

ESTTA Tracking number: **ESTTA432560**

Filing date: **09/27/2011**

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

Proceeding	91197078
Party	Plaintiff Paul Jaboulet Aine
Correspondence Address	JULIE B SEYLER ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017 UNITED STATES jbseyler@lawabel.com, Rdahl@lawabel.com
Submission	Plaintiff's Notice of Reliance
Filer's Name	Aimee M. Allen
Filer's e-mail	aallen@lawabel.com, jbseyler@lawabel.com
Signature	/aimeemallen/
Date	09/27/2011
Attachments	45 Opp. No. 91197078 Notice of Reliance - Sinkoff Declaration.pdf (27 pages) (6114087 bytes)

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

PAUL JABOULET AINE

Opposer,

v.

S.P. GROSSNICKLE, LLC,

Applicant

Opposition No. 91197078

NOTICE OF RELIANCE UNDER RULE 2.123(b)

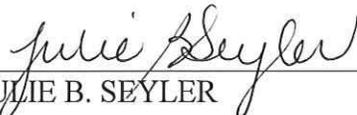
Pursuant to Trademark Rule 2.123(b), the parties have agreed in writing to submit testimony via declaration. Attached hereto is the parties' written agreement executed via email.

Pursuant to Rule 2.123(b) and the agreement between the parties, Opposer hereby makes of record the Declaration of Martin J. Sinkoff and attached exhibits.¹

The Declaration is submitted to show the long term continuous use of PARALLELE 45 by Opposer throughout the U.S. and Opposer's priority of use in the mark. It also sets forth facts that establish the confusing similarity of both marks.

Dated: September 27, 2011

Respectfully submitted,



JULIE B. SEYLER

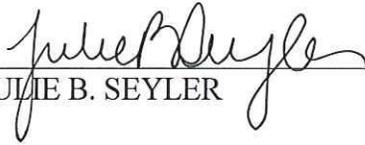
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

¹ Opposer notes that Paragraph 24 of the Declaration of Martin J. Sinkoff depicts Applicant's mark as it appears in the Application, though the image of the mark on the scanned copy of the Declaration is slightly blurred.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF RELIANCE was served by first class mail, postage prepaid this 27th day of September, 2011 upon the following:

Steven L. Smilay, Esq.
BOTKIN & HALL, LLP
105 East Jefferson Blvd., Ste. 400
South Bend, Indiana 46601


JULIE B. SEYLER

SEYLER, J.

From: Steven L. Smilay [ssmilay@bhlawyers.net]
Sent: Friday, September 09, 2011 8:23 AM
To: SEYLER, J.
Subject: RE: Paul Jaboulet Aine Trademark PARALLELE 45 and S.P. Grossnickle Trademark 45 Opposition in the U.S.

Julie:

This will confirm our agreement that both parties will submit their testimony via declaration and that we shall not be taking depositions in these proceedings.

Thanks.

Steve

Steven L. Smilay
Botkin & Hall, LLP
105 E. Jefferson Blvd., Suite 400
South Bend, IN 46601
574-234-3900

From: SEYLER, J. [mailto:JBSeyler@lawabel.com]
Sent: Thu 9/8/2011 6:04 PM
To: Steven L. Smilay
Subject: Paul Jaboulet Aine Trademark PARALLELE 45 and S.P. Grossnickle Trademark 45 Opposition in the U.S.

Dear Steve:

I am following up on our telephone discussion wherein we agreed that both parties will submit their testimony via declaration and that we shall not be taking depositions in these proceedings.

Please confirm this is your understanding as well.

Regards,
Julie

Julie B. Seyler
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, New York 10017
212-949-9022

9/22/2011

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

-----X

Paul Jaboulet Aine,

Opposer,

v.

S.P. Grossnickle, LLC,

Applicant.

DECLARATION OF

Martin J Sinkoff

Opp. No. 91197078

-----X

I, Martin Sinkoff, hereby declare that I have personal knowledge of all the facts set forth below and in such cases where I do not have personal knowledge, I have consulted business records of Frederick Wildman and Sons Ltd., (hereinafter referred to as "Wildman") and Paul Jaboulet Aine, (hereinafter referred to as "Jaboulet" or Opposer").

