

ESTTA Tracking number: **ESTTA590425**

Filing date: **03/04/2014**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	JEC II LLC		
Entity	limited liability company	Citizenship	New York
Address	411 W. 14th St. New York, NY 10014 UNITED STATES		

Name	The One Group LLC		
Entity	limited liability company	Citizenship	Delaware
Address	411 W. 14th St. New York, NY 10014 UNITED STATES		

Name	One Marks LLC		
Entity	limited liability company	Citizenship	Delaware
Address	411 W. 14th St. New York, NY 10014 UNITED STATES		

Attorney information	Michael R. Gilman Pergament Gilman & Cepeda LLP 163 Madison Ave. Ste 110 Morristown, NJ 07960 UNITED STATES mgilman@gilmanpergament.com, jdoloff@gilmanpergament.com Phone:973 998-7722		
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**Applicant Information**

Application No	85825300	Publication date	02/04/2014
Opposition Filing Date	03/04/2014	Opposition Period Ends	03/06/2014
Applicant	Kashin, Sergey 18201 Collins Ave #4204 Sunny Isles Beach, FL 33160 RUX		


**Goods/Services Affected by Opposition**


Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Restaurant services, namely, sit-down service of food and take-out restaurant services; cafe, namely, serving coffee and sweets; bar, namely, serving alcoholic beverages
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## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	lack of bona fide intent to use the mark of the opposed application in US commerce at, or around, the time of the filing of the opposed application; and common law rights in the mark ONE GROUP, THEONEGROUP, THE ONE GROUP and ONEGROUP.

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3924793	Application Date	07/28/2004
Registration Date	03/01/2011	Foreign Priority Date	NONE
Word Mark	ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2003/12/03 First Use In Commerce: 2003/12/03 cafe; bar services; cocktail lounge; and restaurant services		

U.S. Registration No.	4214402	Application Date	06/16/2004
Registration Date	09/25/2012	Foreign Priority Date	NONE
Word Mark	ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2012/04/10 First Use In Commerce: 2012/04/10		

	Night club services		
U.S. Application No.	78530113	Application Date	12/09/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE NEW ORLEANS		
Design Mark	<p style="text-align: center;"><b>ONE NEW ORLEANS</b></p>		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Cafes; bar services; cocktail lounges; restaurant services		

U.S. Application No.	78530118	Application Date	12/09/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE LOS ANGELES		
Design Mark	<p style="text-align: center;"><b>ONE LOS ANGELES</b></p>		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Cafes; bar services; cocktail lounges; restaurant services		

U.S. Application No.	78530122	Application Date	12/09/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE CHICAGO		

Design Mark	<b>ONE CHICAGO</b>
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Cafes; bar services; cocktail lounges; restaurant services

U.S. Application No.	78530126	Application Date	12/09/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE LAS VEGAS		
Design Mark	<b>ONE LAS VEGAS</b>		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Cafes; bar services; cocktail lounges; restaurant services		

U.S. Application No.	78530130	Application Date	12/09/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE ATLANTIC CITY		

Design Mark	<b>ONE ATLANTIC CITY</b>
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Cafes; bar services; cocktail lounges; restaurant services

U.S. Application No.	78663816	Application Date	07/05/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONE NEW YORK		
Design Mark	<b>ONE NEW YORK</b>		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Cafes; bar services; cocktail lounges; restaurant services		

U.S. Application No.	78528430	Application Date	12/07/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE ONE GROUP		

Design Mark	<b>THE ONE GROUP</b>
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 hotels, restaurants, cafes, bar services, cocktail lounges, resort hotels; health resort services, namely, providing food and lodging that specialize in promoting patrons' general health and well-being; and spa services, namely, providing temporary accommodations and meals to clients of a health or beauty spa.

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE ONE GROUP		
Goods/Services	restaurants, bars, lounges, cafes, nightclubs, promotion of the parties and special events of others, special event planning for business purposes, special event planning for commercial, promotional or advertising purposes, corporate event management services, charitable fund raising services by means of an entertainment event, arranging and conducting nightclub entertainment events, arranging and conducting special events for social entertainment purposes, disc jockeys for parties and special events, party planning, and entertainment services, namely, conducting parties		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THEONEGROUP		
Goods/Services	restaurants, bars, lounges, cafes, nightclubs, promotion of the parties and special events of others, special event planning for business purposes, special event planning for commercial, promotional or advertising purposes, corporate event management services, charitable fund raising services by means of an entertainment event, arranging and conducting nightclub entertainment events, arranging and conducting special events for social entertainment purposes, disc jockeys for parties and special events, party planning, and entertainment services, namely, conducting parties		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ONE GROUP		
Goods/Services	restaurants, bars, lounges, cafes, nightclubs, promotion of the parties and special events of others, special event planning for business		

