

ESTTA Tracking number: **ESTTA585811**

Filing date: **02/05/2014**

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 parties request to cancel indicated registration.

Petitioner Information

Name	Diana Karren		
Entity	Individual	Citizenship	UNITED STATES
Address	3845 Ely Road Petaluma, CA 94954 UNITED STATES		

Name	Charles Karren		
Entity	Individual	Citizenship	UNITED STATES
Address	3845 Ely Road Petaluma, CA 94954 UNITED STATES		

Attorney information	Jay M. Behmke Carle, Mackie, Power & Ross LLP 100 B Street, Suite 400 Santa Rosa, CA 95401 UNITED STATES jmbehmke@cmprlaw.com, jdawson@cmprlaw.com Phone:(707) 526-4200		
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Registration Subject to Cancellation

Registration No	3613730	Registration date	04/28/2009
Registrant	Domaine Carneros, Ltd. 1240 Duhig Road Napa, CA 94558 GERMANY		

Goods/Services Subject to Cancellation

Class 033. First Use: 2008/07/14 First Use In Commerce: 2008/07/14 All goods and services in the class are cancelled, namely: Wines
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	3358681	Application Date	03/05/2007
Registration Date	12/25/2007	Foreign Priority Date	NONE

Word Mark	TERRA DE PROMISSIO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2007/01/07 First Use In Commerce: 2007/01/07 Wine

Attachments	77122183#TMSN.jpeg(bytes) 00310040.PDF(1488804 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	/jmb-163603/
Name	Jay M. Behmke
Date	02/05/2014

rely upon the rights developed by them and/or their licensees, and allege on knowledge as to each of themselves and otherwise upon information and belief, as follows:

1. On March 5, 2007, Petitioners filed an application to register their mark TERRA DE PROMISSIO, Serial No. 77-122,183, claiming a first use date of January 7, 2007, covering “Wine” in International Class 033. The Petitioners’ application states that the translation of the TERRA DE PROMISSIO mark is “Land of Promise.” Petitioners respectfully submit that a “land of promise” is a land that shows favorable potential.

2. On October 9, 2007, Petitioners’ mark was published for opposition. On December 25, 2007, the Patent & Trademark Office issued Registration No. 3,358,681 to Petitioners for their TERRA DE PROMISSIO mark.

3. On January 28, 2013, Petitioners filed a combined Declaration of Use and Incontestability under Sections 8 and 15 of the Lanham Act (15 U.S.C. §§ 1058, 1065) with the Patent & Trademark Office. On February 9, 2013, the Patent & Trademark Office issued a Notice of Acceptance under Section 8 and a Notice of Acknowledgment under Section 15. Consequently, Petitioners’ TERRA DE PROMISSIO mark is valid, subsisting, and incontestable as a matter of law.

4. Petitioners and/or their licensees have expended substantial amounts of time and resources in advertising and/or promoting their goods under the TERRA DE PROMISSIO mark. As a result, wines bearing the TERRA DE PROMISSIO mark have garnered numerous awards and accolades from the Wine Spectator, Robert Parker’s Wine Advocate, and other leading wine publications. As a result of such advertising and/or promotional activities, the TERRA DE PROMISSIO mark has become well known and favorably received, the relevant public has come to associate and identify the TERRA DE PROMISSIO mark with Petitioners, and Petitioners derive substantial goodwill from such identification by consumers.

5. Upon information and belief, registrant Domaine Carneros, Ltd., is a Delaware corporation having an address of 1240 Duhig Road, Napa, California 94558 (“Registrant”).

6. Upon information and belief, on July 2, 2008, Registrant filed an Intent to Use application, Serial No. 77-514,016, to register the name LA TERRE PROMISE for “Wines” in International Class 035. Registrant’s application states that the translation of its mark is “The Earth’s Promise.”

7. Notably, Registrant’s own website has translated its mark as “the Promised Land.” Registrant’s website contains a web page that features an image of a bottle of wine bearing Registrant’s LA TERRE PROMISE mark, and text which states in relevant part,

2011 LA TERRE PROMISE PINOT NOIR

We call it the Promised Land (“La Terre Promise”) and it just might be the most picturesque ranch in Carneros.

