

ESTTA Tracking number: **ESTTA132682**

Filing date: **03/29/2007**

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	JohnMarsico		
Entity	Individual	Citizenship	UNITED STATES
Address	12477 W 83rd Drive Arvada, CO 80005 UNITED STATES		

Name	The Scotchman, LLC		
Entity	LLC	Citizenship	Colorado
Address	12477 W 83rd Drive Arvada, CO 80005 UNITED STATES		

Name	TonyTaddonio		
Entity	Individual	Citizenship	UNITED STATES
Address	P.O. Box 16326 Denver, CO 80216 UNITED STATES		

Name	CarlScaglione		
Entity	Individual	Citizenship	UNITED STATES
Address	4444 Upham Wheat Ridge, CO 80033 UNITED STATES		

Name	MikeHoran		
Entity	Individual	Citizenship	UNITED STATES
Address	12477 W 83rd Drive Arvada, CO 80005 UNITED STATES		

Name	AnthonyScaglione		
Entity	Individual	Citizenship	UNITED STATES
Address	12477 W 83rd Drive Arvada, CO 80005 UNITED STATES		

Attorney information	Ronald M. Rubin RUBIN & ZIMMERMAN, P.C. 9725 E. Hampden Suite 330 Denver, CO 80231 UNITED STATES		
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	ron@rzpc.com Phone:303-306-6191
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## Applicant Information

Application No	78908460	Publication date	03/06/2007
Opposition Filing Date	03/29/2007	Opposition Period Ends	04/05/2007
Applicant	Cerveny, Carl 3425 Moore Street Wheat Ridge, CO 80033 UNITED STATES		

## Goods/Services Affected by Opposition

Class 041. First Use: 2006/06/04 First Use In Commerce: 2006/06/04 Opposed goods and sevicees in the class: Entertainment in the nature of an automobile show
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Attachments	ScotchmanOpposition.PDF ( 4 pages )(283395 bytes ) OppositionExhibits13.pdf ( 13 pages )(411840 bytes )
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Signature	/RMR/
Name	Ronald M. Rubin
Date	03/29/2007

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

In the matter of trademark application Serial No. **78908460**  
For the Mark **SCOTCHMAN**  
Published in the Official Gazette on March 6, 2007

**Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione, and  
The Scotchman, LLC  
(Opposers)**

**v.  
Carl Cerveny  
Applicant**

**Notice of Opposition**

Opposer Information:

Carl Scaglione, Tony Taddonio, John Marsico,  
Mike Horan, Anthony Scaglione and The Scotchman, LLC  
12477 W 83<sup>rd</sup> Drive  
Arvada, CO 80005

The Opposers will be damaged by registration of the mark shown in the above application and oppose the same. The grounds for opposition are as follows:

1. The Scotchman, LLC was formed on May 26, 2006 as a fund raising organization to run, manage, and operate an auto show, highlighting 1960 vintage cars, and then donate the net proceeds to The Ronald McDonald House of Denver Colorado. At or about the same time the LLC was formed, The Scotchman, LLC registered its mark, "Scotchman" in Colorado with the Colorado Secretary of State. See Exhibit A.
2. John Marsico and Carl Scaglione originally conceived of the idea of this auto show and fundraiser in the summer of 2005. See e-mails, Exhibit B & C. The concept was germinated by Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione (the "Group") during the next twelve months.
3. The Ronald McDonald House is a non-profit organization that provides nearby housing and services for families whose children are critically ill and receiving treatment at Children's Hospital.
4. The car show theme was based on the "cruisin' days" of the '60's in Denver where teens, who are now a major donor group of The Ronald McDonald House, cruised through the Scotchman drive-in to showcase their "streetrodders". This drive-in was closed in the 1977 and has not since done business.

