

ESTTA Tracking number: **ESTTA5144**

Filing date: **01/28/2004**

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

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Name	Carrabba's Italian Grill, Inc
Granted to Date of previous extension	01/28/2004
Address	Carrabba's Italian Grill, Inc 2202 N. West Shore Boulevard Suite 500 Tampa, FL 33607 UNITED STATES

Attorney information	Rosanne T. Yang Baker & Hostetler LLP 65 E. State St., Ste. 2100 Columbus, OH 43215 UNITED STATES ryang@bakerlaw.com Phone:614-462-2684
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Applicant Information

Application No	76404261	Publication date	09/30/2003
Opposition Filing Date	01/28/2004	Opposition Period Ends	01/28/2004
Applicant	Caramba Restaurant Inc.		
Address	P.O. Box 1280 4318 Main Street Town Plaza, Whistler, BC CANADA		

Goods/Services Affected by Opposition

Class 035. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: retail gift shops featuring souvenir clothing and packaged foods

Class 043. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: restaurant services, namely, restaurants featuring primarily Mediterranean style cuisine

Attachments

Notice of Opposition.pdf (4 pages)

Exhibit A.pdf (1 page)

Exhibit B.pdf (1 page)

Exhibit C.pdf (1 page)

Exhibit D.pdf (1 page)

Exhibit E.pdf (2 pages)

Exhibit F.pdf (2 pages)

Exhibit G.pdf (2 pages)

the United States. As an Italian grill restaurant, Carrabba’s cuisine can be described as Mediterranean-style.

4. Carrabba’s has adopted and is using many well-known marks including “CARRABBA’S” for goods and services in addition to its restaurant services. Carrabba’s is the owner of record of the following registrations and applications with United States Patent and Trademark Office:

Trademark:	Class:	Reg. or App. No:	App. Date:	First Use Date:	Goods:
CARRABBA'S	25, 42	1795108	10-Feb-1993	01-Jun-1987 26-Dec-1986	Clothing; namely, caps, sport shirts, sweatshirts, and t-shirts Restaurant and catering services
CARRABBA'S ITALIAN GRILL AND DESIGN	25, 42	1865848	25-Oct-1993	14-Oct-1993 05-Oct-1993	Clothing; namely, caps, sports shirts, sweatshirts, and t-shirts Restaurant and catering services
CARRABBA'S ITALIAN GRILL AND DESIGN	42	2086036	23-Sep-1996	22-Jul-1996	Restaurant and catering services
CARRABBA'S ITALIAN GRILL AND DESIGN	25	2091159	26-Aug-1996	22-Jul-1996	Clothing, namely caps, sport shirts, sweatshirts and t-shirts
CARRABBA'S ITALIAN GRILL	43	78223913	11-Mar-2003	01-Jun-1987	Dine in, carry out and catering restaurant services
CARRABBA'S ITALIAN GRILL AND DESIGN	43	78300808	16-Sep-2003	01-Jan-1994	Dine in, carry out and catering restaurant services
CARRABBA'S ITALIAN GRILL AND DESIGN	43	78282635	04-Aug-2003	01-Jan-1994	Dine in, carry out and catering restaurant services

All marks listed above are collectively referred to as the “Carrabba’s Marks.”

5. Attached as Exhibits A through G are true and accurate copies of the registrations for the Carrabba’s Marks and printouts from TARR regarding the applications listed above.

6. Carrabba’s goods and services have over the past several years been highly publicized. By virtue of its promotion, advertising, and continuous use of its Carrabba’s Marks in its more than 100 restaurants and on clothing items, Carrabba’s has acquired much notoriety and a most valuable reputation under its Carrabba’s Marks.

7. Carrabba's has been continuously using the mark CARRABBA'S since December 1986 and is continuously expanding its use of the mark CARRABBA'S.

8. There is no issue as to priority. The date of Applicant's application is subsequent to the issuance date of each of Carrabba's registrations and to the first use or filing dates of the Carrabba's Marks listed above.

CLAIM I

9. The mark CARAMBA! RESTAURANTE, if used by Applicant for its specified services, is a reproduction, copy, and colorful imitation of the Carrabba's Marks. Applicant's use of CARAMBA! RESTAURANTE is likely to cause confusion, mistake, or deception with respect to the origin of said services, and to confuse, mislead, and deceive members of the public into believing that Applicant's services have been produced, sold, sponsored, approved, or licensed by Carrabba's or are in some way connected to or affiliated with Carrabba's. Any such confusion would result in injury to or have a direct impact on Carrabba's reputation and its ability to market these services. Furthermore, any defect, objection, or fault found with Applicant's services marketed under its CARAMBA! RESTAURANTE mark would negatively impact and seriously injure the reputation Carrabba's has established for the goods and services it sells under the Carrabba's Marks.

10. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive rights to use CARAMBA! RESTAURANTE. Such registration would be a source of damage and injury to Carrabba's.

CLAIM II

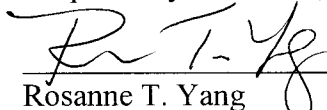
11. Carrabba's repeats and re-alleges each and every allegation set forth in paragraphs 1 through 10.

12. The Carrabba's Marks are distinctive and famous. They have been in use for over 17 years throughout the United States in connection with Carrabba's restaurant services and clothing. Additionally, the Carrabba's Marks have been advertised for over 17 years in the United States and on the Internet, and they are well-known to the trade and members of the consuming public. In addition, one or more of the Carrabba's Marks has been registered on the principal registry with the United States Patent and Trademark Office since 1993. The public generally associates and identifies the Carrabba's Marks with Carrabba's.

13. Applicant's mark constitutes a dilution of the Carrabba's Marks, in violation of 15 U.S.C. §1125(c), in that Applicant's use dilutes the distinctive quality of the Carrabba's Marks by diminishing Carrabba's ability to identify and distinguish its products and services.

WHEREFORE, Carrabba's prays that this Opposition be granted and Application Serial No. 76/404,261 be refused registration.

Respectfully submitted,

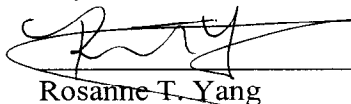


Rosanne T. Yang
Baker & Hostetler LLP
65 East State Street, Suite 2100
Columbus, Ohio 43215
(614) 462-2684 (Telephone)
(614) 462-2616 (Facsimile)
ryang@bakerlaw.com

Attorney for Carrabba's Italian Grill, Inc.

CERTIFICATE OF FILING

I certify that the foregoing Notice of Opposition was filed with the Commissioner for Trademarks, through ESTTA on this 28 day of January 2004.



Rosanne T. Yang

Int. Cls.: 25 and 42

Prior U.S. Cls.: 39 and 100

United States Patent and Trademark Office **Reg. No. 1,795,108**
Registered Sep. 28, 1993

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

CARRABBA'S

CARRABBA, INC. (TEXAS CORPORATION)
3125 KIRBY DRIVE
HOUSTON, TX 77098

FOR: CLOTHING; NAMELY, CAPS, SPORT
SHIRTS, SWEATSHIRTS, AND T-SHIRTS, IN
CLASS 25 (U.S. CL. 39).

FIRST USE 6-1-1987; IN COMMERCE
6-1-1987.

FOR: RESTAURANT AND CATERING
SERVICES, IN CLASS 42 (U.S. CL. 100).
FIRST USE 12-26-1986; IN COMMERCE
12-26-1986.
SEC. 2(F).

SER. NO. 74-357,605, FILED 2-10-1993.

ELEANOR MELTZER, EXAMINING ATTOR-
NEY

Int. Cls.: 25 and 42

Prior U.S. Cls.: 39 and 100

United States Patent and Trademark Office

Reg. No. 1,865,848

Registered Dec. 6, 1994

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER



CARRABBA/OUTBACK JOINT VENTURE
(PARTNERSHIP)
3125 KIRBY DRIVE
HOUSTON, TX 77098

FOR: CLOTHING; NAMELY, CAPS, SPORTS
SHIRTS, SWEATSHIRTS, AND T-SHIRTS, IN
CLASS 25 (U.S. CL. 39).

FIRST USE 10-14-1993; IN COMMERCE
10-14-1993.

FOR: RESTAURANT AND CATERING
SERVICES, IN CLASS 42 (U.S. CL. 100).

FIRST USE 10-5-1993; IN COMMERCE
10-5-1993.

OWNER OF U.S. REG. NOS. 1,795,108 AND
1,804,367.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "ITALIAN GRILL", APART
FROM THE MARK AS SHOWN.

SEC. 2(F).

SER. NO. 74-450,131, FILED 10-25-1993.

LESLEY LAMOTHE, EXAMINING ATTORNEY

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,086,036

United States Patent and Trademark Office

Registered Aug. 5, 1997

**SERVICE MARK
PRINCIPAL REGISTER**



CARRABBA'S ITALIAN GRILL, INC. (FLORIDA CORPORATION)
550 NORTH REO STREET, SUITE 204
TAMPA, FL 33609

FOR: RESTAURANT AND CATERING SERVICES, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 7-22-1996; IN COMMERCE 7-22-1996.

OWNER OF U.S. REG. NOS. 1,795,108, 1,804,367, AND 1,865,848.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ITALIAN GRILL", APART FROM THE MARK AS SHOWN.
SEC. 2(F).

SER. NO. 75-170,269, FILED 9-23-1996.

