

ESTTA Tracking number: **ESTTA232078**

Filing date: **08/21/2008**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Benziger Family Winery LLC		
Entity	Limited Liability Company	Citizenship	California
Address	1883 London Ranch Road Glen Ellen, CA 95442 UNITED STATES		

Attorney information	Paul W. Vapnek, Esq. Townsend and Townsend and Crew LLP Two Embarcadero Center, 8th Floor San Francisco, CA 94111 UNITED STATES pwvapnek@townsend.com Phone:415-576-0200
----------------------	---

Registration Subject to Cancellation

Registration No	2754775	Registration date	08/26/2003
Registrant	Vina Caliterra S.A. Av. Nueva Tajamar 481 Torre Sur, OF. 503 Santiago, CHILE		

Goods/Services Subject to Cancellation

Class 033. First Use: 1997/10/00 First Use In Commerce: 1997/10/00 All goods and services in the class are cancelled, namely: Wines
--

Grounds for Cancellation

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

Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1781659	Application Date	04/08/1991
Registration Date	07/13/1993	Foreign Priority Date	NONE
Word Mark	TRIBUTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1990/08/24 First Use In Commerce: 1990/09/06		

	wine
--	------

Attachments	Petition to Cancel.pdf (4 pages)(152326 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	/Paul W. Vapnek/
Name	Paul W. Vapnek
Date	08/21/2008

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

Registration No. 2,754,775
Issued: August 26, 2003

Mark: **CALITERRA TRIBUTE**

BENZIGER FAMILY WINERY LLC)

Petitioner,)

vs.)

VINA CALITERRA S.A.,)

Registrant.)

Cancellation No.

PETITION TO CANCEL

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Madam:

On August 26, 2003, Registrant Vina Caliterra S.A., a Chilean corporation, with a mailing address of Av. Nueva Tajamar, 481 Torre Sur, OF. 503, Santiago, Chile, and whose Domestic Representative is Hughes Hubbard & Reed LLP with a mailing address of One Battery Park Plaza, New York, New York 10004 (hereinafter "Registrant") was issued Trademark Registration No. 2,754,775 for the mark **CALITERRA TRIBUTE** for "wines, in class 33" (hereinafter "Registrant's Mark"). Petitioner Benziger Family Winery LLC, an California limited liability company, having offices at 1883 London Ranch Road, Glen Ellen, California 95442

(hereinafter "Petitioner") believes that it will be damaged by the continued registration of Registrant's Mark, and hereby Petitions for Cancellation of same. As grounds therefor, Petitioner alleges the following:

1. The date of first use stated in Registration No. 2,754,775 for Registrant's Mark is at least as early as October, 1997 and the date of first use in commerce stated in the Registration is the same, at least as early as October, 1997.

2. Since at least as early as August 24, 1990, Petitioner has been using the mark **TRIBUTE**, and Petitioner is the owner of incontestable Registration No. 1,781,659, and has been extensively engaged in the business of offering fine wine under the mark **TRIBUTE**, although initially the mark was A **TRIBUTE**. Petitioner's registration was amended at least as early as September 21, 2004 to **TRIBUTE**, from A **TRIBUTE** (hereinafter "Petitioner's Mark"). Since its first use, Petitioner has expended substantial resources making and selling fine wines under its valuable mark **TRIBUTE**.

3. In December, 1999, Registrant, through its counsel requested the consent of Petitioner to register its mark. Consent was never granted.

4. Long prior to the alleged first use of Registrant's Mark by Registrant, Petitioner's Mark had come to be and is now well known and of great value to Petitioner, and is recognized and relied upon by the trade and the public as identifying Petitioner as the source of Petitioner's fine wine, and to distinguish Petitioner's wine from those of others. Petitioner's use of Petitioner's Mark has been exclusive and continuous since prior to the date of first use of Registrant's Mark by Registrant. Petitioner is informed and believes that Registrant's principal

and president was fully aware of Petitioner's existence and its use of its Mark, but filed the application for registration with full knowledge of Petitioner's rights in its Mark.

5. Petitioner's Mark and Registrant's Mark are similar in sight, sound and meaning. Registrant's mark includes the entirety of Petitioner's mark. The wines offered by Registrant under the **CALITERRA TRIBUTE** mark, and the wines offered by Petitioner under its **TRIBUTE** mark are closely related.

6. Petitioner will be damaged by the continuing existence on the Principal Register of Registrant's mark because such registration gives colorable rights to Registrant to ship cheap wine to the U.S. and is likely to cause confusion with respect to source and origin of the wines offered by Petitioner and the wines to be sold by Registrant's U.S. distributors under their respective marks; the sponsorship, affiliation or relation between Petitioner and Registrant; and the rights granted Registrant under such registration and the superior rights held by Petitioner in Petitioner's Mark. In addition, Petitioner's Mark is famous within Petitioner's field of use, Registrant's Mark is used on the same goods, and the continued registration of Registrant's Mark dilutes the distinctiveness of Petitioner's mark. The continued registration of Registrant's Mark gives color of statutory rights to Registrant's Mark, in violation and derogation of the superior rights of Petitioner.

7. WHEREFORE, Petitioner hereby respectfully requests that Registration No. 2,754,775 be canceled.

Please charge any necessary fee regarding this Petition to the Deposit Account of Townsend and Townsend and Crew LLP, DAO 20-1430, and credit any overpayment to such deposit account.

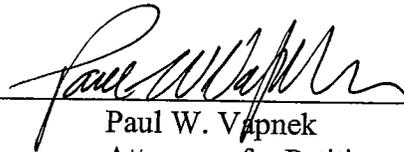
Pursuant to the Trademark Rules, this Notice is being submitted in triplicate.

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

Dated: August 21, 2008

By



Paul W. Vapnek
Attorneys for Petitioner

Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Telephone: (415) 576-0200
Facsimile: (415) 576-0300
PWV:dct
61474434 v1

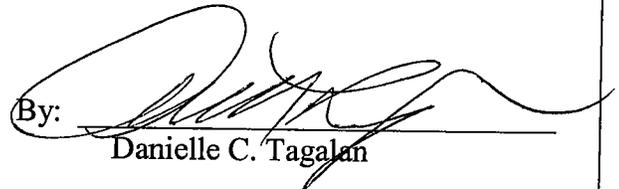
CERTIFICATE OF SERVICE

I hereby certify that on August 21, 2008, I caused the foregoing **PETITION TO CANCEL** to be served via first class mail in an envelope addressed to:

Hughes Hubbard & Reed LLP
One Battery Park Plaza
New York, NY 10004
Domestic Representative for Registrant

Dated: August 21, 2008

By:



Danielle C. Tagalan