

ESTTA Tracking number: **ESTTA193691**

Filing date: **02/20/2008**

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	Pernod Ricard USA, LLC
Granted to Date of previous extension	02/20/2008
Address	100 Manhattanville Road Purchase, NY 10577 UNITED STATES

Attorney information	David H. Bernstein Debevoise & Plimpton LLP 919 Third Avenue New York, NY 10022 UNITED STATES trademarks@debevoise.com, szparnass@debevoise.com Phone:212-909-6696
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**Applicant Information**

Application No	77032829	Publication date	10/23/2007
Opposition Filing Date	02/20/2008	Opposition Period Ends	02/20/2008
Applicant	Natural Organics, Inc. 548 Broadhollow Road Melville, NY 117473708 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 032. All goods and services in the class are opposed, namely: Non-alcoholic beverages, namely, fruit juice beverages
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1261893	Application Date	08/30/1982
Registration Date	12/20/1983	Foreign Priority Date	NONE
Word Mark	MALIBU		
Design Mark			

Description of Mark	THE MARK CONSISTS OF THE CONFIGURATION OF THE REEL INCLUDING THE CYLINDRICALLY SHAPED BODY HAVING A CONICALLY SHAPED FRONT PORTION, A SHALLOW CONE SHAPED REAR PORTION AND A PAIR OF SPACED APART RIBS ABOUT THE CYLINDRICALLY SHAPED BODY.
Goods/Services	Class 033. First use: Liqueur

U.S. Registration No.	1374134	Application Date	04/28/1983
Registration Date	12/03/1985	Foreign Priority Date	NONE
Word Mark	MALIBU		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1980/09/02 First Use In Commerce: 1983/03/00 LIQUEUR		

Attachments	73423567#TMSN.gif ( 1 page )( bytes ) NoticeofOpposition_MalibuMiracle.pdf ( 6 pages )(21388 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 Overnight Courier on this date.

Signature	/S. Zev Parnass/
Name	S. Zev Parnass
Date	02/20/2008

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

In the Matter of Trademark Application Serial No. 77/032,829  
Filed: October 31, 2006  
Mark: MALIBU MIRACLE  
Published: October 23, 2007

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PERNOD RICARD USA, LLC, :  
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                   v. :  
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 NATURAL ORGANICS, INC., :       Opposition No. \_\_\_\_\_  
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Commissioner for Trademarks  
United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Dear Sirs:

Pernod Ricard USA, LLC (“Opposer”), an Indiana limited liability company with an address at 100 Manhattanville Road, Purchase, New York 10577, believes that it would be damaged by the registration of the mark MALIBU MIRACLE in International Class 32 for “non-alcoholic beverages, namely, fruit juice beverages” as applied for in Application Serial No. 77/032,829 (the “Application”), filed on October 31, 2006 by Natural Organics, Inc. (“Applicant”) under Section 1(b) of the Lanham Act. As grounds for its opposition, Opposer, by its attorneys, Debevoise & Plimpton LLP, alleges as follows:

1. Opposer is a leading producer and distributor of wines and spirits. Opposer also distributes and licenses non-alcoholic beverages, including mixers and fruit juices.

2. Opposer and its predecessors in interest have been using the MALIBU mark in connection with the distribution and sale of fruit-flavored rum liqueurs since at least 1980. MALIBU liqueurs are available in a variety of fruit flavors, namely, coconut, mango, pineapple, banana and passion fruit.

3. MALIBU liqueurs are typically blended with fruit juices and other mixers in creating cocktails.

4. As a result of Opposer's extensive investment of time, money and effort, including substantial sales, advertising and promotional activities, the MALIBU mark has come to be recognized as identifying liqueur originating exclusively or otherwise associated with Opposer, and represents a substantial goodwill of Opposer. Indeed, the MALIBU mark has become so famous that it is one of the most recognized alcohol brands in the world.

5. Opposer owns U.S. Trademark Registration No. 1,261,893, issued on December 20, 1983, for the word mark MALIBU for liqueur 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 MALIBU 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. 1,374,134, issued December 3, 1985, for the design mark shown at right for liqueur in International Class 33. This registration is also valid, subsisting and in full force and effect, and constitutes evidence of



Opposer's exclusive right to use the MALIBU plus design 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 New York corporation located and doing business at 548 Broadhollow Road, Melville, New York 11747.

8. On or about October 31, 2006, Applicant filed the Application to register the mark MALIBU MIRACLE for fruit juice beverages in International Class 32. The Application is based on an intent to use the MALIBU MIRACLE mark; no allegation of use has yet been filed.

9. Applicant's MALIBU MIRACLE mark is highly similar to Opposer's MALIBU marks, as both Opposer's and Applicant's marks contain the word MALIBU.

10. The goods set forth in the Application are closely related to the goods in connection with which Opposer has registered and uses the MALIBU marks. By definition, liqueurs are sweet alcoholic beverages, often flavored with fruit. Thus, both MALIBU liqueurs and MALIBU MIRACLE juices are fruit-flavored beverages. Moreover, as noted above, it is common for fruit juices to be blended with MALIBU liqueurs in creating cocktails.

11. Based on the similarities of the parties' respective marks and goods, the public is likely to falsely associate Applicant's goods under the MALIBU MIRACLE 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.

12. Applicant's Application and the presumption of exclusivity that would arise from a registration to Applicant of the MALIBU MIRACLE mark are inconsistent with Opposer's

prior rights in the MALIBU marks and the rights flowing from Opposer's federal trademark registrations for the mark MALIBU.

13. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

14. Use and registration of the MALIBU MIRACLE mark by Applicant in connection with its goods in International Class 32 is likely to cause confusion, cause mistake or deceive consumers, and cause them to believe that the goods offered under Applicant's MALIBU MIRACLE 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).

15. Registration should be refused pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Applicant's use of the mark MALIBU MIRACLE falsely suggests a connection between Applicant and Opposer, with consequent injury to Opposer and to the public.

16. Registration also should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that Applicant's MALIBU MIRACLE mark so resembles Opposer's MALIBU marks, cited above and used consistently by Opposer in the United States, as to be likely to cause confusion, or to cause mistake, or to deceive, with consequent injury to Opposer and to the public.

WHEREFORE, Opposer believes it will be damaged by the registration by Applicant of the MALIBU MIRACLE mark in International Class 32 as sought by Application Serial No. 77/032,829 and respectfully requests that the Opposition be sustained, registration of said mark

be denied, and that the Trademark Trial and Appeal Board grant such other and further relief as it deems just and appropriate.

Payment has been provided in the requisite amount to cover the statutory filing fee for filing a Notice of Opposition. All communications should be addressed to Opposer's counsel, Debevoise & Plimpton LLP, at the address stated below.

Dated: February 20, 2008  
New York, New York

Respectfully submitted,

DEBEVOISE & PLIMPTON LLP

By: /S. Zev Parnass/  
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(212) 909-6696  
trademarks@debevoise.com

Attorneys for Opposer  
Pernod Ricard USA, LLC

CERTIFICATE OF SERVICE

I, S. Zev Parnass, an attorney admitted in the State of New York, caused on this 20th day of February, 2008 a copy of the Notice of Opposition, dated February 20, 2008, to be served, by FedEx overnight courier, upon:

Pasquale A. Razzano, Esq.  
Fitzpatrick, Cella, Harper & Scinto  
30 Rockefeller Plaza  
New York, NY 10112-3800

*Attorney of Record for Applicant*

I certify under the penalty of perjury that the foregoing is true and correct.

Dated: February 20, 2008  
New York, New York

/S. Zev Parnass/  
S. Zev Parnass