ESTTA Tracking number: **ESTTA398494**

Filing date: **03/16/2011**

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	Butter Licensing, LLC
Granted to Date of previous extension	03/16/2011
Address	521 Ffith Avenue 28th Floor New York, NY 10175 UNITED STATES

Attorney information	Keith Sklar McCue, Sussmane & Zapfel, P.C. 521 Fifth Avenue, 28th Floor New York, NY 10175 UNITED STATES ksklar@mszpc.com

Applicant Information

Application No	77361106	Publication date	11/16/2010
Opposition Filing Date	03/16/2011	Opposition Period Ends	03/16/2011
Applicant	Pure Entertainment, LLC 354 Eleventh Street San Francisco, CA 94103 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 1999/05/20 First Use In Commerce: 1999/05/20 All goods and services in the class are opposed, namely: Entertainment services, namely, providing disc jockey services and accompanying mixed musical, video, film and light shows; nightclub services
Class 043. First Use: 1999/05/20 First Use In Commerce: 1999/05/20 Opposed goods and services in the class: Restaurant and bar services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Torres v. Cantine Torresella S.r.l.Fraud	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Opposer has common law rights to use its Mark in all geographical areas except the San Francisco Area Applicant deleted from its application a disclaimer of Applicants exclusive right to use the word Butter apart from Applicant's design mark which disclaimer was

	included in Applicant's original registration

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BUTTER RESTAURANT		
Goods/Services	IC 041 services namely nightclub IC 043 services namely restaurant and bar		

Related Proceedings	Butter Licensing LLC v. Pure Entertainment LLC, Case No. CV-10-1711(JL) United States District Court for the Northern District of California, San Francisco Division

Attachments	Notice of Opposition.pdf (11 pages)(494955 bytes)

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	/Keith Sklar/
Name	Keith Sklar
Date	03/16/2011

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

In the matter of Trademark Application Serial No. 77361106
Filed: December 28, 2007
For the Mark:

The mark consists of the word "butter" printed in lower case, outlined letters enclosed by a single-lined rectangular box, with rounded corners
Published in the Official Gazette on November 16, 2010

BUTTER LICENSING, LLC Opposer, v. PURE ENTERTAINMENT LLC, Applicant.	X : : : : : : : : X	Serial No. 77361106 Opposition No: _____

United States Patent and Trademark Office
Trademark Trial and Appeal Board
BOX TTAB
2900 Crystal Drive
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

In the pending application Serial No. 77361106, filed December 28, 2007 (the "Application") by Pure Entertainment, LLC ("Applicant"), published in the Official Gazette on November 16, 2010, Butter Licensing LLC ("Opposer") states that Opposer will be damaged by the registration of the above mark, has a real interest in the outcome of this proceeding and hereby gives notice of its opposition to the above application for registration on the following grounds:

OPPOSER, ITS MARKS AND RELATED GOOD WILL

1. Opposer, Butter Licensing LLC is a limited liability company organized and existing under the laws of the State of Delaware, having an address at 453 West 17th Street, New York, New York 10011.

2. Since April 2002, Opposer and its affiliate and licensee, Varrick Group LLC, have operated an elegant restaurant at 415 Lafayette Street, New York, New York using Opposer's service mark BUTTER RESTAURANT.

3. Since February, 2010 Opposer and its affiliate Butter Charlotte LLC have operated a night club in Charlotte, North Carolina using Opposer's service mark BUTTER NC.

4. Opposer's mark BUTTER RESTAURANT, Reg. Num. 3,380,349, was registered on February 12, 2008 on the principal register for restaurant and bar services in Class 43, and nightclub services in Class 41. *Ex. A.* The mark consisted of standard characters without claim to any particular font, style, size or color. No claim was made to the exclusive right to use the word restaurant apart from the mark as shown.

