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Filing date: **07/30/2014**

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	Luxco, Inc.		
Entity	Corporation	Citizenship	Missouri
Address	1000 Clark Avenue St. Louis, MO 63102 UNITED STATES		

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Entity	Corporation	Citizenship	Missouri
Address	1000 Clark Avenue St. Louis, MO 63102 UNITED STATES		

Attorney information	Michael R. Annis Husch Blackwell LLP 190 Carondelet Plaza, Suite 600 St. Louis, MO 63105 UNITED STATES andy.gilfoil@huschblackwell.com, mike.annis@huschblackwell.com, alan.nemes@huschblackwell.com Phone:314-480-1500		
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Registration Subject to Cancellation

Registration No	4306180	Registration date	03/19/2013
Registrant	England, Richard Allan PO Box 908 Lyons, CO 80540 UNITED STATES		

Goods/Services Subject to Cancellation

Class 033. First Use: 2012/10/12 First Use In Commerce: 2012/10/12 All goods and services in the class are cancelled, namely: Coffee-based liqueurs

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1380938	Application Date	03/15/1985
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Registration Date	02/04/1986	Foreign Priority Date	NONE
Word Mark	EVERCLEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1919/11/01 First Use In Commerce: 1919/11/01 ETHYL ALCOHOL FOR BEVERAGE PURPOSES		

U.S. Registration No.	1950891	Application Date	12/27/1994
Registration Date	01/23/1996	Foreign Priority Date	NONE
Word Mark	EVERCLEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1919/11/01 First Use In Commerce: 1919/11/01 ethyl alcohol for beverage purposes		

U.S. Registration No.	544403	Application Date	07/06/1950
Registration Date	06/26/1951	Foreign Priority Date	NONE
Word Mark	EVERCLEAR		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 033. First use: First Use: 1917/11/01 First Use In Commerce: 1917/11/01 GRAIN OR ETHYL ALCOHOL FOR BEVERAGE PURPOSES

Attachments	73527016#TMSN.png(bytes) 74615447#TMSN.png(bytes) 71600248#TMSN.png(bytes) NEVER CLEAR cancellation petition.PDF(63278 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	/s/ Michael R. Annis
Name	Michael R. Annis
Date	07/30/2014

CERTIFICATE OF MAILING VIA ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals on July 30, 2014.

/s/ Andrew Gilfoil

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

Mark: RICHARDO’S NEVER CLEAR
U.S. Registration No. 4,306,180
U.S. Application Serial No. 85/466,521

LUXCO, INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
RICHARD ALLEN ENGLAND,)	
)	
Registrant.)	

PETITION TO CANCEL

Luxco, Inc. (“Luxco” or “Petitioner”), a corporation organized and existing under the laws of the State of Missouri, having its principal place of business at Luxco, Inc., 1000 Clark Street, St. Louis, Missouri, believes it is being damaged by continued registration of the mark RICHARDO’S NEVER CLEAR claimed in Registration No. 4,306,180.

As grounds for its petition, it is alleged that:

1. Registrant Richard Allen England. (“Registrant”), in U.S. Application Serial No. 85/466,521, applied to register the standard character trademark RICHARDO’S NEVER CLEAR in connection with “coffee-based liqueurs” in International Class 33. This application was based on Section 1(b) of the Lanham Act. On March 19, 2013, U.S. Registration No.

4,306,180 (the “180 Registration”) issued. On or about December 31, 2012, Applicant submitted a Statement of Use declaring and attesting that the RICHARDO’S NEVER CLEAR mark had been used at least as early as October 12, 2012, and that the same was then in use in commerce.

2. Luxco is the owner of the mark EVERCLEAR in connection with alcohol beverage products. Luxco is also the owner of the below-noted United States Trademark registrations:

MARKS	U.S. REGISTRATION NUMBER	Int’l Class	GOODS DESCRIPTION
EVERCLEAR and Design	1,380,938	1	Ethyl alcohol for beverage purposes
EVERCLEAR and Design	1,950,891	33	Ethyl alcohol for beverage purposes
EVERCLEAR (stylized)	544,403	33	Grain or ethyl alcohol for beverage purposes

3. Each of the aforementioned registrations has obtained incontestable status.

4. In addition, Luxco also owns certain common law rights in its well-known EVERCLEAR trademark.

5. Luxco’s aforementioned common law rights and the above-noted are collectively referred herein as the “EVERCLEAR Marks.”

6. Luxco’s EVERCLEAR Marks are inherently distinctive and uniquely associated with Luxco in connection with Luxco’s goods offered under the EVERCLEAR Marks by reason of the continuous use and promotion by Luxco and its predecessors-in-interest.

7. Luxco and its predecessors-in-interest have extensively used the mark EVERCLEAR in connection with distilled spirits since as early as November 1, 1919, long before Applicant's filing of what matured into the '180 Registration.

