

ESTTA Tracking number: **ESTTA37072**

Filing date: **06/28/2005**

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

Proceeding	92044336
Party	Defendant Celebration Distillation Corporation Celebration Distillation Corporation 2815 Frenchmen St. New Orleans, LA 70122
Correspondence Address	Celebration Distillation Corporation 2815 Frenchmen St. New Orleans, LA 70122
Submission	Motion to Suspend for Civil Action
Filer's Name	Andrea V. Timpa
Filer's e-mail	andrea@swemlaw.com
Signature	/s/ Andrea V. Timpa
Date	06/28/2005
Attachments	0991.avt.mot.suspend.pdf (53 pages)

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

MOET HENNESSEY ASIA PACIFIC	:	
PTE LTD.,	:	
	:	
Petitioner,	:	Reg. No. 2,926,706
	:	
v.	:	
	:	Cancellation No. 92044336
CELEBRATION DISTILLATION	:	
CORPORATION,	:	
	:	
Registrant	:	
	:	

MOTION TO SUSPEND PROCEEDINGS

NOW COMES Celebration Distillation Corporation (“Registrant”), who moves for a suspension of these proceedings pursuant to 37 C.F.R. § 2.117, for the following reasons, to wit:

1.

Registrant is the owner of trademark registration number 2926706 issued by the United States Patent and Trademark Office for the trademark CANE.

2.

On or about March 3, 2005, Moet Hennessey Asia Pacific Pte. Ltd. (“Petitioner”) filed the above-captioned Petition for Cancellation seeking cancellation of Registrant’s mark.

3.

On May 10, 2005, Registrant filed a Complaint against Petitioner in the United States District Court for the Eastern District of Louisiana in the matter entitled *Celebration Distillation Corporation v. Moet Hennessy USA, Inc. and Moet Hennessy Asia Pacific Pte Ltd*, case number 05-1816, Division “S”(2), asserting various violations of the Lanham Act including trademark infringement, dilution, and unfair competition, as well as state law violations of the Louisiana Unfair Trade Practices Act and dilution and tarnishment of Registrant’s mark under state law. *See* Complaint and First Amended Complaint attached hereto as Exhibit “A.”

4.

On May 23, 2005, Petitioner filed a Complaint against Registrant in the United States District Court for the Southern District of New York in the matter entitled *Moet Hennessy Asia Pacific Pte, Ltd., et al v. Celebration Distillation Corporation*, case number 05-4910, seeking a declaratory judgment of non-infringement and cancellation of Registrant’s mark under the Lanham Act. *See* Complaint and First Amended Complaint attached hereto as Exhibit “B.”

5.

The central issue in all three actions is Registrant’s right to use the CANE mark.

6.

37 C.F.R. § 2.117 provides that:

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. § 2.117; *see also* TTAB Manual of Procedure § 510.02(a).

7.

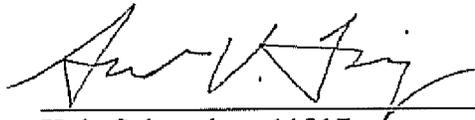
The actions pending before the United States District Courts for the Eastern District of Louisiana and the Southern District of New York embrace the same issues pending before the Board and the decisions of those Courts will have a bearing on this matter.

8.

Accordingly, the Board should suspend these proceedings, including the taking of discovery, until such time as the above-referenced civil actions are finally determined.

WHEREFORE, Registrant prays that this matter be suspended until the civil actions pending before the United States District Courts for the Eastern District of Louisiana and the Southern District of New York are finally determined.

Respectfully submitted,



Kyle Schonekas, 11817

Thomas M. McEachin, 26412

Andrea V. Timpa, 29455

SCHONEKAS, WINSBERG, EVANS
& MCGOEY, L.L.C.

400 Poydras Street, Suite 1440

New Orleans, Louisiana 70130

Telephone: (504) 680-6050

Facsimile: (504) 680-6051

Attorneys for Celebration Distillation Corporation

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Motion to Suspend Proceedings has been served upon counsel of record by U.S. mail, this 29th day of June, 2005.



ANDREA V. TIMPA

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

MOET HENNESSEY ASIA PACIFIC	:	
PTE LTD.,	:	
	:	
Petitioner,	:	Reg. No. 2,926,706
	:	
v.	:	
	:	Cancellation No. 92044336
CELEBRATION DISTILLATION	:	
CORPORATION,	:	
	:	
Registrant	:	
	:	

ORDER SUSPENDING PROCEEDINGS

The foregoing Motion to Suspend Proceedings filed by Registrant, Celebration Distillation Corporation, have been considered;

IT IS HEREBY ORDERED that these proceedings be suspended pursuant to 37 C.F.R. § 2.117 until the civil actions pending before the United States District Courts for the Eastern District of Louisiana and the Southern District of New York are finally determined.

Signed this _____ day of _____, 2005.

Director, U.S. Patent and Trademark Office

FILED
U.S. DISTRICT COURT
EASTERN DISTRICT OF LA

UNITED STATES DISTRICT COURT

2005 MAY 10 PM 4:19

EASTERN DISTRICT OF LOUISIANA

LORETTA G. WHITE
CLERK

CELEBRATION DISTILLATION
CORPORATION

CIVIL ACTION NO.:

05-1816

VERSUS

SECTION:

SECT. SMAG. 2

MOET HENNESSY USA, INC.
AND MOET HENNESSY ASIA
PACIFIC PTE LTD.

MAGISTRATE:

COMPLAINT

Plaintiff, Celebration Distillation Corporation, for its Complaint against Moet Hennessy Asia Pacific Pte Ltd., alleges as follows:

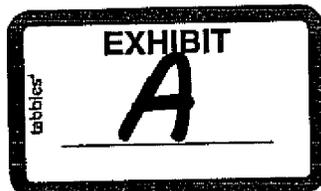
PARTIES

1.

Plaintiff, Celebration Distillation Corporation (hereinafter "Celebration"), is a Louisiana corporation with its principal place of business in New Orleans, Louisiana.

2.

Upon information and belief, defendant, Moet Hennessy USA, Inc. (hereinafter "Moet USA"), is a corporation formed under the laws of Delaware with its principal place of business in New York, New York.



Fee \$250.00
Process _____
 Dkid _____
ClRrnDsp _____
Doc. No _____

3.

Upon information and belief, defendant, Moet Hennessy Asia Pacific Pte, Ltd. (hereinafter "Moet Asia"), is a company formed under the laws of Singapore with its principal place of business in Singapore. Collectively, Moet Asia and Moet USA will sometimes be referred to as simply "Moet."

JURISDICTION AND VENUE

4.

This Court has jurisdiction, pursuant to 15 U.S.C. §§ 1051 *et seq.* (the Lanham Act), jurisdiction being conferred in accordance with 15 U.S.C. § 1121 and 28 U.S.C. § 1338(a) and (b).

5.

This Court also has jurisdiction over this civil action in accordance with 28 U.S.C. § 1332.

6.

This Court has jurisdiction over the Louisiana state statutory claims in accordance with the principles of supplemental jurisdiction pursuant to 28 U.S.C. § 1367(a).

7.

Venue is proper in the Eastern District of Louisiana, pursuant to 28 U.S.C. § 1391(b), in that a substantial part of the events or omissions giving rise to the claims occurred in this District; or, in the alternative, this is a District where the defendants may be found, as Moet USA and Moet Asia are subject to personal jurisdiction in this District.

FACTS

8.

Celebration is engaged in the manufacture and marketing of rum and other goods throughout the United States.

9.

Celebration is the owner of the following trademark registration issued by the United States Patent and Trademark Office ("USPTO") for the trademark, CANE ("CANE Mark"), used in connection with its rum products:

MARK	REG. NO.	REG. DATE	GOODS
CANE	2926706	February 15, 2005	Rum

10.

