

ESTTA Tracking number: **ESTTA467295**

Filing date: **04/16/2012**

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	Ecuabeverage Corporation		
Entity	Corporation	Citizenship	New York
Address	1240 Randall Avenue Bronx, NY 10474 UNITED STATES		

Attorney information	EDWIN D. SCHINDLER EDWIN D. SCHINDLER, PATENT ATTORNEY 4 HIGH OAKS COURT P. O. BOX 4259 HUNTINGTON, NY 11743-0777 UNITED STATES EDSchindler@att.net, EDSchindler@optonline.net, EdwinSchindler@gmail.com, EdwinSchindler@yahoo.com Phone:(631)474-5373
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**Registration Subject to Cancellation**

Registration No	3949746	Registration date	04/26/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	BALORU S.A. Km. 16 1/2, Via Daule Guayaquil, ECUADOR		

**Goods/Services Subject to Cancellation**

Class 032. All goods and services in the class are cancelled, namely: Soft drinks; Syrups for making soft drinks
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**Grounds for Cancellation**

Other	Failure to include disclaimer to unregistrable component, which is "merely descriptive" and to which Registrant can claim no exclusive rights. Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ 1545, 1549 (T.T.A.B. 1990)
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Related Proceedings	Related proceedings involving "related" companies are as follows: 1. Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation, Docket No. 12-1140 (2nd Cir., Docketed 3/23/2012); 2. Royal Signature, Inc. v. Ecuabeverage Corporation, Cancellation No. 92051197; 3. Ecuabeverage Corporation v. Brooklyn Bottling Co. of Milton, New York, Inc., Cancellation No. 920512242; 4. Ecuabeverage Corporation v. Brooklyn Bottling of Milton, New York, Inc., Cancellation No. 92051263
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Attachments	TROPICAL (AND DESIGN), Tmk. Reg. No. 3,949,746-Petition for Cancellation (4-16-2012).PDF ( 53 pages )(2769714 bytes ) TROPICAL (AND DESIGN), Tmk. Reg. No. 3,949,746-Certificate of Service (4-16-2012).PDF ( 1 page )(32928 bytes )
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### **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	/Edwin D. Schindler/
Name	EDWIN D. SCHINDLER
Date	04/16/2012



Respondent Baloru S.A.'s Use of its Registered Trademark by a "Related Company"

3. Baloru is a manufacturer of concentrates used for making soft drinks that are sold in the United States, as explained by Panagiota Betty Tufariello, Esq., attorney for Plaintiff Brooklyn Bottling of Milton, New York, Inc., at a hearing conducted by the U.S. District Court for the Southern District of New York on March 5, 2012, in the civil action entitled *Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation*, Civil Action No. 07-cv-08483 (AKH). ("Exhibit 1" at Page 8)

4. Royal Signature, Inc. arranges for the purchase of the concentrates produced by Baloru in Ecuador and Royal Signature, Inc. imports those concentrates into the United States and provides the concentrates to other entities in the United States for U.S. distribution. ("Exhibit 1" at Page 8)

5. Brooklyn Bottling of Milton, New York, Inc. ("Brooklyn Bottling") acts as a distributor of soft drinks and other beverages in the eastern portion of the United States for Baloru by distributing in the United States soft drinks made from concentrate, or syrup, supplied by Baloru for making the soft drinks that are distributed by Brooklyn Bottling. ("Exhibit 1" at Page 8)

6. Brooklyn Bottling is a "related company" of Baloru, §5 of the Trademark Act, 15 U.S.C. §1055, and Brooklyn Bottling's use of the trademark of Trademark Registration No. 3,949,746, issued April 26, 2011 ("Exhibit 2"), inures to the benefit of Baloru.

Legal Proceedings Relevant to the Petition for Cancellation

7. Ecuabeverage is a direct competitor of Brooklyn Bottling in the relevant soft drink market in the United States.

8. Both Ecuabeverage and Brooklyn Bottling use composite trademarks that include of the term “TROPICAL” in the marketing of their competing goods in the relevant U.S. soft drink market.

9. In the civil litigation of *Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation*, Civil Action No. 07-cv-08483 (AKH), Brooklyn Bottling has alleged that Baloru possesses a “family of marks” based upon the term “TROPICAL” for the relevant goods marketed in the United States by both Ecuabeverage and Baloru’s “related company,” Brooklyn Bottling.

10. Ecuabeverage is being damaged, and will continue to be damaged, by the continued registration of U.S. Trademark Registration No. 3,949,746, issued April 26, 2011, for the mark “TROPICAL (AND DESIGN),” which recites goods in International Class 32 as “soft drinks” and “syrups for making soft drinks.”

**I. Count for Cancellation on the Ground that Baloru, S.A. Can Claim No Exclusive Rights to “TROPICAL,” that “TROPICAL” is an “Unregistrable Component” and, as the “Dominant Feature” of the Registered Trademark, Extends a Non-Registrable Meaning to the Entirety of the Trademark, Pursuant to §6(a) of the Trademark Act, 15 U.S.C. §1056(a)**

11. Petitioner Ecuabeverage Corporation repeats and realleges each and every allegation set forth in ¶¶ 1 – 10 of this *Petition for Cancellation*.

12. Eric Miller, president of Brooklyn Bottling, a “related company” within the meaning of §5 of the Trademark Act, 15 U.S.C. §1055, filed an “Affidavit” on December 22, 2009, in the civil action of *Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation*, Civil Action No. 07-cv-08483 (AKH), in which Eric Miller testified (at ¶ 8) that: “Brooklyn Bottling is not claiming that Defendant [Ecuabeverage]

cannot use the term ‘tropical’ to market its product.” (“Exhibit 3”)

13. Brooklyn Bottling has conceded that Ecuabeverage can use the term “tropical” to market its beverage goods, which beverage goods compete with Brooklyn Bottling, which distributes product for, or utilizes the concentrate of, Baloru in the U.S.

14. Brooklyn Bottling, a related company of Baloru, has disclaimed the exclusive right to use “tropical” in the marketing of “soft drink” goods.

15. No entity can claim any exclusive rights to the term “tropical” in the marketing of soft drink goods.

16. Baloru can claim no exclusive rights to the term “tropical” in the marketing of its soft drink goods.

17. “TROPICAL” is an unregistrable component of U.S. Trademark Registration No. 3,949,746.

18. “TROPICAL” is the dominant, or prominent, feature of U.S. Trademark Registration No. 3,949,746.

19. The dominant or prominent feature of U.S. Trademark Registration No. 3,949,746 is an unregistrable component which extends a nonregistrable meaning to the registered trademark of U.S. Trademark Registration No. 3,949,746, as a whole and, as such, the purported “trademark” of U.S. Trademark Registration No. 3,949,746 is unregistrable in its entirety, should not have been registered, and should therefore be cancelled. *See, Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991).

