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

Proceeding	91167758
Party	Plaintiff Austin Nichols & Co., Inc. dba Pernod Ricard, U.S.A.Austin Nichols & Co., Inc. dba Pernod Ricard, U.S.A. Austin Nichols & Co., Inc. dba Pernod Ricard, U.S.A. 777 Westchester Avenue White Plains, NY 10604 UNITED STATES
Correspondence Address	Louis S. Ederer, Esq. Torys LLP 237 Park Avenue New York, NY 10017 UNITED STATES trademarks@torys.com
Submission	Opposition/Response to Motion
Filer's Name	Louis S. Ederer
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Signature	/Louis S. Ederer/
Date	04/25/2006
Attachments	Opposition to Motion to Suspend.pdf (101 pages)(2598585 bytes)

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

Opposer Austin Nichols & Co. Inc. d/b/a Pernod Ricard U.S.A. (hereinafter "Austin Nichols") hereby opposes Applicant Lodestar Anstalt's (hereinafter "Applicant") motion to suspend the opposition proceedings. Opposer opposes the motion because, as set forth in detail below, the mark that is the subject of the instant application, WILD GEESE RARE IRISH WHISKEY, should be remanded to the Examining Attorney and returned to the pre-publication examination stage.[1] Austin Nichols premises its opposition on two grounds — (i) the series of missteps that permitted the WILD GEESE RARE IRISH WHISKEY mark to be published for opposition in the first place (notably even over the Applicant's repeated requests that the mark

[1] Notably, on November 22, 2005, Applicant, itself, requested that the Notice of Publication be withdrawn and that the application be returned to pre-publication suspension status. It is unclear if the TTAB intends to address Applicant's request.

not be published for opposition), and (ii) the January 17, 2006 decision of the Trademark Trial and Appeal Board ("TTAB") sustaining Austin Nichols' opposition to an application to register the mark WILD GEESE filed by Stichting Lodestar, a company apparently related to the Applicant (Opposition No. 91155615).

As set forth below, remanding the instant application to Examining Attorney for suspension would not only result in the correct procedural outcome, but would also minimize the efforts of the TTAB and the time and expense of the parties in connection therewith.

I. PRIOR PROCEEDINGS

Austin Nichols is part of the Pernod Ricard Group, one of the world's leading manufacturers and suppliers of alcoholic beverage products. Austin Nichols is the owner of WILD TURKEY, one of the most famous alcoholic beverage trademarks in United States history. Austin Nichols has used the famous WILD TURKEY trademark in the United States since 1942, and has successfully built up goodwill of incalculable value in the WILD TURKEY mark because of its successful promotion and sale of WILD TURKEY products over the course of the past sixty years.

Applicant is a company organized in Liechtenstein with no sales activities whatsoever in the United States. Applicant's filing of the instant application is part of a global campaign by Applicant to register trademarks containing the term "Wild Geese" in connection with whiskey products in violation of Austin Nichols' rights in its WILD TURKEY mark. In the instant case, Applicant has sought to capitalize unfairly on the fame of the WILD TURKEY mark by applying to register the mark WILD GEESE RARE IRISH WHISKEY for use with its own competing whiskey product.

The instant opposition proceeding is not the first time Austin Nichols has objected to Applicant's, or its related company's, efforts to register a mark similar to its WILD TURKEY

mark. In June 2000, Stichting Lodestar, identified by Applicant as a "related company" in the instant motion, applied to register WILD GEESE as a trademark (Application Ser. No. 76/074,330). See Ex. A. The application was published for opposition on January 28, 2003, and Austin Nichols filed an opposition to registration of the mark in February 2003 (Opposition No. 91155615). See Ex. B. In November 2003, months after Austin Nichols had opposed registration of WILD GEESE, Applicant filed Application Ser. No. 79/000,112 for the mark WILD GEESE RARE IRISH WHISKEY. See Exhibit C.

In June 2004, the U.S. Patent and Trademark Office ("USPTO") issued an Office Action initially refusing registration of the WILD GEESE RARE IRISH WHISKEY mark based on a possible likelihood of confusion with the prior pending application to register the WILD GEESE mark.[2] See Ex. D. Applicant responded to the Office Action in December 2004 by requesting suspension of its application pending the outcome of the WILD GEESE application and opposition. See Exhibit E (the "First Request for Suspension"). On December 14, 2004, further action on the WILD GEESE RARE IRISH WHISKEY application was suspended pending the outcome of the WILD GEESE application, which had been opposed by Austin Nichols. See Ex. F.

On May 10, 2005, the USPTO inexplicably issued Registration No. 2,947,089 for the WILD GEESE mark, despite the fact that Austin Nichols' opposition was still pending against the application, and, in fact, the case was scheduled for oral argument in July 2005. See Ex. G. Upon learning of the issuance of the registration for WILD GEESE, Austin Nichols immediately

[2] The USPTO also requested that Applicant modify its goods description, and disclaim exclusive rights to the RARE IRISH WHISKEY terms in its mark.

notified the TTAB and the USPTO of the error. On July 28, 2005, the USPTO issued an order canceling registration of the WILD GEESE mark. See Exhibit H.

In the meantime, however, apparently because the cited WILD GEESE application had matured to registration (albeit erroneously), the USPTO removed the WILD GEESE RARE IRISH WHISKEY application from suspension, and issued an Office Action in connection with the application on June 15, 2005. See Ex. I. In the Office Action, WILD GEESE (then mistakenly the subject of an issued registration) was officially cited as an obstacle to registration of the WILD GEESE RARE IRISH WHISKEY mark based on a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Id.

On August 4, 2005, Applicant's attorney filed a response to the June 15, 2005 Office Action pointing out that the WILD GEESE application was still the subject of opposition by Austin Nichols, and therefore the registration, and consequently the Office Action citing the registration, had been issued in error. See Ex. J. Attorney for Applicant requested that the June 15, 2005 Office Action be withdrawn, and that Application Ser. No. 79/000,112 for WILD GEESE RARE IRISH WHISKEY be placed back in suspension. Id. (the "Second Request for Suspension").

There was no response to Applicant's request for suspension. Instead, on August 17, 2005, the USPTO issued an Examiner's Amendment amending the place of business of Applicant. Although according to the Examiner's Amendment the examiner had spoken to the Applicant's attorney, the Examiner's Amendment provided no written record of how the outstanding likelihood of confusion issue had been addressed by Applicant. See Ex. K. Thereafter, on October 12, 2005, despite Applicant's two prior requests for suspension, and notwithstanding the remaining unresolved likelihood of confusion issue in the June 15, 2005

Office Action, the USPTO issued a Notice of Publication, and subsequently published the application to register the WILD GEESE RARE IRISH WHISKEY mark on November 1, 2005. See Ex. L.

Even after that, on November 22, 2005, upon receiving the Notice of Publication, Applicant's attorney contacted the USPTO and requested, in light of its prior requests to suspend the application for WILD GEESE RARE IRISH WHISKEY pending the outcome of the oppositions to the WILD GEESE application, that the USPTO withdraw the November 1, 2005 Notice of Publication and return the WILD GEESE RARE IRISH WHISKEY application to suspension. See Ex. M (the "Third Request for Suspension"). The USPTO did not respond to the Applicant's request. On November 28, 2005, Austin Nichols filed an opposition to registration of WILD GEESE RARE IRISH WHISKEY (Opposition No. 91167758). See Ex. N.

On January 17, 2006, the TTAB issued a decision sustaining Austin Nichols' opposition to the WILD GEESE application, finding that WILD GEESE was likely to be confused with Austin Nichols' WILD TURKEY marks. See Ex. O. On March 14, 2006, Stichting Lodestar filed a Notice of Appeal with the U.S. Court of Appeals for the Federal Circuit from the TTAB's decision. See Ex. P.

On April 5, 2006, Applicant filed the instant motion to suspend the opposition proceedings concerning WILD GEESE RARE IRISH WHISKEY pending the outcome of its appeal of the TTAB's January 17, 2006 decision sustaining Austin Nichols' opposition to the application to register WILD GEESE. See Ex. Q (the "Fourth Request for Suspension").

II. THE BOARD SHOULD REMAND THE INSTANT APPLICATION TO ITS PROPER PRE-PUBLICATION SUSPENSION STATUS

The Trademark Manual of Examining Procedure ("TMEP") states that "The Trademark Trial and Appeal Board, on its own initiative or in response to a request, may remand an

application to the examining attorney for consideration of specific facts." TMEP §1504.05. As noted above, the WILD GEESE RARE IRISH WHISKEY mark should never have been published for opposition. Indeed, Applicant's own counsel asked the Examining Attorney to place the application in suspension three times, including a request for the Notice of Publication to be withdrawn and the to be application returned to suspension before the USPTO. Now, rather than putting the opposition proceeding into suspension, the application should be remanded to the Examining Attorney and placed into suspension in the examination phase because: i) the application was erroneously removed from pre-publication suspension based on the mistaken issuance of the WILD GEESE registration, which was subsequently cancelled; ii) the application was improperly published by the USPTO while the issue of likelihood of confusion remained outstanding and had not been addressed or withdrawn on the written record; and iii) the application was published for opposition despite the Applicant's repeated to have the application suspended.

Additionally, Austin Nichols contends that the application should be remanded to the USPTO in light of the TTAB's January 17, 2006 decision sustaining Austin Nichols' opposition to WILD GEESE. As shown below, this will save the expenditure of many resources if the appeal of the TTAB's decision sustaining Austin Nichols' opposition to the application to register WILD GEESE is affirmed, or is not perfected by Stichting Lodestar.

A. The Application for WILD GEESE RARE IRISH WHISKEY Should Not Have Been Removed From Suspension Until the Application For WILD GEESE Was Registered or Abandoned

The TMEP states that "When there are conflicting marks in pending applications, action on the application with the later effective filing date will be suspended . . . until the mark in the conflicting application with the earlier effective filing date is either registered or abandoned." TMEP § 716.02(c); 37 C.F.R. § 2.83(c). Here, the Examining Attorney placed the later-filed

WILD GEESE RARE IRISH WHISKEY application on suspension in December 2004 pending the final resolution of the WILD GEESE trademark application in accordance with TMEP § 716.02(c). However, the examining attorney subsequently removed the application from suspension based on the erroneous registration of WILD GEESE, which was later cancelled. Although the USPTO corrected its error of issuing the WILD GEESE registration by canceling it, the USPTO has yet to correct the errors precipitated by the issuance of the WILD GEESE registration — namely, the issuance of the June 15, 2005 Office Action and the consequent publication of WILD GEESE RARE IRISH WHISKEY. The TTAB should address these errors by remanding the WILD GEESE RARE IRISH WHISKEY application to the PTO for placement on pre-publication suspension pursuant to TMEP §1504.05.

B. There Is No Written Record That the Likelihood of Confusion Issue that Was Raised in the June 15, 2005 Office Action Was Ever Overcome or Withdrawn.

Under Trademark Office procedure, the Examining Attorney is required to address each refusal or requirement in a prior Office Action, and indicate whether the refusals are withdrawn or maintained. Specifically, the TMEP states:

> The examining attorney should indicate whether particular refusals or requirements are withdrawn or whether the applicant's response is acceptable . . . . To prevent any misunderstanding, every refusal or requirement in the prior action that is still outstanding must be repeated or referred to.

TMEP §713.02. If the applicant presents arguments to overcome a refusal, the Examining Attorney is required to respond to applicant's arguments. TMEP §713.03.