Registration of the CANE mark constitutes *prima facie* evidence of Celebration's exclusive right to use the CANE mark in commerce throughout the United States, pursuant to 15 U.S.C. § 1057(b).

11.

Celebration has sold rum under the CANE mark throughout the United States and has expended capital to advertise and promote the CANE products and the CANE mark.

12.

Celebration first used the CANE mark in 2003 and has made continuous use of the CANE mark since then.

13.

As a result of Celebration's extensive sales, promotion, and advertising, the CANE mark has become famous and represents extraordinarily valuable goodwill owned by Celebration.

14.

Since the beginning of 2004, Celebration has advertised its CANE products and CANE mark through its websites located at www.canerum.com and www.neworleansrum.com.

DEFENDANTS' UNLAWFUL ACTIVITIES

15.

Upon information and belief, Moet USA is a company that produces, markets, and distributes wine and spirits throughout the United States.

16.

Upon information and belief, Moet Asia is a company that produces, markets, and distributes wine and spirits throughout the world.

17.

Moet has been aware of Celebration's use and registration of the CANE mark since at least October of 2004.

18.

Upon information and belief, Moet is advertizing and selling, within the United States, rum products bearing the name, "10 CANE."

19.

Upon information and belief, Moet has advertised its 10 CANE products in print media, on the internet, and through its distributors.

20.

Upon information and belief, despite its knowledge of Celebration's duly-registered CANE mark, Moet launched their 10 CANE products in the United States on April 6, 2005.

21.

Upon information and belief, Moet has created and is using websites, located at www.10cane.com and www.10canerum.com, to advertise and sell their 10 CANE rum.

22.

Moet Asia attempted to register a trademark with the USPTO for 10 CANE.

23.

The USPTO suspended Moet Asia's application because of Celebration's prior registration of the CANE mark.

24.

In March of 2005, Moet Asia filed a Petition to Cancel Celebration's CANE mark with the USPTO's Trademark Trial and Appeal Board.

25.

Celebration has answered that Petition to Cancel and will vehemently defend its right to use the CANE mark.

COUNT 1: TRADEMARK INFRINGEMENT

26.

Celebration adopts, realleges, and incorporates the preceding allegations of its Complaint, as if copied herein *in extenso*.

27.

Moet's acts have caused and/or are likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Moet's marketing, distribution and sale of the 10 CANE products throughout the United States.

28.

On information and belief, Moet's acts have injured and/or are likely to injure Celebration's image and reputation with consumers in this District and elsewhere in the United States by creating confusion about, and dissatisfaction with, Celebration's CANE products and Celebration's customer support for these products.

29.

On information and belief, Moet's acts have injured and/or are likely to injure Celebration's reputation, business, and relations with its customers in this District and elsewhere in the United States by causing customer dissatisfaction, a diminution of the value of the goodwill associated with the CANE mark, and a loss of sales to Celebration.

30.

On information and belief, Moet's marketing and sale in this District and elsewhere in the United States of their 10 CANE products is a deliberate, intentional, and willful attempt to injure Celebration's business, to trade on Celebration's business reputation, to improperly benefit from Celebration's advertising in the United States, to confuse or deceive consumers, and to interfere with Celebration's business relationships with its distributors and its customers in this District and elsewhere in the United States.

31.

Moet's acts constitute an infringement of Celebration's trademark rights in the CANE mark in violation of the Lanham Act, 15 U.S.C. § 1114.

32.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 2: TRADEMARK INFRINGEMENT FOR THE
UNAUTHORIZED USE OF THE CANE MARK IN CONNECTION WITH
MOET'S WEBSITE IN VIOLATION OF SECTION 32 OF THE LANHAM ACT**

33.

Celebration adopts, realleges, and incorporates the preceding allegations of its Complaint, as if copied herein *in extenso*.

34.

Moet's domain names, www.10cane.com and www.10canerum.com, are deceptively similar to Celebration's CANE mark and www.canerum.com domain name.

35.

On information and belief, Moet's use of the www.10cane.com and www.10canerum.com domain names are a deliberate attempt to pass off their websites as websites authorized by or associated with Celebration.

36.

Moet's use of the www.10cane.com and www.10canerum.com domain names has caused or is likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Moet's websites and the goods or services offered on the websites in that consumers and others in this District and elsewhere in the United States are likely to believe that Moet's websites are Celebration's sites or that Celebration authorizes these web sites, Moet's goods or services or that Moet is associated with or related to Celebration.

37.

Moet's acts constitute an infringement of Celebration's trademark rights in the CANE mark in violation of Section 32 of the Lanham Act, 15 U.S.C. ¶ 1114.

38.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 3: UNFAIR COMPETITION IN VIOLATION
OF SECTION 43(A) OF THE LANHAM ACT**

39.

Celebration adopts, realleges, and incorporates the preceding allegations of its Complaint, as if copied herein *in extenso*.

40.

Moet's acts have caused and/or are likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Moet's goods or services in that consumers and others in this District and elsewhere in the United States are likely to believe that Celebration authorizes Moet's goods or services or that Moet is associated with or related to Celebration.

41.

Moet's advertisement, sale, and distribution of 10 CANE rum, their improper and unauthorized use of the 10 CANE mark, and their use of the www.10cane.com and www.10canerum.com domain names separately and collectively constitute unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

42.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 4: VIOLATION OF LOUISIANA UNFAIR
TRADE PRACTICES ACT LA. REV. STAT. ANN. § 51:1401 et seq.**

43.

Celebration adopts, realleges, and incorporates the preceding allegations of its Complaint, as if copied herein *in extenso*.

44.

Moet's acts constitute unfair competition and unfair or deceptive acts or practices in violation of the Louisiana Unfair Trade Practices Act, La. Rev. Stat. Ann § 51:1401 *et seq.*

45.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 5: DILUTION IN VIOLATION OF
SECTION 43(c) OF THE LANHAM ACT**

46.

Celebration adopts, realleges, and incorporates the preceding allegations of its Complaint, as if copied herein *in extenso*.

47.

Moet's aforesaid unauthorized sale of the 10 CANE rum products and their use of the 10 CANE mark constitute dilution and tarnishment of Celebration's famous CANE mark and tarnishment of Celebration's business reputation in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

48.

On information and belief, Moet's acts constituting dilution and tarnishment were intentional and willful.

49.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 6: DILUTION IN VIOLATION
OF LA. REV. STAT. ANN. § 51:223.1**

50.

Celebration adopts, realleges, and incorporates the preceding allegations of its Complaint, as if copied herein *in extenso*.

51.

Moet's aforesaid sale of the 10 CANE rum products and their use of the 10 CANE mark are likely to tarnish and dilute the CANE mark and damage the business reputation of Celebration in violation of La. Rev. Stat. Ann. § 51:233.1.

52.

Moet's acts constituting dilution and tarnishment greatly and irreparably have damaged Celebration and will continue to so damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

53.

Celebration demands a jury trial on those issues triable to a jury.

