ESTTA Tracking number: **ESTTA511541**
Filing date: **12/18/2012**

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

Proceeding	91207423
Party	Defendant BNA Wine Group, LLC
Correspondence Address	ROBERT L BREWER BASS BERRY & SIMS PLC 150 3RD AVE S STE 2800 NASHVILLE, TN 37201-2017 UNITED STATES trademarks@bassberry.com
Submission	Other Motions/Papers
Filer's Name	Robert L. Brewer
Filer's e-mail	trademarks@bassberry.com
Signature	/Robert L. Brewer/
Date	12/18/2012
Attachments	Mot and memo.pdf (22 pages)(846248 bytes)

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

In re the matter of the Application Serial No: 85486857
For the Mark: BNA WINE GROUP
Filed on: December 5, 2011
Published in the Official Gazette on October 2, 2012

The Metropolitan Nashville Airport Authority, Opposer, v. BNA Wine Group, LLC, Applicant.	MOTION AND MEMORANDUM TO SET ASIDE NOTICE OF DEFAULT JUDGMENT Opposition No.: 91207423

MOTION AND MEMORANDUM TO SET ASIDE NOTICE OF DEFAULT JUDGMENT

Pursuant to Rule 55(c) of the Federal Rules of Civil Procedure, Applicant, BNA Wine Group, LLC ("Applicant"), party in the position of Defendant, herein moves to set aside the Notice of Default Judgment ("Notice"). Defendant's motion is supported by a memorandum, which follows below. As explained in the memorandum, Applicant contends good cause exists why default judgment should not be entered against it.

MEMORANDUM

Opposer, The Metropolitan Nashville Airport Authority, filed its Notice of Opposition on Applicant on October 10, 2012. Applicant's Answer was due on November 20, 2012. Applicant prepared an Answer and, following Applicant's established, internal electronic filing procedures,

took the necessary steps to electronically submit its Answer to the U.S. Trademark Trial and Appeal Board ("T.T.A.B."). Consequently, Applicant believed that an Answer was electronically timely filed. Indeed, consistent therewith, Applicant served its Answer on opposing counsel. (See Exhibit A.)

Counsel for Applicant also emailed opposing counsel, attached a courtesy copy of the Answer, introduced herself, and wrote, "We'll look forward to discussing this matter with you during the discovery conference, if not sooner." (See Exhibit B.)

However, no Answer was received by the T.T.A.B. and Applicant subsequently received the Notice of Default Judgment on December 10, 2012.

Applicant attaches hereto as Exhibit C a printout of the screen page confirming its efforts to electronically and timely submit its Answer to the T.T.A.B. For reasons not known to or understood by Applicant, the submission was not complete.

According to the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), a notice of default judgment should not be entered if a defendant who has failed to file a timely answer to the complaint responds to a notice of default by filing a satisfactory showing of good cause why default judgment should not be entered against it. Fed. R. Civ. P. 55(c) (2012); TBMP §312.02 (2012). Further, good cause why default judgment should not be entered against a defendant for failure to file a timely answer to the complaint is usually found when the defendant shows the following:

(1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant;

(2) the plaintiff will not be substantially prejudiced by the delay; and

(3) the defendant has a meritorious defense to the action.

TBMP §312.02.

Applicant submits that for the reasons discussed below, each of the three elements set out above has been met and that the Board should find that Applicant has shown good cause why judgment should not be entered against it.

With regard to the first element, the delay in filing the Answer was not the result of willful conduct or gross neglect. Applicant submits that the screen shot associated with its attempt to file its Answer is sufficient to show that it made a good faith effort to file the same. (See Exhibit C.) Consequently, Applicant's conduct does not constitute willful conduct or gross neglect.

