

ESTTA Tracking number: **ESTTA733404**

Filing date: **03/14/2016**

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	Sazerac Brands, LLC
Granted to Date of previous extension	03/13/2016
Address	10400 Linn Station Road, Suite 300 Louisville, KY 40223 UNITED STATES
Party who filed Extension of time to oppose	Southern Comfort Properties, Inc.
Relationship to party who filed Extension of time to oppose	On March 1, 2016, Sazerac Brands, LLC, and its parent company, Sazerac Company Inc., acquired certain assets of Southern Comfort Properties, Inc., including its intellectual property and trademarks. Thus, pursuant to 37 CFR Â§ 2.102(b), Opposer respectfully request its opposition be accepted.

Attorney information	Shane Rumbaugh Cooley LLP 1299 Pennsylvania Ave, NW Washington, DC 20004 UNITED STATES srumbaugh@cooley.com, trademarks@cooley.com, vbadolato@cooley.com, pwillsey@cooley.com Phone:202-728-7107
----------------------	---

Applicant Information

Application No	86366296	Publication date	09/15/2015
Opposition Filing Date	03/14/2016	Opposition Period Ends	03/13/2016
Applicant	Robinette, Patrick Rt 1 Box 158 Pinetops, NC 27864 UNITED STATES		

Goods/Services Affected by Opposition

Class 029. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Fresh meat; Meat, frozen

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)
Dilution by tarnishment	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1522030	Application Date	06/26/1987
Registration Date	01/24/1989	Foreign Priority Date	NONE
Word Mark	SOUTHERN COMFORT		
Design Mark	SOUTHERN COMFORT		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1934/01/19 First Use In Commerce: 1934/01/19 LIQUEUR		

U.S. Registration No.	2254264	Application Date	07/16/1997
Registration Date	06/15/1999	Foreign Priority Date	NONE
Word Mark	SOCO		
Design Mark	SOCO		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1992/11/01 First Use In Commerce: 1992/11/01 alcoholic beverages, namely, liqueurs		

U.S. Registration No.	2613240	Application Date	04/25/2000
Registration Date	08/27/2002	Foreign Priority Date	NONE
Word Mark	SOUTHERN COMFORT		
Design Mark	SOUTHERN COMFORT		
Description of Mark	NONE		

Goods/Services	Class 021. First use: First Use: 1980/12/31 First Use In Commerce: 1980/12/31 Glass and plastic drinking containers, namely, [flasks, ceramic mugs, ceramic pitchers, ceramic jugs, sponges for household purposes, wood coasters, cork coasters,] swizzle sticks, [bowls, decorative boxes made of non-precious metal,] food and beverage containers, glassware for beverages, [and metal serving trays and serving trays made of non-precious metals]		
----------------	--	--	--

U.S. Registration No.	1897081	Application Date	07/09/1993
Registration Date	05/30/1995	Foreign Priority Date	NONE
Word Mark	SOUTHERN COMFORT RESERVE		
Design Mark	SOUTHERN COMFORT RESERVE		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1994/04/11 First Use In Commerce: 1994/04/11 cordials and liqueurs		

U.S. Registration No.	2643948	Application Date	09/06/2000
Registration Date	10/29/2002	Foreign Priority Date	NONE
Word Mark	SOUTHERN COMFORT		
Design Mark	SOUTHERN COMFORT		
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 1987/12/31 First Use In Commerce: 1987/12/31 Dairy products excluding ice cream, icemilk and frozen yogurt		

U.S. Registration No.	3516262	Application Date	03/20/2008
Registration Date	10/14/2008	Foreign Priority Date	NONE
Word Mark	SOCO HURRICANE		

Design Mark	SOCO HURRICANE
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 Prepared alcoholic cocktail

Attachments	73668904#TMSN.png(bytes) 75325130#TMSN.png(bytes) 76034497#TMSN.png(bytes) 74411718#TMSN.png(bytes) 76123483#TMSN.png(bytes) 77427283#TMSN.png(bytes) Sazerac - Notice of Opposition - SOCO PROVISIONS.pdf(37055 bytes)
-------------	--