WHEREFORE, Celebration prays that this Complaint be deemed good and sufficient and, after due proceedings are had, issue a Judgment that:

1. Moet, their members, officers, directors, shareholders, agents, servants, employees, and attorneys, their successors and assigns, and all others in active concert or participation with Moet, be enjoined and restrained from:
 - a) the importation into, and the dealing, marketing, sale, or distribution of products in the United States bearing the name 10 CANE rum or any other mark similar thereto;

- b) using the 10 CANE name or any other mark similar thereto in connection with any website or other advertising or promotional materials; and
 - c) using the domain names www.10cane.com and www.10canerum.com or any other domain name similar thereto.
2. Moet, their members, officers, directors, shareholders, agents, servants, employees, and attorneys, their successors and assigns, and all others in active concert or participation with Moet, be required, jointly and severally, to:
- a) account for and pay over to Celebration all profits derived by Moet from their acts of trademark infringement, unfair competition, deceptive trade practices, and trademark dilution in accordance with 15 U.S.C. § 1117(a) and the laws of Louisiana, and Celebration asks that these profits award be trebled in accordance with 15 U.S.C. § 1117(a);
 - b) pay to Celebration the costs of this action, including reasonable attorneys' fees and costs, in accordance with 15 U.S.C. § 1117(a), La. Rev. Stat. Ann. § 51:1409, and other applicable laws;
 - c) deliver up for destruction all of products bearing the 10 CANE name or any other mark similar thereto in their possession, as well as all advertising and promotional material bearing the 10 CANE name or any other mark similar thereto, in accordance with 15 U.S.C. § 1118; and

- d) file with the Court and serve on Celebration an affidavit setting forth in detail the manner and form in which they have complied with the terms of the injunction, in accordance with 15 U.S.C. § 1116.
3. Celebration is entitled to such damages, interest, costs, and attorney's fees, and such other and further relief as this Court deems just and equitable in the circumstances.

Respectfully submitted,



Kyle Schonekas, 11817
Thomas M. McEachin, 26412
SCHONEKAS, WINSBERG, EVANS
& MCGOEY, L.L.C.
Texaco Center
400 Poydras Street
Suite 1440
New Orleans, Louisiana 70130
(504) 680-6050

Attorneys for Celebration Distillation Corporation

CIVIL COVER SHEET

05-1816

The JS-44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by the rules of court, as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

Celebration Distillation Corporation

DEFENDANTS

Moet Hennessy USA, Inc. and Moet Hennessy Asia Pacific Pte Ltd.

(b) COUNTY OF RESIDENCE OF FIRST LISTED PLAINTIFF U. S. A.
(EXCEPT IN U.S. PLAINTIFF CASES)

COUNTY OF RESIDENCE OF FIRST LISTED DEFENDANT U. S. A.
(IN U.S. PLAINTIFF CASES ONLY)
NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

(c) ATTORNEYS (FIRM NAME, ADDRESS, AND TELEPHONE NUMBER)

Kyle Schonekas
Schonekas, Winsberg, Evans & McGoey, L.L.C.
400 Poydras St., Suite 1440
New Orleans, LA 70130
(504) 680-6050

ATTORNEYS (IF KNOWN)

SECT 511A 2

II. BASIS OF JURISDICTION (PLACE AN "X" IN ONE BOX ONLY)

- 1 U.S. Government Plaintiff
 2 U.S. Government Defendant
 3 Federal Question (U.S. Government not a party)
 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (PLACE AN "X" IN ONE BOX FOR PLAINTIFF AND ONE BOX FOR DEFENDANT)

(For Diversity Cases Only)

- | | |
|---|---|
| PTF DEF | PTF DEF |
| Citizen of this State <input type="checkbox"/> 1 <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in this State <input type="checkbox"/> 4 <input type="checkbox"/> 4 |
| Citizen of Another State <input type="checkbox"/> 2 <input type="checkbox"/> 2 | Incorporated and Principal Place of Business in Another State <input type="checkbox"/> 5 <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country <input type="checkbox"/> 3 <input type="checkbox"/> 3 | Foreign Nation <input type="checkbox"/> 6 <input type="checkbox"/> 6 |

IV. NATURE OF SUIT (PLACE AN "X" IN ONE BOX ONLY)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veterans Benefits <input type="checkbox"/> 160 Stockholders Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employer's Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Employee Rel. Inc. Security Act	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commercial/ICC Rates/etc <input type="checkbox"/> 480 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 510 Selective Service <input type="checkbox"/> 550 Securities/Commodities/Exchange <input type="checkbox"/> 575 Customer Challenge 12 USC 3410 <input type="checkbox"/> 591 Agricultural Acts <input type="checkbox"/> 592 Economic Stabilization Act <input type="checkbox"/> 593 Environmental Matters <input type="checkbox"/> 594 Energy Allocation Act <input type="checkbox"/> 595 Freedom of Information Act <input type="checkbox"/> 596 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 597 Constitutionality of State Statutes <input type="checkbox"/> 599 Other Statutory Actions
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Tort to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Jobs <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate sentence <input type="checkbox"/> Habeas Corpus <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSD Title XVI <input type="checkbox"/> 866 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS -Third Party 26 USC 7609	

V. ORIGIN

- (PLACE AN "X" IN ONE BOX ONLY)
 1 Original Proceeding
 2 Removed from State Court
 3 Remanded from Appellate Court
 4 Reinstated or Reopened
 5 Transferred from another district (specify)
 6 Multidistrict Litigation
 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION (CITE THE U.S. CIVIL STATUTE UNDER WHICH YOU ARE FILING AND WRITE A BRIEF STATEMENT OF CAUSE DO NOT CITE JURISDICTIONAL STATUTES UNLESS DIVERSITY)

15 U.S.C. 1051 et seq.
Violation of Lanham Act (trademark infringement)

VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A CLASS ACTION
 UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: YES NO

VIII. RELATED CASE(S) IF ANY

JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

5/10/05

FOR OFFICE USE ONLY

RECEIPT # _____ AMOUNT _____ APPLYING IFP _____ JUDGE _____ MAG. JUDGE _____

FILED
U.S. DISTRICT COURT
EASTERN DISTRICT OF LA
2005 JUN -31 P 12:18
LORETTA G. WHYTE
CLERK

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA

CELEBRATION DISTILLATION
CORPORATION

CIVIL ACTION NO.: 05-1816

VERSUS

SECTION: S

MOET HENNESSY USA, INC.
AND MOET HENNESSY ASIA
PACIFIC PTE LTD.

MAGISTRATE: 2

FIRST AMENDED COMPLAINT

Plaintiff, Celebration Distillation Corporation, for its First Amended Complaint against Moet Hennessy USA, Inc., Moet Hennessy Asia Pacific Pte Ltd., and Schieffelin & Co. alleges as follows:

PARTIES

1.

Plaintiff, Celebration Distillation Corporation (hereinafter "Celebration"), is a Louisiana corporation with its principal place of business in New Orleans, Louisiana.

Fee _____
Process _____
X Dktd _____
CtRrnDep _____
Doc. No. _____

2.

Upon information and belief, defendant, Moet Hennessy USA, Inc. (hereinafter "Moet USA"), is a corporation formed under the laws of Delaware with its principal place of business in New York, New York.

3.

Defendant, Moet Hennessy Asia Pacific Pte, Ltd. (hereinafter "Moet Asia"), is a company formed under the laws of Singapore with its principal place of business in Singapore.

4.

Defendant, Schieffelin & Co. (hereinafter "Schieffelin"), is a corporation formed under the laws of Delaware with its principal place of business in New York, New York. Collectively, Moet Asia, Moet USA, and Schieffelin will sometimes be referred to as simply "Moet."

JURISDICTION AND VENUE

5.

This Court has jurisdiction, pursuant to 15 U.S.C. §§ 1051 *et seq.* (the Lanham Act), jurisdiction being conferred in accordance with 15 U.S.C. § 1121 and 28 U.S.C. § 1338(a) and (b).

6.

This Court also has jurisdiction over this civil action in accordance with 28 U.S.C. § 1332.

7.

This Court has jurisdiction over the Louisiana state statutory claims in accordance with the principles of supplemental jurisdiction pursuant to 28 U.S.C. § 1367(a).

8.

Venue is proper in the Eastern District of Louisiana, pursuant to 28 U.S.C. § 1391(b), in that a substantial part of the events or omissions giving rise to the claims occurred in this District; or, in the alternative, this is a District where the defendants may be found, as Moet USA, Moet Asia, and Schieffelin are subject to personal jurisdiction in this District.

FACTS

9.

Celebration is engaged in the manufacture and marketing of rum and other goods throughout the United States.

10.

