

ESTTA Tracking number: **ESTTA419656**

Filing date: **07/13/2011**

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	Kentucky Distillers' Association
Granted to Date of previous extension	07/13/2011
Address	612-A Shelby Street Frankfort, KY 40601 UNITED STATES

Attorney information	Amy Sullivan Cahill Stites & Harbison PLLC Suite 1800400 West Market Street Louisville, KY 40202 UNITED STATES acahill@stites.com Phone:502-681-0597
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Applicant Information

Application No	77747378	Publication date	03/15/2011
Opposition Filing Date	07/13/2011	Opposition Period Ends	07/13/2011
Applicant	Greater Louisville Convention & Visitors Bureau 401 W. Main St. Suite 2300 Louisville, KY 40202 UNITED STATES		



Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Paper napkins; Coaster sets of paper; Note cards; Pens
Class 018. All goods and services in the class are opposed, namely: Tote bags; Luggage tags; Luggage; Umbrellas, Market umbrellas
Class 021. All goods and services in the class are opposed, namely: Flasks; Shot glasses; Portable coolers; Insulated containers for beverage cans; Coaster sets not of paper and not being of textile; Tasting glasses; Decanters; Paper plates and paper cups
Class 025. All goods and services in the class are opposed, namely: T-shirts; Sweatshirts; Ball caps; Boxers

Grounds for Opposition

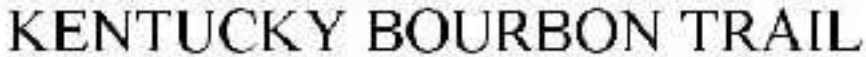
Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3710981	Application Date	05/13/2008
Registration Date	11/17/2009	Foreign Priority Date	NONE
Word Mark	KENTUCKY BOURBON TRAIL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 Promoting tourism in the Central Kentucky region of the United States featuring the provision of hospitality referral information, and the provision of consumer information in the field of bourbon and bourbon distilleries to tourists and visitors</p> <p>Class 039. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 Organizing, conducting, and operating tours related to the bourbon industry</p> <p>Class 040. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 Providing information to others related to the bourbon making process</p> <p>Class 041. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 Educational services, namely, providing educational information to others related to the history and current news about the bourbon industry; entertainment services, namely, arranging and conducting special events related to the bourbon industry</p>		
U.S. Registration No.	3556715	Application Date	05/12/2008
Registration Date	01/06/2009	Foreign Priority Date	NONE
Word Mark	KENTUCKY BOURBON TRAIL		
Design Mark			
Description of	The mark consists of the wording "KENTUCKY BOURBON TRAIL" above		


Mark	designs of barrels and lines.
Goods/Services	Class 035. First use: First Use: 2007/00/00 First Use In Commerce: 2007/00/00 association services, namely, promoting the interests of the Kentucky bourbon industry

U.S. Registration No.	3556684	Application Date	05/09/2008
Registration Date	01/06/2009	Foreign Priority Date	NONE


Word Mark	KENTUCKY BOURBON TRAIL
Design Mark	

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 association services, namely, promoting the interests of the Kentucky bourbon industry Class 041. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 providing guided tours of bourbon distilleries

U.S. Registration No.	2584119	Application Date	09/14/2001
Registration Date	06/18/2002	Foreign Priority Date	NONE

Word Mark	KENTUCKY BOURBON TRAIL
Design Mark	

Description of Mark	"KENTUCKY BOURBON TRAIL" in double bordered rectangle box with " KENTUCKY" in white lettering on red background and " BOURBON TRAIL" in black lettering on white background.
Goods/Services	Class 035. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 association services, namely, promoting the interests of the Kentucky bourbon industry Class 041. First use: First Use: 1999/05/25 First Use In Commerce: 1999/05/25 providing guided tours of bourbon distilleries

U.S. Application No.	77649426	Application Date	01/14/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	KENTUCKY BOURBON TRAIL		
Design Mark			
Description of Mark	The mark consists of the words "KENTUCKY BOURBON TRAIL" in a stylized font situated above the design of a barrel.		
Goods/Services	<p>Class 004. First use: candles</p> <p>Class 009. First use: refrigerator magnets; decorative magnets</p> <p>Class 014. First use: lapel pins</p> <p>Class 016. First use: posters; paper napkins; paper placemats; coasters made of paper; printed materials, namely, books, booklets, and magazines on the topic of the bourbon and distilled spirits industries; printed maps; decals; stickers; bumper stickers; trading cards; calendars; novelty items, namely, identification documents in the nature of imitation passports; pens; pencils; post cards; note pads; greeting cards; note books; address books; binders; stationery; Christmas cards; photographs; bookmarks; artwork, namely, art prints, art pictures, pictures; cookbooks</p> <p>Class 018. First use: tote bags; luggage tags; umbrellas</p> <p>Class 020. First use: commemorative wooden barrel heads</p> <p>Class 021. First use: flasks; shot glasses; drinking glasses; mugs; cups; paper plates; paper cups; beverage glassware; portable beverage coolers in the nature of insulating sleeve holders for beverage cans and bottles; plates; dinnerware; coasters made of stone, leather, wood, cork and plastic; portable beverage and food coolers; fitted wooden toasting boxes</p> <p>Class 024. First use: towels; textile napkins; kitchen linens and place mats not of paper</p> <p>Class 025. First use: clothing, namely, shirts, t-shirts, pants, shorts, sweaters, sweatshirts, caps, visors, hats, jackets, ties, belts, aprons, headwear, footwear</p> <p>Class 028. First use: Christmas tree ornaments; baseballs; golf balls and corn hole game sets comprised of bean bags and playing boards sold together as a unit</p>		

	<p>Class 030. First use: candy; confections, namely, bourbon balls; coffee</p> <p>Class 035. First use: promoting business and tourism in the bourbon-producing region of Kentucky; association services, namely, promoting the interests of the Kentucky bourbon industry</p> <p>Class 039. First use: conducting, operating and organizing tours related to the bourbon industry</p> <p>Class 041. First use: educational services, namely, providing educational information to others related to the history of and current news about the bourbon industry; entertainment services, namely, arranging and conducting special events related to the bourbon industry</p>
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BOURBON TRAIL		
Goods/Services	Tourism, educational and special events services and promotional items in connection with same		

Related Proceedings	Petition to Cancel Registration No. 3932986
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Attachments	<p>77473652#TMSN.jpeg (1 page)(bytes)</p> <p>77472229#TMSN.jpeg (1 page)(bytes)</p> <p>77470390#TMSN.jpeg (1 page)(bytes)</p> <p>76311725#TMSN.gif (1 page)(bytes)</p> <p>77649426#TMSN.jpeg (1 page)(bytes)</p> <p>Notice of Opposition.pdf (9 pages)(236235 bytes)</p>
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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 First Class Mail on this date.

Signature	/Amy Sullivan Cahill/
Name	Amy Sullivan Cahill
Date	07/13/2011

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

KENTUCKY DISTILLERS' ASSOCIATION,

Opposer/Petitioner,

v.

Opposition No.
Appln. Serial No. 77/747,378

**GREATER LOUISVILLE CONVENTION
& VISITORS BUREAU,**

Cancellation No.
Registration No. 3,932,986

Applicant/Registrant.


COMBINED OPPOSITION AND PETITION TO CANCEL


Kentucky Distillers' Association, a non-profit corporation organized and existing under the laws of the Commonwealth of Kentucky, with a principal place of business at 612-A Shelby Street, Frankfort, Kentucky 40601 (hereinafter "Opposer/Petitioner"), believing that it will be damaged by registration, hereby opposes the following application and registration owned by Greater Louisville Convention & Visitors Bureau, an independent commission established by Kentucky statute, with a principal place of business at 401 W. Main Street, Suite 2300, Louisville, Kentucky 40202 (hereinafter "Applicant/Registrant"): (1) Application Serial No. 77/747,378, filed on May 29, 2009, and published for opposition in the *Official Gazette* of March 15, 2011; and (2) Registration No. 3,932,986, issued on March 15, 2011. This Combined Opposition and Petition to Cancel is appropriate pursuant to TBMP § 305.02 because the Opposer/Petitioner's claims against each of the Applicant/Registrant's subject application and registration involve common (i.e., similar) questions of law or fact.

As grounds for its Combined Opposition and Petition to Cancel, Opposer/Petitioner submits the following:

1. Commencing long prior to Applicant/Registrant's relevant priority dates, and at least as early as May 1999, Opposer/Petitioner has and is now organizing and promoting tours, offering educational services, and providing entertainment services and special events related to the bourbon industry to consumers under its marks KENTUCKY BOURBON TRAIL and BOURBON TRAIL (collectively referred to herein as "KENTUCKY BOURBON TRAIL Mark").

2. Opposer/Petitioner is the owner of common law rights in the KENTUCKY BOURBON TRAIL and BOURBON TRAIL marks arising from its use of the marks in commerce and is the owner of the following Federal registrations for the KENTUCKY BOURBON TRAIL mark:

Mark	Goods/Services	Reg. No.	Reg. Date
KENTUCKY BOURBON TRAIL	IC 035. Promoting tourism in the Central Kentucky region of the United States featuring the provision of hospitality referral information, and the provision of consumer information in the field of bourbon and bourbon distilleries to tourists and visitors. IC 039. Organizing, conducting, and operating tours related to the bourbon industry. IC 040. Providing information to others related to the bourbon making process. IC 041. Educational services, namely, providing educational information to others related to the history and current news.	3,710,981	November 17, 2009
	IC 035. Association services, namely, promoting the interests of the Kentucky bourbon industry.	3,556,715	January 6, 2009
KENTUCKY BOURBON TRAIL	IC 035. Association services, namely,	3,556,684	January 6, 2009

	<p>promoting the interests of the Kentucky bourbon industry.</p> <p>IC 041. Providing guided tours of bourbon distilleries.</p>		
	<p>IC 035 Association services, namely, promoting the interests of the Kentucky bourbon industry.</p> <p>IC 041. Providing guided tours of bourbon distilleries.</p>	<p>2,584,119 (Supplemental)</p>	<p>January 22, 2002</p>

3. Applicant/Registrant has obtained Registration No. 3,932,986 for the mark URBAN BOURBON TRAIL for use in connection with “chamber of commerce services, namely, promoting business and tourism in the bourbon-producing region of Kentucky” in International Class 35, claiming a first use date of May 30, 2008 (the “Challenged Registration”).

4. Opposer/Petitioner’s continuous use of its KENTUCKY BOURBON TRAIL Mark throughout the United States predates the priority date of the Challenged Registration as well as the date of first use of the mark which is the subject of the Challenged Registration and thus, Opposer/Petitioner has priority of use.

5. The mark which is the subject of the Challenged Registration is so similar to Opposer/Petitioner’s KENTUCKY BOURBON TRAIL Mark as to create a likelihood of confusion, or to cause mistake, or to deceive, within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), all to Opposer/Petitioner’s irreparable damage.

6. Accordingly, Opposer/Petitioner requests that the challenged registration be cancelled under Section 14 of the Lanham Act, 15 U.S.C. §1064, on the ground that the mark which is the subject of the challenged registration was and remains ineligible for registration pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

7. On May 29, 2009, Applicant/Registrant filed an application for URBAN BOURBON TRAIL, Application Serial No. 77/747,378, based on an intent to use the mark under Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b), in connection with a number of goods as set forth in Exhibit A hereto (the "Challenged Application"). The Challenged Application was published in the *Official Gazette* of March 15, 2011.

8. Opposer/Petitioner is the owner of KENTUCKY BOURBON TRAIL (& Design), Application Serial No. 77/649,426, filed with the U.S. Patent and Trademark Office on January 14, 2009, based on an intent to use the mark in connection with numerous goods and services as set forth in Exhibit B hereto.

9. Opposer/Petitioner's filing date and first use dates of its KENTUCKY BOURBON TRAIL Mark predate the filing date of the Challenged Application and thus Opposer/Petitioner has priority in terms of registration.

10. The goods and services in association with which Opposer/Petitioner uses or proposes to use Opposer/Petitioner's KENTUCKY BOURBON TRAIL Mark are believed to be identical to, overlapping with, or closely related to the goods in association with which Applicant/Registrant proposes to use the URBAN BOURBON TRAIL mark.

11. The proposed mark URBAN BOURBON TRAIL, when applied to the goods and services of Applicant/Registrant, is so similar to Opposer/Petitioner's KENTUCKY BOURBON TRAIL Mark as used with Opposer/Petitioner's goods and services, as to create a likelihood of confusion, or to cause mistake, or to deceive, within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), causing Opposer/Petitioner injury and irreparable damage.

12. Opposer/Petitioner believes that it will be damaged by continued registration of the

mark which is the subject of the Challenged Registration and by the registration of the proposed mark which is the subject of the Challenged Application because (a) there is an appreciable likelihood that consumers will believe that Opposer/Petitioner is the source of any goods or services offered or marketed by Applicant/Registrant in association with the registered or proposed mark; (b) there is an appreciable likelihood that consumers will believe there is an affiliation, connection, association, sponsorship or other such relationship between the parties; (c) there is an appreciable risk that any defects or other quality concerns associated with Applicant/Registrant's goods or services may be attributed to the Opposer/Petitioner; and (d) the registration of the URBAN BOURBON TRAIL mark which is the subject of the Challenged Registration and Challenged Application will give Registrant the presumptive right to use said mark with its goods and services. All of these effects of registration of the mark of the Challenged Registration and Challenged Application will cause injury to Opposer/Petitioner.

WHEREFORE, Opposer/Petitioner prays that Application Serial No. 77/747,378 be REFUSED and that Registration No. 3,932,986 be CANCELLED.

Opposer/Petitioner has appointed Amy Sullivan Cahill (who is licensed to practice in the Commonwealth of Kentucky, the State of Virginia, and the District of Columbia), an attorney at the firm of STITES & HARBISON PLLC, to prosecute this Combined Opposition and Petition to Cancel and to transact all business in and before the United States Patent and Trademark Office in connection herewith.

This 13th day of July, 2011.

By: /s Amy Sullivan Cahill
Amy Sullivan Cahill
STITES & HARBISON, PLLC
400 West Market Street
Suite 1800
Louisville, Kentucky 40202
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Fax: (502) 779-9805
acahill@stites.com

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the forgoing **COMBINED OPPOSITION AND PETITION TO CANCEL** was served on counsel for Applicant/Registrant as identified by the records of the U.S. Patent and Trademark Office, this 13th day of July, 2011, by sending same via First Class mail, postage prepaid, to:

JOHN A. GALBREATH
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Phone Number: 410-628-7770
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/s Amy Sullivan Cahill
Amy Sullivan Cahill

EXHIBIT A

GOODS OF CHALLENGED APPLICATION SERIAL NO. 77/747,378

International Class 016. paper napkins; coaster sets of paper; note cards; pens

International Class 018. tote bags; luggage tags; luggage; umbrellas, market umbrellas

International Class 021. flasks; shot glasses; portable coolers; insulated containers for beverage cans; coaster sets not of paper and not being of textile; tasting glasses; decanters; paper plates and paper cups

International Class 025. t-shirts; sweatshirts; ball caps; boxers

EXHIBIT B

OPPOSER/PETITIONER'S APPLICATION SERIAL NO. 77/649,426

International Class 004. candles

International Class 009. refrigerator magnets; decorative magnets

International Class 14. lapel pins

International Class 16. posters; paper napkins; paper placemats; coasters made of paper; printed materials, namely, books, booklets, and magazines on the topic of the bourbon and distilled spirits industries; printed maps; decals; stickers; bumper stickers; trading cards; calendars; novelty items, namely, identification documents in the nature of imitation passports; pens; pencils; post cards; note pads; greeting cards; note books; address books; binders; stationery; Christmas cards; photographs; bookmarks; artwork, namely, art prints, art pictures, pictures; cookbooks

International Class 18. tote bags; luggage tags; umbrellas

International Class 020. commemorative wooden barrel heads

International Class 21: flasks; shot glasses; drinking glasses; mugs; cups; paper plates; paper cups; beverage glassware; portable beverage coolers in the nature of insulating sleeve holders for beverage cans and bottles; plates; dinnerware; coasters made of stone, leather, wood, cork and plastic; portable beverage and food coolers; fitted wooden toasting boxes

International Class 24. towels; textile napkins; kitchen linens and place mats not of paper

International Class 25. clothing, namely, shirts, t-shirts, pants, shorts, sweaters, sweatshirts, caps, visors, hats, jackets, ties, belts, aprons, headwear, footwear

International Class 28. Christmas tree ornaments; baseballs; golf balls and corn hole game sets comprised of bean bags and playing boards sold together as a unit

International Class 30. candy; confections, namely, bourbon balls; coffee

International Class 35. promoting business and tourism in the bourbon-producing region of Kentucky; association services, namely, promoting the interests of the Kentucky bourbon industry

International Class 39. conducting, operating and organizing tours related to the bourbon industry

International Class 41. educational services, namely, providing educational information to others related to the history of and current news about the bourbon industry; entertainment services, namely, arranging and conducting special events related to the bourbon industry