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

Proceeding	92055799
Party	Defendant I-D Foods Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

I-D FOODS CORPORATION)	
)	
Petitioner,)	Opposition No. <u>92060186</u>
)	
v.)	Mark: ALISTER MACKENZIE
)	Reg. No. 2,782,282 (Cls. 16 & 18)
)	Reg. No. 3,174,410 (Cls. 25)
PAPCZUN, EDMUND)	Reg. No. 4,135,892 (Cls. 28)
)	Reg. No. 4,305,803 (Cls. 16, 18, 25 & 28)
Registrant.)	Reg. No. 4,625,962 (Cls. 33)
)	

**PETITIONER’S OPPOSITION TO REGISTRANT’S REQUEST CONFIRMING
PREJUDICE AS TO THE JULY 29, 2015 ORDER AND STRIKING
U.S. SER. 86/877,079 FROM THE REGISTRY**

I. BACKGROUND

Petitioner by and through its undersigned counsel hereby opposes REGISTRANT’S REQUEST CONFIRMING PREJUDICE AS TO THE JULY 29, 2015 ORDER AND STRIKING U.S. SER. 86/877,079 FROM THE REGISTRY.

Registrant’s has asked the Board to “strike” Application Serial No. 86/877,079 and (although not mentioned in the filing’s caption) dismiss the current Counter-Claims with prejudice. Registrant contends that according to the prior Decision of the Board, Petitioner is not entitled to the mark THE HOUSE OF ALISTER MACKENZIE.

Registrant contends that Petitioner's recent filing shows that it will face renewed filings each time Registrant prevails.¹ Registrant's filing envisions endless litigation as a tactic by Petitioner.

II. THE TRADEMARK TRIAL AND APPEAL BOARD LACKS JURISDICTION

The instant filing asks the Board to assume jurisdiction over a pending application that is still undergoing *ex parte* examination.

The Board has jurisdiction over four types of *inter partes* proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings. TBMP § 102.02. "Any person who believes that he would be damaged by the registration of a mark" may file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, in the Official Gazette of the United States Patent and Trademark Office. [omitted] See TBMP § 303. Application Serial No. 86/877,079 has not been published for Opposition."²

The Board has no authority to rule on an application over which it has no jurisdiction. See TMEP 1504.02 Jurisdiction of Trademark Trial and Appeal Board (The Board has no jurisdiction over a pending application that has been suspended pending disposition of the applicant's petition to cancel a registration cited under §2(d) of the Trademark Act); TMEP 716.02(a) Applicant's Petition to Cancel Cited Registration (The Board has no jurisdiction over the application that is pending before the examining attorney.); TMEP 716.02(c) Conflicting Marks in Pending Applications (The Board has no jurisdiction over the application that is pending before the examining attorney. Thus, the applicant must file the amendment or consent agreement with the examining attorney, not with the Board); TBMP 605.03(c) With Amendment of Plaintiff's Pending Application (The Board has no jurisdiction over a plaintiff's application which is still pending before the examining attorney. omitted] Thus, when the plaintiff in an *inter partes* proceeding before the Board owns an application which is still pending before the

¹ The caption identifies I-D FOODS CORPORATION as the "Petitioner" and EDMUND PAPCZUN as the "Registrant"; however, the filing by EDMUND PAPCZUN reverses this and EDMUND PAPCZUN referred to as the "Petitioner" and I-D FOODS CORPORATION as the "Registrant."

² Application Serial No. 86/877,079 has not been examined.

trademark examining attorney, and an amendment or consent agreement is filed in the application pursuant to a settlement agreement between the parties, the amendment should be filed with the examining attorney, not with the Board.)

III. PETITIONER'S NEW FILE APPLICATION SERIAL NO. 86/877,079

Petitioner filed Application Serial No. 86/877,079 in the anticipation of prevailing in the instant cancellations or in a settlement that would allow Petitioner to obtain registration so that it would have an application in process. This was explained to Opposing Counsel in the attached email (Exhibit A).