**H. U.S. Trademark Registration No. 3,949,746 Should Be Cancelled for Failure to Include a Disclaimer of “TROPICAL” Or, In the Alternative, Should Be Required to Be Amended to Now Disclaim “TROPICAL” Apart From the Mark, As Shown, Pursuant to §6(a) of the Trademark Act, 15 U.S.C. §1056(a)**

20. Petitioner Ecuabeverage Corporation repeats and realleges each and every allegation set forth in ¶¶ 1 – 19 of this *Petition for Cancellation*.

21. Baloru can claim no exclusive right to term “TROPICAL” for soft drinks.

22. Baloru should have been required to disclaim “TROPICAL” in the prosecution of the trademark application that issued as U.S. Trademark Registration No. 3,949,746, because Baloru can claim no exclusive right to the term “TROPICAL” for soft drinks. *See, Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991) (“A disclaimer shows that the applicant enjoys no exclusive rights to the disclaimed symbols apart from the composite mark.”).

23. U.S. Trademark Registration No. 3,949,746 should be cancelled on the ground that the issued trademark registration does not include a disclaimer of the term “TROPICAL,” pursuant to §6 of the Trademark Act, 15 U.S.C. §1056. *See, Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (T.T.A.B. 1990) (cancellation appropriate where unregistrable component has not been disclaimed).

24. In the alternative, Baloru should be required to amend U.S. Trademark Registration No. 3,949,746 to add a disclaimer of the term “TROPICAL,” apart from the mark, as shown, as a condition for avoiding cancellation of said trademark registration.

**III. Count for Cancellation on the Ground that “TROPICAL” is “Merely Descriptive” for Certain Flavored Beverage Drinks, is Therefore an “Unregistrable Component” and, as the “Dominant Feature” of the Registered Trademark, Extends a Non-Registrable Meaning to the Entirety of the Trademark, Pursuant to §6(a) of the Trademark Act, 15 U.S.C. §1056(a)**

25. Petitioner Ecuabeverage Corporation repeats and realleges each and every allegation set forth in ¶¶ 1 – 24 of this *Petition for Cancellation*.

26. “Tropical” is commonly used to describe beverage flavor. (“Exhibit 4”)

27. Brooklyn Bottling disclaimed “TROPICAL” in U.S. Trademark Registration No. 1,899,104, issued June 13, 1995, for the trademark “TROPICAL FANTASY” for “soft drink” goods on the ground that “TROPICAL” was merely descriptive and therefore an unregistrable component. (“Exhibit 5”)

28. Brooklyn Bottling disclaimed “TROPICAL in U.S. Trademark Registration No. 3,284,223, issued August 28, 2007, for the trademark “Tropical Fantasy TF Extreme Energy Drink” for “energy drinks, soft drinks, fruit juice cocktails, fruit juices, vegetable juice cocktails, vegetable juices and bottled water” goods on the ground that “TROPICAL” was merely descriptive and therefore an unregistrable component. (“Exhibit 6”)

29. Jeffrey E. Jacobson, Esq., counsel to Plaintiff Brooklyn Bottling in the civil action entitled *Brooklyn Bottling of Milton, New York, Inc. v. Ecuabeverage Corporation*, Civil Action No. 07-cv-08483 (AKH), testified in an “Affirmation” (at ¶ 20) filed April 11, 2008, in the civil action which referenced the label and goods of Brooklyn Bottling as “Plaintiff’s label for tropical flavored sodas,” thereby using “tropical” in a merely descriptive manner. (“Exhibit 7”)

30. “TROPICAL” is a “merely descriptive” term and therefore an unregistrable component of U.S. Trademark Registration No. 3,949,746.

31. “TROPICAL” is the dominant, or prominent, feature of U.S. Trademark Registration No. 3,949,746.

32. The dominant or prominent feature of U.S. Trademark Registration No. 3,949,746 is a “merely descriptive” and therefore an unregistrable component which extends a nonregistrable meaning to the registered trademark of U.S. Trademark Registration No. 3,949,746, as a whole and, as such, the purported “trademark” of U.S. Trademark Registration No. 3,949,746 is unregistrable in its entirety, should not have been registered, and should therefore be cancelled. *See, Dena Corp. v. Belvedere International Inc.*, 950 F.2d 1555, 1560, 21 USPQ2d 1047, 1051 (Fed. Cir. 1991).

**IV. U.S. Trademark Registration No. 3,949,746 Should Be Cancelled for Failure to Include a Disclaimer of the “Merely Descriptive” Term “TROPICAL” Or, In the Alternative, Should Be Required to Be Amended to Now Disclaim “TROPICAL” on the Ground of Descriptiveness Apart From the Mark, As Shown, Pursuant to §6(a) of the Trademark Act, 15 U.S.C. §1056(a)**

33. Petitioner Ecuabeverage Corporation repeats and realleges each and every allegation set forth in ¶¶ 1 – 32 of this *Petition for Cancellation*.

34. “TROPICAL” is a “merely descriptive” term and therefore an unregistrable component of U.S. Trademark Registration No. 3,949,746.

35. Baloru should have been required to disclaim “TROPICAL” in the prosecution of the trademark application that issued as U.S. Trademark Registration No. 3,949,746, because the term “TROPICAL” is “merely descriptive” for the flavoring of various types of soft drinks.

36. U.S. Trademark Registration No. 3,949,746 should be cancelled on the ground that the issued trademark registration does not include a disclaimer of the “merely descriptive,” and therefore unregistrable, term “TROPICAL,” pursuant to §6 of the Trademark Act, 15 U.S.C. §1056. *See, Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (T.T.A.B. 1990) (cancellation appropriate where unregistrable component has not been disclaimed).

37. In the alternative, Baloru should be required to amend U.S. Trademark Registration No. 3,949,746 to add a disclaimer of the “merely descriptive” term “TROPICAL,” as a condition for avoiding cancellation of said trademark registration.

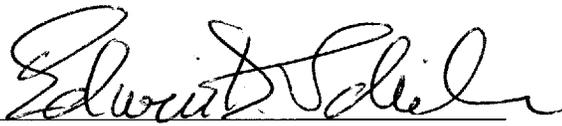
WHEREFORE, Petitioner Ecuabeverage Corporation respectfully demands that its *Petition for Cancellation* be granted and that the U.S. Trademark Registration No. 3,949,746, for the mark “TROPICAL (AND DESIGN),” be cancelled on the grounds that Registrant Baloru S.A. can claim no exclusive rights to the term “TROPICAL” and because “TROPICAL” is “merely descriptive” and the dominant, or prominent, feature of U.S. Trademark Registration No. 3,949,746, thereby rendering the trademark of U.S. Trademark Registration No. 3,949,746, nonregistrable in its entity or, in the alternative, that Registrant Baloru S.A. be required to disclaim the term “TROPICAL,” pursuant to §6 of the Trademark Act, 15 U.S.C. §1056, as a condition for avoiding cancellation of U.S. Trademark Registration No. 3,949,746.

The filing fee of \$300.00 in support of Ecuabeverage Corporation’s *Petition for Cancellation*, pursuant to 37 C.F.R. 2.6(a)(16), for petitioning for the cancellation of U.S.

