

ESTTA Tracking number: **ESTTA688208**

Filing date: **08/06/2015**

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	Kore Wine Company		
Entity	LLC	Citizenship	Oregon
Address	541 N. 4th Street Carlton, OR 97111 UNITED STATES		

Name	Kore Wine Company		
Entity	LLC	Citizenship	Oregon
Address	541 N. 4th Street Carlton, OR 97111 UNITED STATES		

Attorney information	Melville Owen Owen, Wickersham & Erickson, P.C. 455 Market Street, Suite 1910 San Francisco, CA 94105 UNITED STATES mowen@owe.com, epoole@owe.com, bdunne@owe.com Phone:4158823200		
----------------------	---	--	--

**Registration Subject to Cancellation**

Registration No	2682282	Registration date	02/04/2003
International Registration No.	NONE	International Registration Date	NONE
Registrant	Lavinia Seleccion, Sociedad Anonima C/AZALEA 1, MINIPARC 1, EDIFICIO E SOTO DE LA MORALEGA (ALCOBENDAS,) MADIRD, 28109 SPAIN		

**Goods/Services Subject to Cancellation**

Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Alcoholic beverages, namely wines, champagne wines, sparkling wine, liqueurs, spirits, namely scotch, gin, whisky, vodka, rum, brandy, cordials
--

**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	Petition to Cancel-Lavinia.pdf(1295138 bytes )
-------------	--

---

---

## 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	/Melville Owen/
Name	Melville Owen
Date	08/06/2015

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

In re Registration of:

Registrant: Lavinia Seleccion, Sociedad Anonima  
Registration No.: 2,682,282  
Issued: February 4, 2003  
Mark: **LAVINIA**

KORE WINE COMPANY

Petitioner,

v.

LAVINIA SELECCION, SOCIEDAD  
ANONIMA

Registrant.

Cancellation No.

**PETITION FOR CANCELLATION**

Kore Wine Company, an Oregon limited liability company having a business address at 541 N. 4th Street, Carlton, OR 97111 (“Petitioner”) believes that it is and will continue to be damaged by Registration No. 2,682,282, owned by Lavinia Seleccion, Sociedad Anonima, a corporation organized under the laws of Spain (“Registrant”), and hereby petitions to cancel said registration in its entirety.

As grounds for cancellation, Petitioner alleges upon information and belief:

1. Petitioner is engaged in the business of making and selling wine.
2. On October 6, 2014, Petitioner filed an intent to use application for the mark LAVINEA for “wine” in International Class 33 and was assigned application Serial No.

86/416093.

3. On February 2, 2015, Petitioner received an office action refusing registration of its LAVINEA mark based on Section 2(d) confusing similarity with Registration No. 2,682,282 for LAVINIA.

4. Registrant is the owner of Registration No. 2,682,282 for LAVINIA for “alcoholic beverages, namely wines, champagne wines, sparkling wine, liqueurs, spirits, namely scotch, gin, whisky, vodka, rum, brandy, cordials” in International Class 33. Registrant’s application to register LAVINIA was based initially on a bona fide intent to use the mark in U.S. commerce with a Section 44(d) claim of priority. The application thus did not include an assertion of use in U.S. commerce.

5. Upon information and belief, when Registrant filed its application to register the LAVINIA mark, Registrant was not using the mark in U.S. commerce and lacked a bona fide intent to use the mark in U.S. commerce on the goods recited in its application for registration.

6. Petitioner conducted an investigation into the alleged use of the LAVINIA mark by Registrant and Registrant’s related business activity by means of Internet research. Petitioner located Registrant’s company website, which describes LAVINIA as a wine store and provides a catalog of the wine and other alcoholic beverages Registrant sells and offers for sale.

7. Upon information and belief and based on Petitioner’s research, Registrant sells and offers for sale the wine, champagne, and spirits of others, but Registrant does not sell or offer for sale any alcoholic beverages branded with the LAVINIA mark.

8. Upon information and belief, Registrant does not use, and has never used, the

LAVINIA mark on alcoholic beverages, but instead uses LAVINIA in connection with retail store services for the same.

