

ESTTA Tracking number: **ESTTA521431**

Filing date: **02/13/2013**

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	Carriage House Imports Ltd.
Granted to Date of previous extension	02/13/2013
Address	99 Morris Anveue Springfield, NJ 07081 UNITED STATES

Attorney information	Laura Goldbard George Stroock & Stroock & Lavan LLP 180 Maiden Lane, 38th Floor New York, NY 10038-4982 UNITED STATES tm@stroock.com, lgoldbard@stroock.com Phone:212-806-6675
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**Applicant Information**

Application No	85470074	Publication date	10/16/2012
Opposition Filing Date	02/13/2013	Opposition Period Ends	02/13/2013
Applicant	BOSCA S.P.A. Via Luigi Bosca, 2 Canelli (Asti), ITALY		

**Goods/Services Affected by Opposition**

Class 033. First Use: 1993/06/01 First Use In Commerce: 1993/06/01 All goods and services in the class are opposed, namely: Wines and alcoholic beverages except beers
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**Grounds for Opposition**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Likelihood of confusion

Attachments	Notice of Opposition VERDI SPUMANTE.pdf ( 8 pages )(489906 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	/laura goldbard george/
Name	Laura Goldbard George
Date	02/13/2013

Client Matter No. 104912.0902

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

Application Serial No. 85/470,074  
Mark: VERDI SPUMANTE  
Published: October 16, 2012

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CARRIAGE HOUSE IMPORTS LTD.,	:	
	:	
Opposer,	:	
	:	
	:	Opposition No.
v.	:	
	:	
BOSCA S.P.A.	:	
	:	
Applicant.	:	
-----X		

Commissioner for Trademarks  
P.O. Box 1451  
Arlington, Virginia 22313-1451

**NOTICE OF OPPOSITION**

Opposer, Carriage House Imports Ltd. (hereinafter “Carriage House” or “Opposer”) believes that it will be damaged by registration of the mark VERDI SPUMANTE for wines and alcoholic beverages except beer, in International Class 33, Application Serial No. 85/470,074 (“Application”), filed on November 15, 2011, based on use since June 1, 1993, in the name of BOSCA S.P.A. (“BOSCA”), and hereby opposes registration of same. As grounds for the Opposition, Opposer alleges as follows:

1. Opposer, Carriage House, is a Delaware corporation, located at 99 Morris Avenue, Springfield, New Jersey 07081.

2. Applicant, BOSCA, is a joint stock company under the laws of Italy, located at Via Luigi Bosca, 2, Canelli (Asti), Italy.

3. Bosca Cora S.p.A., not BOSCA, is the owner of the mark VERDI SPUMANTE for an alcoholic brewed malt beverage containing natural flavors and Registration No. 2,228,600 issued on March 2, 1999 for the mark VERDI SPUMANTE for alcoholic brewed malt beverages containing natural flavors. During the prosecution of the Application, it was represented in the Response to the Office Action, filed August 31, 2012, that “BOSCA S.P.A. and Bosca Cora, S.p.A. are the same corporate entity...” However, based on documents publicly filed in Italy, a separate entity, Luigi Bosca & Figli S.p.A., has at least a shared interest in the short form “BOSCA S.P.A.” Thus, as both entities may have the right to use “BOSCA S.P.A.”, it is unclear whether Bosca Cora S.p.A. or Luigi Bosca Figli & S.p.A. is being referred to by Applicant’s name.

4. For many years prior to the filing of the Application, Opposer has been using the trademark VERDI SPUMANTE in interstate commerce within the United States. More specifically, the mark VERDI SPUMANTE has been in use in the United States in connection with alcoholic brewed malt beverages containing natural flavors since at least as early as March 3, 1995 and in connection with wines since June 2, 2004 (collectively referred to herein as the “Products”). Carriage House is the exclusive importer and distributor, on behalf of Bosca Cora S.p.A. in the United States, of the Products and sells the Products throughout the United States.

