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Filing date: **11/03/2009**

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

Proceeding	91192056
Party	Defendant INULINA Y MIEL DE AGAVE SA DE CV
Correspondence Address	Luz A. Lettiere Rhine Ernest LLP One Main Street, Suite 600 Evansville, IN 47708 llettiere@rhine-ernest.com
Submission	Answer
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Date	11/03/2009
Attachments	Answer to Opposition #91192056 - Serial #77620828 (DON JULIO).pdf (20 pages)(673739 bytes)

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

In the Matter of Application Serial No. 77/620,828
Filed November 24, 2008
For the mark **DON JULIO**
Published in the OFFICIAL GAZETTE on June 2, 2009

TEQUILA DON JULIO, S.A. DE C.V.,
a Mexico corporation,

Opposer,

v.

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

Applicant.

Opposition No.: 91192056

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 Tequila Don Julio, S.A. de C.V. ("Opposer"), answers as follows:

1. Upon information and belief, Applicant admits the allegation contained in paragraph 1 of the Opposition that Opposer is the owner of the registered mark "DON JULIO" specifically pleaded in the Opposition and that Opposer has all right, title and interest in and to said registered mark in connection with tequila. However, Applicant denies that Opposer has all right, title and interest in and to the words "DON JULIO" apart from their use in connection with Opposer's tequila and distilled spirits, since other third parties own validly existing registrations of: (a) the identical mark "DON JULIO" in standard characters, Reg. No. 1059528, registered in International Class 034, for

cigars; and (b) a design plus words mark containing “DON JULIO” as the dominant element combined with the word “AUTHENTIC”, Reg. No. 2014798, registered in International Class 029, for Mexican food products. A true and correct copy of the record of Reg. No. 1059528 taken from the United States Patent and Trademark Office’s TARR electronic database is attached hereto as Exhibit 1 and is incorporated by reference as if fully set forth herein. A true and correct copy of the record of Reg. No. 2014798 taken from the United States Patent and Trademark Office’s TARR electronic database is attached hereto as Exhibit 2 and is incorporated by reference as if fully set forth herein. Given the valid existence of Reg. No. 1059528 and Reg. No. 2014798, Applicant denies the allegation contained in paragraph 1 of the Opposition that the mark DON JULIO has long been associated in the United States exclusively with Opposer’s products. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 1 of the Opposition that the mark DON JULIO has long been associated in Mexico and elsewhere (not including the United States) exclusively with Opposer’s products. Upon information and belief, Applicant admits the allegation contained in paragraph 1 of the Opposition that Opposer uses the trade name Tequila Don Julio.

2. Upon information and belief, Applicant admits the allegations contained in paragraph 2 of the Opposition.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the 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. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Opposition.

6. Applicant admits the allegations contained in paragraph 6 of the Opposition.

7. Applicant admits the allegations contained in paragraph 7 of the Opposition.

8. Applicant admits the allegation contained in paragraph 8 of the Opposition that Applicant's Application covers goods such as syrups and toppings. Applicant denies the remaining allegations contained in paragraph 8 of the Opposition.

9. Applicant admits the allegations contained in paragraph 9 of the Opposition.

10. Applicant admits the allegations contained in paragraph 10 of the Opposition that the applied-for mark shown in Applicant's Application is identical to Opposer's DON JULIO mark and consists of the identical dominant DON JULIO in Opposer's DON JULIO 1942, DON JULIO REAL and RESERVA DE DON JULIO marks, but only in that they consist of the same standard characters.

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

12. Applicant admits the allegation contained in paragraph 12 of the Opposition that certain of its products are derived from the agave plant. Upon information and belief, Applicant admits the allegation contained in paragraph 12 of the Opposition that the agave plant is the source of Opposer's DON JULIO tequila.

13. Applicant admits the allegation contained in paragraph 13 of the Opposition that the applied-for mark shown in Applicant's Application: (a) is identical to Opposer's DON JULIO mark, in that they both consist of the same standard characters; and (b) consists of the same dominant element of Opposer's DON JULIO formative marks. Applicant denies the allegation contained in paragraph 13 of the Opposition that, when used in connection with the goods identified in Applicant's Application, Applicant's mark "DON JULIO" is likely to cause confusion or mistake, or to deceive.

14. Applicant denies the allegations contained in paragraph 14 of the Opposition.

AFFIRMATIVE DEFENSES

1. Except when used in connection with tequila and distilled spirits, Opposer does not have the exclusive right to use the mark "DON JULIO". Other third parties own validly existing registrations of: (a) the identical mark "DON JULIO" in standard characters, Reg. No. 1059528, registered in International Class 034, for cigars; and (b) a design plus words mark containing "DON JULIO" as the dominant element combined with the word "AUTHENTIC", Reg. No. 2014798, registered in International Class 029, for Mexican food products.

