

ESTTA Tracking number: **ESTTA315721**

Filing date: **11/07/2009**

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

Proceeding	91190188
Party	Plaintiff 3BH
Correspondence Address	Gretchen McCord Hoffmann Wong, Cabello, Lutsch, Rutherford & Brucculeri LLP P. O. BOX 685108 Austin, TX 78768-5108 UNITED STATES wctrademarkaustin@counselip.com
Submission	Other Motions/Papers
Filer's Name	Gretchen McCord Hoffmann
Filer's e-mail	wctrademarkaustin@counselip.com
Signature	/Gretchen McCord Hoffmann/
Date	11/07/2009
Attachments	Complaint as filed - Electronic copy.pdf (7 pages)(249485 bytes) Cover Letter to TTAB for Submitting Copy of Complaint.docx.pdf (1 page)(9189 bytes)

FILED

2009 OCT 15 PM 4:05

CLERK U.S. DISTRICT COURT
WESTERN DISTRICT OF TEXAS

BY



IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS,
AUSTIN DIVISION

3BH, LLC,
Plaintiff,

v.

Doohi Lee,
Defendant.

CIVIL ACTION NO. **A09CA 754SS**

**PLAINTIFF'S ORIGINAL COMPLAINT FOR TRADEMARK INFRINGEMENT AND
UNFAIR COMPETITION**

The Complaint of 3BH, LLC ("3BH"), appearing herein through the undersigned counsel, represents that:

Parties

1. 3BH is a limited liability company organized and existing under the laws of the State of Texas and has its principal place of business at 1717 W. 6th Street, Austin, Texas 78703.
2. Upon information and belief, defendant Doohi Lee ("Defendant") is an individual citizen of the United States and resides at 4100 W 15th Street, Suite 202, Plano, Texas 75093.

Nature of this Action; Jurisdiction of the Court

3. This is an action for common law trademark infringement and unfair competition under the Trademark Act of 1946, as amended, 15 U.S.C. § 1051 *et seq.*; for trademark infringement under Tex. Bus. & Com. Code §16.26(1); and for trademark infringement and unfair competition under the common law of the State of Texas.

4. This Court has jurisdiction over the subject matter and the parties under 28 U.S.C. §§ 1331, 1338(a) and 1338(b) and has supplemental jurisdiction under 28 U.S.C. § 1367(a) of the claim under Texas law. Venue is proper under 28 U.S.C. §§ 1391(b) because, among other reasons, on information and belief, a substantial part of the confusion that has actually occurred and is occurring is in this district.

3BH, ITS BUSINESS, AND ITS MARKS

5. 3BH offers, through its licensees, quality family friendly sports oriented restaurant and bar services under the marks THIRD BASE; THIRD BASE and Design; and THIRD BASE SPORTS BAR (collectively, the “3BH Marks”). 3BH has been offering such services under the 3BH Marks in the greater Austin area since at least as early as September 2, 2006. Currently, three locations in the greater Austin area are operating under the 3BH Marks. The establishments emphasize quality food, atmosphere and experience.
6. The 3BH Marks have been extensively advertised and promoted, and 3BH has expended considerable effort and expense in offering quality services under the 3BH Marks. In addition to maintaining its own active website, 3BH advertises under the 3BH Marks through various channels and media, including radio, television, newspapers, direct mailings, direct emailing, and web advertising. Many of these promotional efforts extend into or are distributed within the Dallas-Ft. Worth Metroplex area.
7. As a result of such efforts, the 3BH Marks have become strongly identified by the consuming public with 3BH, and 3BH enjoys valuable goodwill attached to the 3BH Marks.
8. 3BH is the owner of Texas Registration No.801044047 for the mark THIRD BASE for “Restaurant, bar, and catering services.” 3BH is also the owner of U.S. Application Nos.

77/477762 (for the mark THIRD BASE and Design) and 77/462790 (for the mark THIRD BASE SPORTS BAR), both for "Restaurant, bar, and catering services" in International Class 43.

9. Copies of the records of the Texas Secretary of State and the United States Patent and Trademark Office for the above-identified registration and applications are attached hereto as Exhibit A.

DEFENDANT AND ITS INFRINGING ACTIVITIES

10. Defendant is using the marks 3RD BASE SPORTS BAR & GRILL and 3RD BASE SPORTS BAR & GRILL and Design (collectively, "Defendant's Marks") in conjunction with providing restaurant and bar services in the Dallas-Fort Worth Metroplex area. The use by Defendant of the designation "3rd Base" in Defendant's Marks is phonetically and conceptually identical to the use of "Third Base" in the 3BH Marks. Moreover, Defendant's Marks are being used with almost identical services.
11. Defendant maintains an internet website at www.3rdbasesportsbar.com that is available for viewing in this district and through which customers may request and receive coupons and information on specials being offered by Defendant under Defendant's Marks.
12. Upon information and believe, on February 15, 2008, Defendant filed U.S. Trademark Application No. 76/686837 seeking to register 3RD BASE SPORTS BAR & GRILL and Design and U.S. Trademark Application No. 76/686838 seeking to register 3RD BASE SPORTS BAR & GRILL as trademarks for bar and restaurant services in International Class 43, claiming a date of first use of March 1, 2007, as is evidenced by the publication of the mark in the Official Gazette on December 16, 2008.

