

August 3, 2005

Client Matter No. 27158-030-002

VIA EXPRESS MAIL

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



08-03-2005
U.S. Patent & TMO/TM Mail Rcpt Dt. #11

Re: Application Serial No. 78/429,993
Mark: HERON SOUND

Dear Commissioner:

Enclosed please find the following for filing with the U.S. Patent and Trademark Office:

1. An original plus two (2) copies of the Notice of Opposition; and
2. Self-Addressed Stamped Postcard.

Please debit the Deposit Account No. 50-1847 of Manatt, Phelps & Phillips LLP for the Notice of Opposition filing fee of \$300.00. A duplicate copy of this letter is enclosed for such purpose. Please indicate your receipt of these documents by date-stamping and returning to us the enclosed stamped self-addressed postcard.

Should you have any questions regarding the foregoing, please contact us.

Sincerely,

Gail I. Nevius Abbas

Enclosures

cc. Susan E. Hollander, Esq.
Laura M. Franco, Esq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/429,993
Published in the *Official Gazette* on April 26, 2005

Heron Wines)
)
) Opposer,)
)
) v.)
)
) Winery Exchange, Inc.)
)
) Applicant.)
 _____)

Opposition No. _____



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NOTICE OF OPPOSITION

Pursuant to 15 U.S.C. § 1063(a), Opposer Heron Wines (“Opposer” or “Heron Wines”) alleges that it will be damaged by registration of the mark HERON SOUND (the “proposed mark”) as shown in Application Serial No. 78/429,993, filed by Applicant Winery Exchange, Inc. (“Applicant”), and hereby opposes its registration.

Applicant’s mark is described as follows:

Mark: HERON SOUND
Serial No. 78/429,993
Filed: June 4, 2004
Basis: 1B (intent-to-use)
Published: April 26, 2005
Classes: 33
Goods & Services: Wine.

Opposer is a California company having its principal place of business at 2269

Chestnut Street, #861, San Francisco, California 94123.

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Applicant is, upon information and belief, a California corporation, with a principal place of business located at 35 Leveroni Court, Suite 100, Novato, California 94949.

This Notice of Opposition has been timely filed.

As grounds for its opposition, Opposer alleges as follows:

1. Heron Wines was established and began producing high quality wines in 1994. For the past decade, since at least as early as 1995, Heron Wines has specifically and continuously sold its wines throughout the United States and in several countries worldwide under the distinctive mark HERON (the "HERON Mark").

2. Since its founding, Heron Wines has expanded its distribution of its HERON brand wines in nearly every state in the United States, Canada, the Caribbean, and Asia, and sells 60 thousand cases annually to top restaurant and retail accounts, including, for example, high profile national accounts such as The Four Season Hotels, Whole Foods, Roy's Restaurants and Cost Plus.

3. In addition, since approximately 1995, Heron Wines has operated its website, www.heronwines.com, where consumers may obtain descriptions of its wines and also order them directly through the website's online purchasing facility.

4. Since its inception, Heron Wines has expended substantial time and money in promoting and advertising its wines under the HERON Mark, including but not limited to on the Internet.

5. The HERON wines have received medals and accolades in the San Francisco Wine Competition, and the prestigious Orange County Fair Wine Competition,

co-sponsored by Bon Appetit Magazine. The HERON labels themselves have also received medals for their design in these same venues.

6. The HERON brand wines have received national and international coverage in each of the last ten years in wine publications such as the Wine Spectator, the Wine Enthusiast, Wine Spirits and Wine X Magazine. National lifestyle publications including The New York Times, "W" Magazine, Maxim and Better Homes and Gardens have also featured the HERON brand. In addition, HERON brand wines have appeared in both local and regional printed publications, and on television and radio.

7. Further, HERON wines can be located on many independent websites which are freely accessible by the consuming public, such as *winespectator.com*, *wineenthusiast.com*, *wineandspiritsmagazine.com* and The Beverage Tasting Institute's website *tastings.com*.

