

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

In re Application of: Cervceria Aguila, S.A.



Serial No.: 74/171,315 *MG*

04-24-2002

Filed: May 5, 1991

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

Mark: CERVEZA AGUILA

TRADEMARK TRIAL AND
APPEAL BOARD
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**REQUEST TO LIFT SUSPENSION AND
REMAND FOR FURTHER PROCEEDINGS**

Applicant requests that suspension of the *ex parte* appeal be lifted and the application be remanded to Mark Timothy Mullon or other appropriate Examining Attorney to consider a settlement agreement that has been entered into by the relevant parties.

This application was suspended on July 26, 1995 pending the outcome of Cancellation Action (No. 23,652) against Registration No. 1,746,548 for THE EAGLE PREMIUM. That Cancellation Action has now been settled between the parties and simultaneously with this submission, Applicant has requested withdrawal of that action.

Applicant respectfully requests that the Board remand this application to an Examining Attorney to reconsider his refusal to register the mark on the grounds that Applicant's mark, CERVEZA AGUILA, is likely to be confused with the following mark,



(Registration No. 1,746,548) owned by PITTSBURGH BREWING COMPANY ("PBC") by assignment from Evansville Brewing Company for "alcoholic malt beverages; namely, beer and malt liquor."

The reason for the request for remand is that the parties have entered into an agreement in settlement of Cancellation proceedings (No. 23,652) relating to the likelihood of confusion

between the use of their respective marks on beer. In their settlement, Applicant and Registrant intend to avoid confusion in the marketplace by agreeing to co-exist under set conditions prescribed by the joint agreement.

The parties to the Settlement Agreement have agreed to peacefully co-exist with specific provisions to eliminate the possibility of likelihood of confusion between the parties' respective marks and goods. The pertinent terms of the agreement provide that, (1) the parties acknowledge each other's rights to use their respective marks in connection with their respective goods; (2) neither party believes the use of their respective marks is or will cause confusion among consumers; and (3) both parties shall, in their best judgment, take steps to avoid any confusion that may arise. *See* Settlement Agreement annexed hereto as Exhibit A.

Through this settlement agreement, Applicant (who has use prior to Registrant – April 13, 1990 for Applicant versus May 20, 1991 for Registrant) and Registrant have determined that confusion of the public by concurrent use of their marks is unlikely. This is because they have co-existed without confusion for over ten years since at least as early as 1991. The parties to the settlement agreement recognize that while the goods are similar, the marks are sufficiently different in sight, sound and meaning to avoid a likelihood of confusion among consumers.

It is a well-settled principle that consent agreements, bearing the clear intentions of the parties and containing provisions similar to those incorporated in the parties' settlement agreement, are to be given great weight.¹ In 1993 the Federal Circuit reversed the Board in *In re Four Seasons Hotels, Ltd.*² by upholding the validity of a consent agreement as permitting the concurrent registration of the mark THE FOUR SEASONS BILTMORE for a seaside resort hotel in Santa Barbara, California and THE BILTMORE LOS ANGELES for a hotel in downtown Los Angeles. The court noted that the issue was whether the circumstances in that case were such that the agreement should "carry great weight" in the likelihood of confusion analysis.³ The court determined that it should. In the BILTMORE case, the court permitted that registration of both marks stating,

[t]he parties themselves have determined that confusion of the public by concurrent use of their marks is unlikely... There is no reason to ignore their assessment of likelihood of confusion and not give substantial weight to their agreement as evidence that likelihood of confusion does not exist... [I]t is well settled that in the absence of contrary evidence, a consent agreement itself may be evidence that there is no likelihood of confusion.

Id. at 1074

¹ *In re N.A.D., Inc.*, 745 F.2d 996 (Fed. Cir. 1985); *Bongrain International American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479 (Fed. Cir. 1987); *Amalgamated Bank of New York v. Amalgamated Trust & Sav. Bank*, 842 F.2d 1270 (Fed. Cir. 1988).

