

ESTTA Tracking number: **ESTTA321598**

Filing date: **12/11/2009**

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
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Attachments	Response to Motion for Judgment on Pleadings - Opposition # 91192056 (DON JULIO).pdf ( 9 pages )(424966 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 RESPONSE TO**

**OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS**

Applicant Inulina y Miel de Agave, S.A. de C.V. ("Applicant"), hereby responds to the motion filed on November 24, 2009, by Opposer Tequila Don Julio, S.A. de C.V. ("Opposer") seeking judgment on the pleadings or, in the alternative, to strike certain affirmative defenses pleaded in Applicant's Answer (hereinafter the "Motion"). (Dkt. 5). Applicant responds to said Motion as follows:

**I. FACTUAL BACKGROUND**

On September 25, 2009, Opposer filed a Notice of Opposition against Applicant's Application to register the mark "DON JULIO" in International Class 030, for "honey; honey substitutes; pancake syrup; table syrup; topping syrup." The Notice of Opposition alleges priority and likelihood of confusion between the alcoholic goods

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identified in Opposer's pleadings (described therein as "tequila," "alcoholic beverages, namely tequila," and "beverage alcohol, namely distilled spirits"), and all of the non-alcoholic goods identified in Applicant's Application. (Dkt. 1).

On November 3, 2009, Applicant timely filed its Answer to Opposer's Notice of Opposition. (Dkt. 4). In addition to eight affirmative defenses, Applicant's Answer contains either explicit denials or implicit denials (implied by virtue of Applicant's lack of knowledge or information sufficient to form a belief as to the truth thereof) in response to various factual allegations set forth in Opposer's Notice of Opposition. In particular, Applicant's Answer, *inter alia*: (i) explicitly denies Opposer's allegation that the goods covered by Applicant's Application, namely syrups and toppings, "can be flavored and are flavored with beverage alcohol products, including tequila," and further explicitly denies that "recipes for syrups and toppings often include beverage alcohol products, including tequila" (Dkt. 1, ¶8; Dkt. 4, ¶ 8); (ii) explicitly denies Opposer's allegation that the goods identified in Applicant's Application are related to the tequila offered by Opposer under its "DON JULIO" marks (Dkt. 1, ¶ 11; Dkt. 4, ¶ 11); (iii) explicitly denies Opposer's allegation 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 (Dkt. 1, ¶ 13; Dkt. 4, ¶ 13); and (iv) explicitly denies Opposer's allegation that Opposer will be damaged by registration of Applicant's "DON JULIO" mark because consumers allegedly are likely to believe, mistakenly, that Applicant or its goods emanate from, are sponsored or authorized by, or are otherwise associated or affiliated with Opposer (Dkt. 1, ¶ 14; Dkt. 4, ¶ 14).

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In addition, Applicant's Answer asserts, *inter alia*, the affirmative defenses that: (i) 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 (Dkt. 4, Affirmative Defense ¶ 2); and (ii) 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 and purchasers of such goods will readily recognize the difference between the sources of Applicant's goods and Opposer's goods (Dkt. 4, Affirmative Defense ¶ 5).

## II. INTRODUCTION

Applicant did not intend in preparing and filing its Answer to conduct a discovery fishing expedition or to obfuscate issues in dispute, as asserted in Opposer's Motion. The Lanham Act expressly allows the consideration in all inter partes proceedings of the equitable defenses of laches, estoppel and acquiescence. 15 U.S.C. § 1069. Case law also allows the defenses of abandonment, waiver, and differences in look and appearance between the opposed mark and pled registered marks. Nevertheless, after further review of the relevant facts and the applicable law in this particular case, Applicant concedes that all of the following affirmative defenses fail as a matter of law and should be struck from Applicant's Answer: (i) abandonment and acquiescence (Dkt. 4, Affirmative Defense ¶ 3); (ii) the difference in intended look and appearance between Applicant's "DON JULIO" mark and the highly stylized manner in which Opposer uses its pled registered marks in commerce (Dkt. 4, Affirmative Defense ¶ 4); (iii) estoppel (Dkt. 4,

Affirmative Defense ¶ 6); (iv) laches (Dkt. 4, Affirmative Defense ¶ 7); and (v) waiver (Dkt. 4, Affirmative Defense ¶ 8).<sup>1</sup> However, judgment on the pleadings is unwarranted.

### III. ARGUMENT

#### A. Material Facts Remaining in Dispute Preclude Granting Opposer's Motion for Judgment on the Pleadings.

Opposer has overreached in attempting to obtain judgment on the pleadings. As noted in Section 504.02 of the TBMP, a motion for judgment on the pleadings solely tests undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. See *The Scotch Whisky Association v. United States Distilled Products Co.*, 13 USPQ2d 1711 1714 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), *dismissed*, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991). Moreover, for purposes of the motion, all well-pleaded factual allegations of the nonmoving party must be accepted as true, allegations of the moving party which have been denied (or which are taken as denied) are deemed false, conclusions of law are not taken as admitted, and all reasonable inferences from the pleadings are drawn in favor of the nonmoving party. "A judgment on the pleadings **may be granted only where**, on the facts as deemed admitted, **there is no genuine issue of material fact to be resolved**, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law." (Emphasis

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<sup>1</sup> Applicant notes that this issue could have been resolved in a more efficient manner through the discovery conference required under Rule 2.120(a) of the Trademark Rules of Practice. Well before the deadline of December 4, 2009, set by the Board for the discovery conference to occur, and before Opposer's counsel filed its Motion, Applicant's counsel sent an electronic mail to Opposer's counsel requesting a mutually convenient date and time for the parties to hold the discovery conference. Opposer's counsel failed to respond to Applicant's counsel and instead elected to serve Opposer's Motion upon Applicant by U.S. mail just before a four-day holiday weekend.

added.) TBMP § 504.02; See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* § 1367 *et seq.* (1990).

