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

Proceeding	91178682
Party	Plaintiff Franciscan Vineyards, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	09/24/2008
Attachments	Motion to amend.pdf (13 pages)(459338 bytes)

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

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Fransican Vineyards, Inc.

Opposer

Mark: DOMAINE PINNACLE and
design

v.

Opposition No. 91178682

Domaine Pinnacle, Inc.

Serial No.: 78783236

Applicant

Filed: December 30, 2005

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OPPOSER'S MOTION TO AMEND NOTICE OF OPPOSITION

Opposer, Fransican Vineyards, Inc. ("Opposer"), by its attorney, hereby moves, pursuant to Trademark Rule 2.115 to amend its Notice of Opposition to add an additional ground. Specifically, Opposer wishes to add geographic descriptiveness as an additional basis for refusal to register Applicant's Application, as it came to Opposer's attention during the recent suspension that Applicant's Mark DOMAIN PINNACLE, which means PINNACLE ESTATE, describes the geographic location of the estate at which Applicant's goods are produced or going to be produced, namely on a property at the slopes of Pinnacle Mountain in Quebec, Canada. Discovery does not close until December 8, 2008. Attached hereto is Opposer's proposed Amended Notice of Opposition.

Dated: September 24, 2008

Respectfully submitted,

BAKER AND RANNELLS PA

By: 

Stephen L. Baker

Linda Kurth

Attorney for Opposer

575 Route 28, Suite 102

Raritan, New Jersey 08869

Goods intended to be offered under its alleged mark DOMAINE PINNACLE AND DESIGN.

3. Opposer is now and has been, for many years prior to any date which may be claimed by Applicant, engaged in the use Opposer's Mark for wine and goods and services related thereto.

4. Opposer is now and has been, for many years prior to any date which may be claimed by Applicant, engaged in the sale of a wide variety of wine and goods and services related thereto under Opposer's Mark.

5. Since long prior to any date which may be claimed by Applicant, Opposer on its own behalf has been, and is now engaged in the sale of the goods identified in paragraphs 3 and 4 hereinabove under the Opposer's Mark in interstate commerce.

6. Opposer is the owner of, inter alia, the following U.S. trademark registration(s), all of which are in good order, and in the name of and owned by the Opposer.

MARK	Registration No.	Goods
PINNACLES*	0997378	Wine

* denotes an incontestable registration

7. The use by Opposer of the Opposer's Mark for the Opposer's goods and services alleged herein, is long prior to any date which may be lawfully claimed by Applicant, and Opposer has priority.

8. Upon information and belief, Applicant intends to distribute and sell its goods through the same channels of trade as Opposer, and direct its respective goods to the same ultimate consumer as Opposer.

9. The Opposer's Mark and Applicant's DOMAINE PINNACLE AND DESIGN mark are confusingly similar when applied to the goods of the parties.

10. The goods of Applicant and Opposer are substantially related in part and generally related in part, and Applicant's intended use of DOMAINE PINNACLE AND DESIGN in connection with its goods is without the consent or permission of Opposer.

11. Since Opposer owns the Opposer's Mark by virtue of prior use, mistake or deception as to the source of origin of the goods will arise and will injure and damage the Opposer and its goodwill.

As for a First Cause of Action

12. The registration of the mark DOMAINE PINNACLE AND DESIGN to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Opposer, all to Opposer's irreparable damage.

As for a Second Cause of Action

13. Upon information and belief, Applicant also lacks the requisite intent to use the mark DOMAINE PINNACLE AND DESIGN in commerce for the goods claimed in the application, namely: Apple juices and apple-based non-alcoholic beverages.

14. Upon information and belief, Applicant's business is limited to the manufacture and sale of alcoholic beverages derived from apples. On its website, no non-alcoholic apple juices or apple-based beverages are mentioned and/or available for sale. See <http://www.icecider.com/us/products.html> (visited August 1, 2007), annexed hereto as Exhibit "A".

15. Opposer believes that it is and will be damaged by registration of the mark applied by Applicant.

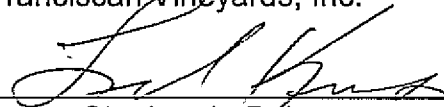
As for a Third Cause of Action

16. The mark DOMAINE PINNACLE AND DESIGN when used on or in connection with the goods or services of Applicant is primarily geographically descriptive.

