

ESTTA Tracking number: **ESTTA464723**

Filing date: **03/30/2012**

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	Vinicola Del Norte, S.A.,
Granted to Date of previous extension	03/31/2012
Address	Ave. John F Kennedy esquina Tiradentes Santo Domingo, DOMINICAN REPUBLIC
Attorney information	Ruben Alcoba Alcoba & Associates, P.A. 3399 NW 72 Avenue, Suite 211 Miami, FL 33122 UNITED STATES alcoba@miamipatents.com, jalcoba@miamipatents.com, ckirsch@southfloridatrademarks.com Phone:305.362.8118

Applicant Information

Application No	85397427	Publication date	01/31/2012
Opposition Filing Date	03/30/2012	Opposition Period Ends	03/31/2012
Applicant	Cofresi Rum Company LLC 3rd Floor 499 Canal Street New York, NY 10013 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Rum; rum-based alcoholic beverages

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85440979	Application Date	10/06/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COFRESI		

Design Mark	<h1>COFRESI</h1>
Description of Mark	NONE
Goods/Services	Class 033. First use: Rum

Attachments	85440979#TMSN.jpeg (1 page)(bytes) COFRESI OPPOSITION WITH EXHIBITS.pdf (12 pages)(3009339 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	/Ruben Alcoba/
Name	Ruben Alcoba
Date	03/30/2012

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

In the Matter of Application Serial No. 85/397,427
Published in the Official Gazette of January 31, 2012

Vinicola Del Norte, S.A .)	
)	
Opposer,)	Opposition No.
)	Mark: COFRESI
v.)	
)	
Cofresi Rum Company, LLC,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Vinicola Del Norte, S.A. (“Opposer”) believes that it will be damaged by registration of the mark shown in Application Serial No. 85/397427, and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of the country of the Dominican Republic, with a principal place of business at Avenue John F. Kennedy esquina Tiradentes, Santo Domingo, Dominican Republic. Opposer is, and has been, since 1962, engaged in the manufacturing, selling, and distribution of alcoholic beverages including Rum. Since 2005, Opposer has marketed and sold alcoholic beverages, under the trademark COFRESI (the “COFRESI Mark”) in the Dominican Republic.

2. Opposer owns all right, title and interest in and to the COFRESI Mark, as well as the following Dominican registrations of its COFRESI Mark and United States applications based therefrom currently pending before the United States Patent and Trademark Office:

- i. Dominican Registration No. 14,814 granted January 04, 2005, for the mark COFRESI in International Class 33 for “Alcoholic Beverages”;
- ii. Dominican Registration No. 18,384 granted February 26, 1970, for the mark COFRESI in International Class 59;
- iii. United States Trademark Application No. 85/440,979, filed on October 6, 2011 for the mark COFRESI, in International Class 33 for “Rum”.

Items i. and iii. of the above referenced registrations and application (collectively “Opposer’s Marks”) are valid Dominican Registrations or currently pending before the United States Patent and Trademark Office. Copies of the Dominican Registrations and current printouts of information from the electronic database records of the USPTO showing the current status and title of these registrations are attached hereto as Exhibit 1 and are incorporated by reference herein as if set forth in full.

3. From a date prior to the filing of the Application at issue, Opposer has used the COFRESI Mark in connection with the foregoing goods. Moreover, by virtue of the excellence of the product sold under the COFRESI Mark, the mark has a valuable reputation.

4. From a date prior to the filing of the Application at issue, Opposer used the COFRESI Mark in the United States in preparation for the United States launch of its products under the COFRESI Mark.

5. From a date prior to the filing of the Application at issue, Opposer had a bona fide intent of commercial use of the COFRESI Mark in connection with alcoholic beverages in the United States.

6. Notwithstanding Opposer’s prior rights in and to the COFRESI Mark, Applicant, on information and belief, on August 14, 2011, filed an application for the trademark Cofresi for

“Rum; rum-based alcoholic beverages” in International Class 33, and the mark was published for opposition in the Trademark Official Gazette of January 31, 2012 (the “Opposed Application”).

7. The mark contained in the Opposed Application is legally identical to Opposer’s Marks.

FIRST CLAIM FOR RELIEF
(Likelihood of Confusion With Previously-Used Trademark)

8. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 7, inclusive, as if fully set forth herein.

9. The Cofresi mark shown in the Opposed Application so resembles Opposer’s previously used and not abandoned COFRESI Mark as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant’s mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

10. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant prima facie evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer’s previously used and not abandoned COFRESI Mark.

SECOND CLAIM FOR RELIEF
(Likelihood of Confusion With Foreign Mark with Bona Fide Intent of Commercial Use in the United States)

11. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 7, inclusive, as if fully set forth herein.

12. Opposer states that the Cofresi mark shown in the Opposed Application so resembles Opposer's COFRESI Mark registered in the Dominican Republic with bona fide intent of commercial use in the United States as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

13. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant prima facie evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's COFRESI Mark registered in the Dominican Republic with bona fide intent of use in the United States.

WHEREFORE, Opposer prays for judgment sustaining this opposition and refusing registration to Applicant of the mark shown in the Opposed Application with Serial No. 85/397,427.

Dated March 30, 2012

Respectfully submitted,

/Ruben Alcoba, Esq./
Alcoba & Associates, P.A
3399 NW 72 Avenue
Suite 211
Miami, FL 33122
alcoba@miamipatents.com
305-362-8118
Attorney for Opposer,
Vinicola Del Norte, S.A .

