

ESTTA Tracking number: **ESTTA60366**

Filing date: **01/04/2006**

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

**Notice of Opposition**

Notice is hereby given that the following parties oppose registration of the indicated application.

**Opposers Information**

Name	OS Asset, Inc.
Granted to Date of previous extension	01/04/2006
Address	2202 N. Westshore Blvd., 5th Floor Tampa, FL 33609 UNITED STATES

Name	Outback Steakhouse of Florida, Inc.
Granted to Date of previous extension	01/04/2006
Address	2202 N. Westshore Blvd., 5th Floor Tampa, FL 33609 UNITED STATES

Attorney information	Rosanne T. Yang Baker & Hostetler LLP Capitol Square Suite 2100 65 E. State Street Columbus, OH 43215 UNITED STATES columbusip@bakerlaw.com Phone:614-462-2684
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**Applicant Information**

Application No	76578890	Publication date	09/06/2005
Opposition Filing Date	01/04/2006	Opposition Period Ends	01/04/2006
Applicant	Colts & Old Port Cigar Company Inc. c/o James D. Murphy 44 Chipman Hill, 10th Floor P.O. Box 7289, Stn. "A" Saint John, New Brunswick E2L 4S6, CANADA		

**Goods/Services Affected by Opposition**

Class 034. All goods and services in the class are opposed, namely: cigars, cigarillos, ashtrays not of precious metal, matches
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Attachments	OUTBACKCI34Opp.pdf ( 7 pages ) OUTBACKExA.pdf ( 9 pages )
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Signature	/ttabob34rty/
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Name	Rosanne T. Yang
Date	01/04/2006

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

In The Matter Of Application Serial No. 76578890  
Published In The *Official Gazette*, September 6, 2005

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OS Asset, Inc. and	)	Opposition No. _____
Outback Steakhouse of Florida, Inc.	)	
	)	
Opposers,	)	
	)	
v.	)	NOTICE OF OPPOSITION
	)	
Colts & Old Port Cigar Company Inc.	)	
	)	
Applicant.	)	

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OS Asset, Inc. and Outback Steakhouse of Florida, Inc., Florida corporations, whose principal address is 2202 North Westshore Boulevard, 5<sup>th</sup> Floor, Tampa, Florida 33607, believe that they will be damaged by the registration of the mark covered by Application Serial No. 76/578,890 and hereby oppose the registration of said mark. As grounds for the opposition it is alleged as follows:

1. OS Asset, Inc. has acquired certain of Outback Steakhouse of Florida, Inc.’s applications and registrations through an assignment entered into by agreement on October 1, 1999. Outback Steakhouse of Florida, Inc. is the exclusive licensee of OS Asset, Inc. with respect to various OUTBACK and OUTBACK STEAKHOUSE trademarks discussed herein. (OS Asset, Inc. and Outback Steakhouse of Florida, Inc. are collectively referred to herein as “Outback”).

2. Applicant seeks to register OUTBACK as a trademark for “cigars, cigarillos, ashtrays not of precious metal, matches” in International Class 34. The filing date of Applicant’s application is March 3, 2004.

3. Outback is in the business of operating and franchising a well-known and highly successful chain of restaurants under the name OUTBACK STEAKHOUSE. Outback’s chain has grown rapidly over the last sixteen years and there are now more than 700 Outback restaurants operating in the United States, and more than 100 Outback restaurants operating internationally in more than 20 countries and territories.

4. Outback has adopted and is using many well-known marks including “OUTBACK” for a variety of goods and services in addition to its restaurant services. Outback is the owner of record of many marks, including but not limited to the following registrations with United States Patent and Trademark Office:

Trademark Name:	Class:	Reg. No:	App. Date:	First Use Date:	Goods/services:
OUTBACK	42	2052618	05/07/96	03/15/88	Dine in and carry out restaurant services
OUTBACK STEAKHOUSE	42	1523949	04/06/88	03/15/88	Restaurant and bar services
OUTBACK STEAKHOUSE AND KANGAROO DESIGN	42	1780666	04/28/89	03/15/88	Restaurant and bar services
OUTBACK	32	2742171	12/16/97	05/01/01	Beer
OUTBACK STEAKHOUSE and Design	32	2742172	12/19/97	05/01/01	Beer
OUTBACK BOWL	41	2044694	04/20/95	09/07/85	Entertainment services in the nature of collegiate post season football games and festivals
OUTBACK BOWL and Design	41	2044787	05/16/95	09/07/95	Entertainment services in the nature of collegiate post season football games and festivals
OUTBACK SPORTS	35, 41	2579010	12/16/97	03/31/01	Promoting sports competitions and/or events of others (class 35)  Physical education services, namely, providing sports lessons and entertainment in the nature of golf

Trademark Name:	Class:	Reg. No:	App. Date:	First Use Date:	Goods/services:
					games (class 41)
OUTBACK GRILLERS	29	2232347	04/17/98	01/28/98	Prepared entrees containing primarily beef and chicken, with vegetables
OUTBACK PRIME	29	2005889	08/10/95	07/01/95	Prepared entrees consisting primarily of lamb, beef and veal
OUTBACK RACK	29	1993032	06/28/95	11/30/94	Prepared entrees consisting primarily of lamb
OUTBACK	30	2020110	01/18/94	03/05/94	Baked goods; namely, bread, biscuits and rolls
DOWN UNDER CATERING BY OUTBACK	42	2296761	12/16/97	11/14/97	Catering services
OUTBACK CATERING	42	2428109	08/19/99	12/18/98	Catering services
OUTBACK BOWL	18	2049759	05/16/95	12/12/96	All purpose athletic bags
OUTBACK BOWL	24	2058048	04/20/95	01/01/96	Cloth pennants
OUTBACK BOWL	26	2109478	04/20/95	04/12/95	Patches for clothing
OUTBACK BOWL	18	2044693	04/20/95	12/26/95	All purpose athletic bags
OUTBACK BOWL	14	2044692	04/20/95	04/12/95	Jewelry, namely rings, watches, precious metal money clips and pendants
OUTBACK BOWL	21	2044691	04/20/95	04/12/95	Cups and mugs
OUTBACK BOWL	25	2044690	01/28/94	04/12/95	Clothing, namely hats, t-shirts, sweatshirts and jackets
OUTBACK BOWL and Design	26	2058094	05/16/95	01/01/96	Patches for clothes
OUTBACK BOWL and Design	25	2044788	05/16/95	01/01/96	Clothing, namely, hats, t-shirts, sweatshirts and jackets
OUTBACK BOWL and Design	14	2049758	05/16/95	09/07/96	Jewelry, namely, rings, watches, precious metal money clips, and pendants
OUTBACK BOWL and Design	21	2044786	05/16/95	01/01/96	Cups and mugs
OUTBACK BOWL and Design	24	2088079	05/16/95	01/01/96	Cloth pennants
OUTBACK CATERING AND DESIGN	42	2448754	08/19/99	12/18/98	Catering services
OUTBACK STEAKHOUSE	25	1992707	03/09/95	11/14/89	Clothing, namely t-shirts, jackets, boxer shorts, sweatshirts, hats, sport shirts, tennis shoes and sweaters
OUTBACK STEAKHOUSE	21	2017992	02/05/96	12/31/88	Ceramic mugs
OUTBACK STEAKHOUSE	25	2052887	07/08/96	12/31/93	Clothing, namely t-shirts and baseball caps

Trademark Name:	Class:	Reg. No:	App. Date:	First Use Date:	Goods/services:
AND DREAMTIME DESIGN					
OUTBACK STEAKHOUSE AND DREAMTIME II DESIGN	25	2052888	07/08/96	07/31/95	Clothing, namely t-shirts and baseball caps
OUTBACK STEAKHOUSE AND KANGAROO DESIGN	25	1895164	07/30/93	01/14/89	Clothing, namely t-shirts, jackets, boxer shorts, sweatshirts, hats, sport shirts, tennis shoes and sweaters
OUTBACK STEAKHOUSE AND KANGAROO DESIGN	21	2017991	02/05/96	12/31/88	Ceramic mugs

All marks listed above are collectively referred to as the “Outback Marks.”

