

ESTTA Tracking number: **ESTTA420623**

Filing date: **07/19/2011**

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	Cheeseburger Restaurants, Inc. and Cheeseburger In Paradise, Inc.		
Entity	Corporation	Citizenship	California
Address	73875 Highway 70 Portola, CA 96122 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:949-760-0404		
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Applicant Information

Application No	76703052	Publication date	06/28/2011
Opposition Filing Date	07/19/2011	Opposition Period Ends	07/28/2011
Applicant	Pfoodman Holdings, L.L.C 15480 Clayton Road, Suite 301 Ballwin, MO 63011 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2009/05/01 First Use In Commerce: 2009/05/01 All goods and services in the class are opposed, namely: Restaurant services, including sit-down service of food and take-out restaurant services, in a food court; and for catering services

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2810903	Application Date	11/02/1999
Registration Date	02/03/2004	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1990/02/01 First Use In Commerce: 1990/02/01 RESTAURANT AND BAR SERVICES		

U.S. Registration No.	3474151	Application Date	10/06/2004
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER ISLAND STYLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2005/04/00 First Use In Commerce: 2005/04/00 Restaurant and bar services		

U.S. Registration No.	1765057	Application Date	08/30/1991
Registration Date	04/13/1993	Foreign Priority Date	NONE
Word Mark	CHEESE BURGER IN PARADISE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/10/25 First Use In Commerce: 1989/10/25 restaurant and bar services		

U.S. Registration No.	2418610	Application Date	09/15/1998
Registration Date	01/09/2001	Foreign Priority Date	NONE

Word Mark	CHEESE BURGER IN PARADISE
Design Mark	CHEESE BURGER IN PARADISE
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1989/10/25 First Use In Commerce: 1989/10/25 RESTAURANT AND BAR SERVICES

U.S. Registration No.	2828125	Application Date	11/13/1997
Registration Date	03/30/2004	Foreign Priority Date	NONE
Word Mark	CHEESEBURGER WITH AN ATTITUDE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/10/00 First Use In Commerce: 1989/10/00 RESTAURANT AND BAR SERVICES		

U.S. Registration No.	2950754	Application Date	11/13/1997
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	CHEESEBURGER IN PARADISE IS A STATE OF MIND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/00/00 First Use In Commerce: 1991/00/00 RESTAURANT AND BAR SERVICES		

Attachments	75838294#TMSN.gif (1 page)(bytes) 78980310#TMSN.jpeg (1 page)(bytes) 74199369#TMSN.gif (1 page)(bytes) 75553386#TMSN.gif (1 page)(bytes) 2011-07-19 Notice of Opposition-CHSRGR.079M.PDF (7 pages)(241697 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 First Class Mail on this date.

Signature	/Steven J. Nataupsky/
Name	Steven J. Nataupsky
Date	07/19/2011

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

Cheeseburger Restaurants, Inc. and
Cheeseburger In Paradise, Inc.,

Opposer,

v.

Pfoodman Holdings, L.L.C

Applicant.

I hereby certify that this correspondence and all marked
attachments are being electronically filed with the
Trademark Trial and Appeal Board through their web site
located at http://estta.uspto.gov on

July 19, 2011
(Date)

[Signature]
Steven J. Nataupsky

NOTICE OF OPPOSITION

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

Dear Sir or Madam:

Cheeseburger Restaurants, Inc. and Cheeseburger In Paradise, Inc. ("Opposer"), located and
doing business at 73875 Highway 70, Portola, California 96122, believes that it will be damaged by
registration of the mark shown in U.S. Trademark Application Serial No. 76/703,052 ("Applicant's
Application") filed May 21, 2010 by Pfoodman Holdings, L.L.C. (hereinafter referred to as
"Applicant"), and hereby opposes the same. Cheeseburger in Paradise, Inc. is a wholly owned
subsidiary of Cheeseburger Restaurants, Inc. and is in privity with Cheeseburger Restaurants, Inc.
Cheeseburger Restaurants, Inc. exercises control of the marks used by Cheeseburger In Paradise, Inc.
with respect to the nature and quality of the goods and services on or in connection with which the
marks are used.

A description of Applicant's Application is as follows:



Mark:
Serial No.: 76/703,052
Filing Date: May 21, 2010
Publication Date: June 28, 2011
Services: Restaurant services, including sit-down service of food and take-out restaurant services, in a food court; and for catering services, in International Class 43
Alleged Date of First Use: May 1, 2009

As grounds for opposition, it is alleged:

1. Since at least as early as 1989, Opposer has used names and marks containing the terms CHEESEBURGER, CHEESE BURGER, PARADISE and a Palm Tree Logo, including the marks set forth in Paragraphs 2 through 7 below (collectively, the "CHEESE BURGER Marks") in association with restaurant and bar services ("Opposer's Services.")

2. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,810,903



(the "'903 Registration") for the mark CHEESE BURGER for "restaurant and bar services" in International Class 42. The '903 Registration was filed on November 2, 1999 and issued on February 3, 2004. Thus, both the filing date and date of registration of the '903 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the



CHEESE BURGER mark shown in the '903 Registration is incontestable.

