

ESTTA Tracking number: **ESTTA480755**

Filing date: **06/28/2012**

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	Edmund Papczun		
Entity	Individual	Citizenship	UNITED STATES
Address	2910 N. Powers Street #316 Colorado Springs, CO 80922 UNITED STATES		

Attorney information	Alain Villeneuve Vedder Price PC 222 North LaSalle Street Chicago, IL 60601 UNITED STATES avilleneuve@vedderprice.com Phone:3126097745		
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Registration Subject to Cancellation

Registration No	3924415	Registration date	03/01/2011
International Registration No.	NONE	International Registration Date	NONE
Registrant	I-D Foods Corporation 1800 Autoroute Laval Laval, H7S2E7 CANADA		

Goods/Services Subject to Cancellation

Class 033. All goods and services in the class are cancelled, namely: Alcoholic beverages, namely, scotch
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Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	2782282	Application Date	05/01/2000
Registration Date	11/11/2003	Foreign Priority Date	NONE
Word Mark	ALISTER MACKENZIE		

Design Mark	ALISTER MACKENZIE
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2003/07/29 First Use In Commerce: 2003/07/29 Leather desk accessories, namely, leather calendar holders, leather desk file trays, leather desk pads, leather desk top organizers, and leather desk top planners Class 018. First use: First Use: 2003/07/29 First Use In Commerce: 2003/07/29 Luggage and leather goods, namely, luggage and luggage straps, and suitcases; tote bags, travel bags, brief cases, attache cases, valises, and portfolios; business card wallets and luggage tags

U.S. Registration No.	4135892	Application Date	12/10/2009
Registration Date	05/01/2012	Foreign Priority Date	NONE
Word Mark	ALISTER MACKENZIE		
Design Mark	ALISTER MACKENZIE		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2011/01/01 First Use In Commerce: 2011/01/01 golf equipment, namely, golf clubs		

U.S. Application No.	85306515	Application Date	04/27/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ALISTER MACKENZIE		
Design Mark			

Description of Mark	The mark consists of a slanted tree crossed at the base by the name "Alister Mackenzie".
Goods/Services	Class 016. First use: Leather desk accessories, namely, leather calendar holders, leather desk file trays, leather desk pads, leather desk top organizers, and leather desk top planners Class 018. First use: Luggage and leather goods, namely, luggage and luggage straps, and suitcases; tote bags, travel bags, brief cases, attaché cases, valises, and briefcase-type portfolios; business card wallets and luggage tags Class 025. First use: pants, trousers, slacks, shorts, belts, socks, footwear, shoes, shirts, sweaters, coats, jackets, pullovers, vests, neckwear, ties, gloves, caps, hats, headwear, and outerwear, namely, jackets, windcheaters and pullovers Class 028. First use: golf equipment, namely, golf clubs

U.S. Registration No.	3174410	Application Date	07/05/2001
Registration Date	11/21/2006	Foreign Priority Date	NONE
Word Mark	ALISTER MACKENZIE		
Design Mark	ALISTER MACKENZIE		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2006/07/01 First Use In Commerce: 2006/07/01 Pants, trousers, slacks, shorts, belts, socks, footwear, shoes, shirts, sweaters, coats, jackets, pullovers, vests, neckwear, ties, gloves, caps, hats, headwear, and outerwear, namely jackets, windbreakers and pullovers		

Attachments	76039271#TMSN.gif (1 page)(bytes) 77890712#TMSN.jpeg (1 page)(bytes) 85306515#TMSN.jpeg (1 page)(bytes) 76280515#TMSN.gif (1 page)(bytes) 41434-00-0010_Petition_for_Cancellation.pdf (33 pages)(363234 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	/Alain Villeneuve/
Name	Alain Villeneuve
Date	06/28/2012

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

PAPCZUM, EDMUND.,

Petitioner,

v.

I-D FOODS CORPORATION a Canadian
Corporation,

Registrant.

Cancellation No.

