

ESTTA Tracking number: **ESTTA352807**

Filing date: **06/14/2010**

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	E. & J. GALLO WINERY
Granted to Date of previous extension	09/01/2010
Address	600 YOSEMITE BOULEVARD MODESTO, CA 95354 UNITED STATES

Attorney information	D. Peter Harvey Harvey Siskind LLP 4 Embarcadero Center, 39th Floor San Francisco, CA 94111 UNITED STATES rzerounian@harveysiskind.com, pharvey@harveysiskind.com, clee@harveysiskind.com Phone:415-354-0100
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Applicant Information

Application No	77712823	Publication date	05/04/2010
Opposition Filing Date	06/14/2010	Opposition Period Ends	09/01/2010
Applicant	Robson, Douglas J. 3407 East Roma Ave Phoenix, AZ 85018 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2009/04/01 First Use In Commerce: 2009/04/01
All goods and services in the class are opposed, namely: Bar and restaurant services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	444756	Application Date	02/11/1946
Registration Date	03/24/1953	Foreign Priority Date	NONE
Word Mark	GALLO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U047 (International Class 033). First use: First Use: 1909/00/00 First Use In Commerce: 1909/00/00 WINES

U.S. Registration No.	887959	Application Date	01/17/1969
Registration Date	03/17/1970	Foreign Priority Date	NONE

Word Mark	GALLO
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class U046 (International Class 001, 005, 029, 030, 031, 032). First use: First Use: 1962/11/19 First Use In Commerce: 1968/07/22 PREPARED MEAT PRODUCTS-NAMELY, SALAME, SAUSAGE, MORTADELLA, CURED MEATS [, AND MEAT LOAF] ; AND CHEESE
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U.S. Registration No.	2320063	Application Date	07/25/1997
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Registration Date	02/22/2000	Foreign Priority Date	NONE
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Word Mark	GALLO
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Design Mark	GALLO
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1988/05/01 First Use In Commerce: 1988/05/01 clothing, namely, T-shirts, sweatshirts, shirts and caps

U.S. Registration No.	3210839	Application Date	01/30/2006
Registration Date	02/20/2007	Foreign Priority Date	NONE

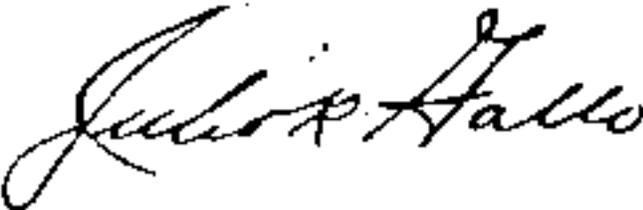
Word Mark	GALLO
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Design Mark	GALLO
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 2006/01/24 First Use In Commerce: 2006/01/24 BEER MUGS, EARTHENWARE MUGS, GLASS MUGS, MUGS, PORCELAIN MUGS

U.S. Registration No.	3382558	Application Date	12/29/2006
Registration Date	02/12/2008	Foreign Priority Date	NONE
Word Mark	GALLO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 2006/12/18 First Use In Commerce: 2006/12/18 BEER MUGS, EARTHENWARE MUGS, GLASS MUGS, MUGS, PORCELAIN MUGS Class 025. First use: First Use: 2007/01/15 First Use In Commerce: 2007/01/15 CAPS, SHIRTS, JACKETS

U.S. Registration No.	778837	Application Date	10/22/1963
Registration Date	10/20/1964	Foreign Priority Date	NONE
Word Mark	ERNEST & JULIO GALLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U047 (International Class 033). First use: First Use: 1958/08/04 First Use In Commerce: 1958/08/04 Wines		

U.S. Registration No.	1813967	Application Date	02/09/1993
Registration Date	12/28/1993	Foreign Priority Date	NONE
Word Mark	JULIO R GALLO		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 1972/08/00 First Use In Commerce: 1972/08/00 wines

U.S. Registration No.	1815078	Application Date	02/09/1993
Registration Date	01/04/1994	Foreign Priority Date	NONE

Word Mark	ERNEST GALLO
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 1972/08/00 First Use In Commerce: 1972/08/00 wines

U.S. Registration No.	2794867	Application Date	12/23/2002
Registration Date	12/16/2003	Foreign Priority Date	NONE

