

ESTTA Tracking number: **ESTTA479035**

Filing date: **06/20/2012**

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	Diageo North America, Inc.
Granted to Date of previous extension	06/20/2012
Address	801 Main Avenue Norwalk, CT 06851 UNITED STATES

Attorney information	Evan Gourvitz Diageo North America, Inc. 801 Main Avenue Norwalk, CT 06851 UNITED STATES trademarks@diageo.com Phone:203-229-4264
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Applicant Information

Application No	79089902	Publication date	02/21/2012
Opposition Filing Date	06/20/2012	Opposition Period Ends	06/20/2012
International Registration No.	0807965	International Registration Date	07/01/2003
Applicant	Martin Anton Groder Etrichgasse 16 A-6020 Innsbruck AUSTRIA		

Goods/Services Affected by Opposition

Class 032. All goods and services in the class are opposed, namely: Beers; mineral and aerated waters and other non-alcoholic drinks, namely, soft drinks and carbonated energy drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, namely, soft drinks and carbonated energy drinks
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)
Other	lack of bona fide intent to use

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2854986	Application Date	05/02/2002
Registration Date	06/15/2004	Foreign Priority Date	NONE
Word Mark	CÂ#ROC		
Design Mark			
Description of Mark	The mark is presented without any claim to special form.		
Goods/Services	Class 033. First use: First Use: 2003/01/24 First Use In Commerce: 2003/01/24 Alcoholic beverages		

U.S. Registration No.	3895207	Application Date	11/24/2009
Registration Date	12/21/2010	Foreign Priority Date	NONE
Word Mark	ROKK		
Design Mark			
Description of Mark	The mark consists of the word "ROKK" with an umlaut over the "O" beneath the depiction of a ship.		
Goods/Services	Class 033. First use: First Use: 2010/07/31 First Use In Commerce: 2010/07/31 Alcoholic beverages except beers		

Attachments	78125682#TMSN.gif (1 page)(bytes) 77880088#TMSN.jpeg (1 page)(bytes) NOTICE OF OPPOSITION and Exhibit A ROX SN 79089902.pdf (16 pages) (685208 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	/Evan Gourvitz/
Name	Evan Gourvitz
Date	06/20/2012

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

In the Matter of Application Serial No. 79/089,902
Published in the Official Gazette on February 1, 2012

Mark: ROX

International Class: 32 and 33

DIAGEO NORTH AMERICA, INC.,

Opposer,

-against-

MARTIN ANTON GRODER,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer Diageo North America, Inc. (“Opposer”) believes that it will be damaged by the registration of the mark ROX (“Applicant’s Mark”) for “Beers; mineral and aerated waters and other non-alcoholic drinks, namely, soft drinks and carbonated energy drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, namely, soft drinks and carbonated energy drinks” in International Class 32 and “[a]lcoholic beverages except beers” in International Class 33, as shown in the above-noted application, Serial No. 79/089,902, and hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1063(a).

As grounds for the opposition, Opposer alleges that:

1. Opposer Diageo North America, Inc. is a Connecticut corporation with its principal place of business located at 801 Main Avenue, Norwalk, Connecticut 06851.
2. Opposer and its predecessors-in-interest have owned and used the RÖKK and CÎROC marks in commerce in the United States in connection with alcoholic beverages

since prior to the November 5, 2010 filing date of the application herein opposed, or any other date upon which Applicant can rely in this proceeding.

3. During its continuous use of its RÖKK and CÎROC marks (collectively, “Opposer’s Marks”), Opposer and its authorized wholesalers, distributors, and retail accounts have expended considerable time, effort and money in advertising and publicizing the sale of alcoholic beverages bearing those marks in the United States.

4. During its continuous use of Opposer’s Marks, Opposer has directly and indirectly sold, and offered for sale, alcoholic beverages bearing those marks throughout the United States.

5. During its continuous use of Opposer’s Marks, Opposer has directly and indirectly sold, and offered for sale, alcoholic beverages bearing those marks to wholesalers, distributors, and individuals over the legal purchase age for alcohol throughout the United States.

6. In addition, from a date prior to any date upon which Applicant can rely in this proceeding, consumers and the public have recognized and used Opposer’s Marks to refer to Opposer’s alcoholic beverages bearing those marks, and have come to identify Opposer’s Marks with Opposer and its products.

7. In addition to Opposer’s common law rights in both of Opposer’s Marks, Opposer owns incontestable U.S. Reg. No. 2,854,986 for CÎROC for “alcoholic beverages” in International Class 33, filed May 2, 2002 and registered June 15, 2004 based on use and use in commerce since January 24, 2003, and Reg. No. 3,895,207 for RÖKK and design for “alcoholic beverages except beers” in International Class 33, filed November 24, 2009 and registered December 21, 2010 based on use and use in commerce since July 31, 2010. Copies of the

certificates and electronic status records for both of these registrations, which are valid, subsisting, and in full force and effect, are attached hereto as Exhibit A.

8. Upon information and belief, Applicant Martin Anton Groder (“Applicant”) is an Austrian citizen with an address of Etrichgasse 16 A-6020 Innsbruck, Austria.