Celebration is the owner of the following trademark registration issued by the United States Patent and Trademark Office ("USPTO") for the trademark, CANE ("CANE Mark"), used in connection with its rum products:

MARK	REG. NO.	REG. DATE	GOODS
CANE	2926706	February 15, 2005	Rum

11.

Registration of the CANE mark constitutes *prima facie* evidence of Celebration's exclusive right to use the CANE mark in commerce throughout the United States, pursuant to 15 U.S.C. § 1057(b).

12.

Celebration has sold rum under the CANE mark throughout the United States and has expended capital to advertise and promote the CANE products and the CANE mark.

13.

Celebration first used the CANE mark in 2003 and has made continuous use of the CANE mark since then.

14.

As a result of Celebration's extensive sales, promotion, and advertising, the CANE mark has become famous and represents extraordinarily valuable goodwill owned by Celebration.

15.

Since the beginning of 2004, Celebration has advertised its CANE products and CANE mark through its websites located at www.canerum.com and www.neworleansrum.com.

DEFENDANTS' UNLAWFUL ACTIVITIES

16.

Upon information and belief, Moet USA is a company that produces, markets, and/or distributes wine and spirits throughout the United States.

17.

Upon information and belief, Schieffelin is a company that produces, markets, and/or distributes wine and spirits throughout the United States.

18.

Upon information and belief, Moet Asia is a company that produces, markets, and/or distributes wine and spirits throughout the world.

19.

Moet has been aware of Celebration's use and registration of the CANE mark since at least October of 2004.

20.

Upon information and belief, Moët is advertising and selling, within the United States, rum products bearing the name, "10 CANE."

21.

Upon information and belief, Moët has advertised its 10 CANE products in print media, on the internet, and through its distributors.

22.

Upon information and belief, despite its knowledge of Celebration's duly-registered CANE mark, Moët launched their 10 CANE products in the United States on April 6, 2005.

23.

Upon information and belief, Moët has created and is using websites, located at www.10cane.com and www.10canerum.com, to advertise and sell their 10 CANE rum.

24.

Moët Asia attempted to register a trademark with the USPTO for 10 CANE.

25.

The USPTO suspended Moët Asia's application because of Celebration's prior registration of the CANE mark.

26.

In March of 2005, Moët Asia filed a Petition to Cancel Celebration's CANE mark with the USPTO's Trademark Trial and Appeal Board.

27.

Celebration has answered that Petition to Cancel and will vehemently defend its right to use the CANE mark.

COUNT 1: TRADEMARK INFRINGEMENT

28.

Celebration adopts, realleges, and incorporates the preceding allegations of its First Amended Complaint, as if copied herein *in extenso*.

29.

Moet's acts have caused and/or are likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Moet's marketing, distribution and sale of the 10 CANE products throughout the United States.

30.

On information and belief, Moet's acts have injured and/or are likely to injure Celebration's image and reputation with consumers in this District and elsewhere in the United States by creating confusion about, and dissatisfaction with, Celebration's CANE products and Celebration's customer support for these products.

31.

On information and belief, Moet's acts have injured and/or are likely to injure Celebration's reputation, business, and relations with customers in this District and elsewhere in the United States by causing customer dissatisfaction, a diminution of the value of the goodwill associated with the CANE mark, and a loss of sales to Celebration.

32.

On information and belief, Moet's marketing and sale in this District and elsewhere in the United States of their 10 CANE products is a deliberate, intentional, and willful attempt to injure Celebration's business, to trade on Celebration's business reputation, to improperly benefit from Celebration's advertising in the United States, to confuse or deceive consumers, and to interfere with Celebration's business relationships with its distributors and its customers in this District and elsewhere in the United States.

33.

Moet's acts constitute an infringement of Celebration's trademark rights in the CANE mark in violation of the Lanham Act, 15 U.S.C. § 1114.

34.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 2: TRADEMARK INFRINGEMENT FOR THE
UNAUTHORIZED USE OF THE CANE MARK IN CONNECTION WITH
MOET'S WEBSITE IN VIOLATION OF SECTION 32 OF THE LANHAM ACT**

35.

Celebration adopts, realleges, and incorporates the preceding allegations of its First Amended Complaint, as if copied herein *in extenso*.

36.

Moet's domain names, www.10cane.com and www.10canerum.com, are deceptively similar to Celebration's CANE mark and www.canerum.com domain name.

37.

On information and belief, Moet's use of the www.10cane.com and www.10canerum.com domain names are a deliberate attempt to pass off their websites as websites authorized by or associated with Celebration.

38.

Moet's use of the www.10cane.com and www.10canerum.com domain names has caused or is likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Moet's websites and the goods or services offered on the websites in that consumers and others in this District and elsewhere in the United States are likely to believe that Moet's websites are Celebration's sites or that Celebration authorizes these web sites, Moet's goods or services or that Moet is associated with or related to Celebration.

39.

Moet's acts constitute an infringement of Celebration's trademark rights in the CANE mark in violation of Section 32 of the Lanham Act, 15 U.S.C. ¶ 1114.

40.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 3: UNFAIR COMPETITION IN VIOLATION
OF SECTION 43(A) OF THE LANHAM ACT**

41.

Celebration adopts, realleges, and incorporates the preceding allegations of its First Amended Complaint, as if copied herein *in extenso*.

42.

Moet's acts have caused and/or are likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Moet's goods or services in that consumers and others in this District and elsewhere in the United States are likely to believe that Celebration authorizes Moet's goods or services or that Moet is associated with or related to Celebration.

43.

Moet's advertisement, sale, and distribution of 10 CANE rum, their improper and unauthorized use of the 10 CANE mark, and their use of the www.10cane.com and www.10cane.com domain names separately and collectively constitute unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

44.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 4: VIOLATION OF LOUISIANA UNFAIR
TRADE PRACTICES ACT LA. REV. STAT. ANN. § 51:1401 et seq.**

45.

Celebration adopts, realleges, and incorporates the preceding allegations of its First Amended Complaint, as if copied herein *in extenso*.

46.

Moet's acts constitute unfair competition and unfair or deceptive acts or practices in violation of the Louisiana Unfair Trade Practices Act, La. Rev. Stat. Ann § 51:1401 *et seq.*

47.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 5: DILUTION IN VIOLATION OF
SECTION 43(c) OF THE LANHAM ACT**

48.

Celebration adopts, realleges, and incorporates the preceding allegations of its First Amended Complaint, as if copied herein *in extenso*.

49.

Moet's aforesaid unauthorized advertisement and sale of the 10 CANE rum products and their use of the 10 CANE mark constitute dilution and tarnishment of Celebration's famous CANE mark and tarnishment of Celebration's business reputation in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

50.

On information and belief, Moet's acts constituting dilution and tarnishment were intentional and willful.

51.

Moet's acts have greatly and irreparably damaged Celebration and will continue to damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

**COUNT 6: DILUTION IN VIOLATION
OF LA. REV. STAT. ANN. § 51:223.1**

52.

Celebration adopts, realleges, and incorporates the preceding allegations of its First Amended Complaint, as if copied herein *in extenso*.

53.

Moet's aforesaid sale of the 10 CANE rum products and their use of the 10 CANE mark are likely to tarnish and dilute the CANE mark and damage the business reputation of Celebration in violation of La. Rev. Stat. Ann. § 51:233.1.

54.

Moet's acts constituting dilution and tarnishment greatly and irreparably have damaged Celebration and will continue to so damage Celebration unless restrained by this Court; wherefore, Celebration is without an adequate remedy at law.

55.

Celebration demands a jury trial on those issues triable to a jury.