In its motion for judgment on the pleadings, Opposer challenges six of Applicant's eight affirmative defenses and fails to make any reference to the fact that Applicant's Answer properly disputes (by means of either express or implied denials) several factual allegations made in Opposer's Notice of Opposition in support of Opposer's claims of priority and likelihood of confusion. Irrespective of the affirmative defenses challenged in Opposer's Motion, several genuine issues of material fact of record remain in dispute concerning Opposer's claims of priority and likelihood of confusion. Moreover, Opposer bears the burden of proof of likelihood of confusion. See *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 135 S.Ct. 542, 160 L.Ed.2d 440, 73 USLW 4029, 72 USPQ2d 1833 (2004). Accordingly, judgment on the pleadings is unwarranted.

**B. The Similarity or Dissimilarity and Nature of Applicant's "DON JULIO" Goods and Opposer's "DON JULIO" Goods is a Genuine Issue of Material Fact.**

Applicant's second affirmative defense makes reference to Applicant's goods being categorized under a different international class of goods, but the focus of Applicant's second affirmative defense is not on such categorization per se. Rather, the focus of Applicant's second affirmative defense is on the dissimilarity between Applicant's limited non-alcoholic goods (narrowly described in Applicant's Application as "honey; honey substitutes; pancake syrup; table syrup; topping syrup") and Opposer's

alcoholic goods (narrowly described in its pled registrations as “tequila,” “alcoholic beverages, namely tequila,” and “beverage alcohol, namely distilled spirits”). (Dkt. 4, Affirmative Defense ¶ 2). This is a genuine issue of material fact concerning Opposer’s “related goods” allegations in support of its likelihood of confusion claim. (Dkt. 1, ¶ 8, ¶ 11, ¶ 13, ¶ 14).

In reviewing Board rulings, the Federal Circuit views the likelihood of confusion issue as a question of law based on factual findings made by applying to material and relevant underlying facts the 13-part test formulated in *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Applying the *Du Pont* test in the context of “related goods” allegations, the Board must consider, *inter alia*, the similarity or dissimilarity and nature of the goods described in the application and the nature of the goods described in the Opposer’s pled registrations if this is a genuine issue of material fact of record. “[W]e consider the applicant’s goods as set forth in its application, **and the opposer’s goods as set forth in its registration.**” *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 1382, 78 U.S.P.Q.2d 1944 (Fed. Cir. 2006), cert. denied, 127 S.Ct. 836, 166 L.Ed.2d 666 (U.S. 2006) (Emphasis added).

Since Opposer’s Notice of Opposition contains a “related goods” factual allegation in support of Opposer’s likelihood of confusion claim (Dkt. 1, ¶ 8 and ¶ 11), the similarity or dissimilarity and nature of Applicant’s goods and Opposer’s goods is a genuine issue of material fact. As Opposer well notes in its motion, in determining likelihood of confusion in an opposition, it is the goods as described in the Application, rather than what the evidence shows the goods to be in fact, that must be considered. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2 937, 942, 16

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U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990). (Dkt. 5, p. 7.) However, as noted above, the same rule applies equally to the goods as described in Opposer's pled registrations. Yet, while citing this rule, Opposer essentially asks the Board to ignore it, first by applying Opposer's **extrinsic definition** to broaden the plain meaning of the narrow term "topping syrup" (as it appears on Applicant's Application), so as to encompass so-called "beverage alcohol flavorings," and then by simultaneously **broadening** the plain meaning of the narrow terms "tequila" and "distilled spirits" identified in Opposer's pled registrations. Even assuming that this issue is mischaracterized in Applicant's Answer as an affirmative defense, the similarity or dissimilarity and nature of the goods described in Applicant's Application and in Opposer's pled registrations remains a genuine issue of material fact concerning Opposer's "related goods" allegations in support of its likelihood of confusion claim (Dkt. 1, ¶ 8, ¶ 11, ¶ 13, ¶ 14), all of which are properly denied elsewhere in Applicant's Answer. (Dkt. 4, ¶ 8, ¶ 11, ¶ 13, ¶ 14, Affirmative Defense ¶ 5).

#### IV. CONCLUSION

Judgment on the pleadings is unwarranted and should not be entered because several genuine issues of material fact of record remain to be resolved. Applicant respectfully requests that the Board not strike Applicant's second affirmative defense because it relates to genuine issues of material fact of record concerning Opposer's "related goods" allegations in support of its likelihood of confusion claim. In the alternative, if the Board deems Applicant's second affirmative defense as mischaracterized, Applicant respectfully requests that the Board not rule on the merits of the genuine issues of material fact raised in said affirmative defense because such genuine issues of material fact are of record in Opposer's Notice of Opposition and are



properly disputed elsewhere in Applicant's Answer. Applicant concedes that Applicant's third, fourth, sixth, seventh and eighth affirmative defenses fail as a matter of law and that they should be struck from Applicant's Answer.

Respectfully submitted,

RHINE ERNEST LLP

Dated: December 11, 2009

By:  \_\_\_\_\_

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION FOR JUDGMENT ON THE PLEADINGS, was served on Opposer by mailing said copy on December 11, 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  
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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 December 11, 2009, in Evansville, Indiana.



Luz A. Lettiere