

ESTTA Tracking number: **ESTTA603398**

Filing date: **05/09/2014**

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

Proceeding	91212861
Party	Defendant Bacardi & Company Limited
Correspondence Address	JANICE HOUSEY SYMBUS LAW GROUP PO BOX 11085 MC LEAN, VA 22102-7985 UNITED STATES jhousey@symbus.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Janice Housey
Filer's e-mail	jhousey@symbus.com,trademarks@symbus.com
Signature	/janice housey/
Date	05/09/2014
Attachments	91212861 LIVE TRUE Answer to Amended Notice of Opposition & Counterclaim 5-9-14.pdf(110380 bytes )



7. Admit, but clarify that the correct filing date is February 26, 2013.
8. Applicant admits that Application Serial No.79/135543 was filed on September 13, 2013 as an extension of International Registration No. 1174013, and that an Office Action was issued on October 15, 2013 refusing registration because of a likelihood of confusion with Opposer's U.S. Registration No. 4222657. Applicant had until April 14, 2014 to file an Answer. Applicant denies that any "intent" can be derived from an application not at issue in the present proceeding, except to the limited extent noted in the Board's Order issued April 30, 2014.
9. Applicant is without sufficient information to admit or deny the results of Opposer's search of the internet. Applicant denies that it has used LIVE TRUE without DEWAR'S and denies that use of LIVE TRUE has any relevance to this proceeding except to the limited extent noted in the Board's Order of April 30, 2014.
10. Applicant denies.
11. Applicant is without sufficient information to admit or deny the quality of Opposer's goods, and therefore, denies. Applicant further answers that to the extent this paragraph seeks to put forth a basis for a Section 2(a), the Section 2(a) claim has been dismissed.
12.
  - a. Applicant denies as to the Section 2(d)-related claims and answers that the Section 2(a) claim has been dismissed.
  - b. Opposer's claim of deceptiveness was dismissed per the Board's Order of April 30, 2014 and therefore, no answer is required to this paragraph.
  - c. Applicant admits that it will continue to use its trademarks but denies that any actual or intended use of the mark LIVE TRUE (without the use of the word

DEWAR'S) has any relevance to this proceeding except to the limited extent noted in the Board's Order of April 30, 2014, denies that Opposer has prior and superior rights and denies that the Opposed Mark is a clear violation of any rights of Opposer.

- d. Applicant denies that any actual or intended use of the mark LIVE TRUE (without the use of the word DEWAR'S) has any relevance to this proceeding except to the limited extent noted in the Board's Order of April 30, 2014 and denies that the outcome of the present proceeding has any effect other than to determine the right of Applicant to register the Opposed Mark.

#### **AFFIRMATIVE DEFENSES**

Applicant alleges the following affirmative defenses and reserves the right to allege additional affirmative defenses.

1. The DEWAR'S portion of Applicant's Mark is famous and therefore, there is no likelihood of confusion between Opposer's alleged mark and the mark opposed herein.

#### **COUNTERCLAIM FOR CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 4,222,657**

1. Bacardi & Company Limited, a corporation of Liechtenstein, with a registered address at 5 Aeulestrasse, Vaduz 9490, Liechtenstein (hereinafter "Bacardi") asserts that it is and will continue to be damaged by registration of the mark LIVE TRUE under Reg. No. 4,222,657, and accordingly, for the reasons set forth herein, petitions to cancel registration of the same.

2. Fairmont Holdings, Inc., a Florida corporation, with a business address in the USPTO records of 3400 S.W. 26th Terrace, #A-1, Dania, Florida 33312 (hereinafter “Fairmont”) is the owner of U.S. Reg. No. 4,222,657 (hereinafter the ‘657 Registration).
3. Bacardi is the owner of USPTO Ser. No. 85/859,951 for the mark for DEWAR’S LIVE TRUE for “Alcoholic beverages except beers” in Class 33.
4. Bacardi is the owner of USPTO Ser. No. 79/135,543 for the mark LIVE TRUE for “Alcoholic beverages (except beers)” in Class 33 and the USPTO has issued a refusal to register this mark on the basis of the prior registration for the mark LIVE TRUE owned by Fairmont.
5. Fairmont applied to register the mark LIVE TRUE on March 18, 2011 and claimed use of the mark since June 1, 2012 for “wine” in Class 33 and since March 15, 2011 for “Cigars, cigar boxes, cigar cutters and cigar tubes” in Class 34. This application matured into the ‘657 Registration on October 09, 2012.
6. Upon information and belief, Fairmont had not used LIVE TRUE as a valid trademark on any of the goods listed in the '657 Registration at the time it applied to register the LIVE TRUE mark, and has not used LIVE TRUE as a valid trademark at any time.
7. Accordingly, the '657 Registration should be cancelled as void *ab initio* for Fairmont's non-use of LIVE TRUE as a valid trademark in connection with any of the goods listed in the ‘657 Registration.
8. Alternatively, Fairmont abandoned the use of LIVE TRUE as a valid trademark in connection with the goods listed in the '657 Registration.
9. Alternatively, upon information and belief, to the extent Fairmont ever made lawful trademark use of LIVE TRUE in connection with the goods listed in the '657

Registration, Fairmont has ceased using the mark in connection with those goods and there is no evidence of any intent to resume use of the mark in connection with those goods and services in U.S. commerce.

The required fee was paid on November 15, 2013.

Respectfully submitted,

Bacardi & Company Limited



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Janice W. Housey  
Counsel for Applicant

Date: May 9, 2014

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### CERTIFICATE OF SERVICE

On this 9th day of May 2014, a true and correct copy of the foregoing ANSWER TO AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIM is being sent via email and first class mail, postage prepaid and addressed as follows:

[kim@kkolbacklaw.com](mailto:kim@kkolbacklaw.com)

Kim Kolback  
Law Offices of Kimberly Kolback  
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Janice W. Housey