

ESTTA Tracking number: **ESTTA698066**

Filing date: **09/24/2015**

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	Bliss Canyon Winery Inc.
Granted to Date of previous extension	09/26/2015
Address	27665 Arnold Drive Sonoma, CA 95476 UNITED STATES
Attorney information	Ronald Wargo Friedemann Goldberg LLP 420 Aviation Blvd Suite 201 Santa Rosa, CA 95403 UNITED STATES rwargo@frigolaw.com Phone:707-543-4900

Applicant Information

Application No	86548909	Publication date	07/28/2015
Opposition Filing Date	09/24/2015	Opposition Period Ends	09/26/2015
Applicant	Ram's Gate Winery, LLC 28700 Arnold Drive Sonoma, CA 95476 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Wine

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
Other	Trademark Act section 1(b) - Applicant did not have a bona fide intention to use Applicant's Mark at the time the registration was filed.

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86705542	Application Date	07/27/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	TOLAY SPRINGS
Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: First Use: 0 First Use In Commerce: 0 Beer Class 033. First use: First Use: 0 First Use In Commerce: 0 Wine

Attachments	86705542#TMSN.png(bytes) TOLAY SPRINGS - Tolay Creek Opposition (00432121xA73BB).pdf(234773 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	/rpw/
Name	Ronald Wargo
Date	09/24/2015

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

In the Matter of Application No.: 86548909
For the Mark TOLAY CREEK
Applicant: Ram’s Gate Winery, LLC
Published in the Official Gazette on: July 28, 2015

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Bliss Canyon Winery, Inc. :
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 Opposer, :
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 v. :
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 Ram’s Gate Winery, LLC :
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 Applicant, :
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NOTICE OF OPPOSITION

Bliss Canyon Winery, Inc. (hereinafter “Opposer”), through its attorneys, believing it will be damaged by the registration of the trademark TOLAY CREEK (“Applicant’s Mark”), Application Serial No. 86548909, filed by Ram’s Gate Winery, LLC (hereinafter “Applicant”) on July 28, 2015, opposes the same and alleges on knowledge as to Opposer and otherwise on information and belief, as follows:

1. Opposer is a corporation organized and existing under the laws of the State of California with its principal place of business at 27665 Arnold Drive, Sonoma, California 95476.

Trademark Act § 2(d)

2. Opposer presently uses, and since October 2014 has used, the trademark “TOLAY SPRINGS” in connection with the production, distribution, and sale of beef in California.

3. Opposer presently uses, and since March 2015 has used, the trademark “TOLAY SPRINGS” in connection with the production, distribution, and sale of olive oil in California.

4. Opposer is the owner of all rights, title, and interest in and to TOLAY SPRINGS, including all common law rights therein.

5. TOLAY SPRINGS is distinctive and is a valid and legally protectable trademark.

6. On or about January 27, 2014, Opposer registered the domain name tolaysprings.com for the Tolay Springs Winery & Farmstead. On or about January 27, 2014, Opposer also registered the domain name tolaycreek.com, which redirects to tolaysprings.com.

7. On or about July 25, 2015, Opposer filed Application No. 86705542, for the trademark TOLAY SPRINGS for Beer (IC 032. US 045 046 048. G & S: Beer) and Wine (IC 033. US 047 049. G & S: Wine) (“Opposer’s Application”) based on its intention to use the TOLAY SPRINGS mark in connection with the production, distribution, and sale of wine and beer in the United States.

8. Opposer has priority over Applicant because it has used TOLAY SPRINGS in California since October 2014. Under the doctrine of natural expansion, the first user of the mark has prior rights in the mark for its own goods or services and for those goods or services which fall within the natural expansion of its business under the mark.

9. Opposer presently intends to use TOLAY SPRINGS in connection with wine and beer and has, as a result, filed Opposer’s Application. If Applicant’s application for registration for Applicant’s Mark is granted, Applicant would thereby obtain at least a prima facie right to use the mark for wine. This will be a source of damage and injury to Opposer because Applicant will have prima facie evidence of the validity of its confusingly similar mark and the exclusive right to use its confusingly

similar mark in commerce, in derogation of Opposer's rights in its TOLAY SPRINGS mark.

10. Applicant's Mark is similar to Opposer's TOLAY SPRINGS mark in sound, appearance, connotation, and commercial impression, particularly with respect to its dominant feature, the shared word "TOLAY." Further, according to the application, Applicant's Mark is intended for use in connection with wine. Wine is within the zone of natural expansion of Opposer's TOLAY SPRINGS mark, currently used in connection with beef and olive oil.

11. In the normal course of trade, Opposer's goods and Applicant's goods would be purchased by the same purchasers in the same channels of trade and would be marketed and promoted in the same channels. Accordingly, consumers would inevitably be led to believe that Applicant's "TOLAY CREEK" wine is produced by, is sponsored by, or is affiliated with Opposer.

12. The registration of Applicant's Mark for the goods recited in the application would be inconsistent with Opposer's rights in its TOLAY SPRINGS mark, and will cause damage to Opposer.

13. Use of the "TOLAY CREEK" mark by Applicant is likely to cause confusion, cause mistake, or deceive the public, and cause the public to believe that the goods offered in connection with its mark emanate from or are otherwise sponsored or endorsed by Opposer, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Trademark Act § 1(b)

14. Opposer is informed and believes, and on that basis alleges, that Applicant lacked a bona fide intention to use Applicant's Mark at the time the registration was filed. Evaluation of a "bona fide" intention requires a fair, objective determination of the applicant's intent "based on all of the circumstances." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994) *citing* S.Rep. No. 100-515, 100th

Cong. 2d Sess. at 24 (1988). The term is read in connection with the definition of “use in commerce” which requires that such use be “in the ordinary course of trade, and not merely to reserve a right in a mark.” *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAD 1993).