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

6. On August 5, 2008, Applicant filed a Petition for Cancellation, Proceeding No. 92049767 with respect to Opposer's BUTTER RESTAURANT Registration (the "Petition") and a Notice of Opposition, Proceeding No. 91183799 with respect to Opposer's BUTTER LOUNGE application (the "Opposition").

7. The Trademark Trial and Appeal Board issued a decision dated February 25, 2010, in favor of Applicant ruling that Applicant established its priority and likelihood of confusion as a matter of law and granted Applicant's Petition and sustained Applicant's Opposition.

8. On June 29, 2010, Opposer's BUTTER RESTAURANT Registration was cancelled and Opposer's BUTTER LOUNGE application was terminated.

9. On April 21, 2010, Opposer filed an action in the United States District Court for the Northern District of California, San Francisco Division, Case No. CV-10-1711(JL) titled Butter Licensing, LLC v Pure Entertainment LLC, to appeal in accordance with 15 U.S.C. §1071(b)(1) the February 25, 2010 decision of the TTAB (the "Appeal"). The Appeal is pending.

10. Opposer's restaurant has 4,500 square feet of space capable of accommodating 300 guests. Butter Restaurant features a constantly changing menu designed and prepared by a famous executive chef, who is a featured chef on the *Food Network*, a cable television channel, and frequently appears in television and print media as a culinary expert

11. Opposer's menu features local and seasonal ingredients, sourced from various farmers, paired with a *Wine Spectator* award winning wine list. The food is French in style and technique and all-American in ingredients.

12. Opposer markets its services to a specific class of discerning and sophisticated restaurant patrons. Opposer's venue and services have also been retained for private events for celebrities, fashion designers, recording artists and corporations. Monday nights in the lounge are renowned and highly publicized in the national media, with paparazzi camped in front of the venue.

13. Opposer's services and venue are in high demand, and as such have become a staple of the New York social scene evidenced by multiple features or mentions and appearances in top rated network television programming.

14. Opposer extensively markets and advertises its brand, including employing a renowned public relations firm to generate press placement, including hundreds of articles in national newspapers, websites and magazine.

15. Opposer has vigorously defended the BUTTER RESTAURANT mark against third parties who have attempted to use Opposer's trademark to confuse actual and potential customers into the belief that their services are originated with, sponsored by or associated or approved by Opposer. Opposer took action against an infringing restaurant in Chicago, Illinois (establishment has now closed), a restaurant and lounge in Los Angeles, California (opened under a different name), and a restaurant and lounge being constructed in Wilmington, North Carolina (ceased use of name).

16. Opposer has common law rights in the BUTTER RESTAURANT mark and BUTTER NC mark and has developed valuable goodwill with respect to the marks. Opposer will have registered rights in the BUTTER RESTAURANT mark in the event its appeal is decided in Opposer's favor.

APPLICANT'S CONFUSINGLY SIMILAR MARK

17. Upon information and belief, Applicant is a California limited liability company .

18. Applicant operates a small local bar at 354 11th Street in San Francisco, California which bills itself as "white trash bistro" featuring "two turntables and a microwave."

19. Applicant does not operate a restaurant or a nightclub.

20. Applicant is situated between a crepes stand operating in an empty lot and an auto body shop. Applicant operates in a small rectangular space dominated by a large rectangular bar. Other than stools surrounding the bar, there is limited seating at a few small high-topped tables and couches. There is no dining area. The menu lists bar food such as corn-dogs, SpaghettiO's® and deep-fried Twinkies®, plus drinks with names like the "Shotgun Wedding." Consistent with such theme, a side of a "trailer" was installed inside Applicant's premises, through the window of which snacks are served to the bar's customers. A small room of approximately 60 square feet is located behind the trailer front and is equipped with a refrigerator, microwave oven and a deep fryer. There is no kitchen area. An employee heats or deep fries the snacks and serves them to customers through the window of the trailer, on paper plates using plastic utensils. Preparation requires no skill or culinary training. The menu features desserts consisting of pre-packaged baked goods normally found in a convenience store. Applicant serves specialty alcoholic beverages featuring Sunny Delight, grape and strawberry Soda and Tang®. Applicant had a total of 12 employees from 1999 through September 29, 2008.

