

ESTTA Tracking number: **ESTTA314133**

Filing date: **10/29/2009**

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

Proceeding	91192007
Party	Defendant INULINA Y MIEL DE AGAVE SA DE CV
Correspondence Address	ALEJANDRO R. MALACARA 82 CHAPEL HILL CIR SAN ANTONIO, TX 78240-3903 MYGABOGADOS@INFOSEL.NET.MX
Submission	Answer
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Date	10/29/2009
Attachments	Answer to Opposition #91192007 - Serial #77620461 (HERRADURA).pdf (22 pages)(799687 bytes)

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

In the Matter of Application Serial No. 77/620,461
Filed November 24, 2008
For the mark **HERRADURA**
Published in the OFFICIAL GAZETTE on April 7, 2009

BROWN-FORMAN CORPORATION,

Opposer,

v.

INULINA Y MIEL DE AGAVE, S.A. DE C.V.,
a Mexico corporation,

Applicant.

Opposition No.: 91192007

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant Inulina y Miel de Agave, S.A. de C.V. ("Applicant"), while utilizing the paragraph numbering referenced in the Notice of Opposition ("Opposition") filed by Opposer Brown-Forman Corporation ("Opposer"), answers as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Opposition.
2. Applicant admits the allegation contained in paragraph 2 of the Opposition that Applicant is a corporation organized and existing under the laws of Mexico, with offices in Capilla de Guadalupe, Mexico.
3. Applicant admits the allegations contained in paragraph 3 of the Opposition.

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Opposition.

5. Upon information and belief, Applicant admits the allegation contained in paragraph 5 of the Opposition that Opposer owns United States Trademark Reg. No. 3,271,918 for the mark "HERRADURA" for alcoholic beverages, namely, tequila and mixed beverages or ready to drink beverages containing tequila or other spirits. Upon information and belief, Applicant denies the allegation contained in paragraph 5 of the Opposition that Opposer owns Application Serial No. 78/814,633 to register "HERRADURA" for non-alcoholic beverages (namely, drinks produced with fruit and vegetable juices and spices; non-alcoholic cocktail mixes) because Opposer abandoned Application Serial No. 78/814,633 on October 19, 2009. A copy of the record of Application Serial No. 78/814,633 taken from the TARR electronic database of the U.S. Patent and Trademark Office and showing the current ABANDONED and DEAD status of Application Serial No. 78/814,633 is attached hereto as Exhibit 1 and is incorporated by reference as if fully set forth herein. Applicant denies the allegation contained in paragraph 5 of the Opposition that Opposer's Application Serial No. 78/814,633 has a constructive use priority filing date of February 14, 2006, that predates the filing date of the Opposed Application, because Opposer's Application Serial No. 78/814,633 was filed under a different class of goods than the Opposed Application and because Opposer's Application Serial No. 78/814,633 was abandoned on October 19, 2009, as shown on Exhibit 1.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6 of the Opposition.

7. Applicant admits the allegation contained in paragraph 7 of the Opposition that in addition to being the source of the mash from which tequila is distilled, the blue agave plant is the source of a nectar that is used as a natural sweetener, as a syrup, and as a substitute for honey. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 7 of the Opposition that the nectar derived from the blue agave plant is used as an ingredient in alcoholic cocktails made with tequila. Applicant denies the allegation contained in paragraph 7 of the Opposition that as a derivative of the agave plant, agave nectar is within the natural zone of product expansion for producers of tequila.

8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 8 of the Opposition that: (a) several owners of trademarks for tequila have introduced agave nectar products under their tequila marks; or (b) Opposer has introduced an agave nectar product in the United States under its "HERRADURA" mark. Upon information and belief, Applicant admits the allegation contained in paragraph 8 of the Opposition that Opposer owns Application Serial No. 77/736,964 to register the mark "HERRADURA AGAVE NECTAR" and design for a natural sweetener, pancake syrup, and table syrup. However, Applicant filed the Opposed Application almost six months before Opposer filed Application Serial No. 77/736,964 as an Intent-to-Use application on May 13, 2009, and the U.S. Patent and Trademark Office issued a Non-Final Action concerning Application Serial No. 77/736,964 on July 23, 2009, as noted in a copy of the record of Application Serial No. 77/736,964 taken from the TARR electronic database of the U.S. Patent and Trademark Office that is attached hereto as Exhibit 2 and is incorporated by reference as

if fully set forth herein. Upon information and belief, Applicant admits the allegation contained in paragraph 8 of the Opposition that Opposer owns Application Serial No. 77/735,890 to register the word-only mark “HERRADURA” for a natural sweetener. However, Applicant filed the Opposed Application almost six months before Opposer filed Application Serial No. 77/735,890 as an Intent-to-Use application on May 13, 2009, and the U.S. Patent and Trademark Office issued an Office Action suspending further action concerning Application Serial No. 77/735,890 on July 23, 2009, as noted in a copy of the record of Application Serial No. 77/735,890 taken from the TARR electronic database of the U.S. Patent and Trademark Office that is attached hereto as Exhibit 3 and is incorporated by reference as if fully set forth herein.