Registration No. 3,924,415

Mark: HOUSE OF ALISTER MACKENZIE

PETITION FOR CANCELLATION

Petitioner, Papczun Edmund, is a private Individual having a place of residence at 2910 N. Powers Street #316, Colorado Springs, CO 80922 (“Petitioner”). Registrant, I-D Foods Corporation, is a Canadian Corporation doing business at 1800 Autoroute Laval, Laval, Canada H7S 2E7, Quebec, Canada (“Registrant”) and is the current owner of U.S. Trademark Registration No. 3,924,415 for the mark HOUSE OF ALISTER MACKENZIE, registered on March 1, 2011.

Petitioner alleges:

1. Petitioner owns U.S. Reg. 2,782,282 for the mark ALISTER MACKENZIE® for leather desk accessories in International Class 016, and for luggage and leather goods in International Class 018. This mark was filed in 2000, registered on the Principal Register on 11/11/2033 and is in full force. This mark became incontestable under the Trademark Act, 15 U.S.C. § 1058 and 1065 on April 29, 2010. See Certificate of Registration attached as Exhibit A.

2. Petitioner also owns U.S. Reg. 3,174,410 for the mark ALISTER MACKENZIE® for several apparels in International Class 025. This mark was filed in 2001, and registered on the Principal Register on 11/21/2006. See Certificate of Registration attached as Exhibit B.

3. Petitioner has openly and continuously sold, promoted, and marketed a wide range of goods under its mark ALISTER MACKENZIE® over the years in commerce. For example, Petitioner owns the domain www.alistermackenzie.com and a copy of the current main page of this site is reproduced below:



Use of the ALISTER MACKENZIE Mark

4. In addition to the ownership of these two U.S. Registrations, Petitioner owns U.S. Registration No. 4,135,892 also for ALISTER MACKENZIE for golf equipment, and U.S. Serial No. 85/306,515 for ALISTER MACKENZIE & Design in International Classes 016, 018, and 025. See TARR Reports as Exhibit C. Further, Petitioner owns, common law rights in ALISTER MACKENZIE™ for a wide range of other goods and services.

5. Petitioner's date of priority is May 1, 2000. Petitioner's mark has not been abandoned, and the use made by Petitioner is nationwide, including for example over the internet, and via other trade channels.

6. By virtue of such continuous and exclusive use, Petitioner's mark ALISTER MACKENZIE® has acquired great value as an identifier of Petitioner's goods. Further,

Petitioner's mark ALISTER MACKENZIE® has accumulated goodwill through advertising, promotion, and continued use in commerce. When customers refer to the ALISTER MACKENZIE, they refer to Petitioner's goods.

7. On March 19, 2007, Registrant applied for the mark HOUSE OF ALISTER MACKENZIE for alcoholic beverages, namely scotch in International Class 033. As part of the prosecution of Registrant's mark, both of Petitioner's marks was cited under Section 2(d) a likely to confuse the marketplace. (7/11/2007 Office Action, and 11/14/2007 Office Action as Exhibit D). The Examiner never lifted the 2(d) rejection, and upon information and belief, U.S. Reg. 3,924,415 issued by mistake.

8. At the earliest, Registrant may claim a date of priority based on a Canadian Registration of February 26, 2007, more than half a decade after Applicant's earliest priority with the Office. (See HOUSE OF ALISTER MACKENZIE Certificate of Registration as Exhibit E).

9. Petitioner as owner of the mark ALISTER MACKENZIE® is damaged by the existing registration of the mark HOUSE OF ALISTER MACKENZIE since these marks, as explained by the Prosecuting Examining Attorney are confusingly similar, and the goods are related in association with this mark. As shown above, Petitioner currently has the mark on scotch glasses. Petitioner has standing to cancel under 15 U.S.C. § 1064.

10. Petitioner filed for other ALISTER MACKENZIE marks with this Office and these marks may face interference problems during the registration process based on the existence on the registry of Registrant's mark. Therefore, standing to file this petition to cancel is also granted to owners of confusingly similar marks based on a 15 U.S.C. § 1052(d). TBMP

§ 309.03(b) citing *Cerveceria Modelo S.A. de C.V. v. R.B. Marco*, 55 USPQ2d 1298, 1300 (TTAB 2000).

COUNT I—LIKELIHOOD OF CONFUSION

11. Petitioner adopts, restates, and realleges each and every allegation previously set forth in this Petition under paras. 1–10 as if fully set forth in this para. 11.