The Declarant's Background

1. I am presently employed in the position of Director of Marketing, Fine Wines of Frederick Wildman and Sons Ltd., a company specializing in the importation and distribution of wine in the United States.
2. I have held my present position of Director of Marketing since August, 2008 and prior to that time, between the years 1996 and 2008 I was the sole owner of Martin Sinkoff Wines, a company specializing in the importation of wine.
3. My career in the wine industry began in 1979 when I worked as an assistant to Alexis Lichine, in Bordeaux, France. Alexis Lichine was a renowned connoisseur of wines and spirits and author of *The New Encyclopedia of Wines and Spirits*. Thus I have been professionally engaged in the wine industry for over 32 years. Because I owned and operated my own wine importation company, I am familiar with all aspects of the U.S. wine industry, including all facts related to importation and selling in the wholesale and retail markets. I have been aware of PARALLELE 45 wine since 1979 when I commenced my employment with Alexis Lichine. It is a venerable brand and well-known within the world of wine.

4. Wildman has distributed and sold wine in the U.S. since at least as early as 1934.
5. Wildman has distributed and sold PARALLELE 45 wine on behalf of Jaboulet since at least as early as 1967 and is the exclusive distributor of PARALLELE 45 wine. I have worked with PARALLELE 45 wine since I began at Wildman in August, 2008.
6. My present duties at Wildman include direct responsibility for the marketing of wines produced and manufactured by Paul Jaboulet Aine, the Opposer in this proceeding.
7. Specifically, Wildman markets and sells Jaboulet's PARALLELE 45 wine throughout the U.S., through its national third party wholesale networks. In the states of New York and New Jersey, Wildman sells its wine through its own wholesale company.
8. Wines are marketed and sold in the U.S. by various distributors such as Southern Wines & Spirits, Glazers, and M.S. Walker. Wildman's many clients include retail stores specializing in wines; retail stores specializing in the sale of all alcoholic beverages; general retail stores that are licensed to sell wine; restaurants that are licensed to sell wine; and wholesalers. Imported wines such as Jaboulet's PARALLELE 45 wine are sold alongside domestic wines, frequently by the same distributors. It is typical for a single customer, be it a restaurant, a retailer, or a wholesaler, to purchase both domestic U.S. wines and French wines and then offer both types of products to their clients.
9. It is common for a single wine list in a restaurant in the U.S. to offer local wines, California wines, Oregon wines, or mid-western wines, as well as French, Italian or Chilean wines. It is therefore likely that the Applicant's 45 wine would be sold in exactly the same channels of trade as Jaboulet's PARALLELE 45 wine.
10. It is common as well for wines sold at different price points to be sold alongside each other.
11. The U.S. marketing campaigns undertaken by Wildman in the U.S., including the one for PARALLELE 45, are nationwide and target retailers and wholesalers. They reach potential purchasers through a variety of media including internet marketing as well as print advertising in national magazines such as *Wine Spectator*. All advertising is targeted to reach throughout the United States.
12. My current duties specifically include overseeing the marketing and sales of PARALLELE 45 wine in the domestic United States. Marketing

activities include overseeing the advertising programs and promotional campaigns for PARALLELE 45, as well as reviewing labels, packaging and pricing.

13. As part of my duties involving PARALLELE 45 wine, I constantly evaluate the U.S. market for wine, including the market for PARALLELE 45 in the U.S. I also help formulate and implement the U.S. marketing strategies for PARALLELE 45 wine. The scope of the marketing strategy is nationwide. Through the Wildman national wholesale network we are able to sell wine through all channels of trade in the U.S.
14. As part of my duties, I report to other senior managers at Wildman, including Rocco Lombardi, Senior Vice President/Director of Sales and Marketing at Wildman, regarding the status of our marketing and sales strategies for PARALLELE 45. I also regularly confer with the sales staff of our company on the success of our product promotions for PARALLELE 45 wine.