WHEREFORE, Celebration prays that this First Amended Complaint be deemed good and sufficient and, after due proceedings are had, issue a Judgment that:

1. Moet, their parents, subsidiaries, members, officers, directors, shareholders, agents, servants, employees, and attorneys, their successors and assigns, and all others in active concert or participation with Moet, be enjoined and restrained from:

- a) the importation into, and the dealing, marketing, sale, or distribution of products in the United States bearing the name 10 CANE rum or any other mark similar thereto;

- b) using the 10 CANE name or any other mark similar thereto in connection with any website or other advertising or promotional materials; and
- c) using the domain names www.10cane.com and www.10canerum.com or any other domain name similar thereto.

2. Moet, their parents, subsidiaries, members, officers, directors, shareholders, agents, servants, employees, and attorneys, their successors and assigns, and all others in active concert or participation with Moet, be required, jointly and severally, to:

- a) account for and pay over to Celebration all profits derived by Moet from their acts of trademark infringement, unfair competition, deceptive trade practices, and trademark dilution in accordance with 15 U.S.C. § 1117(a) and the laws of Louisiana, and Celebration asks that these profits award be trebled in accordance with 15 U.S.C. § 1117(a);
- b) pay to Celebration the costs of this action, including reasonable attorneys' fees and costs, in accordance with 15 U.S.C. § 1117(a), La. Rev. Stat. Ann. § 51:1409, and other applicable laws;
- c) deliver up for destruction all of products bearing the 10 CANE name or any other mark similar thereto in their possession, as well as all advertising and promotional material bearing the 10 CANE name or any other mark similar thereto, in accordance with 15 U.S.C. § 1118; and

- d) file with the Court and serve on Celebration an affidavit setting forth in detail the manner and form in which they have complied with the terms of the injunction, in accordance with 15 U.S.C. § 1116.
3. Celebration is entitled to such damages, interest, costs, and attorney's fees, and such other and further relief as this Court deems just and equitable in the circumstances.

Respectfully submitted,



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Counsel for Plaintiffs Moët Hennessy Asia
Pacific PTE, Ltd. and Schieffelin & Co.

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK

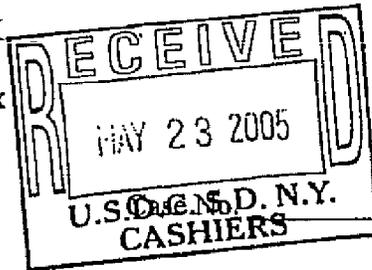
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MÖET HENNESSY ASIA PACIFIC PTE, LTD.
AND SCHIEFFELIN & CO., d/b/a MÖET
HENNESSY USA,

Plaintiffs,

v.

CELEBRATION DISTILLATION
CORPORATION,

Defendant.
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**COMPLAINT FOR
DECLARATORY JUDGMENT AND
TRADEMARK CANCELLATION**

Möet Hennessy Asia Pacific Pte, Ltd. ("Moët Asia") and Schieffelin & Co., d/b/a
Möet Hennessy USA ("Schieffelin") by their undersigned counsel, for their complaint against
Celebration Distillation Corporation allege:

1. This is an action for declaratory judgment brought pursuant to 28 U.S.C.
§ 2201 and Fed. R. Civ. P. 57 for the purpose of resolving an actual controversy now existing
between the parties and for cancellation of Defendant's federal trademark registration No.
2,926,706 for the mark CANE for rum under 15 U.S.C. § 1119 of the Lanham Act. The action
arises under 15 U.S.C. § 1051 *et seq.* (the "Lanham Act").



2. Plaintiff Met Asia arranges for the manufacture, and Plaintiff Schieffelin & Co., d/b/a Met Hennessy USA imports for distribution in the U.S. a premium rum under the name 10 CANE. Plaintiff adopted the name 10 CANE to emphasize the fact that the product is made from first press pure sugar cane. Plaintiffs' 10 CANE rum is recognizable by its distinct label, the logo etched on the bottle, the color of the rum, and the overall label design. Indeed, the overall packaging of 10 CANE rum distinguishes Plaintiffs' product from all other rums currently on the market.

3. Defendant is a New Orleans distiller who manufactures and sells in this district a sugar cane-based rum under the name CANE. Defendant's product packaging is wholly distinct from that of Plaintiffs'. In addition, Defendant's rum is not marketed as a premium liquor and is not sold at the same price as Plaintiff's 10 CANE rum.

4. Defendant has asserted that the use of the name 10 CANE in connection with Plaintiffs' rum infringes on Defendant's trademark rights in the descriptive term CANE.

5. Plaintiffs have no intention to trade off any goodwill that Defendant may have acquired and would have no reason to do so. Plaintiffs seek a declaration that its use of the 10 CANE mark does not infringe on any trademark rights of the Defendant, that there is no likelihood of confusion arising from the use of Plaintiffs' 10 CANE mark in connection with its rum, that Plaintiffs have not violated any purported rights of Defendant, and that Defendant has no trademark rights in the CANE mark on the grounds that it is merely descriptive of the principal ingredient in Defendant's rum.

PARTIES

6. Møet Asia is a company formed under the laws of Singapore with its principal place of business in Singapore.

7. Schieffelin is a Delaware corporation with its principal place of business at 2 Park Avenue, New York, New York 10016.

8. Defendant Celebration Distillation Corporation ("Celebration") is a Louisiana corporation with its principal place of business in New Orleans, Louisiana. Celebration distributes its CANE brand rum in this judicial district and derives revenue from this district.

JURISDICTION AND VENUE

9. This Court has jurisdiction under Section 39 of the Lanham Act, 15 U.S.C. § 1121 because this action arises from threats by Defendant of legal action based upon claims that Plaintiffs have infringed its federally registered trademarks and under Sections 1331 and 1338(a) and (b) of the Judicial Code, 28 U.S.C. § 1331, 1338(a) and 1338(b). Additionally, this Court has jurisdiction pursuant to 28 U.S.C. § 1332 in that the amount in controversy exceeds \$75,000 exclusive of interest and costs and involves citizens of different states and the subject of a foreign state.

10. Venue is proper in the Southern District of New York pursuant to 28 U.S.C. § 1391(b)(2) in that a substantial part of the events or omissions giving rise to the claims occurred in this District.

FACTS

A. **Plaintiffs' 10 CANE Rum**

11. Möet Asia has developed a super-premium or luxury rum produced in Trinidad that is marketed under the trademark 10 CANE. Schieffelin distributes 10 CANE rum in New York and has plans to eventually distribute it in other parts of the United States.

12. 10 CANE rum is produced by an exacting process which makes it unique in the rum market. 10 CANE is marketed to discriminating consumers of premium spirits and sells for approximately \$35 per bottle.

13. The label for 10 CANE rum bears a distinctive logo, a bright orange banner and is packaged in a unique bottle for which Moët Asia has sought a copyright registration and a design patent.

14. Plaintiff Möet Hennessy Asia Pacific Pte, Ltd. is the owner of all rights in the mark 10 CANE for rum. The bottle clearly states that it is imported by Schieffelin & Co.

B. **Defendant's Claimed Trademark Rights And Threat Of Legal Action**

15. Celebration sells a Louisiana rum under the mark CANE. Neither Celebration's label nor its bottle design is similar to the label or bottle used by Plaintiffs. Celebration's CANE rum clearly states on the packaging that it is from Louisiana.

16. Celebration sells its rum under the CANE mark at a much lower price point than Plaintiffs' rum and markets its product to a different audience than the audience for Plaintiffs' 10 CANE rum.

17. Celebration's rum is made from molasses, a derivative of sugar cane. Plaintiffs' rum is made from pure sugar cane. As such, CANE is descriptive of all of the parties' rum products.

18. Celebration is the owner of record of U.S. federal registration number 2,926,706 for the trademark CANE for rum.

19. Celebration's CANE mark is merely descriptive of its rum and has not acquired secondary meaning in the marketplace. Mötet Asia has filed a Petition for Cancellation of Celebration's CANE mark in a proceeding currently pending before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office.

