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

11-07-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

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Bacardi & Company Limited, (by assignment from Tequila Cazadores, S.A. de C.V.) Opposer, v. Tequila Centinela, S.A. de C.V., Applicant.	Opposition No. 125,436 Ser. No. 76/112,825 Mark: CABRITO and Design

REPLY BRIEF IN CONNECTION WITH OPPOSER'S MOTION FOR SUMMARY JUDGMENT

Opposer, Bacardi & Company Limited, hereby requests that the Honorable Board consider this Reply Brief which is offered to clarify the record and respond to additional issues raised by Applicant.

A significant portion of Applicant's opposition brief addresses the fact that Applicant apparently hired a non-lawyer, Mr. Trademark, to file the subject trademark application. It is not clear, though, why Applicant hired this representative if it believed it needed legal advice in connection with filing and/or prosecuting its trademark application. At Mr. Trademark's web site, it is very clear that this company is neither a law firm nor a lawyer (www.mrtrademark.com). Further, even if Mr. Trademark did not provide competent counsel, that in no way alleviates Applicant from

the requirement of making truthful statements, particularly statements made with declarations which make it clear that there are substantial penalties associated with making untruthful statements. If Applicant chose not to retain counsel to file and/or prosecute its application, there is no requirement that it do so. Thus, the mere fact that Applicant chose not to engage the services of a lawyer does not entitle it to escape a finding that it committed fraud. Also, it is clear that Applicant is currently represented by competent trademark counsel and yet, even its proposed amendment contains fraudulent statements.

While Applicant concedes that it only makes two products (i.e., tequila and a cocktail with tequila), Applicant nonetheless argues that its application (as proposed to be amended) is not overly broad since tequila can be considered as an aperitif, liqueur, liquor or spirit. The Trademark Office requires, though, that the identification of goods or services be "specific, definite, clear, accurate and concise." *See Trademark Manual of Examining Procedure 1402.01 In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 USPQ2d 1296 (TTAB 1986), *rev'd on other grounds*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505 (TTAB 1972), *modified without opinion*, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974); *In re Cardinal Laboratories, Inc.*, 149 USPQ 709 (TTAB 1966); *California Spray-Chemical Corp. v. Osmose Wood Preserving Co. of America, Inc.*, 102 USPQ 321 (Comm'r Pats. 1954); *Ex parte A.C. Gilbert Co.*, 99 USPQ 344 (Comm'r Pats. 1953). Further, this Board has a long history of requiring that goods be stated with appropriate specificity. *See In re Air Products & Chemicals, Inc.*, 192 USPQ 84, *recon. denied* 192 USPQ 157 (TTAB 1976) (acceptance of identification of goods as "catalysts," which could include large number of catalysts that applicant does not manufacture, would give applicant a scope of protection to which it was not entitled); *Procter & Gamble Co. v. Economics Laboratory, Inc.*, 175 USPQ 505, 509 (TTAB 1972), *modified without*

opinion, 498 F.2d 1406, 181 USPQ 722 (C.C.P.A. 1974) (noting that, in view of specimens, greater specificity should have been required in identifying registrant's detergent product); *In re Toro Mfg. Corp.*, 174 USPQ 241 (TTAB 1972) (noting that use on "grass-catcher bags for lawn-mowers" did not justify the broad identification "bags," which would encompass goods diverse from and commercially unrelated to applicant's specialized article); *Ex parte Consulting Engineer Publishing Co.*, 115 USPQ 240 (Comm'r Pats. 1957) (amendment of "periodical" to "monthly news bulletin" required); *Merchandising Promotions v. Hastings & Co., Inc.*, 110 USPQ 256 (Comm'r Pats. 1956) (amendment of "gold stamping foil" to "cellophane folders with pressure-sensitive gold foil strip attached for personalizing articles" required). Applicant's amended recitation is not specific, definite, concise or accurate because Applicant is purposely trying to secure broader rights in the mark than those rights to which it is entitled. If the Trademark Office is made aware of the nature of Applicant's actual goods, it would not permit the recitation to include "alcoholic beverages, excluding beer, namely distilled liquor, prepared alcoholic cocktails and aperitifs, and alcoholic drinks, namely liqueurs, distilled liquors, distilled spirits, tequila" if Applicant is really only using the mark on tequila since the date of first use put forth in the application and currently only on tequila and a tequila-based cocktail. To allow such overbroad statements would defeat the Trademark Office's goals in ensuring that registrations be very specific and accurate. If the Trademark Office was to allow the proposed amendment as a proper description of Applicant's goods, it would also have to allow the manufacturer of canned tomatoes to file an application to cover "vegetables, fruits, tomatoes and canned tomatoes" since tomatoes are sometimes considered a fruit, sometimes a vegetable. Also the maker of knapsacks would be entitled to file an application for "luggage, athletic bags, book bags and knapsacks." Clearly to do so would contravene the Trademark Office's requirements and goals.

