

ESTTA Tracking number: **ESTTA1120049**

Filing date: **03/12/2021**

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	LFP IP, LLC
Granted to Date of previous extension	03/13/2021
Address	8484 WILSHIRE BOULEVARD SUITE 900 BEVERLY HILLS, CA 90211 UNITED STATES
Attorney information	JONATHAN W. BROWN LIPSITZ GREEN SCIME CAMBRIA LLP 42 DELAWARE AVENUE SUITE 120 BUFFALO, NY 14202 UNITED STATES Primary Email: ip@lglaw.com 7168491333
Docket Number	11740.1935

Applicant Information

Application No.	90031272	Publication date	01/12/2021
Opposition Filing Date	03/12/2021	Opposition Period Ends	03/13/2021
Applicant	James, Dennis 4 LANDMARK CT. BALTIMORE, MD 21221 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Clothing, namely, shirts, pants, t-shirts, sweatshirts, jackets, shorts, socks, caps being headwear, hats, and scarves

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4312312	Application Date	07/19/2012
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Registration Date	04/02/2013	Foreign Priority Date	NONE
Word Mark	HUSTLER HOLLYWOOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1998/12/03 First Use In Commerce: 1998/12/03 Retail store services featuring digitalvideo discs, adult sexual stimulation aids, apparel, lingerie, hats, cosmetics,candles, perfumes, shave creams, bath and body products, personal lubricants, body creams, novelty items, party games, playing cards, candies, jewelry, books, magazines, condoms, and lotions		

U.S. Registration No.	2689852	Application Date	10/16/2000
Registration Date	02/25/2003	Foreign Priority Date	NONE
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/12/03 First Use In Commerce: 1998/12/03 clothing, namely, beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits, jumpers, leg warmers, leggings, lingerie, lounge wear, neckwear, pants, scarves, shirts, ski wear, slacks, sleep wear, tank tops, socks, vests		

U.S. Registration No.	2679483	Application Date	10/16/2000
Registration Date	01/28/2003	Foreign Priority Date	NONE
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1999/09/20 First Use In Commerce: 1999/09/20 men's and women's jewelry, namely, rings, necklaces, bracelets, [watches] Class 021. First use: First Use: 2000/10/01 First Use In Commerce: 2000/10/01 glassware, namely, shot glasses, mugs, beer steins		

U.S. Registration No.	2773372	Application Date	10/22/2002
Registration Date	10/14/2003	Foreign Priority Date	NONE
Word Mark	HUSTLER CLUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2000/12/28 First Use In Commerce: 2000/12/28 operation of night clubs		

U.S. Registration No.	5576427	Application Date	10/03/2016
Registration Date	10/02/2018	Foreign Priority Date	NONE
Word Mark	HUSTLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1998/12/03 First Use In Commerce: 1998/12/03 Bathing suits; bras; bustiers; corsets; footwear; gloves; hats; hoodies; infantwear; nipple covers, namely, pasties; skirts; sweaters; sweatpants; sweatshirts; T-shirts; tops; underwear		

Attachments	Notice of Opposition - HUSTLERS SOCIETY.pdf(43672 bytes)
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Signature	/Jonathan W. Brown/
Name	JONATHAN W. BROWN
Date	03/12/2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE

TRADEMARK TRIAL AND APPEAL BOARD

In re Application No. 90031272
Filed: July 1, 2020
Published: January 12, 2020 in the *Official Gazette*
For: **HUSTLER’S SOCIETY**

LFP IP, LLC,

Opposer,

v.

DENNIS JAMES,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

Opposer LFP IP, LLC (“Opposer” or “LFP”), a Delaware limited liability company, believes that it would be damaged by the registration on the principal register of the HUSTLER’S SOCIETY mark shown in Application Serial No. 90031272 and hereby opposes registration thereof.

As grounds for opposition, LFP alleges:

Opposer and its HUSTLER® Marks

1. Opposer LFP IP, LLC is a limited liability company organized under the laws of the State of Delaware, having a principal place of business at 8484 Wilshire Boulevard, Suite 900, Beverly Hills, California 90211.

2. LFP, through its affiliated companies and licensees, provides various goods and services throughout the world utilizing its famous HUSTLER marks.

3. Since at least as early as 1972, LFP, through its predecessors, related companies, and licensees, has used its HUSTLER mark in connection with an entertainment magazine under that mark.

4. Opposer first used its HUSTLER and/or HUSTLER composite marks in commerce on or in connection with magazines as early as 1972; online magazines as early as 1993; sexual aids as early as 1997; clothing and retail store services as early as 1998; DVDs and jewelry as early as 1999; night clubs and glassware as early as 2000; broadcasting services as early as 2004; cigarette lighters as early as 2005; garments for pets as early as 2007; and motorcycle helmets as early as 2008.