Trademark Registration No. 3,949,746 in International Class 32, is being concurrently remitted via EFT.

Respectfully submitted

ECUABEVERAGE CORPORATION

By   
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April 16, 2012

# **EXHIBIT 1**

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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK  
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BROOKLYN BOTTLING OF MILTON,  
NEW YORK, INC.,

Plaintiff,

v.

07 CV 8483 (AKH)

ECUABEVERAGE, CORP.,

Defendant.

-----x

March 5, 2012

Before:

HON. ALVIN K. HELLERSTEIN,

District Judge

APPEARANCES

LAW OFFICES OF P.B. TUFARIELLO, PC

Attorneys for Plaintiff

BY: PANAGIOTA BETTY TUFARIELLO

EDWIN D. SCHINDLER

Attorney for Defendant

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1 (In open court)

2 THE DEPUTY CLERK: Appearing for the plaintiff today,  
3 your Honor, is Betty Tufariello. Representing the defendant,  
4 Mr. Edwin Schindler.

5 Please be seated, counsel.

6 THE COURT: I think the first thing I'd like to do,  
7 Ms. Tufariello, is for you to explain the assignments.

8 What we have here is a case that was begun in 2007.  
9 As I recall, all discovery was completed in April of 2010. So  
10 these are now motions made after discovery.

11 No trial date has yet been set. Nothing has happened,  
12 as far as I understand, in the case for about a year. And we  
13 have two motions before me, one by the defendant to dismiss for  
14 lack of prosecution and for sanctions, and one by the plaintiff  
15 to add an allegedly indispensable party, the present owner, I  
16 guess, of the trademark.

17 The trademark number 1,474,395 issued by the United  
18 States Patent and Trademark Office for a first use April 19,  
19 1966 in commerce is Tropical Puro Sabor Nacional, the words  
20 tropical having been disclaimed as a trademark in itself.  
21 Also, there is a disclaimer to the use of Puro Sabor by itself.  
22 Puro sabor is Spanish for pure flavor. And Nacional can't be a  
23 trademark either. So each element of this trademark is  
24 disclaimed in its own right. And you have the trademark for  
25 the entire phrase in English translated as tropical true

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1 national flavor.

2 The trademark was issued to Banco del Pacifico, SA, a  
3 corporation incorporated in Ecuador.

4 I am not clear, I have to say, on the various  
5 assignments, one to a company named Royal and now to a company  
6 named Baloru. And I'll ask Ms. Tufariello to clear that up.

7 MS. TUFARIELLO: Thank you, your Honor. And good  
8 afternoon.

9 THE COURT: Good afternoon.

10 MS. TUFARIELLO: Indeed, when you look at the way this  
11 trademark has gone back and forth, it is confusing.

12 THE COURT: Answer my question, please. Explain the  
13 assignments. Who is the assignee? Who is the assignor?  
14 What's the situation?

15 MS. TUFARIELLO: Today at this moment presently, the  
16 assignor is Brooklyn Bottling. The assignee is Baloru SA.

17 THE COURT: B-A-L-O-R?

18 MS. TUFARIELLO: U, space --

19 THE COURT: A corporation incorporated in Ecuador?

20 MS. TUFARIELLO: Yes, your Honor.

21 THE COURT: With any presence in New York?

22 MS. TUFARIELLO: Not currently, your Honor.

23 THE COURT: Okay. And when was that assignment made?

24 MS. TUFARIELLO: The assignment, as is indicated in my  
25 papers, I believe, was in May of 2011.

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1 THE COURT: Now, previously there had been another  
2 assignment, a company with the name Royal. Tell me about that.

3 MS. TUFARIELLO: Previously to that, actually, there  
4 was an assignment from Royal to Brooklyn Bottling, not from  
5 Tuba Royal. When these proceedings were brought to this Court  
6 initially, the trademark belonged to Royal Signature.

7 THE COURT: The Royal Signature was a company?

8 MS. TUFARIELLO: It is a company --

9 THE COURT: Corporation?

10 MS. TUFARIELLO: Yes.

11 THE COURT: Incorporated where?

12 MS. TUFARIELLO: It's in Panama.

13 THE COURT: Panamanian company?

14 MS. TUFARIELLO: Yes, your Honor.

15 THE COURT: And any presence in New York?

16 MS. TUFARIELLO: We have an agent and, in fact,  
17 Mr. Carlos Arias, who is here with me today, is the agent and  
18 representative of Royal Signature in the United States.

19 THE COURT: And Royal Signature assigned the trademark  
20 to Brooklyn Bottling?

21 MS. TUFARIELLO: Yes, your Honor. But that assignment  
22 was contingent on certain things happening. And that is, too,  
23 in fact, of record in this court, by virtue of one of the  
24 exhibits that was put by Mr. Schindler, my adversary, in reply.

25 THE COURT: Let me find the reply. All I have is a

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1 brief.

2 MS. TUFARIELLO: Actually, your Honor, it is document  
3 130-3 on the court docket.

4 THE COURT: Security interest?

5 MS. TUFARIELLO: Yes, your Honor. It's not really a  
6 security interest. It was an assignment, and it was contingent  
7 on certain events happening.

8 THE COURT: So then how is Brooklyn Bottling a real  
9 party in interest?

10 MS. TUFARIELLO: They had an assignment, and the  
11 understanding was --

12 THE COURT: But it's contingent. Contingent means  
13 subject to conditions precedent.

14 MS. TUFARIELLO: It was an outright assignment, except  
15 that in exchange for that assignment, certain things had to  
16 happen. Consideration had to be paid, had to be made for that  
17 assignment.

18 When the assignment was actually filed showing the  
19 transfer of the trademark from Royal Signature to Brooklyn  
20 Bottling, part of the consideration had been fulfilled, but  
21 part of it was still in the process. But the assignment was  
22 filed so that Brooklyn Bottling could be given the opportunity  
23 to continue with the prosecution of this case.

24 Subsequently, after I was retained and I reviewed the  
25 documents, we came to recognize that the second item in the

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1 consideration, which was the security of \$2 million, if the  
2 Court takes a moment to look at that assignment, which is 130-3  
3 on the court record --

4 THE COURT: Is it part of the record?

5 THE LAW CLERK: It's in the declaration.

6 (Pause)

7 THE COURT: Is it Exhibit 3 to Mr. Schindler's  
8 affirmation?

9 MS. TUFARIELLO: I believe so, your Honor. I believe  
10 so. And if I may direct the Court's attention to the first  
11 page of the assignment, which is identified on the court docket  
12 as page three of seven, paragraph D --

13 THE COURT: I have page one of seven, page two of  
14 seven, I have page three of seven, all right.

15 MS. TUFARIELLO: Yes, your Honor.

16 So if I may direct your attention, your Honor, to  
17 paragraph D, it says notwithstanding anything to the contrary,  
18 the amount of the collateral secured by this agreement will be  
19 \$2 million. And if the Court takes the time to read the rest  
20 of this assignment, this agreement, the Court will see that in  
21 addition -- that in exchange for this assignment, a  
22 collateral -- a lien would be put on Brooklyn Bottling's assets  
23 of \$2 million. That lien was never -- it never occurred. It  
24 never happened.

