

ESTTA Tracking number: **ESTTA399050**

Filing date: **03/21/2011**

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	Casella Wines Pty Ltd.		
Entity	Corporation	Citizenship	Australia
Address	1471 Wakley Road Yenda, NSW 26 AUSTRALIA		

Attorney information	Alfred Zaher Blank Rome, LLP One Logan Square Philadelphia, PA 19103 UNITED STATES dwyer-s@blankrome.com Phone:571-213-0870		
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Applicant Information

Application No	85183731	Publication date	02/22/2011
Opposition Filing Date	03/21/2011	Opposition Period Ends	03/24/2011
Applicant	Diageo North America, Inc. 801 Main Avenue Norwalk, CT 06851 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Alcoholic beverages except beers

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.	3578511	Application Date	06/22/2007
Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	YELLOW TAIL		

Design Mark	YELLOW TAIL
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2001/06/00 First Use In Commerce: 2001/06/00 Wine

U.S. Registration No.	2696372	Application Date	12/12/2000
Registration Date	03/11/2003	Foreign Priority Date	NONE
Word Mark	[YELLOW TAIL]		
Design Mark	[yellow tail]		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 Wine		

Attachments	77212872#TMSN.jpeg (1 page)(bytes) 76179270#TMSN.gif (1 page)(bytes) Notice of Opposition.pdf (19 pages)(276230 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	/Sean W. Dwyer/
Name	Sean W. Dwyer
Date	03/21/2011

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

Casella Wines Pty Ltd.	:	
an Australian corporation,	:	
	:	
Opposer,	:	Serial No.: 85/183,731
	:	
v.	:	Opposition No.: _____
	:	
Diageo North America, Inc.	:	
a Connecticut Corporation	:	
	:	
Applicant.	:	
	:	

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

Attn.: Trademark Trial and Appeal Board

Madam:

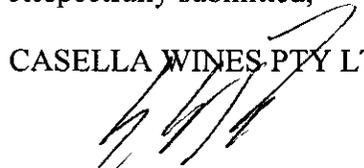
Pursuant to Federal Rule of Civil Procedure 15(a) and 37 C.F.R. § 2.101 et seq., Opposer respectfully requests that the Board accept the enclosed Notice of Opposition against the mark BLUETAIL. We respectfully request that the above-indicated Notice of Opposition be instituted and that, in due course, notification be sent regarding answer dates and testimony periods. Please charge our Deposit Account No. 02-2555 for fees due in connection with the filing of this Notice of Opposition.

Respectfully submitted,

CASELLA WINES PTY LTD.

Date: March 21, 2011

By:



Alfred W. Zaher
David M. Perry
Sean W. Dwyer
Its Attorneys

BACKGROUND ON OPPOSER'S MARKS

1. Opposer has made continuous and extensive use of the following distinctive marks comprised in whole or in part of the words "YELLOW TAIL" (collectively, hereinafter The YELLOW TAIL Mark"): YELLOW TAIL; [YELLOW TAIL]; [YELLOW TAIL] (Stylized); and YELLOW TAIL and Design, which use has developed widespread public recognition and appeal. Opposer has used The YELLOW TAIL Mark on or in connection with a variety of goods, including without limitation, wine and related merchandise (hereinafter, "The Goods").

2. Opposer is the exclusive owner of all rights, title and interest in and to The YELLOW TAIL Mark and is the owner of various U.S. applications and registrations for the same, including, (among others):

YELLOW TAIL U.S. Registration No. 3,578,511; and

[yellow tail]

U.S. Registration No. 2,696,372 (printouts attached).

Opposer's registrations are valid and subsisting and are conclusive evidence of Opposer's exclusive right to use The YELLOW TAIL Mark in commerce for The Goods and for those within their zone of natural expansion.

3. Through extensive and continuous use of The YELLOW TAIL Mark, the Mark has become famous and acquired substantial goodwill in connection with The Goods.