Applicant later cites the Federal Circuit's decision in *L.D. Kichler Co. v. Davoil Inc.*, 52 USPQ2d 1307 (Fed. Cir. 1999) for the proposition that "merely making a false statement is not sufficient to [oppose registration of] ... a mark." *L.D. Kichler* at 1309. However, Opposer does not allege that Applicant made a mere misstatement. Rather, Opposer alleges—and believes that the record proves—that Applicant *intentionally, willfully and fraudulently* misstated the scope of its use to secure a registration that would be broader than the protection that would be rightfully afforded to it and did so with the intent to deceive. Applicant now states that it <u>intended to use</u> the mark for "alcoholic beverages, excluding beer, namely distilled liquor, wine, wine coolers, prepared alcoholic cocktails and aperitifs, and alcoholic drinks, namely liqueurs, hard cider, brandy spirits, distilled liquors, distilled spirits, gin, wine, whiskey, vodka, rum, tequila, anisette aguamiel, aguardiente". Such a claim does not withstand reasonable scrutiny. Specifically, Applicant is not likely to suddenly develop from a tequila-centered business to producing a whole variety of alcoholic beverages. Also, if Applicant indeed had a bona fide intent to use its mark on this whole listing of goods, it would have sought amendment of its application to merely *delete* the use basis as to those goods and *add* a statement of intent to use with respect to those goods.

Applicant also believes that its fraudulent statements in the original application are irrelevant because Applicant sought to—at least partially—rectify the fraud. As put forth in its Motion for Summary Judgment, Opposer submits that a fraudulent application should be considered void *ab initio* and thus, any actions by Applicant after the filing of this inter partes proceeding are irrelevant.

Finally, Applicant seeks to distinguish the cases cited by Opposer in support of its Motion for Summary Judgment by stating that these cases were based on additional evidentiary

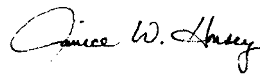
records. For the reasons put forth in its Motion and this Reply, Opposer respectfully submits that this Board can find fraud based solely on the statements in Applicant's application, Applicant's subsequent statements made in connection with this proceeding record and the other evidence submitted by Opposer.

In sum, the application—*as filed* ***and*** *as amended*—stands on its own merits and it is clear that the statements in these verified declarations are false and were intentionally made in an attempt to fraudulently secure a registration for goods beyond the scope of protection to which it would otherwise be entitled.

WHEREFORE, Bacardi & Company Limited respectfully requests that its Amended Notice of Opposition be entered.

Respectfully submitted,

Bacardi & Company Limited



Date: 11/7/02

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CERTIFICATE OF SERVICE

On this 7th day of October, 2002, a true and correct copy of the foregoing Reply Brief In Connection With Opposer's Motion For Summary Judgment was sent via first class mail, postage prepaid and addressed as follows:

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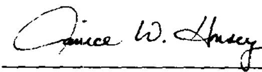

Janice W. Housey

EXHIBIT A

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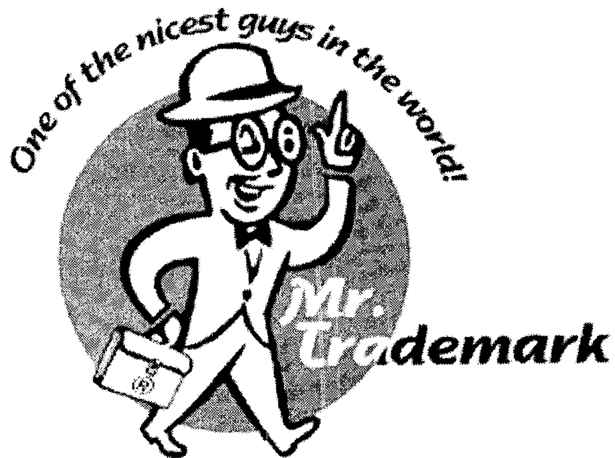

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In re Opposition No. 125,436

Bacardi & Company Limited (by assignment from Tequila Cazadores, S.A. de C.V.)

v.

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Box TTAB

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U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

COVER SHEET

Assistant Commissioner for Trademarks
2900 Crystal Drive
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Madam:

Enclosed for filing in connection with the above-referenced matter, please find the following:

Reply Brief in Connection with Opposer's Motion for Summary Judgment.

Respectfully submitted,

Date: November 7, 2002

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