

ESTTA Tracking number: **ESTTA714821**

Filing date: **12/15/2015**

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 party requests to cancel indicated registration.

**Petitioner Information**

Name	Alto de Casablanca S.A.		
Entity	Corporation	Citizenship	Chile
Address	Casilla 122 Casablanca, CHILE		

Attorney information	Jennifer Lee Taylor Morrison & Foerster LLP 425 Market Street San Francisco, CA 94105 UNITED STATES jtaylor@mofo.com, slarson@mofo.com, aphillips@mofo.com, ggabriel@mofo.com, tmdocket@mofo.com		
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**Registration Subject to Cancellation**

Registration No	4114667	Registration date	03/20/2012
Registrant	Celasso, Arturo Carlos Boulogne Sur Mer 3002 Godoy Cruz Mendoza, 5505 ARGENTINA		

**Goods/Services Subject to Cancellation**

Class 033. First Use: 2006/01/01 First Use In Commerce: 2006/01/01 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.	2127379	Application Date	02/03/1997
Registration Date	01/06/1998	Foreign Priority Date	NONE
Word Mark	VERAMONTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1996/09/04 First Use In Commerce: 1996/09/04		

	wine
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Attachments	Alto de Casablanca, S.A. v. Arturo Carlos Celasso - Petition for Cancellation.pdf(231966 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	/Jennifer Lee Taylor/
Name	Jennifer Lee Taylor
Date	12/15/2015

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

ALTO DE CASABLANCA, S.A., Petitioner,	Cancellation No.:	To be assigned
vs.	Registration No.:	4,114,667
ARTURO CARLOS CELASSO, Respondent.	Issued:	March 20, 2012
	Mark:	VIAMONTE

**PETITION FOR CANCELLATION**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Alto de Casablanca S.A. (“Petitioner”), a corporation incorporated under the laws of Chile with offices at Casilla 122, Casablanca, Chile, believes that it is and will continue to be injured by Registration No. 4,114,667, and hereby petitions to cancel the same.

To the best of Petitioner’s knowledge, the name and address of the current owner of the registration is Arturo Carlos Celasso (“Respondent”), located at Boulogne Sur Mer 3002, Godoy Cruz, Mendoza, Argentina 5505.

The grounds for cancellation are as follows:

1. Petitioner is in the business of producing and selling wine. Petitioner produces a well-known and critically acclaimed wine that is offered under the VERAMONTE mark. Petitioner has gained a reputation for quality for its wines offered under the VERAMONTE mark.

2. Petitioner is the owner of U.S. Registration No. 2,127,379 for VERAMONTE for “wine” in International Class 33. The application was filed on February 3, 1997 with a claimed first use date of September 4, 1996, and a registration date of January 6, 1998. As a result of Petitioner’s filing of a Section 15 affidavit on January 29, 2003, this registration has attained incontestable status. Attached hereto as Exhibit A are true and correct copies of the registration certificate and TSDR record for Registration No. 2,127,379.

3. Petitioner owns the mark covered by Registration No. 2,127,379, the filings itself, and the goodwill and reputation symbolized by the mark covered by the filings. Petitioner has continuously offered and promoted its wine under the VERAMONTE mark since at least as early as September 4, 1996. Through this continuous and widespread use and promotion of the VERAMONTE mark, Petitioner has also acquired common law rights in the mark. The mark is widely known and recognized by the public as identifying Petitioner’s wines.

4. Respondent filed Application Serial No. 85/387,195 for the mark VIAMONTE for “wines” in International Class 33 on August 2, 2011, which registered on March 20, 2012 under Registration No. 4,114,667. In its Statement of Use accompanying its Application Serial No. 85/387,195, Respondent alleged a first use anywhere date of January 1, 2006 and first use in commerce date of January 1, 2006.

5. Petitioner has used its VERAMONTE mark since at least as early as September 4, 1996. Petitioner’s use of the VERAMONTE mark was therefore substantially prior to Respondent’s claimed first use of and application to register its VIAMONTE mark. Further, Petitioner’s Registration No. 2,127,379 issued well before Respondent’s claimed first use of and application to register its VIAMONTE mark.

6. Petitioner’s and Respondent’s marks are confusingly similar in sight, sound, and appearance. The appearance of the marks is extremely similar; the marks are identical except for the letters between the “V” and the “A.” Consequently, the marks are extremely similar when pronounced. Moreover, in Respondent’s Application for Registration No. 4,114,667,

Respondent claimed the mark VIAMONTE has no meaning in a foreign language, making the two marks even more difficult to distinguish based on sound or sight alone. Furthermore, the fact that both marks contain the segment “monte” weighs in favor of the similarity of meaning of the marks, as both relate to hills. These similarities make Respondent’s and Petitioner’s respective marks confusingly similar in appearance, sound, and commercial impression.

7. Petitioner’s and Respondent’s goods—wine—under their respective marks are identical, and are therefore competitive.

8. On information and belief, consumers of Respondent’s wine that is offered under the VIAMONTE mark are likely to consist of many of the same consumers who are familiar with the VERAMONTE mark used in connection with Petitioner’s wine.

9. On information and belief, Respondent offers and distributes the goods with which it uses its VIAMONTE mark through channels of trade that overlap with those used by Petitioner to offer and distribute Petitioner’s wines under the VERAMONTE mark.