Declarant's Knowledge of the Use of PARALELLE 45 in Commerce

15. Wildman has been distributing wines on behalf of Jaboulet since 1954.
16. I have reviewed the available records at Wildman and confirm that Wildman commenced importing and distributing PARALLELE 45 wine as early as 1967 and such use has been continuous since 1967.
17. I have reviewed the attached Exhibit A, which consists of a print-out of the status and title copy of Registration No. 2682366 for PARALLELE 45 and note that said registration claims the trademark has been in use since 1978. I do not have a basis to state why Jaboulet claimed it commenced using the trademark PARALLELE 45 in commerce in 1978 when it filed for registration in 2000. However, as stated in Paragraph 13, Wildman has imported and distributed PARALLELE 45 wine in the U.S. continuously and without interruption since 1967.
18. The attached Exhibit B is a photograph of the first PARALLELE 45 wine sold in commerce in the United States in 1967. The wine bottle bears a vintage date of 1964. The trademark PARALLELE 45 appears on the label.
19. Wildman distributes and sells wine identified and distinguished under the trademark PARALLELE 45 throughout the fifty states, including in particular the states of Michigan, Indiana, Illinois, Ohio, Colorado, California, Washington, Missouri, and Iowa. I have reviewed Exhibit C which consists of Applicant's response to Interrogatory No. 5. It states that Applicant also sells wine to consumers in these states. This obviously

increases the likelihood that the same trade channels and customers will encounter Applicant's and Opposer's wine products and will be confused.

20. Since its first commercial use in 1967, there has never been a period where the trademark PARALLELE 45 has not been in use in U.S. commerce. The mark has thus been in continuous use in commerce on wine for forty-four (44) years.
21. As a result of the years of continuous use, PARALLELE 45 has achieved renown and name recognition. In the past 10 years, a total of approximately 50,000 cases comprising 12 bottles of PARALLELE 45 wine per case have been sold in the U.S. The estimated retail value is \$6,000,000.
22. PARALLELE 45 is consistently recognized as a best value and best buy by *Wine Spectator* and *Wine & Spirit* magazines.
23. With respect to marketing and presenting the goods, PARALLELE 45 is sometimes referred to as P45 in advertising, on invoices, shipment documents, and other materials. In addition to all of the abovementioned reasons, because PARALLELE 45 wine is sometimes referred to as P45, it is particularly likely to be confused in the marketplace with Applicant's 45 wine.

Declarant's Knowledge of Applicant's Mark

24. I am aware that S.P. Grossnickle (hereinafter "Applicant"), filed



Application No. 77/806650 for _____ for wine claiming a date of first use of March 15, 2008 and a date of first use in commerce of July 4, 2008.

25. I have reviewed the attached Exhibit D which consists of examples of how Applicant uses 45 on wine.
26. I have reviewed the attached Exhibit E which consists of Applicant's response to Opposer's Interrogatory No. 11 and note that Applicant admits to having actual knowledge of Opposer's use and registration of the trademark PARALLELE 45 prior to selection, adoption and use of its 45 mark.
27. Applicant's trademark consists solely of the numeric designation 45 in a stylized design.

28. Opposer's trademark consists of PARALLELE 45. The 45 element is dominant on the PARALLELE 45 labels.
29. Applicant selected a trademark consisting of the identical numeric designation used and registered by Opposer for over 44 years on the very same goods, wine.
30. I know from my years of working in the U.S. wine market that Applicant's and Opposer's goods are likely to travel in identical trade channels, be sold in identical retail and wholesale outlets, and be purchased by the identical class of consumers.
31. I have visited Applicant's website at www.fortyfivenorth.com , and a copy of the homepage is attached hereto as Exhibit F, and seen additional representations of Applicant's mark. Opposer's PARALLELE 45 mark, also uses a red color for the 45 element of the mark, (see attached Exhibit G). Applicant and Opposer both depict the 45 element in red. In addition to the other mentioned similarities between the marks, I believe this too is likely to suggest to consumers a connection between Applicant and Opposer.
32. Based on my 32 years of professional experience in the U.S. wine market, I believe that wine purchasers are likely to confuse the marks PARALLELE 45 and 45. Specifically, purchasers of Opposer's goods are likely to believe that PARALLELE 45 and 45 wine come from the same source or related sources because of the similarity of the marks and identical nature of the goods.
33. Based upon my professional knowledge and experience in the wine industry, I know that Applicant's 45 wine would likely be sold to the same customers as PARALLELE 45 products. 45 wine and PARALLELE 45 wine would also travel in many of the same trade and distribution channels. In addition, PARALLELE 45 and 45 wines could be bought by the same ultimate customer.
34. I am aware of a number of wine partnerships between American and French winemakers. For example, Moet et Chandon, the renowned French producer of champagne in France, is associated with Domaine Chandon, a producer of wine in Napa Valley, California. The Californian winery Domaine Carneros was founded by the renowned French company Champagne Taittinger, and Opus One wine, a wine produced and vinted in California is the result of a joint venture between the American winery, Robert Mondavi and the renowned Bordeaux producer of French wines, Baroness Philippine de Rothschild. It is common knowledge within the wine industry, and even the general press, that producers of wine in France and producers of wine in the United States enter into joint business