9. Applicant admits the allegations contained in paragraph 9 of the Opposition that: (a) Applicant is located in the State of Jalisco in Mexico and is engaged in the production of inulin, nectar, and syrups made from the blue agave plant; (b) Applicant’s agave nectar and syrups are used as toppings, sweeteners, and honey substitutes; and (c) Applicant was aware of Opposer’s “HERRADURA” mark for tequila when Applicant selected and adopted the “HERRADURA” mark shown in the Opposed Application. Applicant denies the allegation contained in paragraph 9 of the Opposition that Applicant selected and adopted the “HERRADURA” mark with the intent to pass off its “HERRADURA” goods as originating from the same source as “HERRADURA” tequila or as being licensed, sponsored, or authorized by the owner of the “HERRADURA” mark for tequila.

10. Applicant admits the allegation contained in paragraph 10 of the Opposition that Applicant has filed two other applications in the U.S. Patent and

Trademark Office, namely: (a) Application Serial No. 77/620,828 to register the mark “DON JULIO” for goods identified as honey, honey substitutes, pancake syrup, table syrup and topping syrup; and (b) Application Serial No. 77/620,849 to register the mark “CAZADORES” for goods identified as flavoring syrup, honey, honey substitutes and table syrup.

11. Applicant denies the allegations contained in paragraph 11 of the Opposition.

12. In paragraph 12 of the Opposition, Opposer repeats and realleges the allegations in paragraphs 1 through 11 of the Opposition as if fully set forth therein. Accordingly, no further answer is required.

13. Applicant denies the allegations contained in paragraph 13 of the Opposition.

14. Applicant admits the allegation in paragraph 14 of the Opposition that registration of the mark in the Opposed Application will give Applicant *prima facie* evidence of ownership of and the exclusive right to use the mark, but only in connection with the limited goods identified in the Opposed Application. Applicant denies the remaining allegations contained in paragraph 14 of the Opposition.

15. In paragraph 15 of the Opposition, Opposer repeats and realleges the allegations in paragraphs 1 through 11 of the Opposition as if fully set forth therein. Accordingly, no further answer is required.

16. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 16 of the Opposition because Opposer’s “HERRADURA” mark for tequila registered under U.S. Trademark

Registration No. 3,271,918 (Opposer's Exhibit 1) is the only specific evidence of actual use pleaded by Opposer as grounds for its Opposition. Opposer did not plead any specific evidence of actual use of any other previously used, constructively used and not-abandoned "HERRADURA" mark as grounds for its Opposition.

17. Applicant admits the allegation in paragraph 17 of the Opposition that registration of the mark shown in the Opposed Application will give Applicant *prima facie* evidence of ownership of and the exclusive right to use the mark, but only in connection with the limited goods identified in the Opposed Application. Applicant does not have sufficient knowledge or information to form a belief as to the truth of the remaining allegations contained in paragraph 17 of the Opposition.

AFFIRMATIVE DEFENSES

1. Opposer's "HERRADURA" mark for tequila registered under U.S. Trademark Registration No. 3,271,918 (Opposer's Exhibit 1) consists of a single commonly-used Spanish-language word which, while distinctive when used by Opposer in relation to tequila and other alcoholic beverages classified under International Class 033, is not so distinctive as to afford Opposer the exclusive right to its ownership and use over the entire spectrum of classification of goods.

2. There is no likelihood of confusion, mistake or deception because, *inter alia*, the goods identified in the Opposed Application are limited non-alcoholic goods categorized under a different international class of goods than Opposer's "HERRADURA" tequila and other alcoholic beverages.

3. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's "HERRADURA" mark is intended to have a different look and

appearance than Opposer's "HERRADURA" mark for tequila and other alcoholic beverages, which Opposer actually uses in commerce in a highly stylized manner and in conjunction with a horseshoe design that Applicant does not intend to use in conjunction with Applicant's "HERRADURA" mark.