20. On May 10, 2005, Celebration filed suit against Mötet Asia which does not do business in Louisiana and "Moet Hennessy USA, Inc.," a non-existent entity in the United States District Court for the Eastern District of Louisiana, Civil Action No. 05-1816 (the "Louisiana lawsuit").

21. In the Louisiana lawsuit, Celebration has asserted six claims against Mötet Asia and "Moet Hennessy USA, Inc.," all of which are based on Mötet Asia's use and ownership of 10 CANE, namely: (1) trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114, by virtue of the use of marketing, distribution and sale of 10 CANE products; (2) trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114, by virtue of the use of the www.10cane.com and www.10canerum.com domain names; (3) unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); (4) violation of the Louisiana Unfair Trade Practices Act, La. R.S. § 51:1401, *et seq.*; (5) trademark dilution in

violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); and (6) trademark dilution in violation of Louisiana's anti-dilution statutory provisions, La. R.S. §51:223.1.

**COUNT ONE FOR CANCELLATION OF TRADEMARK
ON GROUNDS OF DESCRIPTIVENESS**

22. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

23. The word "cane" is widely used in connection with rum products as it describes the chief ingredient in rum, namely sugar cane. When used on or in connection with rum, the only product set forth in Registration No. 2,926,706, "cane" is merely a descriptive term that conveys knowledge to an ordinary, reasonable purchaser of the primary ingredient of Celebration's product.

24. The word "cane" is commonly used within the liquor industry on and in connection with rum to describe the principal ingredient in rum.

25. Celebration has filed suit against Mœt Hennessy in the Federal District Court in Louisiana based on its claim of trademark rights in the mark CANE, Registration No. 2,926,706, and its allegation that Mœt Hennessy's use of the name 10 CANE constitutes trademark infringement, unfair competition and dilution under federal and state law. As a result, Plaintiff Mœt Hennessy is being damaged by the continued registration of CANE because Defendant has used its registration to commence baseless litigation against Moet Hennessy.

26. Registration of CANE in connection with rum has allowed Celebration to claim exclusive rights to a term commonly used to describe the characteristics of rum, namely that it is made from sugar cane, and to attempt to preclude Plaintiffs from using CANE in connection with its own rum product.

27. The term “cane” has not become distinctive of Celebration’s goods and Defendant has not acquired any secondary meaning in the term “cane.”

28. Because “cane” is merely descriptive of the ingredients of Defendant’s rum, the term does not constitute a valid mark and should not have been registered under the Lanham Act, 15 U.S.C. § 1052(e)(1). As a result, CANE is not entitled to continued registration and Registration No. 2,926,706 must be cancelled.

29. Pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, this Court should direct that U.S. Registration No. 2,926,706 be cancelled.

COUNT TWO DECLARATORY JUDGMENT
OF NON-INFRINGEMENT

30. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

31. Plaintiffs’ logo, marketing materials, and websites in no way suggest that their 10 CANE rum is a product of or is authorized by Celebration, or falsely represent that there is a connection between plaintiffs and Celebration. Moreover, given the high price of Plaintiffs’ product and the marketing of 10 CANE as a premium brand, Plaintiffs have no intention to create any association with Defendant or its product.

32. As a result of the descriptiveness of Defendant’s mark, the differences in the parties’ goods, labels, packaging, marketing, consumers and price point, the third party use of CANE, and Plaintiffs’ use of the SCHIEFFELIN mark on its products, Plaintiffs’ use of the 10 CANE mark and of the www.10cane.com and www.10canerum.com domain names in connection with their premium rum have not caused and are not likely to cause confusion, mistake, or deception as to the source, origin, sponsorship or approval of 10 CANE rum.

33. Plaintiffs' use of the 10 CANE mark in connection with their premium rum products does not violate Defendant's alleged rights pursuant to Section 32 or 43 of the Lanham Act, 15 U.S.C. § § 1114, 1125(a) or any state infringement or unfair competition laws and Defendant is not entitled to enjoin or prevent Plaintiffs from using the 10 CANE mark or the domain names www.10cane.com or www.10canerum.com in connection with the promotion or sale of its premium rum product.

34. Defendant's threats to Plaintiffs, although without legal foundation, nevertheless subject Plaintiffs to harassment, injury, and uncertainty in the lawful exercise of their business and constitute a serious cloud on Plaintiffs' ability to distribute and sell its products, all to Plaintiffs' detriment and for which Plaintiffs have no adequate remedy at law.

35. Accordingly, Plaintiffs are entitled to a declaration that their use of the 10 CANE mark is not likely to create confusion in the marketplace with Celebration's CANE mark and that Plaintiffs have not violated Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. § § 1114(a), 1125(a) or Louisiana state law.

COUNT THREE DECLARATORY JUDGMENT
NO TRADEMARK DILUTION

36. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

37. Celebration's CANE mark is neither famous nor distinctive, in part because it is a commonly used descriptive mark that has not acquired secondary meaning, has not been sold in large quantities, and has, according to Celebration's certification of registration, only been used in commerce for approximately one year.

38. As such, Plaintiffs have not engaged in trademark dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) because their use of the 10 CANE mark did not begin before Celebration's CANE mark became "famous," which has still not occurred, and in any event plaintiffs' use of the 10 CANE mark does not dilute and is not likely to dilute any distinctive quality of Celebration's CANE mark.

39. Defendant's threats to Plaintiffs, although without legal foundation, nevertheless subject Plaintiffs to harassment, injury, and uncertainty in the lawful exercise of their business and constitute a serious cloud on Plaintiffs' ability to distribute and sell its products, all to Plaintiffs' detriment and for which Plaintiffs have no adequate remedy at law.

40. Plaintiffs are entitled to a declaration that they have not engaged in trademark dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) or Louisiana state law.

PRAYER FOR RELIEF

WHEREFORE, Mœt Hennessy Asia Pacific Pte, Ltd. and Schieffelin & Co. pray that this Court enter judgment against defendant and in favor of plaintiffs on their claims as follows:

(a) Ordering that the Commissioner of the Patent and Trademark Office cancel Registration No. 2,926,706 on the ground that the mark is merely descriptive pursuant to 15 U.S.C. § 1119;

(b) declaring that Plaintiffs, in the promotion and sale of 10 CANE rum, have not infringed any right, including any trademark-related rights, of Defendant and that Plaintiffs

have the lawful right to use the 10 CANE mark in commerce, including the use of the domain names www.10cane.com and www.10canerum.com, in connection with the promotion and sale of its 10 CANE rum and related products;

(c) declaring that Plaintiffs' use of the 10 CANE mark is not likely to create confusion in the marketplace with Celebration's CANE mark and does not constitute trademark infringement or unfair competition in violation of the Lanham Act or Louisiana state law;

(d) declaring that Celebration's CANE mark is not famous and that Plaintiffs' promotion and sale of 10 CANE rum does not and will not dilute Defendant's CANE mark;

(e) permanently enjoining Defendant from making any further threats of infringement or interfering in any way with Plaintiffs' use or registration of its 10 CANE mark;

(f) awarding Plaintiffs any and all damages sustained by Plaintiffs as a result of Defendant's wrongful acts; and

(g) awarding Plaintiffs its costs in this action, including attorneys' fees, together with such other and further relief as the Court may deem just and proper.

Dated: May 23, 2005

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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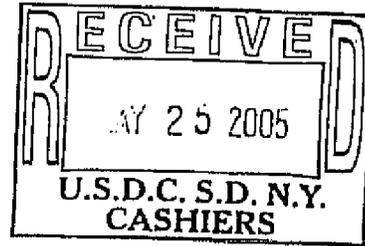
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Counsel for Plaintiffs Moët Hennessy Asia
 Pacific PTE, Ltd. and Schieffelin & Co.



