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Filing date: **11/01/2013**

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

Proceeding	92056848
Party	Defendant Brauerei Beck GmbH & Co. KG
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Signature	/Marcus Peterson/
Date	11/01/2013
Attachments	Beck Answer, Affirmative Defenses, and Counterclaims.pdf(196917 bytes )

Registration Subject to the filing

Registration No	3470447	Registration date	07/22/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	Bacardi & Company Limited Aeulestrasse 5 Vaduz, LIX 9490 LIX		

Goods/Services Subject to the filing

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Sunglasses; sunglasses and spectacle cases; cameras; audio cassette, digital audio, CD and DVD players; radios; compactdiscs, laser discs and audio cassettes featuring music; compact discs and laserdiscs featuring video content on the subject of beverage alcohol, the history of beverage making, and entertainment, cultural and sporting events</p>
<p>Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Paper napkins; printed matter, namely, printed informational brochures on the subjects of alcoholic beverages, the history of beverage making, entertainment, cultural, and sporting events; posters, pens, office requisites, namely, desktop business card holders, pencils, money clips, passport clips</p>
<p>Class 021. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Glassware, porcelain and earthenware for use in drinking, holding and dispensing beverages, namely, drinking glasses, mugs, cups made of glass and plastic, serving pitchers made of glass and aluminum, cups and drinking vessels, serving trays not of precious metal, napkin holders, plastic beverage stirrers, cocktail shakers used in bars, drinking tumblers made of glass; ice buckets; bottle juice mixer holders made of plastic; plastic pourers, namely, plastic pouring spouts for household use; glass and plastic bottles, sold empty</p>

Class 024. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Textiles and textile goods, specifically, bed and table covers and towels

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Clothing, namely, sweatshirts, sport shirts, t-shirts, polo shirts, shorts, pants, trousers, shirts, jackets, wind resistant jackets, rain jackets, turtlenecks, sweaters, ties, belts, suspenders, sweatbands; footwear; headgear, namely, caps, visors

Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Entertainment services, namely, providing a web site featuring music videos, music, related film clips, photographs and other multimedia materials; organization, provision and running of cultural and sporting events; organization, provision and running of entertainment events, namely, discotheques and live music concerts; organization, provision and running of exhibitions, conferences in the field of music entertainment; advice, information and consultancy services relating to all of the aforesaid services; providing prerecorded digital music, digital audio presentations featuring live and prerecorded musical performances, and digital video featuring live and prerecorded cultural and sporting events, all online via a global computer network; providing prerecorded digital music not downloadable from the Internet; production of radio programs; radio entertainment, namely, radio programs featuring performances and interviews with recording artists and musical entertainers; gathering and providing recorded and live entertainment programs featuring musical performances and cultural and sporting events for non-downloadable retrieval from a global computer network; nightclub services

Class 043. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Bar and cocktail bar services; restaurants; catering for the provision of food and drink; providing facilities for fairs and exhibitions for the consumption of alcoholic and non-alcoholic beverages

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

Bacardi & Company Ltd.	§	
	§	
Petitioner,	§	Cancellation No. 92056848
	§	
v.	§	Mark: BECK'S SAPPHIRE
	§	
Brauerei Beck GmbH & Co. KG	§	Registration No. 4,293,143
	§	
Registrant,	§	

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

**REGISTRANT'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS  
TO PETITION FOR CANCELLATION**

Brauerei Beck GmbH & Co. KG ("Registrant"), owner of U.S. Trademark Registration No. 4,293,143 for the mark BECK'S SAPPHIRE, hereby responds to the above-captioned Petition for Cancellation filed by Bacardi & Company Ltd. ("Petitioner") as follows:

1. Registrant lacks sufficient knowledge and information upon which to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 of the Petition for Cancellation and on that basis denies them.
2. Registrant admits the allegations in Paragraph 2 of the Petition for Cancellation.
3. Registrant admits the allegations in Paragraph 3 of the Petition for Cancellation.
4. Registrant lacks sufficient knowledge and information upon which to form a belief as to the truth or falsity of the allegations contained in Paragraph 4 of the Petition for Cancellation and on that basis denies them.

