

ESTTA Tracking number: **ESTTA193938**

Filing date: **02/20/2008**

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 party opposes registration of the indicated application.

Opposer Information

| | | | |
|---------|--|-------------|----------|
| Name | Sizzler USA Franchise, Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 15301 Ventura Blvd., Building B Suite 300 Sherman Oaks, CA 91403 UNITED STATES | | |

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| Attorney information | Jessica C. Bromall Jeffer, Mangels, Butler & Marmaro 1900 Ave. of the Stars, 7th Floor Los Angeles, CA 90067 UNITED STATES trademarkdocket@jmbm.com | | |
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Applicant Information

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|--------------------------------|---|---------------------------------|------------|
| Application No | 78932669 | Publication date | 01/22/2008 |
| Opposition Filing Date | 02/20/2008 | Opposition Period Ends | 02/21/2008 |
| International Registration No. | NONE | International Registration Date | NONE |
| Applicant | Duke, Lana 3817 Edenborn Avenue Metairie, LA 70002 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 043. First Use: 2003/04/00 First Use In Commerce: 2003/04/00
All goods and services in the class are opposed, namely: Restaurant services

Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 882633 | Application Date | 04/22/1969 |
| Registration Date | 12/16/1969 | Foreign Priority Date | NONE |
| Word Mark | SIZZLER | | |
| Design Mark | | | |

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|---------------------|---|
| Description of Mark | NONE |
| Goods/Services | Class U100 (International Class 042). First use: First Use: 1957/01/26 First Use In Commerce: 1963/09/02 RESTAURANT SERVICES |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 888458 | Application Date | 04/22/1969 |
| Registration Date | 03/24/1970 | Foreign Priority Date | NONE |

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| Word Mark | SIZZLER |
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| Design Mark | |
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| Description of Mark | NONE |
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| Goods/Services | Class U101 (International Class 035). First use: First Use: 1961/07/05 First Use In Commerce: 1963/09/02 RENDERING TECHNICAL ASSISTANCE IN THE ESTABLISHMENT AND OPERATION OF RESTAURANTS FOR OTHERS |
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| U.S. Registration No. | 976493 | Application Date | 09/21/1972 |
| Registration Date | 01/08/1974 | Foreign Priority Date | NONE |

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|-----------|----------------------------|
| Word Mark | SIZZLER FAMILY STEAK HOUSE |
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| Design Mark | |
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| Description of Mark | NONE |
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| Goods/Services | Class U100 (International Class 042). First use: First Use: 1968/10/00 First Use In Commerce: 1968/10/00 RESTAURANT SERVICES |
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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1384530 | Application Date | 07/26/1982 |
| Registration Date | 02/25/1986 | Foreign Priority Date | NONE |

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|-----------|---------|
| Word Mark | SIZZLER |
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| Design Mark | |
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| Description of Mark | NONE |
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| Goods/Services | Class 030. First use: First Use: 1957/01/26 First Use In Commerce: 1963/09/02 PREPARED MENU ITEM, NAMELY TOAST FOR CONSUMPTION ON AND OFF THE PREMISES |
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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1462078 | Application Date | 09/02/1980 |
| Registration Date | 10/20/1987 | Foreign Priority Date | NONE |

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|-----------|---------|
| Word Mark | SIZZLER |
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| Design Mark | |
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|----------------|------|
| Description of | NONE |
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| Mark | |
| Goods/Services | Class 029. First use: First Use: 1957/01/26 First Use In Commerce: 1963/09/02 PREPARED MENU ITEMS NAMELY, STEAKS, AND DINNERS CONSISTING OF STEAK, POTATOES AND TOAST FOR CONSUMPTION ON AND OFF THE PREMISES |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1795103 | Application Date | 02/08/1993 |
| Registration Date | 09/28/1993 | Foreign Priority Date | NONE |
| Word Mark | SIZZLER | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1981/12/31 First Use In Commerce: 1981/12/31 clothing; namely, golf shirts, aprons, T-shirts, caps, jackets [and ties] | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2294706 | Application Date | 12/18/1997 |
| Registration Date | 11/23/1999 | Foreign Priority Date | NONE |
| Word Mark | SIZZLER | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 1997/05/11 First Use In Commerce: 1997/05/11 RESTAURANT SERVICES | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2862488 | Application Date | 07/03/2002 |
| Registration Date | 07/13/2004 | Foreign Priority Date | NONE |
| Word Mark | SIZZLER UNITED STEAK LOVERS OF AMERICA | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 2003/01/07 First Use In Commerce: 2003/01/07 CLOTHING, NAMELY T-SHIRTS AND SHIRTS; HEADWAEAR | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3056206 | Application Date | 07/18/2003 |
| Registration Date | 01/31/2006 | Foreign Priority Date | NONE |
| Word Mark | SIZZLER SS | | |
| Design Mark | | | |
| Description of Mark | The mark consists of SIZZLER SS. | | |
| Goods/Services | Class 016. First use: First Use: 2005/11/03 First Use In Commerce: 2005/11/03 STATIONERY; WRITING PAPER; COUPONS; NEWSLETTERS IN THE FIELD OF FOOD AND RESTAURANTS | | |