² 987 F.2d 1565, 26 U.S.P.Q.2d 1071 (Fed. Cir. 1993)

³ *Id.*

In a number of TTAB decisions, following the Federal Circuit's rationale the Board has found that a letter of consent is determinative.⁴ The Board has further noted that a consent to use agreement is "in essence, an admission that the subsequent party's use of the mark for its goods is not likely to cause confusion," and that a consent to use necessarily includes a consent to register, whether expressed or not.⁵

In further support of the general policy of upholding settlement agreements between parties, many courts have weighed the prevention of clearly infringing uses by way of a consent agreement against the public interest in contract enforcement and encouragement of settlement of trademark disputes.⁶ These courts have determined that overly strict judicial scrutiny of consent agreements could violate the policy favoring settlement.⁷

The Second Circuit has noted that "[t]rademark agreements are favored in the law as a means by which parties agree to market products in a way that reduces the likelihood of consumer confusion and avoids time-consuming litigation ... At the time of the execution of such an agreement, the parties are in the best position to determine what protections are needed and how to resolve disputes concerning earlier trademark agreements between themselves".⁸

In light of the prevailing case law favoring the policy upholding agreements for consent and settlement, Applicant respectfully suggests that the Examiner be allowed to weigh the benefits of this overriding policy against the likelihood that the parties to the agreement will fail to correct confusion in the marketplace with respect to their products. Applicant contends that the parties voluntarily entered into the agreement in an effort to avoid present and future conflicts between the use of the marks on the parties' respective goods. In so doing, Applicant urges the Board to allow the Examiner to consider that the parties (under the terms of contractually binding agreement) will seek to avoid confusion given the clear terms of the settlement agreement.

The Applicant further states that the parties have co-existed for over ten years without any instances of actual confusion.

In light of the foregoing arguments, it is respectfully submitted that the marks are not likely to create confusion given the parties' bilateral agreement to co-exist with one another. As such, Applicant respectfully requests that the Examining Attorney withdraw her refusal to register the mark.

⁴ See *In re American Management Ass'n*, 218 U.S.P.Q. 477 (TTAB 1983); *In re Palm Beach, Inc.*, 225 U.S.P.Q. 785 (TTAB 1985); *In re Leonard S.A.*, 2 U.S.P.Q.2d 1800 (TTAB 1987).

⁵ *Richdel, Inc. v. Mathews Co.*, 190 U.S.P.Q.37 (TTAB 1976); see also *Danskin, Inc., v. Dan River, Inc.*, 498 F.2d 1386 (CCPA 1974)

⁶ See *T&T Mfg. Co. v. A.T. Cross Co.*, 449 F.Supp. 813, *aff'd* 587 F.2d 533, *cert. denied*, 441 U.S. 908 (1979)

⁷ *Id.*

⁸ *Clorox Co. v. Sterling Winthrop, Inc.*, 117 F.3d 50, 60 (2d Cir. 1997).

CONCLUSION

In light of the above remarks, Applicant submits that this application should proceed to publication for opposition forthwith.

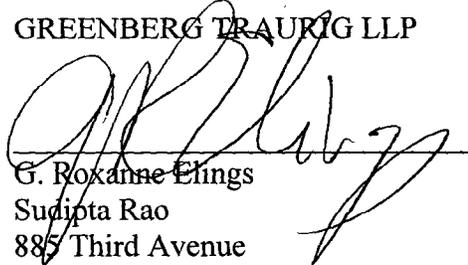
Respectfully submitted,

GREENBERG TRAURIG LLP

Date:

4/24/02

By:


G. Roxanne Elings
Sudipta Rao
885 Third Avenue
New York, New York 10022
(212) 801-2100

GREENBERG
ATTORNEYS AT LAW
TRAURIG

G. Roxanne Elings
212 801 2148
Elingsr@gtlaw.com

February 11, 2002

VIA FEDERAL EXPRESS WITH ENCLOSURES

Alvaro Correa-Ordonez
Baker & McKenzie
Call 35 No. 72-75, 4th Floor
Santa Fe De Bogotá, D.C.
Colombia

Re: *Cerveceria Aguila, S.A. v. Pittsburgh Brewing Company*
United States Cancellation No. 23,652

Dear Alvaro:

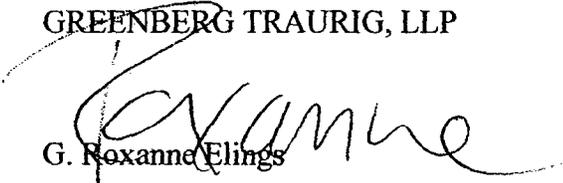
Pursuant to my email to you of this date, enclosed please find an original signed settlement agreement in the above-entitled action. Please have the client maintain this original agreement in a safe place. We will maintain a copy.