With regard to the second prong, Applicant submits that Opposer is not and has not been substantially prejudiced by the delay. Indeed, the Answer was timely served on Opposer (Exhibit A) and, further, a courtesy copy of the Answer was emailed directly to Opposer's counsel (Exhibit B). Opposer and Applicant have been actively engaged in preliminary settlement discussions and, Applicant submits, both parties have been operating under the assumption that the Answer was properly and timely filed. Further, this Motion and Memorandum to Set Aside the Notice of Default Judgment ("Motion") is being filed within approximately one week of having received the Notice of Default Judgment. Consequently, Opposer is not and has not been substantially prejudiced because Opposer has suffered no delay in receiving its Answer, the case has not stalled because preliminary settlement negotiations have continued even after receipt by both parties of the Notice, and this Motion is being filed within approximately one week of receipt of the Notice. Applicant's submits that the delay has been *de minimis*. *See Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 U.S.P.Q.2d 1556, 1557 (T.T.A.B. 1991) (failure to answer due to inadvertence on part of applicant's counsel;

answer had been prepared and reviewed by applicant but counsel inadvertently failed to file it; nine-day delay would cause minimal prejudice; by submission of answer which was not frivolous meritorious defense was shown).

With regard to the third element, Applicant contends that its proposed Answer, submitted herewith as Exhibit D, demonstrates that Applicant intends to vigorously defend this matter and that the defenses set out in the Answer far exceed the minimum requirement of a "plausible response to the allegations in the complaint." *See DeLorme Publishing Co v. Eartha's Inc.*, 60 U.S.P.Q.2d 1222, 1224 (T.T.A.B. 2000).

The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board. TBMP §312.02; *see, e.g., Identicon Corp. v. Williams*, 195 U.S.P.Q. 447, 449 (Comm'r 1977) (fact that in response to order to show cause applicant filed answer but no response to show cause order does not mandate entry of default judgment; applicant allowed time to show cause). Further, it is the policy of the law to decide cases on their merits. Accordingly, case law holds that the Board should be very reluctant to enter a default judgment for failure to file a timely answer and to resolve any doubt on the matter in favor of the defendant. *Id.* Given the above discussion, and consistent with the policy of the law, and the Board's policy to resolve doubt in favor of the Defendant, the Board is urged to exercise its discretion and set aside the Notice of Default Judgment.

CONCLUSION

In conclusion, Applicant submits that, based on the foregoing discussion, it has shown good cause why default judgment should not be entered against it. Consequently, Applicant respectfully requests that the Notice of Default Judgment be set aside, Applicant's Answer

(attached as Exhibit D) be entered, the opposition proceeding be reinstated and the deadline for the discovery conference as well as all subsequent dates be reset. TBMP §312.01.

Respectfully submitted,

DATED: December ~~17~~ 18, 2012

By: Martha Allard

Robert L. Brewer
Paige W. Mills
Martha B. Allard
BASS, BERRY & SIMS PLC
150 Third Avenue South, Suite 2800
Nashville, Tennessee 37201
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Facsimile: (615) 742-0410

Attorneys for Applicant,
BNA Wine Group, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing MOTION AND MEMORANDUM TO SET ASIDE NOTICE OF DEFAULT JUDGMENT was served on the date indicated below by placing a copy in the U.S. Mail, postage prepaid as first class mail, and addressed to the following attorneys of record:

Haverly MacArthur
Reber M. Boult
Adams & Reese LLP
424 Church Street, Suite 2800
Nashville, TN 37219

DATED: December ~~17~~ 18, 2012

Marian Moore
Name:

11426659.1

EXHIBIT A

BASS
BERRY • SIMS PLC

150 Third Avenue South, Suite 2800
Nashville, TN 37201
(615) 742-6200

Marian Moore
Paralegal
PHONE: (615) 259-6126
FAX: (615) 742-0402
E-MAIL: mmoore@bassberry.com

November 15, 2012

Haverly MacArthur, Esq.
Reber M. Boult, Esq.
Adams & Reese LLP
424 Church Street, Suite 2800
Nashville, TN 37219

Re: ***The Metropolitan Nashville Airport Authority v. BNA Wine Group, LLC***
Opposition No.: 91207423

Dear Ms. MacArthur and Mr. Boult:

Enclosed please find a copy of our Answer filed today in the above-referenced matter. If you have any questions, please let us know. Thank you.

