

ESTTA Tracking number: **ESTTA302536**

Filing date: **08/24/2009**

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

**Notice of Opposition**

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

**Opposer Information**

Name	Chivas Holdings (IP) Limited
Granted to Date of previous extension	08/26/2009
Address	111-113 Renfrew Road Paisley, Renfrewshire, PA3 4DY UNITED KINGDOM
Attorney information	Jay A. Bondell Ladas & Parry LLP 26 West 61st Street New York, NY 10023 UNITED STATES jbondell@ladas.com, mcornman@ladas.com, elipins@ladas.com, gdeluca@ladas.com Phone:212 708-1800

**Applicant Information**

Application No	77647485	Publication date	04/28/2009
Opposition Filing Date	08/24/2009	Opposition Period Ends	08/26/2009
Applicant	Chivas USA Enterprises LLC Suite 500 18400 Avalon Boulevard Carson, CA 90746 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 035. All goods and services in the class are opposed, namely: Retail store, on-line store, online retail store ordering, online catalog and mail order catalog services all featuring audio recordings, video recordings, computer accessories, computer games, computer software, computer databases, video games, telephones, binoculars, eyewear, magnets, collectible and novelty items, collectible coins, medallions, albums, scrapbooks, photo frames, sports memorabilia, timepieces, jewelry, jewelry, jewelry boxes, credit cards, calling cards, publications, calendars, catalogs, organizers, directories, stationary, school supplies, giftware, gift sets, portfolios, posters, photos, trading cards, books, card holders, pamphlets, pennants, flags, banners, souvenirs, bank checks, bags, travel bags, travel cases, sports bags, lunch boxes, wallets, umbrellas, clothing, toys, games, sporting goods, Christmas ornaments, decorations, house wares, lamps, lighting fixtures, beverage ware, kitchenware, household supplies, containers, boxes, bed, bath and table linens, furniture, office furniture and accessories, lockers and footlockers</p>
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
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Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3612608	Application Date	08/22/2007
Registration Date	04/28/2009	Foreign Priority Date	07/16/2007
Word Mark	CHIVAS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Spirits measurers, namely, jiggers; measures for alcoholic beverages, namely, dispensers that count or measure output for use with alcoholic beverages; sunglasses; sunglasses cases; spectacle cases; straps for sunglasses or spectacles; mouse pads; camera cases; mobile phone cases; mobile phone straps; memory cards; carrying cases for laptops; flash drives contained in wrist bands; cases for CDs or DVDs</p> <p>Class 014. First use: Jewelry; watches; cases for jewelry; cases for watches; key rings of precious metal; cuff links; tie pins; clocks; metal money clips; cuff links; tie pins; clocks; money clips</p> <p>Class 016. First use: Desktop business card holders; cases for passports; cases for stationery; cases for writing instruments; chequebook holders; billbooks; document portfolios; pencil cases; cases for diaries; paper gift bags; pens; pencils; notebooks; notebook covers, namely, protective covers for notebooks; calendars; photograph albums; folders; postcards; posters; printed menus; drinks and cocktail mats, namely, coasters of cardboard or paper; greeting cards; bookmarkers; table cloths of paper</p> <p>Class 018. First use: Cases for sporting articles, namely, all-purpose sports bags; travel cases; overnight cases; vanity cases sold empty; carrying cases for documents; cosmetic cases sold empty; coin purses; credit card cases; business card cases; keycases; bags, namely, travel bags, make-up bags sold empty, handbags, rucksacks, saddlebags, souvenir bags; sport bags; purses; wallets; umbrellas; umbrella covers; billfolds; walking sticks; bags for sports</p> <p>Class 021. First use: Beverage glassware; sculptures, figures, figurines, and ornaments made of porcelain, earthenware, terra cotta, or china; ice buckets; cocktail stirrers; beverage stirrers; swizzle sticks; cocktail shakers; cocktail picks; mixing cups; strainers for fruits or vegetables; Non-electric juicers; non-electric citrus juicers and squeezers; holders for napkins; menu card holders; bill holders in the nature of trays; candle holders; holders for bar accessories, namely, caddies, buckets, and trays for holding bar accessories such as paper, pens, swizzle sticks, straws, stirrers, cocktail umbrellas, coasters, peelers, strainers, corkscrews, and bottle openers; fitted cases specifically adapted for drinking vessels and drinking flasks; toiletry cases, namely, toothbrush cases, toothbrush holders; fitted vanity cases; bottle openers; corkscrews; household, restaurant and kitchen goods, namely, condiment holders; serving trays; ice cube molds; bar utensil trays;</p>		

