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Filing date: **07/13/2017**

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

Proceeding	86841550
Applicant	CONSTELLATION BRANDS U.S. OPERATIONS, INC.
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Submission	Applicant's Motion to Suspend
Attachments	Notable_Motion_To_Suspend.pdf(67976 bytes ) Signed Co-Existence Agreement-Notable.pdf(88826 bytes )
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Signature	/Stephen L. Baker/
Date	07/13/2017

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

Application Serial No.: 86/841,550

Filing Date: December 7, 2015

Mark: NOTABLE

Applicant: Constellation Brands U.S. Operations, Inc.

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**MOTION FOR CONTINUED SUSPENSION OF THE APPEAL TO  
TTAB FROM REFUSAL TO REGISTER PROCEEDINGS WHILE THE  
TRADEMARK EXAMINING ATTORNEY CONSIDERS OF A PROPOSED  
CO-EXISTENCE AGREEMENT**

The Applicant and Destileria Serralles, who is the registrant owner of trademark GRANADO, registration number 0,910,200, which registration was cited as an obstacle to registration of the subject Applicant's Trademark Application Serial No. 86/841,550 for the mark NOTABLE, have reached a Co-existence And Consent To Register Agreement (hereinafter "Agreement") as a result of negotiations following the USPTO Examiner's refusal to register in the present application.

For the convenience of the Examining Attorney and the Board, a copy of the Agreement is submitted to both herewith. The Applicant hereby requests that the Trademark Trial and Appeal Board (the "TTAB") suspend the appeal proceeding while the USPTO Trademark Examining Attorney considers the Agreement. If the Agreement is approved and the 2 (d) citation withdrawn, the appeal proceeding will be terminated. If the rejection is not withdrawn, the appeal proceedings will resume subjecting the Applicant to unnecessary appeal costing both significant time and money and more importantly tying up the valuable resources of the TTAB.

To facilitate the Examining Attorney's determination regarding the withdrawal of the rejection, we draw its attention to the following:

1. The Registrant believes that the marks and uses of the parties are not so closely related so as to create a likelihood of confusion between the respective marks. Accordingly, the Registrant will not oppose or object to Applicant's request for registration.

2. There is no confusion between the two respective marks, nor is there any likelihood of confusion between them. Registrant's mark has acquired, through extensive and lengthy use, wide recognition by the purchasing public. Over more than 45 years the customers have learned to attribute and associate the mark GRANADO with its owner.

3. The parties believe that the elements of their respective marks create entirely different commercial impressions, based upon the nature of the goods – rum versus wine, the variations in the entirely different words NOTABLE and GRANADO, the labels on the GRANADO rum bottle of the registrant and on the NOTABLE wine bottle of the Applicant, that utilize the marks by each respective party, and the interests of the parties themselves. Further, NOTABLE is an English-language word, and GRANADO is a Spanish-language word, which has several meanings and translations into English, and which is not immediately associated by a Spanish-speaker with a translation into the English language as “notable”, as “notable” is only one of the more obscure meanings of the word, nor is GRANADO necessarily translated into English as NOTABLE by a consumer who does speak Spanish, as the main meanings of the word GRANADO are pomegranate and pomegranate tree. In fact, not only an English speaker not associate GRANADO with NOTABLE, but even a Spanish speaker will not translate NOTABLE into GRANADO or GRANADO into NOTABLE, because notable is a very obscure meaning of the word granado. In fact, some English-Spanish dictionaries, such as the Oxford Spanish-English Dictionary, for example, translate “granado” from Spanish into English as “lists the translation of the word “granado” as “the cream of society” when used as an adjective in Spanish, and “pomegranate tree” when used as a noun. Oxford Dictionary is quite clear about this when it says that there are two main translations of granado in Spanish: the cream of society and pomegranate tree. Thus, granado in Spanish does not mean notable in English at all.