Word Mark	ERNEST & JULIO GALLO
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1983/01/01 First Use In Commerce: 1983/01/01 Shirts, jackets, sweatshirts, aprons

U.S. Registration No.	3036791	Application Date	05/26/2004
Registration Date	12/27/2005	Foreign Priority Date	NONE

Word Mark	THE GALLO FAMILY WINE SHOP
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Design Mark	 <p>THE GALLO FAMILY WINE SHOP</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 2005/03/10 First Use In Commerce: 2005/03/10 JACKETS, SHIRTS AND CAPS</p> <p>Class 035. First use: First Use: 2004/05/17 First Use In Commerce: 2004/05/17 RETAIL SERVICES FEATURING WINE, BRANDY, JACKETS, SHIRTS, CAPS, AND WINE-RELATED ACCESSORIES; EMPLOYEE INFORMATION SERVICES</p>		

U.S. Registration No.	3077733	Application Date	09/01/2004
Registration Date	04/04/2006	Foreign Priority Date	NONE

Word Mark	GALLO FAMILY		
Design Mark	 <p>GALLO FAMILY</p>		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2004/11/08 First Use In Commerce: 2004/11/08 OLIVE OIL		

U.S. Registration No.	3198966	Application Date	05/24/2006
Registration Date	01/16/2007	Foreign Priority Date	NONE
Word Mark	GALLO FAMILY VINEYARDS		

Design Mark	GALLO FAMILY VINEYARDS
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2006/03/31 First Use In Commerce: 2006/03/31 CAPS, SHIRTS, JACKETS

U.S. Registration No.	3440497	Application Date	11/01/2007
Registration Date	06/03/2008	Foreign Priority Date	NONE
Word Mark	GALLO FAMILY VINEYARDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2007/10/01 First Use In Commerce: 2007/10/01 TOTE BAGS, WHEELED TOTE BAGS, BOOK BAGS, WINE BAGS WITH HANDLES FOR CARRYING OR HOLDING WINE Class 021. First use: First Use: 2007/10/01 First Use In Commerce: 2007/10/01 COFFEE CUPS, MUGS, CORK PULLERS, CORKSCREWS Class 025. First use: First Use: 2006/03/31 First Use In Commerce: 2006/03/31 APRONS, CAPS, JACKETS, SHIRTS, SHORTS AND SWEATSHIRTS		

U.S. Registration No.	1650478	Application Date	03/02/1989
Registration Date	07/09/1991	Foreign Priority Date	NONE
Word Mark	GALLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 008. First use:		

	<p>[TABLEWARE; NAMELY, KNIVES, FORKS AND SPOONS; ICE TONGS; PASTRY TONGS]</p> <p>Class 011. First use:</p> <p>[ELECTRIC TABLE LAMPS AND ELECTRIC FLOOR LAMPS]</p> <p>Class 016. First use:</p> <p>[TABLE CLOTHS AND NAPKINS MADE OF PAPER]</p> <p>Class 020. First use:</p> <p>[SIDE TABLES AND MIRRORS]</p> <p>Class 021. First use:</p> <p>[DECORATIVE ART OBJECTS OF WOOD; KITCHEN AND HOUSEHOLD ARTICLES OF WOOD AND PLASTIC; NAMELY, PEPPER MILLS, SALT SHAKERS, CHEESE BOARDS, PLACE MATS, BOWLS, DISHES AND SALAD SERVICES COMPRISED OF BOWLS, FORKS AND SPOONS; KITCHEN AND HOUSEHOLD ARTICLES OF PORCELAIN, OTHER CERAMIC MATERIALS, GLASS, POLISHED AND ENAMELED METAL WITHOUT OR IN COMBINATION WITH WOOD, TEXTILE, LEATHER AND PLASTICS; NAMELY, POTS, PANS, CASSEROLES, PLATES, CUPS, DISHES, PLATTERS, TUREENS, JUGS, CANS, GOBLETS, EGG CUPS, CANDLESTICKS, ORNAMENTAL STOPPERS, BOTTLE OPENERS,] CORK SCREWS, [CAKE SHOVELS,] PLACE CARD HOLDERS, [NAPKIN RINGS, CHAMPAGNE TWIRLING STICKS, DINING GLASSES, BOWLS, VASES, CARAFES, MUGS AND ICE BUCKETS; DECORATIVE AND ART OBJECTS OF PORCELAIN, OTHER CERAMIC MATERIALS AND GLASS; NAMELY, FIGURINES AND DECORATIVE WALL PLATES; SMALL HAND OPERATED APPLIANCES FOR USE IN KITCHENS AND HOUSEHOLDS; NAMELY, PLATE WARMERS, PLATES, PLATE HOODS, TOAST RACKS, NAPKIN STANDS, TEA SIEVES, CRUMB BRUSHES, CRUMB SHOVELS AND COASTERS FOR GLASSES AND BOTTLES]</p>
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Attachments	<p>71496376#TMSN.gif (1 page)(bytes)</p> <p>72316889#TMSN.gif (1 page)(bytes)</p> <p>75330379#TMSN.gif (1 page)(bytes)</p> <p>78802659#TMSN.jpeg (1 page)(bytes)</p> <p>77073560#TMSN.jpeg (1 page)(bytes)</p> <p>72179529#TMSN.gif (1 page)(bytes)</p> <p>74357632#TMSN.gif (1 page)(bytes)</p> <p>74357631#TMSN.gif (1 page)(bytes)</p> <p>78425363#TMSN.jpeg (1 page)(bytes)</p> <p>78477414#TMSN.jpeg (1 page)(bytes)</p> <p>78891422#TMSN.jpeg (1 page)(bytes)</p> <p>77319119#TMSN.jpeg (1 page)(bytes)</p> <p>Notice of Opp.100614.pdf (7 pages)(45101 bytes)</p>
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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	/Raffi V. Zerounian/
Name	Raffi V. Zerounian
Date	06/14/2010