4. Opposer's extensive marketing, promotion and use of The YELLOW TAIL Mark in commerce since at least as early as June 1, 2001, has caused customers, prospective purchasers, and the public generally to immediately associate The YELLOW TAIL Mark with Opposer and to expect a wide variety of goods bearing The YELLOW TAIL Mark to have a connection with, or association with, Opposer.

**APPLICANT'S MARK IS LIKELY TO CAUSE CONFUSION
AS TO SOURCE, ORIGIN, SPONSORSHIP, OR AFFILIATION**

5. Opposer repeats and realleges the allegations contained in paragraphs 1 through 4 above, as if fully set forth herein.

6. On November 23, 2010, Applicant filed application No. 85/183,731 for registration of the mark BLUETAIL (hereinafter "Applicant's Mark") for "alcoholic beverages except beers." Applicant's Mark was published for opposition in the Official Gazette of February 22, 2011 (printouts attached).

7. Applicant's basis for filing is intent to use, pursuant to Section 1(b) of the Lanham Act.

8. Opposer's use of The YELLOW TAIL Mark predates Applicant's filing date.

9. Applicant's Mark BLUETAIL is confusingly similar to The YELLOW TAIL Mark owned by Opposer.

10. The use and registration of Applicant's Mark to identify its goods is likely to cause confusion, mistake and deception as to the source, origin, sponsorship or association of the goods and will injure Opposer.

11. Any defects, objections or faults found with the goods sold and rendered by Applicant under Applicant's Mark, because of the false association with Opposer, would inflict upon and seriously injure the reputation of Opposer.

12. The grant of a Certificate of Registration to Applicant for Applicant's Mark would be inconsistent with and in derogation of Opposer's prior rights and would therefore cause damage and injury to Opposer and deception of and confusion to the public.

**APPLICANT'S MARK IS LIKELY TO DILUTE
THE DISTINCTIVE QUALITY OF OPPOSER'S FAMOUS MARKS**

13. Opposer repeats and realleges the allegations contained in paragraphs 1 through 12 above, as if fully set forth herein.

14. At all times prior to the both Applicant's application to register Applicant's Mark and any use of Applicant's Mark by Applicant, Opposer's YELLOW TAIL Mark was distinctive and had already become famous.

15. The fame and high degree of recognition afforded to Opposer's Mark is evident in the significant duration, extent and geographic reach of advertising and publicity bearing the mark; widespread and extraordinary sales of The Goods bearing The YELLOW TAIL Mark; widespread recognition of The YELLOW TAIL Mark among the general consuming public; and the registration of The YELLOW TAIL Mark accorded on the Principal Register.

16. That Applicant's Mark is likely to cause dilution by blurring is evident in the high degree of similarity or identicalness between Applicant's Mark and The YELLOW TAIL Mark; the high degree of inherent and acquired distinctiveness of The YELLOW TAIL Mark; the substantially exclusive use of The YELLOW TAIL Mark on the Goods; the extraordinary degree of recognition accorded to The YELLOW TAIL Mark by the general consuming public; the apparent intent of Applicant to create an association with The YELLOW TAIL Mark; and any actual association between Applicant's Mark and The YELLOW TAIL Mark that would be established during discovery.

17. The use and registration of Applicant's Mark to identify its goods, after The YELLOW TAIL Mark had become famous, is therefore likely to cause dilution by blurring or dilution by tarnishment of The YELLOW TAIL Mark, regardless of the presence or absence of actual or likely confusion, competition, or of actual economic injury, and will injure Opposer.

18. Any defects, objections or faults found with the goods sold and rendered by Applicant under Applicant's Mark, because of the false association with Opposer, would inflict upon and seriously injure the reputation of Opposer.

19. The grant of a Certificate of Registration to Applicant for Applicant's Mark would be inconsistent with and in derogation of Opposer's prior rights and would therefore cause damage and injury to Opposer and deception of and confusion to the public.