5. In order to promote this auto show theme, the Group contacted Carl Cerveny, the prior owner of the defunct Scotchman drive-in and the applicant now pursuing registration of the mark "Scotchman". Mr. Cerveny expressed interest in this charitable endeavor that assists families in need of housing while their child is receiving critical care at Children's Hospital. Mr. Cerveny participated in the first Scotchman auto show, in June, 2006, as the prior owner of the drive-in restaurant of the 70's, not as the owner or sponsor of the show using the mark.
6. The auto show was formally named the "Scotchman Reunion Car/Motorcycle Show" and was held at Bandimere Speedway in Denver, Colorado on June 4, 2006. Many of the expenses (e.g. advertising and trophies) were paid and/or underwritten by individual members of the Group in 2005 and 2006. See Exhibits D, E, and F. The mailing address for the registration of entrants who wanted to display their streetrodders, P.O. Box 16326, is a post office box of Mile Hi Frozen Foods, Co, the business of Mr. Taddonio, used for the Ronald McDonald House. See Exhibit H.
7. The advertising for the June 4, 2006 Scotchman Reunion Car/Motorcycle Show referenced the Ronald McDonald House and Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, Anthony Scaglione, and/or Carl Cerveny. The advertising directed that checks be made payable to the Ronald McDonald House. See Exhibits G, H, & I.
8. Mr. Cerveny claims use since June 6, 2006. However, the use was not his but that of Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione and The Scotchman, LLC. The use of the mark started in 2005 and was later included in advertising materials for the show in 2006 and of course at the Scotchman Reunion Car/Motorcycle Show (e.g. banners, etc.).
9. The Specimen submitted by Mr. Cerveny in his application lists not his phone number but upon information and belief a forwarding service.
10. It is submitted that Mr. Cerveny's allegations of use in his application for registration of the mark is not accurate and was done in bad faith. The use was that of Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione and The Scotchman.
11. The June 4, 2006 Show netted in excess of \$16,000, which was donated to The Ronald McDonald House. Due to this success, the Group and The Scotchman, LLC decided to make this an annual event to benefit The Ronald McDonald House with the next auto show planned for the summer of 2007. When presented with this, Carl Cerveny indicated that he did not desire to do so if money was to be donated to the Ronald McDonald House and if he couldn't personally make any money from the Show. He then indicated his intent to establish a personal, for profit, auto show with the same name and theme as the show sponsored by the Group in 2006 to benefit the Ronald McDonald House.
12. Ten days after the June, 2006 Scotchman Reunion Car/Motorcycle Show, Carl Cerveny submitted an application for registration of the mark Scotchman for "auto show services".

13. The products and services in conjunction with this mark were first offered by Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione prior to Mr. Cerveny's application for registration of the mark and they acquired common law rights to that mark prior to the trademark application in question
14. Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione, and The Scotchman, LLC have expended substantial sums of money and time in advertising the goods and services of Scotchman Reunion Car/Motorcycle Show throughout Colorado and even nationally including, but not limited to, brochures, printed materials, radio presentations, and banners for prior to and at the June 4, 2006 Scotchman Reunion Car/Motorcycle Show.
15. The Group and The Scotchman, LLC have acquired a common law right to the mark.
16. Our courts have long recognized the coexistence between common law rights and rights under the Lanham Act. The exclusive right to a distinctive mark belongs to the party which first uses the mark in connection with its particular line of business. *McLean v. Fleming*, 96 U.S. 245 (1877).
17. Use is "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a mark . . . a mark shall be deemed to be in use in commerce . . . on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce." 15 U.S.C. 1127.
18. Ownership of a trademark arises when goods or services bearing the mark are "sold, displayed for sale, or otherwise publicly distributed". *Blue Bell v. Farah Manufacturing Co., Inc.*, 508 F.2d 1260, 1265 (5th Cir. 1975).
19. As stated in *Allard Enterprises, Inc. v. Advanced Programming Resources, Inc.*, 146 F.3d 350 (6<sup>th</sup> Cir, 1998):

As long as there is a genuine use of the mark in commerce, however, ownership may be established even if the first uses are not extensive and do not result in deep market penetration or widespread recognition...the exclusive right to a trademark belongs to one who first uses it in connection with specified goods. Such use need not have gained wide public recognition, and even a single use in trade may sustain trademark rights if followed by continuous commercial utilization. @358
20. The Group and Scotchman, LLC own the mark, "Scotchman" in relation to auto show services as established by their common law use of "Scotchman Reunion Car/Motorcycle Show" prior to the application of Mr. Cerveny. The mark was conceived in 2005 and used in commerce in early 2006.