3. Opposer is the owner of and relies on U.S. Trademark Registration No. 3,474,151 (the "'151 Registration") for the mark CHEESEBURGER ISLAND STYLE for "restaurant and bar services" in International Class 43. The '151 Registration was filed on October 6, 2004 and issued on July 22, 2008. Thus, the filing date and date of registration of the '151 Registration is prior to the

filing date and alleged first use date of Applicant's Application.

4. Opposer is the owner of and relies on U.S. Trademark Registration No. 1,765,057

CHEESE  BURGER

(the "'057 Registration") for the mark **·I·N·D·A·R·A·D·I·S·E·** for "restaurant and bar services" in International Class 42. The '057 Registration was filed on August 30, 1991 and issued on April 13, 1993. Thus, both the filing date and date of registration of the '057 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the

CHEESE  BURGER

·I·N·D·A·R·A·D·I·S·E· mark shown in the '057 Registration is incontestable.

5. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,418,610

(the "'610 Registration") for the mark **CHEESE BURGER IN PARADISE** for "restaurant and bar services" in International Class 42. The '610 Registration was filed on September 15, 1998 and issued on January 9, 2001. Thus, both the filing date and date of registration of the '610 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the **CHEESE BURGER IN PARADISE** mark shown in the '610 Registration is incontestable.

6. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,828,125 (the

"'125 Registration") for the mark **CHEESEBURGER WITH AN ATTITUDE** for "restaurant and bar services" in Class 42. The '125 Registration was filed on November 13, 1997 and issued on March 30, 2004. Thus, both the filing date and date of registration of the '125 Registration are prior to the filing date and alleged first use date of Applicant's Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the **CHEESEBURGER WITH AN ATTITUDE** mark shown in the '125 Registration is incontestable.

7. Opposer is the owner of and relies on U.S. Trademark Registration No. 2,950,754

(the “’754 Registration”) for the mark **CHEESEBURGER IN PARADISE IS A STATE OF MIND** for “restaurant and bar services” in Class 42. The ’754 Registration was filed on November 13, 1997 and issued on May 17, 2005. Thus, both the filing date and date of registration of the ’754 Registration are prior to the filing date and alleged first use date of Applicant’s Application.

8. The ’903, ’151, ’057, ’610, ’125, and ’754 Registrations are valid, subsisting, unrevoked and uncanceled; as such they constitute prima facie evidence of the validity of the registered marks and of the registrations thereof, and of Opposer’s ownership of the marks shown therein and Opposer’s exclusive right to use the marks in commerce in connection with the goods and services named therein, without condition or limitation. The ’903, ’151, ’057, ’610, ’125, and ’754 Registrations also constitute notice to Applicant of Opposer’s claim of ownership of the marks shown therein; all as provided in Section 7(b), 22 and 33(a) of the Trademark Act of 1946, as amended.

9. In view of the substantial similarity of the respective marks and the related nature of the goods and services of the respective parties Applicant’s mark so resembles the registered CHEESE BURGER Marks, previously used and registered in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive.

10. If Applicant is permitted to register the mark shown in Applicant’s Application,



Applicant’s corresponding prima facie exclusive right to use the mark in nationwide commerce will conflict with Opposer’s lawful and prima facie exclusive right to use the CHEESE BURGER Marks nationwide.

11. Since a date well prior to the filing date of Applicant’s Application, Opposer has used the CHEESE BURGER Marks in connection with the provision and advertisement of Opposer’s services. Such use has been valid and continuous, and has not been abandoned. As a result of this

use, the relevant class of the public has come to associate Opposer with the family of CHEESE BURGER Marks.

12. By reason of Opposer's widespread and continuous use of the CHEESE BURGER Marks, in addition to the protection afforded to Opposer by the '903, '151, '057, '610, '125, and '754 Registrations, Opposer has extensive, non-registered statutory and common law rights in the CHEESE BURGER Marks.

13. In view of Opposer's prior statutory and common law rights in the CHEESE BURGER



Marks, Applicant is not entitled to register the mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Applicant's use and registration of the mark in U.S. Trademark Application Serial No. 76/703,052 causes, and will continue to cause, dilution of the distinctive quality of the CHEESE BURGER Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c), and will lessen the ability of the CHEESE BURGER Marks to distinguish the goods and services of Opposer.

15. By reason of the foregoing, Opposer will be gravely damaged by registration of the mark shown in Applicant's Application because registration of this mark would be in violation of Opposer's trademark and trade name rights.

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 76/703,052 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 for any fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 19, 2011

By: 

Steven J. Nataupsky

Brigette B. Chaput

2040 Main Street, 14th Floor

Irvine, CA 92614

(949) 760-0404

efiling@kmob.com

Attorneys for Opposers,

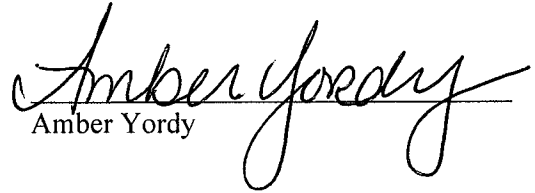
Cheeseburger Restaurants, Inc.

Cheeseburger In Paradise, 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 July 19, 2011, addressed as follows:

PAUL M. DENK
PATENT LAW OFFICE, LC
763 S NEW BALLAS RD STE 305
SAINT LOUIS, MO 63141-8723


Amber Yordy

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