Sincerely,

Marian Moore

Marian Moore
Paralegal

Enclosure

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

In re the matter of the Application Serial No: 85486857
For the Mark: BNA WINE GROUP
Filed on: December 5, 2011
Published in the Official Gazette on October 2, 2012

The Metropolitan Nashville Airport Authority, Opposer, v. BNA Wine Group, LLC, Applicant.	ANSWER TO NOTICE OF OPPOSITION Opposition No.: 91207423

ANSWER TO NOTICE OF OPPOSITION

Applicant, BNA Wine Group, LLC, having a principal place of business at 209 10th Ave. South, Suite 521, Nashville, Tennessee 37203 ("Applicant") answers the Notice of Opposition (the "Notice") of The Metropolitan Nashville Airport Authority, having its principal place of business at One Terminal Drive, Suite 501, Nashville, Tennessee 37214 ("Opposer"), as follows:

Applicant has no knowledge or information sufficient to form a belief as to the truth of the matters alleged in the preamble paragraph of the Notice and therefore denies the same.

1. Applicant admits that Opposer appears to be a quasi-governmental corporation. Applicant is without sufficient knowledge or information sufficient to form a belief as to the remaining allegations contained in Paragraph 1 and therefore denies the same.

2. Applicant admits that "BNA" is the three-letter airport code for the Nashville International Airport. Applicant is without sufficient knowledge or information to form a belief as to the remaining allegations contained in Paragraph 2 and therefore denies the same.

3. Applicant admits that Opposer appears to have filed an application on August 17, 2012 to register the BNA mark for "airport passenger check-in services; airport passenger shuttle services between the airport parking facilities and the airport; airport services; airport services featuring transit lounge facilities for passenger relaxation; providing a website featuring information on airport parking" and the application appears to have been accorded Serial No. 85706350. Applicant is without sufficient knowledge or information to form a belief as to the remaining allegations contained in Paragraph 3 and therefore denies the same.

4. Admitted.

5. Admitted.

6. Applicant admits that it was aware that the BNA term is the three-letter airport code for the Nashville International Airport in Nashville, Tennessee, but specifically denies that BNA is used as a mark for airport services and denies all other allegations in Paragraph 6.

7. Applicant repeats and realleges its answers in the preceding paragraphs 1-6 as if fully set forth herein.

8. Denied.

9. Denied.

10. Denied.

11. Denied.

12. Denied.

13. Applicant repeats and realleges its answers in the preceding paragraphs 1-6 as if fully set forth herein.

14. Denied.

15. Denied.

Applicant denies that Opposer is entitled to any relief, including the relief requested in the WHEREFORE clause of its Notice.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

1. The Notice fails to state a sufficient basis on which to oppose the registration of Applicant's mark and fails to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

2. Opposer's use of the BNA term does not constitute trademark use.

THIRD AFFIRMATIVE DEFENSE

3. Applicant is actually using its mark in commerce. During the time of actual use, there have been no incidents of confusion between the marks. Continued use of the respective marks and registration of Applicant's mark will not damage Opposer.

FOURTH AFFIRMATIVE DEFENSE

4. Applicant's wine is not sufficiently related to the airport services of the Opposer and/or conditions surrounding the marketing of the respective goods and services are not such that they would be or could be encountered by the same persons under circumstances that could

give rise to the mistaken belief that the respective goods originate from the same provider thereof.

FIFTH AFFIRMATIVE DEFENSE

5. The Opposition is barred by the equitable doctrines of waiver, estoppel, unclean hands and/or acquiescence.

SIXTH AFFIRMATIVE DEFENSE

6. Opposer's mark is not famous or entitled to any protection under the Trademark Dilution Revision Act of 2006.

SEVENTH AFFIRMATIVE DEFENSE

7. To the extent that Opposer ever acquired trademark rights in the term BNA, it lost those rights due to the unauthorized, unlicensed use and misuse of the term by multitudes of third parties, such as travel agents, travelers, and travel websites, such as the site commonly referred to as "expedia.com," located at <www.expedia.com>, for decades preceding the filing of this Notice.