In the June 15, 2005 Office Action, the Examining Attorney cited the application for WILD GEESE as a an obstacle to registration based on a likelihood of confusion under Section 2(d) of the Lanham Act. The Applicant responded to the June 15, 2005 Office Action by filing a written request for suspension of the WILD GEESE RARE IRISH WHISKEY application on

August 4, 2005. See Exhibit L. The request for suspension did not address the outstanding issue of the likelihood of confusion refusal under Section 2(d).

On August 17, 2005, the Examining Attorney issued an Examiner's Amendment based on a telephone conversation with Applicant's Attorney. See Exhibit M. The Examiner's Amendment officially amended the place of incorporation of Applicant, but did not document how or whether the outstanding likelihood of confusion issue was addressed. Thus, there is no written record that the Applicant presented arguments to overcome the refusal, or that the refusal was ever withdrawn by the Examining Attorney. See 37 C.F.R. §1.2; TMEP §709.03 (requiring that a written record be created of all business conducted before the Patent and Trademark Office.) Instead, the application was published for opposition without any written record of Applicant ever having presented arguments to overcome the Examining Attorney's initial likelihood of confusion refusal based on Section §2(d).

Thus, the instant application should be remanded to the examining attorney so that the outstanding issues in the June 15, 2005 Office Action can be addressed.

C. The Application Should be Suspended Based on Applicant's Attorneys' Requests.

Moreover, the application should have been suspended in accordance with Applicant's own requests. Applicant's own attorneys have repeatedly acknowledged the USPTO's procedural errors and requested that the instant application placed on suspension in the examination phase on three separate occasions. In fact, prior to the instant motion for suspension, Applicant's attorneys requested that the Notice of Publication be withdrawn and that the matter be returned to suspension before the USPTO. While this would clearly be the correct procedural result, no action was ever taken on this request by either the USPTO or the TTAB.

D. The Application Should be Remanded to the Examining Attorney and Suspended Based on Austin Nichols' WILD TURKEY Trademark Registrations

Finally, Austin Nichols contends that the application should be remanded to the USPTO in light of the TTAB's January 17, 2006 decision sustaining Austin Nichols' opposition to WILD GEESE. As the Applicant has admitted in the instant motion for suspension:

> The Opposer [Austin Nichols] in the related Opposition Proceeding [Opposition No. 91155615] is identical to the Opposer in this action. As noted above, the Applicant in the related Opposition Proceeding is related to the Applicant in this action. Likewise, the related Opposition Proceeding involves the same dispute (i.e., the right to register the mark WILD GEESE in light of the Opposer's WILD TURKEY trademark.

Thus, the USPTO should have identified, as an additional basis for suspending the application to register WILD GEESE RARE IRISH WHISKEY, the existence of Austin Nichols' WILD TURKEY trademark registrations, and can do so now upon remand. Upon remand, the Examining Attorney should be directed to cite Austin Nichols' WILD TURKEY as an addition basis for refusal to register pursuant to §2(d) of the Lanham Act and suspend the application pending the outcome of the appeal of the TTAB's decision sustaining Austin Nichols' opposition to the registration of WILD GEESE.

If the application to register WILD GEESE RARE IRISH WHISKEY is remanded, it would result in the avoidance of unnecessary motion practice before the TTAB in the event that the TTAB's decision sustaining the opposition to the registration of WILD GEESE on the basis of Austin Nichols' WILD TURKEY is affirmed on appeal, or if Stichting Lodestar fails to perfect its appeal. In other words, if the TTAB's decision is affirmed, and Austin Nichols' opposition to the registration of WILD GEESE RARE IRISH WHISKEY has been suspended by the TTAB, then Austin Nichols will be forced to make a motion for summary judgment in order to have its opposition to WILD GEESE RARE IRISH WHISKEY sustained, thus occupying the

resources of the TTAB. If, on the other hand, the application is returned to pre-publication suspension before the USPTO, affirmance of the TTAB's decision concerning WILD GEESE would simply result in the issuance of a Final Refusal by the Examining Attorney. Thus, returning the application to a pre-publication suspension state is not only proper in light of the many missteps that led to publication, but would also result in the most economical allocation of USPTO resources.

CONCLUSION

For the foregoing reasons, Austin Nichols urges the Examining Attorney to move for remand of Application Ser. No. 79/000,112, and once remanded, to place the application in suspension pending the outcome of the appeal of Opposition No. 91155615.

Dated: April 25, 2006

Respectfully submitted,

TORYS LLP

By: /Louis S. Ederer /
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ATTORNEYS FOR OPPOSER:
AUSTIN NICHOLS & CO., INC.
d/b/a PERNOD RICARD U.S.A.

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT A TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

TRADEMARK
Docket No. 39703/DBP/S307

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
INTENT-TO-USE APPLICATION TRANSMITTAL

This paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 CFR § 1.10, Mailing Label No. ***EM340923196US***.

Box NEW APP FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

June 20, 2000

Commissioner:

Enclosed is an application, including drawing, for registration of a mark as follows:

1. Mark, Applicant and Class(es):

   Mark : WILD GEESE
   Applicant : Stichting Lodestar
   Class(es) : 32 and 33

2. Application is made under Section 1(b).

3. Application is made for registration under Section 44(e) based on priority under Section 44(d).

4. Check for the filing fee of $650.00.

The Commissioner is authorized upon filing or during prosecution of this application to charge any additional fees which may be required or credit any overpayment of fees to Deposit Account No. 03-1728. Please show our docket number with any Deposit Account transaction. **A copy of this letter is enclosed**.

Please address all correspondence to **CHRISTIE, PARKER & HALE, LLP, P. O. Box 7068, Pasadena, California 91109-7068.**

Respectfully submitted,

CHRISTIE, PARKER & HALE

By D. Bruce Prout
D. Bruce Prout
626/795-9900

DBP/sfc
SFC PAS257369.1-*-6/20/00 11:20 AM

TRADEMARK
Docket No. 39703/DBP/S307

IN THE U.S. PATENT AND TRADEMARK OFFICE

APPLICATION FOR TRADEMARK/SERVICE MARK REGISTRATION
PRINCIPAL REGISTER

---

1 **MARK:** WILD GEESE INTL. CLASS(ES): 32 and 33

ASSISTANT COMMISSIONER FOR TRADEMARKS:

2 **APPLICANT NAME:** Stichting Lodestar

3 **APPLICANT BUSINESS ADDRESS:** Prinses Irenestraat 59, 1077 WV Amsterdam, The Netherlands

4 **APPLICANT ENTITY** (Check one and supply requested information):

☐ Individual--citizenship *(country)*: _____

☐ Partnership--partnership name and domicile; names and citizenship of general partners: _____

☐ Corporation--state *(country, if appropriate)* of incorporation: _____

☒ Other--*specify nature and domicile of entity*: a Dutch Company

5 **GOODS AND/OR SERVICES**

Applicant requests registration of the above-identified trademark/service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et seq., as amended) for the following goods/services: BEERS, MINERAL AND AERATED WATERS AND OTHER NON-ALCOHOLIC DRINKS, FRUIT DRINKS AND FRUIT JUICES; SYRUPS AND OTHER PREPARATIONS FOR MAKING BEVERAGES (INTL. CLASS 32); ALCOHOLIC BEVERAGES, EXCEPT BEERS (INTL. CLASS 33)

This paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 CFR § 1.10
Mailing Label No. EM 340923196US

BASIS FOR APPLICATION (Check one or more of items 6 through 9, but NOT both items 6 AND 7, and supply requested information.)

6 ☐ **Actual Use** - Applicant is using the mark in commerce on or in connection with the above-identified goods/services under 15 U.S.C. 1051(a), as amended. **One specimen** showing the mark as used in commerce is submitted with this application.

- Date of first use of the mark anywhere: _____
- Date of first use of the mark in commerce which the U.S. Congress may regulate: _____

7 ☒ **Intent to Use** – Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services under 15 U.S.C. 1051(b), as amended.

8 ☒ **Foreign Application** - Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services, and asserts a claim of priority in accordance with 15 U.S.C. 1126(d) Section 44(d), as amended.

- Country and application No.: Benelux, No. 953376
- Date of foreign filing: 22.December.1999

9 ☐ **Foreign Registration** – Applicant has a bona fide intention to use the mark in commerce on or in connection with the above-identified goods/services. Registration is requested under 15 U.S.C. 1126(e) (Section 44(e)), as amended, based on:

- Country of registration: _____
- Registration number: _____

Designation of Domestic Representative

Christie, Parker & Hale, LLP, whose postal address is P.O. Box 7068, Pasadena, California 91109-7068, U.S.A., is hereby designated Applicant's representative upon whom notices or process in proceedings affecting the mark may be served.

Power of Attorney

Applicant hereby appoints the following members of the Bar and attorneys of the law firm Christie, Parker & Hale, LLP, with full power of substitution and revocation, to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the Certificate of Registration:

R. W. Johnston
D. Bruce Prout
Hayden A. Carney
Richard J. Ward, Jr.
Russell R. Palmer, Jr.
LeRoy T. Rahn
Richard D. Seibel
Walter G. Maxwell
William P. Christie
David A. Dillard
Thomas J. Daly
Vincent G. Gioia
Theodore A. Pianko
Edward R. Schwartz
John D. Carpenter
David A. Plumley
Wesley W. Monroe
Gregory S. Lampert
Robert L. Toms, Sr.
James E. Doroshow
Grant T. Langton
Constantine Marantidis
Daniel R. Kimbell
Craig A. Gelfound
Syed A. Hasan
Marilyn R. Khorsandi
Daniel M. Cavanagh
Gary J. Nelson
Kathleen M. Olster
Josephine E. Chang
Lucinda G. Auciello
Joel A. Kauth
Patrick Y. Ikehara
Mark Garscia
Peter J. Reitan
Charles R. Halloran
Raymond R. Tabandeh
Phuong-Quan Hoang
Kathy Mojibi
Gary S. Dukarich
Theresa W. Middlebrook
Cynthia A. Bonner
Paul B. Heynssens
Jun-Young E. Jeon
Marc A. Karish
Molly A. Holman
Peter A. Nichols
Harold E. Wurst
Robert A. Green
Alan M. Kindred
Derrick W. Reed
Patrick S. Schoenburg
Stephen D. Burbach
David B. Sandelands, Jr.
Heidi L. Eisenhut
W. Casey Walls
Leigh O. Lindner

The authority under this Power of Attorney of each person named above shall automatically terminate and be revoked upon such person ceasing to be a member or associate of or of counsel to that firm.

Please address all correspondence concerning this application to **CHRISTIE, PARKER & HALE, LLP**, Post Office Box 7068, Pasadena, California 91109-7068, U.S.A. Telephone 626/795-9900

Declaration

The undersigned being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he is properly authorized to execute this application on behalf of the applicant and further, based on information and belief declares: he believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. 1051(b), he believes applicant to be

entitled to use such mark in commerce; to the best of his knowledge and belief no other person, firm, corporation, or association has the right to use the above-identified mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

10 June 20, 2000
(Date)

11 D. Bruce Prout
(Signature)

12 D. Bruce Prout, Attorney for Stichting Lodestar
(Printed/Typed Name and Title)

SFC PAS257361.1-*-6/20/00 11:12 AM

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	:	
Opposer,	:	
v.	:	Opposition No. 91167758
LODESTAR ANSTALT,	:	
Applicant.	:	

EXHIBIT B TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

02-13-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #01

Attorney Docket: AN USA OP002

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

In the Matter of Application Serial No. 76/074,330
Published in the *Official Gazette* on January 28, 2003
For the Mark: WILD GEESE

AUSTIN NICHOLS & CO., INC. dba PERNOD RICARD U.S.A. Opposer, v. STICHTING LODESTAR Applicant.	Opposition No.:

NOTICE OF OPPOSITION

Opposer Austin, Nichols & Co., Inc., dba Pernod Ricard U.S.A. (hereinafter "Opposer"), a corporation organized and existing under the laws of the State of Delaware and located as 777 Westchester Ave., White Plains, NY 10604, believes that it will be damaged by the registration of the mark WILD GEESE, Serial No. 76/074,330, filed on June 6, 2000, by Stitching Lodestar, Prinses Irenestraat 59, 1077 WV Amsterdam, Netherlands (hereinafter "Applicant"), published for opposition in the *Official Gazette* on January 28, 2003, and hereby opposes the same.

