

ESTTA Tracking number: **ESTTA831351**

Filing date: **07/05/2017**

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	33 SUBS, INC.
Granted to Date of previous extension	07/05/2017
Address	33 Ridgedale Avenue East Hanover, NJ 07936 UNITED STATES

Correspondence information	Mitchell P. Novick, Esq. Law Offices Of Mitchell P. Novick 623 Eagle Rock Avenue Suite 407 West Orange, NJ 07052 UNITED STATES Email: mnovick@mitchellnovick.com, nhyman@mitchellnovick.com Phone: 973-744-5150
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### Applicant Information

Application No	86476294	Publication date	03/07/2017
Opposition Filing Date	07/05/2017	Opposition Period Ends	07/05/2017
Applicant	Daniele & Sons, Inc. 3036 U.S. Highway 46 Parsippany, NJ 07054 UNITED STATES		

### Goods/Services Affected by Opposition

Class 043. First Use: 1985/11/01 First Use In Commerce: 1985/11/01  
All goods and services in the class are opposed, namely: Caf  services; Delicatessen services; Restaurant services; Take-out restaurant services

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1

### Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registra-	NONE	Application Date	NONE
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tion No.			
Registration Date	NONE		
Word Mark	GREAT WAZU		
Goods/Services	cafe services; delicatessen services; restaurant services; and take-out restaurant services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	THE GREAT WAZU		
Goods/Services	cafe services; delicatessen services; restaurant services; and take-out restaurant services		

Attachments	1920oppo_not.pdf(68959 bytes )
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Signature	/mitchell p. novick/
Name	Mitchell P. Novick, Esq.
Date	07/05/2017

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

In the Matter of Application Serial No. 86/476,294 Published: March 7, 2017 Mark: <b>GREAT WAZU</b>	Opposition No. _____
33 SUBS, INC.,  Opposer,  -vs-  DANIELE & SONS, INC.,  Applicant.	<b>NOTICE OF OPPOSITION</b>

Opposer, 33 SUBS, INC. ("Opposer"), a New Jersey corporation having its principal place of business at 33 Ridgedale Avenue, East Hanover, New Jersey, 07936, pursuant to TBMP §309 et seq., believes that it is or will be damaged by registration of U.S. Application Serial No. 86/476,294 directed to the trademark "GREAT WAZU" ("Mark"), filed by DANIELE & SONS, INC. ("Applicant") on December 10, 2014 ("Application"), and hereby opposes registration of this mark.

The grounds for opposition are as follows:

1. Applicant's Application, directed to the Mark "GREAT WAZU", for use in connection with "Café services; Delicatessen services; Restaurant services; Take-out

restaurant services" in International Class 043 (the "Application"), was published for opposition on March 7, 2017.

2. This Notice of Opposition is timely filed as to this Application.
3. The Application alleges the Mark was first used at least as early as November 1, 1985 and was first used in commerce as least as early as November 1, 1985.
4. The foregoing dates of first use for the Mark to the benefit of the Applicant are either not valid and/or otherwise not supported by the facts.

Factual Background - Opposer

5. In about 1981, Anthony Daniele ("TONY"), created the trade names "GREAT WAZU" and "THE GREAT WAZU" ("Trade Names") for use with restaurant services.
6. In about 1982, TONY opened up a restaurant with the trade name "THE GREAT WAZU" ("Original Restaurant") at 18 Route 10, East Hanover, New Jersey 07936.
7. The Original Restaurant's trade name "THE GREAT WAZU" was sometimes referred to in a shortened form at "GREAT WAZU".
8. The Trade Names "THE GREAT WAZU" and "GREAT WAZU" became valuable trademarks ("Trademarks") which TONY

owned, for use with restaurant services.

9. In about 1985, TONY was approached by his brother Joseph Daniele ("JOE"), who requested permission to open up a separate restaurant utilizing the Trademarks.
10. TONY gave permission to JOE to open one restaurant utilizing the Trademarks, to be located at 3071 U.S. Highway 46, Parsippany, New Jersey 07054 ("License").
11. As agreed by TONY and JOE, all benefits of use of the Trademarks under the License accrued to TONY.
12. Upon information and belief, JOE is a principal of Applicant.
13. Upon information and belief, Applicant was formed on about January 24, 1986.
14. The Original Restaurant was in continual operation from opening until TONY sold it to BUDDMEN, all that time utilizing the Trade Names and Trademarks.
15. In about 1989, BUDDMEN purchased from TONY the Restaurant ("First Sale").
16. The First Sale included all goodwill in TONY's restaurant business, and all rights in the Trade Names and ("Trademarks"), subject to the License.