relationships. I believe this fact would contribute to the likelihood that consumers could be confused, mistaken or deceived into believing that wine identified by the designation 45 and wine identified by the trademark PARALLELE 45 could come from the same source.

35. With my years of professional experience working in marketing and sales for Wildman on PARALLELE 45 brand, given the similarity of the 45 brand name to PARALLELE 45, the identical nature of the goods sold under each mark, and the similarity of the customers, I believe there is a high probability for confusion between these two marks.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge.

Executed on September 22nd, 2011.

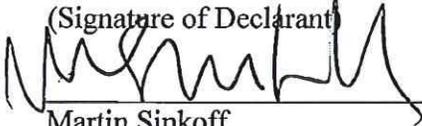
(Signature of Declarant)

Martin Sinkoff
Director of Marketing, Fine Wines
Frederick Wildman and Sons Ltd.

EXHIBIT A

**Status and title copy of Registration No. 2,682,366 for PARALLELE 45
Made of record with the Notice of Opposition**

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-09 14:33:39 ET

Serial Number: 76146225 Assignment Information Trademark Document Retrieval

Registration Number: 2682366

Mark (words only): PARALLELE 45

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2008-12-31

Filing Date: 2000-10-12

Transformed into a National Application: No

Registration Date: 2003-02-04

Register: Principal

Law Office Assigned: LAW OFFICE 101

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-12-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Paul Jaboulet Aine

Address:

Paul Jaboulet Aine
Les Jalets - RN7, La Roche De Glun
26600 Tain L'Hermitage
France

Legal Entity Type: Corporation

State or Country of Incorporation: France

GOODS AND/OR SERVICES

International Class: 033

Class Status: Active

wines

Basis: 1(a), 44(e)

First Use Date: 1978-00-00

First Use in Commerce Date: 1978-00-00

ADDITIONAL INFORMATION

Translation: The English translation of "PARALLELE" is "parallel".

Foreign Registration Number: 1240707

Foreign Registration Date: 1993-07-12

Country: France

Foreign Expiration Date: 2003-07-12

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-12-31 - Section 8 (6-year) accepted & Section 15 acknowledged

2008-12-15 - Assigned To Paralegal

2008-12-09 - TEAS Section 8 & 15 Received

2008-03-23 - Counter claim opp. for Proceeding No.

2008-02-06 - Case File In TICRS

2006-09-02 - Review Of Correspondence Complete

2006-08-21 - PAPER RECEIVED

2003-02-04 - Registered - Principal Register

2002-11-12 - Published for opposition

2002-10-23 - Notice of publication

2002-07-11 - Approved for Pub - Principal Register (Initial exam)