5. Registrant lacks sufficient knowledge and information upon which to form a belief as to the truth or falsity of the allegations contained in Paragraph 5 of the Petition for Cancellation and on that basis denies them.

6. Registrant admits that the attachments in Exhibit A purport to be trademark registrations, and are described in Paragraph 6 of the Petition for Cancellation. Registrant denies the implication that any of the alleged trademarks are valid or subsisting.

7. Paragraph 7 states a legal conclusion, and as such, no answer is required. However, to the extent Paragraph 7 contains an allegation to which a response is required, Registrant denies the allegations in Paragraph 7 of the Petition for Cancellation.

8. Registrant lacks sufficient knowledge and information upon which to form a belief as to the truth or falsity of the allegations contained in Paragraph 8 of the Petition for Cancellation and on that basis denies them.

9. Registrant admits that it commenced use of the BECK'S SAPPHIRE mark at least as early as December 31, 2012. Registrant denies all remaining allegations in Paragraph 9 of the Petition for Cancellation.

10. Registrant lack sufficient knowledge and information upon which to form a belief regarding the truth or falsity of the allegations relating to the "use" of "Petitioner's Marks" (as that term is defined), and on that basis denies the allegations in Paragraph 10 of the Petition for Cancellation.

11. Registrant denies all allegations in Paragraph 11 of the Petition for Cancellation.

12. Registrant denies all allegations in Paragraph 12 of the Petition for Cancellation.

13. Registrant denies all allegations in Paragraph 13 of the Petition for Cancellation.

14. Registrant denies all allegations in Paragraph 14 of the Petition for Cancellation.

15. Registrant denies all allegations in Paragraph 15 of the Petition for Cancellation.

16. Registrant denies all allegations in Paragraph 16 of the Petition for Cancellation.

17. Registrant denies all allegations in Paragraph 17 of the Petition for Cancellation.

18. Registrant denies all allegations in Paragraph 18 of the Petition for Cancellation.

19. Pursuant to the Board's September 17, 2013 Order, the allegations in Paragraph 19 have been dismissed and do not require an answer. However, to the extent that an answer is required, Registrant denies the allegations in Paragraph 19 of the Petition for Cancellation.

20. Registrant admits that it uses German Saphir Hops (sometimes referred to as "Sapphire Hops") in beer sold under the BECK'S SAPPHIRE trademark, and denies the remaining allegations in Paragraph 20 of the Petition for Cancellation.

21. Pursuant to the Board's September 17, 2013 Order, the allegations in Paragraph 21 that "Registrant's Mark" is "primarily merely a surname" have been dismissed and do not require an answer. Moreover, Registrant's Mark is the composite mark BECK'S SAPPHIRE. As explained in Registrant's Motion to Dismiss, BECK'S is an incontestable mark and an attack on BECK'S SAPPHIRE as merely descriptive or generic is an improper collateral attack on the incontestable BECK'S registration. To the extent that a further response is required, Registrant denies the remaining allegations in Paragraph 21 of the Petition for Cancellation.

22. Registrant denies all allegations in Paragraph 22 of the Petition for Cancellation.

## AFFIRMATIVE DEFENSES

Registrant alleges the following affirmative defenses, and reserves its rights to allege additional affirmative defenses:

1. Petitioner fails to state a claim for trademark dilution as to at least its alleged mark “SAPPHIRE” (U.S. Trademark Registration No. 1,650,299) because that is not a famous mark pursuant to 15 U.S.C. §1125(c).
2. There is no likelihood of confusion between Petitioner’s marks relied upon in the Petition for Cancellation and BECK’S SAPPHIRE for use on the goods identified in Trademark Registration No. 4,293,143.
3. Petitioner does not own valid, subsisting trademark rights in the term “SAPPHIRE” by itself.
4. Petitioner acquiesced to Registrant’s registration for the mark BECK’S SAPPHIRE because it knew about Registrant’s application for BECK’S SAPPHIRE and allowed the application to register unopposed.
5. One or more of Petitioner’s registrations, including but not limited to Registration 3,470, 447 are invalid, void *ab initio*, and/or abandoned for Petitioner’s failure to use the mark as a trademark in commerce.
6. Petitioner’s allegation that BECK’S SAPPHIRE is merely descriptive as a whole fails, in part, because Registrant owns an incontestable registration for the mark BECK’S.

