

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: January 15, 2014

Cancellation No. 92056848

Bacardi & Company Limited

v.

Brauerei Beck GmbH & Co. KG

Elizabeth A. Dunn, Attorney (571-272-4267):

On January 13, 2014, the Board participated in the parties' discovery conference, which was conducted by phone. The participants were Janice Housey, attorney for petitioner, and Bobby Ghajar, attorney for respondent, and Elizabeth Dunn, Board attorney.¹

At the beginning of the conference, the parties were advised that the conference would not, and could not, be recorded, that a summary order would issue, and that, while this conference satisfied their discovery conference obligation under the Board's rules, the parties may request additional phone conferences with the Board on contested

¹ Respondent's attorney Marcus Peterson also attended the conference.

disclosure or discovery matters, and may do so in lieu of filing written motions.

PLEADINGS

On July 22, 2008, Registration No. 85460019 issued to petitioner for the mark BOMBAY SAPPHIRE in standard characters for seven classes of goods and services.²

² Registration No. 3470447 includes:

Int. Cl. 9

Sunglasses; sunglasses and spectacle cases; cameras; audio cassette, digital audio, CD and DVD players; radios; compact discs, laser discs and audio cassettes featuring music; compact discs and laser discs featuring video content on the subject of beverage alcohol, the history of beverage making, and entertainment, cultural and sporting events

Int. Cl. 16

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

Int. Cl. 21

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

Int. Cl. 24

Textiles and textile goods, specifically, bed and table covers and towels

Int. Cl. 25

Cancellation No. 92056848

On February 19, 2013, Registration No. 85460019 issued to respondent for the mark BECK'S SAPPHIRE in standard characters for "beer."

Petitioner's amended petition to cancel filed February 23, 2013 pleads claims of priority of use and likelihood of confusion with, and dilution of, petitioner's SAPPHIRE and

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

Int. Cl. 41

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

Int. Cl. 42

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

BOMBAY SAPPHIRE marks for distilled spirits, the subject of common law use and pleaded registrations, including Registration No. 3470447. In the alternative, petitioner pleads that the term SAPPHIRE is merely descriptive or generic of the hops used in beer.

On November 1, 2013, respondent filed an answer denying the salient allegations of the amended petition to cancel and a counterclaim to cancel pleaded Registration No. 3470447 for the mark BOMBAY SAPPHIRE on the grounds that petitioner lacked a bona fide intent to use the mark with all the listed goods and services at the time the application was filed, and abandonment.³ Petitioner filed an answer denying the salient allegations of the counterclaim.

RELATED PROCEEDINGS

The parties are not involved in another proceeding involving these marks. Should they become involved in another proceeding, they must promptly notify the Board and provide the pleadings so that the Board may review for

³ To the extent that respondent also alleges that the Registration No. 3470447 should be cancelled for nonuse at the time the application was filed, applicants under Trademark Act Sec. 44(e) do not have to allege use or provide specimens or dates of use prior to registration. Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984). Once registered, a registration under Sec. 44(e) is subject to a claim of abandonment. See Imperial Tobacco, Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990) ("Under the statute, an abandoned mark is not entitled to continued registration regardless of the basis on which the registration was originally obtained.").

overlap in the issues, and possibly suspend this proceeding pending the disposition of the other action.

SETTLEMENT

As discussed, the parties currently are not engaged in settlement discussions.

If settlement discussions hereafter impinge on Board disclosure, discovery, or trial deadlines, the parties are urged to promptly stipulate to an extension or suspension of the proceeding, and to file it with the Board, before the close of any deadline for taking action. Instruments SA Inc. v. ASI Instruments Inc., 53 USPQ2d 1925, 1927 (TTAB 2000) ("Generally, the safest course of action for a party in pursuit of settlement is immediately to seek the adverse party's permission to file a consented motion to suspend the proceeding. No other action more readily clarifies the status of the case; no other motion better protects the parties.").

ACR (ACCELERATED CASE RESOLUTION) PROCEDURES

With both parties located in Europe, and petitioner unwilling at this juncture to agree to depositions in the United States, or to arrange for oral examination abroad, there is no agreement to adopt ACR procedures. As discussed, the parties may seek approval of ACR at any

point in the proceeding, though the greatest cost benefit occurs with early adoption.

STIPULATIONS

The parties agree to service by email of papers filed with the Board.

DISCLOSURE/DISCOVERY/EVIDENCE ARRANGEMENTS

In view of respondent's strong preference, petitioner will seek approval of email service of responsive discovery documents.

Petitioner, who has pleaded multiple registrations covering several classes of goods and services, was unwilling to expand initial disclosures to include evidence of use of the mark with the listed goods and services. As discussed, the Board expects parties who plead registrations to have reviewed those registrations so that details regarding use are readily available. Evidence of use is relevant, and not burdensome to produce by a party who has put its registrations at issue.

If the parties cannot come to agreement on expediting depositions, and depositions by written questions are necessary, depositions should come up early in the discovery period.

Dates remain as set by the Board's November 20, 2013 order.