We will also undertake to finalize the client's applications, numbered 74/171,315 and 74/537,234 and report to you accordingly.

Please confirm receipt of this letter and the agreement.

Very truly yours,

GREENBERG TRAURIG, LLP


G. Roxanne Elings

GREENBERG TRAURIG, LLP
885 THIRD AVENUE

NEW YORK, NEW YORK 10022-4834

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NEW YORK MIAMI WASHINGTON, D.C. ATLANTA PHILADELPHIA TYSONS CORNER CHICAGO BOSTON PHOENIX WILMINGTON LOS ANGELES DENVER
SÃO PAULO FORT LAUDERDALE BOCA RATON WEST PALM BEACH ORLANDO TALLAHASSEE

MUTUAL CONSENT AGREEMENT

This Mutual Consent Agreement ("Agreement") is made on the dates shown below, by CERVECERIA AGUILA, S.A. ("CA"), located at Calle Ten, #38-56 Barranquilla Colombia, and PITTSBURGH BREWING COMPANY ("PBC"), located at 3340 Liberty Avenue, Pittsburgh, PA 15201.

This Agreement sets forth the understanding between the parties regarding use and registration of: (1) THE EAGLE PREMIUM and Design mark (Registration No. 1,746,548) owned by PBC by assignment from Evansville Brewing Company; (2) CERVEZA AGUILA (Application No. 74/171,315); and (3) CERVEZA AGUILA and Design (Application No. 74/537,234), both owned by CA.

WHEREAS, PBC represents that it is the owner and exclusive licensee of the entire right, title and interest in and to THE EAGLE PREMIUM and Design:



(Registration No. 1,746,548) (a color copy of the design as presently used is annexed hereto as Exhibit A); and its successors-in-interest first used such trademark to the best of PBC's knowledge and belief, prior to or about May 20, 1991, in connection with alcoholic malt beverages; namely, beer and malt liquor.

WHEREAS, CA represents that it is using and has used, since at least as early as April 13, 1990, the trademarks CERVEZA AGUILA; and CERVEZA AGUILA and design:



on and in connection with beer (a color copy of the design is annexed hereto as Exhibit B); and has applied to register its trademarks with the United States Patent and Trademark Office under Serial Numbers 74/171,315 and 74/537,234); and

WHEREAS, neither party believes the use of their respective marks is or will cause confusion among consumers, and both parties shall, in their best judgment, take steps to avoid any confusion that may arise.

THEREFORE, in consideration of the mutual promises and obligations contained herein and other good and valuable consideration, the Parties agree that:

1. CA company shall be entitled to use and/or apply to register the CERVEZA AGUILA and CERVEZA AGUILA and Design trademark (depicted in Application Nos. 74/171,315 and 74/537,234), on and in connection with beer and any reasonably related goods or services, which may have been sold or will be sold by CA company.
2. PBC will provide, at CA's expense, any consent or other documents required by any entity regarding use or registration of the CERVEZA AGUILA trademarks.
3. CA will withdraw its action for cancellation against THE EAGLE PREMIUM and Design, (No. 23,652) and agrees that PBC shall be entitled to use and maintain its registration for THE EAGLE PREMIUM and Design trademark (depicted in Registration No. 1,746,548) on and in connection with beer and any reasonably related goods or services, which may have been sold or will be sold by PBC.
4. Either party – without receiving prior approval from the other party – shall be allowed to make minor modifications to their respective trademarks (word and design), provided such modifications do not affect the overall commercial impression given by the trademark.
5. Neither party shall contest the other party's application to register its marks encompassed by this Agreement, without first notifying that party of its intention and reasons for the contest.
6. This Agreement shall be binding upon and inure to the benefit of the parties to this Agreement, and each of them, and each of their respective successors and assigns.
7. This Agreement represents the entire Agreement between the parties and may not be altered, amended or modified, except in a writing signed by all parties.
8. Each party represents such party is fully authorized to enter into and fully perform this Agreement.