	purposes, special event planning for commercial, promotional or advertising purposes, corporate event management services, charitable fund raising services by means of an entertainment event, arranging and conducting nightclub entertainment events, arranging and conducting special events for social entertainment purposes, disc jockeys for parties and special events, party planning, and entertainment services, namely, conducting parties
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ONEGROUP		
Goods/Services	restaurants, bars, lounges, cafes, nightclubs, promotion of the parties and special events of others, special event planning for business purposes, special event planning for commercial, promotional or advertising purposes, corporate event management services, charitable fund raising services by means of an entertainment event, arranging and conducting nightclub entertainment events, arranging and conducting special events for social entertainment purposes, disc jockeys for parties and special events, party planning, and entertainment services, namely, conducting parties		

Attachments	78458152#TMSN.jpeg( bytes ) 78436394#TMSN.jpeg( bytes ) 78530113#TMSN.jpeg( bytes ) 78530118#TMSN.jpeg( bytes ) 78530122#TMSN.jpeg( bytes ) 78530126#TMSN.jpeg( bytes ) 78530130#TMSN.jpeg( bytes ) 78663816#TMSN.jpeg( bytes ) 78528430#TMSN.jpeg( bytes ) Notice of Opposition.pdf(20808 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	/Michael R. Gilman/
Name	Michael R. Gilman
Date	03/04/2014

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

-----X	:	
<b>JEC II LLC, THE ONE GROUP LLC</b>	:	
<b>and ONE MARKS LLC,</b>	:	
	:	<b>Opposition No.</b>
<b>Opposers,</b>	:	<b>Serial No. 85/825,300</b>
	:	
<b>v.</b>	:	
	:	
<b>SERGEY KASHIN,</b>	:	
	:	
<b>Applicant.</b>	:	
-----X	:	

**NOTICE OF OPPOSITION**

**In the matter of** Application Serial No. 85/825,300 (“the ‘300 application”) for registration in International Class 43 of the mark 1 CAFÉ, BAR @ RESTAURANT, filed January 17, 2013, and published in the Official Gazette on February 4, 2014, in the name of Sergey Kashin (“applicant”), for “restaurant services, namely, sit-down service of food and take-out restaurant services; café, namely, serving coffee and sweets; bar, namely, serving alcoholic beverages.”

JEC II LLC (“JEC”), THE ONE GROUP LLC and One Marks LLC (“One Marks”) (hereinafter collectively referred to as “opposers”), are related companies, operating under a unity of control, located and doing business at 411 West 14<sup>th</sup> Street, New York, NY 10014, and believe they will be damaged by registration of the mark 1 CAFÉ, BAR @ RESTAURANT of the ‘300 application by applicant and hereby timely oppose registration of said mark pursuant to Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. Sec. 1063, on the following grounds:

1. JEC is the owner of, at least, U.S. Trademark Registration No. 3,924,793, for the mark ONE, filed in the USPTO on July 28, 2004, and issued on March 1, 2011, for cafés, bar



services, cocktail lounges and restaurant services in class 43, and U.S. Trademark Registration No. 4,214,402, for the mark ONE, filed in the USPTO on June 16, 2004, and issued on September 25, 2012, for night club services in class 41.

2. One Marks is the owner of the following marks of the following U.S. Trademark Applications:

A. ONE NEW ORLEANS, filed December 9, 2004, assigned Serial No. 78/530,113, covering cafes, bars, cocktail lounges and restaurants in class 43.

B. ONE LOS ANGELES, filed December 9, 2004, assigned Serial No. 78/530,118, covering cafes, bars, cocktail lounges and restaurants in class 43.

C. ONE CHICAGO, filed December 9, 2004, assigned Serial No. 78/530,122, covering cafes, bars, cocktail lounges and restaurants in class 43.

D. ONE LAS VEGAS, filed December 9, 2004, assigned Serial No. 78/530,126, covering cafes, bars, cocktail lounges and restaurants in class 43.

E. ONE ATLANTIC CITY, filed December 9, 2004, assigned Serial No. 78/530,130, covering cafes, bars, cocktail lounges and restaurants in class 43.

F. ONE MIAMI, filed July 5, 2005, assigned Serial No. 78/663,810, covering cafes, bars, cocktail lounges and restaurants in class 43.

G. ONE NEW YORK, filed July 5, 2005, assigned Serial No. 78/663,816, covering cafes, bars, cocktail lounges and restaurants in class 43.