9. According to Registrant's company website, Registrant operates LAVINIA retail stores in Spain, France, Switzerland, and the Ukraine, but does not have a retail store in the United States.

10. Upon information and belief, Registrant's company website targets consumers from Spain, Switzerland, and France (the website is available in Spanish for users from Spain and in French for users from Switzerland and France), but Registrant's company website does not target consumers in the United States and is not even accessible in English. Although European consumers can purchase alcoholic beverages from Registrant's company website, upon information and belief, consumers in the United States cannot.

11. Upon information and belief, Registrant does not use its LAVINIA mark in any fashion in U.S. commerce, as all of its retail stores are in Europe and its company website does not allow for sales to U.S. consumers and does not even target U.S. consumers.

12. On June 3, 2009, Registrant filed with the United States Patent and Trademark Office (USPTO) a Combined Declaration of Use and Incontestability under Section 8 & 15 (the "2009 Declaration"), which contained the following material allegations: "For International Class 33, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class" (bold language in original).

13. Registrant's 2009 Declaration was accompanied by specimens of use consisting of photographs of 1) a bottle of CHATEAU LA GALIANE wine beside a box with "LAVINIA" printed on the top of the box; 2) a bottle of JACQUESSON champagne packed inside a box with a champagne glass; 3) two boxes wrapped with paper and ribbon, with "LAVINIA" printed on the paper and ribbon; and 4) three bags with "LAVINIA Barcelona · Geneve · Kiev · Madrid · Paris" printed on their sides. Attached hereto as Exhibit A is a true and correct copy of Registrant's 2009 Declaration, as obtained through the USPTO TSDR Portal.

14. On October 5, 2009, the USPTO accepted Registrant's 2009 Declaration.

15. Upon information and belief, when Registrant filed the 2009 Declaration, Registrant 1) was not using, and had never used, the LAVINIA mark in U.S. commerce and 2) was not using, and had never used, the LAVINIA mark on the goods recited in the existing registration for the mark.

16. Furthermore, the specimens submitted with the 2009 Declaration do not support a finding that Registrant used the LAVINIA mark on goods in International Class 33. The photographs supplied by Registrant do not show the LAVINIA mark used on alcoholic beverages; rather, they show the mark used in connection with alcoholic beverage retail store services, and the marks CHATEAU LA GALIANE and JACQUESSON used on alcoholic beverages.

17. On January 25, 2013, Registrant filed a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of Registration of a Mark under Section 8 & 9 (the "2013 Declaration"), in which Registrant again alleged use of the LAVINIA mark in U.S. commerce on all of the goods recited in the existing registration for the mark.

18. Registrant's 2013 Declaration was accompanied by specimens of use consisting of 1) a page from a LAVINIA catalog depicting an image, description, and price of a bottle of HERMITAGE wine; and 2) an image of three bags with "LAVINIA Barcelona · Geneve · Kiev · Madrid · Paris" printed on their sides (the same image submitted with the 2009 Declaration). Attached hereto as Exhibit B is a true and correct copy of Registrant's 2013 Declaration and specimens, as obtained through the USPTO TSDR Portal.

19. On February 13, 2013, the USPTO accepted Registrant's 2013 Declaration.

20. Upon information and belief, when Registrant filed the 2013 Declaration, Registrant 1) was not using, and had never used, the LAVINIA mark in U.S. commerce, and 2) was not using, and had never used, the LAVINIA mark on the goods recited in the existing registration for the mark.

21. Furthermore, the specimens submitted with the 2013 Declaration do not support a finding that Registrant used the LAVINIA mark on goods in International Class 33. The specimens do not show the LAVINIA mark used on alcoholic beverages; rather, they show the mark used in connection with alcoholic beverage retail store services, and the mark HERMITAGE used on alcoholic beverages.