5. Attached as Exhibit A are true and accurate copies of the registrations for some of the Outback Marks listed above.

6. Outback’s goods and services have over the past several years been highly publicized in prominent magazines and trade journals. By virtue of its nationwide promotion, extensive advertising, and continuous use of its Outback Marks in its more than 700 restaurants, on food and drink items, for sports events, on clothing items, and for various other products and services, Outback has acquired much notoriety and a most valuable reputation under its Outback Marks.

7. Outback has been continuously using the mark OUTBACK since 1988 and is continuously expanding its use of the mark OUTBACK.

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

## CLAIM I

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

10. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use OUTBACK. Such registration would be a source of damage and injury to Outback.

## CLAIM II

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

12. The Outback Marks are distinctive and famous. They have been in use for over sixteen years throughout the United States and worldwide in connection with Outback's restaurant services, drinks, food, clothing, sports-related services, and various other products. Additionally, the Outback Marks have been advertised for over sixteen years throughout the United States and worldwide, including on the Internet and they are well-known to the trade and members of the consuming public. In addition, one or more of the Outback Marks has been

registered on the principal registry with the United States Patent and Trademark Office since 1988. The public generally associates and identifies the Outback Marks with Outback.

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

WHEREFORE, Outback prays that this Opposition be granted and Application Serial No. 76/578,890 be refused registration.

/Rosanne T. Yang/

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Columbus, Ohio 43215  
(614) 228-1541

Attorneys for OS Asset, Inc. and  
Outback Steakhouse of Florida, Inc.

CERTIFICATE OF FILING

I certify that the foregoing Notice of Opposition was filed electronically with the Commissioner for Trademarks, Trademark Trial and Appeal Board, via ESTTA on the 4th day of January 2006.

/Rosanne T. Yang/

Rosanne T. Yang

# **EXHIBIT A**

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

Reg. No. 2,052,618

United States Patent and Trademark Office

Registered Apr. 15, 1997

**SERVICE MARK  
PRINCIPAL REGISTER**

**OUTBACK**

OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
550 NORTH REO STREET, SUITE 204  
TAMPA, FL 33609

FIRST USE 3-15-1988; IN COMMERCE  
3-15-1988.  
OWNER OF U.S. REG. NOS. 1,523,949 AND  
1,780,666.

FOR: DINE IN AND CARRY OUT RESTAU-  
RANT SERVICES, IN CLASS 42 (U.S. CLS. 100  
AND 101).

SER. NO. 75-099,947, FILED 5-7-1996.

KIM SAITO, EXAMINING ATTORNEY

Int. Cl.: 29

Prior U.S. Cl.: 46

**United States Patent and Trademark Office**

**Reg. No. 1,819,091**

**Registered Feb. 1, 1994**

**TRADEMARK  
PRINCIPAL REGISTER**

**THE OUTBACK SPECIAL**

OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
550 NORTH REO STREET  
SUITE 204  
TAMPA, FL 33609 , BY CHANGE OF NAME  
FROM OUTBACK STEAKHOUSE, INC.  
(FLORIDA CORPORATION) TAMPA, FL  
33609

FOR: PREPARED BEEF FOR CONSUMPTION  
ON OR OFF THE PREMISES, IN CLASS  
29 (U.S. CL. 46).

FIRST USE 3-15-1988; IN COMMERCE  
3-15-1988.

OWNER OF U.S. REG. NO. 1,523,949.

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

SER. NO. 74-183,455, FILED 7-9-1991.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 1,992,707

United States Patent and Trademark Office Registered Aug. 13, 1996

**TRADEMARK  
PRINCIPAL REGISTER**

**OUTBACK STEAKHOUSE**

OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
550 NORTH REO STREET, SUITE 204  
TAMPA, FL 33609

FOR: CLOTHING, NAMELY T-SHIRTS,  
JACKETS, BOXER SHORTS, SWEATSHIRTS,  
HATS, SPORT SHIRTS, TENNIS SHOES AND  
SWEATERS, IN CLASS 25 (U.S. CLS. 22 AND  
39).