WHEREFORE, Opposer prays that the application for registration of DOMAINE PINNACLE AND DESIGN, Serial No. 78783236, filed on December 30, 2005, be denied and that this Opposition be sustained.

Respectfully submitted for Opposer
Franciscan Vineyards, Inc.

By:



Stephen L. Baker
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(908) 722-5640

Dated: September 23, 2008

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

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Fransican Vineyards, Inc.

Opposer

Mark: DOMAINE PINNACLE and
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Opposition No. 91178682

Domaine Pinnacle, Inc.

Serial No.: 78783236

Applicant

Filed: December 30, 2005

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**OPPOSER'S BRIEF IN SUPPORT OF ITS MOTION TO AMEND NOTICE OF
OPPOSITION**

Opposer, Fransican Vineyards, Inc. ("Opposer"), submits this Brief in support of its Motion to Amend its Notice of Opposition. Leave to amend should be freely granted unless one or more of specified grounds for denial exist. None of those grounds exist here and Opposer's Motion should be granted.

PROCEDURAL AND FACTUAL BACKGROUND

On August 1, 2007, Opposer filed a Notice of Opposition against the mark DOMAINE PINNACLE, Serial No. 78783236 on the grounds of likelihood of confusion and based on Applicant's lack of bona fide intent to use its Mark in commerce for the goods claimed in the application, namely Apple juice and apple-based non-alcoholic beverages. On September 10, 2007, Applicant Domaine Pinnacle, Inc. ("Applicant") filed its Answer. On February 11, 2008, the proceedings were suspended by stipulation pending settlement negotiations.

The suspension ended on August 10, 2008, and Opposer began preparing discovery requests. Opposer researched Applicant's website at www.domainepinnacle.com/us/about/html, (Exhibit A) and found that at this page, Applicant stated, "Founded in 2000, Domaine Pinnacle is a family-owned and operated orchard and cidery located on a 430-acre property on the slopes of Pinnacle Mountain near the historic village of Frelighsburg in the Eastern Townships of Quebec, Canada." Further down the page, Applicant states under a section titled *Pinnacle Mountain*:

Originally occupied by Abenaki Indians, Pinnacle Mountain is the only truly undeveloped mountain in Quebec within a 90-mile radius of Montreal. Known by generations of locals simply as "The Pinnacle" (elevation 2,336 ft.), it is a refuge for a wide range of wildlife, including many rare species. The Pinnacle overlooks the picturesque village of Frelighsburg as well as the spectacular ranges of the Green Mountains of Vermont and the Adirondacks of New York State. This incredible setting can be appreciated from the Domaine Pinnacle property, located on the southern slopes of this pristine mountain paradise.

Based on the information acquired during discovery, Opposer has valid grounds to oppose registration of the Mark on the ground of geographic descriptiveness. Opposer timely seeks leave to amend its Notice of Opposition to assert such grounds. Discovery remains open, and the proposed amendment does not require substantial additional planned discovery.

ARGUMENT

OPPOSER SHOULD BE GRANTED LEAVE TO AMEND ITS PETITION TO CANCEL.

A. Leave to Amend is Freely Given in the Absence of Bad Faith, Undue Delay, Undue Prejudice, Dilatory Motive or Futility of Amendment.

Pursuant to Trademark Rule 2.107(b) "[p]leadings in an opposition proceeding . . . may be amended in the same manner and to the same extent as in a civil action in a United States district court." 37 C.F.R. § 2.107. Rule 15(a) of the Federal Rules of Civil Procedure governs

amendments of pleadings in a civil action in the United States district courts, and provides that “leave [to amend] shall be freely given when justice so requires.” Fed. R. Civ. P. 15(a).