21. Applicant's major form of marketing is through local disc jockeys appearing at Butter S.F., who prepare and hand out flyers. Applicant does no marketing outside of San Francisco.

22. Applicant took no steps to expand beyond its current San Francisco location in more than nine years.

23. Applicant has had no material use of Applicant's Mark outside of San Francisco since 1999.

24. On October 17, 2000, Applicant received a registration on the Principal Register for restaurant and bar services featuring the provision of food and drink in, both alcoholic and non-alcoholic, in International Class 42 (now Class 43) for: BUTTER AND DESIGN:

("Applicant's Mark"). It depicted a stick of butter (rectangular shape with curved edges) into which the word "butter" was carved. Applicant disclaimed the exclusive right to use BUTTER apart from the mark as shown.

25. Applicant failed to file the required Section 8 Affidavit of Continued Use on October 17, 2006. Applicant's S.F. Mark was cancelled on July 21, 2007.

26. Applicant filed the Petition and Opposition claiming that Applicant holds a common law trademark to the Butter S.F. Mark, stating , "At all times from and after May 20, 1999, Applicant has used Applicant's Mark [Butter & Design] in interstate commerce to designate its bar, restaurant and entertainment services." The Petition and Opposition did not claim a trademark to the word butter separate from Applicant's Mark.

27. On or about December 22, 2003 the ownership of Applicant changed hands and Applicant's Mark was abandoned. Applicant ceased using the Butter Mark in its premises or marketing materials, or on its website. Applicant adopted a new mark which consists of a melting pat of butter underneath the word "butter" (the "Applicant's New Mark").

28. Applicant's New Mark was erroneously attached to Applicant's application for Applicant's Mark which is the subject of this action.

29. Applicant deleted from the Application the disclaimer of the exclusive right to use the word BUTTER apart from Applicant's Mark as shown, which disclaimer was included in Applicant's original registration. Such action was taken to enable Applicant to claim the exclusive right to use the word BUTTER in connection with all goods and services in Class 41 and 43 and to prevent Opposer and many others from registering or using any mark that includes the word BUTTER.

30. Applicant's Mark is different from its prior registration and different from the common law mark claimed to be owned by Applicant in its Opposition and Petition which was the subject of the decision of TTAB in that Applicant no longer disclaims the exclusive right to use the word Butter.

31. Applicant's Mark and its registration and use by Applicant on the goods and/or services described in the Application is likely to cause confusion, deception and mistake with Opposer's customers as to the origin of Applicant's goods and services.

32. If Applicant is permitted to register Applicant's Mark, Opposer would be damaged and injured. Confusion or deception would result in damage to the Opposer. Persons familiar with Opposer's famous Butter Restaurant Mark would be likely to frequent Applicant's establishment under the mistaken impression that Applicant's services originate with or are otherwise, licensed, endorsed, authorized, affiliated or otherwise associated with Opposer.

33. Furthermore, any defect, objection or fault found with Applicant's services under Applicant's Mark would necessarily reflect upon and seriously injure the reputation and goodwill which Opposer has established for its services under the BUTTER RESTAURANT Mark.

APPLICANT'S DILUTION OF OPPOSER'S MARK

34. Opposer realleges paragraphs 1 through 38 as if restated in full herein.

35. Through the investment by Opposer of time, money and effort, through marketing and promotional activity in the United States and abroad, and through notoriety and comment through the local, national and international media in connection with goods and services offered by Opposer under its mark, Opposer 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.

36. Applicant did not file its application for Applicant's Mark until long after the BUTTER RESTAURANT Mark became famous in connection with Opposer's services.

