shown below.



Joe J. Alfaro, Jr., Opposer
1-15-03

Date