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

Proceeding	91203879
Party	Defendant Department 28, Inc
Correspondence Address	CHRISTOPHER DITICO RAJ ABHYANKER PC 1580 W EL CAMINO REAL STE 8 MOUNTAIN VIEW, CA 94040-2462 UNITED STATES trademarks@rajpatent.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Mark E. Wiemelt
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Signature	/mew/
Date	03/20/2012
Attachments	Motion to Suspend Proceeding TRAVELLER BLACK EDITION VODKA.pdf (16 pages)(839783 bytes)

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

SAZERAC COMPANY, INC.)	
)	Opposition No. 91203879
Opposer,)	
)	Mark : TRAVELLER BLACK
)	EDITION VODKA
v.)	
)	
DEPARTMENT 28, INC.)	Serial No.: 85/371,749
)	
Applicant.)	Published: October 18, 2011

MOTION TO SUSPEND PROCEEDINGS

Applicant, DEPARTMENT 28, INC., by and through its attorneys, in accordance with Rule 2.127 of the Trademark Rules of Practice, requests that proceedings be suspended pending determination of a civil action between Opposer and Applicant pending in the United States District Court for the Northern District of Illinois (Civil Action No. 12 C 1828), a copy of the Complaint is attached hereto. In that action, Applicant seeks a declaration that no trademark rights of Opposer are infringed by Applicant's use of its TRAVELLER BLACK EDITION VODKA Mark, *inter alia*. Applicant further seeks an order that Opposer be enjoined, *inter alia*, from prosecuting any action in any other Court to prevent Applicant from using or registering the TRAVELLER BLACK EDITION VODKA Mark. Because the outcome of that civil action may have a bearing on this Opposition, Applicant respectfully submits that suspension is warranted.

Respectfully submitted,

DEPARTMENT 28, INC.

s/ Mark E. Wiemelt

Mark E. Wiemelt

One of Its Attorneys

Mark E. Wiemelt,

Wiemelt Knechtel

10 S. LaSalle St., Ste. 3500

Chicago, IL 60603

(312) 372-7664

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

DEPARTMENT 28, INC., an Illinois corporation,)	
)	
Plaintiff,)	
)	
v.)	
)	
SAZERAC COMPANY, INC., a Louisiana corporation,)	
)	<u>JURY DEMANDED</u>
Defendant.)	

COMPLAINT FOR DECLARATORY JUDGMENT OF NON-INFRINGEMENT

Plaintiff, DEPARTMENT 28, INC. (hereinafter “DEPARTMENT 28”), by and through its attorney, Mark E. Wiemelt, of WIEMELT KNECHTEL, alleges its complaint against Defendant SAZERAC COMPANY, INC. (hereinafter “SAZERAC”) as follows:

NATURE OF THE ACTION

1. This is an action for declaratory relief of non-infringement under the Trademark Laws of the United States, 15 U.S.C. § 1051, et seq., and 28 U.S.C. §§ 2201 and 2202.

JURISDICTION AND VENUE

2. This Court has jurisdiction over this action under the provisions of 28 U.S.C. § 1332(a) in that this is an action between citizens of different states in which the value of the amount in controversy exceeds \$75,000.00, exclusive of interest and costs, 15 U.S.C. § 1121 (trademark), 28 U.S.C. §§ 1331 (federal question jurisdiction) and 1338(a)(original jurisdiction under Trademark Laws of the United States) in that this case arises under the Trademark Laws of the United States, 15 U.S.C. § 1051, et seq., and 28 U.S.C. §§ 2201 and 2202 in that this case is for declaratory judgment.

3. This Court had personal jurisdiction pursuant to Ill. Rev. Stat., ILCS, Ch. 735, §§ 5/2-208 and 5/2-209.

4. Upon information and belief, Defendant transacts business within the State of Illinois and specifically within this judicial district.

THE PARTIES

5. Plaintiff DEPARTMENT 28, INC., an Illinois corporation, has its headquarters and principal place of business located at 1169 Tower Road, Schaumburg, IL 60173.

6. On information and belief, Defendant SAZERAC COMPANY, INC. is a Louisiana corporation having its principal place of business located at 3850 N. Causeway Boulevard, Suite 1695, Metairie, Louisiana 70002.

