

ESTTA Tracking number: **ESTTA1067876**

Filing date: **07/13/2020**

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	Wolfgang Puck Licensing LLC
Granted to Date of previous extension	07/15/2020
Address	955 KELLY JOHNSON DRIVE LAS VEGAS, NV 89119 UNITED STATES

Name	Wolfgang Puck
Granted to Date of previous extension	07/15/2020
Address	8687 MELROSE AVE. WEST HOLLYWOOD, CA 90069 UNITED STATES

Correspondence information	ROBERT S. CHAPMAN SAUER & WAGNER LLP 1801 CENTURY PARK EAST SUITE 1150 1150 LOS ANGELES, CA 90067 UNITED STATES Primary Email: rchapman@swattys.com Secondary Email(s): Gbarchie@swattys.com (310) 712-8111
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Applicant Information

Application No.	79263615	Publication date	03/17/2020
Opposition Filing Date	07/13/2020	Opposition Period Ends	07/15/2020
International Registration No.	1478565	International Registration Date	04/30/2019
Applicant	Wolfgang Joop RIBBECKSTR . 39 14469 POTSDAM FED REP GERMANY		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Design of restaurants, namely, interior and

architectural design; furnishing design services for the interiors of buildings; design of building interiors; interior design

Class 043. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Services for providing food and drink, namely, food and drink catering, bar and restaurant services; providing temporary accommodation; hotel services; bar and restaurant services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1901065	Application Date	06/06/1994
Registration Date	06/20/1995	Foreign Priority Date	NONE
Word Mark	WOLFGANG PUCK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/06/01 First Use In Commerce: 1991/06/01 restaurant services		

Attachments	Notice of Opposition to Application Serial No. 79263615 (00205714x7A6 7A).PDF(1703638 bytes)
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Signature	/RSC/
Name	Robert S. Chapman
Date	07/13/2020

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

In the Matter of Application Serial No. 792636615

Published in the Official Gazette of March 17, 2020

WOLFGANG PUCK and
WOLFGANG PUCK LICENSING
LLC,

Opposers,

v.

WOLFGANG JOOP,

Applicant.

Opposition No: _____

NOTICE OF OPPOSITION

Opposers Wolfgang Puck (“Puck”) and Wolfgang Puck Licensing LLC (“Licensing”) believe that they each will be damaged by registration of the mark shown in Application Serial No. 792636615 and therefore oppose the Application.

As grounds for opposition, Puck and Licensing allege as follows:

1. Puck is a United States citizen with an address in West Hollywood, California.

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2. Licensing is a limited liability company organized and existing under the laws of the State of Nevada with offices in Las Vegas, Nevada.

3. Applicant Wolfgang Joop (“Joop”) is an individual who resides in Potsdam, Germany. On information and belief, Joop is known in the fashion and cosmetics industries specifically in connection with clothing, shoes, and jewelry.

4. On April 30, 2019, Joop filed Application Serial No. 79263615 to register the claimed mark “THE WOLFGANG” on the Principal Register and for extension of an International Registration No. 1478565 in International classes 42 and 43 concerning restaurants and restaurant design. Specifically, Joop applied to use the mark for “design of restaurants, namely interior and architectural design; furnishing design services for the interiors of buildings; design building interiors; interior designs” and “services for providing food and drink, namely, food and drink catering, bar and restaurant services; providing temporary accommodation; hotel services; bar and restaurant services” on the basis of Joop’s alleged intention to use the claimed mark in commerce.

5. Puck is a world-renowned chef and restaurateur. He has also designed some of the most iconic restaurants such as Spago, Chinois on Main, Cut, and many more. From a time long prior to the filing date of Joop’s Application, or any earlier date of actual use of the mark shown in Joop’s application upon which Joop can rely, and continuously to the present, Licensing and/or its predecessor-in-

interest have used, and licensed the use of, and continue to use and license the use of the mark “WOLFGANG PUCK” in the United States in connection with restaurant services, restaurants, a wide variety of foods, packaged, frozen, and prepared food, and cooking utensils and products. Puck assigned the “Wolfgang Puck” mark to Licensing in 2011. The “Wolfgang Puck” mark became famous long prior to the filing date of Joop’s application, or any earlier date of actual use of the mark shown in Joop’s Application upon which Joop can rely.

6. Licensing owns United States Trademark Registration No. 1901065 for the mark “WOLFGANG PUCK” for restaurant services. This registration is valid and subsisting and has become incontestable. A copy of the record of this registration taken from the TSDR electronic database of the Patent and Trademark Office and showing the current status and title of this registration is attached hereto as Exhibit 1 and incorporated by this reference.

7. Joop’s use of the mark in his Application in connection with the identified services is likely to cause consumers of those services to believe mistakenly that those services originate with, or are sponsored, licensed, or authorized by Licensing or are otherwise affiliated with Puck.

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FIRST CLAIM FOR RELIEF

(Likelihood of Confusion with Registered Service Mark)

8. Licensing repeats and realleges the allegations in paragraphs 1 through 7 as if fully set forth herein.

9. The mark “THE WOLFGANG” as shown in Joop’s Application so resembles Licensing’s registered mark “WOLFGANG PUCK” for restaurant services as to be likely, when used on or in connection with the services identified by Joop in his Application, to cause confusion, to cause mistake, or to deceive, that Joop’s Application is unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d). This conclusion, and the intent to deceive, is manifest given Puck’s famous identification with restaurants and food and Joop’s identification solely with clothing and jewelry design.