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| | <p>Class 029. First use: First Use: 2005/11/03 First Use In Commerce: 2005/11/03 PREPARED ENTREES CONSISTING PRIMARILY OF MEAT, POULTRY AND/OR VEGETABLES; VEGETABLE AND FRUIT SALADS; AND EXCLUDING SAUSAGES</p> <p>Class 030. First use: First Use: 2005/11/03 First Use In Commerce: 2005/11/03 PREPARED ENTREES CONSISTING PRIMARILY OF PASTA AND/OR RICE; SPICES; SAUCES; BAKERY GOODS; BREADS</p> |
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| Attachments | <p>72325145#TMSN.gif (1 page)(bytes) 74356566#TMSN.gif (1 page)(bytes) 75407367#TMSN.gif (1 page)(bytes) 78141337#TMSN.gif (1 page)(bytes) 78276261#TMSN.jpeg (1 page)(bytes) NOO - IF IT DOESN'T SIZZLE.pdf (8 pages)(192165 bytes)</p> |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|----------------------|
| Signature | /jessica c. bromall/ |
| Name | Jessica C. Bromall |
| Date | 02/20/2008 |

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

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| SIZZLER USA FRANCHISE, INC., Opposer, v. LANA DUKE, Applicant. | Opposition No.: _____ Application Serial No.: 78/932,669 Mark: IF IT DOESN'T SIZZLE, SEND IT BACK Published for Opposition: January 22, 2008 Atty. Ref. No.: 59243 - v. Lana Duke |
|--|--|

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Opposer Sizzler USA Franchise, Inc., a Delaware corporation, ("Opposer"), having the address of 15301 Ventura Blvd., Building B, Suite 300, Sherman Oaks, CA 91403, believes that it will be damaged by the registration on the Principal Register of IF IT DOESN'T SIZZLE, SEND IT BACK, in connection with "restaurant services" in International Class 43. The mark IF IT DOESN'T SIZZLE, SEND IT BACK is the subject of federal trademark application Serial No. 78/932,669, allegedly owned by Lana Duke ("Applicant"), and Opposer hereby opposes registration thereof.

As grounds for this Opposition, it is alleged that:

1. Opposer is the owner of record of Registration No. 882,633, issued on December 16, 1969, for the mark SIZZLER, as well as of the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "restaurant

services" in International Class 42, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

2. Opposer is the owner of record of Registration No. 888,458, issued on March 3, 1970, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "rendering technical assistance in the establishment and operation of restaurants for others" in International Class 35, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

3. Opposer is the owner of record of Registration No. 976,493, issued on January 8, 1974, for the mark SIZZLER FAMILY STEAK HOUSE, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER FAMILY STEAK HOUSE mark in commerce in connection with "restaurant services" in International Class 42, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

4. Opposer is the owner of record of Registration No. 1,384,530, issued on February 25, 1986, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "prepared menu item, namely toast, for consumption on and off the premises" in International Class 30, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

5. Opposer is the owner of record of Registration No. 1,462,078, issued on October 20, 1987, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "prepared menu items, namely, steaks, and dinners consisting of steak, potatoes and toast for consumption on and

off the premises" in International Class 29, as identified in the aforementioned registration.

Opposer's registration is unrevoked and uncanceled.

6. Opposer is the owner of record of Registration No. 1, 795,103, issued on September 28, 1993, for the mark SIZZLER, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER mark in commerce in connection with "clothing, namely golf shirts, aprons, T-shirts, caps, jackets, and ties" in International Class 25, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

7. Opposer is the owner of record of Registration No. 2,294,706, issued on November 11, 1999, for the mark SIZZLER & design, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER & design mark (shown below) in commerce in connection with "restaurant services" in International Class 42, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.

8. Opposer is the owner of record of Registration No. 2,862,488, issued on July 13, 2004, for the mark SIZZLER UNITED STEAK LOVERS OF AMERICA & design, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER UNITED STEAK LOVERS OF AMERICA & design mark (shown below) in commerce in connection with "clothing, namely t-shirts and shirts, headwear" in International Class 25, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.



