

ESTTA Tracking number: **ESTTA497169**

Filing date: **09/28/2012**

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	Geo G. Sandeman Sons & Co., Limited
Granted to Date of previous extension	10/20/2012
Address	400 Capability Green Luton, Bedfordshire, LU1 3AE UNITED KINGDOM
Attorney information	Ryan A. McGonigle Baker and Rannells, PA 575 Route 28 Suite 102 Raritan, NJ 08869 UNITED STATES officeactions@br-tmlaw.com, k.hnasko@br-tmlaw.com, r.mcgonigle@br-tmlaw.com Phone:9087225640

Applicant Information

Application No	85304363	Publication date	08/21/2012
Opposition Filing Date	09/28/2012	Opposition Period Ends	10/20/2012
Applicant	Tequila Don Julio, S.A. de C.V. Porfirio Diaz No. 17, Col. Chichimeco Atotonilco el Alto Jalisco, 47750 MEXICO		

Goods/Services Affected by Opposition


Class 033. All goods and services in the class are opposed, namely: Alcoholic beverages except beers

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

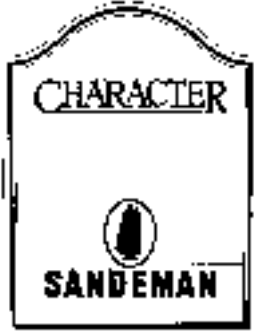
Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	302263	Application Date	10/29/1932
Registration Date	04/04/1933	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class U047 (International Class 033). First use: First Use: 1930/11/27 First Use In Commerce: 1930/11/27 WINES		

U.S. Registration No.	1402440	Application Date	09/16/1985
Registration Date	07/22/1986	Foreign Priority Date	NONE

Word Mark	CHARACTER SANDEMAN
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Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1984/10/00 First Use In Commerce: 1985/02/25 WINE		

U.S. Application/Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
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Word Mark	the Don Figure Mark as described/defined in the Notice of Opposition and particularly at Paragraph 7 of the same
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Goods/Services	glassware and decorative collective gift tins
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Related Proceedings	Opposition No. 91206491 and Cancellation No. 92055987
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Attachments	71331705#TMSN.gif (1 page)(bytes) 73558661#TMSN.gif (1 page)(bytes) Baker-Rannells120928130012.pdf (11 pages)(168205 bytes)
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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	/Ryan A. McGonigle/
Name	Ryan A. McGonigle
Date	09/28/2012

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



In re Application Serial No. 85/304363 the mark , filed on April 25, 2011

GEO G. SANDEMAN SONS & CO.,
LIMITED

Opposer,

v.

TEQUILA DON JULIO, S.A. DE C.V

Applicant.

NOTICE OF OPPOSITION

GEO G. SANDEMAN SONS & CO., LIMITED (“Sandeman” or “Opposer”), a corporation organized and existing under the laws of the State of the United Kingdom believes that it will be damaged by allowing the above-identified application to proceed to registration as Applicant’s mark and hereby opposes the same pursuant to 15 U.S.C. §1063.

Sandeman alleges on knowledge as to its own acts and otherwise on information and belief and as grounds for the notice of opposition as follows:

1. Sandeman is a corporation organized and existing under the laws of the United Kingdom, doing business at 400 Capability Green, Luton, Bedfordshire, United Kingdom LU1 3AE.

2. Applicant, TEQUILA DON JULIO, S.A. DE C.V. (“TDJ” or “Applicant”) is a corporation (*sociedad anónima de capital variable*) existing under the laws of México, doing business at Porfirio Diaz No. 17, Col. Chichimeco, Jalisco 47750 México.

3. Sandeman is the owner of the Don Figure Mark (as defined and depicted hereinbelow) as a trademark as applied to a wide range of wines and related goods, directed to wholesale and retail customers.

4. The Don Figure Mark has been in continuous, open, and notorious use in the United States from 1930 to the present date.

5. The Don Figure Mark, registered in the United States since 1933, was one of the first trademarks to become registered in the USPTO in International Class 033. Beyond that, the Don Figure Mark was one of the first logos to attain iconic status, not just in the United States, but on a global stage. The Don Figure Mark appears as follows:



6. Sandeman is also the owner of all right, title and interest in and to the following U.S. trademark registrations in International Class 033, all of which are in good order:

a. U.S. Trademark Reg. No. 0,302,263 for the stylized depiction of the Don Figure Mark for “wines” in International Class 033 (hereinafter, “the ‘263

Registration"). The '263 Registration is attached as Exhibit "A" hereto. The '263 Registration appears as follows:

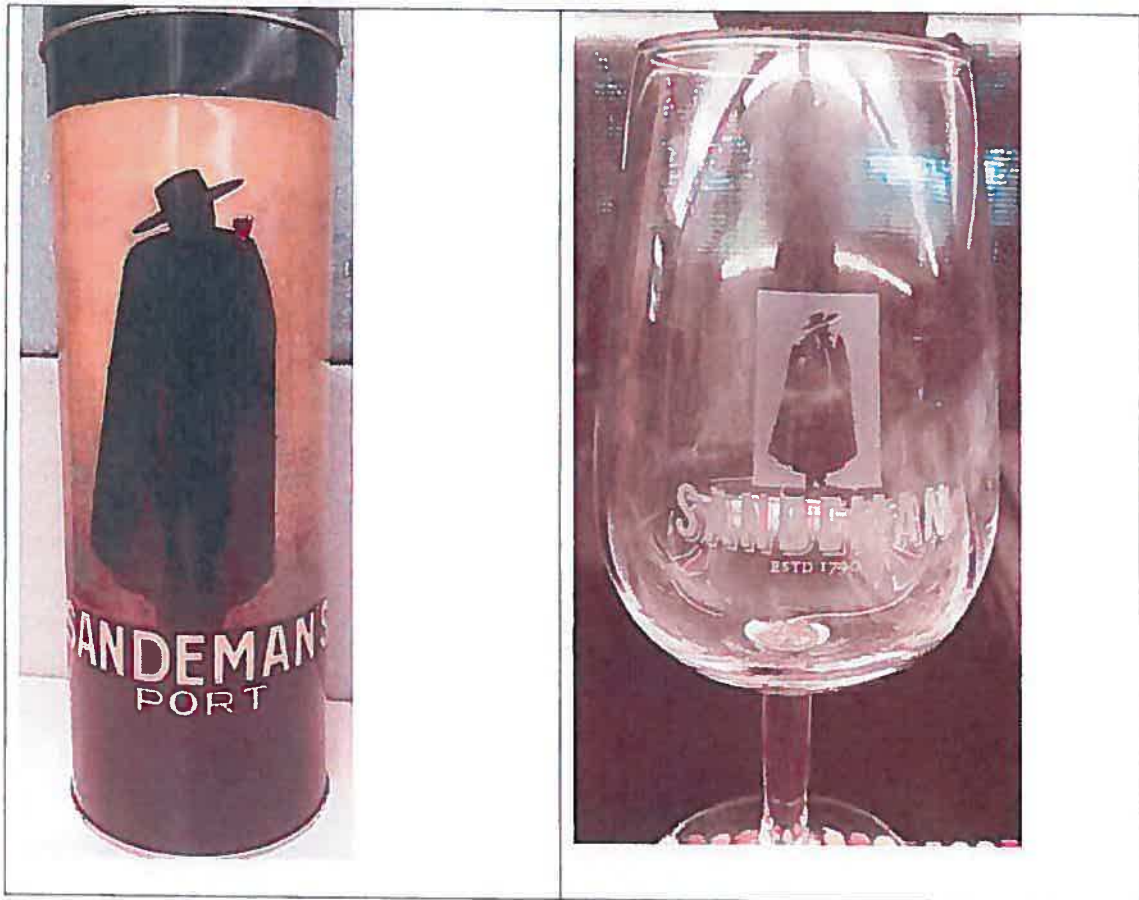


b. U.S. Trademark Reg. No. 1,402,440 for the stylized mark CHARACTER SANDEMAN with the Don Figure Mark for "wine" in International Class 033 (hereinafter, "the '440 Registration"). The '440 Registration is attached as Exhibit "B" hereto. The '440 Registration appears as follows:



(Hereinafter, the '263 Registration and the '440 Registration are referred to as "Opposer's Registrations"). Opposer's Registrations are incontestable.

7. Sandeman is also possessed of common law rights to its Don Figure Mark in connection with glassware and decorative collective gift tins (together with the goods listed in Opposer's Registrations, hereinafter will be referred to as "Sandeman's Goods"), namely:



8. Notwithstanding Sandeman's prior rights in the Don Figure Mark, TDJ applied to register the below-depicted design mark for "alcoholic beverages except beers" in International Class 033 (as depicted below) on April 25, 2011:



9. The application identified hereinabove in paragraph 8 was issued U.S. Trademark Serial No. 85/304363 (hereinafter, the “363 Application”). Sandeman opposes the ‘363 Application in its entirety. As they are referred to herein, the goods described in the ‘363 Application are “TDJ’s Goods”. The design depicted in the ‘363 Application is hereinafter referred to as “TDJ’s Mark.”

10. For far longer than any date that could be claimed by TDJ, Sandeman has been trading as known by the Don Figure Mark in connection with the marketing and sale of Sandeman’s Goods, the same being substantially identical to and generally related to TDJ’s Goods. As such, priority is not an issue.

11. Upon information and belief, TDJ distributes, sells and purveys or intends to distribute, sell and purvey TDJ’s Goods through the same channels of trade as Sandeman, and directs its respective goods to the same ultimate consumers as does Sandeman.

12. The Don Figure Mark and TDJ’s Mark are confusingly similar when applied to the goods and services of the parties.

13. The goods of Sandeman and TDJ are identical and TDJ’s use of TDJ’s Mark in connection with TDJ’s Goods is without the consent or permission of Sandeman.

14. Since Sandeman owns the Don Figure Mark by virtue of prior use, mistake or deception as to the source of origin of the goods will arise and will injure and damage Sandeman and its goodwill.

15. The registration of the TDJ’s Mark to TDJ will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived,

that TDJ's Goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Sandeman, all to Sandeman's irreparable damage.

16. Upon information and belief, service is proper upon TDJ as follows:

Tequila Don Julio, S.A. de C.V.
Porfirio Diaz, No. 17
Col. Chichimeco
Jalisco 47750
MEXICO

and

Lauren Mandell, Esq.
Diageo North America, Inc.
801 Main Avenue
Norwalk, CT 06851-1127

WHEREFORE, Opposer prays that: (1) the application for registration of Applicant's Mark, Serial No. 85304363, filed on April 25, 2011 for TDJ's Mark, be denied; and (2) this Notice of Opposition be sustained.

Dated: September 28, 2012

Respectfully submitted for Opposer
GEO G. SANDEMAN SONS & CO., LIMITED

By:



Stephen L. Baker, Esq.
Ryan A. McGonigle, Esq.
BAKER and RANNELLS, PA
575 Route 28, Suite 102
Raritan, New Jersey 08869
(908) 722-5640

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Notice of Opposition by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this 28th day of September, 2012 to Applicant at the following addresses:

Lauren Mandell, Esq.
Diageo North America, Inc.
801 Main Avenue
Norwalk, CT 06851-1127

And

Tequila Don Julio, S.A. de C.V.
Porfirio Diaz, No. 17
Col. Chichimeco
Jalisco 47750
MEXICO


Ryan A. McGonigle

Exhibit “A”

Int. Cl.: 33

Prior U.S. Cl.: 47

United States Patent and Trademark Office
10 Year Renewal

Reg. No. 302,263

Registered Apr. 4, 1933

Renewal Term Begins Apr. 4, 1993

**TRADEMARK
PRINCIPAL REGISTER**



HOUSE OF SEAGRAM LIMITED, THE
(UNITED KINGDOM CORPORATION)
SEAGRAM HOUSE
5/7 MANDEVILLE PLACE
LONDON, W1M 5LB, ENGLAND, BY
CHANGE OF NAME AND ASSIGN-
MENT FROM GEO. O. SANDEMAN
SONS & CO. LIMITED (GREAT BRIT-
AIN LIMITED LIABILITY COMPA-
NY), LONDON, ENGLAND

OWNER OF GREAT BRITAIN REG.
NO. 518188, DATED 11-27-1930.

FOR: WINES, IN CLASS 47 (INT. CL.
33).

FIRST USE 11-27-1930, IN COMMERCE
11-27-1930.

SER. NO. 71-331,705, FILED 10-29-1932.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Mar. 9, 1993.*

COMMISSIONER OF PATENTS AND TRADEMARKS

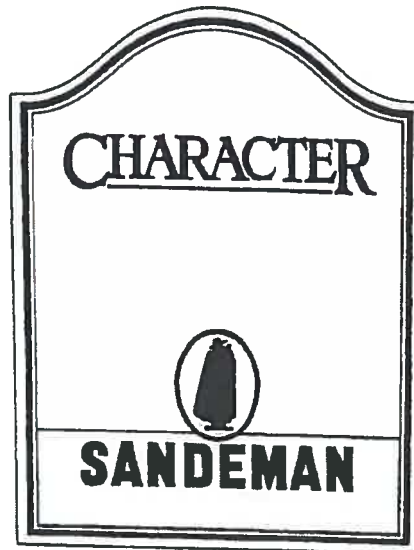
Exhibit “B”

Int. Cl.: 33

Prior U.S. Cl.: 47

United States Patent and Trademark Office Reg. No. 1,402,440
Registered July 22, 1986

**TRADEMARK
PRINCIPAL REGISTER**



GEO. G. SANDEMAN SONS & CO. LIMITED
(GREAT BRITAIN COMPANY)
17 DACRE STREET
LONDON, ENGLAND

OWNER OF U.S. REG. NOS. 64,221, 1,383,624
AND OTHERS

FOR: WINE, IN CLASS 33 (U.S. CL. 47).
FIRST USE 10-0-1984; IN COMMERCE
2-25-1985.

SER. NO. 558,661, FILED 9-16-1985.

JULIE B. SEYLER, EXAMINING ATTORNEY