5. Opposer owns numerous federal registrations on the Principal Register for its HUSTLER marks and various related and composite marks, many of which have become incontestable within the meaning of the Lanham Act. Such registrations include, but are not limited to, the following:

Mark	Reg. No.	Reg. Date	Date of First Use in Commerce	Goods/Services
HUSTLER HOLLYWOOD	4312312	04-02-2013	12-03-1998	Retail store services featuring digital video discs, adult sexual stimulation aids, apparel, lingerie, hats, cosmetics, candles, perfumes, shave creams, bath and body products, personal lubricants, body creams, novelty items, party games, playing cards, candies, jewelry, books, magazines, condoms, and lotions in Class 35
HUSTLER	2689852	02-25-2003	12-06-1998	Clothing, namely, beach wear, blouses, coats, coveralls, dresses, head wear, jackets, jeans, jogging suits,

				jumpers, leg warmers, leggings, lingerie, lounge wear, neckwear, pants, scarves, shirts, ski wear, slacks, sleep wear, tank tops, socks, vests in Class 25
HUSTLER	2679483	01-28-2003	09-20-1999	Men's and women's jewelry, namely, rings, necklaces, bracelets in Class 14; Glassware, namely shot glasses, mugs, beer steins in Class 21
HUSTLER CLUB	2773372	10-14-2003	12-28-2000	Operation of night clubs in Class 41
HUSTLER	5576427	10-02-2018	12-03-1998	Bathing suits; bras; bustiers; corsets; footwear; gloves; hats; hoodies; infant wear; nipple covers, namely, pasties; skirts; sweaters; sweatpants; sweatshirts; T-shirts; tops; underwear in Class 25

6. The federal trademark registrations set forth in Paragraph 5 above (among others, the “HUSTLER Marks”) are valid and subsisting, and constitute prima facie evidence of their validity.

7. By virtue of its extensive and longtime use, substantial worldwide promotional efforts and commercial success of its famous HUSTLER Marks, LFP has established valuable goodwill in the HUSTLER Marks, and the public has come to associate LFP's marks with LFP and its famous founder, Larry Flynt. As such, the HUSTLER Marks have become distinctive and the public has come to know the HUSTLER Marks as an indication of goods and services that originate from Opposer.

The “HUSTLER’S SOCIETY” Application

8. Upon information and belief, Dennis James is an individual with an address of 4 Landmark Court, Baltimore, Maryland 21221 (“Applicant”).

9. On July 1, 2020, Applicant filed U.S. Application Serial No. 90031272 under Section 1(b), 15 U.S.C. § 1051(b) to register the standard character mark HUSTLER'S SOCIETY (the "Application"). After several Examiner's Amendments, the Application was approved for publication for use in connection with "*Clothing, namely, shirts, pants, t-shirts, sweatshirts, jackets, shorts, socks, caps being headwear, hats, and scarves*" in International Class 025.

10. As used herein, "Applicant's Mark" shall refer to the HUSTLER'S SOCIETY mark contained in the application referenced above.

11. As used herein, the "Opposed Goods" shall refer to those goods currently listed in the HUSTLER'S SOCIETY application referenced above.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

12. Opposer has priority based on its prior valid and subsisting registrations for its HUSTLER family of marks. Further, Opposer has used its HUSTLER Marks in commerce before the filing date of the opposed Application and any first use dates that may be asserted by Applicant.

13. The goods identified in the Application are identical and/or highly related to the goods and services identified in LFP's registrations and applications for the HUSTLER Marks, and with which LFP has been using its HUSTLER Marks for many years.

14. The goods identified in the opposed Application are likely to be sold and/or distributed through the same channels of trade and to the same class of purchasers as Opposer's goods and/or services are sold or distributed and/or are intended to be sold and/or distributed under its HUSTLER Marks.

15. Applicant's "HUSTLER'S SOCIETY" mark incorporates Opposer's HUSTLER Mark in its entirety and is likely to cause confusion, mistake or deception in the trade and among ordinary consumers and prospective purchasers as to the source, origin or sponsorship of the parties' respective goods under Section 2(d), 15 U.S.C. § 1052(d).

16. Consumers encountering Applicant's Mark in connection with the Opposed Goods are likely to associate Applicant's Mark with Opposer, and are likely to assume, mistakenly, that the Opposed Goods offered under Applicant's Mark originate with Opposer or that the Opposed Goods are sponsored, endorsed or otherwise authorized by, licensed through, or otherwise associated with Opposer.

17. Opposer would be damaged by registration of Applicant's Mark because registration would grant Applicant statutory rights under the Trademark Act of 1946, and would tend to restrict, interfere with, and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, LFP prays that this Opposition be sustained and that registration of U.S. Trademark Application Serial No. 90031272 be denied.

Dated: March 12, 2021

Respectfully submitted,

LFP IP, LLC, by its counsel
LIPSITZ GREEN SCIME CAMBRIA LLP

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