12. The marks ALISTER MACKENZIE® and HOUSE OF ALISTER MACKENZIE are similar in appearance as Registrant’s mark fully incorporates Petitioner’s mark with the addition of a term at the beginning of the mark. In the mark HOUSE OF ALISTER MACKENZIE, the portion ALISTER MACKENZIE is dominant as the term highly distinctive and unique in association with a persona and Petitioner.

13. Petitioner’s goods are luxury goods sold in association with the persona ALISTER MACKENZIE, a persona that is associated with medicine, golf, the British Isles, and scotch. These goods are closely related and the sale of both of these goods under the ALISTER MACKENZIE brand will result in confusion in the marketplace as to the source of origin for these goods.

14. The marks are similar in appearance, the goods are highly related and travel in similar channels of trade, sold to similar clients and therefore confusion between these mark is obvious.

15. U.S. Registration No. 3,924,415 has no date of first use in commence and only claims a priority under Section 44(D) of 2/26/2007. This registration was registered on March 1, 2011. The mark has not yet acquired incontestable status and can be challenged on the basis of likelihood of confusion. 15 U.S.C. § 1064(1).

16. Petitioner’s priority date is May 1, 2000, a date that predates Registrant’s claimed priority date, and therefore Petitioner is a senior user of the mark ALISTER MACKENZIE® for

these goods or any related goods. Therefore, Petitioner has priority of use for the mark for the purpose of this Cancellation and has seniority of use. TBMP § 309.03(c).

17. Petitioner is damaged by the mark HOUSE OF ALISTER MACKENZIE.

18. As senior and continuous user in commerce of the mark ALISTER MACKENZIE®, Petitioner is entitled to cancel the mark HOUSE OF ALISTER MACKENZIE.

WHEREFORE, Petitioner prays for Count I that Registration No. 3,924,415 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

COUNT II—ABANDONMENT

19. Petitioner adopts, restates, and realleges each and every allegation previously set forth in this Petition under paras. 1–18 as if fully set forth in this para. 19.

20. Petitioner, after a reasonable investigation is unable to find any use of the mark in commerce. Therefore, upon information and belief, the mark HOUSE OF ALISTER MACKENZIE is not in use in the United States and must therefore be cancelled from the principal register.

WHEREFORE, Petitioner prays for Count II that Registration No. 3,924,415 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

COUNT III— FALSE ASSOCIATION 2(A)

21. Petitioner adopts, restates, and realleges each and every allegation previously set forth in this Petition under paras. 1–20 as if fully set forth in this para. 21.

22. Registrant's mark and Petitioner's mark both include the same expression ALISTER MACKENZIE a name/identity a persona in which Petitioner has acquired all rights. Petitioner is not connected with the activities performed by Registrant, and the name Alister Mackenzie has sufficient fame or reputation when this name or persona is used on scotch, to create a false association or connection with Petitioner in violation of Section 2(a).

WHEREFORE, Petitioner prays that Count III for cancellation be entered and the mark HOUSE OF ALISTER MACKENZIE be cancelled from the registry, and that this petition for cancellation be sustained in favor of Petitioner.

Respectfully submitted,

PRESTON INDUSTRIES, INC.

Dated: June 28, 2012

By: Alain Villeneuve
Alain Villeneuve
Attorney for Petitioner

Vedder Price P.C.
222 N. LaSalle St., Suite 2600
Chicago, Illinois 60601
(312) 609-7745

CERTIFICATE OF SERVICE

I hereby certify that on the 28th day of June 2012, I served a true and correct copy of the foregoing **PETITION FOR CANCELLATION** on the attorney for the Petitioner at the address indicated below by depositing said document in the United States mail, first class postage prepaid:

George W. Lewis
Jacobson Holman PLLC
400 7th Street NW, Suite 600
Washington, DC 20004-2218
(202) 393-5350
bwheelock@hdp.com

/Alain Villeneuve/
Attorney for Applicant

EXHIBIT A

Int. Cls.: 16 and 18

Prior U.S. Cls.: 1, 2, 3, 5, 22, 23, 29, 37, 38, 41, and 50

Reg. No. 2,782,282

United States Patent and Trademark Office

Registered Nov. 11, 2003

**TRADEMARK
PRINCIPAL REGISTER**

ALISTER MACKENZIE

GOLF LINKS TO THE PAST (ILLINOIS CORPORATION)
636 WEST DIVERSEY PARKWAY, NO. 110
CHICAGO, IL 60614

FOR: LEATHER DESK ACCESSORIES, NAMELY, LEATHER CALENDAR HOLDERS, LEATHER DESK FILE TRAYS, LEATHER DESK PADS, LEATHER DESK TOP ORGANIZERS, AND LEATHER DESK TOP PLANNERS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 7-29-2003; IN COMMERCE 7-29-2003.