**First Basis for Cancellation – Void *ab initio***

22. Upon information and belief, when Registrant signed and filed the application to register LAVINIA in 2003, Registrant did not have a bona fide intent to use the mark LAVINIA in U.S. commerce or on any of the goods included in the application. Upon information and belief, if Registrant had any intent to use the LAVINIA mark in U.S. commerce, it was only in connection with alcoholic beverage retail store services.

23. Upon information and belief, the registration for LAVINIA is void *ab initio*

because Registrant lacked a bona fide intent to use the mark in U.S. commerce on the applied-for goods at the time it filed the application for registration.

### **Second Basis for Cancellation – Abandonment**

24. Registrant claims to have used the LAVINIA mark in U.S. commerce on all of the goods recited in the corresponding registration since at least 2003. Upon information and belief, Registrant 1) is not using, and has never used, the LAVINIA mark in U.S. commerce; 2) is not using, and has never used, the LAVINIA mark on any of the goods recited in the registration for LAVINIA; and 3) has no intent to use the mark in U.S. commerce or on any of the goods recited in the registration.

25. Upon information and belief, Registrant has abandoned any rights in the LAVINIA mark.

### **Third Basis for Cancellation – Fraud**

26. Upon information and belief, when Registrant signed and filed the application to register LAVINIA in 2003, Registrant did not have a bona fide intent to use the mark LAVINIA in U.S. commerce or on any of the goods recited in the application, and Registrant's allegations of a bona fide intent to use the mark in U.S. commerce on "alcoholic beverages, namely wines, champagne wines, sparkling wine, liqueurs, spirits, namely scotch, gin, whisky, vodka, rum, brandy, cordials" were fraudulent allegations made with the intent of deceiving the USPTO into issuing a registration that should have never issued for lack of Registrant's bona fide intent to use the mark.

27. Upon information and belief, when Registrant filed the required 2009 Declaration, Registrant was not using the LAVINIA mark in U.S. commerce and was not using the mark on alcoholic beverages, and the allegations of use set forth in the 2009

Declaration were fraudulent allegations made with the intent of deceiving the USPTO into maintaining the registration when the registration should properly have been cancelled for non-use of the mark.

28. Upon information and belief, at the time Registrant filed the required 2013 Declaration, Registrant was not using the LAVINIA mark in U.S. commerce and was not using the mark on alcoholic beverages, and the allegations of use set forth in the 2013 Declaration were fraudulent allegations made with the intent of deceiving the USPTO into maintaining the registration when the registration should properly have been cancelled for non-use of the mark.

29. The purpose of Section 8 of the Trademark Act is to remove from the register those registrations which have become deadwood. T.M.E.P. § 1604.11; *see also Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969).

30. Upon information and belief, Registrant's allegations of use in the 2009 Declaration and 2013 Declaration were false, and allowing Registrant's LAVINIA registration to remain on the register, when it has never been used in U.S. commerce or on any of the goods recited in the registration, would be allowing deadwood to remain on the register.

31. Petitioner is and will continue to be injured and damaged by the existence of Registration No. 2,682,282 because it prevents Petitioner from obtaining its own registration, as Registrant's registration is an impediment to Petitioner's ability to federally register Petitioner's mark.

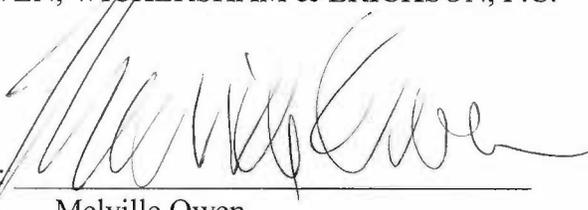
WHEREFORE, Petitioner prays that Registration No. 2,682,282 be canceled in its entirety and that this Petition for Cancellation be sustained in favor of Petitioner.

Respectfully submitted,

OWEN, WICKERSHAM & ERICKSON, P.C.

