

ESTTA Tracking number: **ESTTA506911**

Filing date: **11/21/2012**

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	Del Taco LLC		
Entity	Limited Liability Corporation	Citizenship	California
Address	25521 Commercentre Drive Lake Forest, CA 92630 UNITED STATES		

Attorney information	April L. Besl Dinsmore & Shohl, LLP 255 East Fifth Street Suite 1900 Cincinnati, OH 45202 UNITED STATES april.besl@dinsmore.com, joshua.lorentz@dinsmore.com, jennifer.miller@dinsmore.com Phone:5139778527		
----------------------	---	--	--

**Applicant Information**

Application No	85617158	Publication date	10/23/2012
Opposition Filing Date	11/21/2012	Opposition Period Ends	11/22/2012
Applicant	Highlands Restaurant Company II, LLC 887 W. Marietta Street NW, Studio K-102 Atlanta, GA 30318 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 043. First Use: 2008/10/21 First Use In Commerce: 2008/10/21 All goods and services in the class are opposed, namely: Restaurant 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.	3578966	Application Date	02/06/2008
Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	DEL TACO		

Design Mark	<b>DEL TACO</b>
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 1966/05/31 First Use In Commerce: 1966/05/31 Restaurant services


U.S. Registration No.	1035949	Application Date	03/24/1975
Registration Date	03/16/1976	Foreign Priority Date	NONE
Word Mark	DEL TACO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1966/05/05 First Use In Commerce: 1973/11/28 RESTAURANT SERVICES		


U.S. Registration No.	1728349	Application Date	08/31/1990
Registration Date	10/27/1992	Foreign Priority Date	NONE
Word Mark	DEL TACO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1986/00/00 First Use In Commerce: 1986/00/00 restaurant services

U.S. Registration No.	1793268	Application Date	12/02/1991
Registration Date	09/14/1993	Foreign Priority Date	NONE
Word Mark	DEL TACO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1992/01/01 First Use In Commerce: 1992/01/01 restaurant services		

U.S. Registration No.	1830903	Application Date	12/02/1991
Registration Date	04/12/1994	Foreign Priority Date	NONE
Word Mark	DEL TACO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1992/01/01 First Use In Commerce: 1992/01/01 restaurant services

U.S. Registration No.	2492285	Application Date	06/02/2000
Registration Date	09/25/2001	Foreign Priority Date	NONE
Word Mark	DEL TACO		
Design Mark			
Description of Mark	The mark consists of a three dimensional configuration of a sign, bearing a design and wording on one side which consists of a raised yellow sun rising behind a raised green mountain top border above the raised words 'DEL TACO' in white, all imprinted on and bordered by a red base.		
Goods/Services	Class 042. First use: First Use: 1992/04/23 First Use In Commerce: 1992/04/23 RESTAURANT SERVICES		

Attachments	77390173#TMSN.jpeg ( 1 page )( bytes ) 73047592#TMSN.jpeg ( 1 page )( bytes ) 74093227#TMSN.gif ( 1 page )( bytes ) 74226466#TMSN.gif ( 1 page )( bytes ) 74227652#TMSN.gif ( 1 page )( bytes ) 76063044#TMSN.gif ( 1 page )( bytes ) notice of opposition del taco.pdf ( 8 pages )(35975 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	/april l besl/
Name	April L. Besl
Date	11/21/2012

INTHEUNITEDSTATESPATENTANDTRADEMARKOFFICE  
BEFORETHETRADEMARKTRIALANDAPPEALBOARD

InreApplicationSerialNo.85/617,158 ) OppositionNo.\_\_\_\_\_  
DelTaco,LLC, )  
 ) Mark:THEORIGINALELTACO  
Opposer, ) andDesign  
v. ) PublishedforOpposition:  
 ) October23,2012  
HighlandsRestaurantCompanyII,LLC )  
DBATheOriginalElTaco )  
 )  
Applicant. )  
\_\_\_\_\_ )

CommissionerforTrademarks  
P.O.Box1451  
Alexandria,VA22313-1451

**NOTICEOFOPPOSITION**

Opposer, Del Taco, LLC (hereinafter “Del Taco” or “Opposer”), is a limited liability corporation of the state of California with an address of 25521 Commercentre Drive, Lake Forest, California 92630.

Opposer believes that it is or will be damaged by registration of the mark **THE ORIGINAL EL TACO and Design** by Applicant, Highlands Restaurant Company II, LLC DBA The Original El Taco, as shown in Application Serial No. 85/617,158 (the “Application”), and hereby opposes same, and opposes registration of the Application for the services set forth therein, namely:

THE ORIGINAL EL TACO and Design in International Class 043 covering “restaurant services.”

