

ESTTA Tracking number: **ESTTA528443**

Filing date: **03/25/2013**

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	GEORGETOWN TRADING CO., LLC
Granted to Date of previous extension	05/22/2013
Address	4200 Cathedral Ave NW 711 Washington, DC 20016 UNITED STATES

Attorney information	Andrew N. Spivak Mosaic Legal Group, PLLC 5185 MacArthur Boulevard, NW, Suite 350 Washington, DC 20016-3341 UNITED STATES aspivak@mosaiclegalgroup.com Phone:(202) 600-2270
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Applicant Information

Application No	85693721	Publication date	01/22/2013
Opposition Filing Date	03/25/2013	Opposition Period Ends	05/22/2013
Applicant	VENTURI SPIRITS, LLC SUITE 206 4581 WESTON ROAD WESTON, FL 33331 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Bourbon; Bourbon whisky
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3832546	Application Date	10/22/2008
Registration Date	08/10/2010	Foreign Priority Date	NONE
Word Mark	JAMES E. PEPPER		

Design Mark	<h1>James E. Pepper</h1>		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2010/06/09 First Use In Commerce: 2010/06/09 Bourbon; whiskey		

U.S. Registration No.	3845966	Application Date	01/23/2009
Registration Date	09/07/2010	Foreign Priority Date	NONE
Word Mark	ELIJAH PEPPER		
Design Mark	<h1>Elijah Pepper</h1>		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2010/06/25 First Use In Commerce: 2010/06/25 Bourbon; Whiskey		

U.S. Registration No.	3845967	Application Date	01/23/2009
Registration Date	09/07/2010	Foreign Priority Date	NONE
Word Mark	OSCAR PEPPER		

Design Mark	Oscar Pepper
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2010/06/25 First Use In Commerce: 2010/06/25 Bourbon; Whiskey

Attachments	77597631#TMSN.jpeg (1 page)(bytes) 77655017#TMSN.jpeg (1 page)(bytes) 77655025#TMSN.jpeg (1 page)(bytes) OLD PEPPER BOURBON - Notice of Opposition.pdf (9 pages)(1220587 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	/Andrew N. Spivak/
Name	Andrew N. Spivak
Date	03/25/2013

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

Georgetown Trading Co., LLC,)	
)	
Opposer,)	Opposition No. _____
vs.)	
)	
Venturi Spirits, LLC,)	Mark: OLD PEPPER BOURBON
)	Serial No.: 85/693,721
Applicant.)	Publication Date: January 2, 2013
)	
_____)	

NOTICE OF OPPOSITION

Georgetown Trading Co., LLC, a limited liability company of Washington, D.C., having a principal place of business at 4200 Cathedral Avenue, NW, #711, Washington, D.C. 20016 (hereinafter “Opposer”), believes that it will be damaged by the Registration on the Principal Register of the above-referenced OLD PEPPER BOURBON trademark claimed by Venturi Spirits, LLC, a Florida limited liability company (hereinafter “Applicant”), and hereby opposes the same upon the following grounds:

FACTUAL ALLEGATIONS COMMON TO ALL COUNTS

Applicant is seeking to obtain Registration on the Principal Register of the following mark as a trade mark for use in connection with the respective goods:

	Serial Number	Word Mark	Goods
1	85/693,721	OLD PEPPER BOURBON	International Class 033: Bourbon; Bourbon whisky.

1. Opposer is the owner of U.S. Registration No. 3,832,546 for the word mark JAMES E. PEPPER for use on and in connection with “Bourbon; Whiskey,” in International Class 33 (hereinafter the “Goods”).

2. Opposer is the owner of U.S. Registration No. 3,845,966 for the word mark ELIJAH PEPPER for use on and in connection with the Goods.

3. Opposer is the owner of U.S. Registration No. 3,845,967 for the word mark OSCAR PEPPER for use on and in connection with the Goods.

4. Opposer has expended substantial monies in marketing, advertising, promoting, and distributing its JAMES E. PEPPER, ELIJAH PEPPER, and OSCAR PEPPER trademarks (hereinafter the “PEPPER Family of Marks”) in connection with the Goods in interstate commerce in the United States.

5. Opposer has enjoyed substantial revenue derived from the sale of the Goods in connection with its PEPPER Family of Marks in the United States.

