

ESTTA Tracking number: **ESTTA184177**

Filing date: **01/02/2008**

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	Tia Maria Limited
Granted to Date of previous extension	01/02/2008
Address	Chivas House 72 Chancellors Road London, W6 9RS UNITED KINGDOM

Attorney information	Adam Tracy Pernod Ricard USA, LLC 100 Manhattanville Road Purchase, NY 10577 UNITED STATES marlene.musharbash@pernod-ricard-canada.com Phone:914-848-4621
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Applicant Information

Application No	77070133	Publication date	09/04/2007
Opposition Filing Date	01/02/2008	Opposition Period Ends	01/02/2008
Applicants	Engel, James 89 River Street, PO Box 172 Hoboken, NJ 07030 UNITED STATES Ceola, Enore 89 River Street, PO Box 172 Hoboken, NJ 07030 UNITED STATES Tucker, Mark 89 River Street, PO Box 172 Hoboken, NJ 07030 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Distilled Spirits; Wine; Wines

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	609693	Application Date	07/02/1953
Registration Date	07/26/1955	Foreign Priority Date	NONE
Word Mark	TIA MARIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U049 (International Class 033). First use: First Use: 1947/00/00 First Use In Commerce: 1953/04/05 LIQUEURS		

U.S. Registration No.	1075189	Application Date	09/23/1976
Registration Date	10/11/1977	Foreign Priority Date	NONE
Word Mark	TIA MARIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1946/11/00 First Use In Commerce: 1953/04/02 LIQUEURS		

U.S. Registration No.	2218821	Application Date	12/09/1997
Registration Date	01/19/1999	Foreign Priority Date	NONE
Word Mark	TIA MARIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1953/04/05 First Use In Commerce: 1953/04/05 alcoholic beverages namely, liqueurs		

Attachments	71649695#TMSN.gif (1 page)(bytes) 73100881#TMSN.gif (1 page)(bytes) Notice of Opposition Grandma Maria 77070133.pdf (6 pages)(44579 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/at/
Name	Adam Tracy
Date	01/02/2008

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

In the Matter of Application Serial No. 77/070,133
Published in the Official Gazette on September 4, 2007

TIA MARIA LIMITED

Opposer,

- against -

TUCKER, MARK
CEOLA, ENORE
ENGEL, JAMES

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Opposer, Tia Maria Limited (“Opposer”), a corporation organized under the laws of United Kingdom, with an address at Chivas House, 72 Chancellors Road, London, W6 9RS, United Kingdom, believes that it would be damaged by the registration of the mark GRANDMA MARIA’S in International Class 33 as applied for in Application Serial No. 77/070,133 (the “Application”), filed on December 22, 2006 by Tucker, Mark, Ceola, Enore and Engel, James (“Applicant”) under Section 1(b) of the Lanham Act. As grounds for its opposition, Opposer, by its attorney, Adam W. Tracy of Pernod Ricard USA, LLC, alleges as follows:

FACTS COMMON TO ALL CLAIMS

1. Opposer is an entity under the PERNOD RICARD GROUP, a worldwide network of affiliate organizations in the business of the manufacturing, supply, licensing and distribution of alcoholic beverage products throughout the world including but not limited to, well known brands as TIA MARIA®, KAHLUA®, MALIBU®, CHIVAS REGAL®, BEEFEATER®, WILD TURKEY® and SEAGRAM’S GIN®.

2. Opposer and its predecessors in interest have been using the TIA MARIA mark in connection with the worldwide distribution and sale of liqueurs, since as early as 1947. Opposer and its predecessor in interest have been selling TIA MARIA liqueur in the United States since the early 1950s.

3. As a result of Opposer's extensive investment of time, money, and effort, including substantial sales, advertising and promotional activities, the TIA MARIA mark has come to be recognized as identifying liqueurs originating exclusively or otherwise associated with Opposer and the PERNOD RICARD GROUP, and represents a substantial goodwill of Opposer.

4. Opposer owns U.S. Trademark Registration No. 0609693 issued on July 26, 1955, for the mark TIA MARIA in the following design:



for "liqueurs" in International Class 33. This registration is valid, subsisting and in full force and effect, and constitutes evidence of Opposer's exclusive right to use the TIA MARIA mark pursuant to Sections 7 and 33 of the Lanham Act, 15 U.S.C. §§ 1057, 1115(b).

5. Opposer also owns U.S. Registration No. 1075189 issued October 11, 1977, for the mark TIA MARIA in the following design:



for "liqueurs" in International Class 33. This registration is valid, subsisting and in full force and effect, and constitutes evidence of Opposer's exclusive right to use the mark pursuant to

Sections 7 and 33 of the Lanham Act, 15 U.S.C. §§ 1057, 1115(b).

