

ESTTA Tracking number: **ESTTA662994**

Filing date: **03/25/2015**

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	The ONE Group LLC
Granted to Date of previous extension	03/25/2015
Address	411 West 14th Street New York, NY 10014 UNITED STATES

Name	JEC II LLC
Granted to Date of previous extension	03/25/2015
Address	411 West 14th Street New York, NY 10014 UNITED STATES

Attorney information	Michael Gilman Pergament Gilman & Cepeda LLP 163 Madison Ave ste 110 Morristown, NJ 07960 UNITED STATES mgilman@pgclawgroup.com Phone:9739987722
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### Applicant Information

Application No	86196638	Publication date	11/25/2014
Opposition Filing Date	03/25/2015	Opposition Period Ends	03/25/2015
International Registration No.	NONE	International Registration Date	NONE
Applicant	Outrigger Hotels Hawaii 2375 Kuhio Avenue Honolulu, HI 96815 UNITED STATES		

### Goods/Services Affected by Opposition


Class 043. First Use: 0 First Use In Commerce: 0 Opposed goods and services in the class: restaurant and bar services
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### Grounds for Opposition


False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Other	lack of bona fide intent to use the mark of the opposed application
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### 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.	78528430	Application Date	12/07/2004
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	THE ONE GROUP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 restaurants, cafes, bar services, cocktail lounges		

U.S. Application No.	86048226	Application Date	08/26/2013
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ONEXPERIENCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Corporate event management services; Promoting the parties and special events of others; Special event planning for business purposes; Special event planning for commercial, promotional or advertising purposes</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Charitable fundraising services by means of a golf event; Charitable fundraising services by means of an entertainment event</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Arranging and conducting nightclub entertainment events; Arranging and conducting nightclub parties; Arranging and conducting special events for social entertainment purposes; Cigar lounge services; Disc jockeys for parties and special events; Entertainment services, namely, conducting parties; Night club reservation services, namely, arranging for admission to night clubs and night club events; Night clubs; Party planning</p> <p>Class 043. First use: First Use: 0 First Use In Commerce: 0 Bar and restaurant services; Cafe and restaurant services; Cafes; Cocktail lounge services; Cocktail lounges; Making reservations and bookings for restaurants and meals; Restaurant reservation services; Restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises</p>		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ONE GROUP, THE ONE GROUP, ONEGROUP and THEONEGROUP		
Goods/Services	<p>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; and hotel hospitality services, namely, providing the following services at hotels, condos, hotel/condos and resorts: (a) food and beverage provisioning to guests and visitors whether via bars, restaurants, lounges, cafes, nightclubs,</p>		

	<p>pools, spas and gyms, room service, concessions, at events or gatherings, including banquets and conferences or bar/food services anywhere in such hotels, condos, hotel/condos or resorts; (b) concierge services; (c) information center services; (d) gift shops; (e) party planning; (f) event planning; (g) event management; (h) exhibits; (i) conference and banquet services; (j) charitable events; and (k) the running and provisioning of customer rewards programs.</p>
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Attachments	<p>78458152#TMSN.png( bytes )  78436394#TMSN.png( bytes )  78528430#TMSN.png( bytes )  86048226#TMSN.png( bytes )  916-082_Notice of Opposition.pdf(153240 bytes )</p>
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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 Gilman
Date	03/25/2015

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

-----X	:	
<b>THE ONE GROUP LLC and JEC II LLC</b>	:	
	:	<b>Opposition No.</b>
<b>Opposers,</b>	:	
	:	<b>Serial No. 86-196638</b>
v.	:	
	:	
<b>OUTRIGGER HOTELS HAWAII,</b>	:	
	:	
<b>Applicant.</b>	:	
-----X	:	

**NOTICE OF OPPOSITION**

**In the matter of** Application Serial No. 86-196638 (“the ‘638 application”) for registration in International Class 43 of the mark O.N.E BY OUTRIGGER, filed February 18, 2014, and published in the Official Gazette on November 25, 2014, in the name of Outrigger Hotels Hawaii, an Hawaii limited partnership (“applicant”), composed of Outrigger Enterprises, Inc., an Hawaii corporation, for “restaurant and bar services.”

The ONE Group LLC (“TOG”) and JEC II LLC (“JEC”) (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 of the ‘638 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:

Opposers hereby allege the following grounds in support of its opposition:

1. Opposer 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 (hereinafter collectively referred to as “the JEC Marks”).

