

11-04-2002

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #73

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

In the Matter of Trademark Application:

Ser. No.: 75/837,484
Mark: Miscellaneous Crown and
Shield Design
Published: July 2, 2002
Int'l Class: 35
Our File: L4213

CERVECERIA MODELO, S.A. de C.V. a
Mexican corporation,

Opposer,

v.

PLAZA LAMA, S.A., a Dominican corporation,

Applicant.

Opposition No.:

Box TTAB FEE
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Opposer, Cervceria Modelo, S.A. de C.V. (hereafter "Opposer") is a Mexican corporation with its principal place of business at Lago Alberto No. 156, Colonia Anahuac C.P. 11320, Mexico, D.F., Mexico. Opposer believes that it will be damaged by registration of the marks shown in the above-identified application, and hereby opposes the same in accordance with the provisions of Section 13 of the Lanham Act. (15 U.S.C. 1063) and Section 2(e) of the Lanham Act (15 U.S.C. 1052(e)).

11/13/2002 KGIBBONS 00000064 75837484

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The grounds for opposition are as follows:

1. Opposer is the manufacturer of beer sold and distributed throughout the world under the CORONA trademark, which mark is used in various forms.

2. Opposer owns many U.S. Trademark Registrations including Nos.: 1,681,365 for CORONA EXTRA Stylized for use with beer; 1,681,366 for the word mark CORONA Stylized for use with beer; 1,689,218 for CORONA Stylized and Crown and Griffins Design for use with beer; 1,727,969 for CORONA LIGHT Stylized and Crown and Griffins Design for use with beer; 1,729,694 for CORONA EXTRA LAS CERVEZA MAS FINA and Crown and Griffins Design for use with beer; 2,406,232 for CORONA LIGHT Stylized and Crown and Griffins Design for use with beer; 2,452,813 for CORONA MUSIC for providing entertainment information; 2,489,708 for CORONA EXTRA LA CERVEZA MAS FINA Stylized Crown and Griffins Design for use with clothing; 2,489,709 for CORONA Stylized and Crown and Griffins Design for use with clothing; 2,489,710 for CORONA Stylized for use with clothing; 2,489,711 for CORONA EXTRA Stylized for use with clothing; 2,517,268 for CORONA DECOR for use with mail order catalog services; 2,522,430 for CORONA DECOR Stylized and Design for use with mail order catalog services; 2,590,621 for CORONA Stylized for on-line services; 2,634,004 for CORONA for on-line services; and 2,600,236 for CORONA EXTRA for on-line services. The CORONA mark was first used in commerce at least as early as August 1943, and first used anywhere at least as early as 1925.

3. Opposer is also the owner of the following pending U.S. trademark application Serial Nos.: 76/331,791 for GO SOMEPLACE BETTER. GO WHERE THERE'S CORONA AND CORONA LIGHT for beer; 76/231,041 for CORONA EXTRA for promotion of

entertainment and sporting events; 76/230,810 for CORONA EXTRA Stylized for promotion of entertainment and sporting events; 76/230,586 for CORONA Stylized for promotion of entertainment and sporting events; 76/230,273 for CORONA for promotion of entertainment and sporting events; 76/229,561 for CORONA TEQUILA for tequila; 76/229,560 for CORONA ZONA for beer; 75/876,359 for CORONA EXTRA Stylized for sporting goods; 75/876,355 for CORONA'S Stylized for restaurant services; 75/875,878 for CORONAMUSIC.COM for providing entertainment information; 75/875,866 for CORONA for restaurant services; 75/875,865 for CORONA EXTRA for sporting goods; 75/875,864 for CORONA Stylized for sporting goods; 75/875,863 for CORONA'S Stylized and Design for restaurant services; 75/875,862 for CORONA Stylized and Design for restaurant services; 75/875,858 for CORONA'S for restaurant services; 75/875,857 for CORONA Stylized for restaurant services; 75/875,621 for CORONA for sporting goods; 75/764,705 for CORONA SPORT Stylized and Crown Design for clothing and sporting goods; 75/689,802 for CORONA for fresh fruit; 75/632,948 for CORONA.NET for on-line services; 75/632,945 for CORONAEXTRA.NET for on-line services; 75/632,870 for CORONA.COM for on-line services; 75/632,869 for CORONAEXTRA.COM for on-line services; and 74/532,463 for PANCHO CORONA for clothing (Modelo's trademark registrations and applications are collectively referred to herein as the "CORONA Marks").