25 THE COURT: So does this mean that \$2 million was  
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1 advanced by Royal to Brooklyn?

2 MS. TUFARIELLO: No. The other way around. Brooklyn  
3 Bottling was supposed to permit Royal Signature to take a  
4 security on \$2 million worth of assets of Brooklyn Bottling.

5 THE COURT: In exchange for what?

6 MS. TUFARIELLO: In exchange for the assignment.

7 THE COURT: I see. Okay. So in effect, the trademark  
8 was assigned to Brooklyn Bottling for use in its business, and  
9 a lien of \$2 million secured the obligation of Brooklyn  
10 eventually to pay the money back?

11 MS. TUFARIELLO: Yes, your Honor.

12 THE COURT: Is there a note?

13 MS. TUFARIELLO: Other than the -- no, there was never  
14 a note.

15 THE COURT: Was there some kind of promise that  
16 regulated how and when the \$2 million would be paid?

17 MS. TUFARIELLO: There was an understanding, but the  
18 details of that understanding I'm not privy to.

19 THE COURT: All right. I understand. This is a  
20 five-year agreement?

21 MS. TUFARIELLO: Yes, your Honor.

22 THE COURT: It was made in January of 2008?

23 MS. TUFARIELLO: Yes, your Honor.

24 THE COURT: So how would there be another assignment  
25 to --

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1 MS. TUFARIELLO: Well, upon the breakdown of  
2 consideration, there was a discussion as to the return of the  
3 trademark to Royal Signature. Royal Signature in turn had an  
4 understanding -- if I may, your Honor, before I discuss how the  
5 transfer occurred from Brooklyn Bottling to Baloru, I feel  
6 obligated to share certain basic background facts that are  
7 necessary to understand as to what happened.

8 Baloru SA is the manufacturer of the concentrates that  
9 are coming into the United States and used by Brooklyn Bottling  
10 for purposes of formulating soft drinks, a number of soft  
11 drinks, one of which is the soft drink that bears the mark  
12 Tropical Puro Sabor Nacional.

13 Now, Baloru has an agreement with Royal Signature.  
14 Royal Signature is acting as the importer of the concentrates  
15 from Baloru through Panama into the United States. And I'm not  
16 sure if that's exactly the route, but the relationship is  
17 exactly that. Baloru SA manufactures the concentrates. Royal  
18 Signature makes the arrangements for the purchasing of the  
19 concentrates by US distributors and imports those concentrates  
20 into the United States, and then Royal Signature in turn sells  
21 them or provides them to its distributors, one of which is  
22 Brooklyn Bottling.

23 Currently we have one distributor in the east all the  
24 way up the Mississippi, and we're currently negotiating a  
25 second distributorship with a distributor west of the

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1 Mississippi, and I believe that distributorship is already in  
2 place.

3           So Royal Signature is basically the party that goes  
4 between the manufacturer and ultimately the bottler and the  
5 distributor in the United States. For whatever reason, a long  
6 time ago in the wisdom of the parties, of the officers of these  
7 two companies, Baloru and Royal Signature, Baloru at that time  
8 had decided to turn over the trademark to Royal Signature. The  
9 underlying business reasons, I don't know, and I'm still in the  
10 process of investigating, but they made that decision. So for  
11 all intents and purposes, since the very beginning the mark  
12 Tropical Puro Sabor Nacional was moved from Baloru SA to Royal  
13 Signature. And Royal Signature, in turn, had the right to  
14 sublicense out the trademark to its distributors in the United  
15 States.

16           THE COURT: And none of these parties is mentioned in  
17 the principal register. So how does the owner, which is a bank  
18 in Ecuador, how does it assign its interest to someone who has  
19 standing to sue in this --

20           MS. TUFARIELLO: No, your Honor, on the contrary. If  
21 you're looking strictly at the front of the trademark office  
22 site, indeed, it looks like Banco Pacifico was the original  
23 owner. However, if you click to the assignment status -- and  
24 now I'm going purely from memory -- when you first go to the  
25 trademark website, along the top there is a series of buttons,

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1 a sequence of buttons. One is called test. The other one's  
2 called tar. The other one is called TDR, which is basically  
3 trademark document retrieval. And then there's a little  
4 section that talks about assignments, and it says assignment  
5 history or something along those lines.

6 If, your Honor, if the Court were to click on that  
7 button, it would bring you to a new site where it actually  
8 shows all the assignments. What happened was Baloru SA  
9 actually purchased the trademark, Tropical Puro Sabor Nacional  
10 from Banco Pacifico. That's how Baloru came to be the owner of  
11 the trademark, who in turn as an assignor assigned it to Royal  
12 Signature. And then Royal Signature gave it to Brooklyn  
13 Bottling. And ultimately, when this consideration fell  
14 through, Brooklyn Bottling turned it back to its original  
15 owner, Baloru SA.

16 THE COURT: Well, this may be beautiful and true, but  
17 none of it is alleged. Pleadings are supposed to show the  
18 entitlement of the trademark owner to own and enforce the  
19 copyright -- the trademark, sorry. This is not set out.

20 MS. TUFARIELLO: I understand, your Honor.

21 THE COURT: And what you tell me, and you may be the  
22 first competent expositor of this information after we have had  
23 five years of litigation. All of it should have been set out.

24 MS. TUFARIELLO: I'm sorry, your Honor?

25 THE COURT: All of this should have been set out, and  
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1 all of this would have made unnecessary several motions that I  
2 ruled on. And even now it doesn't set anything out. All  
3 you're telling me is a process in motion but without any strong  
4 indication that anyone has a trademark in the United States.

5 MS. TUFARIELLO: Oh, yes, your Honor, we do have a  
6 trademark, because -- and that's part of the problem.  
7 Unfortunately, as secondary counsel, I'm bound by whatever is  
8 in the pleadings and by whatever discovery has already been  
9 done. And in an effort to --

10 THE COURT: You're telling me a different case than  
11 the one that started here.

12 MS. TUFARIELLO: I understand, your Honor. And I'm  
13 doing the best I can under the circumstances. And I hope the  
14 Court can appreciate my position and the position of both my  
15 clients, both Brooklyn Bottling as well as Royal Signature, as  
16 well as Baloru SA.

17 THE COURT: So what you're telling me should have  
18 happened is that there was a chain that was set out from the  
19 bank in Ecuador to Baloru, to Royal to Brooklyn Bottling and  
20 back along the same path?

21 MS. TUFARIELLO: To Baloru.

22 THE COURT: So Baloru, in effect, should have moved in  
23 this court to at least intervene or be substituted for Brooklyn  
24 Bottling, severed to a great number of challenges by  
25 Ecuabeverages, who's been litigating now under a different set

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1 of years for five years, and you're in effect starting a new  
2 lawsuit. Doesn't make sense.