IN WITNESS WHEREOF:

Date: 19th of November, 2001

CERVECERIA AGUILA S.A.

Mr:

By: _____

Name: Victor Machado

Position: Legal Representative

Date: 2.7.02

PITTSBURGH BREWING COMPANY

By: _____

Name: Joseph A. Pennell

Position: President

A



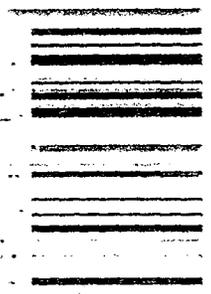
The Bold - The Proud



40% ALC.
NET WT. 300g

The
EAGLE
INVAULT LIQUOR

PLEASE RECYCLE THE GLASS BOTTLE



B



GUINNESS STOUT

GERVEZA-AGUILA

ESTABLISHED 1759

ST. JAMES'S GATE, DUBLIN

THE GUINNESS BOTTLING COMPANY, LTD., LONDON

NET CONT. 12 FL. OZ. 355 ml.

CONSUMERS WARNING: (1) ACCORDING TO THE INTERNATIONAL WOMEN'S BUREAU NOT
 SOME ALCOHOLIC BEVERAGES DURING PREGNANCY CAN BE THE CAUSE OF BIRTH DEFECTS.
 (2) CONSUMPTION OF ALCOHOL BEVERAGES IMPAIRS YOUR ABILITY TO DRIVE A CAR OR
 OPERATE MACHINERY AND MAY CAUSE HEADACHE.

TTAB



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ATTORNEYS AT LAW
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04-24-2002

U.S. Patent & TMO/tm Mail Rcpt Dt. #58

G. Roxanne Elings
212 801 2148
Elingsr@gtlaw.com

April 24, 2002

VIA EXPRESS MAIL: EL819637459US

Commissioner for Trademarks
BOX TTAB NO FEE
2900 Crystal Drive
Arlington, VA 22202-3514

Re: Cerveceria Aguila, S.A..
Serial No.: 74/171,315
Filed: May 5, 1991
Mark: CERVEZA AGUILA
Our Ref.: 51818.010000

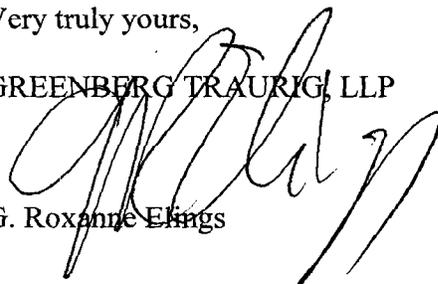
Dear Sir or Madam:

Enclosed please find the following:

- 1. Transmittal letter;
- 2. Request to Lift Suspension and Remand for Further Proceedings and Exhibit; and
- 3. a self-addressed stamped postcard for acknowledging safe receipt of these documents.

Please acknowledge receipt of the enclosed by placing the received stamp of you mail room on the enclosed postcard, and returning it to this office.

Thank you for your attention to this matter.

Very truly yours,
GREENBERG TRAURIG, LLP

G. Roxanne Elings

Enclosures

GREENBERG TRAURIG, LLP
885 THIRD AVENUE
NEW YORK, NEW YORK 10022-4834

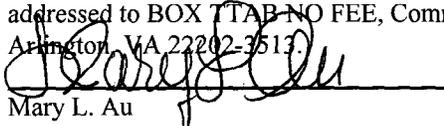
212-801-2100 FAX 212-688-2449 www.gtlaw.com



G. Roxanne Elings
212 801 2148
Elingsr@gtlaw.com

GRE/mla
Enclosures

“Express Mail” mailing label number: EL819637459US Date of Deposit: April 24, 2002. I hereby certify that this paper or fee is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service under 37 CFR 1.10 on the date indicated above and is addressed to BOX TTAB-NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.


Mary L. Au