**COUNTERCLAIM FOR CANCELLATION OF U.S. TRADEMARK  
REGISTRATION NO. 3,470,447 AS VOID *AB INITIO* AND/OR FOR ABANDONMENT**

1. Brauerei Beck GmbH & Co. KG (“Registrant”) is organized and existing under the laws of Germany with a principal place of business at Am Deich 18/19 Bremen 28199, Germany.

2. Bacardi & Company Limited (“Petitioner”) is a corporation organized and existing under the laws of Liechtenstein, with a principal place of business of 5 Aeulestrasse, Vaduz 9490, Liechtenstein.

3. Petitioner is the owner of trademark Registration No. 3,470,447 (“the ‘447 Registration”) for BOMBAY SAPPHIRE for a number of goods and services in International Classes 9, 16, 21, 24, 25, 41, and 43.

4. Registrant has standing to challenge the continued registration of the ‘447 Registration because Petitioner has alleged that registration against Registrant in Petitioner’s Petition for Cancellation.

5. Petitioner applied to register the mark BOMBAY SAPPHIRE on May 24, 2007 on a 44(e) basis.

6. The ‘447 Registration for the mark BOMBAY SAPPHIRE covers over *seventy-five* (75) different types of goods and services, including but not limited to sunglasses, audio cassettes, and laser discs in International Class 9; posters, pens, and passport clips in International Class 16; bed and table covers and towels in International Class 24; turtle necks, sweaters, and footgear in International Class 25; providing prerecorded digital music, production of radio programs, and nightclub services in International Class 41; and bar and cocktail bar services, restaurants, and catering in International Class 43.

7. Upon information and belief, Petitioner had not used the BOMBAY SAPPHIRE mark on each and every one of the goods or services listed in the '447 Registration at the time it applied to register the BOMBAY SAPPHIRE mark, and has not used the mark on each and every one of those goods and services to this day.

8. Upon information and belief, Petitioner had no bona fide intent to use the BOMBAY SAPPHIRE mark in connection with each and every one of the goods or services listed in the '447 Registration at the time it applied to register the BOMBAY SAPPHIRE mark.

9. Accordingly, the '447 Registration should be cancelled as void *ab initio* for Petitioner's non-use of the mark in connection with the goods and services listed in the registration, as well as its lack of bona fide intent to use that mark in connection with each and every one of the goods and services listed in its application to register the '447 Registration.

10. Alternatively, Petitioner abandoned the BOMBAY SAPPHIRE mark in connection with the goods and services listed in the '447 Registration.

11. Upon information and belief, to the extent Petitioner ever used the BOMBAY SAPPHIRE mark in connection with goods and services listed in the '447 Registration, Petitioner has ceased using the mark in connection with those goods and services and has no evidence of an intent to resume use of the mark in connection with those goods and services in U.S. commerce.

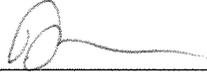
WHEREFORE, Registrant prays:

1. That the Petition for Cancellation be dismissed in its entirety.
2. That U.S. Trademark Registration No. 3,470,447 be cancelled.

Respectfully submitted,

Pillsbury Winthrop Shaw Pittman LLP  
Bobby A. Ghajar  
Marcus D. Peterson

Date: November 1, 2013

By:   
Bobby A. Ghajar  
Attorneys for Registrant  
Brauerei Beck GmbH & Co. KG

CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT: November 1, 2013

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.

  
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Marcus Peterson

**CERTIFICATE OF SERVICE VIA MAIL**

I, Marcus Peterson, Esq., of Pillsbury Winthrop Shaw Pittman LLP, attorneys for Registrant Brauerei Beck GmbH & Co. KG, hereby certify that a true and complete copy of the foregoing REGISTRANT'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS TO PETITION FOR CANCELLATION was served via postage prepaid by first class mail on November 1, 2013 on:

Janice Housey  
SYMBUS LAW GROUP LLC  
P.O. Box 11085  
McLean, VA 22102



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Marcus Peterson