FOR: LUGGAGE AND LEATHER GOODS, NAMELY, LUGGAGE AND LUGGAGE STRAPS, AND SUITCASES; TOTE BAGS, TRAVEL BAGS,

BRIEF CASES, ATTACHE CASES, VALISES, AND PORTFOLIOS; BUSINESS CARD WALLETS AND LUGGAGE TAGS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 7-29-2003; IN COMMERCE 7-29-2003.

THE NAME "ALISTER MACKENZIE" DOES NOT IDENTIFY A LIVING INDIVIDUAL, BUT IS THE NAME OF A HISTORICAL PERSON WHO HAS LONG BEEN DECEASED.

SN 76-039,271, FILED 5-1-2000.

SUSAN HAYASH, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 3,174,410

Registered Nov. 21, 2006

**TRADEMARK
PRINCIPAL REGISTER**

ALISTER MACKENZIE

GOLF LINKS TO THE PAST (ILLINOIS CORPORATION)
636 WEST DIVERSEY PARKWAY, NO. 110
CHICAGO, IL 60614

FOR: PANTS, TROUSERS, SLACKS, SHORTS, BELTS, SOCKS, FOOTWEAR, SHOES, SHIRTS, SWEATERS, COATS, JACKETS, PULLOVERS, VESTS, NECKWEAR, TIES, GLOVES, CAPS, HATS, HEADWEAR, AND OUTERWEAR, NAMELY JACKETS, WINDBREAKERS AND PULLOVERS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 7-1-2006; IN COMMERCE 7-1-2006.

THE NAME "ALISTER MACKENZIE" DOES NOT IDENTIFY A LIVING INDIVIDUAL.

SN 76-280,515, FILED 7-5-2001.

JASON TURNER, EXAMINING ATTORNEY

EXHIBIT C

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

This page was generated by the TARR system on 2012-06-28 16:03:04 ET

Serial Number: 77890712 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 4135892

Mark

ALISTER MACKENZIE

(words only): [ALISTER MACKENZIE](#)

Standard Character claim: [Yes](#)

Current Status: [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: [2012-05-01](#)

Filing Date: [2009-12-10](#)

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

Registration Date: [2012-05-01](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 107](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2012-03-26](#)

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

1. [Papczun, Edmund](#)

Address:

Papczun, Edmund
2910 N. Powers St. #316
Colorado Springs, CO 80922
United States
Legal Entity Type: Individual
Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 028
Class Status: Active
golf equipment, namely, golf clubs
Basis: 1(a)
First Use Date: 2011-01-01
First Use in Commerce Date: 2011-01-01

ADDITIONAL INFORMATION

Name Portrait Consent: "ALISTER MACKENZIE" does not identify a living individual.

Prior Registration Number(s):
2782282
3174410

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.

2012-05-01 - Registered - Principal Register
2012-03-27 - Notice Of Acceptance Of Statement Of Use E-Mailed
2012-03-26 - Law Office Registration Review Completed
2012-03-24 - Allowed for Registration - Principal Register (SOU accepted)
2012-03-09 - Statement Of Use Processing Complete
2012-02-08 - Use Amendment Filed
2012-03-02 - Case Assigned To Intent To Use Paralegal