IN THE UNITED STATES DISTRICT COURT
 FOR THE SOUTHERN DISTRICT OF NEW YORK

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	:	
MOËT HENNESSY ASIA PACIFIC PTE, LTD.	:	
AND SCHIEFFELIN & CO., d/b/a MOËT	:	Case No. 05 CV 4910 (LTS) (RLE)
HENNESSY USA,	:	
	:	
Plaintiffs,	:	
	:	
v.	:	FIRST AMENDED COMPLAINT
	:	FOR DECLARATORY JUDGMENT
CELEBRATION DISTILLATION	:	AND TRADEMARK
CORPORATION,	:	<u>CANCELLATION</u>
	:	
Defendant.	:	
-----	x	

Moët Hennessy Asia Pacific Pte, Ltd. ("Moët Asia") and Schieffelin & Co., d/b/a Moët Hennessy USA ("Schieffelin") by their undersigned counsel, for their first amended complaint against Celebration Distillation Corporation ("Celebration") allege:

1. This is an action for declaratory judgment brought pursuant to 28 U.S.C. § 2201 and Fed. R. Civ. P. 57 for the purpose of resolving an actual controversy now existing between the parties and for cancellation of Defendant's federal trademark registration No. 2,926,706 for the mark CANE for rum under 15 U.S.C. § 1119 of the Lanham Act. The action arises under 15 U.S.C. § 1051 *et seq.* (the "Lanham Act").

2. Plaintiff Moët Asia arranges for the manufacture, and Plaintiff Schieffelin imports for distribution in the U.S. a super-premium rum under the name 10 CANE. Plaintiff adopted

the name 10 CANE to emphasize the fact that the product is made from first press pure sugar cane. Plaintiffs' 10 CANE rum is recognizable by its distinct label, the logo etched on the bottle, the color of the rum, and the overall label design. Indeed, the overall packaging of 10 CANE rum distinguishes Plaintiffs' product from all other rums currently on the market.

3. Defendant is a New Orleans distiller who manufactures and sells in this district a sugar cane-based rum under the name CANE. Defendant's product packaging is wholly distinct from that used by Plaintiffs. In addition, Defendant's rum is not marketed as a super-premium liquor and is not sold at the same price as Plaintiffs' 10 CANE rum.

4. Defendant has asserted that the use of the name 10 CANE in connection with Plaintiffs' rum infringes on Defendant's trademark rights in the descriptive term CANE.

5. Plaintiffs have no intention to trade off any goodwill that Defendant may have acquired and would have no reason to do so. Plaintiffs seek a declaration that their use of the 10 CANE mark does not infringe on any trademark rights of the Defendant, that there is no likelihood of confusion arising from the use of Plaintiffs' 10 CANE mark in connection with their rum, that Plaintiffs have not violated any purported rights of Defendant, and that Defendant has no trademark rights in the CANE mark on the grounds that it is merely descriptive of the principal ingredient in Defendant's rum or is deceptively misdescriptive.

PARTIES

6. Moët Asia is a company formed under the laws of Singapore with its principal place of business in Singapore.

7. Schieffelin is a Delaware corporation with its principal place of business at 2 Park Avenue, New York, New York 10016.

8. Defendant Celebration is a Louisiana corporation with its principal place of business in New Orleans, Louisiana. Celebration distributes its CANE brand rum in this judicial district and derives revenue from this district.

JURISDICTION AND VENUE

9. This Court has jurisdiction under Section 39 of the Lanham Act, 15 U.S.C. § 1121 because this action arises from Defendant's filing of a legal action based upon claims that the sale of Plaintiffs' super-premium 10 CANE rum infringes on Defendant's federally registered trademark and under Sections 1331 and 1338(a) and (b) of the Judicial Code, 28 U.S.C. § 1331, 1338(a) and 1338(b). Additionally, this Court has jurisdiction pursuant to 28 U.S.C. § 1332 in that the amount in controversy exceeds \$75,000 exclusive of interest and costs and involves citizens of different states and the subject of a foreign state.

10. Venue is proper in the Southern District of New York pursuant to 28 U.S.C. § 1391(b)(2) in that a substantial part of the events or omissions giving rise to the claims occurred in this District.

FACTS

A. Plaintiffs' 10 CANE Rum

11. Moët Asia has developed a super-premium or luxury rum produced in and imported from Trinidad that is marketed under the trademark 10 CANE. Schieffelin imports 10 CANE rum for distribution. 10 CANE rum currently is available in New York but will be distributed to other parts of the United States.

12. Plaintiffs' super-premium 10 CANE rum is made directly from pure virgin sugar cane. 10 CANE rum is produced by an exacting process that makes it unique in the rum market.

10 CANE is marketed to discriminating consumers of premium spirits and sells for approximately \$35 per bottle.

13. The bottle for 10 CANE super-premium rum bears a distinctive logo etched into the glass and a bright orange banner that runs across the front, side and part of the back of the bottle, and a hang tag describing the product. The bottle itself has a unique appearance for which Moët Asia has sought a copyright registration and a design patent.

14. Plaintiff Moët Asia is the owner of all rights in the mark 10 CANE for rum. The bottle clearly states that it is imported by Schieffelin & Co.

B. Defendant's Claimed Trademark Rights And Threat Of Legal Action

15. Celebration sells a Louisiana rum under the mark CANE. Neither Celebration's label nor its bottle design is similar to the label or bottle used by Plaintiffs. Celebration's CANE rum clearly states on the packaging that it is from Louisiana and that it is "Crafted and Bottled by Celebration Distillation Corporation" of New Orleans, Louisiana.

16. Celebration sells its rum under the CANE mark at a much lower price point than Plaintiffs' rum and markets its product to a different audience than the audience for Plaintiffs' 10 CANE rum.

17. Celebration's rum is made from molasses, a derivative of sugar cane. As such, CANE is descriptive of an ingredient of Defendant's rum products.

18. Celebration is the owner of record of U.S. federal registration number 2,926,706 for the trademark CANE for rum.

19. Celebration's CANE mark is merely descriptive of its rum and has not acquired secondary meaning in the marketplace. Moët Asia has filed a Petition for Cancellation of

Celebration's CANE mark in a proceeding currently pending before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office.

20. On May 10, 2005, Celebration filed suit against Moët Asia, which does not do business in Louisiana, and "Moët Hennessy USA, Inc.," a non-existent entity, in the United States District Court for the Eastern District of Louisiana, Civil Action No. 05-1816 (the "Louisiana lawsuit").

21. In the Louisiana lawsuit, Celebration has asserted six claims against Moët Asia and "Moët Hennessy USA, Inc.," all of which are based on Moët Asia's use and ownership of 10 CANE, namely: (1) trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114, by virtue of the use of marketing, distribution and sale of 10 CANE products; (2) trademark infringement in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114, by virtue of the use of the www.10cane.com and www.10canerum.com domain names; (3) unfair competition in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); (4) violation of the Louisiana Unfair Trade Practices Act, La. R.S. § 51:1401, *et seq.*; (5) trademark dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); and (6) trademark dilution in violation of Louisiana's anti-dilution statutory provisions, La. R.S. §51:223.1.

FIRST CLAIM FOR RELIEF
CANCELLATION OF TRADEMARK ON GROUNDS OF DECEPTIVENESS

22. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

23. "Cane rum" describes rum distilled from fermented pure cane juice as opposed to molasses. Defendant's rum is made from molasses, a by-product of sugar cane. By using the mark CANE, Defendant has misdescribed the characteristics and quality of its rum

24. Defendant's misleading use of CANE is intended to and will materially affect consumers since it encourages the false impression that Defendant's rum is a super-premium rum product when it is not.

25. Under Section 2(a) of the Lanham Act, 15 U.S.C. § § 1052(a), CANE may not be registered in connection with the goods of Defendant.

26. Pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, this Court should direct that U.S. Registration No. 2,926,706 be cancelled because the designation "cane" is deceptive as used by Defendant.

