

ESTTA Tracking number: **ESTTA246112**

Filing date: **10/31/2008**

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

Proceeding	91182564
Party	Defendant Duke, Lana
Correspondence Address	SABRINA C. STAVISH SHERIDAN ROSS, P.C. 1560 BROADWAY STE 1200 DENVER, CO 80202-5145 UNITED STATES sstavish@sheridanross.com
Submission	Motion to Join/Substitute Party
Filer's Name	Elise M. Stubbe
Filer's e-mail	estubbe@hardycarey.com
Signature	/Elise M. Stubbe/
Date	10/31/2008
Attachments	Motion to Substitute (final).pdf ( 10 pages )(587771 bytes )

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

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Sizzler USA Franchise, Inc.	)	
	)	Application Serial No. 78/932669
vs.	)	Opposition No. 91/182564
	)	
Lana Duke	)	

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**MOTION FOR SUBSTITUTION OF DEFENDANT  
OR IN THE ALTERNATIVE, MOTION TO JOIN PARTY AS DEFENDANT**

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NOW COMES, Ruth’s Hospitality Group, Inc. (“RHGI”)<sup>1</sup>, the assignee of the mark “IF IT DOESN’T SIZZLE, SEND IT BACK” by virtue of an assignment executed with Lana Duke, in which Duke assigned all rights, title and interest in the mark and application to RHGI. As a result of this assignment and pursuant to Section 512.01 of the *Trademark Trial and Appeal Board Manual of Procedure* (TMBP), RHGI hereby petitions to be substituted as the defendant in these proceedings, or in the alternative, to be joined as a party defendant.

**Facts**

RHGI entered into an assignment agreement with Lana Duke (“Duke”) on October 24, 2008 in which Duke agreed and did assign to RHGI the right title and interest in the mark “IF IT DOESN’T SIZZLE, SEND IT BACK”<sup>2</sup> and the application for that mark (collectively, the “Mark”) filed with the U.S. Patent & Trademark Office (“PTO”). On October 29, 2008, counsel

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<sup>1</sup> RHGI contacted Duke’s counsel and was informed that Duke’s counsel had no objection to RHGI filing this motion through ESTTA in the name of Duke’s counsel.

<sup>2</sup> Duke also assigned to RHGI the mark “Come Hungry Darling!” and the associated application, which are not subject to this proceeding.

for RHGI recorded this assignment with the PTO. *See* Exhibit A.

### **Argument**

#### **I. RHGI should be substituted as the defendant in these proceedings rather than joined.**

Pursuant to Section 3.71(d) of the Rules, “the assignee of a trademark application ... may prosecute a trademark application ... or file papers against a third party in reliance on the assignee’s trademark application ... to the exclusion of the original applicant... [provided that] the assignee [establishes] ownership in compliance with Section 3.73(b).” RHGI has taken such steps to confirm its ownership of the mark by filing with the Assignment Services Branch the assignment document for recordation. The document was duly recorded on October 29, 2008, as demonstrated in Exhibit A.

RHGI should be substituted for Duke as the defendant in these proceedings for several different reasons detailed below:

##### *A. RHGI is now the sole owner of the mark and the application and as such, has the sole interest in the outcome of this proceeding.*

By virtue of the assignment executed by the parties, RHGI is now the sole owner of the mark and application at issue here. Duke has no further interest in this matter, nor can the Board take any action against her through these proceedings. The only party that the Board can take an action against is RHGI.

##### *B. Substitution will save resources and be more convenient.*

Allowing RHGI to be substituted as a party would save TTAB resources because the Board would only have to consider the claims of one defendant, rather than potential multiple claims of two defendants. It would also save Sizzler time and effort in responding to and dealing with two separate defendants. Moreover, RHGI has previous experience in similar litigation with

Sizzler before the Board, specifically in the matter of *Sizzler USA Franchise, Inc. v. Ruth's Chris Steak House, Inc.*<sup>3</sup>, Opp. No. 91179895, involving the mark “{FRIENDS OF RUTH’S} AN EVEN HIGHER DEGREE OF SIZZLE”. That proceeding was terminated and the application was allowed to mature into a registration after RCSH filed a motion for summary judgment to which Sizzler failed to file a response. The Board granted the motion as conceded. RHGI is therefore uniquely positioned to defend this claim, and has a vested interest in obtaining a similar outcome that preserves its marks.

C. *As the owner of the mark, RHGI has a vested interest in directing the defense of the application for its benefit only.*

As stated in the March 2008 motion for an extension of time in which to file an answer, it is extremely desirable to RHGI that it be the sole party in this proceeding from the start so that it can have complete control over the direction and management of the proceedings. RHGI and Duke’s strategies for handling this matter could differ and RHGI does not want to be constricted in how it manages this litigation because of these differences.

**II. In the alternative, should this motion to substitute not be granted, RHGI petitions to be joined as a party defendant with Duke.**

Pursuant to TBMP Section 512.01, where an assignee to an application has not been substituted for the original party, the assignee must be joined as a party in the proceeding, in keeping with Section 3.71(d) of the Rules.

For the reasons stated above, RHGI respectfully requests that the Board GRANT its motion to substitute itself as the party defendant for Duke, or in the alternative, to join RHGI as a party defendant in this proceeding.