	<p>jugs; stands for bottles; trays, namely, drip-trays for bars; insulating and non-insulating bottle buckets; cooling devices for bottled beverages, namely, cooling buckets for beer and wine; brushes for hair; combs; decanter stands, namely, stands specially designed to hold decanters; hip flasks</p> <p>Class 025. First use:</p> <p>Clothing, namely, pants, shirts, shorts, tops, dresses, and jackets; footwear; headgear, namely, hats, caps, and baseball caps; scarves; slippers; socks; caps; bandanas; coats; jackets; shirts; T-shirts; polo shirts; pajamas; under garments; aprons; dresses; tracksuits; swimwear; clothing adapted for sports, namely, pants, shirts, shorts, tops, dresses, and jackets; footwear adapted for sports, athletic footwear; headgear adapted for sports, namely, hats, caps, baseball caps and sweatbands; bandanas for wearing around the neck; wrist bands</p> <p>Class 028. First use:</p> <p>Sporting articles for golf, namely, divot repair tools, covers for golf clubs, golf accessory pouches, golf bag covers, golf bag tags, golf bags, golf ball markers, golf balls, golf gloves, golf tees, golf towel clips for attachment to golf bags; sporting articles for sailing, namely, sailing gloves, sailing harnesses, and sailing harness covers; sporting articles for cycling, namely, athletic protective pads for knees and elbows; sporting articles for polo, namely, polo balls, polo mallets; cases specially adapted for sports equipment</p>
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Attachments	79051358#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition.pdf ( 7 pages )(422688 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Michael A. Cornman/
Name	Michael A. Cornman
Date	08/24/2009

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

In the matter of U.S. Trademark Application Serial No. 77/647,485

For the mark CHIVAS POP

Filing Date: January 12, 2009

-----X	)	
Chivas Holdings (IP) Limited,	)	
	)	
Opposer,	)	Opposition No.
	)	
v.	)	
	)	
Chivas USA Enterprises LLC,	)	
	)	
Applicant.	)	
-----X	)	

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 77/647,485 published in the Official Gazette of April 28, 2009, the time for Opposer to oppose having been extended through August 26, 2009, Chivas Holdings (IP) Limited (“Opposer”) believes it would be damaged by the registration of the mark CHIVAS POP in International Class 035 and hereby opposes same, alleging as follows:

1. Opposer is a corporation of the United Kingdom, located and doing business at 111-113 Renfrew Road, Paisley, Renfrewshire PA3 4D9 Scotland, U.K.

2. Upon information and believe, Chivas USA Enterprises LLC (“Applicant”) is a limited liability company organized and existing under the laws of the State of Delaware, having an office and place of business at Suite 500, 18400 Avalon Boulevard, Carson, California 90746.

3. Opposer is the owner of the world-famous mark CHIVAS and variants thereof used in connection with alcoholic beverages. The CHIVAS marks in connection with alcoholic beverages by Opposer and its predecessors in interest have been in use for more than 200 years in the United States and abroad. The CHIVAS marks are registered in the name of Opposer in the U.S. Patent and Trademark Office, including Reg. Nos. 309,456 of February 16, 1934; 325,152 of June 11, 1935; 621,894 of February 21, 1956; and 3,158,704 of February 14, 2006. All of said registrations are valid and subsisting, and the '456; '152; and '894 registrations are incontestable.

4. In addition to use and registration in connection with alcoholic beverages, Opposer is the owner of U.S. Trademark Registration No. 3,612,608 of April 28, 2009 for the mark CHIVAS for a wide range of products in International Trademark Classes 009, 014, 016, 018, 021, 025 and 028. A true copy of the Registration No. 3,612,608 is annexed hereto as Exhibit A. The CHIVAS mark has also been used on coasters, glasses and other items.

