

ESTTA Tracking number: **ESTTA723100**

Filing date: **01/27/2016**

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	Fifth Generation Inc.		
Entity	Corporation	Citizenship	Texas
Address	12101 Moore Road Austin, TX 78719 UNITED STATES		

Attorney information	W. Scott Brown Vinson & Elkins, L.L.P. 1001 Fannin Street, Suite 2500 Houston, TX 77002-6760 UNITED STATES iptldocket@velaw.com Phone:7137581105		
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**Applicant Information**

Application No	86504543	Publication date	12/29/2015
Opposition Filing Date	01/27/2016	Opposition Period Ends	01/28/2016
Applicant	TITOMIROV VODKA LLC 5800 Midhill St. Bethesda, MD 20817 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 033. First Use: 2015/02/00 First Use In Commerce: 2015/04/14 All goods and services in the class are opposed, namely: Vodka
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2216170	Application Date	10/07/1997
Registration Date	01/05/1999	Foreign Priority Date	NONE
Word Mark	TITO'S		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 033. First use: First Use: 1997/01/03 First Use In Commerce: 1997/04/11 Distilled Spirits

U.S. Registration No.	3328375	Application Date	11/03/2006
Registration Date	11/06/2007	Foreign Priority Date	NONE

Word Mark	TITO'S HANDMADE VODKA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 033. First use: First Use: 1997/01/03 First Use In Commerce: 1997/04/11 Distilled Spirits
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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	/wsb/
Name	W. Scott Brown
Date	01/27/2016

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

In the matter of U.S. Trademark Application Serial No. 86/504,543

For the mark: TITOMIROV VODKA

Filed: January 15, 2015

Published: December 29, 2015

FIFTH GENERATION INC.,	)	Opposition No. _____
Opposer,	)	
	)	
v. )	)	
	)	
TITOMIROV VODKA LLC	)	
	)	
Applicant.	)	

***NOTICE OF OPPOSITION***

Fifth Generation Inc., a corporation having an address of 12101 Moore Road, Austin, TX 78719, (“Opposer”), believes that it will be damaged by registration of the mark TITOMIROV VODKA that is the subject of U.S. Trademark Application Serial No. 86/504,543 (“Applicant’s Mark”) for “vodka” filed January 15, 2015, by Titomirov Vodka LLC, a Florida limited liability company having an address of record of 5800 Midhill St., Bethesda, Maryland 20817 (“Applicant”). Opposer opposes registration of Applicant’s Mark.

1. Opposer is engaged in the business of, among other things, distilling vodka. For over 18 years, Opposer has produced a premium vodka known and

marketed around the world as TITO'S<sup>®</sup> and TITO'S HANDMADE VODKA<sup>®</sup>.

2. Opposer prominently uses the TITO'S and TITO'S HANDMADE VODKA marks in marketing materials, newspaper and magazine advertisements, billboards, sports stadium signage, and nearly every other media that can be used to communicate with the public — including, of course, on the labels for its vodka. Opposer has invested millions of dollars in its marks, which has made the TITO'S and TITO'S HANDMADE VODKA marks instantly recognizable to many of the consumers in the United States, especially those consumers who drink vodka. Opposer's TITO'S and TITO'S HANDMADE VODKA marks are very famous marks. Indeed, once Opposer became aware of Applicant and the possibility that Applicant might use the TITOMIROV VODKA mark, Opposer's counsel sent a letter to Applicant informing it of Opposer's famous marks and raising concerns about Applicant introducing confusion into the marketplace.
3. Opposer is the owner of many registrations around the world of many marks used in connection with its vodka, including TITO'S and TITO'S HANDMADE VODKA. In the United States, Opposer owns incontestable registrations for the marks TITO'S (Reg. No. 2,216,170) and TITO'S

HANDMADE VODKA (Reg No. 3,328,375) for use in connection with distilled spirits.

