



06-06-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #73

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

In the Matter of Application Serial No. 78/074252
Published in the Official Gazette of December 31, 2002

<hr/>)	Opposition No
Bronco Wine Company,)	91155064
	Opposer,)	
vs.)	
)	
Diageo North America, Inc.,)	
	Applicant,)	
<hr/>)	

Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
Attn: Box TTAB NO FEE

**OPPOSER'S REPLY TO APPLICANT'S MEMORANDUM
IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES**

Applicant's Memorandum contends that its affirmative defenses are not founded in BATF labeling requirements. On that point, Applicant's Answer, speaks for itself. However, Applicant has incorrectly stated that Opposer, in turn, relies upon its BATF label approvals to establish its trademark rights. Opposer has not, and does not, assert that BATF label approval confers any trademark rights. The Notice of Opposition clearly sets forth that Opposer's trademark rights are based upon use of its trademarks in commerce (Notice of Opposition ¶4).

Opposer's reference in its Motion to its duly issued label approvals is to establish that such use of the trademarks in commerce is lawful and in rebuttal to Applicant's allegations that Opposer is guilty of unclean hands. Specifically, Opposer cited to 27 CFR 4.39(i)(2) to point out that Applicant's reliance upon 27 CFR 4.25a(e)(3)(ii) is misplaced. Regulation 4.39(i)(2) sets forth an exception to regulation 4.25a(e)(3)(ii); *i.e.*, BATF allows use of geographic brand names if the Certificate of Label Approval was issued prior to July 7, 1989. Opposer's label approvals

issued prior to July 7, 1989 and are "grandfathered" under 4.39(i)(2). Therefore, Applicant's reliance upon 4.25a(e)(3)(ii) to argue that Opposer's use of its marks is deceptive and that Opposer is guilty of unclean hands is legally insufficient.

Applicant's memorandum further asserts that Opposer's trademarks RUTHERFORD VINEYARDS and RUTHERFORD VINTNERS are deceptively geographically misdescriptive. Apparently then, Applicant is urging this Board to apply the standard set forth in Section 2(e)(3) of the Trademark Act.

However, geographic designations in use on wine and spirits are properly scrutinized under the test set forth in Section 2(a) of the Trademark Act as amended in 1994. Under the proper test, a "grandfather" clause exists for geographic designations, such as those contained in Opposer's trademarks, which were in use on wine or spirits prior to January 1, 1996 (*i.e.*, one year after the effective date of the WTO Agreement with respect to the United States).

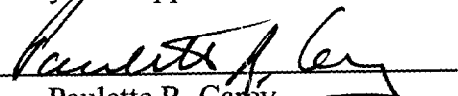
The cases cited by Applicant in support of its deceptive geographic misdescriptiveness argument predate the amendment to Section 2(a). Thus, Applicant's argument is without support in either statute or case law.

Therefore, Applicant's Memorandum fails to raise any cogent argument against Opposer's Motion to Dismiss the Affirmative Defenses. Accordingly, the Affirmative Defenses should be dismissed in their entirety.

Dated: June 4, 2003

Respectfully submitted,

BUCHMAN & O'BRIEN, LLP
Attorneys for Opposer

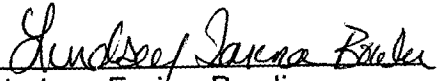
By: 
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CERTIFICATE OF SERVICE

I hereby certify that on June 4, 2003, I served the foregoing Opposer's Reply to Applicant's Memorandum in Opposition to Opposer's Motion to Strike Affirmative Defenses by delivering a copy to the United States Postal Service, as first class mail postage prepaid in an envelope addressed to:

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330 Madison Avenue
New York, NY 10017

Elliot Basner
Diageo North America, Inc.
Six Landmark Square
Stamford, CT 06901


Lindsey Farina-Bowlin

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that these papers are being deposited with the United States Postal Service as first class mail postage prepaid in an envelope addressed to Box TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3514 on June 4, 2003.


Lindsey Farina-Bowlin

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June 4, 2003

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Re: Opposition No. 91155064
Bronco Wine Company v.
Diageo North America, Inc.

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COMMUNICATIONS SECTION

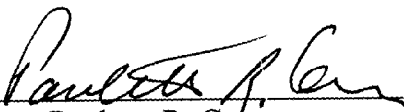
Dear Sir:

On behalf of Opposer, Bronco Wine Company, we submit the enclosed Opposer's Reply to Applicant's Memorandum in Opposition to Opposer's Motion to Strike Affirmative Defenses.

Kindly acknowledge receipt of the documents by stamping and returning the enclosed stamped self-addressed post card.

Cordially,

BUCHMAN & O'BRIEN, LLP

By: 
Paulette R. Carey