FIRST USE 4-14-1988; IN COMMERCE  
11-14-1989.

OWNER OF U.S. REG. NOS. 1,523,949 AND  
1,780,666.

SER. NO. 74-643,659, FILED 3-9-1995.

MIDGE BUTLER, EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cl.: 39

**United States Patent and Trademark Office** **Reg. No. 1,895,164**  
Registered May 23, 1995

**TRADEMARK  
PRINCIPAL REGISTER**



OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
550 NORTH REO STREET, SUITE 204  
TAMPA, FL 33609

FOR: CLOTHING, NAMELY T-SHIRTS,  
JACKETS, BOXER SHORTS, SWEATSHIRTS,  
HATS, SPORT SHIRTS, TENNIS SHOES AND  
SWEATERS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 4-14-1988; IN COMMERCE  
11-14-1989.

OWNER OF U.S. REG. NO. 1,523,949.

SER. NO. 74-419,664, FILED 7-30-1993.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

**United States Patent and Trademark Office**

Reg. No. 1,780,666

Registered July 6, 1993

**SERVICE MARK  
PRINCIPAL REGISTER**



OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
SUITE 204  
550 NORTH REO STREET  
TAMPA, FL 33609, BY CHANGE OF NAME  
FROM MULTI-VENTURE PARTNERS, INC.  
(FLORIDA CORPORATION) TAMPA, FL  
33609

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

FIRST USE 3-15-1988; IN COMMERCE  
3-15-1988.

OWNER OF U.S. REG. NO. 1,523,949.

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

SER. NO. 73-796,663, FILED 4-28-1989.

LIZ KULICK, EXAMINING ATTORNEY

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Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,052,887

United States Patent and Trademark Office

Registered Apr. 15, 1997

TRADEMARK  
PRINCIPAL REGISTER



OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
550 NORTH REO STREET, SUITE 204  
TAMPA, FL 33609

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

FIRST USE 12-0-1993; IN COMMERCE  
12-0-1993.

OWNER OF U.S. REG. NOS. 1,895,164 AND  
1,992,707.

THE LINING (OR STIPPLING) SHOWN IN  
THE MARK ON THE DRAWING IS A FEAT-  
URE OF THE MARK AND DOES NOT INDI-  
CATE COLOR.

SER. NO. 75-130,626, FILED 7-8-1996.

KIM SAITO, EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,052,888

United States Patent and Trademark Office

Registered Apr. 15, 1997

TRADEMARK  
PRINCIPAL REGISTER



OUTBACK STEAKHOUSE OF FLORIDA, INC.  
(FLORIDA CORPORATION)  
550 NORTH REO STREET, SUITE 204  
TAMPA, FL 33609

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

FIRST USE 7-0-1995; IN COMMERCE  
7-0-1995.

OWNER OF U.S. REG. NOS. 1,895,164 AND  
1,992,707.

THE LINING (OR STIPPLING) SHOWN IN  
THE MARK ON THE DRAWING IS A FEAT-  
URE OF THE MARK AND DOES NOT INDI-  
CATE COLOR.

SER. NO. 75-130,627, FILED 7-8-1996.

KIM SAITO, EXAMINING ATTORNEY

Int. Cl.: 42

Prior U.S. Cl.: 100

United States Patent and Trademark Office

Reg. No. 1,523,949

Registered Feb. 7, 1989

SERVICE MARK  
PRINCIPAL REGISTER

OUTBACK STEAKHOUSE

MULTI-VENTURE PARTNERS, INC. (FLORIDA  
CORPORATION)  
SUITE 204  
550 NORTH REO STREET  
TAMPA, FL 33609

FOR: RESTAURANT AND BAR SERVICES,  
IN CLASS 42 (U.S. CL. 100).  
FIRST USE 3-15-1988; IN COMMERCE  
3-15-1988.

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

SER. NO. 720,810, FILED 4-6-1988.

CATHERINE PLAMBECK, EXAMINING AT-  
TORNEY