Registrant's concern that it will be subjected to repeated new re-filings for the same mark and goods is misplaced. The most likely scenario for Application Serial No. 86/877,079 is that an initial Office Action will issue rejecting it under Section 2(d) based on a citation to one or more of Registrant's registrations. Thereafter, the application will likely be placed into suspension pending the termination of the instant Cancellation proceedings. If Registrant prevails, the outstanding citation(s) will likely be maintained and made final and the application will not likely be published. If Petitioner prevails, the application will likely go to publication.

IV. Registrant's Request for Sanctions

Registrant seeks Sanctions under TBMP § 527.03. The alleged grounds for the Sanctions are Petitioner's "callous disregard for Board orders" (citing *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071-72 (TTAB 2000)). First, Petitioner has not disregarded any Order of the Board. Second, Petitioner's actions were reasonable and appropriate. Applicant is not barred from filing a new application if it believes in good faith that Registrant has abandoned its rights and otherwise acquired and/or maintained some, if not all of its rights, by fraud. It is Petitioner's good faith belief that Registrant is attempting to reserve a mark, that it has fabricated specimens and that it has falsely claimed the use of the mark for goods and services when it has not.³

³ Registration No. 4625962 for the mark ALISTER MACKENZIE identifies "Blended whisky; bourbon; cognac; liquor; scotch; whisky; alcoholic beverage produced from a brewed malt base with natural flavors; alcoholic beverages except beers; alcoholic beverages, namely, flavor-infused whiskey; alcoholic beverages, namely, digestives; alcoholic cocktail mixes; aperitifs with a distilled alcoholic liquor base; brandy; brandy spirits; distilled spirits; flavored brewed malt beverage; potable spirits; prepared alcoholic cocktail; scotch; sherry;

V. CONCLUSION

For all of the foregoing reasons, Petitioner requests that the Requests of the Registrant be denied.

Respectfully submitted,

I-D FOODS CORPORATION

Date: April 4, 2016

By: // George Lewis
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Atty Dckt No.: OT12834US00

spirits and liqueurs.” This application was based on an intent to use and Registrant filed a Statement of Use alleging use of the mark for all of the above goods. The specimen submitted with the Statement of Use appears to be an artist’s rendition of a bottle and Petitioner is quoted in a recent article talking about the possible future launch of a Scotch Whiskey product. And it seems very implausible that the mark was ever be used, if ever, for any or all of the goods of the registration. The Statement of Use was filed October 21, 2014. Cancellation No. 92055799 of Registration 3924415 on which the claim of *res judicata* was based was terminated on September 21, 2012.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Petitioner's Opposition To Registrant's Request Confirming Prejudice As To The July 29, 2015 Order And Striking U.S. Ser. 86/877,079 From The Registry was served on counsel for the Registrant, Edmund Papczun, by first-class U.S. mail, postage prepaid, on this 4th day of April, 2016 at their addresses of record as follows:

Alain Villeneuve
Vedder Price PC
222 NORTH LaSalle Street, Ste. 2600
Chicago, IL 60601
Phone: 312-609-7745

//George Lewis

EXHIBIT A

From: Lewis, George
Sent: March 14, 2016 05:35 PM
To: 'Villeneuve, Alain'
Cc: Jeffery, Tracey
Subject: RE: Edmund Papczun v I-D Foods - Cancellation No. 92060186 (41434.00.0010)

Dear Alain,

Thank you for the below email of this date.

The Trademark Trial and Appeal Board has no jurisdiction over an application that has not even been assigned to an Examiner.

As for filing the new application, it was done, in part, in the anticipation of the cancellation of your registrations and/or in the anticipation of settlement so that our client would have an application in process. While the new application might be allowed, we expect that it will be suspended pending the outcome of the cancellation so your client will not likely be hounded by a new application if it prevails in the Cancellation. Inasmuch as our client is using the mark and believes that your client has no valid rights to the mark, filing the new application was prudent and reasonable. It is not the client's intention to continuously file new applications.

This motion is entirely inappropriate and we ask you to carefully consider the jurisdiction of the Board and the grounds for the Motion. If the Motion is not withdrawn, we will consider the appropriateness of seeking redress under available rules.

George