

ESTTA Tracking number: **ESTTA395964**

Filing date: **03/02/2011**

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	Carl Karcher Enterprises, Inc.
Granted to Date of previous extension	03/02/2011
Address	6307 Carpinteria Avenue, Suite A Carpinteria, CA 93013 UNITED STATES

Attorney information	Steven J. Nataupsky KNOBBE MARTENS OLSON & BEAR LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@kmob.com Phone:9497600404
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**Applicant Information**

Application No	77908082	Publication date	11/02/2010
Opposition Filing Date	03/02/2011	Opposition Period Ends	03/02/2011
Applicant	Frost, Carl S. 8624 Bowles Road Rockvale, TN 37153 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 030. First Use: 1990/01/01 First Use In Commerce: 1990/02/01 All goods and services in the class are opposed, namely: Food seasonings
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Common law rights as asserted in the Notice of Opposition

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	901315	Application Date	08/06/1969
Registration Date	10/20/1970	Foreign Priority Date	NONE
Word Mark	CARL'S JR.		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U100 (International Class 042). First use: First Use: 1964/02/00 First Use In Commerce: 1964/02/00 RESTAURANT SERVICES

U.S. Registration No.	1400272	Application Date	10/22/1984
Registration Date	07/08/1986	Foreign Priority Date	NONE

Word Mark CARL'S JR.

Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1964/02/00 First Use In Commerce: 1979/06/07 PAPER NAPKINS, PAPER BAGS, FOOD WRAPPERS, AND PAPER PLACE MATS Class 020. First use: First Use: 1964/02/00 First Use In Commerce: 1979/06/07 [ DRINKING STRAWS ] Class 021. First use: First Use: 1964/02/00 First Use In Commerce: 1979/06/07 DISPOSABLE COFFEE CUPS, PAPER CUPS, AND DISPOSABLE FOOD CONTAINERS


U.S. Registration No.	2141498	Application Date	07/18/1996
Registration Date	03/03/1998	Foreign Priority Date	NONE

Word Mark CARL'S JR. JR.

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1996/08/02 First Use In Commerce: 1996/08/02 restaurant services

U.S. Registration No.	2290206	Application Date	09/18/1998
Registration Date	11/02/1999	Foreign Priority Date	NONE

Word Mark CARL'S JR.

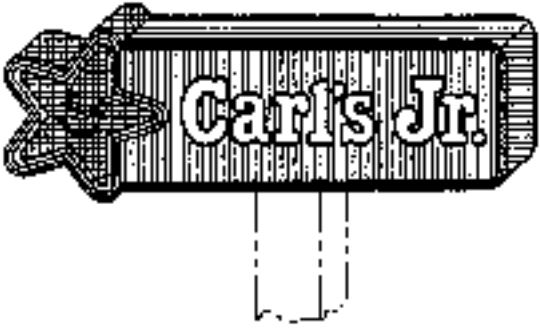
Design Mark	
Description of Mark	NONE

Goods/Services	Class 042. First use: First Use: 1964/02/00 First Use In Commerce: 1964/02/00 RESTAURANT SERVICES
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U.S. Registration No.	2288997	Application Date	09/23/1998
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Registration Date	10/26/1999	Foreign Priority Date	NONE
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Word Mark	CARL'S JR.
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 042. First use: First Use: 1996/11/20 First Use In Commerce: 1996/11/20 RESTAURANT SERVICES
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U.S. Application/Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
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Word Mark	CARL'S JR.
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Goods/Services	as alleged in the Notice of Opposition
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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	/steven j. nataupsky/
Name	Steven J. Nataupsky
Date	03/02/2011



Mark:   
Serial No.: 77/908082  
Goods: Food seasonings in Class 30.  
Filed: January 8, 2010  
Published: November 2, 2010  
Filing Basis: 1(a)

As grounds for opposition, it is alleged:

1. Since at least as early as the 1940s, and long before Applicant filed the Application, Opposer has been using the CARL'S JR. mark and CARL and CARL'S-inclusive marks ("Opposer's Marks") in connection with food items, restaurant services, and other goods and services. The use of these marks has been valid and continuous and has not been abandoned.


2. Opposer, through substantial use and promotion, has acquired significant goodwill and consumer recognition in Opposer's Marks. In addition, by virtue of their substantial use and promotion, Opposer's Marks have become famous in the minds of consumers. Opposer's Marks became famous in the minds of consumers long before Applicant filed the Application.

3. Opposer is the owner of and relies upon incontestable United States Service Mark Registration No. 901315 for the mark CARL'S JR.<sup>®</sup> for "restaurant services" in International Class 42. The application for this mark was filed on August 6, 1969 and registered on October 20, 1970. The mark was first used at least as early as 1964. Opposer first used this mark and obtained its registration long before Applicant filed the Application.