2. TOG is the owner of THE ONE GROUP name in various forms, including but not limited to, THEONEGROUP, THE ONE GROUP, ONEGROUP and 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; and hotel hospitality services, namely, providing the following services at hotels, condos, hotel/condos and resorts: (a) food and beverage provisioning to guests and visitors whether via bars, restaurants, lounges, cafes, nightclubs, pools, spas and gyms, room service, concessions, at events or gatherings, including banquets and conferences or bar/food services anywhere in such hotels, condos, hotel/condos or resorts; (b) concierge services; (c) information center services; (d) gift shops; (e) party planning; (f) event planning; (g) event management; (h) exhibits; (i) conference and banquet services; (j) charitable events; and (k) the running and provisioning of customer rewards programs.

3. TOG is also the owner of the following U.S. Trademark Applications:

A. Serial No. 78/528,430 for the mark THE ONE GROUP, filed December 7,

2004, for restaurants, cafes, bar services and cocktail lounges in class 43; and

B. Serial No. 86/048,226 for the mark ONEXPERIENCE, filed August 8, 2013, for, amongst other services, Arranging and conducting nightclub entertainment events; Arranging and conducting nightclub parties; Arranging and conducting special events for social entertainment purposes; Cigar lounge services; Disc jockeys for parties and special events; Entertainment services, namely, conducting parties; Night club reservation services, namely, arranging for admission to night clubs and night club events; Night clubs; Party planning, in Class 41 and Bar and restaurant services; Cafe and restaurant services; Cafes; Cocktail lounge services; Cocktail lounges; Making reservations and bookings for restaurants and meals; Restaurant reservation services; Restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises, in Class 43.

4. Hereinafter, TOG's marks of paragraphs 2 and 3(A) above shall be collectively referred to as "THE ONE GROUP Marks".

5. Hereinafter, all of opposers' above asserted marks, both common law and as applied for or registered with the USPTO, shall be referred to collectively as, "Opposers' Marks".

6. Opposers have operated, or have licensed, under the JEC Marks, 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.

7. Opposers have operated under THE ONE GROUP Marks, at least one restaurant, bar, café, lounge and/or nightclub, in commerce, since at least 2005. Opposers continue to do so as of the filing date of this proceeding.

8. Opposers also offer hotel hospitality services under contract to hotels and casinos



under THE ONE GROUP Marks, since at least 2005. Opposers continue to do so as of the filing date of this proceeding.

9. Upon information and belief, the earliest date Applicant can rely upon for use in the United States of the O.N.E BY OUTRIGGER mark, is February 13, 2014, which is the priority filing date of the '638 application. The '638 application claims no use of the mark by applicant in the U.S. or in U.S. commerce, relying solely on Sections 1(b) and 44(d) of the Lanham Act, 15 U.S.C. § 1051(b) and 1126(d).

10. Opposers therefore have rights in Opposers' Marks which are superior (in some cases by many, many years) to any which could be asserted by applicant in this proceeding under the mark and opposed services of the '638 application.

11. Applicant's O.N.E BY OUTRIGGER mark, which is the subject of the '638 application, is substantially similar to each of Opposers' Marks in look, sound, connotation and commercial impression. Further, all of applicant's services to be offered under the mark of the '638 application, if not identical to those of Opposers' Marks, are highly related and overlapping to those of Opposers' Marks and travel in the same channels of trade as those of Opposers' Marks.

12. Accordingly, there is a likelihood of confusion, mistake and/or deception between the mark O.N.E BY OUTRIGGER of the '638 application and Opposers' Marks to the ordinary consumer and/or to the trade within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. Section 1052(d).

13. Upon information and belief, applicant lacked, and continues to lack, the requisite bona fide intention to use the O.N.E BY OUTRIGGER mark of the '638 application in commerce, for at least the contested Class 43 services of this proceeding, when it filed the '638

application under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b).

14. Additionally, and upon information and belief, applicant's developed emphasis on the mark O.N.E BY OUTRIGGER was, and is, intended to mimic and point uniquely to TOG's identity or persona. Indeed, over the years, and long before the alleged filing date of the '638 application, TOG has been, and continues to be, known as "The ONE Group", "ONE Group" and/or "THEONEGROUP". As such, applicant's mark O.N.E BY OUTRIGGER of the '638 application suggests a false connection with Opposer TOG, under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a).

