

ESTTA Tracking number: **ESTTA44585**

Filing date: **09/08/2005**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|--|--|
| Name | HEINEKEN BROUWERIJEN B. V. |
| Granted to Date of previous extension | 09/14/2005 |
| Address | Tweede Weteringplantsoen 21 Amsterdam, 1017 ZD NETHERLANDS |

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|--------------------------------|---|
| Domestic Representative | Jonathan Hudis Attorney Oblon, Spivak, McClelland, Maier & Neustadt, P.C. 1940 Duke Street Alexandria, VA 22314 UNITED STATES tmdocket@oblon.com, jhudis@oblon.com Phone:703-413-3000 |
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Applicant Information

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|-------------------------------|---|-------------------------------|------------|
| Application No | 78336665 | Publication date | 05/17/2005 |
| Opposition Filing Date | 09/08/2005 | Opposition Period Ends | 09/14/2005 |
| Applicant | The Sleeman Brewing & Malting Co. Ltd. 551 Clair Road West | | |

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|------------------------------------|
| Guelph, Ontario, N1H 5H9 CANADA |
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Goods/Services Affected by Opposition

Class 032.

All goods and services in the class are opposed, namely: Brewed alcoholic beverages in the nature of ale

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| Attachments | 229137-274098us-nopp.pdf (9 pages) |
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| Signature | /Jonathan Hudis/ |
| Name | Jonathan Hudis |
| Date | 09/08/2005 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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| _____ |) | |
| HEINEKEN BROUWERIJEN B.V., |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No.: _____ |
| |) | Appln. Serial No. 78/336,665 |
| THE SLEEMAN BREWING & MALTING |) | |
| CO. LTD., |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

The Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

HEINEKEN BROUWERIJEN B.V., a limited liability company duly organized and existing under the laws of the Netherlands, located and doing business at Tweede Weteringplantsoen 21, Amsterdam, 1017 ZD, the Netherlands (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No. 78/336,665, filed December 4, 2003, under the Trademark Act of 1946, in the name of THE SLEEMAN BREWING & MALTING CO. LTD., published for opposition in the *Official Gazette* of May 17, 2005, Vol. 1294, No. 3, at Page TM 352, for the mark SLEEMAN CREAM ALE & CAN Design.

The grounds of Opposition are as follows:

1. Opposer, HEINEKEN BROUWERIJEN B.V., is a limited liability company duly organized and existing under the laws of the Netherlands, located and doing business at Tweede Weteringplantsoen 21, Amsterdam, 1017 ZD, the Netherlands.

2. Commencing long prior to Applicant's filing date, or any other priority date that could be claimed by Applicant, Opposer has engaged, and is now engaged in the manufacture, distribution, sale, advertising and promotion in commerce of beer products.

3. Commencing long prior to Applicant's filing date, or any other priority date that could be claimed by Applicant, Opposer has used, and is now using Opposer's CAN Design trademark (hereinafter sometimes referred to as "Opposer's Mark") in connection with beer products manufactured, distributed, sold, advertised and promoted by Opposer in commerce.

4. Opposer is the owner of, and will rely herein, upon the following Federal trademark registration:

MARK



REGISTRATION NO.

2,262,093

ISSUED

July 20, 1999

Opposer's Trademark Registration No. 2,262,093 identifies the goods as "beer." Said registration of Opposer's Mark is valid, subsisting, and incontestable, and is conclusive evidence of Opposer's exclusive right to use Opposer's Mark in commerce on the goods specified in said registration. Said Registration describes Opposer's Mark as follows: "The mark consist[s] of a

three-dimensional representation of a miniature beer barrel. The stippling indicates shading, and is not a feature of the mark.”

5. Since Opposer’s initial use of its CAN Design Mark, Opposer has made a substantial investment in advertising and promoting its beer products under its Mark. Opposer has extensively used, advertised, promoted and offered Opposer’s beer products bearing the mark to the public through various channels of trade in commerce, with the result that Opposer’s customers and the public in general have come to know and recognize Opposer’s CAN Design Mark and associate same with Opposer and/or beer products sold by Opposer. Opposer has built extensive goodwill in connection with the sales of beer products under its Mark.