8. Luxco and/or its predecessors-in-interest have promoted, caused to be promoted, and are now promoting and causing to be promoted the famous EVERCLEAR Marks in interstate commerce throughout the United States for identifying these goods.

9. Through this use, Luxco has established valuable goodwill in the EVERCLEAR Marks, and the relevant public has come to recognize the EVERCLEAR Marks as an indication of the products that emanate from Luxco.

10. Luxco and its predecessors have also spent substantial sums of money to widely and extensively advertise and promote the goods it sells and offers under the EVERCLEAR Marks.

11. Notwithstanding Luxco's long-standing prior rights in its well-known EVERCLEAR Marks, on November 7, 2011, Registrant filed Application Serial No. 85/466,521 (the "'521 Application") in the United States Patent and Trademark Office for the term RICHARDO'S NEVER CLEAR.

12. On information and belief, Applicant knew or had reason to know of Luxco's prior rights in its EVERCLEAR Marks when filing the '521 Application.

13. The registration obtained for the RICHARDO'S NEVER CLEAR mark, which according to the specimen submitted by Registrant purports to contain "a lot of alcohol by volume" of at least "40 proof," so resembles Luxco's well-known EVERCLEAR Marks as to be likely, if used in conjunction with Applicant's coffee-liqueur goods, to cause consumer confusion and to deceive purchasers, potential purchasers and members of the public as to a

perceived affiliation, connection or association between Luxco's extremely well-known EVERCLEAR Marks and Registrant's NEVER CLEAR-branded goods, and/or as to a perceived origin, sponsorship, authorization or approval of Registrant's NEVER CLEAR-branded goods by or from Luxco.

14. Indeed, Registrant's use of the term "NEVER CLEAR" in conjunction with a dark-colored coffee liqueur containing "pure grain spirits" is intended, on information and belief, specifically to draw consumers into a mistaken belief that there is an association between Luxco's famous EVERCLEAR-branded products and Registrant's NEVER CLEAR-branded product, or to otherwise falsely suggest to consumers that Registrant's NEVER CLEAR-branded coffee-liqueur products contain EVERCLEAR distilled spirits as a constituent part.

15. Luxco has not authorized or endorsed Registrant's use and marketing of its infringing imitation of Luxco's well-known EVERCLEAR Marks.

16. Similarly, Registrant's goods are or will be targeted, offered, and sold to the same class of prospective buyers as those for Luxco's famous EVERCLEAR-branded goods, and Registrant's and Luxco's goods are so commercially related that Registrant's RICHARDO'S NEVER CLEAR Mark and Luxco's EVERCLEAR Marks, when used in conjunction with their respective distilled spirits, are confusingly and deceptively similar.

17. The continued registration of the Registrant's NEVER CLEAR Mark will support and assist Registrant in its confusing, misleading and deceptive use, and will cause Luxco to lose control over the good and valuable reputation derived from its well-known EVERCLEAR Marks, causing irreparable harm and injury to Luxco.

18. Further, upon information and belief, Registrant committed fraud on the United States Patent and Trademark Office (“USPTO”) in conjunction with the filing and prosecution of the ‘512 Application.

19. More particularly, on or about December 31, 2012, the Applicant averred and declared in conjunction with prosecuting the subject application that the RICHARDO’S NEVER CLEAR mark had allegedly been lawfully first used in U.S. commerce at least as early as October 12, 2012, and that the mark was “now in use in such commerce.”

20. However, as of that date Applicant had neither applied for nor obtained a Certificate of Label Approval (“COLA”) from the Department of Treasury Alcohol and Tobacco Tax and Trade Bureau (“TTB”), which is an explicit requirement under applicable provisions in Title 27 of the Code of Federal Regulations in order for any sale of 40 proof coffee-based liqueurs under the RICHARDO’S NEVER CLEAR Mark to be lawful under U.S. law.

21. Consequently, any such offer and/or sale of RICHARDO’S NEVER CLEAR-branded products was a *per se* violation of applicable TTB regulations and could not, as a matter of law, constitute lawful use of the mark in commerce under the Lanham Act.

22. Applicant should have known, and upon information and belief did know, that by virtue of its failure to obtain COLA approval from the TTB for its RICHARDO’S NEVER CLEAR-branded product, that any offer and/or sale of goods branded under the mark was unlawful under U.S. law.

23. Applicant made this knowingly false statement with the intention that the USPTO would rely on same. By virtue of the USPTO’s decision to allow the proposed trademark application to register, the USPTO relied on Applicant’s knowingly false statement.

WHEREFORE, Petitioner Luxco, Inc. prays that U.S. Registration No. 4,306,180 be cancelled, and, further that this Petition be sustained in favor of Luxco.

DATED: July 30, 2014

Respectfully Submitted,

By: /Michael Annis/
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Attorneys for Luxco, Inc.

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that a copy of the foregoing PETITION TO CANCEL was served by First Class Mail, postage prepaid on this 30th day of July, 2014, upon:

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/Andrew Gilfoil/