10. Licensing will be damaged by registration of the mark shown in Joop’s Application because such registration will give Joop *prima facie* evidence of ownership of and the exclusive right to use a mark that is confusingly similar to Licensing’s registered mark, in derogation of Licensing’s rights in its registered mark.

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SECOND CLAIM FOR RELIEF

(Likelihood of Confusion with Previously Used Marks)

11. Licensing repeats and realleges the allegations in paragraphs 1 through 7 as if fully set forth herein.

12. “THE WOLFGANG” mark as shown in Joop’s Application so resembles Licensing’s mark “WOLFGANG PUCK” previously used in the United States in connection with restaurant services, foods, and food and cooking products, and not abandoned, as to be likely, when used on or in connection with the services identified in Joop’s Application, to cause confusion, or to cause mistake, or to deceive, that Joop’s mark is therefore unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

13. Licensing will be damaged by registration of the mark shown in Joop’s Application because such registration will give Joop *prima facie* evidence of ownership of and the exclusive right to use a mark that is confusingly similar to Licensing’s previously-used and not-abandoned marks, in derogation of Licensing’s rights in its mark.

THIRD CLAIM FOR RELIEF

(False Suggestion of Connection with Living Person)

14. Puck repeats and alleges the allegations in paragraphs 1 through 7 as if fully set forth herein.

15. The mark in Joop's Application, "THE WOLFGANG" when used in connection with restaurant services, falsely suggests a connection with Wolfgang Puck. Why would Joop suggest using a mark related to his first and not his last name, in a proposed business with which he has had virtually no connection previously? The statement of the question reveals the answer: to falsely suggest a connection, in the restaurant business, with the world-famous Wolfgang Puck. This conclusion, and the intent to deceive, is manifest given Puck's famous identification with restaurants and food and Joop's identification solely with clothing and jewelry design.


16. The mark in Joop's Application incorporates Puck's exact first name. That name points uniquely and unmistakably to Puck as related to the restaurant and food world. Puck has no previous connection with Joop in the restaurant business or otherwise. Puck is world-famous and the use of his first name in connection with restaurants would necessarily cause the public to presume a connection with him. Joop's mark in his Application falsely suggests a connection with Puck and is therefore unregistrable under § 2(a) of the United States Trademark Act, 15 U.S.C. § 1052(a).

17. Puck will be damaged by registration of the mark in Joop's Application because that registration will give Joop *prima facie* evidence of

ownership of and the exclusive right to use a mark that will falsely suggest a connection with Puck.

WHEREFORE, Opposers Puck and Licensing pray for judgment sustaining this opposition and refusing registration to Joop of the mark shown in his Application.

Respectfully submitted,
SAUER & WAGNER LLP

By: 
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Attorneys for Opposers
Wolfgang Puck and Wolfgang Puck Licensing

EXHIBIT 1

For assistance with TSDR, email teas@uspto.gov and include your serial number, the document you are looking for, and a screenshot of any error messages you have received.

STATUS DOCUMENTS MAINTENANCE

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Mark: WOLFGANG PUCK

No Image exists for this case.

US Serial Number: 74533352

Application Filing Date: Jun. 06, 1994

US Registration Number: 1901065

Registration Date: Jun. 20, 1995

Register: Principal

Mark Type: Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office

Status: The registration has been renewed.

Status Date: Jul. 02, 2014

Publication Date: Mar. 28, 1995

Mark Information

Mark Literal Elements: WOLFGANG PUCK

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Name Portrait Consent: The name shown in the mark is of a living individual, whose consent to applicant's use and registration of his submitted herewith.

Related Properties Information

Claimed Ownership of US [1593275](#)

Registrations:

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: restaurant services

[Privacy - Terms](#)

International Class(es): 042 - Primary Class

U.S Class(es): 100

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 01, 1991

Use in Commerce: Jun. 01, 1991

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: WOLFGANG PUCK LICENSING LLC

Owner Address: 3500 LAS VEGAS BLVD. SOUTH
SUITE G-1
LAS VEGAS, NEVADA UNITED STATES 89109

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NEVADA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Joan Kupersmith Larkin

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Address:

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: JOAN KUPERSMITH LARKIN
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LOS ANGELES, CALIFORNIA UNITED STATES 90067

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Correspondent e-mail: jlarkin@seyfarth.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 02, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jul. 02, 2014	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	59136

Privacy - Terms

Jul. 02, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	59136
Jun. 30, 2014	TEAS SECTION 8 & 9 RECEIVED	
Mar. 16, 2011	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jun. 19, 2008	NOTICE OF SUIT	
May 22, 2008	NOTICE OF SUIT	
Oct. 19, 2006	REVIEW OF CORRESPONDENCE COMPLETE	76874
Apr. 13, 2005	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Apr. 13, 2005	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Apr. 13, 2005	ASSIGNED TO PARALEGAL	59136
Feb. 28, 2005	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Feb. 28, 2005	PAPER RECEIVED	
Feb. 23, 2005	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 30, 2001	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jun. 06, 2001	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Jun. 20, 1995	REGISTERED-PRINCIPAL REGISTER	
Mar. 28, 1995	PUBLISHED FOR OPPOSITION	
Feb. 24, 1995	NOTICE OF PUBLICATION	
Oct. 31, 1994	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 07, 1994	ASSIGNED TO EXAMINER	67568
Oct. 04, 1994	ASSIGNED TO EXAMINER	61804

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Jul. 02, 2014

Assignment Abstract Of Title Information - Error retrieving assignments

Proceedings

Summary

Number of Proceedings: 4

Type of Proceeding: Cancellation

Type of Proceeding: Opposition

Type of Proceeding: Opposition

Type of Proceeding: Opposition