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<sup>3</sup> In May 2008, Ruth’s Chris Steak House, Inc. formally changed its name to Ruth’s Hospitality Group, Inc.

Respectfully submitted,

Ruth's Hospitality Group, Inc.

By: Elise M. Stubbe

Elise M. Stubbe, Esq.

Joseph C. Chautin, III, Esq.

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Counsel for Ruth's Hospitality Group, Inc.

Dated: October 31, 2008

Certificate of Service

I, Elise M. Stubbe, hereby certify that service of the foregoing Motion was made on October 31, 2008 via first class mail to the petitioner's counsel of record at the address below.

Rod S. Berman  
Jessica C. Bromall  
Jeffer, Mangels, Butler & Marmaro, LLP  
1900 Avenue of the Stars, Seventh Floor  
Los Angeles, CA 90067

*Elise M. Stubbe*  
Elise M. Stubbe

TO: ELISE M. STUBBE COMPANY: 1080 WEST CAUSEWAY APPROACH

Exhibit A



## UNITED STATES PATENT AND TRADEMARK OFFICE

### Facsimile Transmission

**To:**                   **Name:**                   ELISE M. STUBBE  
                          **Company:**               1080 WEST CAUSEWAY APPROACH  
                          **Fax Number:**           19856290778  
                          **Voice Phone:**

**From:**               **Name:**                   ASSIGNMENT SERVICES BRANCH  
                          **Voice Phone:**           571-272-3350

37 C.F.R. 1.6 sets forth the types of correspondence that can be communicated to the Patent and Trademark Office via facsimile transmissions. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (37 CFR 1.8(a)).

#### Fax Notes:

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2	865.TXT
4	Document 1, Batch 1455692

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TO: ELISE M. STUBBE COMPANY: 1080 WEST CAUSEWAY APPROACH

**UNITED STATES PATENT AND TRADEMARK OFFICE**UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

OCTOBER 29, 2008

\*900119584A\*

PTAS

ELISE M. STUBBE  
1080 WEST CAUSEWAY APPROACH  
MANDEVILLE, LA 70471UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENTTHE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF  
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REFERENCED BELOW.PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE  
INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA  
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PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE,  
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RECORDATION DATE: 10/29/2008

REEL/FRAME: 003879/0533  
NUMBER OF PAGES: 4

BRIEF: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

## ASSIGNOR:

DUKE, LANA

DOC DATE: 10/24/2008  
CITIZENSHIP: UNITED STATES  
ENTITY: INDIVIDUAL

## ASSIGNEE:

RUTH'S HOSPITALITY GROUP, INC.  
500 INTERNATIONAL PARKWAY  
SUITE 100  
HEATHROW, FLORIDA 32746CITIZENSHIP: DELAWARE  
ENTITY: CORPORATIONAPPLICATION NUMBER: 78932649  
REGISTRATION NUMBER:FILING DATE: 07/19/2006  
ISSUE DATE:

MARK: COME HUNGRY DARLING!

DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN BLOCK FORM

TO: ELISE M. STUBBE COMPANY: 1080 WEST CAUSEWAY APPROACH

003879/0533 PAGE 2

APPLICATION NUMBER: 78932669  
REGISTRATION NUMBER:

FILING DATE: 07/19/2006  
ISSUE DATE:

MARK: IF IT DOESN'T SIZZLE, SEND IT BACK  
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN BLOCK FORM

ASSIGNMENT SERVICES BRANCH  
PUBLIC RECORDS DIVISION

**TRADEMARK ASSIGNMENT**

Electronic Version v1.1  
 Stylesheet Version v1.1

**10/29/2008**  
**900119584**

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT
<b>NATURE OF CONVEYANCE:</b>	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

**CONVEYING PARTY DATA**

Name	Formerly	Execution Date	Entity Type
Lana Duke		10/24/2008	INDIVIDUAL: UNITED STATES

**RECEIVING PARTY DATA**

<b>Name:</b>	Ruth's Hospitality Group, Inc.
<b>Street Address:</b>	500 International Parkway
<b>Internal Address:</b>	Suite 100
<b>City:</b>	Heathrow
<b>State/Country:</b>	FLORIDA
<b>Postal Code:</b>	32746
<b>Entity Type:</b>	CORPORATION: DELAWARE

**PROPERTY NUMBERS Total: 2**

Property Type	Number	Word Mark
Serial Number:	78932649	COME HUNGRY DARLING!
Serial Number:	78932669	IF IT DOESN'T SIZZLE, SEND IT BACK

**CORRESPONDENCE DATA**

**Fax Number:** (985)629-0778  
*Correspondence will be sent via US Mail when the fax attempt is unsuccessful.*

**Phone:** (985) 629-0777

**Email:** estubbe@hardycarey.com

**Correspondent Name:** Elise M. Stubbe

**Address Line 1:** 1080 West Causeway Approach

**Address Line 4:** Mandeville, LOUISIANA 70471

<b>NAME OF SUBMITTER:</b>	Elise M. Stubbe
<b>Signature:</b>	/Elise M. Stubbe/
<b>Date:</b>	10/29/2008

OP \$65.00 78932649

TO: ELISE M. STUBBE COMPANY: 1080 WEST CAUSEWAY APPROACH

**Total Attachments: 2**

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