21. Appellant's service mark is the same as Opposers' previously used mark. Registration of, and use by Applicant of the identical mark:

- will likely cause confusion or mistake with the mark of Opposers;
- will result in deception of purchasers or users of the products and services;
- will disparage or falsely suggest a connection with Opposers' auto show and mark;
- will interfere with the continuous use of the mark by Opposers that as has been used for over one and a half years; and
- will damage the established rights of opposers to the mark.

22. The basic goal of the Lanham Act is the protection of trademarks, securing to the owner the good will of his business and protecting the public against spurious and falsely marked goods. Registration must be refused where confusion is likely because of concurrent use of the mark of an applicant the prior use by another. See *E.I. duPont de Nemours and Co* 476 F.2d 1357 (CCPA 1973).

23. Prior use by an opposer may be a basis for denying registration. *Universal Overall Co. v. Stonecutter Mills Corp.*, 310 F.2d 952 (C.C.P.A., 1962); *Popular Merchandise Company v. "21" Club, Inc.*, 343 F.2d 1011 (C.C.P.A., 1965)

Based on the aforesaid, Carl Scaglione, Tony Taddonio, John Marsico, Mike Horan, and Anthony Scaglione, and The Scotchman, LLC would be damaged by the registration of the Mark by Mr. Cerveny. Registration of the mark in the name of Mr. Cerveny would result in public confusion of the origin of the goods and services associated with the mark and would falsely suggest that Mr. Cerveny is connected to the Scotchman Reunion Car/Motorcycle Show. Accordingly, registration by Mr. Cerveny should be denied.

Ronald M. Rubin

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9725 E. Hampden  
Suite 330  
Denver, CO 80231

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and select Business Center.

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05-26-2006 14:11:14

Paper documents must be typewritten or machine printed.

ABOVE SPACE FOR OFFICE USE ONLY

### Statement of Registration of Trademark

filed pursuant to §7-90-301, et seq. and §7-70-102 of the Colorado Revised Statutes (C.R.S.)

1. True name of applicant (if an individual): \_\_\_\_\_  
(Last) (First) (Middle) (Suffix)

OR (if a business organization):

The Scotchman, LLC

If applicant is an entity:

ID number:  
(if applicable)

20061207463

Form of entity:

Limited Liability Company

Jurisdiction of formation:

Colorado

2. Mailing address of applicant:

12477 W. 83rd. Drive

(Street name and number or Post Office Box information)

Arvada

(City)

CO

(State)

80005

(Postal/Zip Code)

(Province - if applicable)

(Country - if not US)

3. If the applicant is not an individual who  
is a resident of Colorado and is a person  
not maintaining a registered agent  
pursuant to part 7 of article 90 of title 7,  
service of process in any action relating  
to the registration may be mailed to the  
following address:

(Complete if statement is true)

(Street name and number or Post Office Box information)

(City)

(State)

(Postal/Zip Code)

(Province - if applicable)

(Country - if not US)

4. Trademark consists of

(mark the appropriate box  
and fill in the blank):

Words ONLY

OR

Words with  
stylized  
lettering\*

OR

Words AND  
design\*

OR

DESIGN  
ONLY\*

Trademark words or description:

(If trademark contains no words,  
briefly describe the design)

Scotchman - design is a stylized Scottish waitress - See facsimile

**\* Attach specimen or facsimile of trademark**

5. Use of Restricted Words (if any of these terms are contained in an entity name, true name of an entity, trade name or trademark stated in this document, mark the applicable box):

- "bank" or "trust" or any derivative thereof  
 "credit union"       "savings and loan"  
 "insurance", "casualty", "mutual", or "surety"

6. The goods and services in connection with which the trademark is used:

Auto Shows and related products

7. The mode and manner in which the trademark is used:

Auto Show advertising including fliers, posters, brochures, postcards

8. The class of goods and services in connection with the trademark: (class code, see line instructions for codes)

Class 42 (Miscellaneous)  
(number)

9. The date the trademark was first used by the applicant or its predecessor ANYWHERE:

01/13/2006

(mm/dd/yyyy)

10. The applicant has adopted and used the trademark in Colorado.

The date the trademark was first used by the applicant or its predecessor in Colorado:

01/13/2006

(mm/dd/yyyy)

The applicant believes that they are the owner of the trademark and no other person is entitled to use the trademark in Colorado.

