

ESTTA Tracking number: **ESTTA463119**

Filing date: **03/21/2012**

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

Proceeding	92054923
Party	Defendant Consolidated European Brands Ltd.
Correspondence Address	MICHAEL J MACDERMOTT CHRISTIE PARKER & HALE LLP PO BOX 29001 GLENDALE, CA 91209-9001 UNITED STATES pto@cph.com
Submission	Other Motions/Papers
Filer's Name	Michael J. MacDermott
Filer's e-mail	pto@cph.com, mm@cph.com
Signature	/Michael J. MacDermott/
Date	03/21/2012
Attachments	Part 1 of Respondents Motion to Set Aside Notice of Default.pdf (18 pages) (370225 bytes) Part 2 of Respondents Motion to Set Aside Notice of Default.pdf (9 pages) (313395 bytes) Part 3 of Respondents Motion to Set Aside Notice of Default.pdf (9 pages) (154980 bytes)

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

In the Matter of Trademark Registration Nos. 1,790,599, 3,322,442 and 4,018,064
For the Marks BLACK DEATH and Design, BLACK DEATH and BLACK DEATH,
respectively

Valgeir Tomas Sigurdsson

Petitioner,

v.

Consolidated European Brands Ltd.

Respondent.

Cancellation No. 92054923

RESPONDENT'S MOTION TO SET ASIDE NOTICE OF DEFAULT

Respondent, Consolidated European Brands Ltd., hereby moves the Honorable Board pursuant to Rule 55(c) of the Federal Rules of Civil Procedure to set aside the Notice of Default entered February 7, 2012.

In support of this motion, Respondent submits the appended declarations of Thomas C. Lines, Steve Waine and Michael J. MacDermott and the following argument.

1. Legal Standard for Setting Aside Notice of Default

"If a defendant who has failed to file a timely answer to the complaint responds to a notice of default by filing a satisfactory showing of good cause why default judgment should not be entered against it, the Board will set aside the notice of default." TBMP Section 312.02.

"Good cause why default judgment should not be entered against a defendant, for failure to file a timely answer to the complaint, is usually found when the defendant shows that (1) the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action. ... The showing of a meritorious defense does not require an evaluation of the merits of the case. All that is required is a plausible response to the allegations in the complaint." TBMP Section 312.02.

"The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board. ... In exercising that discretion, the Board must be mindful of the fact that it is the policy of the law to decide cases on their merits. Accordingly, the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant." TBMP Section 312.02.

2. No Willful Conduct or Gross Neglect

In this case, as set forth in the appended declarations, the failure to file a timely answer was not the result of willful conduct or gross neglect. Respondent acted the same day it became aware of the default and promptly contacted the Petitioner's counsel requesting consent to set aside the default. That consent was not given. Thus, this motion.

As stated in the appended declarations, neither Respondent nor its counsel, to the best of their knowledge, ever received a copy of the Petition for Cancellation allegedly served by Petitioner. In this case, the Petition for Cancellation should have been served

to both of Respondent's addresses of record. Two different addresses are recited in the registrations. Registration No. 1790599 recites an address at 17 Landsdowne Road, Croydon in the United Kingdom. Registration Nos. 3322442 and 4018064 recite an address at 35 Old Queen Street, London in the United Kingdom.

Further, Respondent requests that the Board take judicial notice of the attached renewal of Registration No. 1,790,599 (Exhibit 1) which includes an Appointment of Domestic Representative appointing Respondent's law firm as its representative at its Pasadena, California address. That address was the address of Respondent's counsel until December 9-12, 2011 and Respondent's counsel continues to receive mail from the United States Postal Service at that address.

3. Respondent's Meritorious Defense

Secondly, Respondent submits herewith its proposed answer to the Petition which denies the salient allegations of the Petition and alleges affirmative defenses. Said defenses include a prior agreement between the parties in which the Petitioner agreed not to assert rights in the mark or to challenge Respondent's ownership of same.