Applicant reserves all rights, including but not limited to the right to add additional affirmative defenses as discovery develops and facts become known to it.

PRAYER FOR RELIEF

WHEREFORE, Applicant requests judgment dismissing Opposer's Notice and this proceeding in its entirety with prejudice, and that Applicant's application for the BNA mark (Serial No.: 85486857) be registered to Applicant.

Respectfully submitted,

DATED: November 15, 2012

By: Martha Allard

Robert L. Brewer
Paige W. Mills
Martha B. Allard
BASS, BERRY & SIMS PLC
150 Third Avenue South, Suite 2800
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Facsimile: (615) 742-0410

Attorneys for Applicant,
BNA Wine Group, LLC

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The undersigned hereby certifies that a true and correct copy of the foregoing Answer to the Notice of Opposition was served on the date indicated below by email and by placing a copy in the U.S. Mail, postage prepaid as first class mail, and addressed to the following attorneys of record:

Haverly MacArthur
Reber M. Boult
Adams & Reese LLP
424 Church Street, Suite 2800
Nashville, TN 37219
trademarks@arlaw.com

DATED: November 15, 2012

Martha Allard
Name:

11316946.1

EXHIBIT B

Allard, Martha B.

From: Allard, Martha B.
Sent: Friday, November 16, 2012 8:14 AM
To: 'haverly.macarthur@arlaw.com'
Cc: Brewer, Robert L.
Subject: Opposition No. 91207423
Attachments: Answer to Notice of Opposition.PDF

Haverly,

As you know, our firm represents BNA Wine Group, LLC. Attached is a courtesy copy of the Answer that we filed in response to the Notice of Opposition in this matter.

We'll look forward to discussing this matter with you during the discovery conference, if not sooner.

Best,
Martha Allard

Martha B. Allard
150 Third Avenue South, Suite 2800
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615 742 7944 • 615 742 6293 F
mallard@bassberry.com • www.bassberry.com

BASS
BERRY • SIMS

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EXHIBIT C

United States Patent and Trademark Office

Electronic System for Trademark Trials and Appeals

Answer

Navigation: Back - Detail - Attachments - Size - Validate

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PTO-2151 (Exp. 03/31/2014)
OMB No. 0651-0040 (Exp. 03/31/2014)

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

Proceeding	91207423
Party	Defendant BNA Wine Group, LLC
Correspondence Address	ROBERT L. BREWER, PAIGE W. MILLS AND RYA BASS, BERRY & SIMS PLC 150 3RD AVE S STE 2800 NASHVILLE, TN 37201-2017 trademarks@bassberry.com
Submission	Answer
Filer's Name	Robert L. Brewer
Filer's e-mail	trademarks@bassberry.com
Signature	/Robert L. Brewer/
Date	11/15/2012
Attachments	Answer.pdf (5 pages)(213572 bytes)

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EXHIBIT D

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TRADEMARK TRIAL AND APPEAL BOARD

In re the matter of the Application Serial No: 85486857
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Respectfully submitted,

DATED: November 15, 2012

By: Martha Allard

Robert L. Brewer
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Facsimile: (615) 742-0410

Attorneys for Applicant,
BNA Wine Group, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Answer to the Notice of Opposition was served on the date indicated below by email and by placing a copy in the U.S. Mail, postage prepaid as first class mail, and addressed to the following attorneys of record:

Haverly MacArthur
Reber M. Boult
Adams & Reese LLP
424 Church Street, Suite 2800
Nashville, TN 37219
trademarks@arlaw.com

DATED: November 15, 2012

Martha Allard
Name:

11316946.1