

ESTTA Tracking number: **ESTTA51938**

Filing date: **11/03/2005**

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

<b>Proceeding</b>	91166211
<b>Party</b>	Defendant Winery Exchange, Inc. Winery Exchange, Inc. 35 Leveroni Court, Suite 100 Novato, CA 94949
<b>Correspondence Address</b>	Robert B. Burlingame Pillsbury Winthrop Shaw Pittman LLP Calendar/Docketing Department P.O. Box 7880 San Francisco, CA 94120-7880  rburlingame@pillsburylaw.com, sftrademarks@pillsburylaw.com
<b>Submission</b>	Answer
<b>Filer's Name</b>	Robert B. Burlingame
<b>Filer's e-mail</b>	rburlingame@pillsburylaw.com, sftrademarks@pillsburylaw.com
<b>Signature</b>	/Robert B. Burlingame/
<b>Date</b>	11/03/2005
<b>Attachments</b>	HERON SOUND Answer.pdf ( 4 pages ) HERON SOUND Proof of Service of Answer.pdf ( 1 page )



4. Applicant admits the fourth unnumbered paragraph of the Notice of Opposition.
5. Applicant denies the fifth unnumbered paragraph of the Notice of Opposition.

For its answer to the numbered paragraphs (the alleged “grounds”) in the Notice of Opposition, Applicant avers as follows, with the following paragraph numbers corresponding to the numbered paragraphs in the Notice of Opposition:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
9. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same.
10. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments, and denies same, with the exception that Applicant admits that on June 4, 2004, it filed its intent-to-use application for federal registration of the mark HERON SOUND in International Class 33, for wines.
11. Denied.
12. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the averments of the first sentence, and denies same. Applicant denies the second and third sentences.
13. Denied.
14. Denied.

15. Denied.

### **AFFIRMATIVE DEFENSES**

#### **I. Notice of Opposition Not Timely Filed.**

First, Opposer's claims are barred by statute because the Notice of Opposition was not timely filed. The Notice of Opposition was filed on behalf of "Heron Wines" ninety-nine days after Applicant's U.S. Trademark Application Ser. No. 78/429,993 was published; however, "Heron Wines" had never requested or been granted any requests for extension of time to oppose.

Applicant's U.S. Trademark Application Ser. No. 78/429,993 was published on April 26, 2005.

On May 12, 2005, a request for extension of time to oppose was filed on behalf of "LaelyHeron". On May 13, 2005, the Board issued a notice granting the request and stating, "The request to extend time to oppose is granted until 6/25/2005 on behalf of potential opposer LaelyHeron".

On June 15, 2005, a further request for extension of time to oppose was filed on behalf of "LaelyHeron". On June 15, 2005, the Board issued a notice granting the request and stating, "The request to extend time to oppose is granted until 8/24/2005 on behalf of potential opposer LaelyHeron".

Then on August 3, 2005, the Notice of Opposition was filed on behalf of Heron Wines, which is a "California company" according to the Notice of Opposition. In the Notice of Opposition, the caption, the first unnumbered paragraph, and the final paragraph immediately preceding the Opposer's attorney's signature, all expressly identify the Opposer as "Heron Wines". The numbered paragraphs #1, 2, 3, 4 and 9 in the Notice of Opposition also expressly reference Heron Wines, and there is no mention of "LaelyHeron" in the Notice of Opposition.

In sum, the Notice of Opposition was filed on behalf of Heron Wines, but Heron Wines had not been granted any extension requests that would have permitted it to file the Notice of Opposition ninety-nine days after the publication of U.S. Trademark Application Ser. No. 78/429,993. LaelyHeron had been granted extensions of time to oppose through August 24, 2005, but no Notice of Opposition was filed on behalf of LaelyHeron by that date. Therefore, this opposition must be dismissed as untimely.

II. Laches, Estoppel & Acquiescence.

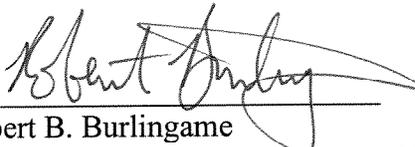
Opposer's claims are also barred by laches, estoppel and acquiescence.

WHEREFORE, Applicant prays that the Board dismiss this opposition with prejudice and pass Application Serial No. 78/429,993 to allowance.

Dated: November 3, 2005

Respectfully submitted,

WINERY EXCHANGE, INC.

By: 

Robert B. Burlingame  
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Opposition No. 91166211

PROOF OF SERVICE BY FIRST-CLASS MAIL

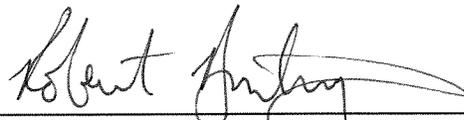
I, Robert B. Burlingame, the undersigned, hereby certify and declare under penalty of perjury that the following statements are true and correct:

1. I am over the age of 18 years and am not a party to the within cause. I am employed by Pillsbury Winthrop Shaw Pittman LLP in San Francisco, CA.
2. My business address is 50 Fremont Street, San Francisco, CA 94105. My mailing address is P.O. Box 7880, San Francisco, CA 94120-7880.
3. On November 3, 2005, I served a true copy of the attached document titled exactly "Answer to Notice of Opposition" by placing it in an addressed and sealed envelope and transmitting it by first-class mail, to the following:

**Susan E. Hollander  
Manatt, Phelps & Phillips LLP  
1001 Page Mill Road, Bldg 2  
Palo Alto, CA 94304**

I declare under penalty of perjury that the foregoing is true and correct.

Executed this 3<sup>rd</sup> day of November, 2005, at San Francisco, CA.

  
\_\_\_\_\_  
Robert B. Burlingame