Leave to amend is freely granted in the absence of bad faith, undue delay, undue prejudice, dilatory motive or futility of amendment. *See Johnston v. Holiday Inns*, 595 F.2d 890, 896 (1st Cir. 1979)(noting lenient standard for leave to amend, but affirming denial of motion to amend complaint five years after filing of initial complaint and after court granted summary judgment and entered judgment in favor of defendant) (*quoting Foman v. Davis*, 371 U.S. 178, 182 (1962)); *see also Shane v. Fauver*, 213 F. 3d 113, 115 (3rd Cir. 2000). This liberal approach for granting leave to amend “ensures that a particular claim will be decided on the merits rather than on the technicalities.” *Dole v. Arco Chemical Co.*, 921 F.2d 484, 487 (3rd Cir. 1990). A motion to amend should not be denied unless the non-moving party makes a showing that it would be prejudiced if leave to amend were granted. *See e.g. Pendley v. Komori Printing Machinery Co., Ltd.*, Civ. A. No. 8900420P, 1990 WL 17152 at *3 (D.R.I. Feb. 8m 1990); *see also Miller v. Beneficial Management Corp.*, 844 F. Supp. 990, 999-1000 (D. N. J. 1993).

B. Opposer Has Acted in Good Faith and in a Timely Manner

It cannot be suggested that the timing of the instant Motion demonstrates anything other than Opposer’s good faith. Opposer has acted to file this Motion after discovering that the Mark DOMAINE PINNACLE means Pinnacle Estate located at Pinnacle Mountain.

C. Applicant Will Not be Prejudiced by the Amendment

Most importantly, Applicant will not be prejudiced by the amendment at this stage of the proceedings. Discovery is ongoing and no depositions have been taken. Very little, if any, additional discovery will be needed as a result of Opposer’s proposed amendment.

D. Opposer's Claims Have Merit and Amendment Would Not Be Futile

The Motion should also be granted because Opposer's proposed new count has a valid basis in law and in fact. Opposer's proposed Amended Notice of Opposition adequately alleges facts sufficient to support its opposition to registration of Applicant's Mark. As such, Opposer's Motion for Leave to Amend should be granted.

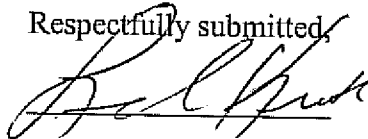
Opposer has adequately pled facts to support refusal to register Applicant's Mark. Opposer alleges that the DOMAINE PINNACLE Mark creates a likelihood of confusion with Opposer's Mark, and that Applicant does not have the requisite intent to use its Mark on apple juices and apple-based non-alcoholic beverages. Opposer now further alleges that Applicant's Mark is geographically descriptive as it refers to Pinnacle Mountain. Given the supporting facts and the legal basis, amendment of Opposer's Notice of Opposition would not be futile and Opposer should be granted leave to file its amended pleadings.

Conclusion

For the foregoing reasons, Opposer respectfully request that its Motion for Leave to Amend be granted.

Dated: September 24, 2008

Respectfully submitted,




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CERTIFICATE OF SERVICE

I hereby certify a copy of the foregoing Opposer's MOTION TO AMEND NOTICE OF OPPOSITION in re: Franciscan Vineyards, Inc. v. Domaine Pinnacle, Inc., Opposition No. 91178682 was served on counsel for Applicant, this 24th day of September, 2008 by sending same via Email and First Class Mail, postage prepaid, to:

THOMAS W. BROOKE
HOLLAND & KNIGHT LLP
2099 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20006-6801
thomas.brooke@hklaw.com

DATED: September 24, 2008



Linda Kurth

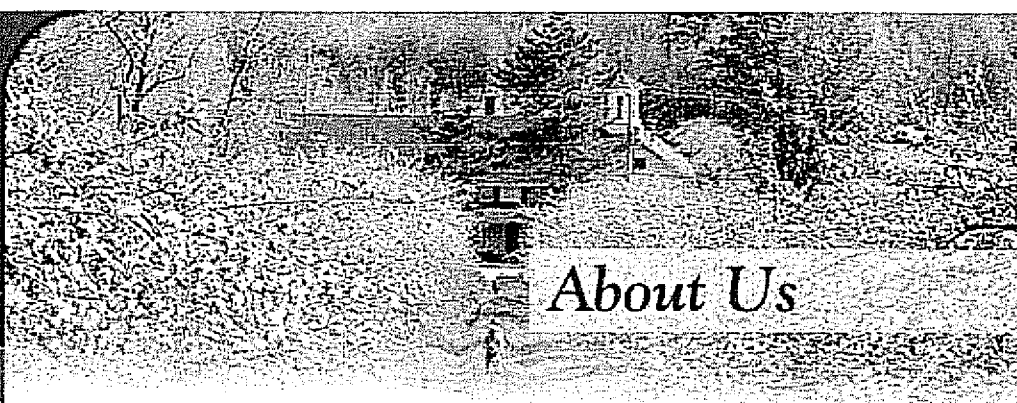
EXHIBIT A



DOMAINE Pinnacle

- Welcome
- About Us
- Visit Us
- Products
- Awards & Reviews
- Recipes
- Purchasing
- Distributor Info
- Media Info
- Contact Us

SELECTED BY
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Founded in 2000, Domaine Pinnacle is a family-owned and operated orchard and cidery located on a 430-acre property on the slopes of Pinnacle Mountain near the historic village of Frelighsburg in the Eastern Townships of Quebec, Canada.