4. On January 15, 2015, Applicant filed an application to register the mark TITOMIROV VODKA (Serial No. 86/504,543) (“Applicant’s Mark”) for use in connection with vodka. On April 22, 2015, the Examining Attorney issued an Office Action refusing registration of the mark on the basis of the mark being primarily merely a surname. Thereafter, Opposer filed a Letter of Protest submitting evidence of its registration of the marks TITO’S and TITO’S HANDMADE VODKA. On August 10, 2015, the Office of Trademark Deputy Commissioner for Trademark Examination Policy granted Opposer’s Letter of Protest and directed the Examining Attorney to consider whether to issue a requirement or refusal based upon a possible likelihood of confusion with Opposer’s TITO’S and TITO’S HANDMADE VODKA marks. Accordingly, the Examining Attorney issued an Office Action on August 11, 2015, refusing registration of Applicant’s Mark on the basis of a likelihood of confusion with Opposer’s TITO’S and TITO’S HANDMADE VODKA marks, in addition to the surname refusal raised in the earlier Office Action. In the Office Action the Examining Attorney noted the following in support of his likelihood of confusion findings:

- a. The goods are namely vodka and are presumed to travel in the same channels of trade to the same class of purchasers.
  - b. The standard of comparison where goods are identical is not as great as in the case of diverse goods.
  - c. The marks are similar and begin with the identical and distinctive prefix TITO.
  - d. The rationale for protection is not only to prevent buyer confusion, but also to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer.
5. Applicant's September 4, 2015 response to the Examiner's Office Action appears to be more focused on personal attacks than substantively addressing the issues raised in the Examiner's Office Action. After asserting that the granting of Opposer's Letter of Protest was "intellectually inconsistent and smacks of ethnic bias," Applicant accuses the Examiner of "racist argumentation."
6. Notwithstanding Applicant's personal attacks on the Trademark Deputy Commissioner and the Examiner, the Examiner issued a Final Office Action on September 8, 2015 that carefully considered Applicant's arguments and provided a detailed likelihood of confusion analysis. Specifically, the Examiner found that Applicant's arguments against a likelihood of confusion

with Opposer's marks were unpersuasive. In making the Section 2(d) refusal final, the Examiner reiterated his earlier likelihood of confusion findings listed above and specifically acknowledged the marketplace confusion that would result through the use of the abbreviated term "TITO'S" when consumers were attempting to order TITOMIROV VODKA.

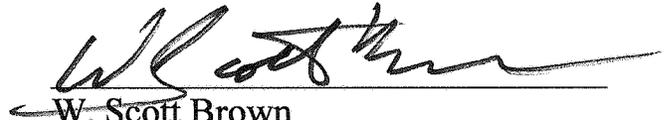
7. However, for reasons unknown by reviewing the record within the Trademark Office and completely inconsistent with the arguments set forth in the Final Office Action, the Examiner eventually approved the application for publication. The subject application was published for opposition on December 29, 2015.
8. Applicant's Mark so resembles Opposer's TITO'S and TITO'S HANDMADE VODKA marks as to be likely when used on or in connection with Applicant's goods, namely vodka, to cause confusion, or to cause mistake or to deceive the consuming public as to the source of the goods.
9. Applicant's Mark is also likely to diminish and dilute the value of Opposer's TITO'S and TITO'S HANDMADE VODKA marks to the great detriment of Opposer's marks, thus significantly damaging Opposer and the goodwill imbued in Opposer's marks.
10. Upon information and belief, it does not appear that Applicant commenced use of Applicant's Mark in U.S. commerce as a trademark for the goods of

Applicant as of the First Use in Commerce Date specified in Applicant's Amendment to Allege Use.

**WHEREFORE**, Opposer requests that this Notice of Opposition be sustained in its favor and Application Serial No. 86/504,543 be rejected.

Please address all correspondence to W. Scott Brown at the address listed below.

Respectfully submitted,



W. Scott Brown

Registry No. 32,968

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**ATTORNEY FOR OPPOSER**

**CERTIFICATE OF ELECTRONIC FILING**

The undersigned hereby certifies that this NOTICE OF OPPOSITION was electronically filed with the Trademark Trial and Appeal Board on January 27, 2016.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that he has caused the foregoing Notice of Opposition to be served upon Applicant's attorney of record, Rebeccah Gan, by depositing a true copy of the same with the United States Postal Service as first class mail in a sealed envelope, first-class postage prepaid, addressed to Rebeccah Gan, Wenderoth, Lind & Ponack, L.L.P., 1030 15th Street, N.W., Suite 400 East, Washington, DC 20005.



W. Scott Brown  
Registry No. 32,968