The grounds for opposition are as follows:

1. Since 1942, Opposer has manufactured, distributed, and sold in commerce in the United States various alcoholic beverage products bearing the trademark WILD TURKEY. Opposer owns the following U.S. trademark registrations for this mark for the words alone and in conjunction with other words, stylized lettering and/or designs:

Registration No. 2,263,231

Mark:	WILD TURKEY
Class/Goods:	33/Whiskey
Registration No.	513,549
Mark:	WILD TURKEY Stylized
Class/Goods:	33/Whiskey
Registration No.	1,912,713
Mark:	WILD TURKEY KENTUCKY COOLERS
Class/Goods:	33/Alcoholic Beverages, namely bourbon combined with a non-alcoholic mixer
Registration No.	1,670,450
Mark:	WILD TURKEY KENTUCKY LEGEND BEYOND DUPLICATION & DESIGN
Class/Goods:	33/Distilled alcoholic beverages, namely whiskey
Registration No.	1,299,830
Mark:	WILD TURKEY ONE-O-ONE & DESIGN
Class/Goods:	33/Whiskey
Registration No.	1,085,002
Mark:	WILD TURKEY
Class/Goods:	33/Liqueur

These marks are hereinafter referred to collectively as the "WILD TURKEY Marks."

3. Since introducing its alcoholic beverage products, Opposer has sold millions of cases of such products bearing the WILD TURKEY Marks throughout the United States.

4. Since introducing its alcoholic beverage products, Opposer has expended millions of dollars on advertising and sales promotion for such products bearing the WILD TURKEY Marks throughout the United States.

5. As a result of Opposer's extensive sales and expenditures for advertising and promotion of its alcoholic beverage products, Opposers' WILD TURKEY Marks are famous marks and have come to signify products originating with Opposer and to symbolize goodwill of incalculable value. Alcoholic beverages bearing Opposer's WILD TURKEY Marks have become well-known leading brands of alcoholic beverages in the United States.

6. On January 28, 2003, Applicant's WILD GEESE mark for "beers, mineral and aerated waters; cola; soft drinks, namely, pop; lemonade; carbonated soft drinks; low calorie soft drinks; non-carbonated soft drinks; fruit drinks and fruit juices; syrups and preparations for making beers, mineral and aerated waters, cola, carbonated drinks, soft drinks, lemonade, carbonated soft drinks, low calorie soft drinks, non-carbonated soft drinks, fruit drinks and fruit juices"in international Class 32 and "alcoholic beverages, namely, wine, rum, gin, vodka, whiskey, alcoholic bitters, brandy, hard cider, distilled spirits, distilled liquor, alcoholic aperitif bitters, aperitif wines; aperitifs with a distilled alcoholic liquor base; aperitifs with a wine base; sake and prepared alcoholic cocktails" in International Class 33 (hereinafter "Applicant's Mark"), was published for opposition in the *Official Gazette*. The application was filed on June 20, 2000 based upon Section 44(e) of the Lanham Act.

7. Applicant's Mark is confusingly similar to Opposer's WILD TURKEY Marks in that both Applicant and Opposer sell alcoholic beverages under the marks and both marks use the word "wild" in connection with the name of a game bird.

8. The goods for which Applicant seeks to register the Applicant's Mark are identical and closely related to the goods for which Opposer has registered its WILD TURKEY Marks.

9. Upon information and belief, Applicant's goods are marketed or will be marketed through the same channels of trade and to the same class of consumers as the goods of Opposer.

10. Prospective purchasers of Applicant's goods are likely to erroneously believe that such goods are produced by or under the authority of Opposer, or to erroneously assume that there is some other trade connection between Opposer and Applicant.

11. Applicant's Mark so resembles Opposer's WILD TURKEY Marks that, when

used on or in conjunction with the goods of Applicant:

(a) It is likely to cause confusion, or to cause mistake, or to deceive;

(b) It falsely suggests a connection with Opposer;

(c) It tends to damage Opposer's goodwill in its aforementioned marks; and

(d) It is likely to dilute the distinctive qualities of Opposer's aforementioned marks.

WHEREFORE, Opposer prays that its Opposition to the registration of Application Serial No. 76/074,330 be sustained.

The Commissioner is authorized to charge $600 for the Notice of Opposition and any additional fee which may be required the undersigned's Deposit Account No. 07-2490.

Please recognize Steven R. Gursky, Louis S. Ederer, Mary L. Grieco, who are members of the Bar of the State of New York and the firm of Gursky & Ederer, LLP, located at 1350 Broadway, 11th Floor, New York, New York 10018, as attorneys for Opposer.

Respectfully submitted,

GURSKY & EDERER, LLP
Attorneys for Opposer

By: _____

Louis S. Ederer
Mary L. Grieco
1350 Broadway, 11th Floor
New York, New York 10018
Tel.: (212) 904-1234
Fax.: (212) 967-4465

Dated: February 12, 2003

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	:	
Opposer,	:	
v.	:	Opposition No. 91167758
LODESTAR ANSTALT,	:	
Applicant.	:	

EXHIBIT C TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

REQUEST FOR EXTENSION OF PROTECTION

SERIAL NUMBER: 79000112

FILING DATE: 11/19/2003

The table below presents the data as entered.

Input Field	Entered
MARK SECTION	
IMAGE	\\ticrs\EXPORT8\IMAGEOUT8\790\001\79000112\xml1\APP0002.JPG
COLLECTIVE, CERTIFICATE OR GUARANTEE MARK	NO
MARK IN STANDARD CHARACTERS	YES
MARK IN COLOR	NO
THREE DIMENSIONAL MARK	NO
SOUND MARK	NO
TM IMAGE: COLOR	NO
IMAGE FILE NAME	\\ticrs\EXPORT8\IMAGEOUT8\790\001\79000112\xml1\APP0002.JPG
TYPE (IMAGE TYPE)	JPG
TEXTUAL ELEMENTS OF MARK	WILD GEESE RARE IRISH WHISKEY
HOLDER DETAILS	
CLIENT IDENTIFIER	477470
NOTIFICATION LANGUAGE	ENGLISH
NAME	Lodestar Anstalt
ADDRESS	Lova-Center,
	P.O. Box 1150
	FL-9490 Vaduz
COUNTRY	Liechtenstein
ENTITLEMENT ESTABLISHMENT	Liechtenstein
LEGAL NATURE	Not provided
LEGAL NATURE: PLACE INCORPORATED	Not provided
CORRESPONDENCE INDICATOR	YES
BASIC GOODS AND SERVICES	
VERSION OF NICE CLASSIFICATION USED	8
NICE CLASSIFICATION	33
GOODS AND SERVICES	Whiskey, all products of irish origin.

PARIS PRIORITY DETAILS	
PARIS PRIORITY CODE:	Liechtenstein
PARIS PRIORITY APPLICATION NUMBER	12922
PARIS PRIORITY APPLICATION DATE	05/26/2003
BASE REGISTRATION DETAILS	
BASE REGISTRATION NUMBER	12922
BASE REGISTRATION DATE	05/26/2003
REPRESENTATIVE DETAILS	
CLIENT IDENTIFIER	489678
NAME	Büchel, Kaminski & Partner
	Patentanwälte Est.
ADDRESS	Austrasse 79
	FL-9490 Vaduz
COUNTRY	Liechtenstein
INTENT TO USE GROUP	
CONTRACTING PARTY CODE	United States of America
DESIGNATIONS	
DESIGNATIONS UNDER THE PROTOCOL	United States of America
INTERNATIONAL REGISTRATION DETAILS	
INTERNATIONAL REGISTRATION NUMBER	0814790
INTERNATIONAL REGISTRATION DATE OF MARK	11/19/2003
INTERNATIONAL REGISTRATION EXPIRY DATE	11/19/2013
EFFECTIVE DATE OF MODIFICATION	11/19/2003
NOTIFICATION DATE	01/01/2004
DATE OF RECORDAL IN INTERNATIONAL REGISTER	12/13/2003
IB DOCUMENT ID	256428201
OFFICE OF ORIGIN CODE	Liechtenstein
OFFICE REFERENCE	79000112
TRANSACTION TYPE VALUES	Initial Designation
ORIGINAL LANGUAGE	ENGLISH
INSTRUMENT UNDER WHICH CONTRACTING PARTY IS DESIGNATED	Protocol
HOLDER REFERENCE	M-5751-IR

DURATION OF MARK (YEARS)	10

WILD GEESE RARE IRISH WHISKEY

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	:	
Opposer,	:	
v.	:	Opposition No. 91167758
LODESTAR ANSTALT,	:	
Applicant.	:	

EXHIBIT D TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/000112

APPLICANT: Lodestar Anstalt

79000112

CORRESPONDENT ADDRESS:
Büchel, Kaminski & Partner
Patentanwälte Est.
Austrasse 79
FL-9490 Vaduz LIECHTENSTEIN

RETURN ADDRESS:
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: WILD GEESE RARE IRISH WHISKEY

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 79/000112

The assigned examining attorney has reviewed the referenced application and has determined the following.

Search Results

Although the examining attorney has searched the Office records and has found no similar *registered* mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), the examining attorney encloses information regarding pending Application Serial No. 76/074330. 37 C.F.R. §2.83.

There may be a likelihood of confusion between the applicant's mark and the mark in the above noted application under Section 2(d) of the Act. The filing date of the referenced application precedes the applicant's filing date. If the earlier#filed application matures into a registration, the examining attorney may refuse registration under Section 2(d).

Action on this application will be suspended pending the disposition of Application Serial No. 76/074330, upon receipt o the applicant's response resolving the following informalities.

Identification of Goods

The wording "whiskey, all products of irish origin" [sic] in the identification of goods is unacceptable as indefinite. Th applicant may amend this wording to "whiskey of Irish origin" if accurate. TMEP §1402.01.

Disclaimers

The applicant must disclaim the descriptive wording "RARE IRISH WHISKEY" apart from the mark as shown. Tradema Act Section 6, 15 U.S.C. Section 1056; TMEP §§ 1213 and 1213.03(a). The wording is merely descriptive because th term "IRISH WHISKEY" is the generic name of the applicant's goods. Furthermore, the word "RARE" merely identifies purported quality of the applicant's whiskey. A term is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C §1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. *I re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry,* 791 F.2d 157, 229 USPQ 81 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright#Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) TMEP §1209.01(b).

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP § 1213 and 1213.08(a)(i). A properly worded disclaimer should read as follows:

> No claim is made to the exclusive right to use "RARE IRISH WHISKEY" apart from the mark as shown.

See In re Owatonna Tool Co., 231 USPQ 493 (Comm'r Pats. 1983).

No set form is required for response to this Office action. The applicant must respond to each point raised. The applican should simply set forth the required changes or statements and request that the Office enter them. The applicant must sig the response. In addition to the identifying information required at the beginning of this letter, the applicant should provid a telephone number to speed up further processing.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of th examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant' telephone number.