4. No Substantial Prejudice to Petitioner

Thirdly, Petitioner will not be prejudiced by the short delay occasioned by the default herein. Respondent requests that the Trademark Board take judicial notice of the attached TARR printout of Petitioner's pending application Serial No. 85/271,770 (Exhibit 2) which was filed on March 20, 2011. Given the allegations in the Petition, it is apparent that Petitioner was fully aware of Respondent's registrations and could have filed its Petition for Cancellation as early as March 20, 2011 after the filing of its application or even before then.

On June 17, 2011, an action issued in the case, a copy of which is attached (Exhibit 3), refusing registration of Petitioner's application. Petitioner could have filed its Petition for Cancellation at that time but chose not to do so.

Instead, Petitioner delayed until mid-December, 2011 before filing its Petition for Cancellation.

It is not tenable for Petitioner to now assert that it would be substantially prejudiced by a delay of one month in Respondent's response to the Petition for Cancellation.

In view of the foregoing argument and the declarations and other evidence submitted herewith, we respectfully urge that Respondent's motion be granted.

DATED: March 16, 2012

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 

Brian K. Brookey
Michael J. MacDermott
Attorneys for Respondent
P.O. Box 29001
Glendale, CA 91209-9001
Phone: 626/795-9900

Enclosures: Declaration of Thomas C. Lines
Declaration of Steve Waine
Declaration of Michael J. MacDermott
Exhibit 1 -Renewal of Registration No. 1,790,599
Exhibit 2 - TARR Printout of Serial No. 85/271,770
Exhibit 3 - Office Action in Serial No. 85/271,770

CERTIFICATE OF TRANSMISSION AND SERVICE

I certify that on March 21, 2012 a true and correct copy of the foregoing document entitled **RESPONDENT'S MOTION TO SET ASIDE NOTICE OF DEFAULT** is being electronically transmitted for filing to the:

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

It is further certified that on March 21, 2012, a true and correct copy of the foregoing document entitled **RESPONDENT'S MOTION TO SET ASIDE NOTICE OF DEFAULT** is being served on counsel for Petitioner by mailing a copy thereof by U.S. Postal Service, first-class mail, addressed to:

Neil Steiner
STEINER & LIBO PROFESSIONAL CORPORATION
433 N. Camden Drive , Suite 730
Beverly Hills, CA 90210

*Attorneys for Petitioner,
Valgeir Tomas Sigurdsson*

By: _____


Brian K. Brookey
Michael J. MacDermott
Attorneys for Respondent
Christie, Parker & Hale, LLP
P.O. Box 29001
Glendale, CA 91209-9001
Phone: 626/795-9900

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

In the Matter of Trademark Registration Nos. 1,790,599, 3,322,442 and 4,018,064
For the Marks BLACK DEATH

Valgeir Tomas Sigurdsson

Petitioner,

v.

Consolidated European Brands Ltd.

Respondent.

Cancellation No. 92054923

DECLARATION OF THOMAS C. LINES

I, Thomas C. Lines, hereby declare and state that:

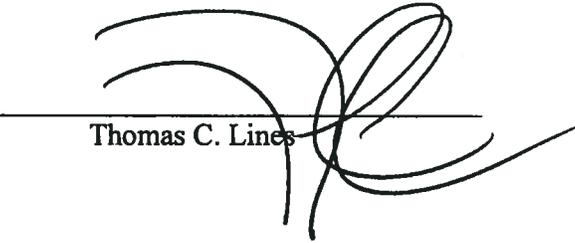
1. I am the Chief Executive Officer of the Respondent Consolidated European Brands Ltd. To the best of my knowledge, the Respondent never received the Petition for Cancellation in this proceeding which was allegedly served by the Petitioner's counsel on December 13, 2011.

2. I first received notice of this proceeding on March 9, 2012 when I received from my counsel Michael J. MacDermott a copy of the Board's February 7, 2012 Notice of Default which, apparently, had been forwarded by our trademark agent in the United Kingdom Mr. Steve Waine.