6. By reason of the high quality of the Goods, and Opposer’s extensive marketing, advertising, promotion, and distribution of the Goods in connection with its PEPPER Family of Marks, the PEPPER Family of Marks has become distinctive and represents extremely valuable goodwill associated with Opposer.

7. Historically, and prior to Opposer’s own use and ownership of the PEPPER Family of Marks, the trademarks PEPPER, OLD PEPPER, OLD OSCAR PEPPER, JAMES E. PEPPER, and OLD JAMES E. PEPPER had become distinctive and famous in connection with the Goods, and represented extremely valuable goodwill associated with the Pepper family, citizens of the United States.

8. On or about 1776, Elijah Pepper began distilling and selling the Goods which were known to consumers as PEPPER whiskey.

9. On or about 1838, Elijah Pepper's son, Oscar Pepper, inherited his father's distillery, built the Old Oscar Pepper distillery, and continued to distill and sell the Goods which were known to consumers as PEPPER and also OLD PEPPER whiskey.

10. On or about 1867, Oscar Pepper's son, James E. Pepper, inherited his father's distillery, continued to distill and sell the Goods which were known to consumers as PEPPER and also OLD PEPPER whiskey.

11. On or about 1879, James E. Pepper moved to Lexington, Kentucky and built the James E. Pepper distillery in order to produce and sell the Goods in connection with the trademarks PEPPER, OLD PEPPER, JAS. E PEPPER, JAMES E. PEPPER, and OLD JAMES E. PEPPER trademarks. At that time, the James E. Pepper distillery was the largest in the United States. Still standing to date, the James E. Pepper distillery in Lexington, Kentucky is a National Historic Landmark.

12. On or about 1958, production of the Goods at the James E. Pepper distillery ceased.

13. The Pepper family's PEPPER brand of the Goods is one of the oldest whiskey brands in United States history.

14. The Pepper family's PEPPER brand of the Goods is one of the most iconic whiskey brands in United States history.

15. Through its predecessor-in-interest, Opposer constructively began and has since continued to use its JAMES E. PEPPER trademark in the United States on and in connection with the Goods since at least as early as October 22, 2008.

16. Through its predecessor-in-interest, Opposer constructively began and has since continued to use its ELIJAH PEPPER and OSCAR PEPPER trademarks in the United States on and in connection with the Goods since at least as early as January 23, 2009.

17. All of the Goods in connection with Opposer's PEPPER Family of Marks have been produced in the state of Kentucky.

18. On information and belief, Applicant has filed a Section 1(b) application for the trademark OLD PEPPER BOURBON, U.S. Trademark Application Serial No. 85/693,721, based on Applicant's intent to use the OLD PEPPER BOURBON trademark in connection with "Bourbon; Bourbon whisky," in International Class 33.

19. On information and belief, Applicant's aforementioned application was filed after Opposer's PEPPER Family of Marks had developed good will and consumer recognition in interstate commerce.

20. On information and belief, the earliest date of constructive or actual use of the OLD PEPPER BOURBON trademark by Applicant upon which it can ever rely will be no earlier than August 2, 2012.

21. Applicant's use, intended use, and application of the OLD PEPPER BOURBON mark was and continues to be without Opposer's consent or permission.

22. On information and belief, prior to filing its aforementioned OLD PEPPER BOURBON application, Applicant itself or, through an affiliate, attempted to purchase the PEPPER Family of Marks from Opposer.

23. Applicant's or Applicant's affiliate's attempted purchase of the PEPPER Family of Marks from Opposer infers Applicant's recognition that Opposer is the rightful owner of the PEPPER Family of Marks.

24. On information and belief, Applicant or Applicant's affiliate has begun and/or intends to build a distillery and bottling facility in Lexington, Kentucky in order to produce bourbon and/or bourbon whisky goods in connection with the OLD PEPPER BOURBON trademark.

25. On information and belief, Applicant's or Applicant's affiliate buys or intends to buy bourbon and/or bourbon whisky goods from a distillery in Kentucky and sell it using the OLD PEPPER BOURBON trademark.

26. On information and belief, Applicant's or Applicant's affiliate's distillery and bottling facility in Lexington, Kentucky is or will be located inside the aforementioned James E. Pepper distillery that is a National Historic Landmark.

27. On information and belief, Applicant intends to reference the aforementioned and historic Pepper family on its OLD PEPPER BOURBON product labels and marketing materials.