27. Plaintiffs are being harmed by the continued registration of CANE by Defendant since such registration has allowed Defendant to claim exclusive rights to use that term on and in connection with a rum product not made from pure sugar cane and to attempt to preclude Plaintiffs from using that term on and in connection with their super-premium rum. Plaintiffs are therefore damaged by the continued registration of the CANE mark.

SECOND CLAIM FOR RELIEF
CANCELLATION OF TRADEMARK ON GROUNDS OF DESCRIPTIVENESS

28. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

29. The word "cane" is widely used in connection with rum products as it describes the chief ingredient in rum, namely sugar cane. When used on or in connection with rum, the only product set forth in Registration No. 2,926,706, "cane" is merely a descriptive term that conveys knowledge to an ordinary, reasonable purchaser of the primary ingredient of Celebration's product.

30. The word "cane" is commonly used within the liquor industry on and in connection with rum to describe the principal ingredient in rum.

31. Celebration has filed suit against Moët Asia and a non-existent entity, "Moët Hennessy USA, Inc.," in the Federal District Court in Louisiana based on its claim of trademark rights in the mark CANE, Registration No. 2,926,706, and its allegation that Moët Asia's and Moët Hennessy USA, Inc.'s [sic] use of the name 10 CANE constitutes trademark infringement, unfair competition and dilution under federal and state law. As a result, Plaintiffs are being damaged by the continued registration of CANE because Defendant has used its registration to commence baseless litigation.

32. Registration of CANE in connection with rum has allowed Celebration to claim exclusive rights to a term commonly used to describe the characteristics of rum, namely that it is made from sugar cane, and to attempt to preclude Plaintiffs from using CANE in connection with their own rum product.

33. The term "cane" has not become distinctive of Celebration's goods and Defendant has not acquired any secondary meaning in the term "cane."

34. Because "cane" is merely descriptive of the ingredients of Defendant's rum, the term does not constitute a valid mark and should not have been registered under the Lanham Act, 15 U.S.C. § 1052(e)(1). As a result, CANE is not entitled to continued registration and Registration No. 2,926,706 must be cancelled.

35. Pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, this Court should direct that U.S. Registration No. 2,926,706 be cancelled.

THIRD CLAIM FOR RELIEF
DECLARATORY JUDGMENT OF NON-INFRINGEMENT

36. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

37. Plaintiffs' logo, marketing materials, and websites in no way suggest that their 10 CANE rum is a product of or is authorized by Celebration, or falsely represent that there is a connection between Plaintiffs and Celebration. Moreover, given the high price of Plaintiffs' product and the marketing of 10 CANE as a super-premium brand, Plaintiffs have no intention to create any association with Defendant or its product.

38. As a result of the descriptiveness of Defendant's mark, the differences in the parties' goods, labels, packaging, marketing, consumers and price point, the third party use of "cane," and Plaintiffs' use of the SCHIEFFELIN & CO. mark on its products, Plaintiffs' use of the 10 CANE mark and of the www.10cane.com and www.10canerum.com domain names in connection with their super-premium rum have not caused and are not likely to cause confusion, mistake, or deception as to the source, origin, sponsorship or approval of 10 CANE rum.

39. Plaintiffs' use of the 10 CANE mark in connection with their super-premium rum products does not violate Defendant's alleged rights pursuant to Section 32 or 43 of the Lanham Act, 15 U.S.C. § § 1114, 1125(a) or any state infringement or unfair competition laws and Defendant is not entitled to enjoin or prevent Plaintiffs from using the 10 CANE mark or the domain names www.10cane.com or www.10canerum.com in connection with the promotion or sale of its super-premium rum product.

40. Defendant's filing of a suit against Moët Asia and the non-existent entity "Moët Hennessy USA Inc.," although without legal foundation, nevertheless subject Plaintiffs to harassment, injury, and uncertainty in the lawful exercise of their business and constitute a serious cloud on Plaintiffs' ability to distribute and sell their products, all to Plaintiffs' detriment and for which Plaintiffs have no adequate remedy at law.

41. Accordingly, Plaintiffs are entitled to a declaration that their use of the 10 CANE mark is not likely to create confusion in the marketplace with Celebration's CANE mark and that Plaintiffs have not violated Sections 32(1) or 43(a) of the Lanham Act, 15 U.S.C. § § 1114(a), 1125(a) or under applicable state law.

FOURTH CLAIM FOR RELIEF
DECLARATORY JUDGMENT OF NO TRADEMARK DILUTION

42. Plaintiffs re-allege and incorporate by reference each of the allegations set forth in paragraphs 1-21 as though set forth fully herein.

43. Celebration's CANE mark is neither famous nor distinctive, in part because it is a commonly used descriptive mark that has not acquired secondary meaning, has not been sold in large quantities, and has, according to Celebration's certification of registration, only been used in commerce for approximately one year.

44. As such, Plaintiffs have not engaged in trademark dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) because their use of the 10 CANE mark did not begin after Celebration's CANE mark became "famous," which has still not occurred, and in any event Plaintiffs' use of the 10 CANE mark does not dilute and is not likely to dilute any distinctive quality of Celebration's CANE mark.

45. Defendant's filing of a suit against Moët Asia and the non-existent entity "Moët Hennessy USA Inc.," although without legal foundation, nevertheless subject Plaintiffs to harassment, injury, and uncertainty in the lawful exercise of their business and constitute a serious cloud on Plaintiffs' ability to distribute and sell their products, all to Plaintiffs' detriment and for which Plaintiffs have no adequate remedy at law.

46. Plaintiffs are entitled to a declaration that they have not engaged in trademark dilution in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) or under applicable state law.

PRAYER FOR RELIEF

WHEREFORE, Plaintiffs Moët Hennessy Asia Pacific Pte, Ltd. and Schieffelin & Co. d/b/a Moët Hennessy USA, pray that this Court enter judgment against Defendant and in favor of Plaintiffs on their claims as follows:

(a) Ordering that the Commissioner of the Patent and Trademark Office cancel Registration No. 2,926,706 on the ground that the mark is deceptive when used in connection with Defendant's goods, pursuant to 15 U.S.C. § 1119;

(b) Ordering that the Commissioner of the Patent and Trademark Office cancel Registration No. 2,926,706 on the ground that the mark is merely descriptive, pursuant to 15 U.S.C. § 1119;

(c) declaring that Plaintiffs, in the promotion and sale of 10 CANE rum, have not infringed any right, including any trademark-related rights, of Defendant and that Plaintiffs have the lawful right to use the 10 CANE mark in commerce, including the use of the domain names www.10cane.com and www.10canerum.com, in connection with the promotion and sale of their 10 CANE rum and related products;

(d) declaring that Plaintiffs' use of the 10 CANE mark is not likely to create confusion in the marketplace with Celebration's CANE mark and does not constitute trademark infringement or unfair competition in violation of the Lanham Act or under applicable state law;

(e) declaring that Celebration's CANE mark is not famous and that Plaintiffs' promotion and sale of 10 CANE rum does not and will not dilute Defendant's CANE mark;

(f) permanently enjoining Defendant from asserting claims against Plaintiffs, filing actions against Plaintiffs, maintaining actions against Plaintiffs, or making any threats against Plaintiffs for infringement or interfering in any way with Plaintiffs' use or registration of Moët Asia's mark;

(g) awarding Plaintiffs any and all damages sustained by Plaintiffs as a result of Defendant's wrongful acts; and

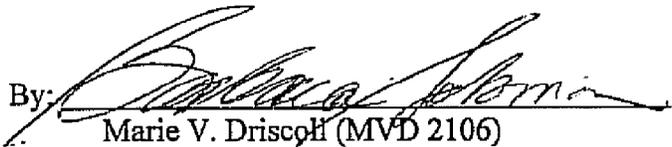
(h) awarding Plaintiffs their costs in this action, including attorneys' fees, together with such other and further relief as the Court may deem just and proper.

Dated: May 25, 2005

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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