Dated: August 6, 2015

By:



Melville Owen  
Emily Poole

Attorneys for Petitioner,  
KORE WINE COMPANY

455 Market Street, 19th Floor  
San Francisco, CA 94105  
Phone: (415) 882-3200  
Fax: (415) 882-3232  
E-mail: [mowen@owe.com](mailto:mowen@owe.com)  
[epoole@owe.com](mailto:epoole@owe.com)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the Petition for Cancellation was sent to Registrant and counsel for Registrant by first class mail, postage prepaid, to the following addresses:

Lavinia Seleccion, Sociedad Anonima  
C/Azalea 1, Miniparc 1, Edificio E  
Soto De La Moralega (Alcobendas)  
Madrid 28109  
Spain

Lynn A. Sullivan  
Leydig Voit & Mayer, Ltd.  
Two Prudential Plaza  
180 N. Stetson, Suite 4900  
Chicago, IL 60601

DATED: August 6, 2015

  
B.C. Dunne

# **Exhibit A**

**Combined Declaration of Use and Incontestability under Sections 8 & 15  
To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 2682282

**REGISTRATION DATE:** 02/04/2003

**MARK:** LAVINIA

The owner, Lavinia Seleccion, Sociedad Anonima, having an address of  
C/Azalea 1, Miniparc 1, Edificio E  
Soto de la Moraleja (Alcobendas,) Madrid, 28109  
ES

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 033, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one specimen for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) packaging for the products.

[Specimen File 1](#)

[Specimen File 2](#)

The registrant hereby appoints Lynn A. Sullivan and Michelle L. Calkins of Leydig Voit & Mayer, Ltd.  
Suite 4900  
Two Prudential Plaza, 180 N. Stetson  
Chicago, Illinois 60601  
United States

to file this Combined Declaration of Use and Incontestability under Sections 8 & 15 on behalf of the registrant. The attorney docket/reference number is 266855.

The registrant hereby appoints Lynn A. Sullivan, having an address of  
Suite 4900  
Two Prudential Plaza, 180 N. Stetson  
Chicago, Illinois 60601  
United States

as registrant's representative upon whom notice or process in the proceedings affecting the mark may be served.

A fee payment in the amount of \$400 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

### **Declaration**

*The mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce. There has been no final decision adverse to the owner's claim of ownership of such mark, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the U.S. Patent and Trademark Office or in the courts.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

Signature: /Lynn A. Sullivan/     Date: 06/03/2009  
Signatory's Name: Lynn A. Sullivan  
Signatory's Position: Attorney of record, Illinois bar

**Mailing Address (current):**  
ALTERA LAW GROUP, LLC  
6500 CITY WEST PARKWAY  
MINNEAPOLIS, Minnesota 55344-0523

**Mailing Address (proposed):**  
Leydig Voit & Mayer, Ltd.  
Two Prudential Plaza, 180 N. Stetson  
Chicago, Illinois 60601

Serial Number: 76097743  
Internet Transmission Date: Wed Jun 03 13:55:44 EDT 2009  
TEAS Stamp: USPTO/S08N15-38.98.140.130-2009060313554  
4904602-2682282-4404cd0ed87ac3c3713accff  
573d3cbe67d-DA-175-20090603134343238034

LAVINIA, notre collection cadeaux

LAVINIA



Signature Lavinia Signature Lavinia





LAVINIA

BORIS  
Aida, Drogaria, 2011  
Tel: 91 3  
CASA  
A la rue de Courbe  
Tel: 01 47 37 11 11  
43  
Diplôme d'Etat  
Paris, 13ème  
Tel: 01 47 37 11 11  
44  
13 Boulevard de la Chapelle  
Tel: 01 47 37 11 11  
www.lavinia.com

Barcelona • Genève • Kiev • Madrid • Paris

Barcelona • Genève • Kiev • Madrid • Paris

[www.lavinia.com](http://www.lavinia.com)

# **Exhibit B**

**Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of  
Registration of a Mark under Sections 8 & 9  
To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 2682282

**REGISTRATION DATE:** 02/04/2003

**MARK:** LAVINIA

The owner, Lavinia Seleccion, Sociedad Anonima, a corporation of Spain, having an address of  
C/AZALEA 1, MINIPARC 1, EDIFICIO E  
SOTO DE LA MORALEGA (ALCOBENDAS,) MADIRD, 28109  
Spain

is filing a Combined Declaration of Use and/or Excusable Nonuse/Application for Renewal of  
Registration of a Mark under Sections 8 & 9.