Notice:

Causing this document to be delivered to the secretary of state for filing shall constitute the affirmation or acknowledgment of each individual causing such delivery, under penalties of perjury, that the document is the individual's act and deed, or that the individual in good faith believes the document is the act and deed of the person on whose behalf the individual is causing the document to be delivered for filing, taken in conformity with the requirements of part 3 of article 90 of title 7, C.R.S., the constituent documents, and the organic statutes, and that the individual in good faith believes the facts stated in the document are true and the document complies with the requirements of that Part, the constituent documents, and the organic statutes.

This perjury notice applies to each individual who causes this document to be delivered to the secretary of state, whether or not such individual is named in the document as one who has caused it to be delivered.

11. Name(s) and address(es) of the individual(s) causing the document to be delivered for filing:

Marsico                      John                      R.  
(Last)                      (First)                      (Middle)                      (Suffix)

12477 W. 83rd. Drive

(Street name and number or Post Office Box information)



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Arvada	CO	80005
(City)	(State)	(Postal/Zip Code)

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(Province - if applicable)	(Country - if not US)
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*(The document need not state the true name and address of more than one individual. However, if you wish to state the name and address of any additional individuals causing the document to be delivered for filing, mark this box  and include an attachment stating the name and address of such individuals.)*

**Disclaimer:**

This form, and any related instructions, are not intended to provide legal, business or tax advice, and are offered as a public service without representation or warranty. While this form is believed to satisfy minimum legal requirements as of its revision date, compliance with applicable law, as the same may be amended from time to time, remains the responsibility of the user of this form. Questions should be addressed to the user's attorney.

# Scotchman



**Scaglione, Carl**

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**From:** John Marsico [jmarsico@frii.com]  
**Sent:** Thursday, April 27, 2006 5:13 PM  
**To:** massarog@RockyMountainNews.com  
**Cc:** Scaglione, Carl  
**Subject:** Scotchman Reunion  
**Importance:** High

Hi Gary:

I'm not **one** to pursue credit for things, but I just want to give you a bit more information regarding the Scotchman Car/Motorcycle Reunion Show scheduled for June 4, 2006.

Last **summer** at the Red Lion Run, a car show sponsored by the Italians of America, I had the opportunity to visit with some long time friends of mine from high school and even grade school. Among **these** people were, Carl Scaglione, Tony Taddonio, and Frank Piccone. Visiting with these **three guys**, Carl Scaglione suggested a car show functioning as a Scotchman Reunion for the summer of 2006. He asked if I would be interested in helping. Of course, growing up in North Denver, I said yes.

I forgot **about** the entire conversation until one evening in October when I got a phone call from Carl Scaglione. Carl called to ask if I was still interested in the Scotchman show. Carl said he had Bandimere interested and he even had met with Carl Cerveny. The call just about shocked me, but I was in.

To **make** a long story short, the actual car and motorcycle portion of the event would not have happened if it weren't for Carl, Tony, and Frank. Carl recruited his friend Mike Horan, and his son Anthony. This committee, including myself, has been meeting since October and we feel we have a great show planned.

I would suggest you contact Carl Scaglione, 303-422-5214, home, 303-548,8599, cell, if you would like more information regarding the actual details how this entire process came together. He really was the engine that pushed this event.

Thanks,

John Marsico  
jmarsico@frii.com

4/28/2006

Ex B

**Scaglione, Carl**

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**From:** John Marsico [jmarsico@frii.com]

**Sent:** Friday, May 26, 2006 10:19 AM

**To:** Rallo Dave

**Subject:** Don't Miss The Scotchman Car Show This Sunday June 4th Denver Mustang Club

Hi Dave:

Here is the message from the Denver Mustang Club. Please pass this on to Dave Stahl. I'm pretty sure Carl Scaglione can set aside space so the Denver Mustang Club can park as a group.

See you there.

John

Hi All,

Don't Miss the Scotchman Motor Restaurants Reunion Car Show!