4. There is no likelihood of confusion, mistake or deception because, *inter alia*, the non-alcoholic goods Applicant intends to market under its "HERRADURA" mark are significantly different than the tequila and other alcoholic beverages marketed under Opposer's "HERRADURA" mark. The channels of commerce, price points, and demographics of potential purchasers of Applicant's "HERRADURA" non-alcoholic goods are widely divergent from the channels of commerce, price points, and demographics of potential purchasers of Opposer's "HERRADURA" tequila and other alcoholic beverages. Consequently, purchasers of goods promoted and sold under Applicant's "HERRADURA" mark will readily recognize the difference between the sources of goods promoted under Applicant's "HERRADURA" mark and any valid or prior "HERRADURA" mark of Opposer.

5. Opposer's claims are barred by abandonment.
6. Opposer's claims are barred by estoppel.
7. Opposer's claims are barred by laches.
8. Opposer's claims are barred by waiver.

PRAYER FOR RELIEF

WHEREFORE, Applicant respectfully requests that the Board deny Opposer Brown-Forman Corporation's prayer for judgment, that it dismiss this opposition proceeding in its entirety, that it grant Applicant's request for registration of the mark

shown in the Opposed Application, and that it grant such other relief as it deems just and appropriate.

Respectfully submitted,

RHINE ERNEST LLP

Dated: October 29, 2009

By: _____

Luz A. Lettiere
Attorneys for Applicant
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S.A. DE C.V.

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EXHIBIT 1

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-10-27 11:36:10 ET

Serial Number: 78814633 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

HERRADURA

(words only): HERRADURA

Standard Character claim: Yes

Current Status: Abandoned: No Statement of Use filed after Notice of Allowance was issued.

Date of Status: 2009-10-19

Filing Date: 2006-02-14

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 700 -Intent To Use Section

Date In Location: 2008-09-16

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BROWN-FORMAN CORPORATION

Address:

EXHIBIT 1

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BROWN-FORMAN CORPORATION
850 DIXIE HIGHWAY
LOUISVILLE, KY 40210
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 032
Class Status: Active
NON-ALCOHOLIC BEVERAGES, NAMELY, DRINKS PRODUCED WITH FRUIT AND
VEGETABLE JUICES AND SPICES; NON-ALCOHOLIC COCKTAIL MIXES
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Translation: The foreign wording in the mark translates into English as "horseshoe".

Prior Registration Number(s):
1208838
1852438

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-10-19 - Abandonment Notice Mailed - No Use Statement Filed
2009-10-19 - Abandonment - No use statement filed
2009-03-11 - Extension 1 granted
2009-03-11 - Extension 1 filed
2009-03-11 - TEAS Extension Received
2008-09-16 - Noa Mailed - SOU Required From Applicant
2008-06-24 - Published for opposition

EXHIBIT 1

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2008-06-04 - Notice of publication
2008-05-19 - Law Office Publication Review Completed
2008-05-19 - Assigned To LIE
2008-05-19 - Approved for Pub - Principal Register (Initial exam)
2008-04-24 - Teas/Email Correspondence Entered
2008-04-24 - Communication received from applicant
2008-04-24 - TEAS Response to Office Action Received
2008-01-03 - Attorney Revoked And/Or Appointed
2008-01-03 - TEAS Revoke/Appoint Attorney Received
2007-10-29 - Notification Of Non-Final Action E-Mailed
2007-10-29 - NON-FINAL ACTION E-MAILED
2007-10-29 - Non-Final Action Written
2007-09-29 - Teas/Email Correspondence Entered
2007-09-28 - Communication received from applicant
2007-09-28 - TEAS Response to Office Action Received
2007-04-04 - Automatic Update Of Assignment Of Ownership
2007-03-30 - NON-FINAL ACTION E-MAILED
2007-03-30 - Non-Final Action Written
2007-03-09 - Previous allowance count withdrawn
2007-02-16 - Approved for Pub - Principal Register (Initial exam)
2007-02-16 - Examiner's Amendment Entered
2007-02-16 - EXAMINERS AMENDMENT E-MAILED
2007-02-16 - Examiners Amendment - Written
2007-01-12 - Teas/Email Correspondence Entered
2007-01-11 - Communication received from applicant

EXHIBIT 1

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2007-01-11 - TEAS Response to Office Action Received
2006-07-28 - Non-final action e-mailed
2006-07-28 - Non-Final Action Written
2006-07-28 - Assigned To Examiner
2006-03-31 - Applicant amendment prior to exam entered
2006-03-31 - TEAS Preliminary Amendment Received
2006-02-22 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