The Application was filed on May 4, 2012 under Section 1(a) of the Trademark Act, alleging first use and first use in commerce on October 21, 2008 and published in the Official Gazette of October 23, 2012. Thus, this Notice of Opposition is timely filed.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of several U.S. federal registrations relating to its distinctive and famous family of DEL TACO Marks (as defined below) used on, and registered for, a variety of goods and services, including but not limited to restaurant services and related services in International Class 043. Opposer is also the owner of the common law trademark DEL TACO used by Opposer in the United States for at least thirty years for restaurant services and related goods. (Opposer's well known and famous family of registered and common law DEL TACO Marks referenced immediately above in this paragraph and the registrations listed immediately below are collectively referred to hereinafter as the "Del Taco Marks.") While the following list is not exhaustive, particularly pertinent to this Opposition are the following relevant U.S. trademark registrations owned by Opposer regarding its DEL TACO Marks for restaurant services and related services:

- a. **DEL TACO**, U.S. Registration No. 3,578,966 in International Class 43 for "restaurant services" registered on February 24, 2009 and citing first use in commerce on May 31, 1966.
- b. **DEL TACO and Design**, U.S. Registration No. 1,035,949 in International Class 42 for "restaurant services" registered on March 16, 1976 and citing first use in commerce on November 28, 1973.
- c. **DEL TACO and Design**, U.S. Registration No. 1,728,349 in International Class 42 for "restaurant services" registered on October 27, 1992 and citing first use in commerce in 1986.
- d. **DEL TACO and Design**, U.S. Registration No. 1,793,268 in International Class 42 for "restaurant services" registered on September 14, 1993 and citing first use in commerce on January 1, 1992.
- e. **DEL TACO and Design**, U.S. Registration No. 1,830,903 in International Class 42 for "restaurant services" registered on April 12, 1994 and citing first use in commerce on January 1, 1992.

f. **DEL TACO and Design**, U.S. Registration No. 2,492,285 in International Class 42 for “restaurant services” registered on September 25, 2001 and citing first use in commerce on April 23, 1992.

2. The above listed registrations are valid, subsisting, and in good standing and each mark is registered on the Principal Register at the United States Patent and Trademark Office.

3. In addition to the above-listed registrations, Opposer is well-known and recognized under its business name “Del Taco” and under its distinctive and famous Del Taco logos, and Opposer owns and uses its DEL TACO Marks in connection with restaurant services and also a variety of goods and services it promotes on its website [www.deltaco.com](http://www.deltaco.com) and in various other advertising and promotional activities.

4. Opposer has engaged in open, prominent and extensive widespread promotion and advertising of its DEL TACO Marks for restaurant services at least as early as 1966, and Opposer is very well-known and well recognized as the source of the goods and services, particularly restaurant services, bearing Opposer’s DEL TACO Marks.

5. Opposer has expended substantial amounts of time, money and effort in advertising and promoting its DEL TACO Mark over a period throughout at least thirty years, and in establishing and preserving the goodwill associated therewith, and the goodwill associated with Opposer’s DEL TACO Mark is a valuable asset to Opposer.

6. Opposer has continuously used the DEL TACO Mark in U.S. commerce in connection with restaurant services and related services on a continuous and exclusive basis since at least as early as 1966, the date of first use in commerce recited in Opposer’s U.S. Registration No. 3,578,966 for DEL TACO.

7. Opposer’s DEL TACO Marks have become distinctive of, and associated in the minds of the purchasing public with Opposer as a well-known provider of restaurant services



offered under its DEL TACO Marks. By virtue of Opposer's efforts, Opposer has gained a significant and valuable reputation for the goods and services associated with its DEL TACO Marks.

8. Opposer's DEL TACO Marks are famous and distinctive within the meaning of the Lanham Act.

9. Declarations have been filed and accepted by the U.S. Patent and Trademark Office pursuant to Sections 8 and 15 of the Lanham Act, 15 U.S.C. §§ 1058 and 1065 for Registration Nos. 1,035,949, 1,728,349, 1,793,268, 1,830,903 and 2,492,285; therefore, these registrations are incontestable.

10. Upon information and belief, Applicant Highland Restaurant Company II, LLC DBA The Original El Taco is the owner of U.S. Trademark Application Serial No. 85/617,158 THE ORIGINAL EL TACO and Design ("Applicant's Mark") for the following services in International Class 043, described in the application as: "restaurant services."

11. Upon information and belief, Applicant is a limited liability company organized under the laws of Georgia, having an address of 887 W. Marietta Street NW, Studio K-102, Atlanta, Georgia 30318.

12. Applicant filed Application Serial No. 85/617, 158 under Section 1(a) of the Trademark Act on May 4, 2012, alleging first use on October 21, 2008.

13. Priority is not at issue: Opposer's longstanding use and prior registration of its DEL TACO Marks as described above is well prior to Applicant's filing date and also well prior to Applicant's alleged first use date asserted in its Application.

14. Applicant is not entitled to use or register the mark that is the subject of the Application for which it seeks registration in Application Serial No. 85/617,158, either on May

4, 2012, the date of filing said application, or on October 23, 2012, the date of publication thereof in the Official Gazette.

15. Applicant's services in International Class 043 covering restaurant services are the same as, closely related to, and overlapping with the goods offered by Opposer under its DELTACO Marks, and are or may be promoted to the same or similar class of consumers, and are available through the same or similar channels of trade.