1 trademark, ranging from wine, meats, and olive oil to mugs and various types of clothing. Opposer
2 has sold billions of dollars of wine throughout the United States bearing the GALLO trademark.
3 Furthermore, Opposer has spent an enormous amount of money – over \$600,000,000 – promoting its
4 GALLO trademark. Goods bearing the GALLO trademark are sold and promoted to retail
5 consumers nationwide through all available media. They are also heavily promoted, sold, and
6 displayed in restaurants and other food service establishments. The GALLO trademark has a high
7 degree of consumer recognition and in the United States stands exclusively for goods made or
8 licensed by Opposer.

9 3. As a result of Opposer’s extraordinary sales and advertising efforts over a period of
10 many decades, consumers throughout the country (and the world) recognize Opposer’s GALLO
11 trademark as an identifier of source. Indeed, the GALLO trademark is famous.

12 4. Given the enormous strength of the GALLO trademark, this mark is entitled to a wide
13 scope of protection, as confirmed by several court rulings. Opposer has consistently and
14 successfully enforced its rights in the GALLO trademark in the United States and abroad.

15 5. Opposer’s GALLO trademark is distinctive and famous, and was distinctive and
16 famous long before the filing of Serial No. 77712823 and long before Applicant’s first use, if any, of
17 the trademark depicted therein.

18 6. Opposer’s rights in the GALLO trademark are reflected in numerous U.S. trademark
19 registrations in several classes. These U.S. registrations include the following, each of which has a
20 priority date preceding the filing of Serial No. 77712823 and preceding Applicant’s first use, if any,
21 of the trademark depicted therein.

- 22 • GALLO (Reg. No. 444,756) for wines in Class 33
- 23 • GALLO (Reg. No. 887,959) for cheese and various meats in Class 29
- 24 • GALLO (Reg. No. 1,650,478) for corkscrews in Class 21
- 25 • GALLO (Reg. No. 2,320,063) for clothing, namely, T-shirts, sweatshirts, shirts and caps
26 in Class 25
- 27 • GALLO (Reg. No. 3,210,839) for various mugs in Class 21

- 1 • GALLO (and design) (Reg. No. 3,382,558) for, among other things, caps, shirts, and
2 jackets in Class 25

3 7. As noted above, Opposer also owns many GALLO-formative and inclusive
4 trademarks, both registered and unregistered. Again, Opposer owns U.S. registrations for its
5 GALLO-formative and inclusive trademarks in several classes. Opposer's registrations covering its
6 GALLO-formative and inclusive trademarks include the following, each of which has a priority date
7 preceding the filing of Serial No. 77712823 and preceding Applicant's first use, if any, of the
8 trademark depicted therein:

- 9 • ERNEST & JULIO GALLO (Reg. No. 778,837) for wines
10 • JULIO R GALLO (Reg. No. 1,813,967) for wines
11 • ERNEST GALLO (Reg. No. 1,815,078) for wines
12 • ERNEST & JULIO GALLO (Reg. No. 2,794,867) for shirts, jackets, sweatshirts, and
13 aprons in Class 25
14 • THE GALLO FAMILY WINE SHOP (and design) (Reg. No. 3,036,791) for, among
15 other things, jackets, shirts, and caps in Class 25
16 • GALLO FAMILY (Reg. No. 3,077,733) for olive oil in Class 29
17 • GALLO FAMILY VINEYARDS (Reg. No. 3,198,966) for caps, shirts, and jackets in
18 Class 25
19 • GALLO FAMILY VINEYARDS (and design) (Reg. No. 3,440,497) for, among other
20 things, aprons, caps, jackets, shirts, shorts, and sweatshirts in Class 25

21 8. Each of the registrations identified in Paragraphs 6 and 7 above is valid and
22 subsisting. Many are incontestable.

23 9. Opposer has also established common law rights in its GALLO and GALLO-
24 formative trademarks, which also predate the filing of Serial No. 77712823 and Applicant's first use,
25 if any, of the trademark depicted therein. Opposer's common law rights in its famous GALLO
26 trademark predate Applicant's application and use, if any, by well over half a century.

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1 **Likelihood of Confusion**

2 10. The mark shown in Serial No. 77712823 so resembles Opposer’s GALLO and
3 GALLO-formative and inclusive trademarks as to be likely, when used on or in connection with the
4 goods identified in Serial No. 77712823, to cause confusion, or to cause mistake, or to deceive. In
5 fact, the primary and dominant element of Applicant’s trademark is identical to Opposer’s GALLO
6 trademark. To further exacerbate confusion, Applicant’s trademark application also features a
7 rooster, which is very similar in appearance to the rooster that appears in Opposer’s Reg. No.
8 3,128,127 for GALLO FAMILY VINEYARDS (& design), as well as other rooster images that
9 appear on Opposer’s products and promotional and marketing materials.

10 11. The primary and dominant element of Applicant’s mark is identical to Opposer’s
11 GALLO trademark. Applicant uses the applied-for mark in connection with restaurant and bar
12 services, and, on information and belief, Applicant currently offers wine at his restaurant/bar. In the
13 normal course of trade, Opposer’s goods are sold in restaurants and bars and would be marketed and
14 promoted there. Accordingly, consumers would inevitably be led to mistakenly believe that
15 Applicant’s bar/restaurant is sponsored by or affiliated with Opposer.

16 12. Accordingly, the Board should refuse registration under Section 2(d) of the Lanham
17 Act, 15 U.S.C. § 1052(d).

18 **Dilution**

19 13. Applicant’s use and/or registration of the mark shown in Serial No. 77712823 is
20 likely to dilute the distinctive quality of Opposer’s famous GALLO trademark.

21 14. The Board should refuse registration on this additional ground, per Sections 13(a) and
22 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

23 WHEREFORE, Opposer prays that this opposition be sustained; that Serial No. 77712823 be
24 rejected; and that no registration be issued to Applicant.

25 Opposer hereby appoints Harvey Siskind LLP, a law firm composed of members of the bar of
26 the State of California, to act as attorneys for Opposer herein, with full power to prosecute this
27 opposition proceeding, to transact all relevant business with the Patent and Trademark Office and in the
28

1 United States Courts, and to receive all official communications in connection with this opposition
2 proceeding.

3 Dated: June 14, 2010

Respectfully submitted,

HARVEY SISKIND LLP

/s/

By: Raffi V. Zerounian

D. PETER HARVEY

RAFFI V. ZEROUNIAN

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San Francisco, CA 94111

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Facsimile: (415) 391-7124

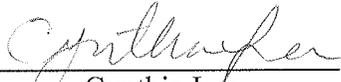
Attorneys for Opposer

E. & J Gallo Winery

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CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the attached NOTICE OF OPPOSITION was served on Applicant via overnight delivery, postage prepaid, addressed to Douglas J. Robson, 3407 East Roma Ave, Phoenix, AZ 85018, and Michael Widener, Esq., Bonnett, Fairbourn, Friedman & Balint, PC, 2901 N. Central Ave, Suite 1000, Phoenix, AZ 85012, on June 14, 2010.


Cynthia Lee

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