The word “EARTH” does not appear on this web page or in any other text on Registrant’s website in connection with Registrant’s mark. A true and correct print out of the above-referenced web page is attached hereto as Exhibit B.

8. Upon information and belief, Registrant amended its application to claim a first use date of July 14, 2008. Upon information and belief, on April 28, 2009, the Patent & Trademark Office issued Registration No. 3,613,730 to Registrant for its LA TERRE PROMISE mark.

Count 1: Likelihood of Confusion

9. Petitioners hereby incorporate by reference the allegations of Paragraphs 1 through 8 hereof as if fully set forth here.

10. Petitioners are the senior users in this case, with both priority of use and priority of registration of their TERRA DE PROMISSIO mark as compared with Registrant’s LA TERRE PROMISE mark.

11. Registrant's mark and Petitioners' mark cover identical goods, wine, in International Class 033.

12. Moreover, Registrant and Petitioners use their respective marks solely in connection with Pinot Noir-based, still wines, made from grapes grown in northern California. Consequently, the truly identical nature of the goods covered by the parties' marks exacerbates the likelihood of consumer confusion as to the source of the goods sold under Registrant's mark and Petitioners' mark, to the detriment of the senior-user Petitioners.

13. Registrant's mark LA TERRE PROMISE is substantially similar in commercial impression to Petitioners' senior TERRA DE PROMISSIO mark. The most distinctive features of Registrant's mark are the words "TERRE" and "PROMISE," while the most distinctive features of Petitioners' mark are "TERRA" and "PROMISSIO." Accordingly, both marks contain words starting with the letters "T" and "P," the words starting with the letter "T" share four out of five letters that appear in sequence, and the words starting with the letter "P" share six letters that appear in sequence.

14. Petitioners will show, at the appropriate time and by way of a Notice of Reliance, the way their TERRA DE PROMISSIO trademark is used as an indication of source to identify their goods to the public. It is under this entire mark that Petitioners' mark has gained the popularity and trust which they have enjoyed for more than seven years.

15. Accordingly, Registrant's proposed mark is likely to cause confusion, mistake, or to deceive the public into believing that Registrant's goods are somehow affiliated or associated with, connected to or sponsored by Petitioners, in violation of Section 2(d) of the Lanham Act.

16. If Registrant is permitted to maintain or continue to use the mark herein opposed, confusion would be likely as to the sponsorship of the goods by reason of the similarity between Registrant's and Petitioners' marks. Persons familiar with Petitioners' TERRA DE PROMISSIO

mark will be likely to purchase and/or use Registrant's goods, believing them to be affiliated or associated with, connected to or sponsored by Petitioners. Likewise, persons exposed to Registrant's mark who subsequently become acquainted with Petitioners' mark, are likely to conclude that the goods offered by Petitioners under their mark are in some manner affiliated or associated with, connected to or sponsored by Registrant. Any such confusion as to sponsorship inevitably would result in damage and injury to Petitioners.

17. Petitioners will be damaged by the maintenance and use of the Registrant's mark because such registration will support and assist Registrant in the confusing and misleading use of Registrant's mark, and will give color of rights to Registrant in violation of Petitioners' prior and superior statutory and common-law rights in the TERRA DE PROMISSIO mark.

18. Furthermore, Petitioners respectfully submit that, as evidenced by Registrant's own website, and the translation entry set forth in Collins Robert, French-English Dictionary (3d ed. 1993), p. 811, the correct translation of Registrant's mark is "The Promised Land." Notably, at the time Registrant applied for its mark, there was a prior registered mark for the words PROMISED LAND for "wines, spirits, liqueurs" in International Class 033, Registration No. 2,973,480, which was and is owned by Taylors Wines Pty Ltd (the "PROMISED LAND mark"). A copy of the Status Page for Registration No. 2,973,480, downloaded from the Patent & Trademark Office TSDR server, is appended hereto as Exhibit C. The Status Page reflects that the PROMISED LAND mark was in good standing at the time that Registrant applied for its LA TERRE PROMISE mark, and that Section 8 and 15 filings for the PROMISED LAND mark were timely made.

