

ESTTA Tracking number: **ESTTA755499**

Filing date: **06/29/2016**

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

Proceeding	91223605
Party	Defendant Bently Heritage L.L.C.
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Attachments	Motion To Set Aside Default.160629 (00076863xA1ADA).pdf(302126 bytes)

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8 Mark: EVE'S KISS

9
10 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
11 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

12 SAZERAC COMPANY, INC., a Delaware
13 limited liability company,

14 Opposer,

15 v.

16 BENTLY HERITAGE L.L.C., a Nevada
17 limited liability company,

18 Applicant.

**CONSENTED MOTION
TO SET ASIDE DEFAULT AND DISMISS
PROCEEDINGS PURSUANT TO
SETTLEMENT**

Opposition No. 91223605

Application No. 86463568

19
20 Applicant Bently Heritage L.L.C. (“Applicant”) applied to register the mark EVE’S KISS in
21 International Class 33 for “distilled spirits” on November 24, 2014. Opposer Sazerac Company, Inc.
22 (“Opposer”) opposed, citing its registration for KISS for “vodka” in the same class. The parties
23 negotiated a settlement of the matter whereby, the description of goods on which Applicant’s EVE’S
24 KISS mark may be used and registered was narrowed, namely, such use and registration will be limited
25 to “distilled spirits, namely, gin, rum, absinthe, whiskey and bourbon, but excluding vodka, liqueurs,
26 tequila and prepared cocktails.” (See Consent Agreement, a true and correct copy of which is attached
27 hereto as Exhibit A.) The parties exchanged final, signed settlement documents on the last day to which
28 they had agreed to extend the deadline for an Answer to the Opposition, namely, May 9, 2016.

1 Consistent with the settlement agreement, on June 20, 2016 the parties prepared and agreed upon
2 a consented Amendment of Application and Dismissal of Opposition Proceeding (a true and correct
3 copy of which is attached hereto as Exhibit B.) However, before this could be filed, when no answer or
4 other pleading indicating a settlement had been reached was filed by June 27, 2016, the Board issued a
5 Notice of Default.

6 Applicant now respectfully requests that the Board set aside the Notice of Default entered on
7 June 27, 2016 and accept the attached consented Amendment of Application and Dismissal of
8 Opposition Proceeding for good cause shown under TBMP §312.02. As shown below, good cause exists
9 here because (1) Applicant's delay in filing its Answer was inadvertent and not the result of willful
10 conduct or gross neglect; (2) Applicant's delay will not prejudice Opposer, who has consented to the
11 settlement and dismissal of this action ; and (3) Applicant and Opposer have successfully negotiated a
12 resolution to the proceedings, and respectfully request the Board accept the Consented Amendment of
13 Application and Dismissal of Opposition Proceeding.

14 **FACTS**

15 1. Opposer filed its Notice of Opposition opposing Applicant's Application Serial No.
16 8643568, and the Board sent notice of the conference, discovery, disclosure and trial schedule, on
17 September 2, 2015. According to the Board's notice, Applicant's Answer was due on October 12, 2015.

18 2. On October 8, 2015, Applicant filed, and the Board granted, a consented Motion for an
19 Extension of Answer, extending Applicant's deadline to file its Answer to November 11, 2015.
20 Thereafter, as the parties negotiated towards a settlement, they agreed to three more consented motions
21 to extend time for an answer to be filed.

22 3. On May 9, 2016, the date upon which the last extension was to expire, Applicant and
23 Opposer exchanged fully-signed settlement and consent agreements whereby they agreed upon a
24 resolution of the proceedings. On June 20, 2016, they implemented that agreement by agreeing upon a
25 consented Amendment of Application and Dismissal of Opposition Proceeding. Under these
26 circumstances, entry of default now would be a miscarriage of justice, and thus the Board's Notice of
27 Default should be set aside. The case should instead be resolved as the parties have agreed, with a
28 consent agreement which serves the interests of the public and of the parties alike.