37. The grant of a registration to Applicant for the Applicant's Mark as sought in Application Serial No. 77/744576 should be denied based on the grounds of dilution pursuant to 15 U.S.C. §§ 1125(c) and 1063(a).

38. By reason of the foregoing, Opposer will be gravely damaged by the registration of Applicant's Mark by Applicant.

FRAUD

39. Opposer realleges paragraphs 1 through 43 as if restated in full herein.

40. Applicant has been aware of the use by Opposer of the BUTTER RESTAURANT mark for its operations in New York since 2002 and that such mark became "famous" within the meaning of 15 U.S.C. § 1125(c).

41. Applicant has been aware of the use by Opposer of the BUTTER NC mark in North Carolina since February 2010.

42. Applicant made an application for an unrestricted registration knowing that Applicant's use had been limited to the San Francisco geographic area since opening its business in 1999.

43. Applicant made an application for an unrestricted registration knowing that Opposer had used the BUTTER RESTAURANT mark since 2002 and has common law rights to use its mark in all geographical areas except the San Francisco area.

44. Applicant failed to disclose in the Application the right of Opposer to continue to use the BUTTER RESTAURANT mark in commerce. Upon information and belief Applicant failed to make such disclosure to avoid a geographical limitation on use in its registration.

45. Applicant's Application is fraudulent because it falsely states that Applicant's Mark was used to provide entertainment services, namely providing disc jockeys and prerecorded music, film and video presentations and night club services. None of such services have ever been provided by Applicant.

46. Applicant failed to disclose in its application that it ceased using Applicant's mark on or about December 22, 2003.

FAILURE TO MAKE A PROPER DISCLAIMER

47. Opposer realleges paragraphs 1 through 51 as if restated in full herein.

48. Applicant deleted from its application a disclaimer of the exclusive right to use the word BUTTER apart from Applicant's design mark, which disclaimer was included in Applicant's original registration.

49. Such action was taken to enable Applicant to claim the exclusive right to use the word BUTTER in connection with all goods and services in Classes 41 and 43

and to prevent Opposer and many others from registering or using any mark that includes the word BUTTER.

50. Applicant failed to make the requisite disclaimer of unregistrable matter.

WHEREFORE, Opposer respectfully request that (a) this Notice of Opposition be sustained and the application for registration of Applicant's Mark by Applicant be refused; or in the alternative (b) Applicant's registration be limited to the San Francisco geographical area; or in the alternative (c) Applicant's registration must disclaim the exclusive right to use the word Butter.

Opposer hereby appoints Kenneth Sussmane and Keith G. Sklar and the law firm of McCue Sussmane & Zapfel, P.C. and all attorneys associated with said firm 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 address McCue Sussmane & Zapfel, P.C., 521 Fifth Avenue, 28th floor, New York, New York 10175, Telephone (212) 931-5500; Facsimile (212) 931-5508.

Dated March 16, 2011

Respectfully submitted,

McCue Sussmane & Zapfel, P.C.

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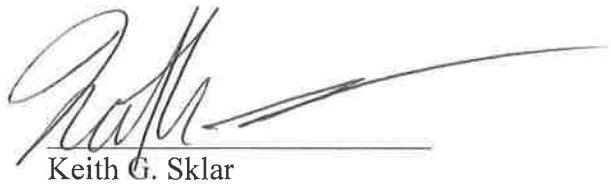
Attorneys for Opposer

Certificate of Service

It is hereby certified, that I am over the age of eighteen years old and not a party to this action, and that on March 16, 2010, I caused a copy of the foregoing Notice of Opposition to be served upon the Applicant at the below addresses by placing it in a sealed envelope with postage thereon fully prepaid, in the United States mail:

Jeffery E. Faucette
Taylor & Company Law Offices, LLP
One Ferry Building, Suite 355
San Francisco, California 94111
Telephone: (415) 788 8200
Facsimile: (415) 788 8208

Date: March 16, 2010



Keith G. Sklar