



08-19-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

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

08/19/2003 10:03:11 AM

In the Matter of Trademark Application:

Ser. No.: 78-172,568
Mark: Miscellaneous Crown Design
Published: June 17, 2003
Int'l Classes: 33
Our File: L4414

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

Opposer,

v.

BANFI PRODUCTS CORP., a corporation of
unknown origin,

Applicant.

Opposition No.:

Opposer, Cerveceria 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 mark 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(d) of the Lanham Act (15 U.S.C. 1052(d)).

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.

08/22/2003 ZCLIFT01 00000230 78172568

01 FC:6402

300.00 OP

007212/00021145

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; 2,600,236 for CORONA EXTRA for on-line services; 2,663,599 for CORONA.COM for on-line services; 2,684,504 for CORONA Stylized for promotion of entertainment and sporting events; 2,687,262 for CORONA EXTRA Stylized for promotion of entertainment and sporting events; and 2,702,882 for CORONA EXTRA for sporting goods. 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; 76/230,273 for CORONA for promotion of entertainment

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 October 9, 2002, Banfi Products Corporation (hereafter "Applicant") filed an actual use trademark application to register the alleged trademark Miscellaneous Crown Design for wines in international class 33, which was assigned Serial No. 78-172,568. Said trademark application was published in the Official Gazette of the United States Patent and Trademark Office on June 17, 2003.

8. Opposer believes that Applicant is attempting to benefit from the goodwill already established by Opposer in its marks, by using a crown-design mark which closely resembles Opposer's registered crown marks, and on products which are closely related to those on which the Opposer's CORONA Marks appear. Accordingly, Opposer believes that the Applicant's proposed mark is likely 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.

09/25/2003 TAP

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: MAA: N
Joseph A. Yanny, Esq.
Michael A. DiNardo, Esq.
Attorneys for Opposer
YANNY & SMITH
1925 Century Park East, Suite 1260
Los Angeles, California 90067
Telephone: (310) 551-2966
Facsimile: (310) 551-1949

Dated: August 15, 2003

TTAB



08-19-2003

U.S. Patent & TMOtc/TM Mail Ropt Dt. #22

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

In the Matter of Trademark Application:

Ser. No.: 78-172,568
Mark: Miscellaneous Crown Design
Published: June 17, 2003
Int'l Classes: 33
Our File: L4414

TRANSMITTAL LETTER

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

03 AUG 25 11:59:32
TTAB FEE

To Whom it May Concern:

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,

MA:Y
Joseph A. Yanny, Esq.
Michael A. DiNardo, Esq.
YANNY & SMITH
1925 Century Park East, Suite 1260
Los Angeles, CA 90067
Telephone: (310) 551-2966
Facsimile: (310) 551-1949
Attorneys for Opposer

Dated: August B 2003

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 8/15, 2003

DK
David Kohut Date 8/15/03