6. Upon information and belief, on December 4, 2003, Applicant filed an application for registration of the alleged SLEEMAN CREAM ALE & CAN Design mark (hereinafter sometimes referred to as “Applicant’s Mark”) for “brewed alcoholic beverages in the nature of ale.” Said application was assigned Serial No. 78/336,665, and was published for Opposition in the *Official Gazette* of May 17, 2005, Vol. 1294, No. 3, at Page TM 352.

7. As published for potential opposition, Application Serial No. 78/336,665 contains the following disclaimer: “no claim is made to exclusive right to use ‘cream ale’, apart from the mark as shown.”

8. As published for potential opposition, Applicant’s mark appears as follows:



9. As published for potential opposition, Application Serial No. 78/336,665 contains the following description of Applicant's Mark: "The mark consists of the stylized words SLEEMAN CREAM ALE and a design of a beer can."

10. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged SLEEMAN CREAM ALE & CAN Design mark, as set forth in Applicant's Trademark Application Serial No. 78/336,665, in that the mark is substantially similar to Opposer's CAN Design Mark and common law rights, and will be used in connection with goods overlapping in channels of trade, if not identical, with those goods offered to the public by Opposer under its CAN Design Mark.

FIRST GROUND FOR OPPOSITION
(Priority and Likelihood of Confusion)
(Challenge to the *Bona Fides* of Applicant's Intent to Use)

11. Opposer repeats and re-alleges paragraphs 1 through 10 above.

12. Applicant's alleged SLEEMAN CREAM ALE & CAN Design mark is a simulation and colorable imitation of, and so resembles Opposer's CAN Design Mark as to be likely, when applied to the proposed goods of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation – in derogation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

13. Upon information and belief, Opposer's goods and Applicant's goods are highly similar, if not identical, will be sold in close proximity, and will be bought and consumed by the same general class of purchasers.

14. Upon information and belief, the *bona fides* of Applicant's intent-to-use its alleged SLEEMAN CREAM ALE & CAN Design mark in commerce is not apparent from materials of record in the subject application, and Opposer therefore challenges same and leaves

the Applicant to its proofs with regard to the nature and sufficiency of Applicant's intent to use the alleged SLEEMAN CREAM ALE & CAN Design mark in commerce at the time of filing Application Serial No. 78/336,665, or at any time thereafter.

15. Opposer, upon information and belief, avers that its customers, and the relevant consuming public, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed goods to be marketed under Applicant's alleged SLEEMAN CREAM ALE & CAN Design mark and misled into believing that such goods are produced by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

SECOND GROUND FOR OPPOSITION
(Fraud on the U.S. Patent and Trademark Office)

16. Opposer repeats and re-alleges paragraphs 1 through 10 above.

17. During the prosecution of Application Serial No. 78/336,665, on June 24, 2004, the Examining Attorney issued an Office Action citing Opposer's U.S. Trademark Registration No. 2,262,093 as a bar to the registration of Applicant's Mark. Specifically, the Examining Attorney stated: "The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used in connection with the identified goods, so resembles the mark in U.S. Registration No. 2262093 as to be likely to cause confusion, to cause mistake, or to deceive."

18. In its Response filed on December 23, 2004 to the June 24, 2004 Office Action (hereinafter, "Applicant's Response"), Applicant made the following statements:

- a. "Applicant respectfully submits that [Applicant's] ... mark is not confusingly similar to the cited mark [of U.S. Trademark Registration No. 2,262,093]."

