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

In the Matter of Application Serial No. 76/321725  
Published in the Official Gazette on May 28, 2002

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57



08-21-2002

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DIAGEO NORTH AMERICA, INC. :

Opposer, :

v. :

Opposition No.

OLD EUROPEAN BREWERY COMPANY, :

Applicant. :

TRADEMARK TRIAL AND  
APPEAL BOARD  
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NOTICE OF OPPOSITION

Diageo North America, Inc., (formerly Guinness UDV North America, Inc.), a Connecticut corporation with offices at Six Landmark Square, Stamford, Connecticut 06901-2704 (hereinafter referred to as "Opposer"), believes that it will be damaged by registration of the mark shown in Application Serial No. 76/321725 and hereby opposes the same.

As grounds of opposition, it is alleged:

1. Old European Brewery Company (hereinafter referred to as "Applicant") is not now and never was entitled to appropriate or register as a trademark the designation SARRANOFF for which it seeks registration in its Application Serial No. 76/321725, published on page TM 470 of the Official Gazette of May 28, 2002 (Volume 1258, No. 4), for the goods set forth therein.

2. Applicant was not entitled to the exclusive use of the designation SARRANOFF for which it seeks registration in its Application No. 76/321725, either on October 5, 2001, the date

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of the filing of the application for registration therefore, or on May 28, 2002, the date of publication thereof in the Official Gazette.

3. Since prior to October 5, 2001, Applicant's filing date, Opposer, which term includes its predecessors, has been and now is engaged, *inter alia*, in the business of importing, producing, bottling, advertising, offering for sale and selling alcoholic and non-alcoholic beverages, including vodka and flavored brewed malt beverages.

4. Since prior to October 5, 2001, Opposer has been and now is using SMIRNOFF as a trademark for its most popular vodka and for a flavored brewed malt beverage, which is sold under the trademark SMIRNOFF ICE.

5. For many years SMIRNOFF vodka has been the largest selling vodka and the second largest selling distilled spirit in the United States.

6. Since prior to October 5, 2001, the SMIRNOFF flavored brewed malt beverage sold under the trademark SMIRNOFF ICE has been and now is the largest selling product in its category.

7. Opposer is the owner of a number of registrations of the trademark SMIRNOFF for vodka issued by the United States Patent and Trademark Office, including Registration No. 513,428 issued August 9, 1949.

8. Opposer is also the owner of Registration No. 2,551,956 issued March 26, 2002 covering the trademark SMIRNOFF for a flavored brewed malt beverage and of Registration No. 2,551,932 issued March 26, 2002 covering the trademark SMIRNOFF ICE for a flavored brewed malt beverage.

9. The registrations referred to in Paragraphs 7 and 8, above, are now outstanding and validly subsisting.

10 In Application Serial No. 76/321725, Applicant seeks to register the designation SARRANOFF as a trademark for beer, flavored brewed malt-based alcoholic beverage in the nature of a beer.

GROUND ONE

11. Opposer repeats and reavers the averments of Paragraphs 1 through 10, inclusive, of this Notice of Opposition.

12. The designation SARRANOFF which Applicant seeks to register, so resembles Opposer's trademarks SMIRNOFF and SMIRNOFF ICE, as previously used and registered by Opposer, as to be likely, when applied to the goods of Applicant, to cause confusion or to cause mistake or to deceive.

GROUND TWO

13. Opposer repeats and reavers the averments of Paragraphs 1 through 10, inclusive, of this Notice of Opposition.

14. Opposer has used its SMIRNOFF trademark on vodka for over sixty years.

15. Opposer has widely advertised and promoted its SMIRNOFF vodka and its SMIRNOFF flavored brewed malt beverage.

16. As a result of the matters alleged in paragraphs 5, 6, 14 and 15, above, Opposer's SMIRNOFF trademark has become and now is a famous mark.

17. The designation SARRANOFF, if it were used by Applicant, would cause dilution of Opposer's SMIRNOFF trademark.

WHEREFORE, Opposer prays that said Application Serial No. 76/321725 be rejected and that registration of the designation SARRANOFF as a trademark to Applicant be refused and denied.

Opposer appoints Albert Robin, Howard B. Barnaby, John J. Torrente, Marylee Jenkins, Ned W. Branthover, Roberta Kraus, and Alexandra B. Urban of Robin, Blecker & Daley, 330 Madison Avenue, Second Floor, New York, New York 10017 (212-682-9640), and Dana Gilland, of Diageo North America, Inc., Six Landmark Square, Stamford, Connecticut 06901-2704, attorneys at law, to act as its attorneys in the above-identified opposition, to prosecute said opposition, to transact all business in the Patent and Trademark Office and the United States Courts in connection with said opposition, and to sign their names to all documents which may hereinafter be filed in connection with said opposition and to receive all official communication relating to the same.

Please direct all communications to Albert Robin.

Dated: New York, New York  
August 19, 2002



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**CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a).**

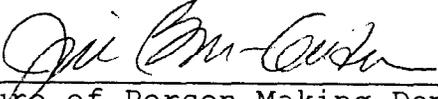
Application No: 76/321725  
Applicant: Old European Brewery Company  
Mark: SARRANOFF  
Document: Notice of Opposition (in  
triplicate), \$300

I hereby certify that the above-identified correspondence,  
which is attached, is being deposited with the United States  
Postal Service as first-class mail in an envelope addressed to:

Assistant Commissioner for Trademarks  
BOX TTAB FEE  
2900 Crystal Drive  
Arlington VA 22202-3513

on: August 19, 2002

Jill Burgess-Grider  
\_\_\_\_\_  
Name of Person Making Deposit

  
\_\_\_\_\_  
Signature of Person Making Deposit

August 19, 2002  
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Date of Signature