7. Upon information and belief, SAZERAC is transacting business in this jurisdiction.

FACTS COMMON TO ALL COUNTS

8. Beginning in 2011 and continuing since then, DEPARTMENT 28 adopted and has used in commerce the term TRAVELLER, alone and in combination with other terms and/or designs, on and in connection with vodka. Representative samples of DEPARTMENT 28's current uses of the term TRAVELLER in connection with vodka are attached hereto as Exhibit A.

9. On May 12, 2011, DEPARTMENT 28 filed Application Serial No. 85/319,458 in the United States Patent and Trademark Office (USPTO) seeking registration of TRAVELLER28 VODKA for "vodka".

10. On July 14, 2011, DEPARTMENT 28 filed Application Serial No. 85/371,749 in the USPTO seeking registration of TRAVELLER BLACK EDITION VODKA for "vodka".

11. On October 18, 2011, the USPTO published Application Serial No. 85/371,749 in the Trademark Official Gazette.

12. On October 25, 2011, the USPTO published Application Serial No. 85/319,458 in the Trademark Official Gazette.

13. On October 28, 2011, SAZERAC filed a Request for Extension of Time to Oppose Application Serial No. 85/371,749 in the USPTO.

14. On October 28, 2011, the USPTO granted SAZERAC's Request for Extension of Time to Oppose Application Serial No. 85/371,749, extending the time to oppose to February 22, 2012.

15. On October 28, 2011, SAZERAC filed a Request for Extension of Time to Oppose Application Serial No. 85/319,458 in the USPTO.

16. On October 28, 2011, the USPTO granted SAZERAC's Request for Extension of Time to Oppose Application Serial No. 85/319,458, extending the time to oppose to February 22, 2012.

15. On November 11, 2011, SAZERAC again filed a Request for Extension of Time to Oppose Application Serial No. 85/319,458 in the USPTO.

16. On November 11, 2011, the USPTO again granted SAZERAC's Request for Extension of Time to Oppose Application Serial No. 85/319,458, extending the time to oppose to February 22, 2012.

17. Counsel for SAZERAC mailed a letter to counsel for DEPARTMENT 28 dated January 13, 2012, alleging ownership of the mark TRAVELERS CLUB for distilled spirits and alcoholic beverages, referencing its U.S. Registration No. 852889 for the mark TRAVELERS

CLUB for “whiskey” and U.S. Application Serial No. 85/413234 for the mark TRAVLERS CLUB for “gin and vodka.” A copy of the letter is attached hereto as Exhibit B.

18. The January 13, 2012 letter claimed that DEPARTMENT 28’s TRAVELLER28 VODKA (Serial No. 85/319,458) and TRAVELLER BLACK EDICITON VODKA (Serial No. 85/371,749) (the “TRAVELLER marks”) are likely to create consumer confusion with SAZERAC’s TRAVELERS CLUB marks.

19. The January 13, 2012 letter stated that SAZERAC required that DEPARTMENT 28 “[e]xpressly abandon its applications for TRAVELLER28 VODKA (Serial No. 85/319,458) and TRAVELLER BLACK EDICITON VODKA (Serial No. 85/371,749) before the U.S. Patent and Trademark Office...”.

20. The January 13, 2012 letter stated that SAZERAC required that DEPARTMENT 28 “[t]ake all steps to ensure that there will be no use of the TRAVELLER marks, and any other variants, translations or transliterations of the mark, in connection with the sale of alcoholic beverage in the United States...”.

21. The January 13, 2012 letter demanded written assurances no later than February 10, 2012 that DEPARTMENT 28 had abandoned its applications for, and ceased all use of, the TRAVELLER marks in the United States.”

22. The January 13, 2012 letter stated that SAZERAC “reserves the right to pursue any and all remedies it may have to protect its interests.”

23. DEPARTMENT 28 responded to the January 13, 2012 letter with a letter dated February 2, 2012.

24. On February 15, 2012, SAZERAC filed a Notice of Opposition of Application Serial No. 85/371,749 in the USPTO, asserting that DEPARTMENT 28’s TRAVELLER

BLACK EDITION VODKA mark is likely to create consumer confusion with the alleged SAZERAC's TRAVELERS CLUB marks, thereby initiating Opposition No. 91203879 before the United States Trademark Trial and Appeal Board.

25. On February 22, 2012, SAZERAC filed a Notice of Opposition of Application Serial No. 85/319,458 in the USPTO, asserting that DEPARTMENT 28's TRAVELLER28 VODKA mark is likely to create consumer confusion with the alleged SAZERAC's TRAVELERS CLUB marks, thereby initiating Opposition No. 91203988 before the United States Trademark Trial and Appeal Board.