3. Consolidated European Brands, Ltd. has a meritorious defense to the allegations of the Petition including the defense of estoppel by virtue of prior agreements with the Petitioner.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Date March 16, 2012


Thomas C. Lines

JLP PAS1164936.1-* -03/15/12 2:30 PM

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

In the Matter of Trademark Registration Nos. 1,790,599, 3,322,442 and 4,018,064
For the Marks BLACK DEATH

Valgeir Tomas Sigurdsson	
	Petitioner,
v.	
Consolidated European Brands Ltd.	
	Respondent.

Cancellation No. 92054923

DECLARATION OF STEVE WAINE

I, Steve Waine, hereby declare and state that:

1. I am a Director, Trademarks for Murgitroyd & Company, a leading intellectual property firm based in the United Kingdom. We maintain an office at 17 Lansdowne Road, Croydon, CRO 2BX, United Kingdom which is the address of the Respondent Consolidated European Brands Ltd. for U.S. trademark Registration No. 1790599.
2. I am responsible for the trademark matters of the Respondent in the European Community and elsewhere.
3. I have checked the records of our firm and we have no record of ever having receive the Petition for Cancellation in this proceeding. We did receive the Notice of Default in the proceeding on or about March 8, 2012 and on March 9, 2012 I promptly forwarded the same by e-mail to my American counterpart Michael J. MacDermott.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Date March 16, 2012



Steve Waine

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

In the Matter of Trademark Registration Nos. 1,790,599, 3,322,442 and 4,018,064
For the Marks BLACK DEATH

Valgeir Tomas Sigurdsson	Cancellation No. 92054923
Petitioner,	
v.	
Consolidated European Brands Ltd.	
Respondent.	

DECLARATION OF MICHAEL J. MACDERMOTT

I, Michael J. MacDermott, hereby declare and state that:

1. I am an attorney at law admitted to practice in the State of California. I am counsel for the Respondent with respect to the registrations in issue.

2. On March 9, 2012, I received the Notice of Default in this proceeding by e-mail from the Respondent's United Kingdom trademark agent Mr. Steve Waine. That was my first notice of this proceeding.

3. I have checked the records of our firm and we have no record of having received the Petition for Cancellation in this proceeding although counsel for Petitioner has verbally alleged that a copy was mailed to our former Pasadena address. Our firm moved its offices to its current address in Glendale, California on our about December 9-12, 2011.

4. On March 9, 2012, I sent the attached e-mail (Exhibit A) to Mr. Neil Steiner, counsel of record for the Petitioner, informing him of the fact that we had not received the Petition for Cancellation and requesting that he consent to set aside the default in this case. I reiterated the request for his consent to set aside the default in a telephone conference later that day with Mr. Steiner. As of this date, Petitioner's counsel has neither consented to the setting aside of the default nor explicitly refused to do so.

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Date March 16, 2012



Michael J. MacDermott

Exhibit 1

7

TRADEMARK
Docket No. 46570/MM/C910

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
COMBINED APPLICATION FOR RENEWAL OF REGISTRATION
UNDER SECTION 9, AND
DECLARATION OF USE UNDER SECTION 8**

Mark : BLACK DEATH (stylized) and design (skull with top hat)
Registration No. : 1,790,599
Registered : August 31, 1993
Class(es) : 33

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 on August 18, 2003 Diane M. Hernandez
(Date of Deposit)

ASSISTANT COMMISSIONER FOR TRADEMARKS:

The applicant for renewal of the above-identified registration is Consolidated European Brands Ltd., a United Kingdom corporation, with mailing address c/o Castles, 17 Lansdowne Road, Croydon CRO 2BX, United Kingdom. The applicant requests that the above-identified registration, granted on August 31, 1993, which applicant now owns, as shown by records in the U.S. Patent and Trademark Office, be renewed in accordance with the provisions of Section 9 of the Act of July 5, 1946.

I, Thomas C. Lines, the undersigned, declare that I am Chief Executive Officer of renewal applicant and am authorized to make this declaration for and on behalf of said applicant; and that the mark shown in the registration is still in use in commerce on or in connection with the following goods identified in the registration: VODKA, the attached specimen showing the mark as currently used.

