

ESTTA Tracking number: **ESTTA207964**

Filing date: **04/29/2008**

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	Pure Entertainment, LLC
Granted to Date of previous extension	04/30/2008
Address	354 Eleventh Street San Francisco, CA 94103 UNITED STATES

Attorney information	Anne L. Turner Phelps Dunbar LLP 111 East Capitol Street, Suite 600 Jackson, MS 39201 UNITED STATES anne.turner@phelps.com Phone:(601) 360-9725
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Applicant Information

Application No	77071279	Publication date	01/01/2008
Opposition Filing Date	04/29/2008	Opposition Period Ends	04/30/2008
Applicant	Butter Licensing LLC 28th Floor c/o 521 Fifth Avenue New York, NY 10175 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Nightclub Services
Class 043. All goods and services in the class are opposed, namely: bar, lounge and restaurant services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77361106	Application Date	12/28/2007
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	BUTTER
Design Mark	
Description of Mark	The mark consists of the word "butter" printed in lower case, outlined letters enclosed by a single-lined rectangular box with rounded corners.
Goods/Services	Class 041. First use: First Use: 1999/05/20 First Use In Commerce: 1999/05/20 Entertainment services, namely, providing disc jockeys and pre-recorded music, film and video presentations; nightclub services Class 043. First use: First Use: 1999/05/20 First Use In Commerce: 1999/05/20 Restaurant and bar services

Attachments	77361106#TMSN.jpeg (1 page)(bytes) Pure Entertainment, LLC - Notice of Opposition.pdf (7 pages)(56324 bytes)
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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 Overnight Courier on this date.

Signature	/ANNE L. TURNER/
Name	Anne L. Turner
Date	04/29/2008

OPPOSER, ITS MARK AND RELATED GOODWILL

- 1) Opposer Pure Entertainment, LLC, is a limited liability company organized and existing under the laws of the State of California, located and doing business at 354 Eleventh Street, San Francisco, California 94103.
- 2) Opposer is the owner of a bar, restaurant and nightclub located in San Francisco, California, that has been continuously doing business under the name "Butter" since on or about May 20, 1999, and which operates a web site for the promotion of its business and the sale of associated merchandise at www.smoothasbutter.com.
- 3) On or about October 28, 1999, Opposer filed with the United States Patent and Trademark Office an application for registration on the Principal Register of the mark "Butter" and design ("**Opposer's Mark**"). Opposer's application was approved and Opposer's Mark was registered on the Principal Register in connection with restaurant and bar services; providing of food and drink, both alcoholic and non-alcoholic (Class 42) on October 17, 2000, under Registration Number 2395741.
- 4) On or about July 21, 2007, Opposer's registration for Opposer's Mark was cancelled by the United States Patent and Trademark Office under Section 8. At the time of such cancellation, Opposer was not represented by counsel, was not aware of the requirement under Section 8 to file an affidavit of use and inadvertently failed to make the Section 8 filing that would have avoided such cancellation. The current owners of Pure Entertainment, LLC, purchased the company, including among other things and without limitation all of the rights and goodwill of the former owners with respect to Opposer's Mark, in or around December 22, 2003, following the initial registration of Opposer's Mark. Opposer was alerted to the Section 8 cancellation by a prospective purchaser of Opposer's rights in and to Opposer's Mark.

5) At all times from and after May 20, 1999, Opposer has adopted and actively and continuously used Opposer's Mark in interstate commerce in connection with nightclub, bar and restaurant services in the United States. Opposer's business has been the subject of both local and national press attention in both industry publications and also in the mainstream media. Opposer's fame and notoriety in the nightclub and bar industry has developed a great deal of goodwill in connection with the BUTTER name. In 2006, Butter (Opposer's business) was named one of the top 100 bars in the United States by *Nightclub & Bar Magazine*, a prominent, nationwide industry magazine.

APPLICANT'S CONFUSINGLY SIMILAR MARK

6) Upon information and belief, Applicant, Butter Licensing, LLC, is a limited liability company organized and existing under the laws of the State of Delaware.

7) On December 26, 2006, Applicant filed under Trademark Act Section 1(b) an application for the registration of the mark BUTTER LOUNGE in International Classes 41 and 43 for hospitality services, namely nightclub services and bar, lounge and restaurant services.

8) The mark BUTTER was deliberately selected by Applicant in an attempt to appropriate Opposer's highly desirable and imaginative name and to trade upon the significant reputation and goodwill developed in the Butter name by Opposer, which name is associated by the public exclusively with the services and reputation of Opposer. Applicant seeks to capitalize on an inadvertent error made by Opposer in the maintenance of its federal trademark registration by filing the application at issue herein. Applicant further seeks thereby to confuse actual and potential customers into the belief that the services provided under Applicant's proposed mark originate with, are sponsored by or are associated with or approved by Opposer, which continues to operate under the common law service mark BUTTER and on which Opposer also maintains California State Service Mark, Certificate No. 052359, filed November 3, 1999. The likelihood

of consumer confusion, mistake and deception is further heightened because the services provided under the BUTTER mark are traditionally associated with Opposer and because Applicant's mark is identical in its dominant elements and in sound, meaning and commercial impression to Opposer's Mark.