2012-02-08 - TEAS Statement of Use Received

2011-08-10 - Notice Of Approval Of Extension Request E-Mailed

2011-08-08 - Extension 1 granted

2011-08-08 - Extension 1 filed

2011-08-08 - TEAS Extension Received

2011-02-08 - NOA E-Mailed - SOU Required From Applicant

2010-12-14 - Official Gazette Publication Confirmation E-Mailed

2010-12-14 - Published for opposition

2010-11-09 - Law Office Publication Review Completed

2010-11-09 - Approved For Pub - Principal Register

2010-09-23 - Teas/Email Correspondence Entered

2010-09-23 - Communication received from applicant

2010-09-23 - Assigned To LIE

2010-09-15 - TEAS Response to Office Action Received

2010-03-18 - Notification Of Non-Final Action E-Mailed

2010-03-18 - Non-final action e-mailed

2010-03-18 - Non-Final Action Written

2010-03-12 - Assigned To Examiner

2009-12-15 - New Application Office Supplied Data Entered In Tram

2009-12-14 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Alain Villeneuve

Correspondent
ALAIN VILLENEUVE
VEDDER PRICE P.C.
222 N LASALLE ST STE 2600
CHICAGO, IL 60601-1104

Phone Number: 312-609-7745

Fax Number: 312-609-5005

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

This page was generated by the TARR system on 2012-06-28 16:03:33 ET

Serial Number: 85306515 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark



(words only): [ALISTER MACKENZIE](#)

Standard Character claim: No

Current Status: [Notice of Allowance \(NOA\) sent \(issued\) to the applicant. Applicant must file a Statement of Use or Extension Request within six months of the NOA issuance date.](#)

Date of Status: [2012-06-05](#)

Filing Date: [2011-04-27](#)

The Notice of Allowance Date is: [2012-06-05](#)

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 105](#)

Attorney Assigned:
[BELL MARLENE D](#)

Current Location: [700 -Intent To Use Section](#)

Date In Location: [2012-06-05](#)

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

1. [Papczun, Edmond](#)

Address:

Papczun, Edmond
2910 N. Powers St. #316
Colorado Springs, CO 80922
United States

Legal Entity Type: Individual**Country of Citizenship:** United States

GOODS AND/OR SERVICES

International Class: 016**Class Status:** Active

Leather desk accessories, namely, leather calendar holders, leather desk file trays, leather desk pads, leather desk top organizers, and leather desk top planners

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 018**Class Status:** Active

Luggage and leather goods, namely, luggage and luggage straps, and suitcases; tote bags, travel bags, brief cases, attaché cases, valises, and briefcase-type portfolios; business card wallets and luggage tags

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 025**Class Status:** Active

pants, trousers, slacks, shorts, belts, socks, footwear, shoes, shirts, sweaters, coats, jackets, pullovers, vests, neckwear, ties, gloves, caps, hats, headwear, and outerwear, namely, jackets, windcheaters and pullovers

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)**International Class:** 028**Class Status:** Active

golf equipment, namely, golf clubs

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.**Description of Mark:** The mark consists of a slanted tree crossed at the base by the name "Alister Mackenzie".**Name Portrait Consent:** The name "ALISTER MACKENZIE" does not identify a living individual.

Design Search Code(s):

05.01.02 - Maple tree; Trees or bushes with a generally rounded shape, including deciduous trees

Prior Registration Number(s):

3174410

3428587

3428588

MADRID PROTOCOL INFORMATION

USPTO Reference Number: [A0024373](#)

International Registration Number: [1080689](#)

International Registration Date: [2011-04-27](#)

Original Filing Date with USPTO: [2011-04-27](#)

International Registration Status: [Application For IR Registered By IB](#)

Date of International Registration Status: [2011-07-07](#)

International Registration Renewal Date: [2021-04-27](#)

Irregularity Reply by Date: (DATE NOT AVAILABLE)

Madrid History:

[07-09-2011 - 12:02:36 - Application For IR Registered By IB](#)

[05-02-2011 - 20:06:04 - IR Certified And Sent To IB](#)

[05-02-2011 - 17:09:08 - Manually Certified](#)

[04-30-2011 - 18:46:40 - New Application For IR Received](#)

PROSECUTION HISTORY

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

[2012-06-05 - NOA E-Mailed - SOU Required From Applicant](#)

[2012-04-10 - Official Gazette Publication Confirmation E-Mailed](#)

[2012-04-10 - Published for opposition](#)

[2012-03-21 - Notification Of Notice Of Publication E-Mailed](#)