Dedicated to creating the highest quality Ice Apple Wine, all products are hand-crafted entirely on the estate. Located on the 45th parallel, the same latitude as the world's renowned wine-growing regions, the south-facing apple orchards benefit from nearly ideal growing conditions. These growing conditions combined with the intensely cold winter conditions create a unique combination that makes the creation of Ice Apple Wine possible!

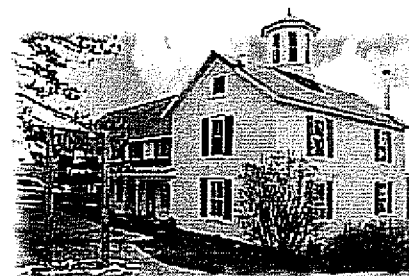


Domaine Pinnacle is owned and operated by Susan and Charles Crawford, urban refugees, who now make the estate the full-time home for their family. Our winemaker is Christian Barthomeuf, the renowned and award-winning father and inventor of Ice Apple Wine. Our multi-disciplinary team is 100% dedicated to supporting this vision.



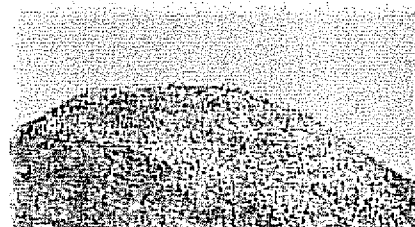
History

The Pinnacle Estates property spans 430 acres and includes a cidery and retail boutique, which is located in the original farmhouse dating back to 1859. The farmhouse apparently has a colorful history with local area residents claiming that it was used as a stop-off point in the underground railway. The turret on the farmhouse was apparently used to watch the Vermont border for people engaged in the abolition movement helping slaves cross into Canada. Later on, during prohibition, apparently the house was also used by a rum-running organization. The spectacular view from the farmhouse of Quebec, Vermont and New York State, obviously was used for more than just sight-seeing!



Pinnacle Mountain

Originally occupied by Abenaki Indians, Pinnacle Mountain is the only truly undeveloped mountain in Quebec within a 90-minute radius of Montreal. Known by generations of locals simply as "The Pinnacle" (elevation 2,336 ft.), it is a refuge for a wide range of wildlife, including many rare species. The Pinnacle overlooks the picturesque village of Frelighsburg as well as the spectacular ranges of



the Green Mountains of Vermont and the Adirondacks of New York State. This incredible setting and views can be appreciated from the Domaine Pinnacle property, located on the southern slopes of this pristine mountain paradise.

Village of Frelighsburg

Domaine Pinnacle is located just 5 km. from the picturesque town of Frelighsburg, located in the Eastern Townships of Quebec, near the Vermont border. Named "The Most Beautiful Village in Quebec", Frelighsburg is a classic Loyalist settlement that blends historic charm with a vibrant and active community. Nestled in a rich valley on the Pike River, Frelighsburg is home to an architectural heritage that preserves many historic buildings and traditions.

The village was settled in the 1790s by American Loyalists, including Abram Freligh a physician of Dutch origin who moved from New York state, and gave his name to the village upon acquiring the sawmill. The mill built by his son in 1839 at the river's edge is considered a historic monument, along with several other buildings. The Anglican (1880) and Catholic (1883) churches whose spires crown this jewel of a village, attest to the cultural diversity that remain an important part of its fabric to this day.

With a population of just over 1,100 residents, Frelighsburg attracts many artists and visitors for its natural beauty and charm. Nestled amongst apple orchards that cover its rolling hills in all directions, and in the shadow of the spectacular and pristine Pinnacle Mountain, Frelighsburg remains as charming and seductive as it did over 200 years ago.