1 **ARGUMENT**

2 The law favors deciding cases on their merits. Therefore the Board is “reluctant to grant
3 judgments by default and tend[s] to resolve doubt in favor of setting aside a default.” *Paolo’s Associates*
4 *Ltd. Partnership v. Bodo*, 21 U.S. P.Q.2d 1899, *3 (T.T.A.B. 1990). “Good cause for setting aside a
5 default requires a showing that (1) the delay in filing was not the result of willful conduct or gross
6 neglect; (2) the delay will not result in substantial prejudice to the opposing party; and (3) the defendant
7 has a meritorious defense.” J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*,
8 §20:130 (4th ed. 2016).

9 Applicant’s delay here was not willful, but rather resulted from an oversight as the parties
10 concluded an amicable resolution to this matter and finalized the settlement documents. Opposer will
11 suffer no prejudice whatsoever, as it has agreed to dismiss its opposition on terms satisfactory to it. As
12 the case has settled, an Answer to the Opposition is now wholly unnecessary. Clearly a resolution of the
13 case which permits the registration of the opposed mark in question strongly suggests that meritorious
14 defenses existed.

15 **PRAYER**

16 WHEREFORE, for the reasons stated, Applicant respectfully requests that the Board set aside its
17 Notice of Default and accept the consented Amendment of Application and Dismissal of Opposition
18 Proceeding.

19 Dated: June 29, 2016

Respectfully submitted,

21 HARVEY SISKIND LLP
22 D. PETER HARVEY
KATE W. MCKNIGHT

23 By /D. Peter Harvey/

24 D. Peter Harvey

25 Attorneys for Applicant
26 Bently Heritage L.L.C.

Exhibit A
to Consented Motion to Set Aside Default

Offered by Applicant Bently Heritage L.L.C.

Sazerac Company, Inc. v.
Bently Heritage L.L.C.

Opposition No. 91223605

CONSENT AGREEMENT

This Consent Agreement (“Agreement”) is entered into as of the date of the last signature below (the “Effective Date”) by and between SAZERAC BRANDS, LLC, a Delaware limited liability company with a place of business at 10400 Linn Station Road, Suite 300, Louisville, Kentucky 40223 (“Sazerac”) and BENTLY HERITAGE, L.L.C., a Nevada limited liability company with a place of business at 1597 Esmeralda Avenue, Minden, NV 89423 (“Bently”). Sazerac and Bently are referred to individually as a “Party” or collectively as the “Parties.”

WHEREAS, the Parties have entered into that certain Settlement and Coexistence Agreement of even date herewith, and this Consent Agreement is subject to, directed by and contingent upon that Settlement and Coexistence Agreement;

WHEREAS, Sazerac, through its parent company Sazerac Company, Inc., and its predecessors in interest have used the KISS trademark (the “KISS Mark”) on and in connection with distilled spirits since at least as early as November of 2006, and Sazerac owns Trademark Registration No. 3,506,350 at the United States Patent and Trademark Office (“USPTO”) for the KISS Mark in connection with “vodka” in International Class 33;

WHEREAS, Bently intends to offer distilled spirits, namely, gin, rum, absinthe, whiskey and bourbon, but expressly excluding vodka, liqueurs, tequila and prepared cocktails, under the trademark EVE’S KISS and to register said mark for said goods, as reflected in its application filed with the USPTO under U.S. Serial No. 86463568 (as amended);

WHEREAS, it is the Parties’ belief that their products and marks may coexist without consumer confusion and are committed to cooperate in good faith to achieve that objective;

NOW THEREFORE, in consideration of the mutual covenants contained herein and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the Parties agree as follows:

1. Sazerac consents to and will not challenge, oppose, petition to cancel or otherwise object to or take any action, or aid any other party in any such action, against Bently’s use, application to register, and registration of the mark EVE’S KISS with respect to distilled spirits,

namely, gin, rum, absinthe, whiskey and bourbon, but excluding vodka, liqueurs, tequila and prepared cocktails, in any jurisdiction, including without limitation, U.S. Serial No. 86463568 (as amended).

