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

Proceeding	92062372
Party	Defendant Vinocopia, Inc.
Correspondence Address	DUSTIN R DUFAULT DUFAULT LAW FIRM PC PO BOX 1219 MINNETONKA, MN 55345 UNITED STATES DDuFault@DuFault-Law.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Dustin R. DuFault
Filer's e-mail	DDuFault@DuFault-Law.com
Signature	/drd/
Date	05/13/2016
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**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

BEARCO, LLC,)	
)	
v.)	Cancellation No.: 92/062,372
)	
Vinocopia, Inc.,)	Reg. No.: 4,262,446
)	Mark: CAPRICCIO
Registrant.)	

MOTION TO SUSPEND PROCEEDINGS

In accordance with TBMP 510.02(a), Registrant, by and through its attorneys, hereby moves for an order suspending the above referenced proceeding pending disposition of a civil action captioned *Vinocopia, Inc. v. Bearco, LLC and Caribbean Distillers, LLC*, filed by Registrant against, *inter alia*, Petitioner in U.S. District Court, District of Minnesota, and given Case No. 0:16-cv-1149. Said civil action involves issues in common with those in the above-identified proceeding presently before the Board, which may have a bearing on the same. A copy of the Complaint as filed is attached herewith. Presently, no Answer has been filed.

Registrant requested consent from petitioner to file this motion, but none was forthcoming. Upon final determination of the aforementioned civil action, the Board will be promptly notified in writing as to the outcome of that proceeding such that further appropriate action can be taken in this cancellation proceeding.

Respectfully Submitted,
DuFAULT LAW FIRM, P.C.

Date: May 13, 2016

s/Dustin R. DuFault/
DuFault Law Firm, P.C.
PO Box 1219
Minnetonka MN 55345
Ph: (952) 935-4392
Fax: (866) 936-4542
DDuFault@DuFault-Law.com
ATTORNEY FOR REGISTRANT
Vinocopia, Inc.

CERTIFICATE OF SERVICE

I, Dustin DuFault, attorney for Registrant, certify that on this day, I served MOTION TO SUSPEND PROCEEDINGS by email, having obtained prior written agreement, to the following.

Ms. Cristina Arenas Solís (carenas@ferraiuoli.com)
Mr. Germán Corcino Medina (gcorcino@ferraiuoli.com)
Mr. Jean G. Vidal (jvidal@ferraiuoli.com)
FERRAIUOLI LLC
221 Plaza, 5th Floor
221 Ponce de León Avenue
San Juan, PR 00917

Dated: May 13, 2016

/s/Dustin R. DuFault
Dustin R. DuFault
DuFault Law Firm, P.C.
PO Box 1219
Minnetonka, MN 55345
DDuFault@DuFault-law.com
(952) 935-4392

Vinocopia's CAPRICCIO trademark as used generally in connection with wine or wine-related products. Upon information and belief, Defendants have and continue to engage in using the confusingly similar mark CAPRICCIO to promote substantially similar, if not virtually identical, goods, including wine and sangria (a wine product). This practice by Defendants infringes upon Vinocopia's trademark and constitutes trademark infringement, deceptive trade practices and unfair competition.

3. This action seeks permanent injunctive relief and damages against Defendants' willful infringement of Vinocopia's federally and state protected rights in violation of the Lanham Act and the Minnesota Deceptive Trade Practices Act.

THE PARTIES

4. Plaintiff Vinocopia is a Minnesota corporation with its registered office and principal place of business located at 6636 Cedar Avenue South, Suite 300, Richfield, Minnesota, 55423. Vinocopia is generally engaged in providing, *inter alia*, importation and distribution of wine within Minnesota, and throughout the United States.

5. Upon information and belief, Defendant Bearco is a Limited Liability Company organized under the laws of Puerto Rico, with its principal place of business located at PR 174 Street, Minillas Industrial Park 107, Bayamón, Puerto Rico, 00959. Upon further information and belief, Defendant Bearco is

engaged in producing, bottling and distributing alcoholic beverages, including wine products offered for sale and sold within the State of Minnesota.

6. Upon information and belief, Defendant Caribbean is a Limited Liability Company organized under the laws of the State of Florida, with its principal place of business located at 220 Alhambra Circle, #304, Coral Gables, Florida, 33134. Upon further information and belief, Defendant Caribbean is engaged in the importation and distribution of alcoholic beverages, including wine products sold within the State of Minnesota.