5. Applicant's CHIVAS POP application, filed on an "intent- to-use" basis, seeks registration for the CHIVAS POP mark in connection with retail store, online store, online retail store ordering, online catalog and mail order catalog services directed to a variety of goods which are identical to, complementary to or related to, Opposer's CHIVAS goods as set forth in the '608 registration.

6. The registration of the CHIVAS POP mark by Applicant would wrongfully suggest to the public that the services with which the mark is or will be used are authorized or otherwise associated with Opposer, when such services are not so authorized, and would falsely suggest that Applicant has exclusive rights to the CHIVAS mark, all to the harm and damage of Opposer and its rights in and to its CHIVAS marks.

7. Upon information and belief, Applicant is a related company to Club Deportivo Guadalajara, A.C., a Mexico corporation ("Deportivo Mexico"). Deportivo Mexico and Chivas Brothers Limited, a related company to Opposer, are parties to a settlement agreement as a resolution of the action entitled *Chivas Brothers Limited, et al. v. Club Deportivo Guadalajara*,

*A.C., et al.*, CV 98-7853, which action was filed in the United States District Court for the Eastern District of New York. The settlement provided, *inter alia*, that Deportivo Mexico “shall not at any time attempt to register in the United States any mark that incorporates or consists in whole or in part of CHIVAS” other than, in some limited forms, in connection with soccer teams only in International Class 041. The Settlement Agreement further provided that its terms were binding on the parties, their officers, employees, successors, assigns, subsidiaries, affiliates, parents and licensees.

8. Upon information and belief Applicant is bound by the terms of the Settlement Agreement and is prohibited from seeking the registration sought by application Serial No. 77/647,485.

9. Applicant’s application to register CHIVAS POP in connection with services in Class 035 is a breach of the settlement agreement and is causing harm and damage to Opposer in that Opposer and its related parties surrendered claims assertable against Deportivo Mexico and related companies in return, *inter alia*, for Deportivo Mexico’s forbearance from seeking registration of the CHIVAS mark. In addition, as aforesaid, registration of Applicant’s mark will cause consumers to wrongfully associate Applicant and its services offered and promoted under the CHIVAS POP mark with Opposer, when they are not, to Opposer’s further harm and damage.

WHEREFORE, the Opposer prays that the present opposition be granted, that registration of Applicant's CHIVAS POP mark be denied, and that Opposer be granted such other relief as may be warranted.

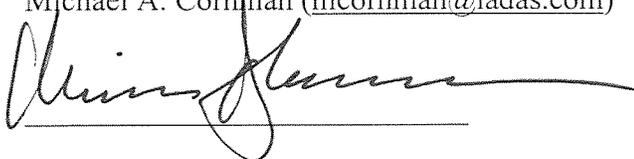
New York, New York

AUGUST 24, 2009

Respectfully submitted,

Jay A. Bondell (jbondell@ladas.com)

Michael A. Cornman (mcomman@ladas.com)

A handwritten signature in black ink, appearing to read "Michael A. Cornman", written over a horizontal line.

**Ladas & Parry LLP**

Attorneys for Opposer

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New York, NY 10023

Phone: 212 708-180

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Int. Cls.: 9, 14, 16, 18, 21, 25 and 28

Prior U.S. Cls.: 1, 2, 3, 5, 13, 21, 22, 23, 26, 27, 28, 29,  
30, 33, 36, 37, 38, 39, 40, 41 and 50

Reg. No. 3,612,608

United States Patent and Trademark Office

Registered Apr. 28, 2009

TRADEMARK  
PRINCIPAL REGISTER

CHIVAS

CHIVAS HOLDINGS (IP) LIMITED (UNITED  
KINGDOM CORPORATION)  
111-113 RENFREW ROAD  
PAISLEY, RENFREWSHIRE PA3 4DYSCOTLAND  
UNITED KINGDOM

FOR: SPIRITS MEASURERS, NAMELY, JIGGERS;  
MEASURES FOR ALCOHOLIC BEVERAGES,  
NAMELY, DISPENSERS THAT COUNT OR MEAS-  
SURE OUTPUT FOR USE WITH ALCOHOLIC BEV-  
ERAGES; SUNGLASSES; SUNGLASSES CASES;  
SPECTACLE CASES; STRAPS FOR SUNGLASSES  
OR SPECTACLES; MOUSE PADS; CAMERA CASES;  
MOBILE PHONE CASES; MOBILE PHONE STRAPS;  
MEMORY CARDS; CARRYING CASES FOR LAP-  
TOPS; FLASH DRIVES CONTAINED IN WRIST  
BANDS; CASES FOR CDS OR DVDS, IN CLASS 9  
(U.S. CLS. 21, 23, 26, 36 AND 38).