2002-05-08 - Communication received from applicant

2002-05-08 - PAPER RECEIVED

2002-02-01 - Final refusal mailed

2001-08-23 - Communication received from applicant

2001-03-13 - Non-final action mailed

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Lawrence E. Abelman

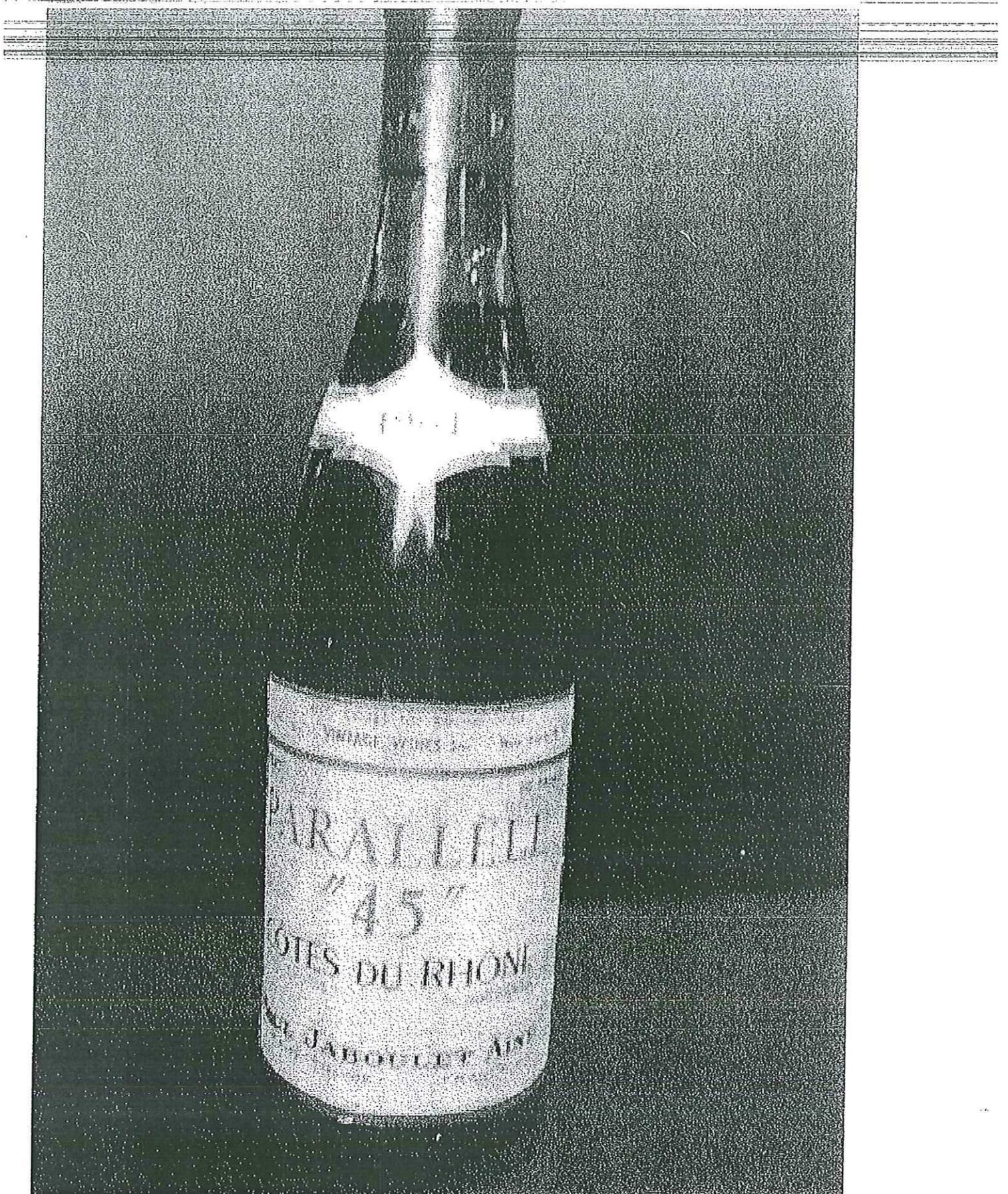
Correspondent

Lawrence E. Abelman
ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK NY 10017-5621
Phone Number: 212-9499022
Fax Number: 212-9499190

Domestic Representative

LAWRENCE E. ABELMAN
Phone Number: 212-9499022
Fax Number: 212-9499190

EXHIBIT B
Photograph of first bottle of
PARALLELE 45 sold in United States



JABOULET00001

EXHIBIT C
Applicant's response to Opposer's Interrogatory No. 5

INTERROGATORY NO. 3

- (a) Identify all persons who approved the selection of Applicant's MARK.
- (b) Describe the specific reasons for the selection of Applicant's MARK.

ANSWER:

- (a) Eric Grossnickle, Creative Director
- (b) Steve Grossnickle, Sole Member of Applicant, 1428 S. Freedom Parkway,
Winona Lake, Indiana 46590.

