

ESTTA Tracking number: **ESTTA662611**

Filing date: **03/23/2015**

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

Proceeding	92060880
Party	Defendant FN Cellars, LLC
Correspondence Address	FN CELLARS LLC PO BOX 327 OAKVILLE, CA 94562 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Mark G. Kachigian
Filer's e-mail	mkachigian@hjkllaw.com
Signature	/markgkachigian/
Date	03/23/2015
Attachments	Answer and Counterclaim to Petition for Cancellation of BELLA UNION.pdf(5414290 bytes)

Registration Subject to the filing

Registration No	4486053	Registration date	02/18/2014
Registrant	Union Wine Company P.O. Box 370 Sherwood, OR 97140 UNITED STATES		

Goods/Services Subject to the filing

Class 033. First Use: 2012/11/28 First Use In Commerce: 2013/10/09
All goods and services in the class are requested, namely: Wines

2. Answering paragraph 2 of the Petition for Cancellation, FN Cellars admits the allegations therein.

3. Answering paragraph 3 of the Petition for Cancellation, FN Cellars denies the allegations therein and specifically denies that Union Wine Co. has priority over FN Cellars.

4. Answering paragraph 4 of the Petition for Cancellation, FN Cellars denies the allegations therein and specifically denies that Union Wine Co. has priority of use over FN Cellars.

5. Answering paragraph 5 of the Petition for Cancellation, FN Cellars denies the allegations therein.

6. Answering paragraph 6 of the Petition for Cancellation, FN Cellars denies the allegations contained therein.

7. Answering paragraph 7 of the Petition for Cancellation, FN Cellars lacks knowledge or information sufficient to form a belief as to the allegations contained therein, and therefore denies the same.

8. Answering paragraph 8 of the Petition for Cancellation, FN Cellars denies the allegations contained therein and specifically denies that its registered trademark, **BELLA UNION**, is highly similar to Petitioner's **UNION WINE CO.**, that the dominant portion of Registrant's mark is the term "Union," and that there is a likelihood of confusion.

9. Answering paragraph 9 of the Petition for Cancellation, FN Cellars denies the allegations therein.

10. Answering paragraph 10 of the Petition for Cancellation, FN Cellars denies the allegations therein.

11. Answering paragraph 11 of the Petition for Cancellation, FN Cellars denies the allegations therein.

12. Answering paragraph 12 of the Petition for Cancellation, FN Cellars denies the allegations therein.

AFFIRMATIVE DEFENSES

FN Cellars asserts the following affirmative defenses. By setting forth these affirmative defenses, FN Cellars does not assume the burden of proving any fact, issue, or element of a cause of action where such burden properly belongs to Petitioner. Moreover, nothing stated herein is intended or shall be construed as an acknowledgment that any particular issue or subject matter is relevant to Petitioner's allegations.

FIRST AFFIRMATIVE DEFENSE (Standing)

1. Petitioner lacks standing to oppose registration of the mark, because Petitioner does not have rights, superior or otherwise, sufficient to support the Petition for Cancellation, and because Petitioner has failed to allege how it would be damaged by the registration, as required by 15 U.S.C. §1064.

SECOND AFFIRMATIVE DEFENSE (Unclean Hands)

2. Petitioner's action is barred by the doctrine of unclean hands, including because Petitioner procured the UNION WINE CO. Registration through false statements made during prosecution regarding Petitioner's use of the mark as a trademark for the claimed goods.

THIRD AFFIRMATIVE DEFENSE (Failure to State a Claim)

3. Petitioner has failed to allege facts sufficient to establish any proper grounds for cancellation of the BELLA UNION Registration.

FOURTH AFFIRMATIVE DEFENSE
(Failure to Allege Fraud with Particularity)

4. Petitioner cites *Torres v. Cantine Torresella S.r.l.* fraud as a ground for cancellation of the BELLA UNION Registration, yet Petitioner has failed to allege fraud in particularity in accordance with Fed. R. Civ. P. 9(b).

FIFTH AFFIRMATIVE DEFENSE
(Additional Affirmative Defenses)

5. Registrant hereby gives notice that it intends to rely on additional affirmative defenses that become available or apparent during discovery and thus reserves the right to amend its answer to assert such affirmative defenses.

COUNTERCLAIM

1. Registrant is the owner of the trademark **BELLA UNION** and is the owner of the BELLA UNION Registration filed July 5, 2013 and registered October 7, 2014. Under 15 U.S.C. §1057(b), a certificate of registration of a trademark issued by the United States Trademark Office on the Principal Register is prima facie evidence of the validity of the registration and of the exclusive right to use the registered mark.