2. There is no likelihood of confusion, mistake or deception because, *inter alia*, the goods identified in Applicant's Application are limited non-alcoholic goods categorized under a different international class of goods than Opposer's "DON JULIO" marks for tequila and distilled spirits.

3. Assuming the goods identified in Applicant's Application are deemed to be related to the tequila sold by Opposer under its DON JULIO marks, Opposer's claim

that it has the exclusive right to use the mark “DON JULIO” in connection with the types of goods identified in Applicant’s Application is barred by abandonment and acquiescence because Opposer previously filed, and then abandoned, an application to register the “DON JULIO” mark for, among other goods, “syrups and other preparations for making beverages”. A true and correct copy of the record of Opposer’s abandoned application (Serial No. 76543420, filed on September 8, 2003, and abandoned on October 29, 2004) taken from the United States Patent and Trademark Office’s TARR electronic database is attached hereto as Exhibit 3 and is incorporated by reference as if fully set forth herein.

4. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant’s “DON JULIO” mark is intended to have a different look and appearance than Opposer’s “DON JULIO” mark for tequila and distilled spirits, which Opposer uses in commerce in a highly stylized manner and in conjunction with a logo design that Applicant does not intend to use in conjunction with Applicant’s “DON JULIO” mark.

5. There is no likelihood of confusion, mistake or deception because, *inter alia*, the non-alcoholic goods Applicant intends to market under its “DON JULIO” mark are significantly different than the tequila and distilled spirits marketed under Opposer’s “DON JULIO” mark. The channels of commerce, price points, and demographics of potential purchasers of Applicant’s “DON JULIO” non-alcoholic goods are widely divergent from the channels of commerce, price points, and demographics of potential purchasers of Opposer’s “DON JULIO” tequila and distilled spirits. Consequently, purchasers of goods promoted and sold under Applicant’s “DON JULIO” mark will readily recognize the difference between the sources of goods promoted under

Applicant's "DON JULIO" mark and any of Opposer's "DON JULIO" marks for tequila and distilled spirits.

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 Tequila Don Julio, S.A. de C.V.'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: November 3, 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 2009-11-03 13:29:22 ET

Serial Number: 73090895 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1059528

Mark (words only): DON JULIO

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2006-12-15

Filing Date: 1976-06-18

Transformed into a National Application: No

Registration Date: 1977-02-15

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

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: 40S -Scanning On Demand

Date In Location: 2007-11-07

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

1. SWISHER INTERNATIONAL, INC.

Address:

SWISHER INTERNATIONAL, INC.
459 EAST 16TH STREET
JACKSONVILLE, FL 32206
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

Exhibit 1

Page 1 of 3

GOODS AND/OR SERVICES

International Class: 034
Class Status: Active
CIGARS
Basis: 1(a)
First Use Date: 1976-06-08
First Use in Commerce Date: 1976-06-08

ADDITIONAL INFORMATION

Name Portrait Consent: "DON JULIO" IS A FICTITIOUS NAME AND NOT THE NAME OF ANY PARTICULAR LIVING INDIVIDUAL.

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.

- 2007-11-07 - Case File In TICRS
- 2007-01-03 - Automatic Update Of Assignment Of Ownership
- 2006-12-15 - Second renewal 10 year
- 2006-12-15 - Section 8 (10-year) accepted/ Section 9 granted
- 2006-12-15 - Assigned To Paralegal
- 2006-10-13 - Combined Section 8 (10-year)/Section 9 filed
- 2006-10-13 - TEAS Section 8 & 9 Received
- 2004-05-12 - TEAS Change Of Correspondence Received
- 1996-12-05 - First renewal 10 year
- 1996-10-24 - Section 9 filed/check record for Section 8
- 1982-05-17 - Section 8 (6-year) accepted & Section 15 acknowledged

Exhibit 1

Page 2 of 3

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
DONALD C LUCAS

Correspondent

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15TH FLOOR
475 PARK AVENUE SOUTH
NEW YORK NY 10016
Phone Number: 212-661-8000
Fax Number: 212-661-8002

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 2009-11-03 13:30:41 ET

Serial Number: 74611486 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2014798

Mark



(words only): DON JULIO AUTHENTIC

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2007-01-18

Filing Date: 1994-12-15

Transformed into a National Application: No

Registration Date: 1996-11-12

Register: Principal

Law Office Assigned: LAW OFFICE 101

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: 830 -Post Registration

Date In Location: 2007-01-18

Exhibit 2

Page 1 of 4

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

1. Fisher, Craig

Address:

Fisher, Craig
Don Julio Foods 447 N. 300 W., SUITE 5
KAYSVILLE, UT 84037
United States
Legal Entity Type: Individual
Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 029
Class Status: Active
Mexican food products, refried beans
Basis: 1(a)
First Use Date: 1994-07-01
First Use in Commerce Date: 1994-07-01

International Class: 030
Class Status: Active
Mexican food products, namely tortillas, taco shells, tortilla chips, salsas, chilies, spices, and seasonings
Basis: 1(a)
First Use Date: 1994-07-01
First Use in Commerce Date: 1994-07-01

ADDITIONAL INFORMATION

Disclaimer: "AUTHENTIC"

Lining and Stippling: The lining shown in the drawing is a feature of the mark and is not intended to indicate color. The stippling shown in the drawing is a feature of the mark and is not intended to indicate color.

