

ESTTA Tracking number: **ESTTA115557**

Filing date: **12/19/2006**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	William Grant & Sons, Inc.		
Entity	Corporation	Citizenship	New Jersey
Address	130 Fieldcrest Avenue Edison, NJ 08837 UNITED STATES		

Attorney information	Anthony R. Masiello Holland & Knight LLP 2099 Pennsylvania Avenue, N.W. Washington, DC 20006 UNITED STATES anthony.masiello@hkllaw.com Phone:(202) 419-2405		
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Applicant Information

Application No	78722859	Publication date	12/12/2006
Opposition Filing Date	12/19/2006	Opposition Period Ends	01/11/2007
Applicant	Dieffenbach, Craig 636 West Mercer Place Seattle, WA 98119 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: VODKA
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Attachments	opp__Dec_19_2006_16_13_43_88.pdf (5 pages)(241629 bytes)
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Signature	/anthony masiello/
Name	Anthony R. Masiello
Date	12/19/2006

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

WILLIAM GRANT & SONS, INC.)	
)	
Opposer)	
)	
v.)	Opp. No. _____
)	
CRAIG DIEFFENBACH)	(Serial No. 78/722,859)
)	
Applicant)	

NOTICE OF OPPOSITION

William Grant & Sons, Inc. ("Opposer"), a corporation organized and existing under the laws of the State of New Jersey, with its principal place of business located at 130 Fieldcrest Avenue, Edison, New Jersey 08837, believes that it will be damaged by the registration of the mark claimed in Application Serial No. 78/722,859 (the "Application") in the name of Craig Dieffenbach ("Applicant"), an individual United States citizen, of 636 West Mercer Place, Seattle, Washington 98119, filed on September 29, 2005 and published in the Official Gazette of December 12, 2006, and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the well known trademark HENDRICK'S, which Opposer has used in U.S. commerce since at least as early as August 2000 in connection with gin.
2. Opposer is the owner of U.S. Registration No. 2,432,377 for the mark HENDRICK'S as applied to gin, which registration issued on February 27, 2001 and is valid and subsisting.
3. Under Opposer's mark HENDRICK'S, Opposer markets in the United States a premium gin that is distilled in Scotland.
4. As a result of Opposer's continuous, substantial and vigorous use and promotion of its trademark HENDRICK'S and the widespread commercial success

of Opposer's gin offered under that mark throughout the United States and abroad, Opposer's mark HENDRICK'S has become distinctive of Opposer's gin in U.S. commerce. Opposer's mark HENDRICK'S is widely recognized as an indicator of the source of Opposer's goods in U.S. commerce, has acquired a highly favorable reputation among members of the purchasing public, and has become a valuable symbol of Opposer's goodwill.

5. Notwithstanding Opposer's prior rights in the mark HENDRICK'S, on September 29, 2005 Applicant filed the Application in the United States Patent and Trademark Office for registration of the mark HENDRIX ELECTRIC VODKA ("Applicant's Mark") for use in connection with vodka ("Applicant's Goods").

6. The Application was filed on the basis of Applicant's bona fide intention to use the mark in commerce, under 15 U.S.C. Section 1051(b).

7. On information and belief, Applicant made no use of Applicant's Mark in connection with any goods prior to September 29, 2005.

8. On information and belief, Applicant knew or had reason to know of Opposer's prior rights in the HENDRICK'S mark when Applicant filed the Application and prior to the time that Applicant made first use of the Applicant's Mark.

9. Applicant has displayed Applicant's Mark in a stylized format in which the designation HENDRIX is presented in a style of lettering that differs from the style of lettering in which the other words of the mark are presented.

10. Applicant has displayed Applicant's Mark in a stylized format in which the designation HENDRIX is presented in a color that differs from the color in which the other words of the mark are presented.

11. The designation HENDRIX is the phonetic equivalent of the designation HENDRICK'S.

12. On information and belief, it is Applicant's intention that vodka under Applicant's Mark will be made available to purchasers in retail liquor stores.

13. On information and belief, it is Applicant's intention that vodka under Applicant's Mark will be made available to purchasers in bars.

14. On information and belief, it is Applicant's intention that vodka under Applicant's Mark will be made available to purchasers in restaurants.

15. If Applicant's Mark is used in commerce, on information and belief, customers calling for Applicant's Goods will sometimes abbreviate the Applicant's Mark to HENDRIX.