DESIGNATION OF DOMESTIC REPRESENTATIVE

Christie, Parker & Hale, LLP, whose postal address is P.O. Box 7068, Pasadena, California 91109-7068, U.S.A., is hereby designated applicant's domestic representative upon whom notices or process in proceedings affecting the mark may be served.

09/15/2003 TSMITH 00000216 1790599

01 FC:6205
02 FC:6201

100.00 OP
400.00 OP

✓

Registration No. 1,790,599

POWER OF ATTORNEY

Applicant hereby appoints the following members of the Bar and attorneys of the law firm Christie, Parker & Hale, LLP, with full power of substitution and revocation, to transact all business in the Patent and Trademark Office in connection with this Registration:

D. Bruce Prout	Syed A. Hasan	Charles R. Halloran	Frank L. Cire
Richard J. Ward, Jr.	Harold E. Wurst	Raymond R. Tabandeh	Rodney V. Warfford
LeRoy T. Rahn	Robert A. Green	Gary S. Dukarich	David J. Bailey
Walter G. Maxwell	Howard A. Kroll	Cynthia A. Bonner	Kevin K. Leung
William P. Christie	Richard A. Wallen	Jun-Young E. Jeon	Rose A. Hickman
David A. Dillard	Michael J. MacDermott	Peter A. Nichols	Ksenya Medvedev
Thomas J. Daly	Anne Wang	Stephen D. Burbach	R. William Johnston
Vincent G. Gioia	Constantine Marantidis	Leigh O. Linder	Hayden A. Carney
Theodore A. Pianko	Daniel R. Kimbell	Brian K. Brookey	Russell R. Palmer, Jr.
Edward R. Schwartz	Daniel M. Cavanagh	Mark J. Marcelli	Richard D. Seibel
John D. Carpenter	Gary J. Nelson	David J. Steele	Theresa W. Middlebrook
Wesley W. Monroe	Kathleen M. Olster	John W. Peck	Richard J. Paciulan
David A. Plumley	Josephine E. Chang	Brian L. Yates	Richard A. Clegg
Gregory S. Lampert	Joel A. Kauth	Gary D. Lueck	
Mark Garscia	Patrick Y. Ikehara	Tom H. Dao	

The authority under this Power of Attorney of each person named above shall automatically terminate and be revoked upon such person ceasing to be a member or associate of or of counsel to that law firm.

Please address all correspondence and the renewal certificate to CHRISTIE, PARKER & HALE, LLP, P.O. Box 7068, Pasadena, CA 91109-7068.

