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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Black Dog Tavern Company, Inc.
v.
The King Street Investment Company, L.L.C.

Opposition No. 113,007
to application Serial No. 75/509,509
filed on June 24, 1998

Zick Rubin of Hill & Barlow for The Black Dog Tavern
Company, Inc.

George E. Marzloff for The King Street Investment
Company, L.L.C.

Before Simms, Bottorff, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

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The King Street Investment Company, L.L.C.
(applicant) has applied to register the mark shown below
for "coffee" in International Class 30."¹



The Black Dog Tavern Company, Inc. (opposer) has
opposed registration on the ground that it "has held
common and statutory rights in the marks Black Dog Brand
Coffee (with drawing of a black dog), The Black Dog
Coffee Beans (with drawing of a black dog)), The Black
Dog, The Black Dog Tavern, and drawings of a black dog
(collectively, 'The Black Dog Tavern Marks') as applied
to coffee as well as to related products and services."
Notice of Opposition at 1-2. Specifically, opposer
alleges that it owns three registrations. Two are for
the words THE BLACK DOG in typed form for "restaurant and
bakery shop services"² and "printed matter, namely
catalogues published periodically featuring clothing,

¹ Serial No. 75/509,509, filed June 24, 1998, which alleges a date of first use of June 10, 1998, and a date of first use in commerce of June 11, 1998.

² Registration No. 1,559,349, issued October 3, 1989.

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food, jewelry, toys and gift items."³ Opposer also alleges that it owns the following design mark for "restaurant and bakery shop services"⁴:



Applicant filed an answer in which it denied the salient allegations of the notice of opposition.

The record consists of the file of the involved application; opposer's nine requests for admission; and applicant's admissions.⁵ Applicant submitted no evidence.

Applicant's admissions, made of record by opposer, are set out below:

1. Admit that since at least as early as June 24, 1998, H. Price Jessup has been a principal of the King Street Investment Company, LLC.
2. Admit that since at least as early as April 28, 2000, George E. Marzloff, Esq. has been an authorized agent of The King Street Investment Company, LLC with respect to the above-captioned opposition.
3. Admit that as of April 28, 2000, you were not making use of the Mark in connection with coffee.

³ Registration No. 1,882,153, issued March 7, 1995.

⁴ Registration No. 1,561,546, issued October 17, 1989.

⁵ Opposer filed a "Motion to Submit into Evidence Opposer's requests for Admissions to Applicant and Applicant's Admissions into Evidence." We understand this motion to be a notice of reliance. 37 CFR § 2.120(j)(3)(i).

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4. Admit that between April 28, 2000 and December 31, 2000, you were not making use of the mark in connection with coffee.
5. Admit that as of May 15, 2001, you were not making use of the mark in connection with coffee.
6. Admit that between June 11, 1998 and May 15, 2001 you did not make continuous use of the Mark in connection with coffee.
7. Admit that you have no present intention of making use of the Mark in connection with coffee.
8. Admit that on or about April 28, 2000, H. Price Jessup informed Opposer's counsel, Zick Rubin, in a telephone conversation that you had stopped selling "Black Dog Coffee."
9. Admit that on or about May 4, 2000, George E. Marzloff, Esq. sent an email to Opposer's counsel, Zick Rubin, stating "I think you are correct as to Price Jessup not using the trademark at this time."

Opposer filed a brief that requested entry of judgment in its favor for the sole reason that "applicant's registration should be denied because applicant admits that it has not used the mark continuously in commerce and has no intention of using the mark in commerce." Opposer's Br. at 3 (capitalization omitted). Applicant did not file a brief. Neither party requested an oral hearing.

Discussion

We dismiss the opposition.

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The first issue that we must address is opposer's standing to bring this opposition. "[A] party opposing a registration pursuant to Section 13 of the Lanham Act must show (1) that he has standing and (2) a statutory ground which negates the applicant's entitlement to registration." Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). Opposer has submitted three registrations with its notice of opposition. Establishing ownership of an allegedly confusingly similar registration is sufficient to prove standing. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) ("In this case, as stated earlier, Laser Golf owns two prior registrations. These registrations and the products sold under the mark they register suffice to establish Laser Golf's direct commercial interest and its standing to petition for cancellation of Cunningham's LASERSWING mark"). While opposer has alleged ownership of three registrations and it has attached copies of those registrations to its notice of opposition, these registrations are not properly of record. There are several ways for a party to introduce registrations it owns into evidence in a Board proceeding. The most common way is to attach to the notice of opposition two copies of the registration

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prepared and issued by the USPTO showing both current status and title or to submit such copies under notice of reliance. 37 CFR § 2.122(d). Opposer has not provided such copies.⁶ Other ways a party's registration will be considered to be of record include by identification and introduction during the testimony period by a qualified witness who testifies concerning the status and title of the registrations; by admission in the applicant's answer; or by the applicant treating the registration as being of record in its brief. TBMP § 702.03(a). Inasmuch as no testimony was taken in this case, and because applicant did not admit the existence of the registrations in its answer, in its admissions or in a brief, the registrations were not made of record by any of these means.

The Trademark Rules provide a means for implementing this proof of a prima facie case. They require that, in an opposition proceeding, registrations may be entered into evidence by (1) furnishing two copies of each registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration; (2) appropriate identification and introduction of the registrations during the taking of testimony; or (3) filing a notice of reliance on the registrations during Opposer's testimony period. 37 C.F.R. §2.122(d) (emphasis added). These rules

⁶ One registration attached to the notice of opposition is clearly merely a soft copy of the registration. The other two copies contain term information but no indication of current status and title.

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are simple and clear, but Hewlett did not follow them.

Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (Federal Circuit affirmed the Board's dismissal of an opposition for failing to present a prima facie case of likelihood of confusion).

Because there is no evidence of record regarding opposer's standing either based on its ownership of a federal registration, common law rights, or any other reason, we hold that opposer has failed to prove its standing to oppose this application and therefore, we must dismiss this opposition. See Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76, 81 (TTAB 1979) (The exhibits "do not show ownership of or title to the registrations as of the date of attestation ... and therefore do not serve as evidence in support of opposer's claim of damage").

Because opposer has not proven its standing, we dismiss this opposition.⁷ However, we note that applicant has admitted that applicant has "no present intention of making use of the Mark in connection with coffee" and that it has not used the mark continuously since June 11,

⁷ Because opposer has not proven that it has standing, we have not addressed any other issues raised by this proceeding.

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1998. Accordingly, if applicant ultimately prevails in this case, pursuant to Trademark Rule 2.131, we will remand the application to the examining attorney for further examination with respect to the issue of applicant's use of its mark. See TBMP §§ 515 and 805.

Decision: The opposition is dismissed.