[2012-03-07 - Law Office Publication Review Completed](#)

[2012-03-07 - Assigned To LIE](#)

[2012-02-17 - Approved For Pub - Principal Register](#)

[2012-02-08 - Teas/Email Correspondence Entered](#)

[2012-02-07 - Communication received from applicant](#)

2012-02-07 - TEAS Response to Office Action Received
2011-10-19 - Notification Of Non-Final Action E-Mailed
2011-10-19 - NON-FINAL ACTION E-MAILED
2011-10-19 - Non-Final Action Written
2011-09-28 - Teas/Email Correspondence Entered
2011-09-28 - Communication received from applicant
2011-09-28 - TEAS Response to Office Action Received
2011-08-09 - Notification Of Examiner's Amendment/Priority Action E-Mailed
2011-08-09 - Examiner's Amendment/Priority Action E-Mailed
2011-08-09 - Examiners Amendment And/Or Priority Action - Completed
2011-08-05 - Assigned To Examiner
2011-05-03 - Notice Of Design Search Code Mailed
2011-05-02 - New Application Office Supplied Data Entered In Tram
2011-04-30 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Alain Villeneuve

Correspondent

ALAIN VILLENEUVE

VEDDER PRICE, P.C.

222 N LASALLE ST STE 2600

CHICAGO, IL 60601-1104

Phone Number: 13126097745

Fax Number: 13126095005

EXHIBIT D

To: I-D Foods Corporation (trademark@jhip.com)
Subject: TRADEMARK APPLICATION NO. 77134486 - HOUSE OF ALISTER MAC - T36390US0
Sent: 11/14/2007 12:26:42 PM
Sent As: ECOM109@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/134486

MARK: HOUSE OF ALISTER MAC

77134486

CORRESPONDENT ADDRESS:

GEORGE W. LEWIS
JACOBSON HOLMAN PLLC
400 7TH ST NW STE 600
WASHINGTON, DC 20004-2218

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: I-D Foods Corporation

CORRESPONDENT'S REFERENCE/DOCKET

NO:

T36390US0

CORRESPONDENT E-MAIL ADDRESS:

trademark@jhip.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 11/14/2007

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

A. Refusal to Register: Likelihood of Confusion

Registration of the proposed mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3174410 and 2782282. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registrations.

A likelihood of confusion determination involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours*

& Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §1207.01 *et seq.*

Similarity of the Marks

The examining attorney must look at the marks in their entireties under Section 2(d). 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 National Data Corp.*, 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 1988). TMEP §1207.01(b)(viii).

The applicant's mark THE HOUSE OF ALISTER MACKENZIE and the wording in the registered mark ALISTER MACKENZIE are similar in appearance and sound and would create the same general overall commercial impression among potential consumers. Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv).

If the marks of the respective parties are identical or highly similar, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Similarity of the Goods

The second part of the legal analysis involves comparing the goods to determine whether they are similar or related, and could cause a mistaken belief among potential purchasers that the goods come from a common source. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion as to the source of those goods. *See In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP §§1207.01 *et seq.*

If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

The applicant's goods/services, namely "Alcoholic beverages, namely, scotch" are related to registrant's goods/services, namely

Registration Number 76280515: Class 025 Pants, trousers, slacks, shorts, belts, socks, footwear, shoes, shirts, sweaters, coats, jackets, pullovers, vests, neckwear, ties, gloves, caps, hats, headwear, and outerwear, namely jackets, windbreakers and pullovers

Registration Number 76039271:

Class 018: Luggage and leather goods, namely, luggage and luggage straps, and suitcases; tote bags, travel bags, brief cases, attache cases, valises, and portfolios; business card wallets and luggage tags

Class 016: Leather desk accessories, namely, leather calendar holders, leather desk file trays, leather desk pads, leather desk top organizers, and leather desk top planners.

It is therefore quite likely that both applicant's and registrant's goods/services will travel through the same channels of trade to the same classes of purchasers. *See below*

Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely clothing, leather and alcoholic beverages, are of a kind that may emanate from a single source. *See In re Infinity Broad. Corp.*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988).

The marks are very similar. The goods/services are related. The similarities among the marks and the goods/services are so great as to create a likelihood of confusion among consumers. Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988). TMEP §§1207.01(d)(i).