3 MS. TUFARIELLO: Well, your Honor, one of the things  
4 that the Court indicated in response to my letter to bring this  
5 motion back in August was bring your motion so long as you're  
6 ready to go to trial. I don't need a lot of discovery. I'm  
7 prepared --

8 THE COURT: You're not going to get any. You're not  
9 going to get any. The case is finished in April 2010. And  
10 you're describing a different case from the one that's been  
11 pleaded. The point you're making in the motion is that I  
12 should not grant the defendants' motion because you called upon  
13 them to settle and they didn't want to settle. But that's not  
14 their obligation. They don't have to settle if they don't want  
15 to.

16 MS. TUFARIELLO: Actually, we have begun settlement  
17 discussions and we've come a long way, your Honor. At this  
18 point we have --

19 THE COURT: I'm really not interested in that. I'm  
20 not interested in the settlement discussions. I'm interested  
21 in where the case stands now. I do understand what you've told  
22 me. Thank you, because it makes sense for the first time.

23 All right. With that, let me pass on your motion. I  
24 will not grant your motion to include Baloru as an  
25 indispensable party. If Baloru wants to take possession of its

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1 rights, it has a right to intervene -- it could have had a  
2 right to intervene at an earlier time. But it chose not to  
3 intervene. You're suing the party that has no presence here.  
4 You want to sue a party that has no presence here because you  
5 believe that its presence is indispensable to litigation. You  
6 admit that you can't carry on the litigation without it, and  
7 it's obvious that you can't.

8 So I will deny the motion because we're not going to  
9 start again at this point in time and waste all the years that  
10 we've wasted. The motion is denied.

11 MS. TUFARIELLO: Thank you, your Honor.

12 THE COURT: Now, Mr. Schindler, your turn.

13 MR. SCHINDLER: Thank you, your Honor.

14 As an initial matter, I'd like to address the question  
15 of the assignment. The initial assignment in this case,  
16 presumably was from Royal Signature to Brooklyn Bottling, but  
17 according to the security interest from Royal Signature to  
18 Brooklyn Bottling says that the duration of the assignment of  
19 the trademark from the secured party, which is Royal Signature,  
20 to Brooklyn Bottling is five years from the date hereof. And  
21 it could end sooner, depending upon if there's a termination of  
22 the security interest for any reason.

23 The assignment with the reversion of the interest is  
24 not an assignment. It does not convey all the substantial  
25 rights. And, in fact, my understanding is Royal Signature

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1 might still be the owner and Brooklyn Bottling never acquired  
2 rights to the --

3 THE COURT: That's one of the reasons I denied the  
4 motion, because it's uncertain what the situation is. And you  
5 would be involved in discovery proceedings, you would ask for  
6 such, and we would have to open up the case again that's been  
7 closed since April of 2010. I decline to do that.

8 MR. SCHINDLER: Concerning the lack of prosecution,  
9 there has been no prosecution in this case for well over a  
10 year. In addition, if, according to the Second Circuit and the  
11 law of the case in this court, only the registered owner of the  
12 trademark can prosecute trademark -- a federal infringement  
13 claim under 15, 1114(1) section --

14 THE COURT: Title 15, what's the section number?

15 MR. SCHINDLER: 1114(1). The Second Circuit has held  
16 that only the registered owner, only the registrant has  
17 standing to bring that claim. And I think two or three claims  
18 of the amended complaint are dependent upon being a registered  
19 owner of that trademark. Otherwise, the Second Circuit held  
20 those claims must be dismissed for lack of standing.

21 This Court has held that also in this case back in  
22 October 3rd -- excuse me, March 3, 2007, when an initial motion  
23 to dismiss was brought, that Brooklyn Bottling did not own the  
24 registration that brought the federal trademark infringement  
25 claim on. This Court granted that motion. There was a quick

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1 assignment done for purposes strictly of the lawsuit, which is  
2 arguably an improper assignment.

3 THE COURT: Let's not get involved in --

4 MR. SCHINDLER: Okay.

5 THE COURT: Your point, Mr. Schindler, is that nothing  
6 has been done in this lawsuit since the discovery has closed,  
7 but that's true of your client as well. You also have not done  
8 anything in the lawsuit. You have counterclaims for relief to  
9 cancel the trademark. You have not done anything in the  
10 lawsuit either. Your motion directed to the plaintiff could  
11 just as well be made by the plaintiff against you.

12 MR. SCHINDLER: That's true, your Honor. We're  
13 willing to --

14 THE COURT: Nobody's done anything in this case.

15 MR. SCHINDLER: There's another issue, your Honor.

16 THE COURT: You know what, this is what I think I need  
17 to do: I think I should dismiss this lawsuit and the  
18 counterclaims without prejudice and without costs and forget  
19 about my own desire to levy sanctions on both of you for  
20 basically wasting my time for five years.

21 This is a different case now than it was. It's  
22 different from both points of view. Both sides have been  
23 remiss in not carrying this fight the way they wanted to and  
24 the way they said they would, and there's absolutely no need to  
25 continue this lawsuit at this point in time, because the whole

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1 basis for this lawsuit is uncertain.

2 I might add, how this trademark could be used in any  
3 offensive way is beyond me. It's entirely descriptive. Every  
4 single word is disclaimed in its own sense, and putting it  
5 together doesn't say anything more than the parts do.

6 But that's not something I adjudicate now. This is an  
7 uncertain trademark with uncertain ownership and uncertain  
8 alleged infringements, and there's no basis for it at this  
9 point in time. So the motion to dismiss for lack of  
10 prosecution is granted. It's going to apply to both the claims  
11 and the counterclaims.

12 I deny the motion for sanctions. I think there's  
13 blame to go around, including on me for not pushing you harder,  
14 and, therefore, the claims are dismissed.

15 So the motion for joining the required party, as  
16 Rule 19 puts it, rather than indispensable party, is denied.

17 The motion to dismiss is granted.

18 Thank you very much.

19 MS. TUFARIELLO: And, your Honor, just to be clear, I  
20 understand it is being dismissed without prejudice?

21 THE COURT: That's correct.

22 MS. TUFARIELLO: Thank you, your Honor.

23 THE COURT: You can bring it again.

24 MS. TUFARIELLO: Thank you.

25 THE COURT: But don't ask me to be the judge.

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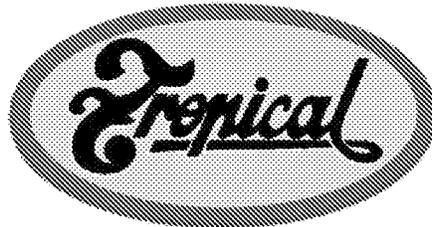
1 MS. TUFARIELLO: Thank you, your Honor.  
2 MR. SCHINDLER: Thank you, your Honor.  
3 THE COURT: And I suspect that if you bring it again,  
4 it won't hang around for very long because it doesn't seem to  
5 me that there's an enforceable trademark here.  
6 Thank you.  
7 (Adjourned)  
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# **EXHIBIT 2**

# United States of America

United States Patent and Trademark Office



**Reg. No. 3,949,746**

**Registered Apr. 26, 2011**

**Int. Cl.: 32**

**TRADEMARK**

**PRINCIPAL REGISTER**

BALORU S.A. (ECUADOR SOCIEDAD ANONIMA (SA))  
KM. 16 1/2, VIA DAULE  
GUAYAQUIL, ECUADOR

FOR: SOFT DRINKS; SYRUPS FOR MAKING SOFT DRINKS, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

OWNER OF ECUADOR REG. NO. 183-66, DATED 4-19-1966, RENEWED AS REG. NO. 2446, DATED 3-20-2009, EXPIRES 5-13-2020.