27. This action involves a case of actual controversy over alleged infringement of trademark rights allegedly owned by the SAZERAC.

28. SAZERAC's activities have placed DEPARTMENT 28 under a reasonable apprehension that DEPARTMENT 28 will be sued for what SAZERAC believes is the infringement of trademark rights allegedly owned by the SAZERAC. Based on the legal actions, accusations of infringement by SAZERAC, and threat of additional legal action, there now exists a justiciable case and controversy for adjudication by the Court.

COUNT I

DECLARATORY JUDGMENT OF NON-INFRINGEMENT

29. DEPARTMENT 28 adopts the allegations of Paragraphs 1-29 as if fully alleged herein and further alleges as follows:

30. SAZERAC through its filing of the Opposition litigation and its allegations of trademark infringement, legal actions and threats of additional legal action, has created case of actual controversy and a real and reasonable apprehension that DEPARTMENT 28 will be subject to liability if it continues to use any of the TRAVELLER marks.

31. DEPARTMENT 28's uses of the TRAVELLER marks in connection with vodka does not infringe the alleged SAZERAC's TRAVELERS CLUB marks.

32. DEPARTMENT 28's uses of the TRAVELLER marks are distinctly different from the alleged SAZERAC's TRAVELERS CLUB marks.

33. DEPARTMENT 28's uses of the TRAVELLER marks are not likely to cause confusion in the minds of the public with respect to the alleged SAZERAC's TRAVELERS CLUB marks.

34. Upon information and belief, there are a myriad of adoptions, registrations and uses of the term TRAVELLER, and variants, translations or transliterations of the term, for goods related to the goods of SAZERAC and DEPARTMENT 28, as well as a variety of non-competing goods and services. As such, any trademark rights that SAZERAC may have are narrowly circumscribed to the goods sold by SAZERAC in connection with its alleged SAZERAC's TRAVELERS CLUB marks and any other use would not lead to a likelihood of confusion.

35. There is a justiciable controversy between the parties concerning DEPARTMENT 28's liability for alleged the infringement of trademark rights allegedly owned by the SAZERAC, and SAZERAC's right to charge DEPARTMENT 28 with infringement. The Opposition litigation, threatened additional legal action, and charges of infringement noted above have caused and threaten further to cause injury to DEPARTMENT 28, including litigation costs and attorneys' fees. Such acts likely will occur, and continue to occur, unless enjoined by this Court.

RELIEF SOUGHT

WHEREFORE Plaintiff DEPARTMENT 28 prays:

A. For a declaration that no trademark rights of Defendant SAZERAC are infringed by Plaintiff DEPARTMENT 28's use of the term TRAVELLER, alone and in combination with other terms and/or designs, on and in connection with vodka;

B. Defendant SAZERAC be permanently enjoined from asserting or threatening to assert infringement against Plaintiff DEPARTMENT 28, from engaging in acts or conduct which suggests in any way that Defendant SAZERAC has the right to curtail any activity of Plaintiff DEPARTMENT 28, and from prosecuting any action in any other Court to prevent Plaintiff DEPARTMENT 28 from using or registering the term TRAVELLER, alone and in combination with other terms and/or designs, on and in connection with vodka;

C. For a recovery of damages adequate to compensate Plaintiff DEPARTMENT 28 for Defendant SAZERAC's allegations of infringement;

D. For an assessment against Defendant SAZERAC of Plaintiff DEPARTMENT 28's costs and attorneys' fees and expenses due to the exceptional nature of this case;

E. For recovery of damages for the time diverted and expenses incurred in responding to Defendant SAZERAC's threats of infringement and litigation; and

F. For such other and further relief as the Court may deem appropriate or just, including but not limited to punitive damages.

JURY DEMAND

Plaintiff hereby demands a trial by jury in the above-captioned action.

Dated: March 13, 2012

Respectfully submitted,

DEPARTMENT 28, INC.

