ESTTA Tracking number: **ESTTA318786**

Filing date: **11/24/2009**

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

Proceeding	91192102
Party	Plaintiff Pine Ridge Winery, LLC
Correspondence Address	Heather A. Dunn, Esq. DLA Piper LLP (US) 555 Mission Street, Suite 2400 San Francisco, CA 94105-2933 UNITED STATES tmdocket@dlapiper.com, heather.dunn@dlapiper.com, dash.mclean@dlapiper.com
Submission	Opposition/Response to Motion
Filer's Name	Heather Dunn
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Signature	/Heather Dunn/
Date	11/24/2009
Attachments	PineRidgeOppositionto12b5Motion11-24-09.pdf (12 pages)(1745285 bytes)

In the Matter of Application Serial No. 77617766
Published in the *Official Gazette* on June 2, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Pine Ridge Winery, LLC. Opposer, v. Martin G. Lagina, Applicant.	Opposition No. 91192102

PINE RIDGE WINERY, LLC'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

I. INTRODUCTION

Applicant Martin G. Lagina's ("Applicant") Rule 12(b)(5) Motion to Dismiss ("Motion") is frivolous and should be denied. The Motion is misleading, misstates the law or, at best, is based on a misunderstanding of the law. The Motion's sole argument – that Opposer Pine Ridge Winery, LLC ("Opposer") failed to properly serve its Notice of Opposition on Applicant – is not supported by the facts or any of Defendant's citations and, in fact, is incorrect. Opposer completely complied with Trademark Rules 2.101(a), (b), and 2.119 to properly file its Notice of Opposition and to properly serve Applicant, both of which Opposer accomplished on September 29, 2009.

II. FACTUAL BACKGROUND

According to the Trademark Office records, on or about November 19, 2008, Applicant applied to register the trademark ARCUS VINETUM which was subsequently assigned Application

Serial No. 77617766 for "wine" in class 33. This application was published in the *Official Gazette* on June 2, 2009. On or about July 1, 2009, Opposer filed a First 90 Day Request for Extension of Time to Oppose Applicant's Mark for Good Cause, and the time period within which to file an opposition was extended to September 30, 2009.

On September 29, 2009, Opposer filed its Notice of Opposition with the Trademark Trial and Appeal Board (the "Board") on the ground that Applicant's proposed mark ARCUS VINETUM for wine is confusingly similar to Applicant's long-held mark ARCUS ESTATE for wine. On September 29, 2009, prior to electronically filing the Notice of Opposition, Applicant deposited a copy of the Notice of Opposition in the United States mail, postage prepaid, addressed to Applicant as follows: Martin G. Lagina, 121 East Front Street, Suite 200, Traverse City, MI 49684. Applicant's Notice of Opposition included a Certificate of Service certifying the same.

III. ARGUMENT

DEFENDANT'S MOTION IS FRIVOLOUS AND SHOULD BE DENIED.

Applicant's sole argument in support of its Motion is that Opposer has allegedly not met its service obligation in connection with its Notice of Opposition. See Motion, unnumbered page 2 ("Opposer, however, failed to **actually** serve a copy of the Notice of Opposition **prior** to filing on APPLICANT" … "Rather, service was sent by First Class Mail after filing the ESTTA form and was received via First Class Mail by APPLICANT on October 1, 2009") (emphasis in original). The allegation that Applicant failed to actually serve a copy of the Notice of Opposition prior to filing it with the Board is simply untrue and unsupported by any facts, alleged facts, or evidence. In fact, Applicant himself admits that he received the service copy of the Notice of Opposition via First Class Mail on Thursday October 1, 2009 in Michigan, which is consistent with Opposer's deposit of the same into First Class Mail in California two days prior, on Tuesday, September 29, 2009. See Declaration of Applicant (submitted with Motion), ¶ 3.