FOR: JEWELRY; WATCHES; CASES FOR JEW-  
ELRY; CASES FOR WATCHES; KEY RINGS OF  
PRECIOUS METAL; CUFF LINKS; TIE PINS;  
CLOCKS; METAL MONEY CLIPS; CUFF LINKS;  
TIE PINS; CLOCKS; MONEY CLIPS, IN CLASS 14  
(U.S. CLS. 2, 27, 28 AND 50).

FOR: DESKTOP BUSINESS CARD HOLDERS;  
CASES FOR PASSPORTS; CASES FOR STATION-  
ERY; CASES FOR WRITING INSTRUMENTS; CHE-  
QUEBOOK HOLDERS; BILLBOOKS; DOCUMENT  
PORTFOLIOS; PENCIL CASES; CASES FOR DIA-  
RIES; PAPER GIFT BAGS; PENS; PENCILS; NOTE-  
BOOKS; NOTEBOOK COVERS, NAMELY,  
PROTECTIVE COVERS FOR NOTEBOOKS; CALEN-  
DARS; PHOTOGRAPH ALBUMS; FOLDERS; POST-  
CARDS; POSTERS; PRINTED MENUS; DRINKS  
AND COCKTAIL MATS, NAMELY, COASTERS OF  
CARDBOARD OR PAPER; GREETING CARDS;  
BOOKMARKERS; TABLE CLOTHS OF PAPER, IN  
CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FOR: CASES FOR SPORTING ARTICLES, NAME-  
LY, ALL-PURPOSE SPORTS BAGS; TRAVEL CASES;  
OVERNIGHT CASES; VANITY CASES SOLD EMP-

TY; CARRYING CASES FOR DOCUMENTS; COS-  
METIC CASES SOLD EMPTY; COIN PURSES;  
CREDIT CARD CASES; BUSINESS CARD CASES;  
KEYCASES; BAGS, NAMELY, TRAVEL BAGS,  
MAKE-UP BAGS SOLD EMPTY, HANDBAGS,  
RUCKSACKS, SADDLEBAGS, SOUVENIR BAGS;  
SPORT BAGS; PURSES; WALLETS; UMBRELLAS;  
UMBRELLA COVERS; BILLFOLDS; WALKING  
STICKS; BAGS FOR SPORTS, IN CLASS 18 (U.S.  
CLS. 1, 2, 3, 22 AND 41).

FOR: BEVERAGE GLASSWARE; SCULPTURES,  
FIGURES, FIGURINES, AND ORNAMENTS MADE  
OF PORCELAIN, EARTHENWARE, TERRA COTTA,  
OR CHINA; ICE BUCKETS; COCKTAIL STIRRERS;  
BEVERAGE STIRRERS; SWIZZLE STICKS; COCK-  
TAIL SHAKERS; COCKTAIL PICKS; MIXING CUPS;  
STRAINERS FOR FRUITS OR VEGETABLES; NON-  
ELECTRIC JUICERS; NON-ELECTRIC CITRUS JUI-  
CERS AND SQUEEZERS; HOLDERS FOR NAPKINS;  
MENU CARD HOLDERS; BILL HOLDERS IN THE  
NATURE OF TRAYS; CANDLE HOLDERS; HOLD-  
ERS FOR BAR ACCESSORIES, NAMELY, CADDIES,  
BUCKETS, AND TRAYS FOR HOLDING BAR AC-  
CESSORIES SUCH AS PAPER, PENS, SWIZZLE  
STICKS, STRAWS, STIRRERS, COCKTAIL UM-  
BRELLAS, COASTERS, PEELERS, STRAINERS,  
CORKSCREWS, AND BOTTLE OPENERS; FITTED  
CASES SPECIFICALLY ADAPTED FOR DRINKING  
VESSELS AND DRINKING FLASKS; TOILETRY  
CASES, NAMELY, TOOTHBRUSH CASES, TOOTH-  
BRUSH HOLDERS; FITTED VANITY CASES; BOT-  
TLE OPENERS; CORKSCREWS; HOUSEHOLD,  
RESTAURANT AND KITCHEN GOODS, NAMELY,  
CONDIMENT HOLDERS; SERVING TRAYS; ICE  
CUBE MOLDS; BAR UTENSIL TRAYS; JUGS;  
STANDS FOR BOTTLES; TRAYS, NAMELY, DRIP-  
TRAYS FOR BARS; INSULATING AND NON-IN-  
SULATING BOTTLE BUCKETS; COOLING DEVI-  
CES FOR BOTTLED BEVERAGES, NAMELY,  
COOLING BUCKETS FOR BEER AND WINE; BRU-  
SHES FOR HAIR; COMBS; DECANter STANDS,  
NAMELY, STANDS SPECIALLY DESIGNED TO