15. TOG was incorporated in Delaware on December 3, 2004.

16. Applicant's O.N.E BY OUTRIGGER mark has improperly taken a significant element of TOG's name, *i.e.*, namely the element, "ONE" and simply added the non-differentiating term "By Outrigger".

17. Accordingly, applicant's O.N.E BY OUTRIGGER mark of the '638 application would be recognized as pointing uniquely and unmistakably to Opposer, TOG.

18. Members of the consuming public and trade have either referred to TOG by the names "The One Group", "THEONEGROUP", "One Group" and/or "ONE" over the years, and/or have been exposed to various advertisements, articles, and other forms of media that refer to TOG by the names "The One Group", "THEONEGROUP", "One Group" and/or "ONE".

19. In particular, TOG operates numerous well-known establishments throughout the United States. First and foremost is its famous STK restaurant chain, which has at least 6 restaurants located in six (6) of the United States' most popular and renowned cities: two (2) STK locations in New York City, as well as one STK in each of Los Angeles, California, Miami, Florida, Las Vegas, Nevada, Atlanta, Georgia and Washington, D.C. The New York City

location on Little West 12<sup>th</sup> Street, in New York's famed meatpacking district, was the first to open, on or around September 18, 2006. Next came the Los Angeles, California location, which opened on or around February 6, 2008, and which received media coverage for the excitement surrounding the planning and development of same prior to December 11, 2007. Thereafter, STK locations in Miami Beach and Las Vegas opened on or around January 6, 2010, and December 15, 2010, respectively. On December 1, 2011, two STK locations opened: (i) a second location in New York City, in midtown; (ii) and the STK in Atlanta, Georgia. The latest STK opened in Washington, D.C. in 2014, and others are in the works for Denver, CO and Chicago, IL.

20. TOG also operates other well-known and well regarded restaurants, lounges and hotel hospitality services throughout the United States, which further establish the fame or reputation of TOG, as follows: (i) HERAEA restaurant in Las Vegas, NV; (ii) ASELLINA restaurant in New York, New York and CUCINA ASELLINA restaurant in Atlanta, GA; (iii) BAGATELLE restaurants in New York, NY, Las Vegas, NV and Los Angeles, CA; (iv) Gansevoort Park Rooftop lounge in New York, NY; and (v) hotel hospitality locations, such as, the Gansevoort Park Avenue Hotel in New York, NY.

21. TOG has advertised, and exposed the public and trade to its "ONE" persona via its operation of these various establishments and its various hotel hospitality, restaurant, bar and lounge services, long before any date applicant can establish in this proceeding.

22. At all of these establishments, and for all of these provided services, THE ONE GROUP Marks are extensively marketed and promoted to the consuming public. All of these extensive activities and services performed and provided by TOG, at all of these numerous nationwide establishments, further establish and support that the persona or identity of opposer,

TOG, is famous or has a considerable reputation.

23. In addition to exposing the consuming public to its name, identity or persona via the aforementioned physical locations throughout the United States, TOG has further utilized, and continues to use, other avenues of exposing the consuming public to its name, identity or persona, such as, but not limited to, via its various social media sites, including, but not limited to, its website (togrp.com) and its Facebook and Twitter pages (*see e.g.*, <https://www.facebook.com/TheONEGroupUS>; <https://twitter.com/TheONEGroupUS>; <https://twitter.com/STKRooftopNYC/status/233662807923650560>; etc). By way of examples from the aforementioned Facebook, Twitter and togrp.com website pages, TOG has been, and is still, listing its name or identity in many ways as “The ONE Group”, “THEONEGROUP”, “THE ONE GROUP” and/or “One Group” while listing its many establishments therewith.

24. Other third party articles/reviews have further exposed the public to TOG and its famous and/or well-known establishments.

25. The aforementioned exposure evidences that the mark O.N.E BY OUTRIGGER of the ‘638 application points uniquely and unmistakably to TOG and that the fame or reputation of TOG is such that when the mark O.N.E BY OUTRIGGER of the ‘638 application is used to identify the applicant’s goods or services, a connection with TOG would be presumed/triggered in the minds of the members of the consuming public.

