

ESTTA Tracking number: **ESTTA499753**

Filing date: **10/12/2012**

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

Proceeding	91206066
Party	Defendant Ruth's Hospitality Group, Inc.
Correspondence Address	ELISE M STUBBE HARDY CAREY CHAUTIN & BALKIN LLP 1080 W CAUSEWAY APPROACH MANDEVILLE, LA 70471-3036 UNITED STATES estubbe@hardycarey.com, jchautin@hardycarey.com
Submission	Answer
Filer's Name	Elise M. Stubbe
Filer's e-mail	estubbe@hardycarey.com
Signature	/Elise M. Stubbe/
Date	10/12/2012
Attachments	Answer (filed 10-12-12).pdf (6 pages)(43926 bytes)

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

Sizzler USA Franchise, Inc.	§	
	§	Application Serial No. 85/568,417
v.	§	
	§	Opposition No. 91206066
Ruth's Hospitality Group, Inc.	§	

ANSWER

Ruth's Hospitality Group, Inc. ("Respondent"), the owner of the application identified in the heading of this document, hereby files this answer to the Amended Notice of Opposition¹ filed by Sizzler USA Franchise, Inc. ("Opposer") to address the allegations against it and to state affirmative defenses.

1. Respondent is without knowledge or information sufficient to form a belief as to the truth of Opposer's address or state of incorporation, and therefore DENIES the same. Respondent DENIES Opposer's allegation that the registration of SIZZLE, SWIZZLE & SWIRL (the "Mark") in connection with restaurant and bar services in Class 43 will damage Opposer. Respondent ADMITS that it is the owner of the Mark that is subject of application serial number 85/568417 (the "Application") in connection with services in Class 43.

2. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 2, and therefore DENIES the same.

¹ Filed September 26, 2012 in response to the Board's September 12, 2012 decision granting in part RHGI's Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted.

3. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 3, and therefore DENIES the same.
4. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 4, and therefore DENIES the same.
5. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 5, and therefore DENIES the same.
6. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 6, and therefore DENIES the same.
7. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 7, and therefore DENIES the same.
8. Respondent is without knowledge or information sufficient to form a belief as to the truth of the averments in Opposer's Paragraph 8 and therefore DENIES the same.
9. Respondent ADMITS that it is a Delaware corporation with a principal place of business located at 1030 W. Canton Avenue, Suite 100, Winter Park, Florida 32789.
10. Respondent ADMITS that it is the owner of record of the Application serial number 85/568417 for registration of the Mark SIZZLE, SWIZZLE & SWIRL for use in connection with "Bar services; Restaurant services" in Class 43.
11. Respondent DENIES all allegations in Paragraph 11.
12. Respondent DENIES all allegations in Paragraph 12.
13. Respondent DENIES all allegations in Paragraph 13.
14. Respondent DENIES all allegations in Paragraph 14.
15. Opposer's statement that Respondent, if it is granted registration of the Mark would thereby obtain at least a prima facie exclusive right to use the Mark in connection

with the services in the Application is a legal conclusion that does not require a denial or admission by Respondent. Respondent DENIES that such registration would be a source of damage and injury to Opposer.

Affirmative Defenses

16. Opposer lacks standing to bring this Opposition.

17. Opposer cannot be harmed by the Application because Respondent has already obtained a registration for a mark that is substantially similar to this Mark for the same services. Respondent is the owner of the mark “JUST FOLLOW THE SIZZLE” (Reg. No. 3,028,865) which was registered on December 13, 2005 in Class 43 for restaurant and lounge services. Opposer did not oppose this application. Opposer cannot now claim to be harmed by the Application since it was not harmed by the registration of the prior mark.

18. Opposer is barred from opposing Respondent’s Application on the grounds of *res judicata*. Two of Respondent’s other marks featuring the word ‘SIZZLE’ have already been the target of oppositions filed by Opposer. Both oppositions were dismissed with prejudice by the Board and the applications proceeded to mature into registrations that remain active. Opposer filed oppositions against Respondent’s marks “{FRIENDS OF RUTH’S} AN EVEN HIGHER DEGREE OF SIZZLE” (Opp. No. 91/179895) and “IF IT DOESN’T SIZZLE, SEND IT BACK” (Opp. No. 91/182564) both in Class 43 for restaurant and lounge services. Opposer cannot now claim that a third application featuring the word “SIZZLE” will cause it damage since two prior oppositions involving the same term ended in a final judgment against Opposer.

19. Opposer has no recognized or implied proprietary right in the term “SIZZLE” for any class of goods or services. It has not obtained nor plead any registration nor has it shown that it is using any mark that is made up only of the word “SIZZLE” in any class. As such, it is barred by the concept of equity from asserting proprietary rights in the word “SIZZLE” against the numerous other users, including Respondent, who have incorporated the word in their marks.

20. There does not exist any likelihood of confusion between Respondent’s Mark and Opposer’s Marks.

21. Opposer is estopped from bringing this current opposition on the grounds that it has failed to prosecute two prior oppositions that it filed against Respondent’s applications, both of which also featured the word “SIZZLE”. Opposer failed to respond to Respondent’s Motion for Summary Judgment and Motion to Dismiss for Failure to State a Claim in oppositions against, respectively, “{FRIENDS OF RUTH’S} AN EVEN HIGHER DEGREE OF SIZZLE” (Opp. No. 91/179895) and “IF IT DOESN’T SIZZLE, SEND IT BACK” (Opp. No. 91/182564). Opposer’s failure to file any response to these motions resulted in a default judgment in favor of Respondent and both marks maturing into registrations which are still valid today. Opposer’s failure to file any responses to these motions has also effectively stripped it of the right to now seek a third try at litigating Respondent’s right to use “SIZZLE” in its marks. When it defaulted, Opposer in effect acquiesced to Respondent’s registration of the prior marks featuring the word “SIZZLE” and cannot now argue that a third mark also featuring the word “SIZZLE” will damage or harm them.

Relief Requested

The Respondent respectfully requests that this Opposition proceeding be dismissed and that Respondent's application to register the Mark be granted.

Respectfully submitted:

Ruth's Hospitality Group, Inc.

Elise M. Stubbe

By: _____

Elise M. Stubbe, Esq.
Joseph C. Chautin, III, Esq.
Hardy, Carey, Chautin & Balkin LLP
1080 West Causeway Approach
Mandeville, Louisiana 70471
(985) 629-0777 *Telephone*
(985) 629-0778 *Facsimile*

estubbe@hardycarey.com

Counsel for Ruth's Hospitality Group, Inc.

Dated: October 12, 2012

Certificate of Service

I, Elise M. Stubbe, hereby certify that service of the foregoing Answer was made on October 12, 2012 via first class mail to the petitioner's counsel of record at the address below.

Rod S. Berman
Jeffer, Mangels Butler & Mitchell, LLP
1900 Avenue of the Stars, 7th Fl.
Los Angeles, CA 90067

Elise M. Stubbe

Elise M. Stubbe