/G. Fosdick/

Geoffrey Fosdick

Trademark Attorney

Law Office 111

(540) 851-0865

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visi **http://www.uspto.gov/teas/index.html** and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and includ the serial number, law office and examining attorney's name on the upper right corner of each page of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieva (TARR) system at **http://tarr.uspto.gov/**

For general and other useful information about trademarks, you are encouraged to visit the Office's web site a **http://www.uspto.gov/main/trademarks.htm**

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNEI EXAMINING ATTORNEY.

DESIGN MARK

Serial Number
76074330

Status
OPPOSITION PENDING

Word Mark
WILD GEESE

Standard Character Mark
No

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
Stichting Lodestar COMPANY NETHERLANDS Prinses Irenestraat 59 1077 WV Amsterdam NETHERLANDS

Goods/Services
Class Status -- ACTIVE. IC 032. US 045 046 048. G & S: BEERS, MINERAL AND AERATED WATERS; COLA; SOFT DRINKS, NAMELY, POP; LEMONADE; CARBONATED SOFT DRINKS; LOW CALORIE SOFT DRINKS; NON-CARBONATED SOFT DRINKS; FRUIT DRINKS AND FRUIT JUICES; SYRUPS AND PREPARATIONS FOR MAKING BEERS, MINERAL AND AERATED WATERS, COLA, CARBONATED DRINKS, SOFT DRINKS, LEMONADE, CARBONATED SOFT DRINKS, LOW CALORIE SOFT DRINKS, NON-CARBONATED SOFT DRINKS, FRUIT DRINKS AND FRUIT JUICES.

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: ALCOHOLIC BEVERAGES, NAMELY, WINE, RUM, GIN, VODKA, WHISKEY, ALCOHOLIC BITTERS, BRANDY, HARD CIDER, DISTILLED SPIRITS, DISTILLED LIQUOR, ALCOHOLIC APERITIF BITTERS, APERITIF WINES; APERITIFS WITH A DISTILLED ALCOHOLIC LIQUOR BASE; APERITIFS WITH A WINE BASE; SAKE AND PREPARED ALCOHOLIC COCKTAILS.

Foreign Country Name
BENELUX

Foreign Priority
FOREIGN PRIORITY CLAIMED

Foreign Application Number

953376

Foreign Filing Date
1999/12/22

Foreign Registration Number
0661535

Foreign Registration Date
1999/12/22

Foreign Expiration Date
2009/12/22

Filing Date
2000/06/20

Examining Attorney
LOUGHRAN, BARBARA A.

Attorney of Record
R. W. Johnston

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT E TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on November 29, 2004.

Signature

Mark	: WILD GEESE RARE IRISH WHISKEY
Serial No.	: 79/000,112
Filed	: November 19, 2003
Applicant	: Lodestar Anstalt
Law Office	: 111
Examiner	: Geoffrey Fosdick
Docket No.	: 52995/DBP/S307

RESPONSE TO OFFICIAL OFFICE ACTION OF JUNE 3, 2004

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Post Office Box 7068
Pasadena, CA 91109-7068
November 29, 2004

Commissioner:

This is in response to the June 3, 2004 official Office action. Responsive to the objection to the goods description, the following is proposed:

WHISKEY OF IRISH ORIGIN (Int. Cl. 33)

Reconsideration of the objection and approval of the description is requested.

Responsive to the requirement for disclaimer, Applicant hereby disclaims the wording "RARE IRISH WHISKEY" separate and apart from the rest of the mark as shown without disclaiming any common law rights therein.

Suspension of this Application is requested pending disposition of Application No. 76/074,330.

Enclosed herewith is a request to direct further correspondence to the undersigned.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By D. Bruce Prout

D. Bruce Prout
626/795-9900

DBP/tll
Enclosure: Request
MAS PAS595903.1-*-11/29/04 5:12 PM

12-02-2004

U.S. Patent & TMOfc/TM Mail Rept Dt. #39

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT F TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/000112

APPLICANT: Lodestar Anstalt

79000112

CORRESPONDENT ADDRESS:
D BRUCE PROUT
CHRISTIE PARKER & HALE LLP
PO BOX 7068
PASADENA CA 91109-7068

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: WILD GEESE RARE IRISH WHISKEY

CORRESPONDENT'S REFERENCE/DOCKET NO: 52995/DBP/S3

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

Serial Number 79/000112

NOTICE OF SUSPENSION

This letter responds to the applicant's communication filed on December 2, 2004. The applicants amendments are acceptable.

Action on this application is suspended pending the disposition of Application Serial Number 76074330

The Trademark Applications and Registrations Retrieval (TARR) database on the USPTO website at http://tarr.uspto.gov provides detailed, up to the minute information about the status and prosecution history of trademark applications and registrations. The TARR database is available 24 hours a day, 7 days a week. Status and status date information is also available via push-button telephone at (703) 305#8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at http://www.uspto.gov/teas/index.html.

/G. Fosdick/

Geoffrey Fosdick

Trademark Attorney

Law Office 111

(540) 851-0865

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	:	
Opposer,	:	
v.	:	Opposition No. 91167758
LODESTAR ANSTALT,	:	
Applicant.	:	

EXHIBIT G TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

Int. Cls.: 32 and 33

Prior U.S. Cls.: 45, 46, 47, 48 and 49

Reg. No. 2,947,089

United States Patent and Trademark Office

Registered May 10, 2005

TRADEMARK
PRINCIPAL REGISTER

WILD GEESE

STICHTING LODESTAR (NETHERLANDS COMPANY)
PRINSES IRENESTRAAT 59
1077 WV AMSTERDAM, NETHERLANDS

FOR: BEERS, MINERAL AND AERATED WATERS; COLA; SOFT DRINKS, NAMELY, POP; LEMONADE; CARBONATED SOFT DRINKS; LOW CALORIE SOFT DRINKS; NON-CARBONATED SOFT DRINKS; FRUIT DRINKS AND FRUIT JUICES; SYRUPS AND PREPARATIONS FOR MAKING BEERS, MINERAL AND AERATED WATERS, COLA, CARBONATED DRINKS, SOFT DRINKS, LEMONADE, CARBONATED SOFT DRINKS, LOW CALORIE SOFT DRINKS, NON-CARBONATED SOFT DRINKS, FRUIT DRINKS AND FRUIT JUICES, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FOR: ALCOHOLIC BEVERAGES, NAMELY, WINE, RUM, GIN, VODKA, WHISKEY, ALCOHOLIC BITTERS, BRANDY, HARD CIDER, DISTILLED SPIRITS, DISTILLED LIQUOR, ALCOHOLIC APERITIF BITTERS, APERITIF WINES; APERITIFS WITH A DISTILLED ALCOHOLIC LIQUOR BASE; APERITIFS WITH A WINE BASE; SAKE AND PREPARED ALCOHOLIC COCKTAILS, IN CLASS 33 (U.S. CLS. 47 AND 49).

PRIORITY CLAIMED UNDER SEC. 44(D) ON BENELUX APPLICATION NO. 953376, FILED 12-22-1999, REG. NO. 0661535, DATED 12-22-1999, EXPIRES 12-22-2009.

SER. NO. 76-074,330, FILED 6-20-2000.

BARBARA A. LOUGHRAN, EXAMINING ATTORNEY

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT H TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

July 28, 2005

D. Bruce Prout, Esq.
CHRISTIE, PARKER & HALE, LLP
POST OFFICE BOX 7068
PASADENA, CA 91109-7068

Re: Trademark Registration No. 2,947,089
Mark: WILD GEESE

Dear Mr. Prout:

Trademark Registration No. 2,947,089, for the mark WILD GEESE, inadvertently issued on May 10, 2005, to Stichting Lodestar. The registration issued after a timely notice of opposition had been filed with the Trademark Trial and Appeal Board. The Office apologizes for this error.

The attached order specifies that Registration No. 2,947,089 is cancelled. The registration certificate is invalid and has no force or effect. The application will be restored to pendency as application serial No. 76/074330 and forwarded to the Trademark Trial and Appeal Board for further action.

Sincerely,

Gwendolyn A. Austin
Paralegal Specialist
Office of the Commissioner
for Trademarks
Phone: (571) 272-9564

cc: Attorney for Potential Opposers

Paulette R. Carey, Esq.
BUCHMAN & O'BRIEN, LLP
510 THORNALL STREET, SUITE 200
EDISON, NJ 08837

UNITED STATES
PATENT AND TRADEMARK OFFICE

Cancellation Order

WHEREAS Registration No. 2,947,089 was issued to Stichting Lodestar on May 10, 2005, for the mark WILD GEESE; and

WHEREAS due to a clerical error by the U.S. Patent and Trademark Office, Registration No. 2,947,089 was inadvertently issued after a Notice of Opposition had been filed with the Trademark Trial and Appeal Board;

THEREFORE, Registration No. 2,947,089, having been issued inadvertently and not in accordance with the procedures required by 15 U.S.C. §§1062(a) and 1063, is hereby ordered cancelled.

_____
(Date)

_____
Lynne G. Beresford
Deputy Commissioner for
Trademark Operations

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT I TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/000112

APPLICANT: Lodestar Anstalt

79000112

CORRESPONDENT ADDRESS:
D BRUCE PROUT
CHRISTIE PARKER & HALE LLP
PO BOX 7068
PASADENA CA 91109-7068

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: WILD GEESE RARE IRISH WHISKEY

CORRESPONDENT'S REFERENCE/DOCKET NO: 52995/DBP/S3

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

Serial Number 79/000112

On December 14, 2004, action on this application was suspended pending the disposition of Application Serial No. 76074330. The referenced application has matured into a registration. Therefore, registration is refused as follows.

Section 2(d) - Likelihood of Confusion Refusal

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. 2947089 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq*. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG,* 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

n the present case, the dominant portions of these marks are identical. The applicant's mark is "WILD GEESE RARE IRISH WHISKEY," and the egistrant's mark is "WILD GEESE." The term "RARE IRISH WHISKEY" is the descriptive term for the applicant's goods. Indeed, the applicant ias properly disclaimed exclusive rights to the term. While the examining attorney cannot ignore a disclaimed portion of a mark and must view narks in their entireties, one feature of a mark may be more significant in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 53 F.2d 915, 189 USPQ 693 (CCPA 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant.

Furthermore, even if "RARE IRISH WHISKEY" were not the descriptive term for the applicant's goods, it represents mere addition to a registered nark. The mere addition of a term to a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). *Coca#Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) ("THE LILLY" and "LILLI ANN"); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER MAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 342 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC").

Finally, the goods of the applicant and the registrant are identical. If the goods or services of the respective parties are closely related, the degree of similarity between marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods or services. *ECI Division of E Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443 (TTAB 1980).

It should be noted that the examining attorney must determine whether there is a likelihood of confusion on the basis of the goods identified in the application and registration. Since the registration describes the goods broadly and there are no limitations as to their nature, type, channels of trade or classes of purchasers, it is presumed that the goods encompasses all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.

NOTICE: FEE CHANGE

Effective January 31, 2005 and pursuant to the Consolidated Appropriations Act, 2005, Pub. L. 108-447, the following are the fees that will be charged for filing a trademark application:

(1) $325 per international class if filed electronically using the Trademark Electronic Application System (TEAS); or

(2) $375 per international class if filed on paper

These fees will be charged not only when a new application is filed, but also when payments are made to add classes to an existing application. If such payments are submitted with a TEAS response, the fee will be $325 per class, and if such payments are made with a paper response, the fee will be $375 per class.

The new fee requirements will apply to any fees filed on or after January 31, 2005.

NOTICE: TRADEMARK OPERATION RELOCATION

The Trademark Operation has relocated to Alexandria, Virginia. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at http://www.uspto.gov/teas/index.html.