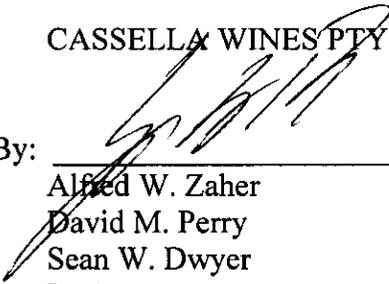
For the reasons set forth in the foregoing paragraphs one through twenty-one, Opposer believes that it would be damaged by the registration of Applicant's Mark, and thus Applicant should be denied registration of the mark.

WHEREFORE, Opposer prays that this opposition be sustained and that Application Serial No. 85/183,731 be refused registration.

Respectfully submitted,

CASELLA WINES PTY LTD.

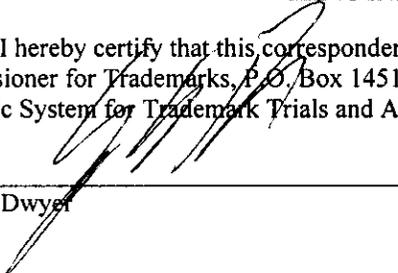
Date: March 21, 2011

By: 
Alfred W. Zaher
David M. Perry
Sean W. Dwyer
Its Attorneys

BLANK ROME LLP
ONE LOGAN SQUARE
PHILADELPHIA, PA 19103
(215) 569-5767

CERTIFICATE OF ELECTRONIC FILING

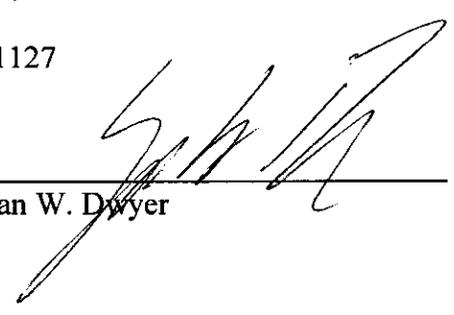
I hereby certify that this correspondence is addressed to the Trademark Trial and Appeal Board, Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, and is being deposited via the Electronic System for Trademark Trials and Appeals (ESTTA) on March 21, 2011.


Sean W. Dwyer

CERTIFICATE OF SERVICE

I, Sean W. Dwyer, do hereby certify that I have on March 21, 2011, mailed via first class mail, the foregoing Notice of Opposition to the following:

Lauren Mandell
Diagio North America, Inc.
801 Main Ave.
Norwalk, CT 06851-1127



Sean W. Dwyer

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Serial Number: 77212872 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3578511

Mark

YELLOW TAIL

(words only): YELLOW TAIL

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2009-02-24

Filing Date: 2007-06-22

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: 2009-02-24

Register: Principal

Law Office Assigned: LAW OFFICE 112

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: 650 -Publication And Issue Section

Date In Location: 2009-02-24

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

1. Casella Wines Pty Ltd.

Address:

Casella Wines Pty Ltd.
1471 Wakley Road
Yenda NSW2681
Australia

Legal Entity Type: Corporation**State or Country of Incorporation:** Australia

GOODS AND/OR SERVICES

International Class: 033**Class Status:** Active

Wine

Basis: 1(a)**First Use Date:** 2001-06-00**First Use in Commerce Date:** 2001-06-00

ADDITIONAL INFORMATION

Prior Registration Number(s):

2696372

2862612

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.

2009-02-24 - Registered - Principal Register

2009-01-21 - TTAB Release Case To Trademarks

2009-01-21 - Opposition terminated for Proceeding

2009-01-21 - Opposition dismissed for Proceeding

2008-03-06 - Opposition instituted for Proceeding

2007-11-07 - Extension Of Time To Oppose Received

2007-11-06 - Published for opposition
2007-10-17 - Notice of publication
2007-10-01 - Law Office Publication Review Completed
2007-09-26 - Approved for Pub - Principal Register (Initial exam)
2007-09-23 - Assigned To Examiner
2007-07-19 - Applicant amendment prior to exam entered
2007-07-19 - Assigned To LIE
2007-07-03 - TEAS Voluntary Amendment Received
2007-06-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