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	/Shane Rumbaugh/
Name	Shane Rumbaugh
Date	03/14/2016

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

In the Matter of Application Serial No. 86/366,296
For the Trademark SOCO PROVISIONS
Published in the *Official Gazette* on September 15, 2015

SAZERAC BRANDS, LLC,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
Patrick Robinette,)	
)	
Applicant.)	
<hr style="border: 0.5px solid black;"/>		
)	

NOTICE OF OPPOSITION

Opposer Sazerac Brands, LLC (“Sazerac”), a Delaware limited liability company having its principal place of business at 10400 Linn Station Road, Suite 300, Louisville, Kentucky 40223, will be damaged by the issuance of a registration for the mark SOCO PROVISIONS (the “Applicant’s Mark”), as applied for in Application Serial No. 86/366,296 filed on August 14, 2014, by Applicant Patrick Robinette, an individual with a mailing address of Rt. 1 Box 158, Pinetops, North Carolina 27864 (“Applicant”).

As grounds for opposition, Sazerac alleges as follows.

1. Sazerac, through its parent company Sazerac Company, Inc. (“Sazerac Company”), markets and sells a number of different types and brands of alcoholic beverages and distilled spirits, including vodkas, whiskeys, tequilas, liqueurs, and other spirits. Sazerac Company has marketed and sold alcoholic beverages and distilled spirits in the United States for over a century.

2. On March 1, 2016, Sazerac and Sazerac Company acquired certain assets of

Southern Comfort Properties, Inc., along with its intellectual property including the following trademark registrations:

- SOUTHERN COMFORT (Reg. No. 1,522,030), issued January 24, 1989, for “liqueur”;
- SOUTHERN COMFORT RESERVE (Reg. No. 1,897,081), issued May 30, 1995 for “cordials and liqueurs”;
- SOCO (Reg. No. 2,254,264), issued June 15, 1999, for “alcoholic beverages, namely, liqueurs”;
- SOUTHERN COMFORT (Reg. No. 2,613,240), issued August 27, 2002, for “[g]lass and plastic drinking containers, namely, [flasks, ceramic mugs, ceramic pitchers, ceramic jugs, sponges for household purposes, wood coasters, cork coasters,] swizzle sticks, [bowls, decorative boxes made of non-precious metal,] food and beverage containers, glassware for beverages, [and metal serving trays and serving trays made of non-precious metals]”;
- SOUTHERN COMFORT (Reg. No. 2,643,948), issued October 29, 2002, for “[d]airy products excluding ice cream, ice milk and frozen yogurt”; and
- SOCO HURRICANE (Reg. No. 3,516,262), issued October, 14 2008, for “[p]repared alcoholic cocktail.”

(referred to collectively as the “SOCO Marks”).

**FIRST GROUND FOR OPPOSITION
LIKELIHOOD OF CONFUSION**

3. Sazerac incorporates by reference paragraphs 1 through 2, inclusive, as if fully set forth here.
4. Sazerac’s parent company and its predecessors-in-interest have consistently and

continually marketed and sold distilled spirits under the SOCO Marks since at least as early as 1989. By virtue of its marketing and the excellence of the underlying products, the public has come to know, rely on, and recognize the SOCO Marks as source identifiers for Sazerac Company's products and the products of its predecessors-in-interest.

5. In conjunction with use of the SOCO Marks, Sazerac Company's products and the products of its predecessors-in-interest have grown substantially in popularity across the United States.

6. On August 14, 2014, Applicant filed an application to register the mark SOCO PROVISIONS upon an intent-to-use basis in connection with "[f]resh meat; meat, frozen" in International Class 29.

7. The SOCO Marks have priority through use in commerce and filing dates prior to Applicant's filing date of August 14, 2014.

8. The SOCO Marks are strong and well-known.

9. Applicant's Mark is similar in sight, sound, meaning, and commercial impression to the SOCO Marks.

10. Applicant's Mark is intended for use in connection with products that are closely related to the products Sazerac Company offers under the SOCO Marks.