17. At no time during BUDDMEN's ownership of the Original Restaurant did BUDDMEN give JOE or anyone else permission to use the Trade Names and Trademarks.
18. In about 2001, due to a fire, the Original Restaurant was moved to a new location, 33 Ridgedale Avenue, East Hanover, New Jersey 07936 ("Fire Relocation").
19. Other than the time necessary for the Fire Relocation, the Original Restaurant was in continual operation from the First Sale until sold to 33 SUBS on about December 17, 2013 ("Second Sale") all that time utilizing the Trade Names and Trademarks.
20. As part of the Second Sale, 33 SUBS obtained from BUDDMEN all goodwill in BUDDMEN, and all rights in the Trade Names and Trademarks, subject to the License.
21. At about the time of the Second Sale, JOE confirmed and agreed to 33 SUBS's rights regarding the trademark "THE GREAT WAZU".
22. Thus, a restaurant utilizing the Trade Names and Trademarks, and under the control and/or ownership of Opposer and its predecessors in interest, has been in continual operation from its original opening in about 1982 until today.
23. The Original Restaurant has become a well known food establishment specializing in cafe services;

delicatessen services; restaurant services; and take-out restaurant services.

24. As such, Opposer is the owner of significant common law rights from the use, advertisement and promotion of the Trade Names and Trademarks.

25. Except for the License, at no time did any owner of the Trade Names and Trademarks sell, transfer, intend to sell, or intend to transfer the Trademarks, any good-will associated with the Trade Name and Trademarks, or any exclusive or other rights regarding the Trade Names and Trademarks to Applicant, JOE, or any other third-party.

Legal Basis for Opposition

26. Opposer has a priority date predating any priority date associated with the Applicant.

27. In view of the fact that Opposer's Trademarks ("GREAT WAZU" and "THE GREAT WAZU" marks) are identical to the Applicant's "GREAT WAZU" Mark for which the Applicant seeks registration, together with the fact that both parties provide identical and closely related goods, Applicant's designations so resembles Opposer's marks as to likely cause confusion or to cause mistake or to deceive within the meaning of section 2(d) of the Lanham Act, 15 U.S.C. 1052(d).

28. Opposer has expended considerable effort and expense in promoting the Trade Names and Trademarks with the result that the purchasing public has come to know, rely upon, and recognize them with the goods and services of the Opposer.
29. Opposer has exceedingly valuable goodwill established in its Trade Names and Trademarks.
30. Federal Registration of Applicant's "GREAT WAZU" Mark would provide the Applicant with prima facie evidence of the exclusive right to use the "GREAT WAZU" Mark to the possible exclusion of the Opposer, who has a legitimate and superior right to use the Mark.
31. Likewise, if the Applications complained of herein were allowed to mature into a Registration, Opposer's legitimate and superior right to use the "GREAT WAZU" Mark in commerce on virtually identical goods and services as sold by Applicant will cause confusion in trade and in the public, all to the great detriment of Opposer.
32. Applicant does not have any rights in the Mark, except pursuant to the License.
33. Applicant does not have Opposer's consent to use the Mark.
34. Applicant does not have Opposer's consent to register



the "GREAT WAZU" Mark.

35. Concurrent use of the "GREAT WAZU" Mark by Applicant will result in damage to Opposer's long standing reputation and goodwill, if the goods and services sold by the Applicant are inferior, since purchasers are likely to attribute the source of the Applicant's goods to Opposer.

36. By reason for the foregoing, Opposer believes and submits that it will be damaged by the registration of the Applicant's Mark.

WHEREFORE, Opposer prays that this Opposition be sustained and the registration sought by Applicant be refused and for all such further relief as the Trademark Trial and Appeal Board may deem necessary.

Dated: July 5, 2017

Respectfully submitted,

LAW OFFICES OF MITCHELL P. NOVICK

By:           /mitchell p. novick/            
MITCHELL P. NOVICK, ESQ.

Counsel for Opposer  
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MPN/s  
2017-1920

Notice Of Opposition

Opposition No. \_\_\_\_\_

**CERTIFICATE OF SERVICE**

I, MITCHELL P. NOVICK, hereby certify that a true and correct copy of the foregoing Notice Of Opposition was served upon the attorney of record for the Applicant by first-class mail, postage-prepaid to the following address, on the undersigned date:

Christopher J. McHattie, Esq.  
THE MCHATTIE LAW FIRM  
Counsel for Applicant  
550 West Main Street  
Boonton, New Jersey 07005

Dated: July 5, 2017

          /mitchell p. novick/            
MITCHELL P. NOVICK