Name Portrait Consent: The "DON JULIO" name does not identify a living individual.

Translation: The English translation of "DON JULIO" is "Mr. Julio".

Design Search Code(s):

02.01.01 - Busts of men facing forward; Heads of men facing forward; Men - heads, portraiture, or busts facing forward; Portraiture of men facing forward

02.01.10 - Men, Spaniards or Mexicans, including men wearing sombreros; Mexican men; Sombreros, men wearing; Spaniards (men)

05.07.01 - Corn, stalks

05.11.08 - Corn without husks; Ears of corn without husks

24.09.07 - Advertising, banners; Banners

26.01.02 - Circles, plain single line; Plain single line circles

26.01.17 - Circles, two concentric; Concentric circles, two; Two concentric circles

26.03.21 - Ovals that are completely or partially shaded

Exhibit 2

Page 2 of 4

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.

2007-01-18 - First renewal 10 year
2007-01-18 - Section 8 (10-year) accepted/ Section 9 granted
2007-01-18 - Assigned To Paralegal
2006-11-13 - Combined Section 8 (10-year)/Section 9 filed
2006-11-13 - TEAS Section 8 & 9 Received
2006-09-12 - Case File In TICRS
2002-07-30 - Section 8 (6-year) accepted & Section 15 acknowledged
2002-06-17 - Section 8 (6-year) and Section 15 Filed
1996-11-12 - Registered - Principal Register
1996-02-06 - Published for opposition
1996-01-05 - Notice of publication
1995-11-29 - Approved for Pub - Principal Register (Initial exam)
1995-10-30 - Communication received from applicant
1995-09-27 - Non-final action mailed
1995-09-15 - Assigned To Examiner
1995-08-18 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Exhibit 2

Page 3 of 4

Attorney of Record
TADIANA W. JONES

Correspondent
TADIANA W JONES
DURHAM JONES & PINEGAR

111 E BROADWAY
STE 900
SALT LAKE CITY, UT 84111

Exhibit 2
Page 4 of 4

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 2009-11-03 13:27:58 ET

Serial Number: 76543420 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark (words only): DON JULIO

Standard Character claim: No

Current Status: Abandoned-Failure To Respond Or Late Response

Date of Status: 2004-10-29

Filing Date: 2003-09-08

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 113

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: M4X -TMO Law Office 113 - Examining Attorney Assigned

Date In Location: 2004-10-29

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

1. Tequila Don Julio, S.A. de C.V.

Address:

Tequila Don Julio, S.A. de C.V.
Porfirio Diaz No. 17 Colonia Chichimeco, 47750Atotonilco el Alto
Jalisco
Mexico

Legal Entity Type: Corporation

State or Country of Incorporation: Mexico

GOODS AND/OR SERVICES

Exhibit 3

Page 1 of 3

International Class: 032

Class Status: Active

BEERS, MINERAL AND AERATED WATERS AND OTHER NON-ALCOHOLIC DRINKS;
FRUIT DRINKS AND FRUIT JUICES; SYRUPS AND OTHER PREPARATIONS FOR MAKING
BEVERAGES

Basis: 1(b), 44(d)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Foreign Application Number: 591372

Country: Mexico

Foreign Filing Date: 2003-03-07

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.

2004-10-29 - Abandonment Notice Mailed - Failure To Respond

2004-10-29 - Abandonment - Failure To Respond Or Late Response

2004-03-31 - Non-final action mailed

2004-03-28 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

STEVEN ROSENTHAL

Correspondent

ATTN: LEGAL DEPARTMENT
DIAGEO NORTH AMERICA, INC.
SIX LANDMARK SQUARE
STAMFORD, CONNECTICUT 06901
Phone Number: (203) 359-7269

Domestic Representative

DANA M. GILLAND

Exhibit 3

Phone Number: (203) 359-7269

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 November 3, 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:

Rochelle D. Alpert
Sharon R. Smith
Morgan, Lewis & Bockius LLP
One Market, Spear Street Tower
San Francisco, CA 94105

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 November 3, 2009, in Evansville, Indiana.


Luz A. Lettiere