/G. Fosdick/

Geoffrey Fosdick

Trademark Attorney

Law Office 111

(540) 851-0865

HOW TO RESPOND TO THIS OFFICE ACTION:

- ONLINE RESPONSE: You may respond formally using the Office's Trademark Electronic Application System (TEAS) Response to Office Action form (visit http://www.uspto.gov/teas/index.html and follow the instructions, but if the Office Action issued via email you must wait 72 hours after receipt of the Office Action to respond via TEAS).
- REGULAR MAIL RESPONSE: To respond by regular mail, your response should be sent to the mailing return address above and include the serial number, law office number and examining attorney's name in your response.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at http://tarr.uspto.gov.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at http://portal.uspto.gov/external/portal/tow.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at http://www.uspto.gov/main/trademarks.htm

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

DESIGN MARK

Serial Number
76074330

Status
REGISTERED

Word Mark
WILD GEESE

Standard Character Mark
No

Registration Number
2947089

Date Registered
2005/05/10

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
Stichting Lodestar COMPANY NETHERLANDS Prinses Irenestraat 59 1077 WV Amsterdam NETHERLANDS

Goods/Services
Class Status -- ACTIVE. IC 032. US 045 046 048. G & S: BEERS, MINERAL AND AERATED WATERS; COLA; SOFT DRINKS, NAMELY, POP; LEMONADE; CARBONATED SOFT DRINKS; LOW CALORIE SOFT DRINKS; NON-CARBONATED SOFT DRINKS; FRUIT DRINKS AND FRUIT JUICES; SYRUPS AND PREPARATIONS FOR MAKING BEERS, MINERAL AND AERATED WATERS, COLA, CARBONATED DRINKS, SOFT DRINKS, LEMONADE, CARBONATED SOFT DRINKS, LOW CALORIE SOFT DRINKS, NON-CARBONATED SOFT DRINKS, FRUIT DRINKS AND FRUIT JUICES.

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: ALCOHOLIC BEVERAGES, NAMELY, WINE, RUM, GIN, VODKA, WHISKEY, ALCOHOLIC BITTERS, BRANDY, HARD CIDER, DISTILLED SPIRITS, DISTILLED LIQUOR, ALCOHOLIC APERITIF BITTERS, APERITIF WINES; APERITIFS WITH A DISTILLED ALCOHOLIC LIQUOR BASE; APERITIFS WITH A WINE BASE; SAKE AND PREPARED ALCOHOLIC COCKTAILS.

Foreign Country Name

BENELUX

Foreign Priority
FOREIGN PRIORITY CLAIMED

Foreign Application Number
953376

Foreign Filing Date
1999/12/22

Foreign Registration Number
0661535

Foreign Registration Date
1999/12/22

Foreign Expiration Date
2009/12/22

Filing Date
2000/06/20

Examining Attorney
LOUGHRAN, BARBARA A.

Attorney of Record
R. W. Johnston

WILD GEESE

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT J TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

Please place on Upper Right Corner
**of Response to Office Action ONLY. *
Examining Attorney: FOSDICK, GEOFFREY
Serial Number: 79/000112

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on August 1, 2005.

Tammy Lightman

Mark	: WILD GEESE RARE IRISH WHISKEY
Serial No.	: 79/000,112
Filed	: November 19, 2003
Applicant	: Lodestar Anstalt
Law Office	: 111
Examiner	: Geoffrey Fosdick
Docket No.	: 52995/DBP/S307

RESPONSE TO OFFICE ACTION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Post Office Box 7068
Pasadena, CA 91109-7068
August 1, 2005

Commissioner:

This is in response to the June 15, 2005 Office action. The Action refuses registration based on prior Registration No. 2,947,089 under § 1052(d) of the Trademark Act.

However the '089 registration is based on Application No. 76/074,330 which is the subject of Opposition Nos. 91155165 and 91155995 and therefore the registration was

08-04-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #39

improperly granted. Withdrawal of the June 15, 2005 official Office action is requested and further suspension is requested pending the outcome of the oppositions.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By D. Bruce Prout

D. Bruce Prout
626/795-9900

DBP/mee
TLL PAS635988.1-*-08/1/05 5:00 PM

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT K TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 79/000112

APPLICANT: Lodestar Anstalt

79000112

CORRESPONDENT ADDRESS:
D BRUCE PROUT
CHRISTIE PARKER & HALE LLP
PO BOX 7068
PASADENA CA 91109-7068

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

If no fees are enclosed, the address should include the words "Box Responses - No Fee."

MARK: WILD GEESE RARE IRISH WHISKEY

CORRESPONDENT'S REFERENCE/DOCKET NO: 52995/DBP/S3

CORRESPONDENT EMAIL ADDRESS:

Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and email address.

Serial Number 79/000112

EXAMINER'S AMENDMENT

ADVISORY – AMENDMENTS TO GOODS/SERVICES: If the identification of goods and/or services has been amended below, any future amendments must be in accordance with 37 C.F.R. §2.71(a) and TMEP §1402.07(e).

AMENDMENT(S) AUTHORIZED: As authorized by Bruce Prout on August 17, 2005, the application is amended as noted below. *If applicant disagrees with or objects to any of the amendments below, please notify the undersigned trademark examining attorney immediately.* Otherwise, no response is necessary. TMEP §707.

The applicant is a corporation organized under the laws of Liechtenstein.

/G. Fosdick/

Geoffrey Fosdick

Trademark Attorney

Law Office 111

(540) 851-0865

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	:	
Opposer,	:	
v.	:	Opposition No. 91167758
LODESTAR ANSTALT,	:	
Applicant.	:	

EXHIBIT L TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Oct 12, 2005

NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:
79/000,112

2. Mark:
WILD GEESE RARE IRISH WHISKEY
Standard Character Mark

3. International Class(es):
33

4. Publication Date:
Nov 1, 2005

5. Applicant:
Lodestar Anstalt

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: 202-512-1800

By direction of the Commissioner.

Correspondence Address:

D BRUCE PROUT
CHRISTIE PARKER & HALE LLP
PO BOX 7068
PASADENA CA 91109-7068

TMP&I

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT M TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on November 18, 2005.

Diane L. Goss

Mark	: WILD GEESE RARE IRISH WHISKEY
Serial No.	: 79/000,112
Filed	: November 19, 2003
Applicant	: Lodestar Anstalt
Law Office	: 111
Examiner	: Geoffrey Fosdick
Docket No.	: 52995/DBP/S307

WITHDRAW OF PUBLICATION AND REQUEST FOR SUSPENSION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Post Office Box 7068
Pasadena, CA 91109-7068
November 18, 2005

Commissioner:

We have now received the enclosed Notice of Publication noting that the above-identified trademark application published on November 1, 2005.

On August 1, 2005 a response to the June 15, 2005 Office action was filed requesting the withdrawal of the Office action, and further suspension of trademark application 79/000,112, pending the outcome of oppositions.

Withdrawal of the November 1, 2005 publication is requested and further suspension of the subject application is requested.

Respectfully submitted,
CHRISTIE, PARKER & HALE, LLP

By D. Bruce Prout
D. Bruce Prout
626/795-9900

DBP/dg
DLG PAS653201.1-*-11/15/05 3:16 PM

11-22-2005
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #26

UNITED STATES PATENT AND TRADEMARK OFFICE

(1) DBP (2) GJN

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

RECEIVED
OCT 21 2005
Christie, Parker & Hale, LLP

Oct 12, 2005

NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:
   79/000,112

2. Mark:
   WILD GEESE RARE IRISH WHISKEY
   Standard Character Mark

3. International Class(es):
   33

4. Publication Date:
   Nov 1, 2005

5. Applicant:
   Lodestar Anstalt

CASE # 52995 ACTION Fil: Reg Cert.
REMINDER 5/1/06 DUE DATE
DEADLINE

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: 202-512-1800

By direction of the Commissioner.

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT N TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

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

In the Matter of Application Serial No. 79/000,112

Published in the *Official Gazette* on November 1, 2005

For the Mark: WILD GEESE RARE IRISH WHISKEY

AUSTIN, NICHOLS & CO., INC. dba PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No.:
LODESTAR ANSTALT,	
Applicant.	

NOTICE OF OPPOSITION

Opposer Austin, Nichols & Co., Inc., dba Pernod Ricard U.S.A. (hereinafter "Opposer"), a corporation organized and existing under the laws of the State of Delaware and located at 777 Westchester Ave., White Plains, NY 10604, believes that it will be damaged by the registration of the mark WILD GEESE RARE IRISH WHISKEY, Application Serial No. 79/000,112, filed on November 19, 2003 by Lodestar Anstalt, Lova-Center, P.O. Box 1150 FL-9490 Vaduz, Liechtenstein (hereinafter "Applicant"), published for opposition in the *Official Gazette* on November 1, 2005, and hereby opposes the same.

The grounds for opposition are as follows:

1. Since 1942, Opposer has manufactured, distributed, and sold in commerce in the United States various alcoholic beverage products bearing the trademark WILD TURKEY. Opposer owns the following U.S. trademark registrations for this mark:

Mark:	WILD TURKEY
Registration No.	2,263,231
Class/Goods:	33/Whiskey
Mark:	WILD TURKEY Stylized
Registration No.	513,549
Class/Goods:	33/Whiskey
Mark:	WILD TURKEY FREEDOM
Registration No.	2,882,234
Class/Goods:	33/Alcoholic beverages, namely, whiskey
Mark:	WILD TURKEY BOURBON
Registration No.	3,006,403
Class/Goods:	33/Potable Distilled Spirits
Mark:	WILD TURKEY KENTUCKY COOLERS
Registration No.	1,912,713
Class/Goods:	33/Alcoholic Beverages, namely bourbon combined with a non-alcoholic mixer
Mark:	WILD TURKEY KENTUCKY LEGEND BEYOND DUPLICATION & Design
Registration No.	1,670,450
Class/Goods:	33/Distilled alcoholic beverages, namely whiskey
Mark:	WILD TURKEY BOURBON 101
Application Ser. No.	78/233,721
Class/Goods:	33/Potable Distilled Spirits

These marks are hereinafter referred to collectively as the "WILD TURKEY Marks." A certified copy of each registration will be filed during Opposer's testimony period.

2. Since introducing its alcoholic beverage products, Opposer has sold millions of cases of products bearing the WILD TURKEY Marks throughout the United States.

3. Since introducing its alcoholic beverage products, Opposer has expended millions of dollars on advertising and sales promotion for products bearing the WILD TURKEY Marks throughout the United States.

4. As a result of Opposer's extensive sales and expenditures for advertising and promotion of its alcoholic beverage products, Opposer's WILD TURKEY Marks are famous marks and have come to signify products originating with Opposer and to symbolize goodwill of incalculable value. Alcoholic beverages bearing Opposer's WILD TURKEY Marks have become well-known leading brands of alcoholic beverages in the United States.

5. Applicant's application was filed on November 19, 2003 based upon Section 66(a) of the Lanham Act.

6. On November 1, 2005, Applicant's WILD GEESE RARE IRISH WHISKEY mark for "whiskey of Irish origin" in International Class 33 (hereinafter "Applicant's Mark"), was published for opposition in the *Official Gazette*. Applicant was required to disclaim the exclusive right to use the words "Rare Irish Whiskey" apart from Applicant's Mark.

7. Applicant's Mark is confusingly similar to Opposer's WILD TURKEY Marks in that both Applicant and/or Opposer sell alcoholic beverages under the marks and both marks use the word "wild" in connection with the name of a game bird.

8. The goods for which Applicant seeks to register the Applicant's Mark are identical and/or closely related to the goods for which Opposer has registered its WILD TURKEY Marks.