- b. “[A]s described below, a proper comparison of Applicant’s entire mark to the cited mark shows that the marks are quite dissimilar in overall appearance and commercial impression.”
- c. “Applicant’s mark is a two-dimensional representation of a can shaped like a beer barrel and featuring the distinct work [sic] SLEEMAN and the distinctive Sleeman Logo.”
- d. “The cited mark, Registration No. 2262093, which issued July 20, 1999 to Heineken Brouwerijen B.V. (“Registrant”) is a three-dimensional representation of a beer key [sic]. There are no other design elements to the cited mark. It is a three-dimensional representation of a plain can in the shape of a beer keg whereas Applicant’s mark is a two-dimensional representation of a can in the shape of a beer barrel bearing additional design elements and wording.”
- e. “[T]he Applicant’s mark is not packaging but, it is a design mark. The Applicant’s mark is not three-dimensional and therefore it is not confusing with the cited mark [of U.S. Trademark Registration No. 2,262,093].”
- f. “[T]he cited mark [of U.S. Trademark Registration No. 2,262,093] is claimed as a distinguishing guise in that it is a three dimensional representation whereas the Applicant’s mark is simply a two-dimensional design.”
- g. “[W]e [Applicant] respectfully submit that the Applicant’s mark, as applied for in connection with the design noted above, is easily distinguishable from the cited mark [of U.S. Trademark Registration No. 2,262,093] and that therefore, they should not be found confusing with one another on that basis and on the basis of the other design elements.”

19. On April 27, 2005, the PTO issued a Notice of Publication for Application Serial No. 78/336,665, notifying Applicant that Applicant’s Mark would be published in the *Official Gazette* on May 17, 2005.

20. Applicant’s Response distinguished Applicant’s Mark from Opposer’s Mark, at least in part, on the basis that Applicant’s Mark was a two-dimensional design mark whereas Opposer’s Mark was a three-dimensional mark.

21. Upon information and belief, Applicant intended to use and has used Applicant’s Mark as a three-dimensional configuration mark.

22. Upon information and belief, Applicant made the statements distinguishing Applicant's Mark from Opposer's Mark, at least in part, on the basis that Applicant's Mark was a two-dimensional design mark whereas Opposer's Mark was a three-dimensional that Applicant knew or should have known were erroneous, false, and/or misleading.

23. Upon information and belief, Applicant's erroneous, false, and/or misleading statement distinguishing Applicant's Mark from Opposer's Mark, at least in part, on the basis that Applicant's Mark was a two-dimensional design mark whereas Opposer's Mark was a three-dimensional mark was a material misrepresentation made with the intention of convincing the Examining Attorney to publish Applicant's Mark for potential opposition in the *Official Gazette*, and was therefore fraudulent. Therefore, Application Serial No. 78/336,665 should be deemed void.

24. Upon information and belief, Applicant's fraudulent statement distinguishing Applicant's Mark from Opposer's Mark, at least in part, on the basis that Applicant's Mark was a two-dimensional design mark whereas Opposer's Mark was a three-dimensional mark in fact convinced the Examining Attorney to publish Applicant's Mark for potential opposition in the *Official Gazette*. But for Applicant's fraudulent statement, the Examining Attorney would not have published Applicant's Mark for potential opposition. Absent opposition by a third party, Applicant would otherwise be granted a registration for Applicant's Mark to which it would not otherwise be entitled.

25. Registration to Applicant of Applicant's Mark on the basis of Application Serial No. 78/336,665 should be denied, due to Applicant's fraudulent statements made during the prosecution of said Application.

WHEREFORE, Opposer, HEINEKEN BROUWERIJEN B.V., believes and avers that it is being and will continue to be damaged by registration of the SLEEMAN CREAM ALE & CAN Design mark as aforesaid, and prays that said Application Serial No. 78/336,665 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed JONATHAN HUDIS, a member of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., and a member of the Bar of the Commonwealth of Virginia, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

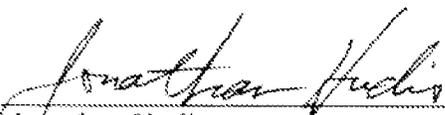
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If filed by paper, we enclose our credit card payment form or check for the required filing fee for this Opposition. If filed online, we herein authorize the Commissioner to charge the applicable filing fee that may be required for this Opposition to Account No. 50-2014. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

HEINEKEN BROUWERIJEN B.V.

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