16. It is commonly known among consumers of alcoholic beverages that martinis may be made with either gin or vodka.

17. The designation "Hendrick's martini" is the phonetic equivalent of the designation "Hendrix martini."

18. On information and belief, Applicant has cooperated with Electric Hendrix, LLC, a limited liability company organized under the laws of Washington ("EHL"), for the purpose of marketing vodka under the Applicant's Mark.

19. On information and belief, Applicant owns a controlling interest in EHL.

20. On information and belief, Applicant exercises control over EHL.

21. Opposer has used, advertised and promoted its mark HENDRICK'S in interstate commerce and international commerce involving the United States from a date long prior to the filing date of the Application and long prior to any use by Applicant of Applicant's Mark.

22. Opposer's Registration No. 2,432,377 issued long prior to the filing date of the Application and long prior to any use by Applicant of Applicant's Mark.

23. Opposer's mark HENDRICK'S is widely recognized as an indicator of the source of Opposer's goods in U.S. commerce and became distinctive of Opposer's gin in U.S. commerce long prior to the filing date of the Application and long prior to any use by Applicant of Applicant's Mark.

24. Opposer's mark HENDRICK'S is famous and became famous long prior to the filing date of the Application and long prior to any use by Applicant of Applicant's Mark.

COUNT I

Likelihood of Confusion - §2(d)

25. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 24, above, as if set forth in their entirety herein.

26. The Applicant's Mark so closely resembles the Opposer's mark HENDRICK'S in sound and appearance that the use and registration thereof by Applicant are likely to cause confusion, mistake, and deception as to the source or origin of Applicant's Goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's mark HENDRICK'S.

27. Applicant's Goods are so closely related to Opposer's gin that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's Goods originate with Opposer or that Applicant is in some way connected with, sponsored by or affiliated with Opposer, all to Opposer's irreparable damage and injury.

28. Likelihood of confusion in this case is enhanced by the fact that Applicant's Goods are competitive with or closely related to the goods provided by Opposer under its mark HENDRICK'S and are marketed or are intended to be marketed through trade channels that are the same as or similar to those in which Opposer markets gin under the mark HENDRICK'S.

29. Likelihood of confusion is enhanced by the fact that Opposer's goods offered under the mark HENDRICK'S are provided or intended to be provided to the same classes of prospective customers as are Applicant's Goods.

30. Under the circumstances, registration and use of Applicant's Mark is likely to cause Opposer to lose control over the good and valuable reputation represented by and derived from its trademark HENDRICK'S.

31. Registration of Applicant's Mark in light of the prior rights of Opposer in the trademark HENDRICK'S is therefore likely to cause confusion, mistake and/or deception among members of the relevant purchasing public resulting in damage and injury to Opposer in violation of the provisions of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

COUNT II
Dilution - §43(c)

32. Opposer realleges and incorporates by reference the allegations contained in paragraphs 1 through 31, above, as if set forth in their entirety herein.

33. Use of Applicant's Mark is likely to cause dilution of the distinctive quality of the Opposer's mark HENDRICK'S.

34. Use or registration of Applicant's Mark will lessen the capacity of Opposer's famous mark HENDRICK'S to identify and distinguish Opposer's goods.

35. Use and registration of the Applicant's Mark will deprive Opposer of the ability to protect its reputation, persona, and goodwill, and is likely to tarnish the good and favorable reputation of Opposer's famous HENDRICK'S mark.

36. Likelihood of damage to Opposer's goodwill is enhanced by the fact that prospective customers who encounter defects in the quality of Applicant's Goods will attribute those defects to Opposer, and this will dilute by tarnishment Opposer's reputation and goodwill.

37. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's Mark and registration should be refused pursuant to the provisions of Section 43(c) of the Trademark Act. 15 U.S.C. §1125(c).

The required fee of \$300.00 has been provided. Any additional charges should be made to the Deposit Account of Holland & Knight LLP, Account No. 50-1542.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied to the Application.

WILLIAM GRANT & SONS, INC.

Date: December 19, 2006

By: 

Paul F. Kilmer
Anthony R. Masiello
HOLLAND & KNIGHT LLP
2099 Pennsylvania Avenue, N.W.
Washington, D.C. 20006
(202) 955-3000
Attorneys for Opposer

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