9) BUTTER LOUNGE is confusingly and deceptively similar to the service mark and trade name used in the United States by, and not abandoned by, Opposer, such that the use of BUTTER LOUNGE by Applicant is likely to create confusion, mistake and deception of consumers in the bar, restaurant and nightclub industry when used in connection with Applicant's services. The likelihood of confusion between Opposer's Mark and Applicant's proposed mark is heightened as a result of the very similar nature of the services provided (or, in the case of Applicant, to be provided) by Opposer and Applicant and the identical channel of trade. To wit, upon information and belief, Applicant received in or around April 2007 from the United States Patent and Trademark Office an Office Action refusing registration of Applicant's mark based on a likelihood of confusion under Trademark Act Section 2(d) with Opposer's then registered mark.

10) In view of the significant goodwill, distinctiveness, reputation and fame of the BUTTER name and service mark, the use and registration of BUTTER LOUNGE by Applicant is likely to create confusion, mistake and deception among consumers and will cause or tend to cause consumers to believe that Applicant's services originate with or are otherwise licensed, sponsored or authorized by Opposer.

11) By reason of the foregoing, Opposer will be gravely damaged by the registration of BUTTER LOUNGE by Applicant.

APPLICANT'S DILUTION OF OPPOSER'S MARK

12) Opposer realleges paragraphs 1 through 11 as if restated in full herein.

13) Through the investment by Opposer of time, money and effort over the years through marketing and promotional activity in the United States, and through notoriety and comment through the local and national media in connection with the service offered by Opposer under the BUTTER mark, Opposer's Mark is "famous" within the meaning of 15 U.S.C. §1125(c) and is therefore entitled to protection against dilution of its distinctive quality.

14) Applicant did not file its application for the mark BUTTER LOUNGE until long after the mark BUTTER became famous in connection with Opposer's services. Applicant willfully adopted the mark BUTTER LOUNGE with knowledge of Opposer's federal, state and common law rights in and to the BUTTER mark.

15) Registration of or commercial use of Applicant's mark will cause dilution of the distinctive qualities of Opposer's mark by significantly lessening the capacity of Opposer's mark to identify and distinguish Opposer's goods and services.

16) The grant of a registration to Applicant for the BUTTER LOUNGE mark as sought in Application Serial No. 77/071,279 should be denied based on the grounds of dilution pursuant to 15 U.S.C. §§ 1125(c) and 1063(a).

FRAUD

17) Opposer realleges paragraphs 1 through 16 as if restated in full herein.

18) Opposer first became aware of a use or intent to use of a confusingly similar mark to Opposer's Mark in the same or virtually identical channel of commerce in or around December 2001. Opposer notified Mr. Richie Akiva and an associated entity identified as Varrick Group, LLC, of Opposer's federal registration of and its senior rights in and to the mark BUTTER. Based upon information and belief, Opposer believes Mr. Richie Akiva or Varrick Group to be affiliates of Applicant. Applicant has persisted since that time in its attempts to use a mark confusingly similar to Opposer's Mark subject to the continuing objection of Opposer.

19) Based upon the national reputation of Opposer and Opposer's Mark and upon the actual notice described in paragraphs 3, 9 and 18, Applicant knew or should have known at all times at least from and after October 2000 of Opposer's senior rights in and to the mark BUTTER.

20) Applicant knew or should have known at the time of filing its application for registration of the mark BUTTER LOUNGE of Opposer's then current federal registration of the service mark BUTTER, and Applicant knew or should have known at all times following the cancellation of Opposer's federal registration that Opposer continued to use Opposer's Mark in interstate commerce in the identical, or at least substantially similar, channels of commerce, that Opposer's Mark was and continued to be registered as a service mark under the laws of the State of California and that Opposer, regardless of the inadvertent failure to make a Section 8 statement of use resulting in the cancellation of Opposer's federal registration, had not abandoned Opposer's Mark. A simple search using any popularly available internet search engine would have revealed Opposer's continuing use of the BUTTER mark.

21) Applicant failed to disclose to the United States Patent and Trademark Office in its Application or in any other filed document Opposer's use in interstate commerce of the mark BUTTER, which is of such near resemblance to Applicant's mark BUTTER LOUNGE as to be likely to cause confusion, mistake or to deceive when used in connection with restaurant, bar and nightclub services.

WHEREFORE, Opposer respectfully requests that the Notice of Opposition be sustained and that registration of BUTTER LOUNGE to Applicant be refused.

Opposer hereby appoints Jerome C. Hafter, Anne L. Turner, and Justin L. Matheny, their attorneys to prosecute the above opposition with full power of substitution and revocation and to transact all business in the Patent and Trademark Office in connection therewith; correspondence

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DATED this 28th day of April, 2008.

Respectfully submitted,

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