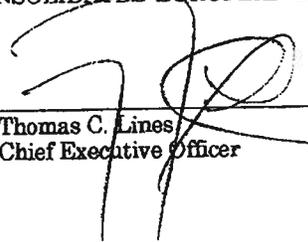
DECLARATION

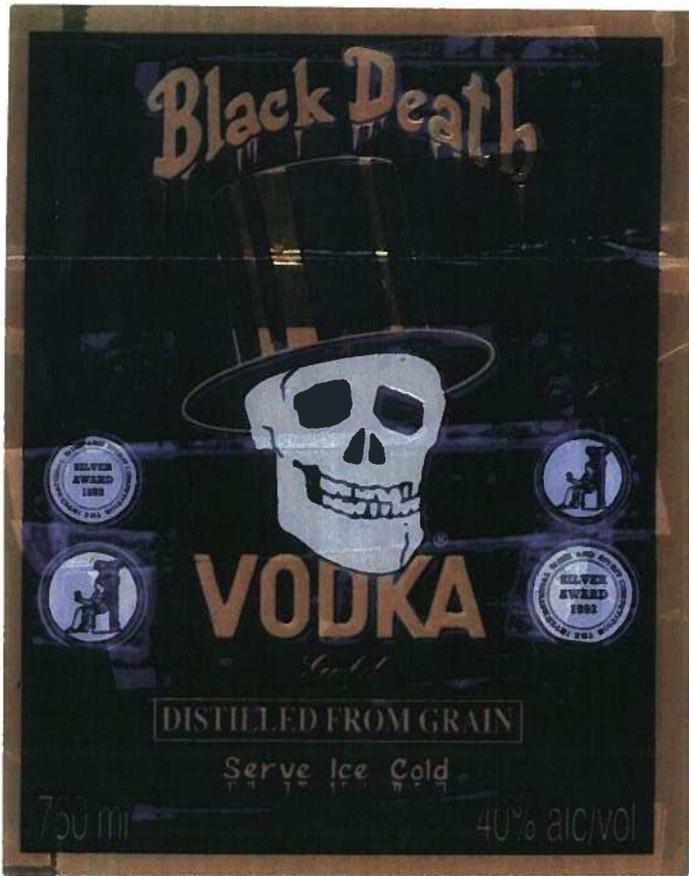
Registration No. 1,790,599

I, the undersigned, declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the aforesaid registration and this renewal application.

CONSOLIDATED EUROPEAN BRANDS LTD.

Date 28 FEB, 2003

By 
Thomas C. Lines
Chief Executive Officer



Incoming Correspondence Routing Sheet

To: Post Registration (PRU)

Word Mark: BLACK DEATH

Reg. No.: 1790599



Serial No: 74202223



Mail Date: 09022003



Doc. Type: Combined Section 8 and 9



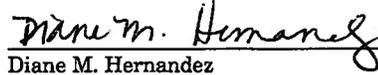
Fee

RAM Mail Date: 090203



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
COMBINED RENEWAL APPLICATION
AND DECLARATION OF USE TRANSMITTAL

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 on August 28, 2003.


Diane M. Hernandez

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

August 28, 2003

Commissioner:

Enclosed for filing are:

1. A combined renewal application and declaration of use for the following registration:

Mark : BLACK DEATH (stylized) and design (skull with top hat)
Reg. No. : 1,790,599
Registered : August 31, 1993
Class(es) : 33
Registrant : Consolidated European Brands Ltd.

2. One specimen of the mark as used.
3. A check for \$500 for the filing fee.

Any deficiency in or overpayment of fees for this transaction should be charged or credited to Deposit Account No. 03-1728. Please show our docket number with any Deposit Account transaction. **A copy of this letter is enclosed.**

Please address all correspondence to **CHRISTIE, PARKER & HALE, LLP, P.O. Box 7068, Pasadena, California 91109-7068.**

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 
Michael J. MacDermott
626/795-9900

MM/dmh

Black Death



VODKA

Bottled under supervision of
THE BOURDSSON FAMILY

Do not consume without my signature

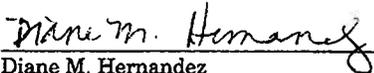
Signature

40

Serve Ice Cold
100% Grain Neutral Spirits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
COMBINED RENEWAL APPLICATION
AND DECLARATION OF USE TRANSMITTAL

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Diane M. Hernandez

Commissioner for Trademarks
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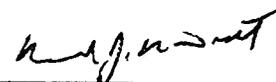
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Any deficiency in or overpayment of fees for this transaction should be charged or credited to Deposit Account No. 03-1728. Please show our docket number with any Deposit Account transaction. **A copy of this letter is enclosed.**

Please address all correspondence to **CHRISTIE, PARKER & HALE, LLP, P.O. Box 7068, Pasadena, California 91109-7068.**

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

By 

Michael J. MacDermott
626/795-9900

MM/dmh

Exhibit 2

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2012-03-16 14:34:13 ET

Serial Number: [85271770 Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

BLACK DEATH

(words only): [BLACK DEATH](#)

Standard Character claim: [Yes](#)

Current Status: [An Office action suspending further action on the application has been sent \(issued\) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.](#)

Date of Status: [2011-12-24](#)

Filing Date: [2011-03-20](#)

Filed as TEAS Plus Application: [Yes](#)

Currently TEAS Plus Application: [Yes](#)

Transformed into a National Application: [No](#)

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 103](#)