David S. Gooder

Correspondent

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Domestic Representative

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Fax Number: 415-446-5230

EXHIBIT 2

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-10-27 11:38:25 ET

Serial Number: 77736964 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark



(words only): HERRADURA AGAVE NECTAR TEQUILA ORIGINAL EST 1870

Standard Character claim: No

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2009-07-23

Filing Date: 2009-05-14

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

Attorney Assigned:
HABEEB MYRIAH A

Current Location: L5X -TMEG Law Office 105 - Examining Attorney Assigned

Date In Location: 2009-07-23

EXHIBIT 2

13

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Brown-Forman Corporation

Address:

Brown-Forman Corporation
850 Dixie Highway
Louisville, KY 40210
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

Phone Number: 415-446-5225

Fax Number: 415-446-5230

GOODS AND/OR SERVICES

International Class: 030

Class Status: Active

Natural sweetener; Pancake syrup; Table syrup

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Description of Mark: The mark consists of the words HERRADURA AGAVE NECTAR; design of a horseshoe with the words HERRADURA, ORIGINAL, TEQUILA and EST. 1870 imposed thereon; image of an agave plant in a field; and stylized representations of agave plants.

Translation: The English translation of HERRADURA in the mark is horseshoe.

Design Search Code(s):

05.13.03 - Grasses

05.13.25 - Bales of hay or straw; Hay in bales; Other plants including bales of hay or straw; Straw in bales

07.07.02 - Skylights; Windows

18.13.01 - Horseshoes

20.03.06 - Address labels; Hang tags; Identification tags; Labels; Tags (paper)

20.03.10 - Alcohol bottle labels; Bottles, labels for alcohol bottles; Labels, alcohol bottles

24.09.07 - Advertising, banners; Banners

26.11.21 - Rectangles that are completely or partially shaded

26.11.25 - Rectangles with one or more curved sides

26.17.01 - Bands, straight; Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s)

26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal

Prior Registration Number(s):

1208838

EXHIBIT 2

14

3271918
3272054

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

- 2009-07-23 - Notification Of Non-Final Action E-Mailed
- 2009-07-23 - Non-final action e-mailed
- 2009-07-23 - Non-Final Action Written
- 2009-07-17 - Assigned To Examiner
- 2009-05-19 - Notice Of Design Search Code Mailed
- 2009-05-18 - New Application Office Supplied Data Entered In Tram
- 2009-05-18 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

David S. Gooder

Correspondent

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4040 CIVIC CENTER DR STE 528
SAN RAFAEL, CA 94903-4191
Phone Number: 415-446-5225
Fax Number: 415-446-5230

EXHIBIT 3

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2009-10-27 11:48:27 ET

Serial Number: 77735890 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark

HERRADURA

(words only): HERRADURA

Standard Character claim: Yes

Current Status: An office action suspending further action on the application has been mailed.

Date of Status: 2009-07-23

Filing Date: 2009-05-13

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 105

Attorney Assigned:
HABEEB MYRIAH A

Current Location: L5X -TMEG Law Office 105 - Examining Attorney Assigned

Date In Location: 2009-07-23

LAST APPLICANT(S)/OWNER(S) OF RECORD

EXHIBIT 3

16

1. Brown-Forman Corporation

Address:

Brown-Forman Corporation
850 Dixie Highway
Louisville, KY 40210
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Delaware**Phone Number:** 415-446-5225**Fax Number:** 415-446-5230

GOODS AND/OR SERVICES

International Class: 030**Class Status:** Active

Natural sweetener

Basis: 1(b)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Translation: The English translation of HERRADURA in the mark is horseshoe.**Prior Registration Number(s):**

1208838

3271918

3272054

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-07-23 - Notification Of Letter Of Suspension E-Mailed

2009-07-23 - Letter of suspension e-mailed

2009-07-23 - Suspension Letter Written

2009-07-17 - Assigned To Examiner

EXHIBIT 3

17

2009-05-18 - New Application Office Supplied Data Entered In Tram

2009-05-16 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

David S. Gooder

Correspondent

DAVID S. GOODER

BROWN-FORMAN BRANDS

4040 CIVIC CENTER DR STE 528

SAN RAFAEL, CA 94903-4191

Phone Number: 415-446-5225

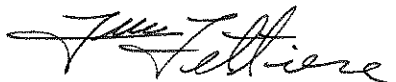
Fax Number: 415-446-5230

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION was served on Opposer by mailing said copy on October 29, 2009, via First Class Mail, postage prepaid, addressed to Opposer's counsel of record in the records of the U.S. Patent and Trademark Office, as follows:

Christopher C. Larkin
SEYFARTH SHAW LLP
2029 Century Park East, Suite 3500
Los Angeles, CA 90067-3021

I declare under penalty of perjury under the laws of the State of Indiana and the United States of America that the foregoing is true and correct, and that this declaration was executed on October 29, 2009, in Evansville, Indiana.



Luz A. Lettiere