Trademark Rule 2.119(b) provides that "Service of papers . . . may be made in any of the following ways: ... (4) Transmission by the 'Express Mail Post Office to Addressee' service of the United States Postal Service or by first-class mail, which may also be certified or registered; ...." Trademark Rule 2.199(c) further states that "When service is made by first-class mail, 'Express Mail,' or overnight courier, **the date of mailing** or of delivery to the overnight courier **will be considered the date of service**" (emphasis added). Under Trademark Rule 2.119(c), the date on which Applicant mailed the Notice of Opposition to Applicant is the date of service. Opposer mailed the Notice of Opposition to Applicant on September 29, 2009. See Certificate of Service in Notice of Opposition filed September 29, 2009 (courtesy copy attached). Thus, September 29, 2009 was the date of actual service.

Applicant deposited the service copy of the Notice of Opposition in the mail prior to electronically filing the Notice of Opposition with the Board on September 29, 2009. Applicant stated so when filing the Notice of Opposition by checking the applicable box on the ESTTA form. Furthermore, Applicant's Notice of Opposition included a Certificate of Service attesting to service of the Notice of Opposition on Applicant on September 29, 2009. This Certificate constitutes prima facie evidence of proper service (see 37 C.F.R. § 2.199(a)), and Applicant has failed to submit any evidence rebutting this prima facie showing of proper service. Therefore, Opposer properly filed its Notice of Opposition and completely met its service obligation. There is no requirement that Applicant must have *received* the service copy of the Notice of Opposition prior to Opposer filing the Notice of Opposition.

Applicant's case citations in the Motion are also misleading or inapposite. For example, Applicant cites to *Springfield, Inc. v. XD*, 86 USPQ2d 1063 (TTAB 2008), where the opposer electronically filed its opposition on November 7, 2007, the last day of the opposition period, checked the box on the ESTTA form indicating that it had effected service on the applicant, but

in fact it hadn't mailed a service copy of the notice of opposition to the applicant or otherwise effected service. Then, weeks later, on November 26, 2007, the opposer in *Springfield* filed a motion for leave to file an amended notice of opposition indicating that it served a copy of the notice of opposition on applicant on November 26, 2007. The Board dismissed the opposition there on the ground that proper service was not actually made. *Springfield* is entirely distinguishable from the case at hand because in the case at hand, Opposer in fact had served its Notice of Opposition on Applicant by depositing it into First Class Mail prior to the deadline to file the Opposition, and prior to electronically filing its Notice of Opposition. Applicant also cites to *Schott AG v. L'Wren Scott*, 88 USPQ2d 1862 (TTAB 2008), where again the opposer never mailed or otherwise served a copy of the Notice of Opposition on the applicant, so the Board dismissed the opposition. In the cases relied upon by Applicant, the Board found that the opposers had not actually deposited in the mail (or otherwise served) the notices of opposition on the applicants prior to the opposition deadlines or prior to filing the notices of opposition with the Board. By contrast, in the case at hand Opposer did deposit its Notice of Opposition in the mail to Applicant prior to the opposition deadline and prior to filing the Notice of Opposition with the Board. Therefore, Applicant's citation to these cases is misplaced at best, and misleading at worst.

Applicant's statement in his Motion that Opposer did not actually serve Applicant prior to filing the Notice of Opposition is simply untrue and unsupported by any factual evidence. Therefore, Applicant has failed to controvert the prima facie showing of proper service demonstrated by the Opposer's Certificate of Service. 37 C.F.R. § 2.119(a). Moreover, Applicant's unsupported statement that service was not timely completed is controverted by Opposer's statement on the ESTTA form at the time of electronically filing the Notice of Opposition, and by Applicant's

receipt of the service copy of the Notice of Opposition via First Class Mail in Michigan on October 1, 2009 – just two days after Opposer's date of service.[1]

Applicant's Motion seems to imply that he believes service was not proper in this case because Applicant did not *receive* the service copy of Opposer's Notice of Opposition until two days after the Notice of Opposition was filed. This is, at a minimum, a misunderstanding of the law. Service, when sent by First Class Mail, is effected on the date of mailing.

CONCLUSION

For the reasons stated above, Opposer respectfully asks that the Board deny Applicant's Motion to Dismiss.