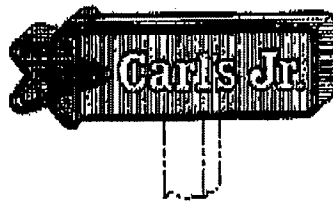
4. Opposer is the owner of and relies upon incontestable United States Trademark Registration No. 1400272 for the mark CARL'S JR.<sup>®</sup> for "paper napkins, paper bags, food wrappers, and paper place mats" in International Class 16 and "disposable coffee cups, paper cups, and disposable food containers" in International Class 21. The application for this mark

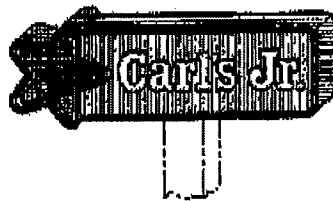
was filed on October 22, 1984 and registered on July 8, 1986. The mark was first used at least as early as 1964. Opposer first used this mark and obtained its registration long before Applicant filed the Application.

5. Opposer is the owner of and relies upon incontestable United States Service Mark Registration No. 2141498 for the mark CARL'S JR. JR.<sup>®</sup> for "restaurant services" in International Class 42. The application for this mark was filed on July 18, 1996 and registered on March 3, 1998. The mark was first used at least as early as 1996. Opposer first used this mark and obtained its registration long before Applicant filed the Application.

6. Opposer is the owner of and relies upon incontestable United States Service Mark Registration No. 2290206 for the mark  for "restaurant services" in International Class 42. The application for this mark was filed on September 18, 1998 and registered on November 2, 1999. The mark was first used at least as early as 1964. Opposer first used this mark and obtained its registration long before Applicant filed the Application.

7. Opposer is the owner of and relies upon incontestable United States Service Mark



Registration No. 2288997 for the mark  for "restaurant services" in International Class 42. The application for this mark was filed on September 23, 1998 and registered on October 26, 1999. The mark was first used at least as early as 1996. Opposer first used this mark and obtained its registration long before Applicant filed the Application.

8. Opposer's registrations as specified in Paragraphs 3, 4, 5, 6, and 7 above are incontestable. As such, they constitute conclusive evidence of the validity of the registered marks

and of the registration of the marks, of Opposer's ownership of its marks, and of Opposer's exclusive right to use the registered marks in commerce as provided in Section 33 of the Lanham Act, 15 U.S.C. § 1115.

9. Opposer's registrations as specified in Paragraphs 3, 4, 5, 6, and 7 are valid, subsisting, unrevoked, uncanceled, and not abandoned. As such, they constitute prima facie evidence of the validity of the registered marks and of the registrations thereof, Opposer's ownership of the marks shown therein, and Opposer's exclusive right to use its marks in commerce in connection with the goods and services named therein, without condition or limitation. Said registrations also constitute notice to Applicant of Opposer's claim of ownership of the marks shown therein, all as provided in Sections 7(b), 22 and 33(a) of the Trademark Act of 1946, as amended.

10. Opposer also relies on its prior common law rights in Opposer's Marks as a ground for this Opposition.


11. Opposer's dates of first use and filing dates for the above registrations substantially precede the filing date of the Application.

12. In view of the substantial similarity between Opposer's Marks for food products, restaurant services, and food related products and the Application for food seasonings, it is alleged that Applicant's mark so resembles Opposer's Marks as to be likely to cause confusion or to cause mistake or deceive under Section 2(d) of the Trademark Act. In view of Opposer's prior statutory and common law rights, Applicant is not entitled to registration of the Application pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

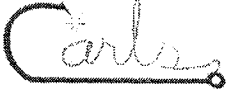
13. Applicant's use and registration of the mark in U.S. Trademark Application Serial No. 77/908082 causes, and will continue to cause, dilution of the distinctive quality of Opposer's

Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c), and will lessen the ability of Opposer's Marks to distinguish the goods and services of Opposer.

14. By reason of the foregoing, Opposer will be damaged by the registration of U.S.

Trademark Application Serial No. 77/908082 for the mark  because registration of this mark would be in violation of Opposer's trademark and service mark rights.

WHEREFORE, Opposer requests that U.S. Trademark Application Serial No. 77/908082

for the mark  be rejected and stricken, that no registration be issued thereon to Applicant, and this opposition be sustained in favor of Opposer.

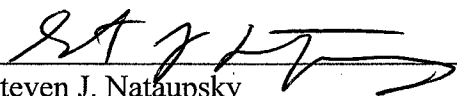
Please charge Deposit Account No. 11-1410 to cover the opposition fee and any additional fees which may be required, including any fees for additional extension of time, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 2, 2011

By: \_\_\_\_\_

  
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Attorneys for Opposer,  
Carl Karcher Enterprises, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on March 2, 2011, addressed as follows:

Matthew H. Swyers  
The Trademark Company  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180



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Sarah Beno Couvillion  
Trademark Paralegal

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