5. On November 15, 2011, Applicant, BOSCA, filed the use-based Application, Serial No. 85/470,074, for the mark VERDI SPUMANTE for wines and alcoholic beverages except beers (the “Goods”). The date of first use claimed is June 1, 1993. Alcoholic beverages except beers has to be referring to some product other than alcoholic malt beverages containing

natural flavors due to the fact that Registration 2,228,600 is for the same mark, VERDI SPUMANTE, for alcoholic malt beverages containing natural flavors and duplicative registrations are not permitted. It is unknown by Opposer of any such products as the only products that Opposer sells under the VERDI SPUMANTE mark are wines and alcoholic brewed malt beverages containing natural flavors. Upon information and belief, no products, other than winess and alcoholic malt beverages containing natural flavors, have been sold under the mark VERDI SPUMANTE in the United States. Accordingly, such claim is a false and material representation.

6. Opposer and Applicant are parties to an exclusive Distribution Agreement which was first entered into on August 14, 1993, amended October 18, 2000. More specifically, Opposer was appointed the sole and exclusive importer and distributor of VERDI brand and related malt beverages for the United States. As the exclusive distributor, Opposer would have been aware and should have been aware as to when the VERDI SPUMANTE Products were first distributed and what products were distributed in the United States. Moreover, Opposer does not know of any use of VERDI SPUMANTE for wines in the United States until 2004. Opposer did not start selling wines in the United States under the VERDI SPUMANTE mark on June 1, 1993, the claimed date of first use. Rather, Opposer did not start selling wines under the VERDI SPUMANTE mark in the United States until June 2, 2004 and has not to date sold any products other than wines and alcoholic malt beverages containing natural flavors under the VERDI SPUMANTE mark in the United States. Accordingly, Applicant's date of first use and the inclusion of alcoholic beverages except beer are material false representations which were made knowingly, and it would be improper for the Application to issue into registration with an erroneous date of first use and goods that are not in use.

7. In the event that Applicant did commence selling the Goods in the United States on June 1, 1993, then such sales were by some entity other than Opposer and contrary to the following representation made by Applicant to Opposer:

d) Bosca has the right to designate and appoint Carriage House as the exclusive importer and distributor of the Products in the Territory.

Thus, if the Goods in the United States were sold since June 1, 1993, as Applicant did not sell them, then they were sold by some entity other than Opposer. Alternatively, in the event that Applicant did not commence selling the Goods in the United States on June 1, 1993, then the date of first use is false.

8. Further, if products other than wines and alcoholic malt beverages containing natural flavors have not been sold in the United States under the VERDI SPUMANTE mark, then including "alcoholic beverages except beer" in the Application is a false and material representation. Alternatively, in the event that products other than wines and alcoholic malt beverages containing natural flavors have been sold in the United States under the VERDI SPUMANTE mark, then they had to have been sold by some entity other than Opposer. Based on the fact that Applicant exported the VERDI SPUMANTE Products to the United States, then Applicant has records of such sales and all the statements were made knowingly.

9. Moreover, in the event that Applicant BOSCA S.P.A. is actually a short form for Luigi Bosca & Figli S.p.A. rather than Bosca Cora S.p.A., then there is a likelihood of confusion because the identical marks for closely related goods are owned by two different entities. As a result, Applicant could claim, albeit wrongfully, that VERDI SPUMANTE for the Goods are not covered by the exclusive arrangement with Opposer, resulting in damage to Opposer. Not only

would such an attempt result in Opposer not being the exclusive distributor for the Goods but Opposer would no longer have a re-sale interest or right of first refusal pursuant to the Distribution Agreement. As a result, Applicant could transfer the mark without consequence or sell VERDI SPUMANTE Goods through another distributor.

10. Opposer tried to obtain clarification of the date of first use by contacting Applicant's attorney. However, no substantive response was received.