Attorney Assigned:
[SPARACINO MARK V](#)

Current Location: [L3X -TMEG Law Office 103 - Examining Attorney Assigned](#)

Date In Location: [2011-12-24](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SIGURDSSON, VALGEIR TOMAS

Address:

SIGURDSSON, VALGEIR TOMAS

433 N. Camden Drive, Ste 730

Beverly Hills, CA 90210

United States

Legal Entity Type: Individual

Country of Citizenship: Iceland

GOODS AND/OR SERVICES

International Class: 033

Class Status: Active

Distilled Spirits; Spirits; Spirits and liqueurs

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-12-24 - Notification Of Letter Of Suspension E-Mailed

2011-12-24 - LETTER OF SUSPENSION E-MAILED

2011-12-24 - Suspension Letter Written

2011-12-13 - Teas/Email Correspondence Entered

2011-12-13 - Communication received from applicant

2011-12-13 - TEAS Response to Office Action Received

2011-11-25 - Applicant/Correspondence Changes (Non-Responsive) Entered

2011-11-25 - TEAS Change Of Owner Address Received

2011-11-25 - TEAS Change Of Correspondence Received

2011-11-23 - Attorney Revoked And/Or Appointed

2011-11-23 - TEAS Revoke/Appoint Attorney Received

2011-06-17 - Notification Of Non-Final Action E-Mailed

2011-06-17 - Non-final action e-mailed

2011-06-17 - Non-Final Action Written

2011-06-17 - Assigned To Examiner

2011-03-24 - New Application Office Supplied Data Entered In Tram

2011-03-23 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

NEIL STEINER

Correspondent

NEIL STEINER

STEINER & LIBO, PROFESSIONAL CORPORATION

433 N. CAMDEN DRIVE, SUITE 730

BEVERLY HILLS CA 90210

Phone Number: 310 273 7778

Exhibit 3

To: SIGURDSSON, VALGEIR TOMAS (michael@machatlaw.com)

Subject: U.S. TRADEMARK APPLICATION NO. 85271770 - BLACK DEATH - N/A

Sent: 6/17/2011 6:20:00 PM

Sent As: ECOM103@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
[Attachment - 7](#)
[Attachment - 8](#)
[Attachment - 9](#)
[Attachment - 10](#)
[Attachment - 11](#)
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[Attachment - 29](#)
[Attachment - 30](#)

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 85271770

MARK: BLACK DEATH

85271770

CORRESPONDENT ADDRESS:

MICHAEL MACHAT
MACHAT & ASSOCIATES, P.C.
9107 WILSHIRE BLVD STE 425
BEVERLY HILLS, CA 90210-5550

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: SIGURDSSON, VALGEIR
TOMAS

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:

michael@machatlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/17/2011

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62, 2.65(a); TMEP §§711, 718.03.

REFUSAL TO REGISTER – Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3322442 and 1790599. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods

and/or services, and similarity of trade channels of the goods and/or services. See *In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.*, 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

A. Two Part Analysis

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

1. The Marks Are Confusingly Similar

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); see TMEP §1207.01(b).

Applicant's mark BLACK DEATH is confusingly similar to the mark in registration no. 3322442, BLACK DEATH, because they are identical.

Applicant's mark is confusingly similar to the mark in registration no. 1790599, BLACK DEATH and design, because they both contain the dominant term BLACK DEATH.

When a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods and/or services; therefore, the word portion is normally accorded greater weight in determining whether marks are confusingly similar. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); TMEP §1207.01(c)(ii); see *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Kysela Pere et Fils, Ltd.*, 98 USPQ2d 1261, 1267-68 (TTAB 2011).

The word portions of the marks are nearly identical in appearance, sound and meaning. The addition of the design element does not obviate the similarity of the marks in this case. See *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

When applicant's mark is compared to a registered mark, "the points of similarity are of greater importance than the points of difference." *Esso Standard Oil Co. v. Sun Oil Co.*, 229 F.2d 37, 108 USPQ 161 (D.C. Cir.), *cert. denied*, 351 U.S. 973, 109 USPQ 517 (1956); TMEP §1207.01(b).