2. On information and belief, Petitioner is the owner of the UNION WINE CO. Registration for wines in International Class 033, registered on February 18, 2014, claiming a date of first use of November 28, 2012 and claiming a date of first use in interstate commerce of October 9, 2013.

3. Petitioner filed a Statement of Use in support of the UNION WINE CO. Registration on November 27, 2013 alleging that the mark was first used by the Petitioner, or the Petitioner's related company, licensee, or predecessor in interest, at least as early as November 28, 2012, and first used in commerce at least as early as October 9, 2013, and was then in use in such commerce.

4. Because Petitioner has petitioned to cancel the BELLA UNION Registration on the basis of likelihood of confusion with the UNION WINE CO. Registration, Registrant will be damaged by the continued registration of the UNION WINE CO. Registration.

5. On information and belief, Petitioner did not and does not use the mark UNION WINE CO. as a trademark identifying or distinguishing the goods claimed at registration, but merely uses the mark UNION WINE CO. as an identifier of a business entity. The specimen submitted to the United States Patent and Trademark Office in connection with the UNION WINE CO. Registration is attached to this petition (“Exhibit A”). The specimen shows the back of a wine label for the goods claimed - “Kings Ridge Pinot Noir” - and also shows the trade name serving to identify the Petitioner as a business entity. Further, attached hereto is the front label of the wine bottle for “Kings Ridge Pinot Noir” (“Exhibit B”), which does not include the designation UNION WINE CO. Accordingly, at all times prior to the statutory deadline allowed for demonstrating use, the designation UNION WINE CO. was used solely as a commercial name of a business entity, as defined in 15 U.S.C. §1127, and was not used as a trademark to identify or distinguish the goods claimed. *See* TMEP §1202 et seq.

FIRST GROUND FOR RELIEF

NON-USE

6. Registrant incorporates by reference paragraphs 1 through 5 of this Counterclaim, as if fully set forth herein.

7. Because UNION WINE CO. was not used by Petitioner as a trademark prior to the statutory deadline allowed for demonstrating use, it was not eligible for federal registration.

8. Accordingly, the UNION WINE CO. Registration should be declared void and must be cancelled in accordance with 15 U.S.C. §1064(3).

9. Based on the foregoing, Registrant has priority under federal trademark law.

SECOND GROUND FOR RELIEF

FRAUD

10. Registrant incorporates by reference paragraphs 1 through 5 of this Counterclaim, as if fully set forth herein.

11. On information and belief, Petitioner intended to deceive the U.S. Trademark Office by its statement in its Statement of Use for the UNION WINE CO. Registration that the mark was first used by the Petitioner, or the Petitioner's related company, licensee, or predecessor in interest, at least as early as November 28, 2012, and first used in commerce at least as early as October 9, 2013, and was then in use in such commerce, because Petitioner knew that it was not using the term **UNION WINE CO.** as a trademark to identify or distinguish the goods claimed in the UNION WINE CO. Registration at the time that Statement of Use was filed.

12. Accordingly, the UNION WINE CO. Registration should be declared void and must be cancelled in accordance with 15 U.S.C. §1064(3).

13. Based on the foregoing, Registrant has priority under federal trademark law.

PRAYER FOR RELIEF

WHEREFORE, this Respondent/Registrant, FN Cellars, LLC, prays that the Petition for Cancellation be dismissed with prejudice, that Petitioner Union Wine Co. be required to answer this Counterclaim, that this Counterclaim be sustained, and that U.S. Trademark Registration No. 4,486,053 for the mark UNION WINE CO. be cancelled.