10. In view of the fact that Respondent’s VIAMONTE mark is highly similar in appearance, sound, meaning, and commercial impression to Petitioner’s VERAMONTE mark, that Respondent’s VIAMONTE goods are identical to Petitioner’s VERAMONTE goods, and that the customers and trade channels for Respondent’s and Petitioner’s goods will be the same or overlapping, Respondent’s VIAMONTE mark is likely to cause confusion with Petitioner’s VERAMONTE mark, or to cause mistake, or to deceive as to the origin, source, or sponsor of Respondent’s goods. Petitioner therefore has been injured, and will continue to be injured, by the continuing registration of Respondent’s VIAMONTE mark.

11. Filing Fee: The U.S. Patent & Trademark Office is authorized to charge \$300.00 for the Petition for Cancellation to **Deposit Account 03-1952** (Reference No.73714-6001.501).

WHEREFORE, Petitioner prays that Registration No. 4,114,667 be canceled.

Respectfully submitted,

Dated: December 15, 2015

By:



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Jennifer Lee Taylor  
Attorney for Petitioner  
Alto de Casablanca, S.A.

Morrison & Foerster LLP  
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San Francisco, California 94105-2482  
Telephone: (415) 268-6538  
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# **EXHIBIT A**

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

Reg. No. 2,127,379

**United States Patent and Trademark Office**

Registered Jan. 6, 1998

**TRADEMARK  
PRINCIPAL REGISTER**

**VERAMONTE**

ALTO DE CASABLANCA, S.A. (CHILE CORPORATION)  
CASILLA 122  
CASABLANCA, CHILE, ASSIGNEE OF FRANCISCAN VINEYARDS, INC. (DELAWARE CORPORATION) RUTHERFORD, CA 94573

FIRST USE 9-4-1996; IN COMMERCE 9-4-1996.

"VERAMONTE" TRANSLATES LOOSELY INTO "MOUNTAINSIDE" IN ENGLISH.

SER. NO. 75-234,995, FILED 2-3-1997.

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

JENNIFER RICHARD, EXAMINING ATTORNEY

**Generated on:**

This page was generated by TSDR on 2015-12-15 17:58:18 EST

**Mark:** VERAMONTE

**US Serial Number:** 75234995

**Application Filing Date:**

Feb. 03, 1997

**US Registration Number:** 2127379

**Registration Date:**

Jan. 06, 1998

**Register:**

Principal

**Mark Type:**

Trademark

**Status:**

The registration has been renewed.

**Status Date:**

Jan. 12, 2008

**Publication Date:** Oct. 14, 1997

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## Mark Information

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**Mark Literal Elements:**

VERAMONTE

**Standard Character Claim:**

No

**Mark Drawing Type:**

1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

**Translation:**

"VERAMONTE" translates loosely into "mountainside" in English.

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## Goods and Services

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**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 incontestability; and
- Asterisks "\*" identify additional (new) wording in the goods/services.

**For:**

wine

**International Class(es):** 033 - Primary Class

**U.S Class(es):**

047, 049

**Class Status:**

ACTIVE

**Basis:**

1(a)

**First Use:** Sep. 04, 1996

**Use in Commerce:**

Sep. 04, 1996

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## Basis Information (Case Level)

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**Filed Use:** Yes

**Currently Use:** Yes

**Amended Use:** No



Section 8 - Accepted

Affidavit of  
Incontestability:

Section 15 - Accepted

Renewal Date:

Jan. 06, 2008

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## TM Staff and Location Information

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TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location:

Jan. 12, 2008

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## Assignment Abstract Of Title Information

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### Summary

Total Assignments: 1

Registrant:

ALTO DE CASABLANCA, S.A.

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### Assignment 1 of 1

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#### Conveyance:

ASSIGNS THE ENTIRE INTEREST

Reel/Frame: 1607/0992

Pages:

3

Date Recorded: Jun. 27, 1997

#### Supporting Documents:

No Supporting Documents Available

#### Assignor

Name: FRANCISCAN VINEYARDS, INC.

Execution Date:

Jun. 13, 1997

Legal Entity Type: CORPORATION

State or Country Where  
Organized:

DELAWARE

#### Assignee

Name:

ALTO DE CASABLANCA, S.A.

Legal Entity Type: CORPORATION

State or Country Where  
Organized:

CHILE

Address:

CASILLA 122  
CASABLANCA, CHILE

#### Correspondent

Correspondent Name:

OWEN, WICKERSHAM & ERICKSON, P.C.

Correspondent Address:

MELVILLE OWEN, ESQ.  
455 MARKET STREET, 19TH FLOOR  
SAN FRANCISCO, CA 94105

Domestic Representative - Not Found

**PROOF OF SERVICE BY MAIL**

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on December 15, 2015, I served a copy of:

**PETITION FOR CANCELLATION**

on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

**Curt Handley, Esq.**  
**Law Office of Curt Handley**  
**19540 Buckingham Dr, Ste 1**  
**Mokena, Illinois 60448-2432**

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 15th day of December, 2015.

\_\_\_\_\_  
Grace Gabriel  
(typed)

  
\_\_\_\_\_  
(signature)