19. "Promised Land" is defined as "something and especially a place or condition believed to promise final satisfaction or realization of hopes."

20. Accordingly, Petitioners respectfully submit that Registrant's mark should have been refused registration, and should now be cancelled, on the grounds that Registrant's mark is also confusingly similar to the senior PROMISED LAND mark for wine in International Class 033.

WHEREFORE, Petitioners pray that registration of LA TERRE PROMISE, Registration No. 3,613,730, be cancelled, and that this Petition be sustained in favor of Petitioners.

Dated: February 5, 2014
Santa Rosa, California

Respectfully submitted,

/jmb-163603/
Jay M. Behmke
John B. Dawson
CARLE, MACKIE, POWER & ROSS, LLP
100 B Street, Suite 400
Santa Rosa CA 95401
Tel: (707) 526-4200
Fax: (707) 526-4707
Email: jbehmke@cmprlaw.com
jdawson@cmprlaw.com

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

In the Matter of Registration No. 3,613,730
Registered on April 28, 2009

PROOF OF SERVICE

I am employed in the County of Sonoma; I am over the age of eighteen (18) years and not a party to the within entitled action; my business address is 100 B Street, Suite 400, Santa Rosa, California 95401.

I hereby certify that a true and complete copy of the foregoing **PETITION FOR CANCELLATION** has been served on the attorneys of record for Registrant by mailing said copy on February 5, 2014, via First-Class Mail, postage prepaid to:

Katja Loeffelholz
Dickenson, Peatman & Fogarty
1455 First Street, Ste 301
Napa, California 94559

Executed on February 5, 2014, at Santa Rosa, California.

/cc/

Colleen Culver

EXHIBIT A

Generated on: This page was generated by TSDR on 2014-02-04 21:07:31 EST

Mark: LA TERRE PROMISE

LA TERRE PROMISE

US Serial Number: 77514016
Application Filing Date: Jul. 02, 2008
US Registration Number: 3613730
Registration Date: Apr. 28, 2009
Filed as TEAS Plus: Yes
Currently TEAS Plus: Yes
Register: Principal
Mark Type: Trademark
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.
Status Date: Apr. 28, 2009
Publication Date: Nov. 25, 2008
Notice of Allowance Date: Feb. 17, 2009

Mark Information

Mark Literal Elements: LA TERRE PROMISE
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type: 4 - STANDARD CHARACTER MARK
Translation: The foreign wording in the mark translates into English as "THE EARTH'S PROMISE."

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Wines
International Class(es): 033 - Primary Class
U.S Class(es): 047, 049
Class Status: ACTIVE
Basis: 1(a)
First Use: Jul. 14, 2008
Use in Commerce: Jul. 14, 2008

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Domaine Carneros, Ltd.
Owner Address: 1240 Duhig Road
Napa, CALIFORNIA 94558
UNITED STATES
Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Katja Loeffelholz
Attorney Primary Email Address: kl@gawwanmale.com
Attorney Email Authorized: No

Correspondent

Correspondent Name/Address: Katja Loeffelholz
Dickenson, Peatman & Fogarty
1455 First Street, Ste 301
NAPA, CALIFORNIA 94559
UNITED STATES

Phone: 707-252-7122

Fax: 707-255-6876

Correspondent e-mail: tmdept@dpf-law.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 05, 2013	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 28, 2009	REGISTERED-PRINCIPAL REGISTER	
Mar. 24, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	66121
Mar. 23, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Mar. 10, 2009	STATEMENT OF USE PROCESSING COMPLETE	66154
Feb. 19, 2009	USE AMENDMENT FILED	66154
Mar. 10, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66154
Feb. 19, 2009	TEAS STATEMENT OF USE RECEIVED	
Feb. 17, 2009	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Nov. 25, 2008	PUBLISHED FOR OPPOSITION	
Nov. 05, 2008	NOTICE OF PUBLICATION	
Oct. 23, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	66121
Oct. 23, 2008	ASSIGNED TO LIE	66121
Oct. 11, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 07, 2008	ASSIGNED TO EXAMINER	78180
Jul. 07, 2008	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Mar. 24, 2009

EXHIBIT B



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HOME ABOUT VISIT WINES WINEMAKING EVENTS GROUP EVENTS WINE CLUB WINE SHOP

2011 La Terre Promise Pinot Noir

- Overview
- Wine Details
- Tasting Notes



2011 LA TERRE PROMISE PINOT NOIR

We call it the Promised Land (“La Terre Promise”) and it just might be the most picturesque ranch in Carneros.