15. Applicant is aware that Opposer presently uses, and since October 2014 and March 2015 has used, the trademark “TOLAY SPRINGS” in connection with the production, distribution, and sale of beef and olive oil, respectively, in California.

16. On or about February 10, 2015, a representative of Opposer told a representative of Applicant of its specific intention to produce, distribute, and sell wine and beer under the TOLAY SPRINGS trademark. In fact, David Oliver, Managing Director of Applicant, visited Opposer’s facility which is located adjacent to Applicant’s facility.

17. At the time of the foregoing conversation, Opposer had not yet applied to use its TOLAY SPRINGS mark in connection with the sale of wine and beer because it had not yet determined that it would use the mark within a six-month period.

18. Approximately two weeks later, on or about February 27, 2015, Applicant filed its application to use “TOLAY CREEK” for wine on the basis that it has “a bona fide intention” to use the mark in commerce.

19. Opposer discovered Applicant’s application to use Applicant’s Mark when it filed Opposer’s Application on or about July 25, 2015.

20. Opposer is informed and believes, and on that basis alleges, that at the time Applicant filed its application to use Applicant’s Mark, it did not have a bona fide intention to use the mark in commerce. Circumstances which support this contention include, but not limited to, the fact that: 1) Applicant registered “TOLAY CREEK” two weeks after being informed that Opposer planned to expand its use of its TOLAY SPRINGS mark for use with wine and beer; and 2) more than one year earlier, Opposer had registered the domain names tolaysprings.com and tolaycreek.com for the Tolay

Springs Winery & Farmstead, and this was either known to Applicant or knowable by typing the words into an internet browser address bar. These additional circumstances suggest that as of February 27, 2015, Opposer's intention was to warehouse the mark and/or trade on Opposer's goodwill.

21. The registration of Applicant's Mark for the goods recited in the application would be inconsistent with Opposer's rights in its TOLAY SPRINGS mark, and will cause damage to Opposer.

Trademark Act § 2(e)(2)

22. Tolay Creek is a well-known geographic feature appearing on United States Geological Survey maps that lends its name to the Tolay Creek Watershed.

23. Opposer is informed and believes, and on that basis alleges, that Tolay Creek is a 12.5-mile-long southward-flowing stream in southern Sonoma County, California, USA, which flows through Tolay Lake and ends in north San Pablo Bay.

24. Opposer is the record owner of vineyard property adjacent to vineyard property owned by Applicant, and Opposer is informed and believes, and on that basis alleges, that Tolay Creek runs through the vineyard properties of Opposer and Applicant, among others. Opposer is informed and believes, and on that basis alleges, that Applicant intends to use Applicant's Mark in connection with wine originating from its vineyard property adjacent to Tolay Creek.

25. Opposer would be damaged by Applicant's Mark because it currently uses, and has applied to register, its trademark "TOLAY SPRINGS," which is not a geographic feature or location on the United States Geological Survey maps. Due to the similarity of Applicant's Mark to TOLAY SPRINGS, in the event it is determined that Opposer does not have priority over Applicant's Mark, Applicant's registration of its mark would cast a cloud upon Opposer's right to continue to use and expand the use of its TOLAY SPRINGS trademark.

26. Because Tolay Creek is a location within the premier grape growing and wine making region of Sonoma County, Opposer is informed and believes, and on that basis alleges, that the primary significance of the mark as it is used is a generally known geographic place and the relevant purchasing public would be likely to believe that the goods for which the mark is sought to be registered originate in that place.

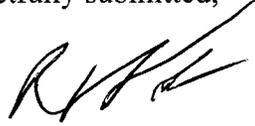
27. As used by Applicant when applied to the goods of Applicant, Applicant's Mark is primarily geographically descriptive within the meaning of 15 U.S.C. § 1052(e). Applicant's mark contains no suggestive, arbitrary, or fanciful qualities and as such, the mark is incapable of distinguishing Applicant's goods from those of any other place in or around Tolay Creek, Sonoma County, California.

28. Because use of the "TOLAY CREEK" mark by Applicant is primarily geographically descriptive within the meaning of 15 U.S.C. § 1052(e), it is invalid.

WHEREFORE, it is respectfully prayed that this Opposition be sustained and that Application No. 86548909 be denied registration.

DATED: September 24, 2015

Respectfully submitted,

By: 

RONALD P. WARGO II
Attorneys for Opposer
BLISS CANYON WINERY, INC.

CERTIFICATE OF SERVICE

STATE OF CALIFORNIA, COUNTY OF SONOMA

I am employed in the County of Sonoma, State of California. I am over the age of eighteen (18) and not a party to the within action. My business address is 420 Aviation Boulevard, Suite 201, Santa Rosa, California 95403.

On September 24, 2015, I served the foregoing document(s) described as:

NOTICE OF OPPOSITION

on the interested parties in this action as follows:

Ram's Gate Winery, LLC
28700 Arnold Drive
Sonoma CA 95476

[] BY UNITED STATES MAIL

I enclosed the document(s) listed above in an envelope or package addressed to the person(s) at the address(es) listed above and placed the envelope or package for collection and mailing following this firm's ordinary business practices. I am readily familiar with this firm's practice of collecting and processing correspondence for mailing. Under that practice, on the same day that correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service with postage thereon fully prepaid at Santa Rosa, California. I am aware that, on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after the date of deposit for mailing.

[XX] (FEDERAL) I declare that I am employed in the office of a member of the Bar of this Court, at whose direction the service was made.

Executed on September 24, 2015, at Santa Rosa, California.



David Wohlschlagger