4. Opposer manufactures, sells, distributes, advertises, and licenses various types of products, including beer, clothing, and sporting goods. Opposer utilizes the above-referenced CORONA Marks in various combinations on its products to identify them as originating from Opposer. Opposer sells, promotes, and advertises its products sold under the CORONA Marks

in various retail establishments, including supermarkets, food stores, and convenience stores; in various eating and drinking establishments; in entertainment venues; through on-line catalog and retail services; and in other establishments.

5. Opposer has developed extensive goodwill with respect to its CORONA Marks, individually and in composite. Opposer has expended substantial sums in the advertising and promotion of its products, and by its efforts and its considerable expenditures for promotional activities, Opposer has developed an extensive and valuable reputation for its various marks.

6. By virtue of its efforts, and the expenditures of considerable sums for promotional activities as well as the excellence of the quality of its products, Opposer has gained a valuable reputation through its above-identified CORONA Marks. Opposer's CORONA Marks are famous within the meaning of 15 U.S.C. § 1125(c).

7. On or about November 1, 1999, Plaza Lama, S.A. (hereafter "Applicant") filed an intent-to-use trademark application to register the alleged trademark Miscellaneous Crown and Shield Design for retail department stores; mail order catalog services featuring a variety of consumer goods, namely, fabrics, housewear, clothing, footwear, eyewear, stationery, watches, electronics, household appliances, furniture and sporting goods in international class 35, which was assigned Serial No. 75/837,484. Said trademark application was published in the Official Gazette of the United States Patent and Trademark Office on July 2, 2002. Opposer is informed and believes that Applicant has not made use in United States Commerce of the Miscellaneous Crown and Shield Design mark in connection with any goods or services identified in this application.

8. Opposer believes that Applicant is attempting to benefit from the goodwill already established by Opposer in its marks, by using a mark for its goods which so closely resembles Opposer's marks so as to cause a likelihood of confusion and to confuse the purchasing public into believing that it is purchasing goods provided and/or sponsored by Opposer. Opposer is therefore informed and believes that Applicant's proposed mark is likely to confuse Opposer's customers, potential customers, and the public generally in relation to its above-mentioned CORONA Marks.

9. Opposer is informed and believes that Applicant's use or intended use of the proposed mark began after Opposer's CORONA Marks became famous and will dilute the strength of Opposer's marks by lessening the capacity of Opposer's marks to identify and distinguish Opposer's goods and services.

10. Opposer has not and does not consent in any way to Applicant's proposed use or registration of the alleged trademark.

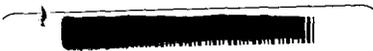
WHEREFORE, Opposer respectfully requests that the registration of Applicant's mark under the above-identified application be refused and that this Opposition be sustained.

This Notice of Opposition is submitted in duplicate. Please charge any additional fees due, or credit any overage, to Deposit Account No. 25-0050.

Respectfully submitted,

By: 
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Dated: October 30, 2002



TTAB

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MARK OFFICE

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TRANSMITTAL LETTER

Box TTAB FEE
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Please find enclosed herewith (1) two copies of Cerveceria Modelo, S.A. de C.V.'s Notice of Opposition; (2) a check in the amount of \$ 300; and (3) an Acknowledgment Post Card. Please charge any additional fees due, or credit any overage, to Deposit Account No. 25-0050.

Submitted by,

Dated: October 30, 2002

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Certificate of Mailing:

I hereby certify that this correspondence is being deposited in duplicate with the United States Postal Services as first class mail in an envelope addressed to: Box TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on this date October 30 2002

Jason Williams
Date 10/30/02