28. Applicant is seeking to obtain Registration on the Principal Register of the trademark HENRY CLAY for use in connection with "Bourbon; Bourbon whisky" at U.S. Trademark Application Serial No. 85/693,759.

29. HENRY CLAY was a brand of whiskey produced and sold by James E. Pepper at his aforementioned distillery in Lexington, Kentucky.

COUNT I - LIKELIHOOD OF CONFUSION

30. Opposer hereby incorporates the allegations contained in Paragraph Nos. 1-29 by reference herein.

31. On information and belief, the goods for which Applicant is seeking registration of the OLD PEPPER BOURBON trademark are identical or substantially similar to the Goods in connection with which Opposer uses its PEPPER Family of Marks.

32. On information and belief, the goods for which Applicant is seeking registration of the OLD PEPPER BOURBON trademark are or will be produced in the same geographic region as the Goods of Opposer, namely, in the state of Kentucky.

33. On information and belief, the goods for which Applicant is seeking registration of the OLD PEPPER BOURBON trademark are offered to the same customers that Opposer offers its Goods in connection with its PEPPER Family of Marks.

34. On information and belief, the goods for which Applicant is seeking registration of the OLD PEPPER BOURBON trademark are offered through the same channels of trade that Opposer offers its Goods in connection with its PEPPER Family of Marks.

35. The OLD PEPPER BOURBON mark for which Applicant is seeking registration is substantially similar to the PEPPER Family of Marks which are used by and registered to Opposer.

36. PEPPER is the dominant word in Opposer's PEPPER Family of Marks.

37. PEPPER is the dominant word in Applicant's OLD PEPPER BOURBON trademark.

38. The only trademarks registered with the U.S. Patent and Trademark Office that contain the word PEPPER in connection with bourbon, bourbon whiskey, bourbon whisky, whiskey, or whisky are the three trademarks in Opposer's PEPPER Family of Marks.

39. The only pending trademark application with the U.S. Patent and Trademark Office that contains the word PEPPER in connection with bourbon, bourbon whiskey, bourbon whisky, whiskey, or whisky is for Applicant's OLD PEPPER BOURBON trademark.

40. Applicant's OLD PEPPER BOURBON trademark is confusingly similar to Opposer's PEPPER Family of Marks and use thereof by Applicant on the goods specified in Applicant's above-referenced OLD PEPPER BOURBON trademark application is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer or are otherwise endorsed, sponsored or approved by Opposer, whereby Opposer will be damaged by the registration of Applicant's claimed OLD PEPPER BOURBON trademark on the Principal Register of the U.S. Patent and Trademark Office.

41. If Applicant is granted registration of its claimed OLD PEPPER BOURBON trademark as shown in Applicant's above-listed application, Applicant will thereby obtain the *prima facie* exclusive right to use such mark in the United States, and such registration will impair and diminish Opposer's goodwill and rights in its PEPPER Family of Marks, thereby causing irreparable damage and injury to Opposer. Therefore, Opposer opposes registration of Applicant's claimed OLD PEPPER BOURBON trademark pursuant to 15 U.S.C. §§1052 and 1063(a), as amended by the Trademark Act of 1999.

COUNT II – DILUTION

42. Opposer hereby incorporates the allegations contained in Paragraph Nos. 1-29 by reference herein.

43. The trademarks in Opposer's PEPPER Family of Marks were famous and distinctive prior to any first use of the OLD PEPPER BOURBON trademark by Applicant.

44. Applicant's OLD PEPPER BOURBON trademark is likely to cause dilution of Opposer's PEPPER Family of Marks by tarnishment.

45. Applicant's OLD PEPPER BOURBON trademark is likely to cause dilution of Opposer's PEPPER Family of Marks by blurring.

PRAYER FOR RELIEF

WHEREFORE, Opposer prays that Applicant's above-referenced application for the OLD PEPPER BOURBON trademark be rejected, that Registration of the OLD PEPPER BOURBON trademark for the goods specified therein be refused, and that Opposer be awarded such further relief as this Board deems just and proper.

Respectfully submitted,

March 25, 2013

By: 
Andrew N. Spivak

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CERTIFICATE OF SERVICE

I, Andrew N. Spivak, one of the Attorneys for Opposer, hereby certify that on this 25th day of March, 2013, a true a correct copy of the foregoing NOTICE OF OPPOSITION was served via first class mail, postage prepaid upon:

Francisco A. Corrales
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