**Date:** This Sunday 6/4/06

**Place:** Bandimere Speedway

**Time:** 10:00 AM to 4:00 PM

**Entry Fee** is \$30.00

**DOOR PRIZES - TROPHY'S - FUN FOOD - MEMORY LANE**

All Proceeds will Benefit The Ronald McDonald House

\*\*\* If you want to park with the DMC club members meet us at 9:30 AM in the parking lot just below the racers entrance we'll all go in together. All cars are welcome so I hope to see everyone!!!

Mike

5/26/2006

EXHIBIT



PO BOX 7477  
 LOVELAND, CO 80537-0477  
 970-686-6155

# Sales Receipt

Date	Sale No.
1/27/2006	

Sold To
SCOTCHMAN RESTAURANT REUNION SHOW CARL SCAGLIONE 4444 UPHAM WHEAT RIDGE CO 80033

Check No.	Payment Method	Project
7248	Check	

Description	Qty	Rate	Amount
1/4 page advertisement-MARCH/APRIL 2006		90.00	90.00
1/4 page advertisement-MAY 2006		90.00	90.00
Artwork fee		20.00	20.00
Scotchman Restaurant Reunion Show		<b>Total</b>	\$200.00

EXHIBIT D

Twins Trophies N' Engraving  
11103 W. 67th Way  
Arvada CO 80004

**Invoice**

Number	1042
Date	04/10/06

<b>Bill To</b> Scotchman Reunion Show Tony Taddonio P.O. Box 16326 Denver CO 80216
--

<b>Ship To</b> Scotchman Reunion Show Tony Taddonio P.O. Box 16326 Denver CO 80216
--

P.O. Number	Terms	Sales Rep	Sales Territory	Code
		JFM		

Quantity	Description	Unit Price	Amount
500	Dash Plaques for Scotchman Reunion Show @ \$1.25 ea. = \$625.00 + \$49.44 Tax	taxable	
1	Deposit Due	200.00	200.00
1	Balance due on delivery \$474.44		

Amount Paid 0.00	Amount Due 200.00		
		<b>TOTAL</b>	<b>\$200.00</b>

TONY,  
 ARE YOU TAX EXEMPT SINCE THIS IS FOR RONALD  
 McDONALD ?

Exhibit E


**MILE HI INVESTMENTS INC**  
 4701 E 50TH AVENUE  
 DENVER, CO 80216  
 PH 303-399-6066


1972  
 23-7/1020 5105  
 1018018706

DATE: April 14, 2006

PAY TO THE ORDER OF: Winn Trophies 'N' Engraving

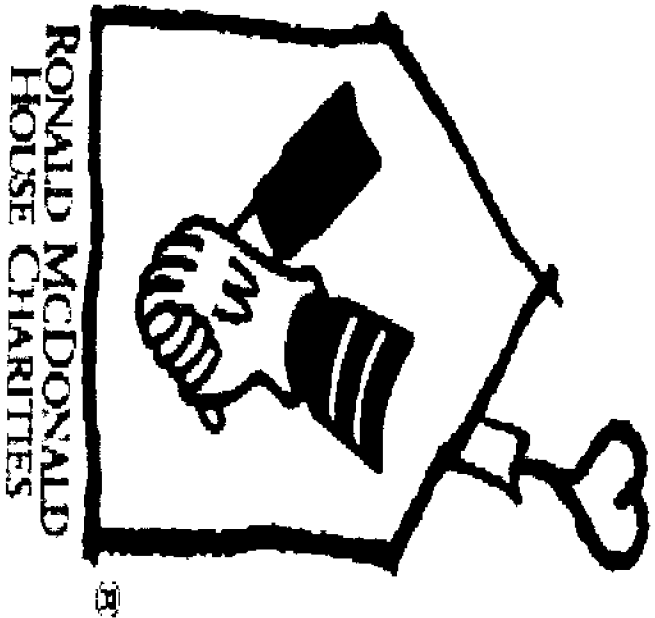
Two hundred and no/100 \$ 200.00


 Wells Fargo Bank, N.A.  
 Colorado  
 www.wellsfargo.com

DOLLARS 

FOR: Raymond [Signature]

MICR LINE: **⑆ 102000076⑆ 1018018706⑆ 01972**



ALL PROCEEDS DONATED TO THE  
RONALD McDONALD HOUSE CHARITIES

# Starline

REUNION

CAR/MOTORCYCLE SHOW



A COMBINATION OF

*Quality*  
and  
*Thrills*

COFFEE SHOP  
CAR SERVICE  
CARRY-OUT

"The Aristocrat of Exquisite Messes"

JUNE 4, 2006





# Scotchman

## MOTOR RESTAURANTS

### REUNION CAR/MOTORCYCLE SHOW



For the first time since the Scotchman closed in 1977, you can order a Mr. Horrible Burger, Hollywood Cola, Your Pet Dog, or a Hot Kookie!