Certificate of Service

I hereby certify that, on March 30, 2012, a true and correct copy of the foregoing Notice of Opposition has been duly served by sending such copy by first class mail, postage prepaid, to

RICHARD M. HENDLER
LAW OFFICES OF RICHARD M. HENDLER
10-14 BOND ST STE BOX PO BOX 218
GREAT NECK, NY 11021.

/Ruben Alcoba/

EXHIBIT

1



NUMERO 148141

REPUBLICA DOMINICANA

Secretaría de Estado de Industria y Comercio

OFICINA NACIONAL DE LA PROPIEDAD INDUSTRIAL
SANTO DOMINGO

Dirección de Signos Distintivos

CERTIFICADO DE MARCA DE FABRICA

COFRESI

SOLICITUD: 2003-53782		DE FECHA: 22/08/2003
CLASE(S) INTERNACIONAL(ES): 33		
FECHA DE EMISION: 01/04/2005	TERMINO: 10 Años	FECHA VENCIMIENTO: 01/04/2015

TITULAR: VINICOLA DEL NORTE, S.A. CALLE F. NO. 7 ZONA INDUSTRIAL DE HERRERA, SANTO DOMINGO OESTE REPUBLICA DOMINICANA R.N.C.: 1-05-00060-1	GESTOR: JUAN ALBERTO UREÑA DE JESUS / RADHAMES JIMENEZ PEÑA CALLE FRANK FELIX MIRANDA NO. 38 NACO, SANTO DOMINGO DISTRITO NACIONAL, REPUBLICA DOMINICANA Cédula: 001-0947814-9
APLICADO A PROTEGER: BEBIDAS ALCOHOLICAS	

En virtud del Artículo 75 de la Ley número 20-00 Sobre Propiedad Industrial de Fecha 10 de Mayo del 2000, emite el presente Certificado en la Oficina Nacional de Propiedad Industrial, hoy día 19 de Julio del 2005.

Secuencia 14

Lic. Santo F. Ramírez B.
Director del Departamento de Signos Distintivos

CERTIFICADO: Que ha sido renovado por

20

años, que vencerá el día 26 del mes de febrero del año 2000

el Reg. N° 18,384 Marca de Fábrica o de Comercio: "COPREST"

efectuada en fecha 26 del mes de febrero del año 1970

en favor de VINICOLA DEL NORTE, S.A.

organizada de acuerdo con las leyes de la República Dominicana, domiciliada en la Calle 30 de Marzo, prolongación de la ciudad de Puerto Plata.

cuyo titular actual es: VINICOLA DEL NORTE, S.A.

Esta Marca de Fábrica ha sido renovada en la Clase N° 59 de la Nomenclatura actual de Marcas de Fábricas.



REPUBLICA DOMINICANA

Secretaría de Estado de Industria y Comercio

Santo Domingo, Distrito Nacional

5 OCT. 1990

No. 23789

SANTO DOMINGO, D.N.

Al (a)

: Señor (a)

Ing. George Arzeno

Ciudad.-

Asunto

: Envío de Certificado de Registro.

Anexo

: Certificado de Registro No. RENOVACION

"Arca de Fábrica "COFRESI"

clase No. 59

No. 18,384 de fecha 26 de febrero

de 1990.

REMITIDO, cortésmente, el Certificado de Registro señalado en el anexo, de acuerdo a su solicitud de fecha

28 de junio

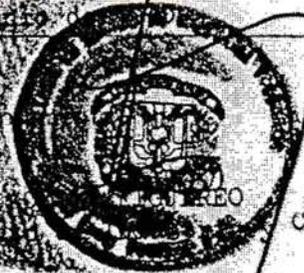
A

DR. NILSON

Director del Departamento

Comercio

NAF:AG/ect.-





REPUBLICA DOMINICANA
SECRETARIA DE ESTADO DE INDUSTRIA Y COMERCIO

DEPARTAMENTO DE INDUSTRIA Y COMERCIO

Registro de la Propiedad Industrial y Comercial

CERTIFICADO DE RENOVACION DE MARCA DE FABRICA O
DE COMERCIO

MARCA "COFRESI"

NUM. 18,384 clase NO. 59

FECHA 26 de febrero de 1970

VENCE 26 de febrero del 2000

Y en vista de que se han llenado todas las formalidades requeridas al efecto por el Art. 14, párrafo III, de la Ley N° 1450, de Registro de Marcas de Fábrica y Nombres Comerciales e Industriales, de fecha 30 de Diciembre de 1937, se expide el presente Certificado, en Santo Domingo, D. N., Capital de la República Dominicana, hoy día 25 del mes de septiembre del año 1990

DR. NILSON ACCONZA

Director del Departamento de Industria y Comercio

REGISTRADA BAJO N° 187

SELLOS NOS.
852316/17
RD\$ 12.00
HAFAG/act.



Exh



United States Patent and Trademark Office

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COFRESI

Word Mark **COFRESI**
Goods and Services IC 033. US 047 049. G & S: Rum
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 85440979
Filing Date October 6, 2011
Current Filing Basis 44E
Original Filing Basis 44E
Owner (APPLICANT) Vinicola Del Norte, S.A. sociedad anonima (sa) DOMINICAN REP Ave. John F Kennedy esquina Tiradentes Santo Domingo DOMINICAN REP
Attorney of Record Miguel Veizaga
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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