16. Applicant's mark is nearly identical to, and confusingly similar to Opposer's DELTACO Marks in sight, sound, meaning, and commercial impression, and is used in connection with same services covered by Opposer's DELTACO Marks. An integral part of Applicant's mark is "ELTACO" which merely eliminates the letter "D" from DELTACO. For at least these reasons, when viewed for the same services, namely restaurant services, Applicant's Mark and Opposer's DELTACO Marks are nearly indistinguishable.

17. Applicant's Mark so closely resembles Opposer's DELTACO Marks as to be likely, when applied to the services of Applicant, to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's services originate with or come from Opposer, or are authorized, licensed, endorsed, sponsored by, or are connected in some way with Opposer, and therefore, the registration thereof by Applicant would be injurious to Opposer.

18. Applicant's design elements so closely resemble Opposer's design elements in its DELTACO Marks as to be likely, when applied to the services of Applicant, to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's services originate with or come from Opposer, or are authorized, licensed, endorsed, sponsored by, or are connected in some way with Opposer. Applicant's use of a semi-circle as well as the colors orange, red, and yellow evoke the impression of a sun or a sunset. Several of Opposer's DEL

TACO Design Marks use the image of a rising or setting sun in a semi-circle shape, including Registration Nos. 1,793,268; 1,830,903; and 2,492,285. Further, Applicant's design element resembles a backward letter "D" when viewed with Applicant's EL TACO wording appears to be the words "DEL TACO," which creates the same commercial impression and/or colorable imitation of Opposer's Del Taco Marks. For at least these reasons, when viewed for the same services, namely, restaurant services, Applicant's mark and Opposer's DEL TACO Marks are confusingly similar, and therefore the registration thereof by Applicant would be injurious to Opposer.

19. Applicant knew or should have known of Opposer's DEL TACO Marks when Applicant adopted its mark.

20. Applicant's adoption and use of Applicant's Mark is without the license or permission of Opposer.

21. Registration of Applicant's Mark is barred by the provision of 15 U.S.C. § 1052(d), for the reason that it consists of or comprises a mark which so resembles Opposer's DEL TACO Marks previously registered in the United States Patent and Trademark Office, previously used by Opposer and not abandoned, as to be likely, when used in connection with the goods of Applicant, to cause confusion, mistake or to deceive. For at least these reasons, any use of Applicant's Mark by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the goods offered under Applicant's Mark emanate from or are otherwise sponsored or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). This likelihood of confusion will damage Opposer within the meaning of 15 U.S.C. § 1063.

22. Applicant's use and attempted registration of Applicant's Mark is likely to cause confusion or mistake with respect to a false affiliation with Opposer and Opposer's DELTACO Marks, and therefore should be denied registration pursuant to 15 U.S.C. § 1125(a) and will damage Opposer within the meaning of 15 U.S.C. § 1063.

23. Applicant's use and attempted registration of Applicant's Mark is likely to lessen the capacity of Opposer's famous and distinctive DELTACO Marks to distinguish and identify Opposer's services from those of others, thereby diluting the distinctive quality of Opposer's DELTACO Marks in violation of 15 U.S.C. § 1125(c), and thereby causing damage to Opposer within the meaning of 15 U.S.C. § 1063.

24. Registration of Applicant's Mark to Applicant would create statutory rights in favor of Applicant, and thereby restrict, interfere with and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

25. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's Mark to Applicant on the Principal Register.

26. The Opposition fee in the amount of \$300.00 is filed herewith. The Commissioner is authorized to charge any underpayment to Deposit Account No. 04-1133 in case of any deficiency.

WHEREFORE, Opposer prays that said Application Serial No. 85/617,158 be rejected; that registration of THE ORIGINAL ELTACO and Design be refused and denied, and that this Opposition be sustained in Opposer's favor.

Opposer requests such other and further relief as the Board may deem just and proper.

Date:November21,2012

Respectfullysubmitted,

DINSMORE&SHOHL LLP

/s/April Besl

Joshua A. Lorentz

April L. Besl

Jennifer K. Miller

Attorneys for Opposer, Del Taco, LLC.

Email Joshua.Lorentz@dinsmore.com

April.Besl@dinsmore.com

Jennifer.Miller@dinsmore.com

Dinsmore & Shohl LLP

255 East Fifth Street, Suite 1900

Cincinnati, OH 45202

Voice: (513) 977-8503

Facsimile: (513) 977-8141

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Notice of Opposition has  
been served upon the following by regular U.S. mail this 21st day of November, 2012:

Highlands Restaurant Company II, LLC  
DBA The Original El Taco  
887 W. Marietta Street NW, Studio K-102  
Atlanta, Georgia 30318  
United States

/s/April Besl

Joshua A. Lorentz

April L. Besl

Jennifer K. Miller

Attorneys for Opposer, Del Taco, LLC.

Email: Joshua.Lorentz@dinsmore.com

April.Besl@dinsmore.com

Jennifer.Miller@dinsmore.com