9. By the application herein opposed, Serial No. 79/089,902, Applicant seeks to register Applicant’s Mark for goods including “Beers; mineral and aerated waters and other non-alcoholic drinks, namely, soft drinks and carbonated energy drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages, namely, soft drinks and carbonated energy drinks” in International Class 32 and “[a]lcoholic beverages except beers” in International Class 33.

10. Applicant’s Mark is confusingly similar in appearance, sound, and commercial impression to Opposer’s Marks.

11. The goods for which Applicant seeks registration are closely related or identical to, and likely to be perceived as closely related or identical to, those in connection with which Opposer uses and has used Opposer’s Marks in the United States.

12. Upon information and belief, the products sold in connection with Opposer’s Marks and the products set forth in Applicant’s Application Serial No. 79/089,902 are intended to be directed to similar or identical classes of purchasers and to be distributed through overlapping or identical channels of trade in the United States.

13. Upon information and belief, Applicant does not have and cannot demonstrate any *bona fide* intent to use Applicant’s Mark in connection with all of the goods set forth in International Classes 32 and 33 of his application in the United States.

14. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

15. Registration should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the ground that Applicant's Mark so closely resembles Opposer's Marks as to be likely, when used on or in connection with the goods identified in the Application, to cause confusion, or to cause mistake, or to deceive, with the consequent injury to Opposer and to the public.

16. Registration also should be refused because Applicant does not have, did not have on the filing date of its application, and cannot demonstrate any *bona fide* intent to use Applicant's Mark in commerce in connection with all of the goods set forth in International Classes 32 and 33 of his application in the United States.

WHEREFORE, Opposer believes it will be damaged by the registration of Applicant's ROX mark for the goods identified in Application Serial Number 79/089,902 and respectfully requests that the opposition be sustained and registration of said mark be denied.

Pursuant to 37 C.F.R. §2.6(a)(17), Opposer respectfully requests that the \$300.00 statutory filing fee for filing a Notice of Opposition in one international class, and any additional amount, be charged to Deposit Account No. 083120.

All communication should be addressed to Opposer's counsel at the below stated address.

Dated: Norwalk, Connecticut
June 20, 2012

Respectfully submitted,



Evan Gourvitz
Diageo North America, Inc.
801 Main Avenue
Norwalk, Connecticut 06851

Counsel for Opposer Diageo North America, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be served, via first class mail, postage prepaid, on this 20th day of June 2012, to counsel for Applicant at the address identified on the Patent and Trademark Office's TARR database as follows:

Dianne Smith-Misemer
Hovey Williams LLP
10801 Mastin Blvd., Suite 1000
Overland Park, Kansas 66210

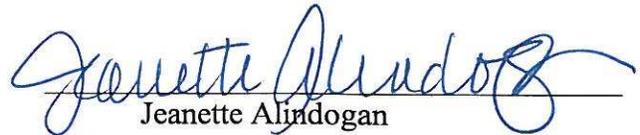

Jeanette Alindogan

EXHIBIT A

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

United States Patent and Trademark Office

Reg. No. 2,854,986

Registered June 15, 2004

**TRADEMARK
PRINCIPAL REGISTER**

CÎROC

DIAGEO NORTH AMERICA, INC. (CONNECTI-
CUT CORPORATION)
SIX LANDMARK SQUARE
STAMFORD, CT 06901

FOR: ALCOHOLIC BEVERAGES, IN CLASS 33
(U.S. CLS. 47 AND 49).

FIRST USE 1-24-2003; IN COMMERCE 1-24-2003.

THE MARK IS PRESENTED WITHOUT ANY
CLAIM TO SPECIAL FORM.

SN 78-125,682, FILED 5-2-2002.

ANDREW BENZMILLER, EXAMINING ATTOR-
NEY

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-06-20 09:33:16 ET

Serial Number: [78125682 Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: [2854986](#)

Mark

CÎROC

(words only): [CÎROC](#)

Standard Character claim: [No](#)

Current Status: [A Sections 8 and 15 combined declaration has been accepted and acknowledged.](#)

Date of Status: [2009-06-30](#)

Filing Date: [2002-05-02](#)

Transformed into a National Application: [No](#)

Registration Date: [2004-06-15](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 116](#)

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: [2009-06-30](#)

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

1. [Diageo North America, Inc.](#)

Address:

[Diageo North America, Inc.](#)

[801 Main Ave](#)

[Norwalk, CT 06851](#)

[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Connecticut](#)

GOODS AND/OR SERVICES

International Class: 033

Class Status: Active

Alcoholic beverages

Basis: 1(a)

First Use Date: 2003-01-24

First Use in Commerce Date: 2003-01-24

ADDITIONAL INFORMATION

Description of Mark: The mark is presented without any claim to special form.