EXHIBIT A

HOLD DECANTERS; HIP FLASKS, IN CLASS 21 (U.S. CLS. 2, 13, 23, 29, 30, 33, 40 AND 50).

FOR: CLOTHING, NAMELY, PANTS, SHIRTS, SHORTS, TOPS, DRESSES, AND JACKETS; FOOTWEAR; HEADGEAR, NAMELY, HATS, CAPS, AND BASEBALL CAPS; SCARVES; SLIPPERS; SOCKS; CAPS; BANDANAS; COATS; JACKETS; SHIRTS; T-SHIRTS; POLO SHIRTS; PAJAMAS; UNDER GARMENTS; APRONS; DRESSES; TRACKSUITS; SWIMWEAR; CLOTHING ADAPTED FOR SPORTS, NAMELY, PANTS, SHIRTS, SHORTS, TOPS, DRESSES, AND JACKETS; FOOTWEAR ADAPTED FOR SPORTS, ATHLETIC FOOTWEAR; HEADGEAR ADAPTED FOR SPORTS, NAMELY, HATS, CAPS, BASEBALL CAPS AND SWEATBANDS; BANDANAS FOR WEARING AROUND THE NECK; WRIST BANDS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FOR: SPORTING ARTICLES FOR GOLF, NAMELY, DIVOT REPAIR TOOLS, COVERS FOR GOLF CLUBS, GOLF ACCESSORY POUCHES, GOLF BAG COVERS, GOLF BAG TAGS, GOLF BAGS, GOLF BALL MARKERS, GOLF BALLS, GOLF GLOVES, GOLF TEES, GOLF TOWEL CLIPS FOR ATTACHMENT TO GOLF BAGS; SPORTING ARTICLES FOR SAILING, NAMELY, SAILING GLOVES, SAILING HARNESSSES, AND SAILING HARNESS COVERS;

SPORTING ARTICLES FOR CYCLING, NAMELY, ATHLETIC PROTECTIVE PADS FOR KNEES AND ELBOWS; SPORTING ARTICLES FOR POLO, NAMELY, POLO BALLS, POLO MALLETS; CASES SPECIALLY ADAPTED FOR SPORTS EQUIPMENT, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY DATE OF 7-16-2007 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION 0957304 DATED 8-22-2007, EXPIRES 8-22-2017.

OWNER OF U.S. REG. NOS. 309,456, 3,058,704 AND OTHERS.

THE ENGLISH TRANSLATION OF THE SPANISH WORD "CHIVAS" IN THE MARK IS "GOATS".

SER. NO. 79-051,358, FILED 8-22-2007.

MICHAEL TANNER, EXAMINING ATTORNEY

CERTIFICATE OF SERVICE

It is hereby certified that on August <sup>24</sup>, 2009, a true copy of the foregoing NOTICE OF OPPOSITION, is being served by first-class mail, postage prepaid, to the attorney for Applicant at the following address:

Jennifer T. So, Esq.  
Pillsbury Winthrop Shaw Pittman LLP  
725 S. Figueroa Street – Suite 2800  
Los Angeles, CA 90017-5406

By:   
Gerri De Luca