11. Applicant knowingly made false and material representations regarding the date of first use of VERDI SPUMANTE for wines and the inclusion of alcoholic beverages except beer. Applicant is aware of when it first sold VERDI SPUMANTE in the United States for wines to Opposer and knows that it was not on June 1, 1993. In fact, VERDI SPUMANTE for wines was not sold in the United States in either interstate commerce or commerce between the United States and Italy until 2004. Moreover, Applicant is aware of the products sold under the VERDI SPUMANTE mark in the United States. The only products sold under the VERDI SPUMANTE mark in the United States are wines and alcoholic malt beverages containing natural flavors. Therefore, there are no products to be included by the words "alcoholic beverages except beer." Such false, material representations were made with the intent to deceive the USPTO into believing that the Applicant met statutory conditions for a use-based application for all the goods in the Application, as required to grant a registration. Applicant knowingly concealed the facts from the USPTO and the USPTO reasonably relied on the truth of such false statements in allowing the Application for Goods that either are not in use or with a false date of first use.

## **COUNT I – LIKELIHOOD OF CONFUSION**

12. Applicant repeats and realleges the allegations in Paragraphs 1 through 11, as fully set forth herein.

13. In the event that BOSCA S.P.A. is referring to Luigi Bosca & Figli S.p.A. rather than Bosca Cora S.p.A. in the Application, then the same mark for closely related goods is owned by two different companies. The confusing similarity of Applicant's trademark and Applicant's Goods to Registration No. 2,228,600, the registration of the mark VERDI SPUMANTE, for alcoholic brewed malt beverages containing natural flavors, if the Application and Registration are owned by two separate companies, is likely to cause confusion, mistake and deceive the trade and public into believing that Applicant's Goods originate with or are otherwise licensed, sponsored or authorized by Opposer, unless the Application and Registration No. 2,228,600 are owned by the same entity.

14. The use and registration of the mark VERDI SPUMANTE for the Goods by Applicant is likely to damage the distinctiveness created and established by Bosca Cora S.p.A., through its distributor, Opposer, Carriage House, by virtue of the confusion, mistake and deception likely to occur between the marks.

15. By reason of all of the foregoing, Opposer will be gravely damaged by the registration of the mark VERDI SPUMANTE for Applicant's Goods.

## **COUNT II – FRAUD**

16. Applicant repeats and realleges the allegations in Paragraphs 1-11 and 13-15, as fully set forth herein.

17. In view of the false and material representations, knowingly made, in regard to the date of first use in connection with wines and the goods that were not and are not in use, namely – “alcoholic beverages except beer”, such statements are material because the USPTO would not have published the Application. Moreover, Applicant attested in the Declaration of the Application that all statements in the Application are true.

18. The USPTO reasonably relied on the truth of such false statements and did approve the Application for publication.

19. Applicant committed fraud in the Application and Opposer will be gravely damaged by the registration of VERDI SPUMANTE for wines with the erroneous date of first use and the inclusion of “alcoholic beverages except beer.”

20. As a result of Applicant’s fraud, Opposer will be gravely damaged by the registration of the mark VERDI SPUMANTE for the Goods.

WHEREFORE, by reason of the foregoing, Opposer respectfully requests that the opposition be sustained and that registration of the mark VERDI SPUMANTE be refused.

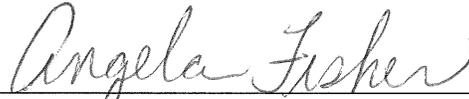
Dated: New York, New York  
February 13, 2013

Respectfully submitted,  
STROOCK & STROOCK & LAVAN LLP  
Attorneys for Opposer  
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New York, New York 10038-4982  
(212) 806-5400

By   
Laura Goldbard George

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on counsel for BOSCA SPA, by forwarding said copy to the attorney for Applicant, Lori S. Meddings, Esq., Michael Best & Friedrich LLP, 100 East Wisconsin Avenue, Suite 3300, Milwaukee, WI 53202-4108, by first class mail, on February 13, 2013.

A handwritten signature in cursive script that reads "Angela Fisher". The signature is written in black ink and is positioned above a horizontal line.

Angela Fisher