**WHERE:** Bandimere Speedway  
**WHEN:** Sunday, June 4, 2006  
**TIME:** 10:00 a.m. to 4:00 pm  
**ENTRY FEE:** \$25.00, Day of Show \$30.00 **CAR/DRIVER**  
PRE-REGISTER BEFORE MAY 15, 2006

FIRST 400 VEHICLES REGISTERED RECEIVE DASH PLAQUES

Spectator entrance fee \$12.00, children under 12 are free.

**ALL PROCEEDS WILL  
 BENEFIT THE RONALD  
 MCDONALD HOUSE!**

**Trophies and Raffle Prizes  
 Vendors Welcome!**

**TO ORDER:**  
 SELECT YOUR FISH  
 PICK UP SPECIALS OPTION  
 GIVE US A CALL  
 SPECIALLY TRAINED ANSWER  
 AND TAKE ORDER

Mail applications to:  
 Scotchman Reunion  
 c/o Ronald McDonald  
 P.O. Box 16326  
 Denver, CO 80216

#### CONTACTS:

[www.scotchmanreunion.org](http://www.scotchmanreunion.org)  
 Bandimere Speedway  
[www.bandimere.com](http://www.bandimere.com)  
 Ronald McDonald House  
 Konl, 303-832-6642  
 Carl Cerveny  
 303-233-1506  
 Carl Scaglione  
 303-422-5214  
 John Marsico  
[giannibegood@fritl.com](mailto:giannibegood@fritl.com)  
 Mike Horan  
[mhoran12@aol.com](mailto:mhoran12@aol.com)

EXHIBIT A

**FIRST 400 VEHICLES REGISTERED  
RECEIVE DASH PLAQUES  
TROPHIES AND RAFFLE PRIZES**

**SPONSORS & VENDORS  
WELCOMED  
PLEASE SEE WEBSITE:  
www.scotchmanreunion.org**

1. **Scotchman Reunion Information.** . . . www.scotchmanreunion.org
2. **Contact Phone Numbers.** . . . . 303.281.9730 or 1-800.815.2103
3. **Bandimere Speedway.** . . . www.bandimere.com
4. **Vehicle Registration.** . . . www.scotchmanreunion.org
5. **Former Employees.** . . . www.scotchmanreunion.org/employee.html

The North Denver Tribune would like to print everyone's favorite story of The Scotchman. Please send your story to Elisa Cohen, Managing Editor c/o ElisaC@NorthDenverTribune.com or mail to PO Box 12009, Denver, CO 80212.

Scotchman Vehicle Application

NAME: \_\_\_\_\_ ADDRESS: \_\_\_\_\_  
 CITY: \_\_\_\_\_ STATE: \_\_\_\_\_ ZIP: \_\_\_\_\_  
 HOME PHONE: \_\_\_\_\_ BUSINESS PHONE: \_\_\_\_\_  
 EMAIL ADDRESS: \_\_\_\_\_

**AUTO INFORMATION**

YEAR: \_\_\_\_\_ MAKE: \_\_\_\_\_ MODEL: \_\_\_\_\_  
 INTERIOR COLOR: \_\_\_\_\_ EXTERIOR COLOR: \_\_\_\_\_  
 SPECIAL FEATURES: \_\_\_\_\_

**MOTORCYCLE INFORMATION**

YEAR: \_\_\_\_\_ MAKE: \_\_\_\_\_ MODEL: \_\_\_\_\_  
 INTERIOR COLOR: \_\_\_\_\_ EXTERIOR COLOR: \_\_\_\_\_

Make Checks Payable to Ronald McDonald House

Mail Check & Application to P.O Box 16326, Denver, CO 80216

**THE SHOW IS OPEN TO ALL VEHICLES**

*Exhibit I*