INJURY TO 3BH

13. Defendant's Marks, when used for bar and restaurant services, so resemble the 3BH Marks as to be likely to cause confusion. Indeed, 3BH has experienced numerous instances of actual consumer confusion. Such instances of actual confusion have been experienced in both the greater Austin area and in the Dallas-Ft. Worth Metroplex area.
14. 3BH has written to Defendant and requested that he cease use of Defendant's Marks or any mark that includes "Third Base" or a phonetic equivalent for restaurant and bar services. The parties have engaged in extended negotiations but have been unable to amicably resolve their differences.
15. During the course of those negotiations, 3BH informed Defendant of the issued State of Texas registration for its THIRD BASE mark. Despite his knowledge of this registration, Defendant proceeded to open and operate his second restaurant and bar location under the Defendant's Marks after issuance of the Texas registration.
16. Defendant's use of Defendant's Marks for restaurant and/or bar services allows and will allow Defendant to receive the benefit of the goodwill built up at great labor and expense by 3BH in its 3BH Marks and further allows Defendant to gain acceptance for his goods and services based not on his own merits, but on an association with the reputation and goodwill of 3BH.
17. Defendant's use of Defendant's Marks for restaurant and/or bar services constitutes an invasion of 3BH's valuable property rights in a manner that unjustly enriches Defendant.
18. Defendant's use of Defendant's Marks in connection with restaurant and/or bar services is likely to cause confusion with the use by 3BH of its 3BH Marks and falsely indicates to the purchasing public that the Defendant and/or his services are in some manner connected with, sponsored by, affiliated with, or related to 3BH.

19. Use by Defendant of a mark confusingly similar to the 3BH Marks places the valuable reputation and goodwill of 3BH in the hands of Defendant, over whom 3BH has no control.
20. On information and belief, Defendant intends to continue his unauthorized activities.
21. Unless these acts of Defendant are restrained by this Court, they will continue and will continue to cause irreparable injury to Plaintiff and to the public, for which there is no adequate remedy at law.

COUNT I

TRADEMARK INFRINGEMENT IN VIOLATION OF 15 U.S.C. § 1125(a)

22. 3BH realleges paragraphs 1 – 21 hereof as if fully set forth herein.
23. The acts of Defendant complained of above constitute false designations of origin and/or false representations in commerce in violation of 15 U.S.C. § 1125(a). Defendant's use of Defendant's Marks falsely represents that Defendant is licensed or sponsored by 3BH, or that Defendant is in some manner associated, affiliated or connected with 3BH, and is likely to cause confusion.

COUNT II

INFRINGEMENT IN VIOLATION OF TEXAS BUSINESS

AND COMMERCE CODE §16.26(1)

24. 3BH realleges paragraphs 1 – 21 and 23 hereof as if fully set forth herein.
25. The acts of Defendant complained of above constitute trademark infringement and unfair competition in violation of §16.26(1) of the Texas Business and Commerce Code.

COUNT III

COMMON LAW TRADEMARK INFRINGEMENT AND UNFAIR COMPETITION

26. 3BH realleges paragraphs 1 – 21, 23, and 25 hereof as if fully set forth herein.

27. The acts of Defendant complained of above constitute trademark infringement and unfair competition in violation of the common law of the State of Texas.

WHEREFORE, 3BH prays:

(a) That Defendant and those acting in concert with him be permanently enjoined from using the designation “3rd Base” or any other designation confusingly similar to the 3BH Marks in connection with the offering or promotion of restaurant, bar, or related goods or services;

(b) That, pursuant to 15 U.S.C. § 1117(a), 3BH recover from Defendant all of Defendant’s profits resulting from his acts of trademark infringement and that those profits be increased at least three times to compensate 3BH for Defendant’s infringement;

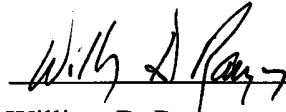
(c) That, pursuant to 15 U.S.C. § 1117(a), 3BH recover from Defendant 3BH’s damages and that those damages be increased three times the amount of actual damages in order to compensate 3BH for Defendant’s infringement;

(d) That, pursuant to 15 U.S.C. § 1117(a), 3BH recover from Defendant its reasonable attorney fees and costs incurred in this action;

(e) That, pursuant to 15 U.S.C. § 1118, the Court order that all signs, printed goods, and advertisements of all sorts in the possession of Defendant that bear 3BH’s Marks or any mark or name confusingly similar thereto be delivered up and destroyed; and

(f) That 3BH recover such other further relief as this Court may deem appropriate.

Respectfully submitted,



William D. Raman

State Bar No. 16492700

Federal ID No. 4117

wraman@counselip.com

Gretchen McCord Hoffmann, CIPP

State Bar No. 24032308

ghoffmann@counselip.com

**Wong, Cabello, Lutsch, Rutherford, and
Brucculeri, LLP**

221 W. 6th St. Suite 950

Austin, TX 78701

v: 512.473.2550 ext. 103

f: 512.473.2555

TRADEMARK

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

3BH, LLC,
Opposer,

v.

Doohi Lee,
Applicant.

Opposition No. 91190188

**BOX TTAB
FEE**

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

Attn: Denise M. DelGizzi, Supervisory Paralegal Specialist

Dear Ms. DelGizzi,

In response to your correspondence of November 2, 2009, Opposer hereby submits a copy of the Original Complaint for Trademark Infringement and Unfair Competition filed on October 15, 2009, in the U.S. District Court for the Western District of Texas.

Per our exchange of voice mails, Opposer would also like to confirm that the references in your November 2, 2009, correspondence to use of "Applicant" in Opposer's Motion to Suspend were inadvertent mistakes and should have referenced Opposer.

Respectfully submitted,

By: /s/ Gretchen McCord Hoffmann
Gretchen McCord Hoffmann
Attorney for Opposer

WONG, CABELLO, LUTSCH,
RUTHERFORD & BRUCCULERI, L.L.P.
P.O. Box 685108
Austin, Texas 78768-5108
(512) 473-2550

Dated: November 7, 2009