9. Opposer is the owner of record of Registration No. 3,056,206, issued on January 31, 2006, for the mark SIZZLER SS & Design, as well as the business and goodwill connected therewith. Opposer has been using the SIZZLER SS & design mark (shown below) in commerce in connection with "stationary, writing paper, coupons, newsletters in the field of food and restaurants" in International Class 16, "prepared entrees consisting primarily of meat, poultry and/or vegetables; vegetable and fruit salads, and excluding sausages" in International Class 29, and "prepared entrees consisting primarily of pasta and/or rice, spices, sauces, bakery goods, breads" in International Class 30, as identified in the aforementioned registration. Opposer's registration is unrevoked and uncanceled.



10. On information and belief, Applicant has a principal address of 3817 Edenborn Avenue, Metairie, Louisiana 70002.

11. On information and belief, Applicant is the owner of record of trademark application Serial No. 78/932,669 for registration of the mark IF IT DOESN'T SIZZLE, SEND IT BACK ("Applicant's Mark") for use in connection with "restaurant services" in International Class 43 ("Applicant's Services").

12. As set forth in Opposer's Reg. Nos. 882,633, 888,458, 1,384,530, 1,462,078, Opposer has used the mark SIZZLER in connection with its restaurant services and menu items, as well as in connection with its provision of assistance in establishing and operating restaurants, since as least as early as September 2, 1963. Opposer's use of SIZZLER has been continuous since 1963.

13. As set forth in Opposer's Reg. No. 2,294,706, Opposer has used the mark SIZZLER & design in connection with its restaurant services, since at least as early as May 11, 1997. Opposer's use of the SIZZLER & design mark has been continuous since 1997.

14. As set forth in Opposer's Reg. No. 3,056,206, Opposer has used the mark SIZZLER SS & design in connection with *inter alia*, prepared entrees since at least as early as November 3, 2005. Opposer's use of the SIZZLER SS & design mark has been continuous since 2005.

15. As set forth in Opposer's Reg. No. 976,493, Opposer has used the mark SIZZLER FAMILY STEAK HOUSE in connection with its restaurant services since at least as early as October of 1968. Opposer's use of SIZZLER FAMILY STEAK HOUSE has been continuous since 1968.

16. As set forth in Opposer's Reg. No. 1,795,103, Opposer has also used the mark SIZZLER in connection with clothing, namely golf shirts, aprons, t-shirts, caps, jackets, and ties, since at least as early December 31, 1981. Opposer's use of SIZZLER has been continuous since 1981.

17. As set forth in Opposer's Reg. No. 2,862,488, Opposer has also used the mark SIZZLER UNITED STEAK LOVERS OF AMERICA & design in connection with clothing, including t-shirts, shirts, and headwear, since at least as early as January 7, 2003.

18. Since long prior to July 19, 2006, the filing date of Applicant's application, and since long prior to April 2003, Applicant's claimed date of first use, Opposer has widely advertised and promoted each of its marks identified above (collectively referred to herein, as the "SIZZLER Marks") in connection with its goods and services with the result that the SIZZLER Marks have become well known and associated with Opposer in the United States. Because of these efforts, and by virtue of the excellence and success of the goods and services offered and provided by Opposer under the SIZZLER Marks, Opposer has built up a valuable reputation and tremendous goodwill in its SIZZLER Marks belonging exclusively to Opposer.

19. Applicant's Mark – IF IT DOESN'T SIZZLE, SEND IT BACK – so resembles the SIZZLER Marks as to be likely, when used in connection with Applicant's Services, as to cause confusion, or mistake, or deception. Applicant's Mark, therefore, creates a confusingly similar commercial impression. Thus, consumers will likely believe that Applicant's use of the mark IF IT DOESN'T SIZZLE, SEND IT BACK in connection with Applicant's Services is in some way associated or connected with or sponsored, authorized, or warranted by Opposer. Any objection or fault with Applicant's Services offered in connection with Applicant's Mark would reflect upon and seriously injure Opposer's reputation in connection with goods and services offered under the SIZZLER Marks.


20. Applicant's Mark so resembles Opposer's SIZZLER Marks as to be likely, when used in connection with Applicant's Services, as to cause dilution of Opposer's SIZZLER Marks.

21. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to use of the mark IF IT DOESN'T SIZZLE, SEND IT BACK in connection with the goods and services identified in application Serial No. 78/932,669. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, in accordance with Section 13 of the Trademark Act (15 U.S.C. § 1063),
Opposer prays that this Opposition be sustained and that application Serial No. 78/932,669 be
refused.

Respectfully submitted,

Dated: February 20, 2008



Rod S. Berman
Jessica C. Bromall
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Los Angeles, CA 90067
(310) 203-8080
E-mail: trademarkdocket@jmbm.com
Attorneys for Opposer Sizzler USA Franchise, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION has been sent via U.S. mail, this 20th day of February, 2008, directed to:

Sabrina C. Stavish
Sheridan Ross, P.C.
1560 Broadway Ste 1200
Denver, Co 80202-5145

Dated: February 20, 2008

Name: