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

Proceeding	91192056
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TRADEMARK
Docket No. 046411.0205

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

In the matter of application Serial No. 77/620,828
Filed September 25, 2009
For the mark **DON JULIO**
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Tequila Don Julio, S.A. de C.V., Opposer, v. Inulina y Miel de Agave S.A. de C.V., Applicant.	Opposition No. 91,192,056

REPLY IN SUPPORT OF TEQUILA DON JULIO'S MOTION FOR JUDGMENT ON THE PLEADINGS OR, IN THE ALTERNATIVE, MOTION TO STRIKE

INTRODUCTION

Opposer Tequila Don Julio, S.A. de C.V. ("Opposer" or "Don Julio") submits this reply brief in support of its Motion for Judgment on the Pleadings or, Alternatively, to Strike ("Motion") certain of the affirmative defenses pled without any legal grounds in the Answer of Applicant, Inulina y Miel de Agave S.A. de C.V. ("Applicant" or "Inulina"). As to all but one of the challenged affirmative defenses, Applicant "concedes" that it did not have valid legal grounds for asserting the affirmative defense "after further review of the relevant facts and the applicable law ..." Dkt. 6 (Opposition to Motion), at 3. Thus, after Applicant's outright concession as to its impropriety, only one affirmative defense remains at issue in this motion for

the Board's consideration. *Id.* The remaining challenged defense is the second affirmative defense wherein Applicant asserts that the designation applied-for in the opposed application will not cause a likelihood of confusion with the registered marks of Don Julio, because the designation applied for and Don Julio's registered marks fall within different international classifications. Dkt. 4 (Answer), Affirmative Defense ¶2. But that remaining challenged defense also is baseless given "the relevant facts and the applicable law." *Id.*

In order to attempt to save this ill-conceived affirmative defense, Applicant attempts to rewrite its second defense to consist of a denial of a likelihood of confusion. If so re-characterized, however, the defense is duplicative — it is no different from the affirmative defense Applicant sets forth in its fifth affirmative defense. Either way, it has no place in the Answer and should be stricken so that it is clear, as established law holds, that international classifications do not bear on the likelihood of confusion determination at issue in this proceeding.

ARGUMENT

I. Applicant "Concedes" that Four of Its Alleged Affirmative Defenses Fail as a Matter of Law

Applicant "concedes" (Dkt. 6 at 3) the failure *as a matter of law* of certain of the challenged affirmative defenses it asserts in its Answer: (1) abandonment and acquiescence (Affirmative Defense, ¶3); (2) Applicant's word mark allegedly will have a different look and appearance than Opposer's registered word mark (Affirmative Defense, ¶4); (3) estoppel (Affirmative Defense, ¶6); (4) laches (Affirmative Defense, ¶7); and waiver (Affirmative Defense, ¶8). *Id.* Applicant acknowledges that these defenses legally have no place in this proceeding "after further review of the relevant facts and the applicable law..." *(id.),* which is a step that Applicant, of course, should have undertaken *before* alleging these affirmative defenses

not after these affirmative defenses had been challenged as legally deficient. Thus, these affirmative defenses by Applicant's own concession are no longer at issue and should be at the very least stricken. They simply have no place in this proceeding.

II. The Remaining Challenged Affirmative Defense Also Should Be Stricken

The only remaining affirmative defense at issue concerns the international classification of the goods in the opposed application and the goods for which Don Julio uses its DON JULIO® formative marks and name. The remaining challenged affirmative defense appears in paragraph 2 of Applicant's Answer. Dkt. 4, Affirmative Defense ¶2. There Applicant plainly asserts that the differing international classification of goods for the DON JULIO® registrations and the opposed Application provides Applicant with a defense to Opposer's claim of a likelihood of confusion. *Id.*

In arguing against a motion for judgment on the pleadings as to this second affirmative defense, Applicant apparently after reviewing the applicable law and facts is forced to re-characterize the affirmative defense to attempt to eliminate the reference to the international classifications of goods. Dkt. 6 at 5-6. The text of the affirmative defense, however, speaks for itself: "There is no likelihood of confusion, mistake or deception because, *inter alia*, the goods identified in Applicant's Application are limited to 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.

Applicant attempts this forced re-characterization, since as to this defense, as well, it does not dispute that the law is well established that the international classification of an application does not bear on likelihood of confusion. As set forth in the opening brief in support of the motion before the Board, the cases holding that different international classifications do not

preclude a finding of a likelihood of confusion are "legion." TMEP §1201.01(d)(v); *see Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 U.S.P.Q.2d 1771 (Fed. Cir. 1993) (classification of goods is "wholly irrelevant" to the issue of likelihood of confusion); *National Football League v. Jasper Alliance Corp.*, 16 U.S.P.Q.2d 1212, 1216 n.5 (T.T.A.B. 1990) (same); see *Hewlett-Packard Dev. Co., L.P. v. Vudu, Inc.*, Opp. No. 91185393 at pp. 7-8 (Oct. 26, 2009) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed"). Revealingly, Applicant does not even attempt to distinguish this authority. Rather, Applicant attempts only to rewrite its affirmative defense but this rewriting does not work.

Even if Applicant's affirmative defense is properly re-characterized to eliminate any reference to the international classifications, the second affirmative defense should be stricken as duplicative. Without the reference to the international classification, the defense on its face duplicates the fifth affirmative defense in Applicant's Answer, which specifically denies likelihood of confusion. Dkt. 4, Affirmative Defense ¶5. While this fifth affirmative defense denying likelihood of confusion is not properly an affirmative defense, it is at least not legally defective.

Once the reference to international classification is eliminated in Applicant's second affirmative defense, the defense does not differ from the fifth so-called affirmative defense. Indeed, Applicant concedes this fact by citing its fifth affirmative defense in support of its second affirmative defense. Dkt. 6 at 7. As such, at best, the second affirmative defense duplicates the fifth affirmative defense or, at worst, the second affirmative defense is not legally

cognizable. In either event, it should be stricken so that it is plain to the Applicant what issues remain in dispute in this proceeding.

CONCLUSION

Opposer respectfully requests the Board to issue judgment on the pleadings as to the challenged affirmative defenses or, alternatively, to strike the affirmative defenses identified in Don Julio's Motion so that the issues are properly defined to include the only issue properly before the Board — whether the Opposer's DON JULIO® formative marks and trade name are confusingly similar to the opposed identical DON JULIO designation for what appears on the face of the opposed application to include related goods.

Dated: December 28, 2009

Respectfully submitted,

By: _____

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TRADEMARK
Docket No. 046411.0205

CERTIFICATE OF SERVICE

I, Yelena Lolua, declare that I am and was at the time of the service mentioned in this declaration, employed in the County of San Francisco, California. I am over the age of 18 years and not a party to this cause. My business address is Spear Street Tower, One Market, San Francisco, CA 94105.

On **December 28, 2009**, I served a copy(ies) of the following document(s)

REPLY IN SUPPORT OF TEQUILA DON JULIO'S MOTION FOR JUDGMENT ON THE PLEADINGS OR, IN THE ALTERNATIVE, MOTION TO STRIKE

by placing the document(s) listed above in a sealed envelope with postage thereon fully prepaid, in the United States mail at **San Francisco**, California addressed as set forth below. I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

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I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct, and that this declaration was executed on **December 28, 2009**, at San Francisco, California.

Yelena Lolua