2. Bently consents to and will not challenge, oppose, petition to cancel or otherwise object to or take any action, or aid any other party in any such action, against Sazerac's use, application to register or registration of the mark KISS with respect to vodka, liqueurs, tequila and prepared cocktails in any jurisdiction, including without limitation, U.S. Registration No. 2,988,971.

3. The Parties to this Agreement, being most familiar with the realities of the marketplace, acknowledge and agree that the nature of their use of their respective marks makes it unlikely that any consumer confusion will occur between them. The Parties will cooperate as needed to ensure that the uses of their respective marks referenced herein will not create confusion among the consuming public. Should either Party become aware of any instances of actual confusion, it shall promptly notify the other Party thereof. The Parties shall thereafter work together in good faith to examine the circumstances surrounding the confusion, and to take appropriate action to prevent such confusion.

4. Each Party shall retain the right to enforce and/or defend its marks and related rights hereunder against third parties as it, in its sole discretion, deems appropriate.

5. This Agreement shall be binding upon, and shall inure to the benefit of, the Parties hereto, and their respective legal heirs, subsidiaries, successors, and assigns, and upon any and all others acting by or through them, or in privity with them, or under their direction.

6. The geographic scope of this Agreement shall be worldwide.

<SIGNATURE PAGE FOLLOWS>

IN WITNESS WHEREOF, the Parties have caused this Consent Agreement to be signed as of the day, month and year set forth below in each of the Parties' signatures hereto:

BENTLY HERITAGE, L.L.C.

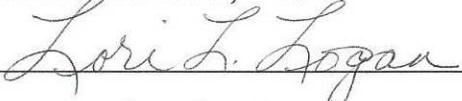
By:  _____

Print Name: Brady J. Frey

Title: Chief Operating Officer

Date: 5/2/2016

SAZERAC BRANDS, LLC

By:  _____

Print Name: Lori L. Logan

Title: Marketing Director

Date: 5/3/16

129699110

Exhibit B
to Consented Motion to Set Aside Default

Offered by Applicant Bently Heritage L.L.C.

Sazerac Company, Inc. v.
Bently Heritage L.L.C.

Opposition No. 91223605

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

Sazerac Company, Inc.)	
)	
Opposer,)	
)	Opposition No. 91223605
v.)	
)	Directed to U.S. Ser. No. 86463568
Bently Heritage L.L.C.)	
)	
Applicant.)	

AMENDMENT OF APPLICATION AND
DISMISSAL OF OPPOSITION PROCEEDING

Applicant Bently Heritage L.L.C., with the consent of Opposer Sazerac Company, Inc. hereby amends the description of goods of U.S. Serial No. 86/463568 to “Distilled spirits, namely, gin, rum, absinthe, whiskey and bourbon, but excluding vodka, liqueurs, tequila and prepared cocktails” in Class 33.

Contingent upon the Board’s acceptance of Applicant’s amendment, Opposer dismisses the above-captioned opposition proceeding without prejudice, with Applicant’s consent.

Respectfully submitted,

<u>/s/ Peter Willsey</u> Peter Willsey Mary J. Klumpp Cooley LLP 1299 Pennsylvania Ave. N.W., Ste. 700 Washington, DC 20004 Attorneys for Opposer Sazerac Company, Inc.	<u>/s/ D. Peter Harvey</u> D Peter Harvey Harvey Siskind LLP Four Embarcadero Center, 39th Floor San Francisco, California 94111 Attorney for Applicant Bently Heritage L.L.C.
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1 **CERTIFICATE OF TRANSMISSION**

2 I hereby certify that true and correct copies of the attached CONSENTED MOTION TO
3 SET ASIDE DEFAULT (Opposition No. 91223605) are being electronically transmitted to the
4 Trademark Trial and Appeal Board on June 29, 2016.

5
6 */D. Peter Harvey/*
7 D. Peter Harvey

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