We call it the Promised Land (“La Terre Promise”) and it just might be the most picturesque ranch in Carneros. This site was selected for its rolling hills and exceptional soils, planted between 2002 and 2004 it has been carefully planted to a wide variety of Pinot noir clones. Year after year it has proven itself by consistently delivering aromatic and exciting Pinot noir.

This edition features the vaunted “Dijon 667” clone which is widely planted in California and a particular favorite here in Carneros. The pure fruit expression of this clone is one of its undeniable hallmarks, and in this example showcases a focused beam of raspberry and black cherry with a wisp of anise. The other key feature of the Dijon 667 is its unique tannin profile. While great Pinot noir is always elegant and delicate this clone lends a textural component which adds richness to the mid-palate as well as lengthens the finish.

- SPARKLING WINES
- PINOT NOIR | STILL WINES
- MAGNUMS & MORE!
- CHATEAU SOCIETY CLUB EXCLUSIVES/CURRENT SHIPMENT WINES
- GIFTS & MERCHANDISE
- WINE CLUB GIFT MEMBERSHIP
- SHIPPING POLICY
- FEDEX CLIMATE CONTROL SHIPPING

SHIPPING STATE
 ▼



\$55.00/Bottle

Cart Total: \$0.00

1 ADD TO CART

CUSTOMER LOGIN EMPLOYMENT EMAIL SIGNUP DIRECTIONS CONTACT US MEDIA & TRADE CUSTOMER SERVICE/SHIPPING
 SPARKLING WINES BRUT SPARKLING WINE BRUT ROSE ROMANTIC NAPA VALLEY CALIFORNIA WINE CLUB

Domaine Carneros | 1240 Duhig Road, Napa California 94559 | 800.716 BRUT(2788) | E-Mail: info@DomaineCarneros.com
 2014 Copyright - Domaine Carneros

EXHIBIT C

Address: _____

Authorized:

Correspondent

Correspondent Name/Address: Sheldon H. Klein
Gray, Plant, Mooty, Mooty & Bennett, P.A.
600 New Hampshire Ave., NW
Suite 700
Washington, DISTRICT OF COLUMBIA 20037
UNITED STATES

Phone: (202) 295-2200

Fax: 612-632-4444

Correspondent e-mail: trademark@gpmlaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Sheldon H. Klein

Phone: 202-295-2200

Fax: 612-632-4444

Domestic Representative e-mail: trademark@gpmlaw.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Aug. 29, 2011	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 26, 2011	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Aug. 26, 2011	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70132
Aug. 26, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70132
Jul. 15, 2011	TEAS SECTION 8 & 15 RECEIVED	
Jul. 19, 2005	REGISTERED-PRINCIPAL REGISTER	
Apr. 14, 2005	LAW OFFICE REGISTRATION REVIEW COMPLETED	76984
Apr. 13, 2005	ASSIGNED TO LIE	76984
Apr. 04, 2005	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 02, 2005	STATEMENT OF USE PROCESSING COMPLETE	65362
Feb. 04, 2005	USE AMENDMENT FILED	65362
Feb. 04, 2005	TEAS STATEMENT OF USE RECEIVED	
Dec. 23, 2004	EXTENSION 1 GRANTED	76874
Dec. 14, 2004	EXTENSION 1 FILED	76874
Dec. 14, 2004	TEAS EXTENSION RECEIVED	
Jun. 15, 2004	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Mar. 23, 2004	PUBLISHED FOR OPPOSITION	
Mar. 03, 2004	NOTICE OF PUBLICATION	
Jan. 21, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 15, 2004	EXAMINERS AMENDMENT E-MAILED	
Jan. 14, 2004	ASSIGNED TO EXAMINER	77658

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None
File Location

Current Location: TMO LAW OFFICE 113

Date in Location: Aug. 26, 2011