B. Applications Pursuant to sections 1(b) and 44(d)

The application specifies both an intent to use basis under Trademark Act Section 1(b) and a claim of priority under Section 44(d) based on a foreign application. *See* 15 U.S.C. §§1051(b), 1126(d); 37 C.F.R. §2.34(a)(2), (a)(4). However, the application does not include a foreign registration certificate or a statement indicating whether applicant intends to rely upon the resulting foreign registration under Section 44(e) as an additional basis for registration. *See* 15 U.S.C. §1126(e).

Although Section 44(d) provides a basis for filing and a priority filing date, it does not provide a basis for publication or registration. 37 C.F.R. §2.34(a)(4)(iii); TMEP §§1002.02, 1003.03. It is unclear whether applicant intends to rely on Section 44(e) as an additional basis for registration.

Therefore, applicant must clarify the basis in the application by satisfying one of the following:

- (1) If applicant intends to rely on Section 44(e), in addition to Section 1(b), as a basis for registration, applicant must provide a written statement to that effect. In addition, (i) applicant's country of origin must either be a party to a convention or treaty relating to trademarks to which the United States is also a party, or must extend reciprocal registration rights to nationals of the United States by law; and (ii) applicant must submit a true copy, photocopy, certification or certified copy of the foreign registration from applicant's country of origin. *See* 15 U.S.C. §1126(b), (c), (e); 37 C.F.R. §2.34(a)(3)(ii); TMEP §§806.02(f), 1002.01, 1004. A copy of the foreign registration must be a copy of a document that issued to the applicant by or was certified by the intellectual property office in the applicant's country of origin. TMEP §1004.01. If the foreign registration is not written in English, then applicant must provide an English translation. 37 C.F.R. §2.34(a)(3)(ii). The translation should be signed by the translator. TMEP §1004.01(b). If the foreign registration has not yet issued, or applicant requires additional time to procure a copy of the foreign registration (and English

translation, as appropriate), applicant must respond to this Office action requesting suspension pending receipt of the foreign registration documentation. TMEP §1003.04.; or

(2) If applicant intends to rely solely on an intent to use basis under Section 1(b), while retaining its Section 44(d) priority filing date, applicant must submit a written statement that it does not intend to rely on Section 44(e) as a basis for registration and request that the mark be approved for publication based solely on the Section 1(b) basis. *See* TMEP §§806.02(f), 806.04(b), 1003.04. Although the mark may be approved for publication on the Section 1(b) basis, it will not register until an acceptable allegation of use has been filed. *See* 15 U.S.C. §1051(c)-(d); 37 C.F.R. §§2.76, 2.88; TMEP §§1103, 1104.

If, after careful review of the contents of this Office Action and of the recommended Trademark Office web site links discussed above and noted below, the applicant still has questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

/wrossman/
William M. Rossman
Trademark Examining Attorney
Law Office 109
William.Rossman@USPTO.GOV
571-272-9029

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

To: I-D Foods Corporation (trademark@jhip.com)
Subject: TRADEMARK APPLICATION NO. 77134486 - HOUSE OF ALISTER
MAC - T36390US0
Sent: 7/11/2007 4:57:47 PM
Sent As: ECOM109@USPTO.GOV

- Attachments:** [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/134486

MARK: HOUSE OF ALISTER MAC

CORRESPONDENT ADDRESS:

GEORGE W. LEWIS
JACOBSON HOLMAN PLLC
400 7TH ST NW STE 600
WASHINGTON, DC 20004-2218

77134486

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: I-D Foods Corporation

CORRESPONDENT'S REFERENCE/DOCKET

NO:

T36390US0

CORRESPONDENT E-MAIL ADDRESS:

trademark@jhip.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 7/11/2007

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

A. Refusal to Register: Likelihood of Confusion

Registration of the proposed mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 3174410 and 2782282. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registrations.

A likelihood of confusion determination involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

Similarity of the Marks

The examining attorney must look at the marks in their entireties under Section 2(d). 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 National Data Corp.*, 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 1988). TMEP §1207.01(b)(viii).