9. Upon information and belief, Applicant's goods are or will be marketed through the same channels of trade and to the same class of consumers as the goods of Opposer.

10. Prospective purchasers of Applicant's goods are likely to erroneously believe that such goods are produced by or under the authority of Opposer, or to erroneously assume that there is some other trade connection between Opposer and Applicant.

11. Applicant's Mark so resembles Opposer's WILD TURKEY Marks that, when used on or in conjunction with the goods of Applicant:

(a) It is likely to cause confusion, or to cause mistake, or to deceive;

(b) It falsely suggests a connection with Opposer;

(c) It tends to damage Opposer's goodwill in the WILD TURKEY marks; and

(d) It is likely to dilute the distinctive qualities of Opposer's WILD TURKEY marks.

WHEREFORE, Opposer prays that its Opposition to the registration of Application Serial No. 79/000,112 be sustained.

The Commissioner is authorized to charge $600 for the Notice of Opposition and any additional fee which may be required the undersigned's Deposit Account No. 502793.

Please recognize Louis S. Ederer, Steven R. Schoenfeld, John Maltbie, Alan Veronick, Dorothy C. Alevizatos, Sophie B. Anger, and Alisa Cahan who are members of the Bar of the State of New York and the firm of TORYS, LLP, located at 237 Park Avenue, New York, New York 10017, as attorneys for Opposer.

Respectfully submitted,
TORYS, LLP
Attorneys for Opposer

By: Louis S. Ederer

Louis S. Ederer
237 Park Avenue
New York, New York 10017
Tel.: (212) 880-6000
Fax: (212) 682-0200

Dated: November 28, 2005

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT O TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Oral Hearing: July 7, 2005 Mailed: January 17, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Austin, Nichols & Co, Inc.
v.
Stichting Lodestar

Opposition No. 91155165
to application Serial No. 76074330
filed on June 20, 2000

Louis S. Ederer of Torys LLP for Austin, Nichols & Co., Inc.

Gary J. Nelson of Christie, Parker & Hale, LLP for Stichting Lodestar

---

Before Hairston, Holtzman and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Stichting Lodestar (a Netherlands company), seeks registration of the mark WILD GEESE (in standard character form) for goods identified in the application as "beers, mineral and aerated waters; cola; soft drinks, namely, pop; lemonade; carbonated soft drinks; low calorie soft drinks; non-carbonated soft drinks; fruit drinks and fruit juices; syrups and preparations for making beers,

mineral and aerated waters, cola, carbonated drinks, soft drinks, lemonade, carbonated soft drinks, low calorie soft drinks, non-carbonated soft drinks, fruit drinks and fruit juices" in International Class 32; and "alcoholic beverages, namely, wine, rum, gin, vodka, whiskey, alcoholic bitters, brandy, hard cider, distilled spirits, distilled liquor, alcoholic aperitif bitters, aperitif wines; aperitifs with a distilled alcoholic liquor base; aperitifs with a wine base; sake and prepared alcoholic cocktails" in International Class 33.[1]

Opposer, Austin, Nichols & Co., Inc., opposed registration of applicant's mark, on the grounds that, as applied to applicant's goods, the mark so resembles opposer's previously used, registered and famous WILD TURKEY marks[2] for various alcoholic beverages as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. §1052(d).[3]

---

[1] Serial No. 76074330, filed June 6, 2000. The application is based on a foreign application under Trademark Act Section 44(d), 15 U.S.C. §1126. The bona fide intent-to-use basis under Trademark Act Section 1(b), 15 U.S.C. §1051(b), was deleted during prosecution.

[2] Opposer pleaded six registrations which are discussed infra.

[3] The notice of opposition also references a claim of false suggestion of a connection under Section 2(a) of the Trademark Act and dilution under Section 43(c) of the Trademark Act; however these claims were not sufficiently pleaded and opposer did not pursue these claims in its brief or at oral hearing. In view thereof, the Board considers the false suggestion and dilution claims to have been waived.

Applicant filed an answer by which it denied the salient allegations of the notice of opposition.

As a preliminary matter, we address two outstanding motions filed after the briefing phase of this proceeding: opposer's motion (filed April 14, 2005) to accept opposer's late responses to applicant's requests for admissions; and opposer's motion (filed May 27, 2005) to reopen the record to introduce newly discovered evidence.

We construe opposer's motion to accept its responses to the requests for admissions as a motion to withdraw admissions under Fed. R. Civ. 36(b). Applicant served 25 requests for admissions on May 20, 2003. By its late responses, which were not served by opposer until October 24, 2003, opposer effectively admitted all of the requests including the following:

> No. 14. Admit that none of the WILD TURKEY-based marks are used in association with whiskey.
>
> No. 18. Admit that none of the WILD TURKEY-based marks are used in association with distilled spirits.
>
> No. 19. Admit that none of the WILD TURKEY-based marks are used in association with distilled liquor.
>
> No. 25. Admit that none of the WILD TURKEY-based marks are used in association with prepared alcoholic cocktails.

Opposer states that it was not aware of the requests, served on May 20, 2003, until August 27, 2003 when, during a conversation with applicant, applicant indicated it had not

received responses to the requests. Opposer states that upon further review of the case file, opposer discovered the requests stapled to the back of the interrogatories, and that on September 16, 2003, applicant wrote a letter concerning the requests for admissions. In this letter, applicant states that it "has been nearly one month since [applicant's counsel] had a telephone conference with one of [opposer's attorneys] regarding the above-identified WILD GEESE trademark opposition. During that telephone conference, I was informed that [opposer] would be promptly responding to Stichting Lodestar's First Request For Admissions, originally served on [opposer] on May 20, 2003. Please advise when we can expect to receive the responses." Opposer served its responses on October 24, 2003 concurrently with its responses to applicant's second set of interrogatories and requests for production of documents, due on that date.

In arguing against opposer's motion, applicant contends that opposer has not shown that its failure to serve timely responses was the result of excusable neglect, and that allowing withdrawal of the admissions at the conclusion of the trial would be prejudicial to applicant. In short, applicant would have the Board dispense with this case inasmuch as it has been admitted, by operation of the rules, that whiskey is not sold under the mark WILD TURKEY.

Fed. R. Civ. P. 36(b) provides that admissions may be withdrawn upon motion if "the merits of the action will be subserved thereby and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits."

Cleary, the presentation of the merits will be subserved by accepting the withdrawal of the four admissions. Moreover, applicant did not show that withdrawal of these four admissions will, in fact, prejudice it in presenting its defense on the merits. Applicant engaged in discovery on these very points, (see e.g., interrogatory no. 4 "Identify with particularity each product or service Opposer has sold or intends to sell under each of the WILD TURKEY-based marks,") presented evidence during trial, and argued its case on the merits. Moreover, it is difficult to imagine how applicant could reasonably rely on an admission under these circumstances where opposer has several pleaded registrations for the mark WILD TURKEY for use with whiskey. Applicant did not seek to cancel these registrations by way of compulsory counterclaims, and opposer has submitted status and title copies of these registrations. Thus, opposer may rely on the presumptions accorded to these registrations, namely that it uses WILD TURKEY in connection with whiskey. In view thereof,

opposer's motion to withdraw its admissions is granted and the denials to Request for Admissions Nos. 14, 18, 19 and 25 are accepted.

By its motion to reopen the record, opposer seeks to introduce the decision from a court in New Zealand in a case involving these parties. Opposer argues that this decision serves as rebuttal evidence to applicant's arguments and evidence regarding trademark disputes between these parties involving their respective marks in other foreign jurisdictions, including Thailand. Inasmuch as applicant's arguments and evidence regarding foreign uses and trademark disputes are irrelevant to this proceeding, the rebuttal evidence is similarly irrelevant. Whether or not consumers in Thailand may or may not likely be confused under Thai trademark law is wholly irrelevant to whether or not there is a likelihood of confusion in the United States. Foreign use is ineffective to establish trademark rights in the United States and is thus irrelevant to a determination of likelihood of confusion here. See, Person's Co., Ltd. V. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) (foreign use has no effect on U.S. commerce and cannot form the basis for a holding that appellant has priority here; the concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme); Fruit of the Loom Inc. v.

Fruit of the Earth Inc., 3 USPQ2d 1531, 1534 (TTAB 1987); and Lever Brothers Co. v Shaklee Corp., 214 USPQ 654, 657 (TTAB 1982). Cf. In re Bel Paese Sales Co., 1 USPQ2d 1233, 1235 (TTAB 1986) (foreign use is essentially of no probative value absent other evidence showing that the foreign use had a material or significant impact on perception of the term by the relevant purchasing public *in the United States*); and In re Men's International Professional Tennis Council, 1 USPQ2d 1917 (TTAB 1986). In view thereof, opposer's motion to reopen the record is denied.

Further, applicant has pointed out that opposer's main brief on the case was filed two days late on February 18, 2005. Trademark Rule 2.128(a)(1) states: "The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony." Notwithstanding that the rebuttal testimony period in this case closed on a Saturday (December 18, 2004), opposer's brief was due 60 days thereafter on February 16, 2004. Barring the granting of an extension of time by the Board, the plaintiff's main brief is due 60 days from the *actual* date on which the period for rebuttal testimony closes, regardless of whether that date falls on a weekend or a Federal Holiday. Opposer, in its mistaken belief that its brief was timely filed, misconstrues the

effect of Trademark Rule 2.196 on the dates in question.[4] Trademark Rule 2.196 extends the time period to take some action when that time period ends on a weekend or Federal Holiday; it does not then also automatically extend the date of subsequent dependent time periods unless those dates also end on a weekend or Federal Holiday. However, we note that this matter was raised merely as an informational statement in applicant's brief; that opposer's explanation as to its mistaken interpretation of the rules clearly demonstrates that the delay was not willful; that the two-day delay in filing opposer's brief was minimal and has had no impact on the proceedings; and that applicant has indicated no prejudice as a result of the delay. Under the circumstances, and because it benefits the Board in its ability to make a just determination of the case to have the briefs of both parties of record, opposer's brief is accepted.

Finally, before we turn to the merits of this proceeding, we address those of applicant's objections to exhibits introduced during testimony that were maintained in

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[4] Opposer states that it "confirmed its analysis, and the February 18, 2005 filing deadline, by telephone with the Board." Opposer's Reply Br. p. 18. Opposer is advised that parties may not rely on information obtained by telephone. Trademark Rule 2.191 provides in pertinent part: "The action of the Office will be based exclusively on the written record. No attention will be paid to any alleged oral promise, stipulations, or understanding in relation to which there is disagreement or doubt." See In re Merck & Co., 24 USPQ2d 1317, 1318 n. 2 (Comm'r 1992).

applicant's brief. Applicant objects to opposer's exhibits nos. 11, 14, 43, 48, 49 and 50. Applicant argues that these exhibits "should be excluded because they were not produced in a timely manner." Applicant's Br. p. 16. Applicant did not indicate in its brief whether or not it had requested these documents during discovery, nor did applicant include a copy of any request for production of documents. Applicant did, however, submit under notice of reliance, opposer's responses to applicant's first set of interrogatories, and opposer, in response to some of the objections, states that it produced related documents; therefore, where possible, we will address these objections on the merits.

Opposer, in response, argues as to exhibit nos. 11, 14 and 43 that "they relate to business activities after January 2004 (and were created after the January 31, 2004 [discovery] cut-off date) and were produced to update information of the same nature that had already been produced during discovery." Opposer's Br. p. 17. With regard to exhibits 49 and 50, opposer requests that the Board take judicial notice of these exhibits, inasmuch as they are official records of the USPTO.