DIANE B. MELNICK, EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,091,159

United States Patent and Trademark Office

Registered Aug. 26, 1997

**TRADEMARK
PRINCIPAL REGISTER**



CARRABBA'S ITALIAN GRILL, INC. (FLORIDA CORPORATION)
550 NORTH REO STREET SUITE 204
TAMPA, FL 33609

OWNER OF U.S. REG. NOS. 1,795,108,
1,804,367, AND 1,865,848.

SEC. 2(F).

FOR: CLOTHING, NAMELY, CAPS, SPORTS
SHIRTS, SWEATSHIRTS AND T-SHIRTS, IN
CLASS 25 (U.S. CLS. 22 AND 39).

SER. NO. 75-155,486, FILED 8-26-1996.

FIRST USE 7-22-1996; IN COMMERCE
7-22-1996.

DIANE B. MELNICK, EXAMINING ATTORNEY

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-01-27 15:47:22 ET

Serial Number: 78223913

Registration Number: (NOT AVAILABLE)

Mark (words only): CARRABBA'S ITALIAN GRILL

Standard Character claim: No

Current Status: Application has been published for opposition.

Date of Status: 2003-12-02

Filing Date: 2003-03-11

The Information will be/was published in the Official Gazette on 2003-12-02

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

Attorney Assigned:

BUSH KAREN K Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2003-10-22

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Carrabba's Italian Grill, Inc.

Address:

Carrabba's Italian Grill, Inc.
2202 N. West Shore Blvd., 5th Floor
Tampa, FL 33607
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Florida

Phone Number: 813-282-1225

Fax Number: 813-281-2114

GOODS AND/OR SERVICES

Dine in, carry out and catering restaurant services

International Class: 043

First Use Date: 1987-06-01

First Use in Commerce Date: 1987-06-01

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "ITALIAN GRILL"

Section 2(f): as to "CARRABBA'S"

Prior Registration Number(s):

1795108

1804367

1865848

2086036

2091159

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-12-02 - Published for opposition

2003-11-12 - Notice of publication

2003-09-16 - Approved for Pub - Principal Register (Initial exam)

2003-09-08 - Examiners amendment e-mailed

2003-09-02 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Kelly B. Lefferts (Attorney of record)

Kelly B. Lefferts

Outback Steakhouse, Inc.

2202 N. West Shore Blvd., 5th Floor

Tampa FL USA 33607

Phone Number: 813-282-1225

Fax Number: 813-281-2114

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-01-27 15:48:42 ET

Serial Number: 78282635

Registration Number: (NOT AVAILABLE)

Mark



(words only): CARRABBA'S ITALIAN GRILL

Standard Character claim: No

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2003-09-10

Filing Date: 2003-08-04

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

Attorney Assigned:
BUSH KAREN K Employee Location

Current Location: L5D -TMEG Law Office 105 - Docket Clerk

Date In Location: 2003-09-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Carrabba's Italian Grill, Inc.

Address:
Carrabba's Italian Grill, Inc.
Suite 500 2202 N. West Shore Blvd.
Tampa, FL 336075761

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Florida

Phone Number: 813-282-1225

Fax Number: 813-281-2114

GOODS AND/OR SERVICES

Dine in, carry out and catering restaurant services

International Class: 043

First Use Date: 1994-01-01

First Use in Commerce Date: 1994-01-01

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "ITALIAN GRILL"

Section 2(f): CARABBA"S

Prior Registration Number(s):

1795108

1804367

1865848

2086036

2091159

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2003-09-10 - Non-final action e-mailed

2003-09-08 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

Kelly B. Lefferts (Attorney of record)

Kelly B. Lefferts

Outback Steakhouse, Inc.

Suite 500

2202 N. West Shore Blvd.

Tampa, FL 33607-5761

Phone Number: 813-282-1225

Fax Number: 813-281-2114

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-01-27 15:48:11 ET

Serial Number: 78300808

Registration Number: (NOT AVAILABLE)

Mark



(words only): CARRABBA'S ITALIAN GRILL

Standard Character claim: No

Current Status: Newly filed application, not yet assigned to an examining attorney.

Date of Status: 2003-10-01

Filing Date: 2003-09-16

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: L5R -TMEG Law Office 105 - Review And Amendment

Date In Location: 2003-12-10

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Carrabba's Italian Grill, Inc.

Address:

Carrabba's Italian Grill, Inc.
Suite 500 2202 N. West Shore Boulevard
Tampa, FL 336075761
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Florida

Phone Number: 813-282-1225

Fax Number: 813-281-2114

GOODS AND/OR SERVICES

Dine in, carry-out and catering restaurant services

International Class: 043

First Use Date: 1994-01-01

First Use in Commerce Date: 1994-01-01

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "Italian Grill"

Prior Registration Number(s):

1795108

1804367

1865848

2086036

2091159

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

(NOT AVAILABLE)

CONTACT INFORMATION

Correspondent (Owner)

Kelly B. Lefferts (Attorney of record)

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