JURISDICTION AND VENUE

7. This is a civil action at law and in equity for trademark infringement and unfair competition arising under the Acts of Congress relating to trademarks, namely, the Lanham Act, 15 U.S.C. § 1051 *ET. SEQ.*, and particularly 15 U.S.C. § 1125(a) and common law, as well as Minnesota's Deceptive Trade Practices Act (Minn. Stat. §325D.44).

8. This court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338, 1367 and 15 U.S.C. § 1121.

9. This court has personal jurisdiction over Defendants Bearco and Caribbean because both have engaged in acts or omissions within this State and District that are causing injury to Vinocopia.

10. Venue is proper in the District of Minnesota because Plaintiff's claims arise in this jurisdiction, the complained of products of

Defendant Bearco are sold here, and both Vinocopia and Defendant Caribbean does business in this judicial district.

BACKGROUND

11. Since at least as early as 2009, Plaintiff Vinocopia has used its CAPRICCIO mark in commerce in connection with wine. Vinocopia is the owner of U.S. Trademark Registration No. 4,262,446, which issued on December 18, 2012 (hereinafter “**the ‘446 Registration’**”). Attached herewith as Exhibit A is a true and correct copy of the ‘446 Registration.

12. Plaintiff Vinocopia’s CAPRICCIO mark is a distinctive indicator of the origin of Vinocopia’s goods and is associated by the public and the trade exclusively with Vinocopia in each of the geographic markets in which Vinocopia uses its CAPRICCIO mark.

13. Upon information and belief, Defendants produce, promote, distribute, offer for sale or sell wine products bearing a confusingly similar CAPRICCIO mark (hereinafter the “**imitation mark**”).

14. Upon information and belief, Defendant Bearco is the owner of U.S. Trademark Application Serial Number 86/479,401, an Intent-To-Use application filed on December 12, 2014, to register the mark CAPRICCIO BUBBLY SANGRRIA (*sic*) within the U.S. Patent & Trademark Office for sangria (a wine product) (hereinafter the “**401 application**”).

15. Upon information and belief, Defendant Bearco is the owner of U.S. Trademark Application Serial Number 86/665,899, filed on June 17, 2015,

to register the mark CAPRICCIO within the U.S. Patent & Trademark Office for wine (hereinafter, the “**’899 application**”).

16. The goods and services set forth in the aforementioned ’401 application and ’899 application are identical or closely related to the goods and services offered by Vinocopia in connection with its CAPRICCIO trademark.

17. Upon information and belief, prior to Vinocopia’s use of its CAPRICCIO mark within each of the geographic markets Vinocopia has continuously used its CAPRICCIO mark, neither Defendant produced, promoted, distributed, offered for sale or sold within those same geographic markets any wine or wine-related products bearing their imitation mark.

18. Upon information and belief, prior to Vinocopia’s use of its CAPRICCIO mark within the State of Minnesota, neither Defendant produced, promoted, distributed, offered for sale or sold within the State of Minnesota wine or wine-related products bearing their imitation mark.

19. Upon information and belief, Defendants now produce, promote, distribute, offer for sale and sell wine or wine-related products bearing the imitation mark in similar geographical markets, including Minnesota, where Plaintiff Vinocopia uses its CAPRICCIO mark.

20. Plaintiff Vinocopia’s use of its CAPRICCIO mark within these geographical markets within the United States in interstate commerce, including Minnesota, preceded any of Defendants’ use of their imitation mark in those same geographical markets. Because Vinocopia has an earlier date of use

within these geographical markets, Vinocopia has priority of use within those same geographical markets.

21. Upon information and belief, at the time of Defendants' selection, adoption and use of the confusingly similar imitation mark in the geographical markets where Vinocopia has priority of use, Defendants were aware of such use but proceeded using their imitation mark on similar goods nonetheless.

COUNT I
FEDERAL UNFAIR COMPETITION

22. Plaintiff Vinocopia repeats and incorporates by reference the allegations of paragraphs 1 – 21 as if set forth in full herein.

23. Count I arises under Section 43(a) of the Federal Trademark Act of 1946 as amended (15 U.S.C. §1125(a)).

24. Defendants' use of the imitation CAPRICCIO mark in the geographic markets in which Vinocopia enjoys prior, continuous, and good-faith use of Vinocopia's CAPRICCIO mark is likely to cause confusion, deception, and mistake in those markets by creating the false and misleading impression that Defendants' goods are affiliated, connected, or associated with Vinocopia or have the sponsorship, endorsement, or approval of Vinocopia.