Applicant's objection to exhibit nos. 11 and 14 are overruled. Exhibit no. 11 is opposer's most recently prepared "block chart." This "block chart," showing the

budget plan for media spending in 2004 on a monthly basis, was prepared by opposer's media agency on August 1, 2004, one month before it was produced, and the day before opposer's testimony deposition. Exhibit no. 14 is a series of print advertisements from 2004. Applicant has not presented argument as to how it would be prejudiced by the submission of this recent, updated information, nor did applicant indicate that no documents as to media spending or print advertisements had been produced and, in fact, the record contains such undisputed documents. Thus, we find opposer's explanation that it had produced such documents and that these merely represent the most recent, updated information sufficient to overcome the objection.

Applicant's objection to exhibit no. 43 is sustained. Interrogatory no. 9 reads: "Identify each person who is or has ever been licensed or permitted by you to use any of the WILD TURKEY-based Marks, and explain how you control the nature and quality of each such use." Opposer responded: "None at the present time." Exhibit no. 43 is a licensing agreement between opposer and a third-party entered into in May, 2004. While there is nothing in the record to show that applicant requested the production of any licensing agreements, applicant's interrogatory requested essentially the same information and opposer should have supplemented its response to the interrogatory, in a more timely manner,

by providing the name of the licensee prior to September 2, 2004, and the licensing agreement in exhibit no. 43 is tied to the testimony regarding opposer's licensee.

Applicant's objection to exhibit no. 48 on the ground that it was not timely produced is overruled. This exhibit is a printout of a third-party website that was retrieved and printed out by opposer's attorney the day before opposer's testimony deposition. Applicant did not indicate if it had requested this type of information during discovery and in any event opposer was not obligated to disclose the entirety of its proposed evidence. British Seagull Ltd. V. Brunswick Corp., 28 USPQ2d 1197, 1201 (TTAB 1993, aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); and Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1657 (TTAB 2002). That being said, the witness attesting to this evidence did not have personal knowledge of the source of the printout and, therefore, was not competent to testify as to its authenticity. Thus, the document is not admissible.

Applicant's objection to exhibit no. 49 is overruled. This exhibit consists of the USPTO Trademark Electronic Search System (TESS) printouts of opposer's pleaded registrations, the status and title copies of which were also submitted under notice of reliance.

Applicant's objection to exhibit no. 50 is overruled. This exhibit consists of printouts of two of opposer's applications that were not pleaded. Applicant has not shown the Board that it requested information or documents pertaining to these marks.[5]

The evidence of record consists of the pleadings herein; the file of the opposed application; the testimony depositions (with exhibits, excluding exhibits nos. 43 and 48) of Mr. Joseph Uranga, Group Director for Wild Turkey Bourbon with Pernod Ricard USA, and Mr. John Conway, in house intellectual property counsel with Pernod Ricard USA.[6] In addition, opposer submitted, under a notice of reliance, status and title copies of five of opposer's pleaded registrations, and testified as to their ownership and validity.[7] Applicant submitted, by stipulation of the parties, the declaration (with exhibits) of Deanna D. Crowe, a paralegal with applicant's outside counsel, Christie, Parker & Hale, LLP. In addition, applicant submitted, under a notice of reliance, TESS printouts of third-party registrations, foreign registrations for the parties'

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[5] We note that applicant did not object on the basis that the applications were not pleaded.

[6] Pernot Ricard USA is a related company to opposer and handles opposer's sales, marketing and intellectual property matters. (Uranga Dep. p. 7; Conway Dep. pp. 5-9).

[7] Opposer did not make of record pleaded registration no. 1912713.

respective trademarks, and opposer's responses to applicant's interrogatories.

The pleaded registrations, all of which are in full force and effect and owned by opposer, are summarized as follows:

Registration No. 513549 for the mark

WILD TURKEY

for whiskey in International Class 33, filed January 30, 1946, issued August 16, 1949, section 8 accepted, section 15 acknowledged, renewed;

Registration No. 1085002 for the mark WILD TURKEY (in standard character form) for liqueur in International Class 33, filed November 22, 1976, issued February 7, 1978, section 8 accepted, section 15 acknowledged, renewed;

Registration No. 1299830 for the mark

(WILD TURKEY ONE-O-ONE and turkey design, ONE-O-ONE disclaimed) for whiskey in International Class 33, filed October 19, 1983, issued October 19, 1984, section 8 accepted, section 15 acknowledged, renewed;

Registration No. 1670450 for the mark

(WILD TURKEY KENTUCKY LEGEND BEYOND DUPLICATION and design) for distilled alcoholic beverages; namely, whiskey in International Class 33, section 8 accepted, section 15 acknowledged, renewed;

Registration No. 2263231 for the mark WILD TURKEY (in standard character form) for whiskey in International Class 33, filed August 14, 1998, issued July 20, 1999, section 8 accepted, section 15 acknowledged.

Because opposer has made its five pleaded registrations of record, opposer has established its standing to oppose registration of applicant's mark, and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d

1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Another key factor, is the fame of the prior mark. We begin with this factor, because fame "plays a 'dominant' role in the process of balancing the du Pont factors." Recot Inc. v. Benton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). See also, Palm Bay Imports, Inc. v. Veuve Clicquot, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005). In addition, fame "varies along a spectrum from very strong to very weak." In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003).

Opposer's testimony and evidence establish that opposer started selling its whiskey under the WILD TURKEY trademark in 1942; that sales of WILD TURKEY products in the United States in 2002 and 2003 were approximately $65 million and 500,000 cases in total annual sales; that the WILD TURKEY trademarks have been federally registered since 1949; that opposer owns registrations for WILD TURKEY marks in connection with various merchandise, including umbrellas, duffel bags, clothing, watches, pens and pencils, golf accessories, key chains, and barbecue sauce; that opposer spends tens of millions of dollars annually on advertising and promotion in the United States, $11.7 million in 2003, through print ads in national magazines and trade

publications, billboard advertising, local radio advertising, and internet advertising; that opposer has a "comprehensive brand strategy program" that educates employees, distributors and retailers about the history of WILD TURKEY, brand identity, and the objectives and strategy for promoting and selling the brand that includes a "field guide" and the "ambassador's training program"; that WILD TURKEY is used on consumer point-of-sale materials given or displayed to consumers at liquor stores, bars and restaurants and include baseball hats, golf shirts, golf bags, watches, scratch card games, cufflinks, flashlights, computer mouse pads, ceramic collectibles, promotional cookbooks with WILD TURKEY recipes; that opposer also promotes its WILD TURKEY whiskey through high profile national sponsorships such as the Professional Bowler's Association and the National Turkey Federation and numerous local sponsorships such as a crawfish festival in Biloxi, Mississippi and a rodeo in Houston, Texas; and that the WILD TURKEY brand receives extensive unsolicited media coverage including reviews by wine and spirit writers, numerous awards such as Gold and Silver places in the International Wine & Spirit Competition and San Francisco World Spirits Competition in 2000 and 2001, frequent mentions in a variety of magazines, newspapers, and television shows (see, e.g., Uranga Dep. p. 78 "The biggest one was when David Letterman

had [the turkey callers] on... . [T]he bottle spent about 20 minutes on his desk as he talked about the callers..."). In addition, the record shows that opposer, as part of the Pernod Ricard Group, jointly promotes its WILD TURKEY whiskey with other Pernod Ricard Group brands (e.g., Bushmill's Irish whiskey), and opposer has expanded its WILD TURKEY whiskey product to include other premium bourbon and non-bourbon whiskeys and other spirit products.

Applicant presented no evidence or argument to rebut opposer's evidence of fame.

As shown through the testimony and other evidence, opposer has extensive sales under and advertising expenditures in connection with the WILD TURKEY marks. Moreover, opposer's advertising and sales statistics are placed in the context of a broad, organized and aggressive marketing strategy that places its WILD TURKEY marks in front of consumers in a variety of ways (e.g., point-of sales displays, promotional events, sponsorships, merchandising, radio advertising, national magazines with wide circulation, billboards, etc.). The WILD TURKEY marks have been used for over sixty years and are displayed prominently on the product labels. WILD TURKEY whiskey has been extensively promoted and heavily advertised in a variety of media. There has also been promotion through targeted outdoor billboard displays, extensive point-of-sale

displays, and wide distribution of collateral merchandise. On this record, we find that opposer's WILD TURKEY marks are famous and entitled to broad protection. Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) ("[T]he fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.").

We turn next to the second, third and fourth du Pont factors, i.e., the similarities between opposer's and applicant's goods and the similarities between opposer's and applicant's trade channels and classes of purchasers of these goods. We must make our determinations under these factors based on the goods as they are recited in the application and registrations, respectively. See In re Elbaum, 211 USPQ 639 (TTAB 1981).

The goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. In re Martin's

Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Opposer's registrations are for whiskey and liqueur. Whiskey, as identified in applicant's application, is identical to whiskey, as identified in opposer's Registration Nos. 513549, 1299830, 1670450 and 2263231, and closely related to opposer's liqueur as identified in opposer's Registration No. 1085002. In addition, beer in International Class 32 and the other alcoholic beverages in International Class 33 as identified in applicant's application are closely related to opposer's whiskey and liqueur. The record shows that consumers of alcoholic beverages are accustomed to seeing brands on new products, including the crossover from distilled spirits to malt beverages. Conway Rebuttal Dep. p. 12. Applicant has presented no argument that its beer and other alcoholic beverages are unrelated to opposer's goods and, moreover, has acknowledged that various alcoholic beverages, including beer, are related. (Applicant's Br. p. 34 "[A]lcoholic beverages such as wine and beer, and the various types of 'hard liquors' such as whiskey, have been consistently recognized as related goods for trademark purposes.").[8]

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[8] See also, for example, In re Chatam International Inc., 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (beer and tequila closely related; Jose Gaspar Gold v. Gaspar's Ale); In re Majestic, supra (brewed malt liquor and distilled tequila similar "by virtue of the fact that both are alcoholic beverages that are

Given the absence of any restrictions or limitations in the parties' respective identifications of goods, the parties' identical and closely related alcoholic beverage products are deemed to be marketed in the same trade channels and to the same classes of purchasers. Kangol Ltd. V. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). In addition, the record establishes that sales of alcoholic beverages in the United States are regulated by the Alcohol, Tobacco and Trade Bureau which imposes a three-tier system of distribution whereby suppliers (such as opposer) sell to distributors who, in turn, sell to retailers and the end-consumers purchase the products from the retailers. Thus, the parties' alcoholic beverages, in fact, travel through the same channels of trade.

The parties' respective goods are ordinary consumer items which would be purchased without a great deal of care,

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marketed in many of the same channels of trade to many of the same consumers"); The Fleischmann Distilling Corporation et al. v. Maier Brewing Co. et al., 314 F.2d 149, 160, 136 USPQ 508, 518 (9th Cir. 1963) (beer and whiskey "being both within the alcoholic beverage industry, are 'so related as to fall within the mischief which equity should prevent.'"); White Horse Distillers, Ltd. V. Ebling Brewing Co., Inc., 30 USPQ 238 (CCPA 1936) (scotch whiskey and ale are "goods of the same descriptive properties within the meaning of the statute"); Somerset Distilling Inc. v. Speymalt Whiskey Distributors Ltd., 14 USPQ2d 1539, 1542 (TTAB 1989) ("scotch whiskey, gin and vodka are all closely related, in that they are what might be characterized as basic alcoholic beverages"); and In re AGE Bodegas Unidas, S.A., 192 USPQ 326 (TTAB 1976) ("there is clearly a relationship between wine and whiskey, both of which alcoholic beverages are sold through the same specialized retail outlets to the same purchasers, and are frequently bought at the same time").

by ordinary consumers. (Conway Dep. p. 31 lines 21-22 ("Our consumers are not sophisticated") and Conway Rebuttal Dep. p. 9 ("...we are an impulse item"). See also, e.g., In re Majestic, supra at 1205. Applicant points to opposer's testimony regarding brand loyalty and argues that brand conscious consumers would distinguish between the marks; however, there is no evidence that ordinary consumers of alcoholic beverages are always brand conscious. These findings under the second, third and fourth du Pont factors all weigh significantly in opposer's favor in our likelihood of confusion analysis.

