

ESTTA Tracking number: **ESTTA731993**

Filing date: **03/08/2016**

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	FRANCISCAN VINEYARDS, INC
Granted to Date of previous extension	03/09/2016
Address	1178 GALLERON ROAD ST. HELENA, CA 94574 UNITED STATES

Attorney information	Stephen L. Baker Baker and Rannells, P.A. 92 East Main St, Ste. 302 Somerville, NJ 08876 UNITED STATES jld@br-tmlaw.com,K.Hnasko@br-tmlaw.com,s.baker@br-tmlaw.com
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### Applicant Information

Application No	86709910	Publication date	11/10/2015
Opposition Filing Date	03/08/2016	Opposition Period Ends	03/09/2016
Applicant	San Bartolo Farms, Inc. 9801 N. Litchfield Rd. El Mirage, AZ 85335 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: Distilled Spirits
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### Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
No bona fide intent to use mark for identified goods or services	Trademark Act section 1(b)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1125844	Application Date	02/25/1977
Registration Date	10/09/1979	Foreign Priority Date	NONE
Word Mark	FRANCISCAN		

Design Mark	<b>FRANCISCAN</b>
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 1951/09/24 First Use In Commerce: 1951/09/24 WINES

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	FRANCISCAN		
Goods/Services	those goods closely-related to alcohol beverages including ancillary services such as hosting events (receptions, lunches, dinners, and corporate affairs); wine tastings; and educational services in the field of wines, etc.		

Attachments	73117068#TMSN.png( bytes ) Notice of Opposition.pdf(74912 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	/Jason DeFrancesco/
Name	Jason DeFrancesco
Date	03/08/2016



3. On April 21, 2015, Applicant filed an intent-to-use trademark application, Application Serial No. 86709910, for the word mark FRANCISCO'S RESERVE ("Applicant's Mark"), as a trademark for "distilled spirits" ("Applicant's Goods").

4. At the time of filing Application Serial No. 86709910, Applicant did not have use of Applicant's Mark in US commerce.

5. At the time of filing Application Serial No. 86709910, Applicant did not have intent to use the applied-for mark in U.S. commerce.

6. Application Serial No. 86709910 is void ab initio under Trademark Act Section 1(b) because Applicant lacked the requisite bona fide intent to use the mark in commerce when it filed for registration of Applicant's Mark.

7. Application Serial No. 86709910 was published for opposition in the Official Gazette on November 10, 2015 and the time to oppose has been extended to March 9, 2016.

8. Opposer is the owner of the mark FRANCISCAN, which is subject to numerous trademarks, trade names and service marks used in association with a variety, and constantly expanding field of goods and services ("Opposer's Mark").

9. Opposer has long used Opposer's Mark continuously on and in association with goods and services in commerce that are closely-related to Applicant's Goods, which include but are not limited to the alcohol trade, adult beverages, and other ancillary goods and services related thereto such as restaurant services; the hosting of events such as private receptions, lunches, dinners, and corporate affairs; wine tastings; educational services in the field of wines and other related entertainment services.

10. In addition to the foregoing goods and services provided for in paragraph no. 9 above, Opposer is the owner of the incontestable registration, Registration No. 1125844, on the Principal Register of the United States Patent and Trademark Office, Registered October 9, 1979 for the mark FRANCISCAN for “wines.”

(Hereinafter, the goods and services referenced in paragraph nos. 8, 9 and 10 are referred collectively as “Opposer’s Goods and Services.”)

11. Opposer’s Goods and Services have been widely-advertised, promoted, continuously used, offered for sale and sold throughout the United States under Opposer’s Mark, prior to any date which may be claimed by Applicant, and Opposer has priority.

12. Opposer is now, and has been for many years, trading under, known by and referred to by Opposer’s Mark, this identifying Opposer as the exclusive source of Opposer’s Goods and Services.

13. Applicant’s Goods under Applicant’s Mark travel through the same channels of trade as Opposer’s Goods and Services under Opposer’s Mark, thus causing Applicant’s Goods under Applicant’s Mark to be directed to the same ultimate consumer as Opposer’s Goods and Services under the Opposer’s Mark.

14. Opposer’s Mark and Applicant’s Mark are substantially identical and or confusingly similar when applied to the respective goods and services of the parties.

15. Applicant’s Goods are in-part identical, in-part closely related and in-part similar to Opposer’s Goods and Services or within Opposer’s ever expanding natural progression of goods and services and channels of trade.

16. Applicant's purported intention to use, and or use thereof with respect to Applicant's Mark in commerce is without the approval, consent or permission of the Opposer.

17. The registration of Applicant's Mark will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's Goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), all to Opposer's irreparable damage.

18. Applicant's Mark falsely suggests a connection with Opposer, and or will bring Opposer into contempt or disrepute, in violation of §2(a) of the Lanham Act, 15 U.S.C. §1052(a), all to Opposer's irreparable damage.

19. Any use of Applicant's Mark on related goods by Applicant shall point uniquely and unmistakably to the Opposer, such that consumers who encounter Applicant's Mark will recognize Applicant's Mark as pointing uniquely and unmistakably to the source of Opposer's Mark, namely, the Opposer causing damage to the Opposer.

20. Issuance of registration for Applicant's Mark to Applicant will create a false and misleading connection to the Opposer, all to the irreparable damage of the consumer and the Opposer.

21. Issuance of registration for Applicant's Mark to Applicant will create a cloud on Opposer's rights to use Opposer's Marks for Opposer's Goods and Services.

WHEREFORE, Opposer, Franciscan Vineyards, Inc. prays that the application for registration of Applicant's Mark, Serial No. 86709910, be denied and this Opposition be sustained.

Dated: March 8, 2016

Respectfully submitted,

By: /Jason DeFrancesco/  
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Attorneys for Opposer,  
Franciscan Vineyards, Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of Opposer's Notice of Opposition was forwarded by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this 8th day of March, 2016 to Applicant at the following address:

GEORGE U. WINNEY  
Gammage & Burnham, PLC  
2 N Central Ave, FL15  
Phoenix, AZ 85004-4470

/Jason DeFrancesco/  
Jason L. DeFrancesco