Please charge the filing fees of this Opposition to Motion to Dismiss, if any, to Deposit Acct. No. 07-1907. Please charge any additional fees, or credit any overpayment, to Deposit Acct. No. 07-1907.

Dated: November 24, 2009

DLA PIPER LLP (US)

By: _____

Heather A. Dunn, Esq.
DLA PIPER LLP (US)
555 Mission Street, Suite 2400
San Francisco, CA 94105-2933
Telephone: (415) 836-2557
Attorneys for Opposer
Pine Ridge Winery, LLC

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[1] Opposer also notes that Applicant has not suffered any prejudice as he admits that he was aware of the filing of the Notice of Opposition on September 29, 2009 (see Declaration of Applicant, ¶ 2), and actually received the Notice of Opposition on October 1, 2009. *Id*, ¶ 3.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document:

PINE RIDGE WINERY LLC'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

was served on Applicant Martin G. Lagina by depositing the same in the United States mail, postage prepaid, addressed to Applicant as follows:

Martin G. Lagina
121 East Front Street
Suite 200
Traverse City, MI 49684

this 24th day of November 2009.

Shelley Marlowe

Shelley Marlowe

Exhibit A

Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov
ESTTA Tracking number: **ESTTA308809**
Filing date: **09/29/2009**

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	Pine Ridge Winery, LLC
Granted to Date of previous extension	09/30/2009
Address	5901 Silverado Trail Napa, CA 94558 UNITED STATES

Attorney information	Heather A. Dunn, Esq. DLA Piper LLP (US) 555 Mission Street, Suite 2400 San Francisco, CA 94105-2933 UNITED STATES tmdocket@dlapiper.com, heather.dunn@dlapiper.com, dash.mclean@dlapiper.com Phone:415.836.2557

Applicant Information

Application No	77617766	Publication date	06/02/2009
Opposition Filing Date	09/29/2009	Opposition Period Ends	09/30/2009
Applicant	Lagina, Martin G. 121 East Front Street, Suite 200 Traverse City, MI 49684 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Wine

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	As set forth in the attached Notice of Opposition

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77659782	Application Date	01/29/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ARCUS ESTATE		

Design Mark	ARCUS ESTATE
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 1996/05/31 First Use In Commerce: 1996/05/31 Wine

Attachments	77659782#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (3 pages)(98694 bytes)

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	/Heather A. Dunn/
Name	Heather A. Dunn, Esq.
Date	09/29/2009

In the Matter of Application Serial No. 77617766
Published in the *Official Gazette* on June 2, 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Pine Ridge Winery, LLC. Opposer, v. Martin G. Lagina, Applicant.	Opposition No.

NOTICE OF OPPOSITION

Opposer, Pine Ridge Winery, LLC, a limited liability company organized and existing under the laws of the State of Delaware having its principal place of business at 5901 Silverado Trail, Napa, California 94558 ("Opposer") believes that it has been and/or will be damaged by the registration of Application Serial No. 77617766 for ARCUS VINETUM and hereby opposes the same.

As grounds for opposition, Opposer alleges that:

1. According to the Trademark Office records, on or about November 19, 2008, Applicant Martin G. Lagina, an individual ("Applicant"), applied to register the trademark ARCUS VINETUM which was subsequently assigned Application Serial No. 77617766 ("Applicant's Mark") for "wine" in class 33 based on Applicant's intent to use Applicant's Mark in commerce on the aforementioned goods. This application was published in the June 2, 2009 edition of the *Official Gazette*.

2. On or about July 1, 2009, Opposer filed a First 90 Day Request for Extension of Time to Oppose Applicant's Mark for Good Cause, and the time period within which to file an opposition was extended to September 30, 2009.

3. Opposer is the owner of the trademark ARCUS ESTATE and filed an application to register the trademark on January 29, 2009, which was subsequently assigned Application Serial No. 77659782, for "wine" in class 33 based on Opposer's use of ARCUS ESTATE anywhere and in commerce on the aforementioned goods since at least as early as May 31, 1996 ("Opposer's Application").