We turn next to the first du Pont factor, i.e., whether applicant's mark and opposer's mark are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under this du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Sealed Air Corp. v. Scott Paper Co., 190

USPQ 106 (TTAB 1975). Furthermore, if a mark comprises both a word and a design, greater weight is often accorded to the word, which would be used by purchasers in requesting the goods or services. In re Appetito Provisions Co., Inc., 3 USPQ2d 1553, 1554 (TTAB 1987).

Applicant's mark, WILD GEESE, is depicted in standard character form. Two of opposer's WILD TURKEY marks are in standard character form and the other three are stylized, two of which include design elements and additional wording. The literal portions of the parties' marks begin with the identical word, WILD. The similarity of the marks continues with the second word in each mark being a game bird. Despite the difference in the words TURKEY and GEESE, the commercial impression and general connotation of wild game birds, creates a confusingly similar mark. Given the fame and arbitrary nature of opposer's WILD TURKEY marks, and the broad scope of protection to which they are entitled, we find that the similarities in the parties' marks outweigh their differences.

Similarity of connotation or commercial impression alone is sufficient to support a finding of likelihood of confusion between marks; and this is true even if the marks exhibit aural and optical dissimilarity when they convey the same general idea or stimulate the same mental reaction. H. Sichel Sohne, GmbH v. Michel Monzain Selected Wines, Inc.,

202 USPQ 62, 65 (TTAB 1979) (hereinafter Sohne I); and H. Sichel Sohne, GmbH v. John Gross & Co., 204 USPQ 257 (TTAB 1979) (hereinafter Sohne II) (BLUE NUN and BLUE CHAPEL bring to mind a similar religious connotation). This is true especially where, as in this case, the marks are arbitrary. United Rum Merchants Ltd. v. Fregal, Inc., 216 USPQ 217, 219 (TTAB 1982).

In arguing that the marks are dissimilar, applicant dissects registrant's marks and concludes that the common term WILD is weak, in view of the numerous third-party registrations and uses of the word WILD in connection with various alcoholic and non-alcoholic beverages, and that the word TURKEY is the dominant portion of registrant's mark, which is different from the word GEESE in applicant's mark. Applicant further argues that the word TURKEY should be accorded narrow protection in view of the numerous registrations and uses of bird names in connection with various alcoholic and non-alcoholic beverages.

First, with regard to the evidence pertaining to the word WILD, the third-party registrations are not evidence of use and, thus, are of little probative value in an analysis of the strength of the marks. Third-party registrations may be "useful to demonstrate the sense in which a term is used in ordinary parlance and they can show that a particular term has been adopted by those engaged in a certain field or

industry and that said term has less than arbitrary significance with respect to certain goods or services." In re Dayco Products-Eaglemotive, Inc., 9 USPQ2d 1910, 1912, (TTAB 1988) (IMPERIAL adopted by others in the vehicular field to refer to that term's ordinary significance as a laudatory designation). However, the third-party registrations submitted by applicant show a variety of meanings of the term WILD (e.g., WILD PIG, DR. WILD, WILDCATTER'S CRUDE, WILD RIVER, WILD CARD and SCREAMING WILD BERRY) and do not lead to a conclusion that the term has an "ordinary significance" in the field of beverages. The examples of use also suffer from the same deficiency (e.g., THE WILD BUNCH, WILD THING, WILD PASSION and WILDCAT). Moreover applicant's argument does not rebut the facts of this case where the word WILD has a specific significance as used with TURKEY or GEESE in that it distinguishes the birds from their domesticated relatives.

The third-party registrations and examples of use of bird names for various beverages have even less probative value under the Dayco analysis inasmuch as they present a variety of names, do not point to ordinary usage of a particular term, and do not show that the words in issue here, TURKEY and GEESE are so widely used that consumers are able "to discern between several competing products having similar, but not identical, product names and bird images."

Applicant's Br. p. 33. See Sohne I, supra at 66 ("We must remember that the conflict herein is between "BLUE ANGEL" and "BLUE NUN," and the fact that others have used and/or registered marks containing a certain feature in common with these marks for similar goods cannot preclude a holding that these marks as a whole are confusingly similar.")

Applicant, in its analysis, improperly dissects the marks and does not consider the marks in their entireties. We note that despite applicant's search of USPTO records and the marketplace, applicant failed to find any example of WILD plus a game bird in use in the United States for any of the identified goods.[9] See Crowe Decl. and Applicant's Notice of Reliance; see also Uranga Dep. p. 39 and Conway Dep. p. 22. This may in fact be a result of opposer's policing efforts. See Conway Dep. p. 22 ("But the closer it gets to a bird the more serious we take it. And if it's a game bird in particular that is one of our absolute red flags for enforcement.")[10]

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[9] With regard to the two examples of WILD with a bird allegedly used in connection with wine that appear in printouts of website pages introduced under the Crowe declaration, opposer's undisputed evidence shows that neither of those products are being sold in the United States, and that one is in the process of being acquired by opposer. Conway Rebuttal Dep. pp. 59-60, 67-73.

[10] Applicant's arguments regarding opposer's "aggressive enforcement program" have no relevance to the question of whether applicant's mark used in connection with the goods recited in its application would be likely to cause confusion with the marks in opposer's registrations.

As stated earlier, marks must be considered in their entireties, and the commercial impression is derived from the marks as a whole, and not from their elements separated and considered in detail. Sohne I, supra at 65. We find that the WILD TURKEY portion of opposer's registered marks is unitary and that TURKEY cannot be viewed as a separable element of the marks. The handful of examples of use in the record of TURKEY as a "nickname" for the brand are not sufficient to diminish the unity of the WILD TURKEY marks in issue here. However, even if TURKEY is the dominant part of the mark, it does not change our conclusion that taken in their entireties and given the strength and fame of opposer's WILD TURKEY marks, confusion is likely. We consider the similarity of these marks where the word WILD is followed by the name of a game bird to be significant. We find, on balance, that the similarities in connotation and commercial impression of the respective marks which are enhanced by the identical first word, WILD, followed by the name of a game bird outweigh the dissimilarities which result from the sound and appearance of the second word. Further, the stylization in Registration No. 513549, the stylization, bird design and disclaimed wording ONE O ONE in Registration No. 1299830, and the added tag line KENTUCKY LEGEND BEYOND DUPLICATION and frame design in Registration No. 1670450 do not serve to adequately distinguish these

marks. The term WILD TURKEY is the dominant element in each of these marks and the bird design further enhances the mental impression and connotation of a game bird. We conclude that the parties' marks are substantially similar.

We do not find applicant's attempt to distinguish the United Rum and Sohne cases persuasive. In particular, with regard to the Sohne cases, the Board emphasized that it considered the marks BLUE NUN on the one hand, and BLUE ANGEL and BLUE CHAPEL on the other, in their entireties and rejected the applicant's similar attempt to minimize the importance of the identical element BLUE.

Considering the respective marks in their entireties, we conclude that the evidence of record as it pertains to the relevant du Pont factors clearly supports a finding of likelihood of confusion as to the marks in opposer's Registration Nos. 513549, 1085002, 1299830, 1670450, and 2263231 and that registration of applicant's mark, therefore, is barred under Trademark Act Section 2(d).

Finally, to the extent there is any doubt with regard to the question of likelihood of confusion, such doubt must be resolved in favor of opposer, the prior registrant. Hewlett-Packard Co. v. Packard Press, inc., 281 USPQ2d 1001, 1003 (Fed. Cir. 2002) ("This court resolves doubts about the likelihood of confusion against the newcomer because the newcomer has the opportunity and obligation to avoid

confusion with existing marks"); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Decision: The opposition is sustained.

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT P TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

TTAB

TRADEMARK
Docket No. 110.2*6/S307

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

Austin, Nichols & Co., Incorporated Opposer, v. Stichting Lodestar Applicant.	Opposition No. 91155165 NOTICE OF APPEAL

Notice is hereby given that applicant Stichting Lodestar in the above-named case hereby appeals to the United States Court of Appeals for the Federal Circuit from the decision entered in this case on January 17, 2006 sustaining the opposition to Applicant's application for registration.

A copy of the decision is attached hereto as Attachment A.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Dated: March 14, 2006

By _____
Edward R. Schwartz
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ERS/blv

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03-15-2006
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #72

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

Mark: WILD GEESE RARE IRISH WHISKEY
Serial No. 79/000,112
Filed: November 19, 2003
Published: November 1, 2005

AUSTIN NICHOLS & CO., INC. d/b/a PERNOD RICARD U.S.A.,	
Opposer,	
v.	Opposition No. 91167758
LODESTAR ANSTALT,	
Applicant.	

EXHIBIT Q TO THE OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS

TRADEMARK
Docket No. S307:110.2*8

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

Austin Nichols & Co., Inc. dba Pernod Ricard, U.S.A. Opposer, v. Lodestar Anstalt Applicant.	Opposition No. 91167758 Mark: WILD GEESE RARE IRISH WHISKEY Ser. No.: 79/000,112 Date Filed: November 19, 2003

MOTION TO SUSPEND OPPOSITION PROCEEDINGS

Applicant Lodestar Anstalt ("Lodestar") moves to suspend the above captioned opposition proceeding pending disposition of a related proceeding, Opposition No. 91155165, now on appeal before the United States Court of Appeals for the Federal Circuit. The appeal was filed by Stichting Lodestar, a related company to Lodestar Anstalt, and seeks the over turn of the decision issued by the United States Trademark Trial and Appeal Board regarding the mark WILD GEESE.

The Opposer in the related Opposition Proceeding is identical to the Opposer in this action. As noted above, the Applicant in the related Opposition Proceeding is related to the Applicant in this action. Likewise, the related Opposition Proceeding involves the same dispute (i.e., the right to register the mark WILD GEESE in light of Opposer's WILD TURKEY trademark).

Under 37 C.F.R. § 2.117(a), the Board has the power to suspend the proceeding when a party or parties to a pending case are engaged in another Board proceeding that may have a bearing on the proceeding. In such instances, the Board will ordinarily "...suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board." Trademark, Trial and Appeal Board ("TBMP") §510.02(a). *See General Motors Corporation v. Cadillac Club Fashions, Inc.*, 22 U.S.P.Q.2d 1933, 1937 (TTAB 1992).

Moreover, suspension of this pending opposition proceeding will promote judicial economy and the conservation of the Board's resources.

Accordingly, it is respectfully requested that all further proceedings in Opposition No. 91167758, be suspended pending disposition of the appeal of Opposition No. 91155165

A copy of the Notice of Appeal filed with the TTAB and Petition for Review filed with the United States Court of Appeals for the Federal Circuit have been enclosed with this Motion to Suspend.

DATED: March 30, 2006

Respectfully submitted by,

CHRISTIE, PARKER & HALE, LLP

By: Gary J. Nelson
Gary J. Nelson

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Attorneys for Opposer

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CERTIFICATE OF SERVICE

I certify that on April 25, 2006, the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS** is being electronically filed with the followiing:

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

It is further certified that on April 25, 2006, the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO SUSPEND THE OPPOSITION PROCEEDINGS** is being served by mailing a copy thereof by first class mail addressed to:

Gary J. Nelson, Esq.
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