THE COLOR(S) BLACK, YELLOW AND RED IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE WORD "TROPICAL" IN BLACK INSIDE A YELLOW OVAL WITH A RED BORDER.

SER. NO. 77-805,079, FILED 8-14-2009.

JAY BESCH, EXAMINING ATTORNEY



*David J. Kyros*

Director of the United States Patent and Trademark Office

**EXHIBIT 3**

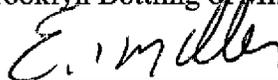


5. "Brooklyn Bottling" was assigned ownership in the TROPICAL PURO SABOR NACIONAL mark from Royal Signature, Inc., a Panamanian corporation on February 11, 2008.
6. Brooklyn Bottling believes that the Defendant Ecuabeverage ("Defendant") is infringing Brooklyn Bottling's rights in and to its registered trademark and trade dress by marketing a product that is causing confusion among consumers.
7. Brooklyn Bottling and Defendant are direct competitors in the soft drink industry, and specifically in the east coast markets comprised of individuals of Ecuadorian descent.
8. Brooklyn Bottling is not claiming that Defendant cannot use the term "tropical" to market its product.
9. However, Brooklyn Bottling does have a problem with Defendant's use of the term "tropical" in such a way as to confuse and deceive consumers about the source of Brooklyn Bottling's product and Defendant's product.
10. Defendant has, in many ways, duplicated or approximated elements of Brooklyn Bottling's trademark and trade dress.
11. Defendant is using the same primary colors on its labeling (red, blue, and yellow) as Brooklyn Bottling, and which are also the colors of the Ecuadorian flag.
12. Defendant has copied numerous design elements from Brooklyn Bottling including the use of blue script font for the word "Tropical," and setting that word on a yellow background.
13. Brooklyn Bottling uses the phrase "Puro Sabor Nacional" which means "Pure National

Flavor” in English while the Defendant uses the phrase “Puro Sabor Ecuatoriano” which means “Pure Ecuadorian Flavor.”

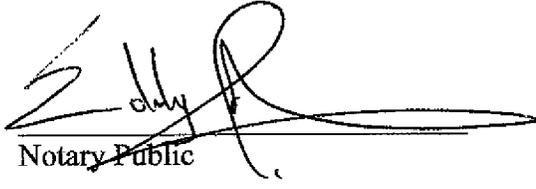
14. There is no difference between these two phrases because the consumers being targeted by the parties’ products are generally Ecuadorian.
15. Although Brooklyn Bottling’s mark does not contain references to Ecuador, our packaging does indicate that it has “flavor” from Ecuador
16. Frequently, our products are sold in the same stores and sit next to each other on the same shelves.
17. Brooklyn Bottling’s biggest concern is that Defendant uses the term “Tropical” on its products in the same manner that Brooklyn Bottling uses the term “Tropical” on its products.
18. As a result of Defendant’s practices, consumers have been confused as to which product is the original beverage which has caused Brooklyn Bottling damage.
19. Accordingly, I respectfully ask that this Court grant Brooklyn Bottling’s instant motion for partial summary judgement on all of Brooklyn Bottling’s claims.

Brooklyn Bottling of Milton, New York, Inc.



Eric Miller, President

Sworn to before me  
this 11<sup>th</sup> day of December, 2009

  
Notary Public



millar.afd support motion sj.121109

**EXHIBIT 4**

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 76/666940

**APPLICANT:** Brooklyn Bottling of Milton, NY, Inc.

**\*76666940\***

**CORRESPONDENT ADDRESS:**

JEFFREY E. JACOBSON  
JACOBSON & COLFIN, P.C.  
60 MADISON AVE STE 1026  
NEW YORK, NY 10010-1666

**RETURN ADDRESS:**

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

**MARK:** TROPICAL FANTASY TF EXTREME ENERGY DRINK

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

Please provide in all correspondence:

**CORRESPONDENT EMAIL ADDRESS:**

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**OFFICE ACTION**

**RESPONSE TIME LIMIT:** TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

**MAILING/E-MAILING DATE INFORMATION:** If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.

Serial Number 76/666940

The assigned examining attorney has reviewed the referenced application and determined the following.

**IDENTIFICATION OF GOODS**

The identification of goods is unacceptable as indefinite. The underlined goods are acceptable as filed. The remaining goods require further amendment as noted.

The applicant may adopt the following identification, if accurate: “Energy drinks, soft drinks, fruit juice cocktails, fruit juices and bottled water,” in Class 32. TMEP §1402.01.

Please note that, while an application may be amended to clarify or limit the identification, additions to the

identification are not permitted. 37 C.F.R. §2.71(a); TMEP §1402.06. Therefore, the applicant may not amend to include any goods that are not within the scope of goods set forth in the present identification.

### **STANDARD CHARACTER STATEMENT**

Applicant must submit the following standard character claim: “The mark consists of standard characters without claim to any particular font, style, size, or color.” 37 C.F.R. §2.52(a); TMEP §807.03(a).

### **DISCLAIMER**

The applicant must insert a disclaimer of TROPICAL and ENERGY DRINK in the application. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.08(a)(i).

A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use TROPICAL and ENERGY DRINK apart from the mark as shown.

TROPICAL is commonly used to describe beverage flavor. (See attached material from the Internet). Applicant identifies “energy drinks” in its identification of goods. Its specimen of record demonstrates that the mark is used on tropical flavored energy drinks. Therefore, the terms are descriptive and must be disclaimed.

Printouts of articles downloaded from the Internet are admissible as evidence of information available to the general public, and of the way in which a term is being used by the public. TMEP §710.01(b). *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1475-76 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370-1 (TTAB 1998).

The Office can require an applicant to disclaim an unregistrable part of a mark consisting of particular wording, symbols, numbers, design elements or combinations thereof. 15 U.S.C. §1056(a). Under Section 2(e) of the Trademark Act, the Office can refuse registration of an entire mark if the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. 15 U.S.C. §1052(e). Thus, the Office may require an applicant to disclaim a portion of a mark that, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a).

Failure to comply with a disclaimer requirement can result in a refusal to register the entire mark. TMEP §1213.01(b).