6. Opposer also owns U.S. Registration No. 2218821, issued January 19, 1999, for the word mark TIA MARIA, for “alcoholic beverages namely, liqueurs” in International Class 33. This registration is valid, subsisting and in full force and effect, and constitutes evidence of Opposer’s exclusive right to use the TIA MARIA mark pursuant to Sections 7 and 33 of the Lanham Act, 15 U.S.C. §§ 1057, 1115(b).

7. Upon information and belief, Applicant is a group of individuals located at 89 River Street, PO Box 172, Hoboken, NJ 07030, United States.

8. On or about December 22, 2006, Applicant filed Intent-to-Use Application Serial No. 77/070,133 (the “Application”) to register the mark GRANDMA MARIA’S for “Distilled Spirits; Wine; Wines” in International Class 33.

**LIKELIHOOD OF CONFUSION UNDER
SECTION 2(d) OF THE LANHAM ACT, 15 U.S.C. § 1052(d)**

9. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 8 above as if fully set forth herein.

10. Applicant’s GRANDMA MARIA’S mark is highly similar to Opposer’s TIA MARIA marks, as both Opposer’s and Applicant’s marks contain the word MARIA as well as being phonetically and visually similar.

11. The goods set forth in the Application, are identical to the goods in connection with which Opposer has registered and uses the TIA MARIA marks.

12. On information and belief, Applicant has targeted and/or intends to target the same type of customers that now purchase Opposer’s TIA MARIA products or to whom Opposer markets and promotes its TIA MARIA products, because customers of Applicant’s GRANDMA MARIA’S products would likely overlap with customers of Opponent’s TIA MARIA products,

as they are both alcoholic beverages.

13. Based on the similarities of the parties' respective marks and goods, the public is likely to falsely associate Applicant's goods under the GRANDMA MARIA'S mark with Opposer or with Opposer's goods, falsely believe that Applicant's goods emanate from or are sponsored, endorsed or licensed by Opposer, or falsely believe that there is some relationship between Applicant and Opposer.

14. In addition to the potential for overlapping consumer bases, it is extremely probable that both the online and brick and mortar channels of trade of Applicant's applicable products marketed and sold under Applicant's GRANDMA MARIA'S mark will overlap with the current channels of trade of Opposer's TIA MARIA liqueur products.

15. Applicant's Application and the presumption of exclusivity that would arise from a registration to Applicant of the GRANDMA MARIA'S mark are inconsistent with Opposer's prior rights in the TIA MARIA marks and the rights flowing from Opposer's federal trademark registrations for the mark TIA MARIA.

16. Use and registration of the GRANDMA MARIA'S mark by Applicant in connection with its goods in International Class 33 is likely to cause confusion, cause mistake or deceive consumers, and cause them to believe that the goods offered under Applicant's GRANDMA MARIA'S mark emanate from, or are sponsored by, endorsed by or otherwise connected with Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

17. Opposer will be damaged by the registration of Applicant's GRANDMA MARIA'S mark by reason of the foregoing, and because it would give color of right therein to Applicant inconsistent with Opposer's prior rights.

**DILUTION UNDER SECTION 43(c)
OF THE LANHAM ACT, U.S.C. § 1125(c)**

18. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 17 above as if fully set forth herein.

19. Opposer's TIA MARIA marks acquired distinctiveness and became famous prior to Applicant's filing of the Application to register the GRANDMA MARIA'S mark.

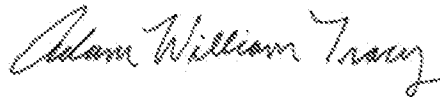
20. Use and registration of the GRANDMA MARIA'S mark by Applicant is likely to dilute Opposer's TIA MARIA marks by creating an association that impairs the distinctiveness and/or harms the reputation of the TIA MARIA marks in violation of 15 U.S.C. § 1125(c).

21. Opposer will be damaged by the registration of Applicant's GRANDMA MARIA'S mark by reason of the foregoing.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration in International Class 33 sought by Application Serial No. 77/070,133 be denied.

Dated: Purchase, New York
January 2, 2008

PERNOD RICARD USA, LLC on behalf of
TIA MARIA LIMITED



By: _____

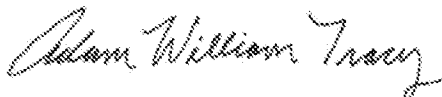
Adam W. Tracy, Esq.
Attorney for Applicant
100 Manhattanville Road
Purchase, NY 10577
914-848-4621

Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that I have caused a copy of the foregoing Notice of Opposition to be sent by pre-paid first class mail to Applicant at the following address on this 2nd day of January 2008:

89 River Street
PO Box 172
Hoboken
NJ 07030
United States

A handwritten signature in cursive script that reads "Adam William Tracy".

Adam W. Tracy