4. The following terms of the Agreement signed by the parties govern the rights of the parties insofar as use of their respective marks is concerned:

i. The parties agree that their respective use of the terms "NOTABLE" and "GRANADO" is sufficient to avoid confusion.

ii. Both parties have agreed to use their best efforts to avoid any potential likelihood of confusion and have further agreed to use their best efforts to resolve any dispute regarding the Agreement, including its validity, interpretation, performance, or breach.

iii. The benefits and obligations resulting from the Agreement shall run with the ownership of the goodwill associated with the uses of the respective trademarks.

iv. The parties believe that adherence to the above terms regulating the use of the respective marks will entirely eliminate even the remotest likelihood of consumer confusion.

v. The Court of Appeals for the Federal Circuit, in a 1988 decision approving agreements of this type (AmalgamatedBankv.AmalgamatedTrust&Savings, 6 USPQ2d 1350 (Fed. Cir. 1987) remanded to the TTAB, stating that:

1. "whether the owners of the marks in question have agreed, in some form, to memorialize methods of avoiding confusion"; and

2. "memorialization agreement is viewed in the light of the parties' interest and the prevailing marketplace" are important factors.

In Amalgamated, there were identical marks and identical uses. Here, the marks are not identical. In fact, they are very far from identical and are very different visually, phonetically and conceptually. If it were not the Examiner's insistence on the doctrine of foreign equivalents, which application is not obvious in this case at all, since an average Spanish speaker will NOT immediately associate the word GRANADO with the English word NOTABLE. A Spanish speaker might translate GRANADO as pomegranate or pomegranate tree, but certainly not as notable. Here, also, there is detail as to the methods of avoiding confusion amongst the non-identical marks. Finally, "neither party wishes to have the likelihood of confusion adjudicated." AmalgamatedBank, 6 USPQ2d

at 1307.

In In re SGS Tool Company, 24 USPQ2d 1382 (TTAB 1992) a settlement agreement was not nearly as detailed as the within Agreement, and was approved by the Board. As in the SGS case, the parties herein both believe there is no likelihood of confusion or conflict between Registrant's mark and the trademark application of Petitioner.

The Examining Attorney's attention is also respectfully drawn to the following decisions clearly showing there is no per se rule that use of similar marks on related goods necessarily creates a likelihood of confusion.

HydeParkFootwearCo.Inc.V.Hampshire-Designers, Inc., 197 USPQ 632 (TTAB 1977). Marks for shirts and for boots and shoes (both including every similar designs) were determined not to be likely to cause confusion.

In re British Bulldog. Ltd., 224 USPQ 854 (TTAB 1984). "PLAYERS" mark for shoes was deemed not to cause likelihood of confusion with the same word mark for men's underwear. See also Byk-Gulden.Inc.v.TrimenLaboratories.Inc., 211 USPQ 364 (TTAB 1981); AvonShoeCo.Inc.v.DavidCrystallInc., 121 USPQ 397 (S.D.N.Y. 1959); and Harzfeld'sInc.v.JosephM.Feldman.Inc., 184 USPQ 692 (TTAB 1974). USPQ2d 1465 (TTAB 1992); and OldeTymeFoodsInc.v.Roundy'sInc., 22 USPQ2d 1542 (Fed. Cir. 1992). Thus, it is highly unlikely that confusion will result. Both parties should be allowed to register and maintain registrations for their valuable and long used trademarks.

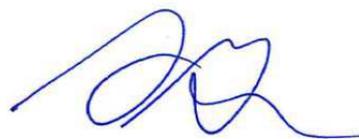
WHEREFORE, Petitioner prays that the 2(d) citation be withdrawn so that the appeal can be terminated and the application can proceed to publication.

Dated: July 12, 2017

Respectfully submitted for

Applicant Constellation Brands U.S.  
Operations, Inc.

BAKER and RANNELLS, PA

A handwritten signature in blue ink, consisting of several loops and a long horizontal stroke at the end.

By:

Stephen L. Baker  
John M. Rannells  
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CERTIFICATE OF SERVICE

I hereby certify a copy of the foregoing was served on the USPTO Examining Attorney via TEAS, this 13<sup>th</sup> day of July, 2017.

A handwritten signature in blue ink, consisting of several loops and a long horizontal stroke at the end.