A “disclaimer” is a statement that applicant does not claim exclusive rights to an unregistrable component of a mark. A disclaimer does not affect the appearance of the applied-for mark.

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02.

/Kathleen M. Vanston/  
Examining Attorney  
Law Office 103  
(571) 272-9235

**HOW TO RESPOND TO THIS OFFICE ACTION:**

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the *date of receipt in the Office*, not the postmarked date.** To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

**STATUS OF APPLICATION:** To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

**VIEW APPLICATION DOCUMENTS ONLINE:** Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

**GENERAL TRADEMARK INFORMATION:** For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

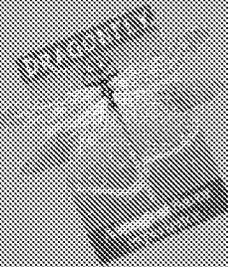
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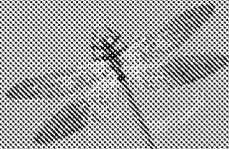
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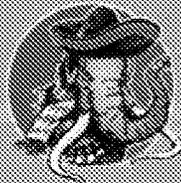
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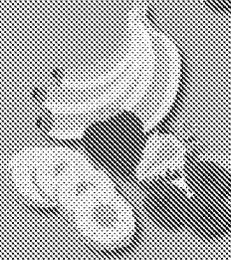
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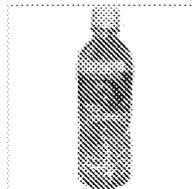
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Brand Name: Five 02 - Fire Mountain Beverage Company

Payment Remarks: Based on Agreement Terms

Supply Ability: Based on Order Quantity

Minimum Order: Based on Delivery Agreement

Delivery Lead Time: Based on Delivery Location

Inner Packing: 24 = 1 Case, 72 Cases per Pallet

Certification(s): Premium Brand

#### Detailed Product Description

Flavored infused vitamin enriched with oxygen!

Oxygenated, vitamin-flavored tropical water. Is a great tasting, zero-sugar, zero

Oxygenated, vitamin-flavored tropical water is a great tasting, zero-sugar, zero carbohydrates, zero-caffeine, zero-calorie, non-carbonated, purified, flavored-water beverage infused with vitamins a, c, b-6, and b-12 coupled with niacin, potassium calcium and iron.

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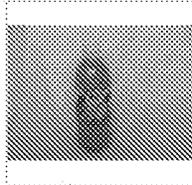
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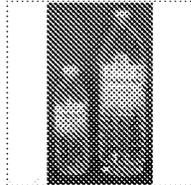
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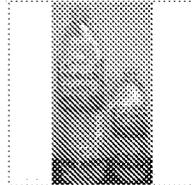
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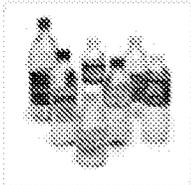
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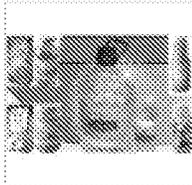
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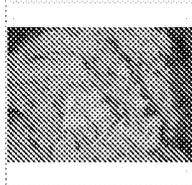
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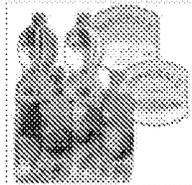
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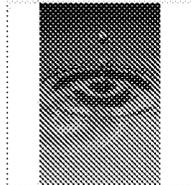
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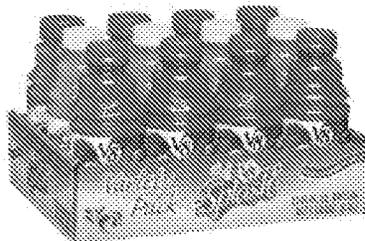
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Variety Pack includes: 4 Tropical Blend - a **tropical flavored** beverage of 5 juices and mango puree, from concentrate; 4 Strawberry Kiwi - a strawberry and kiwi flavored beverage of 4 juices from concentrate, with other natural flavors; and 4 Berry Blend - a berry flavored beverage of 6 juices from concentrate with other natural flavors.

**EXHIBIT 5**

**Int. Cl.: 32**

**Prior U.S. Cl.: 45**

**United States Patent and Trademark Office**

**Reg. No. 1,899,104**

**Registered June 13, 1995**

**TRADEMARK  
PRINCIPAL REGISTER**

**TROPICAL FANTASY**

**BROOKLYN BOTTLING CORPORATION (NEW  
YORK CORPORATION)  
458 COZINE AVENUE  
BROOKLYN, NY 11208**

**NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "TROPICAL", APART FROM  
THE MARK AS SHOWN.**

**FOR: SOFT DRINKS, IN CLASS 32 (U.S. CL.  
45).**

**SER. NO. 74-104,891, FILED 10-11-1990.**

**FIRST USE 4-0-1988; IN COMMERCE  
4-0-1988.**

**PATRICIA MALESARDI, EXAMINING ATTOR-  
NEY**

**EXHIBIT 6**

**Int. Cl.: 32**

**Prior U.S. Cls.: 45, 46 and 48**

**Reg. No. 3,284,223**

**United States Patent and Trademark Office**

**Registered Aug. 28, 2007**

**TRADEMARK  
PRINCIPAL REGISTER**

**Tropical Fantasy TF Extreme Energy Drink**

BROOKLYN BOTTLING OF MILTON, NY, INC.  
(NEW YORK CORPORATION)

C/O JACOBSON & COLFIN, P.C.

60 MADISON AVE., SUITE 1026

NEW YORK, NY 10010

FOR: ENERGY DRINKS, SOFT DRINKS, FRUIT  
JUICE COCKTAILS, FRUIT JUICES, VEGETABLE  
JUICE COCKTAILS, VEGETABLE JUICES AND  
BOTTLED WATER, IN CLASS 32 (U.S. CLS. 45, 46  
AND 48).

FIRST USE 7-0-2006; IN COMMERCE 7-0-2006.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,899,104 AND  
2,844,369.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE TROPICAL AND ENERGY DRINK,  
APART FROM THE MARK AS SHOWN.

SER. NO. 76-666,940, FILED 10-3-2006.

KATHLEEN M. VANSTON, EXAMINING ATTOR-  
NEY

**EXHIBIT 7**

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

-----X

BROOKLYN BOTTLING OF MILTON,  
NEW YORK, INC.,

Plaintiff,

:  
: 07 CIV 08483 (AKH)  
:

-against-

: AFFIRMATION IN OPPOSITION  
: TO DEFENDANT’S MOTION FOR  
: PARTIAL SUMMARY JUDGEMENT

ECUABEVERAGE, CORP.

Defendant.