25. Defendants' activities constitute false representations, false descriptions, and false designations of origin of Vinocopia's goods in violation of 15 U.S.C. § 1125(a) that are causing and, unless enjoined by this Court, will

continue to cause a likelihood of confusion and deception and injury to Vinocopia's good will and reputation as symbolized by its mark and registration, for which Vinocopia has no adequate remedy at law.

26. Defendants' actions in the geographic markets in which Vinocopia enjoys the prior, continuous, and good-faith use of the CAPRICCIO mark demonstrate an intentional, willful, and bad-faith intent to trade on the good will associated with Vinocopia's CAPRICCIO mark to the irreparable injury of Vinocopia.

27. Defendants' activities in the geographic markets in which Vinocopia enjoys the prior, continuous, and good-faith use of the CAPRICCIO mark are causing, and are likely to cause, substantial injury to the public and Vinocopia, and Vinocopia is entitled to injunctive relief in those markets.

COUNT II
FEDERAL COMMON-LAW UNFAIR COMPETITION

28. Plaintiff Vinocopia repeats and incorporates by reference the allegations of paragraphs 1 – 21 as if set forth in full herein.

29. Defendants' use of their imitation marks in connection with wine or wine products in geographic markets in which Vinocopia enjoys the prior, continuous, and good-faith use of the CAPRICCIO mark is causing and is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendants' goods are affiliated, connected, or associated with

Vinocopia or have the sponsorship, endorsement, or approval of Vinocopia.

30. Defendants' activities in the geographic markets in which Vinocopia enjoys the prior, continuous, and good-faith use of the CAPRICCIO mark constitute false representations, false descriptions, and false designations of origin of Defendants' goods that are causing, and unless enjoined by this Court, will continue to cause a likelihood of confusion and deception and injury to Vinocopia's good will and reputation as symbolized by the CAPRICCIO mark, for which Vinocopia has no adequate remedy at law.

31. Defendants' activities in the geographic markets in which Vinocopia enjoys the prior, continuous, and good-faith use of the CAPRICCIO mark demonstrate an intentional, willful, and bad-faith intent to trade on the good will associated with Vinocopia's CAPRICCIO mark to the irreparable injury of Vinocopia.

32. Defendants' activities in the geographic markets in which Vinocopia enjoys the prior, continuous, and good-faith use of the CAPRICCIO mark are causing, and are likely to cause, substantial injury to the public and Vinocopia, and Vinocopia is entitled to injunctive relief in those markets.

COUNT III
DECEPTIVE TRADE PRACTICES UNDER MINNESOTA LAW

33. Plaintiff Vinocopia repeats and incorporates by reference the allegations of paragraphs 1 – 21 as if set forth in full herein.

34. Count III arises under Minnesota Statute section 325D.44 of the Minnesota Uniform Deceptive Trade Practices Act.

35. Plaintiff Vinocopia has used its CAPRICCIO mark to distinguish Plaintiff's goods from all other similar goods in the State of Minnesota, and Plaintiff has acquired good will through its prior, continuous use of the aforementioned mark.

36. Plaintiff Vinocopia's use of its CAPRICCIO mark has acquired secondary meaning with the pertinent public in Minnesota indicating Plaintiff as the source of its goods.

37. Defendants' use of the imitation CAPRICCIO mark within Minnesota where Vinocopia enjoys prior, continuous, and good-faith use of the its CAPRICCIO mark is likely to cause confusion, deception, and mistake by creating the false and misleading impression that Defendants' goods are affiliated, connected, or associated with Vinocopia or have the sponsorship, endorsement, or approval of Vinocopia.

38. Defendants' use of the imitation mark within the state of Minnesota constitutes acts in violation of Minn. Stat. § 325D.44 in that such use is likely to cause confusion, misunderstanding, cause mistake or deceive as to affiliation, connection or association of Defendants Plaintiff Vinocopia.

39. Defendants' use of the imitation mark falsely attributes Plaintiff as the origin, sponsorship or approval of the Defendants' products or services, and falsely represents that the Defendants' products are provided by,

marketed by, sponsored by, approved of or licensed by Plaintiff Vinocopia.

40. As a proximate result of the Defendants' acts, Plaintiff Vinocopia has suffered detriment to its business, goodwill, reputation and profits, all to its damage in an amount as yet not fully ascertained.

COUNT IV
UNFAIR COMPETITION UNDER MINNESOTA COMMON LAW

41. Plaintiff Vinocopia repeats and incorporates by reference the allegations in paragraphs 1 – 21 as if set forth in full herein.