Stephen L. Baker

## COEXISTENCE AGREEMENT

This Agreement is entered into this 10<sup>th</sup> day of July, 2017, between the parties, CONSTELLATION BRANDS U.S. OPERATIONS, INC., a N.Y. corporation with offices at 235 N. Bloomfield Rd, Canandaigua, NY 14424, ("CBUSO") and DESTILERIA SERRALLES, INC., a Puerto Rican corporation with offices at Central Mercedita, Ponce, P. R. ("Serralles"). CBUSO and Serralles may be referred to as "Party" and as "the Parties".

### RECITALS

A. Serralles has long used the mark GRANADO for rum and owns U.S. Reg. No. 0910200 for GRANADO, ("Serralles Trademark") for "alcoholic beverages – namely, rum" ("Serralles Goods").

B. CBUSO has used the mark NOTABLE for wine in the U.S. The NOTABLE mark is a play on the word NOTE given CBUSO's use of musical note designs in close association with the mark. CBUSO also owns a U.S. application Ser. No. 86/841,550 for the NOTABLE (the "CBUSO Application"), for the goods "alcoholic beverages except beers; wine" (the "CBUSO Goods"), which application was rejected by the USPTO as being confusingly similar to the Serralles Trademark.

C. The Parties, as business persons well-acquainted with the alcoholic beverage business believe the marks NOTABLE and GRANADO as used by the respective parties in the marketplace will not cause confusion.

IN CONSIDERATION of the foregoing expressed and mutual recitals contained herein, the Parties agree as follows:

1. Serralles consents to the use and registration in the U.S.A. by CBUSO of NOTABLE for wine.
2. CBUSO consents to the use or registration in the U.S.A. by Serralles of the mark GRANADO for rum.
3. CBUSO will not use the word mark GRANADO for any goods and will only use the mark NOTABLE for wine. CBUSO will not use the NOTABLE mark in any manner that is likely to be confused with the Serralles GRANADO mark.
4. CBUSO shall delete "alcoholic beverages except beers;" from the CBUSO Goods in the CBUSO Application.
5. In the event either Party learns of any likelihood of confusion from the use of the Parties' respective marks, the Parties agree to use reasonable efforts to resolve such matters and to avoid any such likelihood of confusion.
6. To enable CBUSO to register its NOTABLE Trademark, Serralles consents to the submission of this Agreement to the U.S. Patent and Trademark Office as evidence of its consent.
7. This Agreement shall be binding on the assigns, successors in interest and subsidiaries, direct or indirect, of both Parties.
8. This Agreement, which may not be changed by either Party without the consent of the other contains the entire agreement of the Parties and all prior representations, negotiations, and agreements (whether oral or written) relating to the subject matter of this Agreement as merged herein and extinguished. This Agreement may be executed in two or more counterparts.

Signature, whether original or scanned will be deemed to be original, valid, binding, and enforceable.

9. Notice related to this Agreement shall be in writing by mail and also by email where disclosed:

To CBUSO: At the address set forth above,  
Attn.: General Counsel

Copy to: Stephen L. Baker  
Baker & Rannells PA  
92 East Main Street, Suite 302  
Somerville, New Jersey 08876  
Tel: (908) 722-5640  
Email: s.baker@br-tmlaw.com

To Serralles: At the address set forth above,  
Attn.: Legal Department

Copy to: Deborah K. Squiers  
Cowan, Liebowitz & Latman, PC  
114 West 47th Street  
New York, New York 10036  
Tel: (212) 790-9200  
Email: [dks@cfl.com](mailto:dks@cfl.com)

10. The failure of either Party to enforce any provision of this Agreement shall not be construed as a waiver of such provision or waiver of the right of either Party to thereafter enforce such provision.

IN WITNESS WHEREOF, the Parties hereto have caused this Agreement to be executed on the date first written above.

Constellation Brands U.S. Operations, Inc.

By:   
Name: Lonette Merriman  
Title: Assistant Secretary

Destileria Serralles, Inc.

By:   
Name: Jorge A. Vazquez  
Title: Chief Financial Officer