-----X

STATE OF NEW YORK )  
)ss:  
COUNTY OF NEW YORK )

JEFFREY E. JACOBSON, a member of the Bar of the State of New York and this Court,  
deposes and swears under the penalty of perjury that:

1. I am Counsel for Brooklyn Bottling Company of Milton, New York, Inc., (“Brooklyn Bottling”) as well as North Shore Bottling Co., Inc. (“North Shore”).
2. I am fully familiar with the facts of this matter and I respectfully submit this Affirmation in Opposition to Defendant Ecuabeverage’s Motion for Partial Summary Judgement on the First, Second and Sixth Causes of Action in the Amended Complaint.
3. Defendant’s Motion for Partial Summary Judgement is with specific regard only to the federal trademark registered with the United States Patent and Trademark Office (“USPTO”) for TROPICAL PURO SABOR NACIONAL, (“the MARK”), in class 032 for soft drinks and flavored syrups used in the preparation of making soft drinks. The MARK was originally registered on January 26, 1988, given registration number 1474395; and was

subsequently assigned to Plaintiff.

4. Defendant's Statement of Material Facts in Support of its motion for partial summary with its litany of disclaimers, waivers, and amendments pursuant to requirements of the U.S. Patent and Trademark Office would have the Court divert its attention from one significant material fact in each instance, that although the Plaintiff may have disclaimed, or waived, the exclusive right to use a specific word as a requirement by the U.S. P. & T. O. to grant registration, such was typically for use of that specific word or two, APART FROM THE MARK AS SHOWN.

5. Those waivers, amendments and requirements do not affect the fact that the Plaintiff's Trademark, in total, was registered, and granted all the rights accorded to a registered trademark. The Trademark was ultimately deemed incontestible by the filing of proper paperwork fourteen years ago in 1994.

6. The U.S. Patent & Trademark Office grants an exclusive right to use a particular mark in the context of the whole mark. Please refer to Plaintiff's Memorandum section entitled "A TRADEMARK IS VIEWED IN ITS TOTALITY, NOT IN ITS PARTS."

7. Plaintiff does not claim an exclusive right to any single word comprising a part of its registered trademark.

8. Plaintiff does claim that Defendant's use of marks, including in some instances just one word separate from others, are used in such a fashion as to be likely to cause confusion in the marketplace.

9. The question then remains for a trier of facts to determine, is whether Defendant's use of its own marks and designs in commerce, for similar goods, is likely to cause confusion, or

does cause confusion, with Plaintiff's valid, registered, and incontestable mark.

10. That question, is not a matter of law.

11. There are no depositions, answers to interrogatories or admissions on file. Whether or not such other factual issues exist has yet to be determined through testimony or production of documents. There are numerous factual issues that need to be determined.

12. Plaintiff believes and contends that it is much too early in the prosecution of this matter to entertain, let alone grant, a motion for even partial summary judgement.

13. Defendant has not raised any defenses to Plaintiff's allegations, but only argues that the TROPICAL PURO SABOR NACIONAL mark does not warrant trademark protection, despite the fact that the mark is a trademark registered by the United States Patent and Trademark Office, and was subsequently determined to be incontestible as of May 23, 1994.

14. Defendant's attack on the separate elements of the mark are without merit. The Trademark Office has recognized and registered the TROPICAL PURO SABOR NACIONAL mark in its entirety and not in its solitary elements.

15. Before the mark could even be registered, the applicant had to use the mark in trade in association with the goods themselves, submit a valid trademark application, satisfy any objections raised by the examining attorney to that application and the use of the mark and only then could the mark be published for opposition purposes.

16. The mark is subsequently published for opposition so that anyone who does not think the mark should be granted trademark registration can object to the registration of the mark. Only after the mark has been published for opposition purposes and is unopposed can it actually be registered.

17. However, even the Defendant's own motion raises issues of material fact that have not been determined prior to the instant motion for partial summary judgment.

18. The Trademark Office answers the question "What is a trademark?" with the following response: A trademark includes any word, name, symbol, or device, or any combination, used, or intended to be used, in commerce to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others, and to indicate the source of the goods. In short, a trademark is a brand name.

19. According to the Trademark Office, the mark is used to identify and distinguish the goods of one manufacturer or seller from goods manufactured or sold by others.

20. By a quick visual comparison of the Defendant's label and the Plaintiff's label for tropical flavored sodas, it appears that the Defendant has intentionally chosen a label design and a brand name that makes it difficult for consumers to identify and distinguish the Plaintiff's goods from the Defendant's goods. This appears to be an intentional and calculated act.

21. Whether the Defendant has chosen a label (trade dress) and brand (trademark) which intentionally causes confusion among consumers is a question of fact that has yet to be determined.

22. Whether the Defendant has chosen a label and brand name which incidentally causes confusion among consumers is a question of fact which has yet to be determined. It is Plaintiff's position, as seen in the accompanying affidavit of Eric Miller, that confusion between the Plaintiff's brand and the Defendant's brand is the aim of the Defendant's use of its coloration and placement of their mark.

23. Despite Defendant's motive in choosing their label and brand, the ultimate question

of fact is whether consumers will be confused by the similarity of Defendant's label and brand to the Plaintiff's label and brand.

24. Despite the Defendant's attempt to discredit the Plaintiff's trademark, the fact remains, and the Defendant's acknowledge, that Plaintiff is the registered owner (the exclusive assignee) of the TROPICAL PURO SABOR NACIONAL mark. (Please refer to paragraph 1 of Defendant's Statement of Material Facts.)

25. The fact also remains that the United States Patent and Trademark Office has duly examined the application for this mark, determined that it should be recognized as a valid trademark, issued a registration certificate for the mark and consequently accorded it all the rights and protections of a validly registered trademark.

26. Defendants analysis of the mark and its application is irrelevant. The mark has been in use in commerce in the United States since at least as early as 1988. Whatever shortcoming the mark may have had, and the Plaintiff does not concede that the mark had any, and are now irrelevant due to the mark's continuous use in commerce.

27. Just by being used continuously in the marketplace for such a long period of time, the registered owners of the TROPICAL PURO SABOR NACIONAL mark have strengthened the mark and continuously created good will in association with its Trademark.

28. Neither the Trademark Office nor the consumers look at the single elements of the mark; they look at the mark as a whole.

29. The mark is TROPICAL PURO SABOR NACIONAL. The mark is not TROPICAL + PURO + SABOR + NACIONAL.

30. Even the Trademark Office recognized that the totality of the mark, when it required



**CERTIFICATE OF SERVICE**

I, EDWIN D. SCHINDLER, hereby certify that I served a true, and complete, copy of Ecuabeverage Corporation's *Petition for Cancellation* (including Exhibits 1 – 7) directly upon Respondent Baloru S.A., via Air Mail, and upon the following counsel via First-Class Mail, postage pre-paid:

BALORU S.A.  
Km. 16 1/2, Via Daule  
Guayaquil,  
ECUADOR

Thomas M. Wilentz  
75 South Broadway, 4<sup>th</sup> Floor  
White Plains, New York 10601

Panagiota Betty Turfariello  
INTELLECTULAW – LAW OFFICES OF  
P. B. TURFARIELLO, P.C.  
25 Little Harbor Road  
Mount Sinai, New York 11767

on April 16, 2012.



Edwin D. Schindler  
*Attorney for Petitioner*  
Reg. No. 31,459