11. Applicant's target customer base overlaps with the consumers of Sazerac Company's alcoholic beverages and dairy products.

12. As Applicant's description of goods lacks any restrictions or limitations as to the Applicant's channels of trade, Sazerac may assume that Applicant's Mark, like the SOCO Marks, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's intended channels of trade for its food-based products overlap with

channels of trade used in marketing, selling, and otherwise distributing alcohol-based and dairy products marketed under the SOCO Marks.

13. If Applicant is permitted to register Applicant's Mark for the goods specified in the Application herein opposed, confusion resulting in damage and injury to Sazerac would occur. Persons familiar with the SOCO Marks would likely perceive Applicant's products as associated with, affiliated with, or sponsored by Sazerac. Such confusion would inevitably result in damage to Sazerac.

14. Sazerac's customers and the relevant public are likely to misapprehend Applicant's Mark as a Sazerac trademark rather than a mark of Applicant, and/or believe in error that goods offered under the Applicant's Mark are offered by, in association with, or under license from Sazerac.

15. Any defect, objection to, or fault found with Applicant's food products marketed under its SOCO PROVISIONS mark would necessarily reflect on and seriously injure the reputation that Sazerac has established for the alcoholic beverage and dairy products offered under the SOCO Marks.

16. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use its SOCO PROVISIONS mark, all to the detriment of Sazerac. As such, for the reasons set forth herein, registration of Applicant's Mark should be denied pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

**SECOND GROUND FOR OPPOSITION
DILUTION OF A FAMOUS MARK**

17. Sazerac incorporates by reference paragraphs 1 through 16, inclusive, as if fully set forth here.

18. The SOCO Marks are highly distinctive of Sazerac's goods.
19. Sazerac and its predecessors-in-interest have used the SOCO Marks since at least 1989 for alcoholic beverage products.
20. Sazerac and its predecessors-in-interest have extensively advertised and promoted the SOCO Marks. Sazerac and the SOCO Marks have also enjoyed extensive media attention.
21. As a result of the considerable publicity afforded the SOCO Marks, and the strong and loyal base of customers that Sazerac enjoys for its goods, the SOCO Marks have a high degree of consumer recognition.
22. Sazerac is the owner of U.S. registrations for the SOCO Marks.
23. Accordingly, when the public encounters the term "SOCO" or "SOUTHERN COMFORT" it immediately associates the terms with Sazerac. Thus the SOCO Marks are famous.
24. The SOCO Marks became famous before Applicant filed its application for the SOCO PROVISIONS mark on August 14, 2014.
25. The SOCO PROVISIONS mark is similar to the SOCO Marks, and it is likely to cause dilution of the famous SOCO Marks, including dilution by blurring, all to Sazerac's damage.
26. Registration of the mark herein opposed is likely to dilute Sazerac's famous SOCO Marks by creating an association between the marks that impairs the distinctiveness of the SOCO Marks. Thus, Applicant's SOCO PROVISIONS mark is unregistrable pursuant to Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063, 1125.
27. Wherefore, Sazerac prays that this Opposition be sustained and that Application Serial No. 86/366,296 be denied and refused registration.

COOLEY LLP

Date: March 14, 2016

By: /Shane Rumbaugh/

Peter J. Willsey, Esq.
Vincent J. Badolato, Esq.
Shane M. Rumbaugh, Esq.
1299 Pennsylvania Ave.,
NW, Suite 700
Washington, D.C. 20004
Tel: (202) 842-7800
Fax: (202) 842-7899
Email: trademarks@cooley.com

*Attorneys for
Sazerac Brands, LLC*

CERTIFICATE OF SERVICE

I hereby certify that I mailed the foregoing **NOTICE OF OPPOSITION** regarding *Sazerac Brands, LLC v. Patrick Robinette*, to the listed Correspondence Information for Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Patrick Robinette
Rt. 1 Box 158
Pinetops, North Carolina 27864

Date: March 14, 2016

By: /Shane Rumbaugh/
Shane M. Rumbaugh