42. The above acts by Defendants constitute unfair competition and unfair business practices under Minnesota common law.

43. The conduct of Defendants alleged herein has damaged and continues to damage Plaintiff Vinocopia in an amount to be ascertained at trial, and will, unless permanently restrained and enjoined, further impair if not destroy the value of Plaintiff Vinocopia's CAPRICCIO trademark, as well as Plaintiff's business reputation and goodwill, and Plaintiff has no adequate remedy at law.

44. Plaintiff Vinocopia is entitled to monetary damages and injunctive relief prohibiting Defendants from using the imitation marks. Without permanent injunctive relief, Plaintiff has no means by which to control the continuing injury to its reputation and goodwill. Plaintiff has been and will continue to be irreparably harmed.

45. Plaintiff Vinocopia is entitled to recover all damages

proximately caused by Defendants' willful unfair competition and unfair business practices.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff Vinocopia prays for the following relief:

1. That Defendants and all their agents, officers, employees, representatives, successors, assigns, attorneys, and all other persons acting for, with, by, through, or under authority from either Defendant, or in concert or participation with either Defendant, and each of them, be enjoined in any geographic market in which Plaintiff Vinocopia enjoys the prior, continuous, and good-faith use of its CAPRICCIO mark from:

- a. using the term CAPRICCIO, or any copy, reproduction, colorable imitation, or simulation thereof in connection with Defendants' products;
- b. using any trademark, service mark, name, logo, or source designation of any kind on or in connection with wine, wine products, or alcoholic beverages, that is a copy, reproduction, colorable imitation, or simulation of or confusingly similar to the trademark, service marks, names, or logos, of Plaintiff Vinocopia, or is likely to cause confusion, mistake, deception, or public misunderstanding that Defendants' goods are those of Vinocopia, or are sponsored by or in any way related to Vinocopia; and

c. passing off, palming off, or assisting in passing off or palming off, Defendants' goods as those of Vinocopia, or otherwise continuing any and all acts of infringement or unfair competition.

2. That, with respect to any geographic market in which Vinocopia enjoys the prior, continuous, and good-faith use of its CAPRICCIO mark, Defendants be ordered to deliver up for destruction all advertising material, promotional material or the like in the possession, custody, or control of Defendants that are found to feature confusingly similar imitations of Vinocopia's CAPRICCIO mark or that otherwise unfairly compete with Vinocopia and its goods.

3. That the U.S. Patent and Trademark Office be ordered to issue concurrent use registrations of the parties' respective marks that reflect the geographic markets in which each party has priority of rights.

4. That this Court pursuant to 15 U.S.C. § 1117 order Defendants to account to Plaintiff Vinocopia for any and all profits derived from the sale of goods or services, and for all damages sustained by Plaintiff Vinocopia by reason of trademark infringement complained of herein.

5. That this Court pursuant to 15 U.S.C. § 1117 award Plaintiff Vinocopia the amount of actual damages suffered by Plaintiff Vinocopia, and that that amount be trebled.

6. That the costs of this action be awarded to Plaintiff Vinocopia in that this is an exceptional case and that Plaintiff Vinocopia be awarded its reasonable

attorneys' fees.

7. That Vinocopia have such other and further relief as the Court may deem just.

Respectfully submitted,

Vinocopia, Inc.

Dated: May 2, 2016

By: /s/Dustin R. DuFault
Dustin R. DuFault (No. 302,776)
DuFault Law Firm, P.C.
PO Box 1219
Minnetonka, Minnesota 55345
Tel: (952) 935-4392
Fax: (866) 936-4542
DDuFault@DuFault-Law.com

ATTORNEY FOR PLAINTIFF
Vinocopia, Inc.

United States of America
United States Patent and Trademark Office

CAPRICCIO

Reg. No. 4,262,446

Registered Dec. 18, 2012

Int. Cl.: 33

TRADEMARK

PRINCIPAL REGISTER

VINOCOPIA, INC. (MINNESOTA CORPORATION)
SUITE300
6636 CEDAR AVE SO
RICHFIELD, MN 55423

FOR: WINE, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 8-16-2012; IN COMMERCE 8-16-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

THE ENGLISH TRANSLATION OF "CAPRICCIO" IN THE MARK IS "CAPRICE".

SN 85-481,666, FILED 11-28-2011.

DAWN HAN, EXAMINING ATTORNEY



David J. Kyjars

Director of the United States Patent and Trademark Office