For International Class 033, the mark is in use in commerce on or in connection with **all** goods/services, or  
to indicate membership in the collective membership organization, listed in the existing registration for  
this specific class: Alcoholic beverages, namely wines, champagne wines, sparkling wine, liqueurs, spirits,  
namely scotch, gin, whisky, vodka, rum, brandy, cordials ; or, the owner is making the listed excusable  
nonuse claim.

The owner is submitting one(or more) specimen(s) showing the mark as used in commerce on or in  
connection with any item in this class, consisting of a(n) catalog pages showing product and pricing;  
packaging for the product.

[Specimen File 1](#)

[Specimen File 2](#)

The registrant's current Attorney Information: Lynn A. Sullivan of LEYDIG VOIT & MAYER, LTD.  
TWO PRUDENTIAL PLAZA, 180 N. STETSON  
SUITE 4900  
CHICAGO, Illinois (IL) 60601  
United States

The registrant's proposed Attorney Information: Lynn A. Sullivan of LEYDIG VOIT & MAYER, LTD.  
TWO PRUDENTIAL PLAZA, 180 N. STETSON  
SUITE 4900  
CHICAGO, Illinois (IL) 60601  
United States

The docket/reference number is 266855.

The Other Appointed Attorney(s): Michelle L. Zimmermann, Anne E. Naffziger.

The phone number is 312-616-5600.

The fax number is 312-616-5700.

The email address is trademark@leydig.com.

The registrant's current Correspondence Information: LYNN A. SULLIVAN of LEYDIG VOIT & MAYER, LTD.

TWO PRUDENTIAL PLAZA, 180 N. STETSON  
SUITE 4900  
CHICAGO, Illinois (IL) 60601  
United States

The registrant's proposed Correspondence Information: LYNN A. SULLIVAN of LEYDIG VOIT & MAYER, LTD.

TWO PRUDENTIAL PLAZA, 180 N. STETSON  
SUITE 4900  
CHICAGO, Illinois (IL) 60601  
United States

The docket/reference number is 266855.

The phone number is 312-616-5600.

The fax number is 312-616-5700.

The email address is trademark@leydig.com.

The registrant hereby appoints Lynn A. Sullivan, TWO PRUDENTIAL PLAZA, 180 N. STETSON, SUITE 4900, CHICAGO, Illinois (IL) United States (USX) 60601 as registrant's representative upon whom notice or process in the proceedings affecting the mark may be served.

The phone number is 312-616-5600.

The fax number is 312-616-5700.

The email address is trademark@leydig.com.

A fee payment in the amount of \$500 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

### **Declaration**

#### **Section 8: Declaration of Use and/or Excusable Nonuse in Commerce**

*Unless the owner has specifically claimed excusable nonuse, the mark is in use in commerce on or in connection with the goods and/or services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce.*

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like

may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

**Section 9: Application for Renewal**

*The registrant requests that the registration be renewed for the goods/services/collective organization identified above.*

Signature: /Lynn A. Sullivan/ Date: 01/25/2013  
Signatory's Name: Lynn A. Sullivan  
Signatory's Position: Attorney of record, Illinois bar  
Signatory's Phone Number: 312-616-5652

Mailing Address (**current**):  
LEYDIG VOIT & MAYER, LTD.  
SUITE 4900  
CHICAGO, Illinois 60601

Mailing Address (**proposed**):  
LEYDIG VOIT & MAYER, LTD.  
SUITE 4900  
CHICAGO, Illinois 60601

Serial Number: 76097743  
Internet Transmission Date: Fri Jan 25 13:35:17 EST 2013  
TEAS Stamp: USPTO/S08N09-38.98.140.130-2013012513351  
7678203-2682282-4903940764d9cb5c98894ecd  
8eb67f0d6-DA-11718-20130125131539024984





[www.lavinia.com](http://www.lavinia.com)