26. Opposer TOG also operates STK, HELIOT, and CUCINA ASELLINA locations in London, England, including a HELIOT located in The Hippodrome Casino, and the RADIO Rooftop bar, lounge and terrace at the ME London Hotel in London, England. As such, opposer TOG, is also famous, and/or has a well-known reputation, among consumers from Europe who visit TOG’s establishments in the United States. Indeed, opposers has created a vast empire

operated under the identity or name of “The One Group”, “THEONEGROUP”, “One Group” and/or “ONE”.

27. Many of opposers’ aforementioned establishments are located in hotels.

28. In view of the above, the aforementioned services, activities and commercial enterprises of opposers are related, and have an obvious connection, for many reasons to the restaurant and bar services being applied for under the O.N.E BY OUTRIGGER mark of the ‘638 application.

29. Opposers are not connected with the activities performed by applicant under the O.N.E BY OUTRIGGER mark of the ‘638 application. Opposers have not given applicant permission to use: (i) TOG’s persona or identity in any way; and/or (ii) the mark O.N.E BY OUTRIGGER of the ‘638 application in anyway. Opposers also have not provided applicant with permission to apply for the mark O.N.E BY OUTRIGGER of the ‘638 application with the USPTO or any other trade or service mark agency, and has not provided applicant with permission to own the mark of the ‘638 application. No license agreement or assignment exists between opposers and applicant, and opposers are not connected with applicant in any way.

30. The fame or reputation of Opposer TOG is such that when the mark O.N.E BY OUTRIGGER of the ‘638 application is used to identify applicant’s restaurant and/or bar services, a connection with TOG would be presumed/triggered in the minds of the members of the consuming public and trade. As established above, for a plurality of reasons, including, but not limited to, its services and establishments provided under its many famous, renowned brands, its commercial and promotional efforts surrounding them and its physical presence in many locations throughout the United States, Opposer TOG has established fame in the ONE and ONE Group names.

31. In view of the above, applicant's emphasis on, and incorporation of, the significant "ONE" element of opposer's name and identity will cause purchasers or consumers to assume that applicant's services provided under applicant's mark are connected with TOG's existing services provided under its name, identity or persona.

32. In view of the above, applicant's mark O.N.E BY OUTRIGGER of the '638 application suggests a false connection with Opposer TOG under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a).

33. Opposers will therefore be damaged by the registration sought in the '638 application, insofar as the registration would constitute *prima facie* evidence of the validity of the registration, applicant's ownership of the mark O.N.E BY OUTRIGGER, 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 Opposers' Marks, the rights of which are far superior to the rights applicant may assert in this proceeding.

34. On the basis of the foregoing, opposers are being, and are likely to be, materially harmed and damaged by the registration of applicant's O.N.E BY OUTRIGGER mark of the opposed '638 Application.

**WHEREFORE**, opposers, The ONE Group LLC and JEC II LLC, request that the instant Opposition be granted and the issuance of a registration based on Application Serial No. 86-196638 to applicant be denied based upon all the grounds hereinabove stated, including, but not limited to:

A. Applicant's O.N.E BY OUTRIGGER mark is likely to be confused with Opposers' Marks, which were in use in commerce, or the application(s) therefor were filed with the USPTO, earlier than applicant's earliest constructive use date;

B. Applicant's lack of a bona fide intent to use the O.N.E BY OUTRIGGER mark of the '638 application in US commerce;

C. Applicant's mark O.N.E BY OUTRIGGER of the '638 application suggests a false connection with Opposer TOG under Section 2(a) of the Lanham Act, 15, U.S.C. Section 1052(a)

D. Such further bases of relief as may be determined during the discovery stage of this proceeding; and

E. Such other and further relief as the Board may deem just.

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 25, 2015

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 document, entitled: “**NOTICE OF OPPOSITION**”, was served on this 25<sup>th</sup> day of March, 2015, by first class mail, postage prepaid, on applicant’s attorney of record for Application Serial No. 86-196638 and applicant, as follows:

Patricia L. Cotton, Esq.  
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and

Outrigger Hotels Hawaii  
2375 Kuhio Avenue  
Honolulu, Hawaii 96815

Dated: March 25, 2015

\_\_\_\_\_  
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 25<sup>th</sup> day of March, 2015.

Dated: March 25, 2015

\_\_\_\_\_  
s/Michael R. Gilman/  
Michael R. Gilman