

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

TTAB

VAGABUNDO COMPANY, INC.

Opposer

v.

CARIBBEAN DISTILLERS CORP.

Applicant

OPPOSITION NUMBER:

APPLICATION SERIAL NO. 85169624

MARK: DRACO RUM

REQUEST FOR RECONSIDERATION

TO THE TRADEMARK TRIAL AND APPEAL BOARD:

COMES NOW Vagabundo Company, Inc., through its undersigned attorney, and respectfully requests that the Board reconsider its decision given on September 21, 2011 which deemed the filing of the Notice of Opposition as untimely. Vagabundo Company respectfully states as follows:

1. For the reasons included herein, Vagabundo respectfully requests reconsideration of the Board's determination that the Notice of Opposition is untimely and requests that the Opposition be instituted as requested by Vagabundo Company.

2. It is Vagabundo's contention that a technical failure on the ESTTA web site was an unforeseen circumstance out of the opposer's control that justifies the Board's leniency in allowing Vagabundo's Notice of Opposition, particularly in light of the totality of the circumstances and the facts of this case.

3. Vagabundo Company opposes the registration of the trademark DRACO RUM, application serial number 85169624, as filed by Applicant Caribbean Distillers based on its prior ownership of the mark, pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), and because the application

infringes Mr. Draco C. Rosa's rights as a celebrity to use his name, likeness and persona as a trademark. Vagabundo Company believes it would be damaged by this application because it is likely to cause confusion, to cause mistake and/or to deceive the public as to the origin and/or endorsement of the Applicant's product, and respectfully alleges that Caribbean Distillers lacked a bona fide intent to use the mark at the time of filing its application.

4. The DRACO RUM trademark was published for opposition on May 3, 2011.

5. Vagabundo Company filed a timely *Request for Extension of Time to Oppose* on June 2, 2011 and a *60 Day Request for Extension of Time to Oppose for Good Cause* on June 30, 2011. On July, 1, 2011, the Trademark Trial and Appeals Board granted Vagabundo's request to extend time to oppose until 8/31/2011.

6. Vagabundo filed the above mentioned *Requests for Extension of Time* in order to allow sufficient time for the parties to reach an amicable solution to the controversy regarding the ownership of the mark that would save the parties considerable time and significant litigation costs.

7. Given that no resolution was reached, on August 31, 2011, Vagabundo attempted to file its Notice of Opposition via the Electronic System for Trademark Trials and Appeals (ESTTA).

8. Unfortunately, ESTTA experienced a technical failure that did not allow the undersigned to file the Notice of Opposition electronically. *See* attached Exhibits I-V, evidence of the error messages given by ESTTA.

9. In order to find a solution to the technical failure, we attempted to contact the United States Patent and Trademark Office as well as the TTAB via email and telephone (call reference number 1863547) on August 31, 2011, to no avail. *See* attached Exhibits VI-VII, evidence of emails.

10. The USPS Express Mail service was unavailable at the time because the Post Office had closed. Given that electronic filing was not possible, Vagabundo proceeded to file the Notice of Opposition on paper via the United States Postal Service on the following day.

11. In a notification issued on September 21, 2011, Paralegal Specialist Mr. Tyrone Craven notified the parties that the Notice of Opposition had been received on September 6, 2011 and, thus, deemed the opposition to be untimely.

12. As stated above, Vagabundo respectfully requests reconsideration of the Board's determination and requests that the Opposition be instituted. We respectfully sustain that the totality of the circumstances of this case justify that the Board reconsider its position.

13. According to Trademark Rule 101.01, "[T]he USPTO rules governing procedure in inter parties proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings". In this case, the procedure should not be so inflexible so as to perpetuate an unfair and potentially fraudulent result.

14. Vagabundo respectfully sustains that Caribbean Distillers filed the application for the trademark DRACO RUM in bad faith and that it lacked a bona fide intent to use the mark at the time of filing its application in violation of 15 U.S.C. Section 1051(b). *See Smithkline Beecham Corp. v. Omnisource DDS LLC, 97 USPQ2d 1300 (2010).*

15. Because Caribbean Distillers lacked a bona fide intent to use the mark at the time of filing, application serial number 85169624 must be considered void *ab initio*. As such, Caribbean Distillers should not be granted a priority date and the application must be refused.

16. Upon information and belief, Caribbean Distillers, through counsel, committed fraud on the PTO at the time of filing its application for DRACO RUM. Caribbean Distillers and its counsel had knowledge of Mr. Draco C. Rosa and/or Vagabundo Company's ownership of the mark because at the time of filing the application, the parties had begun conversations in order to negotiate a potential business deal for the production and distribution of the rum, among other reasons included in the Notice of Opposition.

17. At the time of filing the application, Caribbean Distillers and its counsel had knowledge of Vagabundo's prior use of the mark in commerce. Thus, the filing of the application, and the statement included therein, constitutes fraud on the PTO.