By: s/ Mark E. Wiemelt
One of Its Attorneys

Mark E. Wiemelt - IL. Atty. #: 06208213

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EXHIBIT A

TRAVELLER VODKA

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Info

Collection



Traveller Vodka 750ml

- 40% alc/vol (80 proof)
- 750ml (25 fl oz)
- 100% neutral spirits distilled from rye
- distilled 4 times
- filtered 2 times
- etched glass bottle with transparent elements
- synthetic cork closure
- tin sleeve

Traveller Black Edition Vodka 750ml

- 40% alc/vol (80 proof)
- 750ml (25 fl oz)
- 100% neutral spirits distilled from rye
- distilled 4 times
- filtered 3 times
- etched glass bottle with transparent elements
- synthetic cork closure
- tin sleeve
- bottle packed in embossed tin tube

Traveller Vodka 50ml

- 40% alc/vol (80 proof)
- 50ml (1.6 fl oz)
- 100% neutral spirits distilled from rye
- distilled 4 times
- filtered 2 times
- frosted glass bottle
- aluminum cap closure

Traveller Vodka - always a smooth journey!

EXHIBIT B



FACSIMILE

TO:	Phone Number:	Fax Number:
Raj Abhyanker Raj Abhyanker, P.C.		(650) 989-2131

FROM:		<i>FOR COOLEY USE ONLY</i>
Heather Dunn Navarro		REQUESTOR NUMBER:
Sender's Direct Line:	+1 650 843 5649	12685
Reply Fax Number:	+1 650 849 7400	CLIENT MATTER:
Total Pages Including Cover:	3	304566-109

DELIVERY: Originals Will Follow By Regular Mail
DATE: January 13, 2012
RE: Department28 Trademarks

COMMENTS:

If you do not receive all of the pages or find that they are illegible, please call Julie Correll at (650) 843-5848.

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1

Heather Dunn Navarro
T: +1 650 843 5649
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VIA MAIL AND FACSIMILE
650-989-2131

January 13, 2012

Raj Abhyanker
Raj Abhyanker, P.C.
1580 W. El Camino Real, Suite 8
Mountain View, CA 94040-2462

**RE: Department28 Trademarks:
TRAVELLER28 VODKA and
TRAVELLER BLACK EDITION VODKA**

Dear Mr. Abhyanker:

Our firm represents Sazerac Company, Inc. and its subsidiaries ("Sazerac") in trademark and branding matters. It has come to our attention that your client, Department28, Inc., has filed intent to use applications in the U.S. Patent and Trademark Office for the marks TRAVELLER28 VODKA (Serial No. 85/319,458) and TRAVELLER BLACK EDITION VODKA (Serial No. 85/371,749), both intended for use on and in connection with "vodka" (collectively, the "TRAVELLER marks").

Since at least as early as June 10, 1964, Sazerac and its wholly-owned subsidiary, Majestic Distilling Company, Inc., have been using the TRAVELERS CLUB mark on and in connection with distilled spirits and alcoholic beverages in interstate commerce. Sazerac and its subsidiary own the following registration and application in the United States:

TRAVELERS CLUB (U.S. Reg. No. 0852889) for "whiskey", and

TRAVELERS CLUB (Serial No. 85/413,234) for "gin and vodka."

Sazerac has invested substantial resources in promoting the TRAVELERS CLUB products which has resulted in significant industry and consumer recognition and valuable goodwill in the distilled spirits markets.

Sazerac is committed to protecting its trademarks and the goodwill they have engendered. Given the visual and phonetic similarities of your client's TRAVELLER marks and Sazerac's TRAVELERS CLUB marks, the overlap in products, and the similarity in marketing channels, your client's TRAVELLER marks are likely to create consumer confusion. Customers are likely to conclude that your client's vodkas are offered by, or are affiliated with, Sazerac. Accordingly, we require that Department28:

1) Expressly abandon its applications for TRAVELLER28 VODKA (Serial No. 85/319,458) and TRAVELLER BLACK EDITION VODKA (Serial No. 85/371,749) before the U.S. Patent and Trademark Office;

Raj Abhyanker
January 13, 2012
Page Two

2) Take all steps to ensure that there will be no use of the TRAVELLER marks, and any other variants, translations or transliterations of the mark, in connection with the sale of alcoholic beverages in the United States; and

3) Confirm in writing to the undersigned no later than February 10, 2012 that you agree to the terms set forth in 1) and 2) above.

We are hopeful that this matter can be resolved amicably, and look forward to receiving your written assurances that your client has abandoned its application for, and ceased all use of, the TRAVELLER marks in the United States.

Sazerac reserves the right to pursue any and all remedies it may have to protect its interests. Should you wish to discuss this matter further, please feel free to contact me directly at the number above.

Sincerely,

COOLEY LLP



Heather Dunn Navarro

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