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See

Recot, Inc. v. M.C. Becton, 214 F.2d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

The marks are compared in their entireties under a Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b)(viii), (c)(ii).

2. The Goods and/or Services are Related

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); see, e.g., *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant's goods are "Distilled Spirits; Spirits; Spirits and liqueurs."

The goods for registration no. 3322442 include "DISTILLED SPIRITS," and "LIQUEURS." The respective goods are related because they are identical.

The goods for registration no. 1790599 are "vodka." The trademark examining attorney has attached evidence from the USPTO's X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods listed therein, namely spirits, liqueurs and vodka, are of a kind that may emanate from a single source under a single mark. See *In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

In addition, various alcoholic beverages have been shown to be related goods for purposes of a Trademark Act Section 2(d) analysis. *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (holding GASPAR'S ALE for beer and ale likely to be confused with JOSE GASPAR GOLD for tequila); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (holding RED BULL for tequila likely to be confused with RED BULL for malt liquor); *In re Salierbrau Franz Sailer*, 23 USPQ2d 1719 (TTAB 1992) (holding CHRISTOPHER COLUMBUS for beer likely to be confused with CRISTOBAL COLON & design for sweet wine); *Somerset Distilling, Inc. v. Speymalt Whiskey Distribs. Ltd.*, 14 USPQ2d 1539 (TTAB 1989) (holding JAS. GORDON and design for scotch whiskey likely to be confused with GORDON'S for distilled gin and vodka); *Schieffelin & Co. v. Molson Cos.*, 9

USPQ2d 2069 (TTAB 1989) (holding BRAS D'OR for brandy likely to be confused with BRADOR for beer); *Bureau Nat'l Interprofessionnel Du Cognac v. Int'l Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988) (holding trademark COLAGNAC for cola flavored liqueur likely to be confused with certification mark COGNAC for brandy).

B. Any Doubt Resolved in Favor of Registrant

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

EARLIER-FILED APPLICATION MAY BE A BAR TO REGISTRATION

The effective filing date of pending Application Serial No. 85058914 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus

applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

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TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

Print: Jun 17, 2011

74202223

DESIGN MARK

Serial Number
74202223

Status
REGISTERED AND RENEWED

Word Mark
BLACK DEATH

Standard Character Mark
No

Registration Number
1790599

Date Registered
1993/08/31

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner
Consolidated European Brands Ltd. CORPORATION UNITED KINGDOM 17
Landsdowne Road Croydon UNITED KINGDOM CRO 2BX

Goods/Services
Class Status -- ACTIVE. IC 033. US 049. G & S: vodka. First Use:
1979/00/00. First Use In Commerce: 1989/09/00.

Prior Registration(s)
1428102

Filing Date
1991/09/10

Examining Attorney
UNKNOWN

Attorney of Record
MICHAEL J. MACDERMOTT

Black Death



Print: Jun 17, 2011

77039135

DESIGN MARK

Serial Number
77039135

Status
REGISTERED

Word Mark
BLACK DEATH

Standard Character Mark
Yes

Registration Number
3322442

Date Registered
2007/10/30

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Consolidated European Brands Limited CORPORATION UNITED KINGDOM 35 Old
Queen Street London SW1H 9JD UNITED KINGDOM

Goods/Services
Class Status -- ACTIVE. IC 033. US 047 049. G & S: DISTILLED
SPIRITS; VODKA; LIQUEURS; WINE; WINE COOLERS; PREPARED ALCOHOLIC
COCKTAILS; FLAVORED BREWED MALT BEVERAGES; ALCOHOLIC BEVERAGES OF
FRUIT.

Foreign Country Name
ERPNTY CMNTY TM OFC

Foreign Registration Number
000334276

Foreign Registration Date
1998/08/31

Foreign Expiration Date
2016/07/30

Print: Jun 17, 2011

77039135

Prior Registration(s)

1428102;2760856

Filing Date

2006/11/07

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BLACK DEATH