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

Proceeding	79146450
Applicant	Schenk Holding SA
Applied for Mark	ESTRELLA DE MURVIEDRO
Correspondence Address	Andy I. Corea St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905-5619 UNITED STATES tm-pto@ssjr.com, acorea@ssjr.com
Submission	APPLICANT'S REQUEST FOR SUSPENSION OF APPEAL AND REMAND TO EXAMINING ATTORNEY FOR CONSIDERATION OF CONSENT AGREEMENT
Attachments	79146450 Remand Request.pdf(429045 bytes)
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Date	09/03/2015

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

Applicant	Schenk Holding SA
Mark	ESTRELLA DE MURVIEDRO
Serial No. 79146450	Filing Date: March 17, 2014

APPLICANT'S REQUEST FOR SUSPENSION OF APPEAL AND REMAND TO EXAMINING ATTORNEY FOR CONSIDERATION OF CONSENT AGREEMENT

Applicant respectfully requests suspension of the Appeal and remand of the above application to the Examining Attorney pursuant to 37 C.F.R. §2.142(d) and Trademark Trials and Appeals Board Manual of Procedure §1207.02. Applicant submits that there is good cause to suspend the appeal and remand the application based on the following facts:

Applicant's has appealed the refusal to register its trademark under Section 2(d), 15 U.S.C. § 1052(d). Applicant has reached an agreement with owner of the cited registration who has provided a second written consent (attached as Exhibit 1(a)) to Applicant's registration.

Likelihood of Confusion – Consent Agreement

The examining attorney refused registration under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) citing a likelihood of confusion with the following prior registration:

U.S. Registration No. 2,800,136 (ESTRELLA)

Applicant and the owner of the cited registration have reached a consent agreement regarding use and registration of their respective marks. A copy of the executed agreement is attached and made of record in this application.

Consent agreements should be given great weight, and that the Office should not substitute its judgment concerning likelihood of confusion for the judgment of the real parties in interest without good reason, that is, unless the other factors clearly dictate a finding of likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank,* 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International (American) Corp. v. Delice de France Inc.*, 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985). As noted by the predecessor to the Federal Circuit,

> When those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 1363, 177 USPQ 563, 568 (C.C.P.A. 1973).

The consent in this case states why no likelihood of confusion will occur from concurrent use of the marks in question and makes sufficient arrangements to avoid confusion the public – it is not a naked consent to register. *In re Permagrain Products, Inc.*, 223 USPQ 147 (TTAB 1984). It is therefore entitled to great weight in determining the likelihood of confusion. *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank,* 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); *Bongrain International*

(American) Corp. v. Delice de France Inc., 811 F.2d 1479, 1 USPQ2d 1775 (Fed. Cir. 1987); *In re N.A.D. Inc.*, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985).

Identification of Goods

Applicant requests that the examining attorney amend the identification of goods for International Class 33 to the following: "SPARKLING WINE; MUSCAT WINE".

In view of the amended identification of goods and the consent agreement, Applicant requests that the examining attorney withdraw the refusal to register.

Respectfully submitted,

ATTORNEYS FOR APPLICANT

September 3, 2015

Andy I. Corea
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
Tel. 203 324-6155
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AGREEMENT

THIS AGREEMENT, is entered into as of the date last signed below (the "Effective Date"), by and between SCHENK HOLDING SA, a Societé Anonyme organized under the laws of Switzerland, with an address at Avenue de la Grace 18, CH-1180, Rolle, Switzerland ("SCHENK"), and BRONCO WINE COMPANY, a California corporation with an address at 6342 Bystrum Road, Ceres, California 95307 ("BRONCO") (each a "Party" and collectively the "Parties").

WHEREAS, BRONCO owns United States Trademark Registration No. 2,800,136 for the mark ESTRELLA, registered December 30, 2003 at the United States Patent and Trademark Office ("USPTO").

WHEREAS, SCHENK has filed U.S. Trademark Application Ser. No. 79146450 for the mark

ESTRELLA DE MURVIEDRO filed March 17, 2014 at the USPTO.

WHEREAS, the Parties believe their respective marks may co-exist without confusion and wish to reach an agreement to govern the parameters of their co-existence and avoid confusion between their marks;

NOW, THEREFORE, in consideration of the above recitals, the mutual promises and undertakings set forth in this Agreement, and other good and valuable consideration, the sufficiency of which is mutually acknowledged, the Parties agree as follows:

1. SCHENK will amend the identification of goods in U.S. Trademark Application Ser. No. 79146450 to: "sparkling wine; Muscat wine".

2. SCHENK will limit its use and registration of the ESTRELLA DE MURVIEDRO trademark in the United States to the following form:

ESTRELLA DE MURVIEDRO

3. BRONCO consents to the use and registration of the mark ESTRELLA DE MURVIEDRO as set forth in paragraphs 1 and 2 will not oppose, seek to cancel, or otherwise contest SCHENK's rights to use and register the mark as long as SCHENK is in compliance with the terms of this Agreement.

4. Each Party waives and releases the other Party from any claims for damages, profits, or other monetary and/or injunctive relief arising from its past use and/or registration of its respective marks.

5. This Agreement is binding upon and inures to the benefit of BRONCO and SCHENK and their respective agents, representatives, successors and assigns, and rights granted by this Agreement may be freely assigned or sublicensed by either Party. By taking an assignment, an assignee

shall be deemed to have accepted and agreed to perform all of the rights and obligations of the assignor under this Agreement.

6. This Agreement constitutes the entire agreement between the Parties with respect to the identified subject matter and shall not be varied in its terms by any other prior or contemporaneous agreement, whether written or oral, or otherwise, except in writing executed by authorized representatives of both Parties.

7. The Parties believe that the use of their respective marks in compliance with the terms of this Agreement is unlikely to result in confusion among consumers. In the unlikely event that actual consumer confusion does occur, the Parties agree to work cooperative to mitigate and resolve the confusion.

IN WITNESS WHEREOF, the Parties have caused this Agreement to be signed on the day, month and year set forth adjacent to each of the Parties' signatures hereto.

SCHENK HOLDING SA	BRONCO WINE COMPANY
By:	By:
Name: SCHENK FRANÇOIS	Name: Fred T. Franzia
Title: MEMBER OF THE BOARD	Title: C.E.O.
Date: 3 July, 2015	Date: 8/17, 2015 IN CERES, CA

SCHENK HOLDING SA
DIRECTION GENERALE
CH-1180 ROLLE