INTERROGATORY NO. 4

Identify all persons, including their business title and business address, who have final authority for the marketing, advertising and/or promotion of products for Applicant's MARK.

ANSWER:

Eric Grossnickle, Creative Director, 8580 E. Horn Road, Lake Leelanau, Michigan 49653.

Alanna Grossnickle, General Manager, 8580 E. Horn Road, Lake Leelanau, Michigan 49653.

INTERROGATORY NO. 5

- (a) Identify each purchaser and/or user of the products sold under Applicant's MARK, and describe the method of distribution. As used in this interrogatory "purchaser and/or user" refers to any class or classes of purchasers or users, such as may be identified by sex, age, economic status and geographic location and to the extent known, any breakdown which identifies the percentage of purchasers or users which fall into any of the

categories enumerated.

ANSWER:

Applicant objects to this interrogatory to the extent that it is overbroad and not reasonably limited so as to be calculated to lead to the discovery of admissible evidence in this proceeding. Without waiving this objection and inasmuch as the goods and services listed in Applicant's application are limited to "wine," with regard to "wine," Applicant responds to as follows:

Approximately 90% of Applicant's wine is sold to consumers over the age of 21. The majority of these people reside in Michigan, but purchasers have also come from Indiana, Illinois, Ohio, Colorado, California, Washington, Missouri, Iowa and other states.

Approximately 7% of Applicant's wine is sold through Elite Imperial Beverage in Michigan and Nelson Beverage in Warsaw, Indiana.

Approximately 3% of Applicant's wine is sold through local retailers in Leelanau and Grand Traverse counties in Michigan.

INTERROGATORY NO. 6

Describe the geographic area within the United States of the past and present distribution of the goods sold under Applicant's MARK.

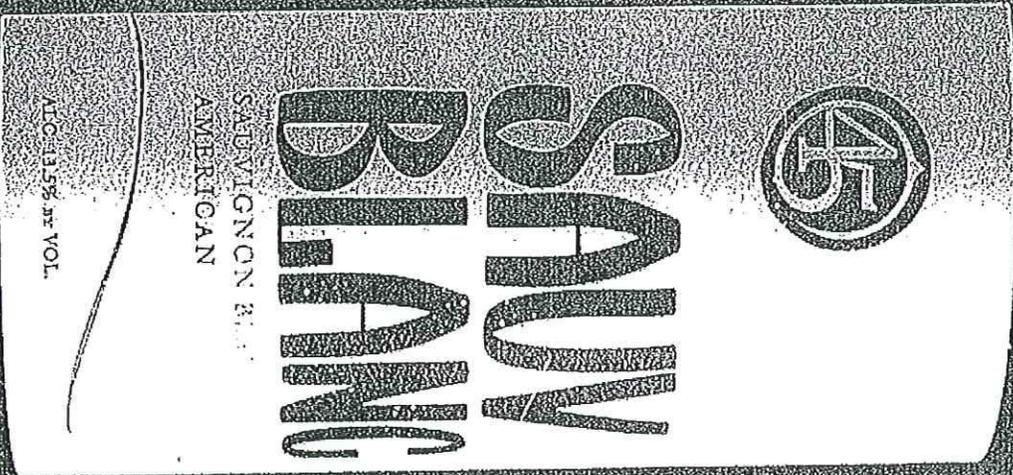
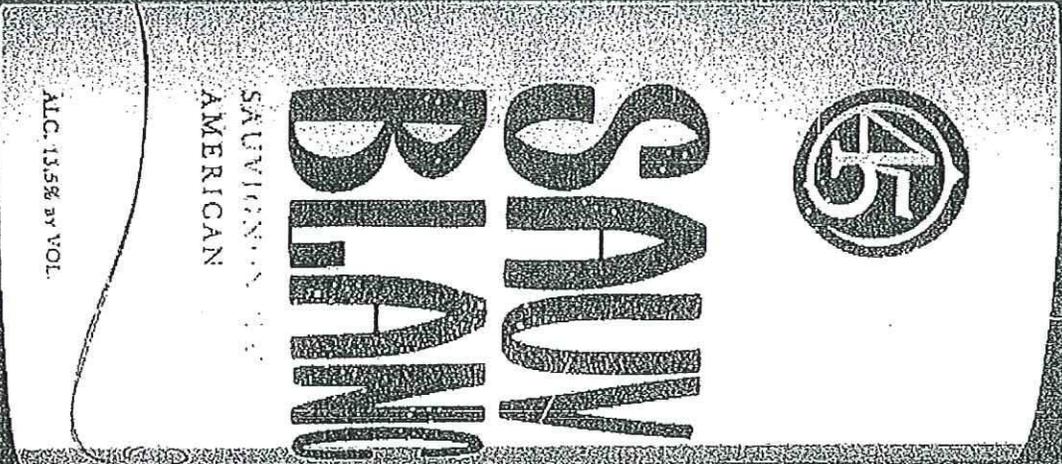
ANSWER:

Applicant objects to this interrogatory to the extent that it is overbroad and not reasonably limited so as to be calculated to lead to the discovery of admissible evidence in this proceeding. Without waiving this objection and inasmuch as the goods and services listed in Applicant's application are limited to "wine," with regard to "wine," Applicant responds to as follows:

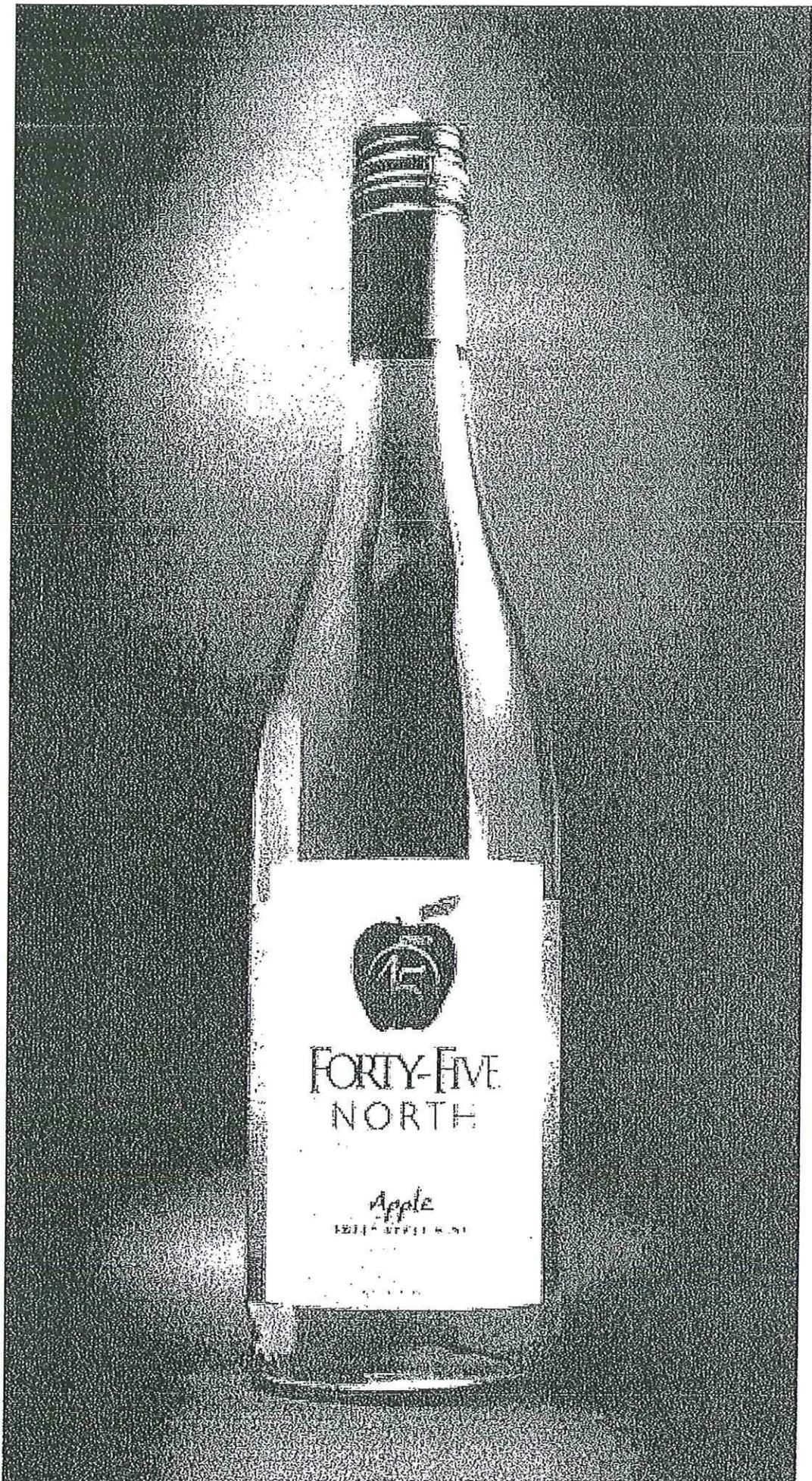
The vast majority of Applicant's wines are sold through Applicant's tasting room located at its winery in Lake Leelanau, Michigan. The balance are sold throughout Michigan and in