2. One Group is the owner of the ONE GROUP name in various forms, including but not limited to, THEONEGROUP, ONEGROUP, ONE GROUP and THE ONE GROUP, for numerous and various services, including, but not limited to, restaurants, bars, lounges, cafes, nightclubs, promotion of the parties and special events of others, special event planning for

business purposes, special event planning for commercial, promotional or advertising purposes, corporate event management services, charitable fund raising services by means of an entertainment event, arranging and conducting nightclub entertainment events, arranging and conducting special events for social entertainment purposes, disc jockeys for parties and special events, party planning, and entertainment services, namely, conducting parties (hereinafter “the ONE GROUP name”).

3. One Group is also the owner of U.S. Trademark Application No. 78/528,430 for the mark THE ONE GROUP, filed December 7, 2004, assigned Serial No. 78/528,430, covering, amongst other services, restaurants, cafes, bars and cocktail lounges in class 43.

4. Opposers have operated, or have licensed, under the ONE mark, at least one restaurant, bar, café, lounge and/or nightclub, in commerce, since at least as early as December 3, 2003. Opposers continue to do so as of the filing date of this proceeding.

5. Opposers started providing at least restaurant, bar, café, lounge and nightclub services under the ONE GROUP name since at least 2005.

6. Opposer One Marks’ applications all have filing dates in 2004 or 2005.

7. Upon information and belief, the earliest date applicant can claim for its mark 1 CAFÉ, BAR @ RESTAURANT of the opposed ‘300 application is January 17, 2013, which is the filing date of the ‘300 application in the USPTO under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b). The ‘300 application claims no use of the mark by applicant in the US or in US commerce.

8. Opposers therefore have rights which are superior by many, many years to any which could be asserted by applicant in this proceeding, in at least their above stated identical or substantially similar marks for identical, and highly related, services to the mark and services of

the '300 application.

9. Applicant's alleged intention to use a mark that so closely resembles opposers' ONE marks and ONE GROUP name, evidences an intention by applicant to trade on opposers' goodwill.

10. There is a likelihood of confusion, mistake and/or deception between the mark 1 CAFÉ, BAR @ RESTAURANT of applicant's opposed '300 application and opposers' multiple ONE marks and ONE GROUP name for opposers' identical, and highly related, services, to the ordinary consumer within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d).

11. Upon information and belief, applicant lacked the requisite bona fide intention to use the mark 1 CAFÉ, BAR @ RESTAURANT of the '300 application in commerce when it filed its application to register that mark under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b).

12. Opposers will therefore be damaged by the registration sought by applicant, insofar as the registration would constitute *prima facie* evidence of the validity of the registration, applicant's ownership of the mark 1 CAFÉ, BAR @ RESTAURANT, and applicant's exclusive right to use the mark, when, in fact, applicant is not entitled to such rights by virtue of opposers' prior rights in their numerous ONE marks and ONE GROUP name as asserted herein, in association with identical and highly related services, the rights of which are superior to the rights applicant may assert in this proceeding.

13. On the basis of the foregoing, opposers are likely to be materially harmed and damaged by issuance to registration of the mark 1 CAFÉ, BAR @ RESTAURANT of the opposed '300 application.

**WHEREFORE**, opposers pray that the instant opposition be sustained and the issuance of a registration based on Application Serial No. 85/825,300 to applicant be denied.

The Commissioner is authorized to charge any deficiencies in payment, or credit any overpayment, to Deposit Account No. 50-4711.

Respectfully submitted,

PERGAMENT GILMAN & CEPEDA LLP  
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Dated: March 4, 2014

By: s/Michael R. Gilman/  
Michael R. Gilman

**CERTIFICATE OF SERVICE**

I, Michael R. Gilman, do hereby certify that a true and correct copy of the foregoing document, entitled “**NOTICE OF OPPOSITION,**” was served on this 4<sup>th</sup> day of March, 2014, by first class mail, postage prepaid, on applicant’s attorney of record in application Serial No. 85/825,300, and on applicant, as follows:

RAJ ABHYANKER  
RAJ ABHYANKER, P.C.  
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and

SERGEY KASHIN  
18201 Collins Ave #4204  
Sunny Isles Beach, FL 33160

Dated: March 4, 2014

By:           s/Michael R. Gilman/            
Michael R. Gilman

**Certificate Of Filing On ESTTA System**

I hereby certify that this document is being filed using the United States Patent and Trademark Office website ESTTA service, on this 4<sup>th</sup> day of March, 2014.

Dated: March 4, 2014

By:           s/Michael R. Gilman/            
Michael R. Gilman