

ESTTA Tracking number: **ESTTA756784**

Filing date: **07/07/2016**

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

Proceeding	91227653
Party	Plaintiff Sazerac Brands, LLC
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Date	07/07/2016
Attachments	Sazerac - Answer to Cancellation Counterclaims in BULLSHINE FIRE-BULL.pdf(24503 bytes)

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

SAZERAC BRANDS, LLC,)	
)	
Opposer/Counterclaim Respondent,)	Opposition No. 91227653
)	
v.)	Trademarks:
)	FIREBALL (Reg. No 2,852,432)
BULLSHINE DISTILLERY LLC,)	FIREBALL (Reg. No. 3,550,110)
)	FIREBALL & Design (Reg. No. 3,734,227)
)	
)	BULLSHINE FIREBULL (Serial No.
)	86/750,668)
Applicant/Counterclaim Petitioner.)	
)	
)	
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SAZERAC BRANDS, LLC’S ANSWER TO PETITIONER’S COUNTERCLAIMS

Sazerac Brands, LLC (“Sazerac”) hereby answers the Counterclaims for Cancellation (“Counterclaims”) of Sazerac’s Registration Nos. 2,852,432, 3,550,110, and 3,734,227, asserted by Bullshine Distillery LLC (“Bullshine Distillery” or “Petitioner”), as follows.

Counterclaim 1 – Fraud on the PTO

20. Sazerac admits that Petitioner seeks cancellation of U.S. Reg. No. 2,852,432, but denies that said registration was maintained fraudulently.

21. Admitted.

22. Sazerac admits that, on August 5, 2009, it filed a Combined Declaration of Use and Incontestability under Sections 8 and 15 for U.S. Reg. No. 2,852,432 and that Mr. Todd Bontemps signed the 8 & 15 declaration affirming that the subject mark had been in continuous use in commerce on or in connection with the goods and/or services as evidenced by the specimen submitted therewith. Sazerac further admits that that the specimen, described as an

“actual photograph of registrant’s product,” includes a photograph of a bottle with a label that states in part, “DR. MCGILLICUDDY’S IMPORTED FIREBALL, ORIGINAL FORMULA, CINNAMON FLAVORED WHISKY,” IMPORTED BY SAZERAC CO., INC.”, but denies any allegation that the foregoing words were displayed in equal type size or prominence on the label in question. Finally, Sazerac admits that a Notice of Acceptance and Acknowledgment of the Sections 8 and 15 Declaration was mailed by the United States Patent and Trademark Office on September 4, 2009. All other allegations contained in Paragraph 22 are denied.

23. Sazerac admits that, on June 4, 2014, it filed a Combined Declaration of Use and Incontestability under Sections 8 and 9 for U.S. Reg. No. 2,852,432 and that Mr. Todd Bontemps signed that same 8 & 15 Declaration, affirming that the subject mark had been in continuous use in commerce on or in connection with the goods and/or services as evidenced by the specimen submitted therewith. Sazerac further admits that that the specimen includes a photograph of a bottle with a label that states in part, “FIREBALL RED HOT [CINNAMON] WHISKY, WHISKY WITH NATURAL CINNAMON FLAVOR”, but denies any allegation that the foregoing words were displayed in equal type size or prominence on the label in question. Finally, Sazerac admits that a Notice of Acceptance and Renewal of the Sections 9 and 15 Declaration was mailed by the United States Patent and Trademark Office on September 4, 2009. All other allegations contained in Paragraph 23 are denied.

24. Denied.

25. Sazerac admits that the United States Alcohol and Tobacco Tax and Trade Bureau (or “TTB”) regulates the sale of whisky and liqueurs in the United States. Paragraph 25 purports to refer to and cite provisions of the C.F.R. and the TTB’s Beverage Alcohol Manual,

and contains legal conclusions based on the same; such “allegations” do not require a response. Sazerac denies the remaining allegations in Paragraph 25.

26. Sazerac admits that the registration for FUEL YOUR FIRE (U.S. Reg. No. 4,564,436) identifies “[d]istilled spirits and liqueurs; prepared alcoholic cocktails.” Sazerac further admits “distilled spirits” and “liqueurs” are listed separately in the recitation for U.S. Reg. No. 4,564,436, but denies any inference made or allegation stated with respect to Sazerac’s state of mind or knowledge of the terms’ purported independence in so doing. Sazerac denies that the protection afforded by U.S. Reg. No. 4,564,436 does not cover with “whisky.”

27. Denied.

Counterclaim 2 -- Genericness

28. Sazerac incorporates by reference its responses to the allegations contained in paragraphs 20 through 27, inclusive, as if fully recited in this paragraph. Sazerac admits that Petitioner seeks cancellation of the referenced trademark registrations, but denies all other allegations in Paragraph 28.

29. Sazerac lacks knowledge or information sufficient to form a belief as to the truth of the other allegations in Paragraph 29 and, therefore, denies the same.

30. Denied.

31. Denied.

32. Denied.

33. Denied.

34. Sazerac admits that the Examining Attorney responsible for U.S. Reg. No. 2,847,730 (then U.S. Serial No. 75/941,554) required a disclaimer of the term FIREBALL on the

basis of descriptiveness and that, based on the Examining Attorney's request, Sazerac agreed to that disclaimer. Sazerac denies all other allegations in Paragraph 34.

35. Denied.

AFFIRMATIVE DEFENSES

1. Petitioner fails to state a claim on which relief can be granted.
2. Sazerac presently has insufficient knowledge or information upon which to form a belief as to whether it has additional, but as-yet-unstated, affirmative defenses available. Accordingly, Sazerac hereby reserves the right to assert additional affirmative defenses in the event it determines that such defenses are appropriate.

PRAYER FOR RELIEF

WHEREFORE, Sazerac prays that the Counterclaims for Cancellation be dismissed with prejudice.

COOLEY LLP

Date: July 7, 2016

By: /s/ Thomas M. Hadid
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Respondent, Sazerac Brands, LLC*

CERTIFICATE OF TRANSMITTAL AND SERVICE

I hereby certify that this Sazerac Brands LLC's Answer to Petitioner's Counterclaims for Cancellation is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below.

I hereby further certify that on the date indicated below, a true and correct copy of this Sazerac Brands, LLC's Answer Petitioner's Counterclaims for Cancellation was placed in the United States Mail via First Class Mail, addressed to counsel for petitioner as follows:

Mr. Kendal M. Sheets
Sheets Law Office
P.O. Box 71
McLean, Virginia 22101-0071

Date: July 7, 2016

/s/ Thomas M. Hadid
Thomas M. Hadid

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