MADRID PROTOCOL INFORMATION

USPTO Reference Number: A0012568

International Registration Number: 0968098

International Registration Date: 2008-05-27

Original Filing Date with USPTO: 2008-05-27

International Registration Status: Application For IR Registered By IB

Date of International Registration Status: 2008-07-24

International Registration Renewal Date: 2018-05-27

Irregularity Reply by Date: (DATE NOT AVAILABLE)

Madrid History:

07-24-2008 - 17:04:21 - Application For IR Registered By IB

05-27-2008 - 21:01:11 - IR Certified And Sent To IB

05-27-2008 - 15:37:09 - Automatically Certified

05-27-2008 - 15:37:09 - New Application For IR Received

PROSECUTION HISTORY

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

2009-06-30 - Section 8 (6-year) accepted & Section 15 acknowledged

2009-06-25 - Assigned To Paralegal

2009-06-23 - TEAS Section 8 & 15 Received

2005-03-02 - TEAS Change Of Correspondence Received

2005-03-01 - TEAS Change Of Owner Address Received

2004-06-15 - Registered - Principal Register

2004-04-01 - Allowed for Registration - Principal Register (SOU accepted)

2004-03-11 - Assigned To Examiner
2004-03-09 - Case File In TICRS
2004-03-04 - Statement Of Use Processing Complete
2004-02-03 - Use Amendment Filed
2004-02-03 - TEAS Statement of Use Received
2003-08-19 - Extension 1 granted
2003-08-08 - Extension 1 filed
2003-08-08 - TEAS Extension Received
2003-02-11 - NOA Mailed - SOU Required From Applicant
2002-11-19 - Published for opposition
2002-10-30 - Notice of publication
2002-09-18 - Approved For Pub - Principal Register
2002-09-13 - Examiner's amendment mailed
2002-09-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Jennifer J. Millones

Correspondent

Jennifer J. Millones

Diageo North America, Inc.

801 Main Ave

Norwalk CT 06851

Phone Number: 203.229-2100

Fax Number: 203.229.8925

United States of America

United States Patent and Trademark Office



Reg. No. 3,895,207

Registered Dec. 21, 2010

Int. Cl.: 33

TRADEMARK

PRINCIPAL REGISTER

DIAGEO NORTH AMERICA, INC. (CONNECTICUT CORPORATION)
801 MAIN AVENUE
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGES EXCEPT BEERS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 7-31-2010; IN COMMERCE 7-31-2010.

THE MARK CONSISTS OF THE WORD "ROKK" WITH AN UMLAUT OVER THE "O" BENEATH THE DEPICTION OF A SHIP.

THE ENGLISH TRANSLATION OF "RÖKK" IN THE MARK IS "SPINNING WHEEL".

SN 77-880,088, FILED 11-24-2009.

DEBRA LEE, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-06-20 09:33:39 ET

Serial Number: 77880088 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3895207

Mark



(words only): [ROKK](#)

Standard Character claim: No

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

Date of Status: 2010-12-21

Filing Date: 2009-11-24

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: 2010-12-21

Register: Principal

Law Office Assigned: LAW OFFICE 116

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: 2010-11-18

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(a)

First Use Date: 2010-07-31

First Use in Commerce Date: 2010-07-31

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Description of Mark: The mark consists of the word "ROKK" with an umlaut over the "O" beneath the depiction of a ship.

Translation: The English translation of "RÖKK" in the mark is "SPINNING WHEEL".

Design Search Code(s):

18.07.04 - Brigs (boats); Clippers (boats); Schooners (boats); Ships with two and three masts, including brigs, clippers and schooners

18.07.10 - Aircraft carriers; Battleships; Destroyers, air craft carriers and the like; Military ships (excluding submarines)

26.11.21 - Rectangles that are completely or partially shaded

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.

2010-12-21 - Registered - Principal Register

2010-11-19 - Notice Of Acceptance Of Statement Of Use E-Mailed

2010-11-18 - Law Office Registration Review Completed

2010-11-15 - Assigned To LIE

2010-11-15 - Assigned To LIE

2010-11-12 - Allowed for Registration - Principal Register (SOU accepted)

2010-10-26 - Statement Of Use Processing Complete

2010-10-11 - Use Amendment Filed

2010-10-26 - Case Assigned To Intent To Use Paralegal

2010-10-11 - TEAS Statement of Use Received

2010-09-07 - NOA E-Mailed - SOU Required From Applicant

2010-07-13 - Official Gazette Publication Confirmation E-Mailed

2010-07-13 - Published for opposition

2010-06-09 - Law Office Publication Review Completed

2010-06-04 - Approved For Pub - Principal Register

2010-05-20 - Teas/Email Correspondence Entered

2010-05-20 - Communication received from applicant

2010-05-20 - Assigned To LIE

2010-04-28 - TEAS Response to Office Action Received

2010-02-03 - Notification Of Non-Final Action E-Mailed

2010-02-03 - Non-final action e-mailed

2010-02-03 - Non-Final Action Written

2010-01-27 - Assigned To Examiner

2009-12-02 - Notice Of Design Search Code Mailed

2009-12-01 - New Application Office Supplied Data Entered In Tram

2009-11-27 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Lauren Mandell

Correspondent

LAUREN MANDELL
DIAGEO

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