8. As a result of Opposer's efforts outlined above, and the widespread public recognition and renown generated by the wines offered under the HERON Mark, the HERON Mark enjoys extensive consumer recognition and Opposer has earned substantial revenue from the provision of its wines under the HERON Mark.

9. Also as a result of Opposer's promotion efforts and by virtue of the excellence and public acclaim of its goods, Opposer has garnered a valuable reputation for its HERON Mark, which is an asset of substantial value and a symbol of Heron Wines' goodwill.

10. On June 4, 2004 – nine years after Opposer first used its HERON Mark – Applicant filed its intent-to-use application for federal registration of the mark HERON SOUND in International Class 33, for wines. Accordingly, no issue of priority exists, as

Opposer's prior use in commerce of its HERON Mark long precedes Applicant's filing date of its intent-to-use application for its proposed mark.

11. Applicant's proposed mark so resembles and indeed creates the same commercial impression as Opposer's prior HERON Mark as to cause confusion, or to cause mistake or to deceive the public as to the origin of Applicant's goods bearing HERON SOUND. Therefore, registration of HERON SOUND is prohibited by 15 U.S.C. § 1052(d) and will result in damage to Opposer and to the public.

12. Upon information and belief, Opposer's goods displaying Opposer's HERON Mark and those on which Applicant displays or intends to display the proposed mark are very similar; are marketed through the same, or essentially the same, trade channels; and are offered for sale to the same, or essentially the same, purchasers and prospective purchasers. Accordingly, registration and use by Applicant of its proposed mark is likely to cause confusion, or to cause mistake or to deceive the public as to the origin of Applicant's goods displaying HERON SOUND. Therefore, registration of "HERON SOUND is prohibited by 15 U.S.C. §§ 1052(d) and 1125 and will result in damage to Opposer and to the public.

13. Registration and/or use of Applicant's proposed mark will lead the public to conclude, incorrectly, that Applicant is or has been, and that Applicant's goods displaying HERON SOUND are or have been, authorized, sponsored, or licensed by Opposer. Accordingly, issuance of any registration to Applicant for HERON SOUND is contrary to the provisions of 15 U.S.C. §§1052(d) and 1125 and will result in damage to Opposer and to the public and will result in damage to Opposer and to the public.

14. Opposer also will be damaged by the registration of Applicant's proposed mark, as such registration would grant Applicant *prima facie* exclusive right to use the proposed mark pursuant to 15 U.S.C. § 1057(b), despite Opposer's priority over Applicant and the likelihood of confusion and injury to goodwill that will be caused by Applicant's mark, all being contrary to the principals of registration set out in 15 U.S.C. § 1051 *et seq.*

15. Registration of the proposed mark would be incorrect and improper in view of the provisions of the Trademark Act of 1946, as amended, including specifically but not limited to the provisions of 15 U.S.C. §§ 1051, 1052, 1057, 1063 and 1125.

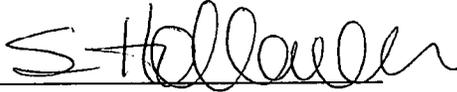
WHEREFORE, Opposer prays that this Opposition be sustained, and that registration to Applicant for HERON SOUND in Application Serial No. 78/429,993 for the goods identified in International Class 33 be denied.

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Opposer submits this Notice of Opposition in triplicate, and hereby advises the Board that it may debit the Deposit Account No. 50-1847 of Manatt, Phelps & Phillips LLP for the appropriate filing fee of \$300.00. Please direct all notices, pleadings and correspondence in this matter to the undersigned counsel for Opposer Heron Wines.

DATED: August 3, 2005

Respectfully submitted,

By: 

Susan E. Hollander, Esq.

Laura M. Franco, Esq.

Gail I. Nevius Abbas, Esq.

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Attorneys for Opposer Heron Wines

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Certificate No. EV 724101595 US, postage prepaid, in an Express Mail envelope addressed to: U.S. Patent and Trademark Office, Trademark Trial & Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this 3rd day of August, 2005.



Laurie Palmer