The applicant's mark THE HOUSE OF ALISTER MACKENZIE and the wording in the registered mark ALISTER MACKENZIE are similar in appearance and sound and would create the same general overall commercial impression among potential consumers. Similarity in sound alone is sufficient to find a likelihood of confusion. *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). TMEP §1207.01(b)(iv).

If the marks of the respective parties are identical or highly similar, the examining attorney must consider the commercial relationship between the goods or services of the respective parties carefully to determine whether there is a likelihood of confusion. *In re Concordia International Forwarding Corp.*, 222 USPQ 355 (TTAB 1983).

Similarity of the Goods

The second part of the legal analysis involves comparing the goods to determine whether they are similar or related, and could cause a mistaken belief among potential purchasers that the goods come from a common source. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. The fact that the goods of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods, but likelihood of confusion

as to the source of those goods. *See In re Rexel Inc.*, 223 USPQ 830, 831, (TTAB 1984), and cases cited therein; TMEP §§1207.01 *et seq.*

If the marks of the respective parties are identical, the relationship between the goods or services of the respective parties need not be as close to support a finding of likelihood of confusion as might apply where differences exist between the marks. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992); *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *Amtcor, Inc. v. Amtcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981); TMEP §1207.01(a).

The applicant's goods/services, namely "Alcoholic beverages, namely, scotch" are related to registrant's goods/services, namely

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Registration Number 76039271:

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It is therefore quite likely that both applicant's and registrant's goods/services will travel through the same channels of trade to the same classes of purchasers. ***See below***

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B. Name of an Individual

Applicant must clarify whether the name in the mark identifies a particular living individual.

If the name in the mark identifies a particular living individual, then applicant must submit the following:

- (1) a signed, written consent from that individual, authorizing applicant to register the name as a trademark with the USPTO; and
- (2) a statement that “ALISTER MACKENZIE identifies a living individual whose consent is of record.”

However, if the name in the mark does not identify a living individual, then applicant must submit a statement that “ALISTER MACKENZIE does not identify a living individual.” Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §§813 and 1206.

C. Response Guidelines

Please note, there is no required format or form for responding to this Office action. The Office recommends applicants use the Trademark Electronic Application System (TEAS) to respond to Office actions online at <http://www.uspto.gov/teas/index.html>. However, if applicant responds on paper via regular mail, the response should include the following information: (1) the name and law office number of the examining attorney; (2) the serial number of this application; (3) the mailing date of this Office action; and, (4) applicant's telephone number.

When responding to this Office action, applicant must make sure to respond to each refusal and requirement raised. If there is a refusal to register the proposed mark, then applicant may wish to argue against the refusal, i.e., submit arguments and/or evidence as to why the refusal should be withdrawn and why the mark should register. If there are other requirements, then applicant should simply set forth in writing the required changes or statements and request that the Office enter them into the application record. Applicant must also sign and date its response.

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.

/William Rossman/
Trademark Examining Attorney
Law Office 109
William.Rossman@USPTO.Gov
(571) 272- 9029

RESPOND TO THIS ACTION: If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office Action should be filed using the Office’s Response to Office action form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the USPTO does not accept e-mailed responses.**

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EXHIBIT E

United States of America

United States Patent and Trademark Office

HOUSE OF ALISTER MACKENZIE

Reg. No. 3,924,415

I-D FOODS CORPORATION (CANADA CORPORATION)
1800 AUTOROUTE LAVAL
LAVAL, CANADA H7S2E7

Registered Mar. 1, 2011

Int. Cl.: 33

FOR: ALCOHOLIC BEVERAGES, NAMELY, SCOTCH, IN CLASS 33 (U.S. CLS. 47 AND 49).

TRADEMARK

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

PRINCIPAL REGISTER

PRIORITY CLAIMED UNDER SEC. 44(D) ON CANADA APPLICATION NO. 1336887, FILED 2-26-2007, REG. NO. TMA775592, DATED 8-26-2010, EXPIRES 8-26-2025.

THE NAME(S), PORTRAIT(S), AND/OR SIGNATURE(S) SHOWN IN THE MARK DOES NOT IDENTIFY A PARTICULAR LIVING INDIVIDUAL.

SER. NO. 77-134,486, FILED 3-19-2007.

WILLIAM ROSSMAN, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office