David M. Perry

Correspondent

DAVID M. PERRY
BLANK ROME LLP
ONE LOGAN SQUARE 9TH FLOOR
PHILADELPHIA, PA 19103-6998
Phone Number: (215) 569-5767
Fax Number: (215) 832-5767



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No assignment has been recorded at the USPTO

For Serial Number: 77212872

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Web interface last modified: Apr 30, 2009 v.2.1

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Serial Number: 76179270 Assignment Information Trademark Document Retrieval

Registration Number: 2696372

Mark

[yellow tail]

(words only): [YELLOW TAIL]

Standard Character claim: No

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

Date of Status: 2008-09-12

Filing Date: 2000-12-12

Transformed into a National Application: No

Registration Date: 2003-03-11

Register: Principal

Law Office Assigned: LAW OFFICE 108

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: 2008-09-12

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

1. Casella Wines Pty Ltd.

Address:

Casella Wines Pty Ltd.
Farm 1471 Wakley Road
YENDA NSW 2681
Australia
Legal Entity Type: Corporation
State or Country of Incorporation: Australia

GOODS AND/OR SERVICES

International Class: 033
Class Status: Active
Wine
Basis: 1(a)
First Use Date: 2001-06-01
First Use in Commerce Date: 2001-06-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

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.

2008-09-12 - Section 8 (6-year) accepted & Section 15 acknowledged
2008-09-12 - Assigned To Paralegal
2008-09-11 - TEAS Section 8 & 15 Received
2006-08-18 - Attorney Revoked And/Or Appointed
2006-08-18 - TEAS Revoke/Appoint Attorney Received
2003-03-11 - Registered - Principal Register
2003-01-06 - Allowed for Registration - Principal Register (SOU accepted)
2002-12-30 - Assigned To Examiner
2002-12-10 - Statement Of Use Processing Complete

2002-10-24 - Use Amendment Filed
2002-10-25 - PAPER RECEIVED
2002-08-06 - NOA Mailed - SOU Required From Applicant
2002-04-02 - Published for opposition
2002-03-13 - Notice of publication
2001-09-24 - Approved For Pub - Principal Register
2001-05-29 - Communication received from applicant
2001-05-02 - Non-final action mailed
2001-04-18 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Alfred W. Zaher

Correspondent

Alfred W. Zaher

Blank Rome LLP

9th Floor

One Logan Square

Philadelphia PA 19103-6998

Phone Number: 215-569-5364

Fax Number: 215-832-5364

Domestic Representative

Timothy D. Pecsénye, Alfred W. Zaher, David M. Perry, Emily J. Barnhart, Bruce D. George, Lisa Casey Spaniel, Megan E. Spitz, and Zachary A. Aria



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For Serial Number: 76179270

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Serial Number: 85183731 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

BLUETAIL

(words only): BLUETAIL

Standard Character claim: Yes

Current Status: Application has been published for opposition. The opposition period begins on the date of publication.

Date of Status: 2011-02-22

Filing Date: 2010-11-23

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

The Information will be/was published in the Official Gazette on 2011-02-22

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

Attorney Assigned:
YAO GRETTA

Current Location: 650 -Publication And Issue Section

Date In Location: 2011-01-15

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

1. Diageo North America, Inc.

Address:

Diageo North America, Inc.
801 Main Avenue
Norwalk, CT 06851
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Connecticut**Phone Number:** 203.229.4750**Fax Number:** 203.845.5925

GOODS AND/OR SERVICES

International Class: 033**Class Status:** Active

Alcoholic beverages except beers

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

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.

2011-02-22 - Notice Of Publication E-Mailed

2011-02-22 - Published for opposition

2011-01-15 - Law Office Publication Review Completed

2011-01-14 - Assigned To LIE

2010-12-24 - Approved For Pub - Principal Register

2010-12-24 - Assigned To Examiner

2010-11-30 - Notice Of Pseudo Mark Mailed

2010-11-29 - New Application Office Supplied Data Entered In Tram

2010-11-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Lauren Mandell

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DIAGEO

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NORWALK, CT 06851-1127

Phone Number: 203.229.4750

Fax Number: 203.845.5925



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