

ESTTA Tracking number: **ESTTA489215**

Filing date: **08/15/2012**

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	Sazerac North America, Inc.
Granted to Date of previous extension	08/15/2012
Address	1001 Wilkinson Boulevard Frankfort, KY 40602 UNITED STATES

Attorney information	Heather Dunn Navarro Cooley LLP 777 6th Street, NW, Suite 1100 Washington, DC 20001 UNITED STATES trademarks@cooley.com, hdnararro@cooley.com Phone:650-843-5000
----------------------	---

Applicant Information

Application No	85480533	Publication date	04/17/2012
Opposition Filing Date	08/15/2012	Opposition Period Ends	08/15/2012
Applicant	Fire Tail Brands, LLC 2148 Hawks Landing Drive Lake St. Louis, MO 633671853 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: VODKA
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	303289	Application Date	01/31/1933
Registration Date	05/16/1933	Foreign Priority Date	NONE
Word Mark	IMPERIAL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U049 (International Class 033). First use: First Use: 1887/00/00 First Use In Commerce: 1887/00/00 WHISKY

Attachments	71334502#TMSN.gif (1 page)(bytes) 2012-08-15 Sazerac-Fire Tail Brands Ntc of Opp.pdf (5 pages)(51416 bytes)
-------------	---

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	/hdn/
Name	Heather Dunn Navarro
Date	08/15/2012

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

In the matter of application Serial No. 85/480,533
For the Trademark IMPERIAL JADE
Published in the Official Gazette on April 17, 2012

SAZERAC NORTH AMERICA, INC.,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
FIRE TAIL BRANDS, LLC,)	
)	
Applicant.)	
<hr/>		

NOTICE OF OPPOSITION

Opposer Sazerac North America, Inc. (“Sazerac”), a Delaware corporation having its principal place of business at 1001 Wilkinson Boulevard, Frankfort, Kentucky 40602 will be damaged by the issuance of a registration for the mark IMPERIAL JADE (the “Applicant’s Mark”), as applied for in Application Serial No. 85/480,533 filed on November 23, 2011 by Applicant Fire Tail Brands, LLC (“Applicant”).

As grounds for opposition, Sazerac alleges:

1. Sazerac is a company that markets and sells a wide-range of alcoholic beverages and distilled spirits, including without limitation whiskeys, vodkas, rums, tequilas, and liqueurs.
2. Sazerac is the exclusive authorized licensee of the IMPERIAL mark and product line owned by Pernod Ricard USA, LLC (“Pernod Ricard”). Since January 28, 1994, Sazerac and its predecessors-in-interest who were authorized licensees of Pernod Ricard have had the

sole right to produce, distribute, sell, and market the IMPERIAL product line, as well as to enforce the IMPERIAL trademark.

3. Pernod Ricard owns United States Registration No. 0303289 for IMPERIAL, issued May 16, 1933, for whisky (the “IMPERIAL Mark”).

4. Sazerac, Pernod Ricard, and their predecessors-in-interest have consistently and continually distilled, marketed, sold or otherwise distributed whiskey under the IMPERIAL Mark since 1887. By virtue of its prior use, marketing, and the excellence of the underlying products, the public, over the last 125 years, has come to know, rely on, and recognize the IMPERIAL Mark as a source identifier for Sazerac’s licensed whiskey products. Sazerac and its predecessors-in-interest have gained valuable reputation and a substantial amount of goodwill through the use and recognition of its licensed IMPERIAL Mark.

5. Upon information and belief, Sazerac alleges that on November 23, 2011, Applicant filed an Application to register the mark IMPERIAL JADE on an intent-to-use basis (Section 1(b)). Applicant seeks registration of the IMPERIAL JADE mark on and in connection with “vodka.”

6. Applicant’s Mark is likely to be confused with and mistaken for Sazerac’s licensed IMPERIAL Mark because Applicant’s Mark is confusingly similar in sight, sound, and meaning to Sazerac’s licensed IMPERIAL Mark. The dominant mark component “IMPERIAL” within Applicant’s IMPERIAL JADE Mark includes Sazerac’s entire licensed IMPERIAL Mark and has the same commercial connotation as Sazerac’s licensed IMPERIAL Mark.

7. If Applicant’s Mark is allowed to register, a likelihood of confusion will be created for consumers of alcoholic beverages. Applicant has claimed a *bona fide* intent to use the IMPERIAL JADE Mark on and in connection with alcoholic beverage products that overlap

with and are related to Sazerac's products marketed and sold under its licensed IMPERIAL Mark.

8. Applicant's targeted customer and consumer base overlaps with the customers and consumers of Sazerac's alcoholic beverages, including whiskey.

9. As Applicant's goods description contains no restrictions or limitations as to Applicant's channels of trade, Sazerac may assume that Applicant's Mark, like Sazerac's licensed IMPERIAL Mark, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's intended channels of trade for its alcoholic beverages overlaps with the channels of trade used by Sazerac in marketing, selling, or otherwise distributing its whiskey under the IMPERIAL Mark.

10. If Applicant is permitted to register its IMPERIAL JADE mark for the goods specified in the Application herein opposed, confusion resulting in damage and injury to Sazerac would likely occur. Persons familiar with Sazerac's licensed marks would likely perceive Applicants' products as associated or affiliated with or sponsored by Sazerac. Such confusion would inevitably result in damage to Sazerac.

11. Customers of Sazerac's products and the relevant public are likely to misapprehend Applicant's Mark as a Sazerac mark and/or believe in error that goods offered under the IMPERIAL JADE mark are offered by or in association with or under license from Sazerac.

12. Any defect, objection to, or fault found with Applicant's goods marketed under the IMPERIAL JADE mark would necessarily reflect on and seriously injure the reputation that Sazerac has established for its alcoholic beverages and distilled spirits.

13. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use Applicant's Mark, all to the detriment of Sazerac and its licensor, Pernod Ricard.

14. Wherefore, Sazerac prays that this Opposition be sustained and that Application Serial No. 85/480,533 be denied and refused registration.

COOLEY LLP

Date: August 15, 2012

By: Heather Dunn Navarro (jle)

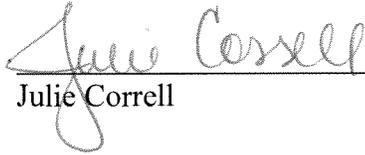
Heather Dunn Navarro, Esq.
Todd S. Bontemps, Esq.
Attorneys for Opposer
777 6th Street, NW
Suite 1100
Washington, DC 20001
(650) 843-5000

CERTIFICATE OF SERVICE

I hereby certify that on August 15, 2012 I mailed the foregoing NOTICE OF OPPOSITION regarding Sazerac North America, Inc. v. Fire Tail Brands, LLC to Applicant's counsel by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Jody H. Drake
Sughrue Mion, PLLC
2100 Pennsylvania Avenue NW, Suite 800
Washington, DC 20037-3200

Date: August 15, 2012



Julie Correll