18. Caribbean Distillers and its counsel also had knowledge of the fact that the opposer had previously attempted to register the mark RON DRACO (on behalf of Phantom Vox Corporation, application serial number 77739456), thus demonstrating its ownership and prior intent to use the mark. Through no fault of its own, *Phantom Vox's* application was abandoned on July 19, 2010 due to an inadvertent mistake by counsel who failed to file a timely *Extension to file the Statement of Use*.

19. Caribbean Distillers filed the DRACO RUM trademark application in bad faith, having seized the opportunity presented by Phantom Vox's unintentional abandonment of the trademark application for RON DRACO. As argued in the Notice of Opposition, Caribbean Distillers' actions are part of an aggressive business strategy directed to create an unfair advantage for the applicant in the negotiation of a potential joint venture with *Draco* and/or Vagabundo Company.

19. These dealings on behalf of Caribbean Distillers constitute acts of unfair competition in violation of Section 43(A) of the Lanham Act, 15 U.S.C. §1125, and we respectfully argue should not be sanctioned by the United States Patent and Trademark Office or the Trademark Trial and Appeal Board.

20. In Sovereign Military Hospitaller v. Florida Priory of Knights Hospitallers, -- F.Supp.2d --, 2011 WL 4639824 (S.D.Fla., September 29, 2011) the United States District Court for the Southern District of Florida recently cancelled various registrations, despite the fact that they had become incontestable. The Court stated:

The Florida Priory does challenge the remaining registered marks on the ground that they were procured by fraud. Although these marks are now incontestable, these marks are subject to challenge on the grounds that they were fraudulently obtained. See 15 U.S.C. §

1115(b)(1). **Although “fraud” is a strong term that is not to be used lightly, the Federal Circuit has held that knowing misrepresentations to the PTO with the intent to deceive constitute fraud.** In re Bose Corp., 580 F.3d 1240, 1245 (Fed.Cir.2009) (“We hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.”). **Whereas direct evidence of such intent is rarely available, intent can be inferred from indirect and circumstantial evidence.** Id. at 1245 (citing Star Scientific, Inc. v. R.J. Reynolds Tobacco Co., 537 F.3d 1357, 1366 (Fed.Cir.2008)). “When drawing an inference of intent, ‘the involved conduct, viewed in light of all the evidence ... must indicate sufficient culpability to require a finding of intent to deceive.’ “ Id. (quoting Kingsdown Med. Consultants v. Hollister Inc., 863, F.2d 867, 876 (Fed.Cir.1988)). Sovereign Military, Id. at page 6. (Emphasis added.)

21. Furthermore, DRACO is the name of a living person, and Caribbean Distillers knowingly filed its application for the mark containing the name without the proper consent, in violation of Section 2(c) of the Lanham Act, 15 U.S.C. §1052(c). The disclaimer provided by Caribbean Distillers is a mere pretext. Mr. Draco C. Rosa is an internationally renowned Puerto Rican performing artist, musician, singer-songwriter, actor, record producer and entrepreneur that is known and widely referred to as “*Draco*”. The evidence in this case will show that Caribbean Distillers intended to use *Draco* as the spokesperson for the rum.

22. Thus, at the time of filing application serial number 85169624, Caribbean Distillers violated 15 U.S.C. Section 1051(b)(3) when it signed the following statement as part of its trademark application:

The undersigned, **being hereby warned that willful false statements** and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, **and that such willful false statements, and the like, may jeopardize the validity of the application** or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, **if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive;** and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. (Emphasis added.) See also, Sovereign Military, Id. at page 5.

23. If the Applicant were allowed to proceed with its application unopposed, the opposer will be harmed and the pending application could have an adverse effect on Vagabundo's business plans for the production and distribution of its rum. If the application is allowed to go forward unopposed, the Applicant would have the procedural upper hand and could continue to harm the opposer and/or to obstruct its business plans, even though it is ultimately unlikely that the Applicant would prevail either in a Petition for Cancellation and/or in a judicial proceeding. In light of the above-mentioned circumstances, we respectfully argue that there is no reason to postpone the consideration and the adjudication of this controversy at this stage, *i.e.*, in an opposition proceeding.

WHEREFORE, in light of the totality of the circumstances described above, Vagabundo Company, Inc. respectfully requests that the TTAB reconsider its decision with regards to the untimely filing of the Notice of Opposition and, therefore, respectfully requests that it institute the opposition proceedings as requested.

Respectfully submitted. On this 19th day of October, 2011.

CERTIFICATE OF SERVICE: It is hereby certified that on this day I sent notification to the following persons via Express Mail at the following addresses: Ms. Cristina Arenas Solís, FERRAIUOLI TORRES MARCHAND ROVIRA, LLC, 221 Ave. Ponce de León, 221 Plaza Suite 403, San Juan, Puerto Rico 00917.



/s/ Christina M. Beauchamp Richards, Esq.

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