EXHIBIT D
Use of 45

G



G0151



G0139

SPECIAL OFFER
FOR E.G.T. READERS:
**RECEIVE 10% OFF
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NORTH**

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OPEN YEAR-ROUND
WINE TASTING PARTIES
CROSS-COUNTRY SKIING

8580 E Horn Rd, Lake Leelanau, MI, 49653
fortyfivenorth.com · 231-271-1188

EXHIBIT E
Applicant's Response to Interrogatory No. 11

Applicant's Mark are the instant Opposition proceeding and the prosecution of Applicant's application for registration of Applicant's Mark before the USPTO.

INTERROGATORY NO. 11

- (a) State when and how Applicant first learned of Opposer's use of Opposer's MARK.
- (b) Identify all documents which refer or relate to such knowledge.

ANSWER:

- (a) Opposer's use of Opposer's Mark was contained in the search results noted in response to Interrogatory No. 9.
- (b) The search results and correspondence from Applicant's counsel to Applicant.

INTERROGATORY NO. 12

Identify the documents in Applicant's possession or control referring or relating to Opposer.

ANSWER:

The search results noted in response to Interrogatory No. 9, and correspondence from Applicant's counsel to Applicant.

INTERROGATORY NO. 13

- (a) Has Applicant or any person acting for or on behalf of Applicant received any communication, oral or in writing, from any person which suggests, implies or infers that Opposer may be connected or associated with

EXHIBIT F

Home of the website www.fortyfivenorth.com

Forty-Five North Vineyard & Winery (/)

Thanks for Visiting...

Forty-Five North Vineyard & Winery, located in the heart of beautiful Leelanau County, Michigan, is a family-owned producer of many award-winning wines.

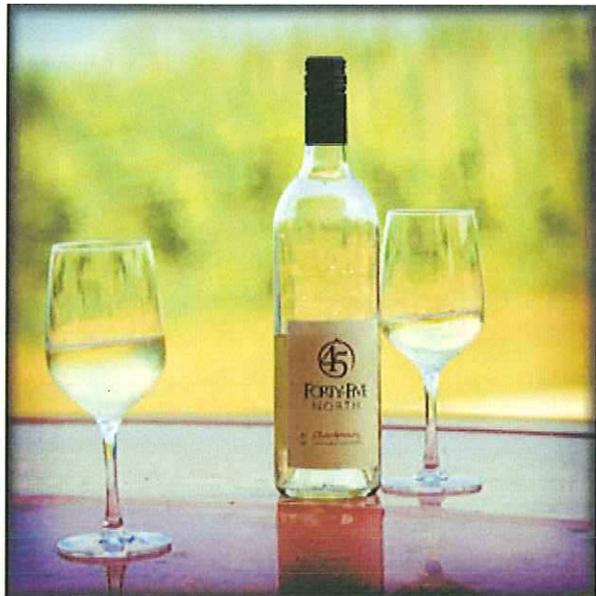


Northern Michigan has offered the best of a vacation end point for three generations of Grossnickles. The Traverse City area provides the midwest with perhaps the best in hiking, swimming, boating, golfing, and a just plain relaxing atmosphere for all ages. And hence, was visited... [Continue reading](#) → [\(/about/\)](#)

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