4. The Examining Attorney at the United States Patent and Trademark Office cited Applicant's Mark as a potential bar to registration of Opposer's Application on the basis that there may be a likelihood of confusion between the two marks because, although Applicant filed to register ARCUS VINETUM over thirteen (13) years after Opposer began using ARCUS ESTATE, Opposer's Application was filed subsequent to the filing date of the application for Applicant's Mark.

5. In addition to rights arising from the Opposer's pending federal application listed in Paragraph 3, above, Opposer has valid common law rights in ARCUS ESTATE both as an inherently distinctive trademark for its wine and as the name of Opposer's signature vineyard in the Red Hills of Dundee, Oregon, which has been used to grow distinctive grapes for producing wine for many years - both the wine and vineyard are also know simply as, "ARCUS" (collectively, "Opposer's Mark").

6. Opposer's Mark has become a valuable asset of Opposer and a symbol of its goodwill. By reason of its significant advertising for and distribution of Opposer's wine bearing Opposer's Mark, the trade and purchasing public have come to recognize Opposer's Mark as signifying Opposer and as identifying Opposer as the source of Opposer's wine goods and related services ("Opposer's Goods and Services") bearing Opposer's Mark.

7. Opposer has continuously used Opposer's Mark since at least as early as May 31, 1996 to identify Opposer's Goods and Services, which use predates Applicant's filing date for its intent-to-use Application Serial No. 77617766 (specifically, November 19, 2008), by over thirteen years.

8. The goods identified in Application Serial No. 77617766 and Opposer's Goods and Services are identical and are of the type which could be and are offered in the same channels of trade and to the same prospective customers.

9. If Application Serial No. 77617766 is registered, the public will reasonably believe that Applicant's goods are provided, sponsored, or endorsed by Opposer, all to the detriment of consumers and Opposer.

10. Applicant's Mark is highly similar to Opposer's Mark, and is confusingly similar to Opposer's Mark and is likely to be confused therewith. Such confusion, mistake, and deception regarding the origin of Applicant's goods is likely to cause irreparable harm to Opposer.

11. Due to Opposer's longstanding and continuous use of Opposer's Mark in connection with Opposer's Goods and Services, Opposer's Mark has become well known as designating Opposer's Goods and Services throughout the United States.

12. The granting of a trademark registration for Applicant's Mark would violate and diminish the prior and superior rights of Opposer in Opposer's Mark and would be in violation of 15 U.S.C. § 1052(d).

13. The granting of a trademark registration for Applicant's Mark may also block the registration of Opposer's Mark, which would be a source of damage and injury to Opposer.

14. As stated in Paragraph 5, above, Opposer has valid common law rights in Opposer's Mark.

15. Applicant's Mark is in violation and derogation of those common law rights and is likely to cause confusion, mistake and deception among purchasers and users as to the source or origin of Applicant's goods, or their affiliation with or sponsorship by Opposer, thereby causing loss, damage, and injury to Opposer and the public.

16. If Applicant is granted the registration herein opposed, it would thereby obtain a prima facie exclusive right to its mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 77617766 be rejected, that no registration be issued thereon, and that this Opposition be sustained in favor of Opposer.

Please charge the filing fees of this Notice of Opposition to Deposit Acct. No. 07-1907. Please charge any additional fees, or credit any overpayment, to Deposit Acct. No. 07-1907.

Dated: September 29, 2009

DLA PIPER LLP (US)

By: _____
Heather A. Dunn, Esq.

DLA PIPER LLP (US)
555 Mission Street
Suite 2400
San Francisco, CA 94105-2933
Telephone: (415) 836-2557

Attorneys for Opposer
Pine Ridge Winery, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document:

NOTICE OF OPPOSITION

was served on Applicant Martin G. Lagina by depositing the same in the United States mail, postage prepaid, addressed to Applicant as follows:

Martin G. Lagina
121 East Front Street
Suite 200
Traverse City, MI 49684

this 29th day of September 2009.

Allison V. Burn