Respectfully submitted,



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Date: March 23, 2015

Attorneys for Registrant/Respondent
FN Cellars, LLC

CERTIFICATE OF SERVICE

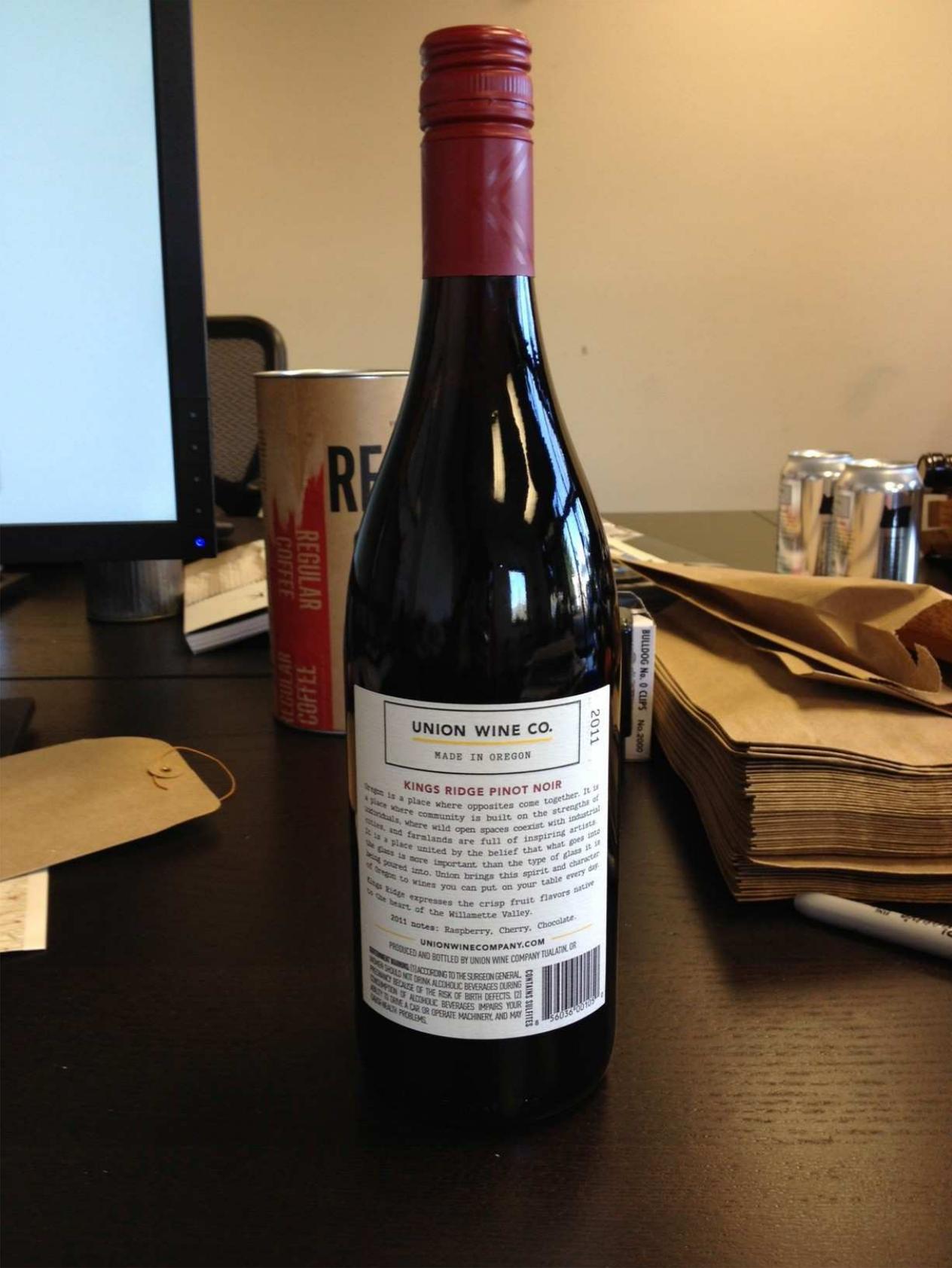
This is to certify that a true and correct copy of the foregoing document was sent via e-mail and was mailed, first class, postage prepaid on the 23rd day of March, 2015 to:

Paul W. Reidl
Law Office of Paul W. Reidl
241 Eagle Trace Drive, 2nd Floor
Half Moon Bay, California 94019

A handwritten signature in black ink, appearing to read 'Mark G. Kachigian', written over a horizontal line.

Mark G. Kachigian
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EXHIBIT A



UNION WINE CO. 2011
 MADE IN OREGON

KINGS RIDGE PINOT NOIR

Oregon is a place where opposites come together. It is a place where community is built on the strengths of mountains, where wild open spaces coexist with industrial cities, and farmlands are full of inspiring artists. It is a place united by the belief that what goes into the glass is more important than the type of glass it is being poured into. Union brings this spirit and character of Oregon to wines you can put on your table every day. Kings Ridge expresses the crisp fruit flavors native to the heart of the Willamette Valley.

2011 notes: Raspberry, Cherry, Chocolate.

UNIONWINECOMPANY.COM
 PRODUCED AND BOTTLED BY UNION WINE COMPANY TUALATIN, OR

DISCLAIMER: WARNING: (1) ACCORDING TO THE SURGEON GENERAL, WOMEN SHOULD NOT DRINK ALCOHOLIC BEVERAGES DURING PREGNANCY BECAUSE OF THE RISK OF BIRTH DEFECTS. (2) EXCESSIVE CONSUMPTION OF ALCOHOLIC BEVERAGES IMPAIRS YOUR ABILITY TO DRIVE A CAR OR OPERATE MACHINERY, AND MAY CAUSE HEALTH PROBLEMS.

CONTAINS SULFITES
 503670010101

EXHIBIT B



KINGS RIDGE
OREGON PINOT NOIR



2012

WILLAMETTE VALLEY GROWN
13% ALC./VOL. 750 ML.