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

Proceeding	91215114
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SHIRLEY PLANTATION, LLC,  
UPPER SHIRLEY VINEYARDS, LLC

and

CHARLES H. CARTER

*Opposers,*

v.

STILLHOUSE VINEYARDS, LLC

D/B/A PHILIP CARTER WINERY

*Applicant.*

Opposition No.: 91215114 (parent)  
91216395  
91218094

Application Nos.: 85/947562  
86/121979  
86/129686

Marks: SHIRLEY PLANTATION  
SHIRLEY



Applicant's Trial Brief

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## DESCRIPTION OF THE RECORD

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## STATEMENT OF FACTS

After many years of hard work, saving, and planning, Philip Carter Strother's dream came true when he became the owner of Stillhouse Vineyards, LLC in January of 2008. (App. Exh. 1). His first move was to start utilizing the tradename Philip Carter Winery. (*Id.*). Philip Carter Strother worked with a graphic designer named Allan Guy to develop a new logo to go with the new company name. (App. Exh. 3). As a member of the Carter family, and a direct descendant from Robert "King" Carter, and the Carter family were recognized by the London society in 1762 with a gold medal for the wines he produced at his Cleve Plantation in Virginia, Philip Carter Winery's brand identity would be to honor historical landmarks in Virginia and Carter history. (App. Exh. 6). The new logo developed for Philip Carter Winery would be inspired from a Carter family crest found online by Allan Guy ("Philip Carter Winery Logo"). (App. Exh. 3). There were several options of Carter crests in the world including one with lions and one with cartwheels. Philip Carter Strother settled on the cartwheel design for the company logo because the cartwheels reminded him of the tops of wine barrels. (App. Exh. 9). The Philip Carter Winery Logo was first used in commerce in February of 2008 and started Philip Carter Winery's unique brand identity. (App. Exh. 10).

In January of 2008, along with rebranding the winery, Philip Carter Strother started rebranding the winery's facilities in Hume, Virginia. Among other things, he renamed the tasting room Cleve Hall, and named the two blocks of chardonnay vines "Shirley." (App. Exh. 1).

On March 5, 2013, Randy Carter of the Shirley Plantation Foundation, Shirley Plantation, LLC, and brother of Opposer Charles Carter contacted Philip Carter Winery about working with the winery on a commemorative wine and hosting a tasting of Philip Carter Winery wines at Shirley Plantation to commemorate the 400th anniversary. (App. Exh. 2). On March 7, 2013 Philip Strother

and Randy Carter spoke by phone as a follow-up to the email inquiry of March 5th. (*Id.*). The parties discussed a Philip Carter Winery wine being produced to be called Shirley or Shirley Plantation. This worked well for the Philip Carter Winery because it had the Shirley chardonnay blocks and vines already and it fit the theme of its wine names. (App. Exh. 1). Shirley was the name Philip Carter Winery intended for its chardonnay reserve, so the timing was terrific. (*Id.*). It was decided that Philip Carter Winery would own the wines and label and in turn would place the wine in commerce in retail distribution and promote the interest with Shirley Plantation to help drive additional tourism/foot traffic to the historic location. (*Id.*). It was further agreed that Philip Carter Winery wines would be located for sale in the Shirley Plantation gift shop and additional information about the winery would be available to guests of Shirley Plantation. (*Id.*). The two companies would cross promote each other. (*Id.*). Randy Carter agreed that this was an excellent idea and agreed to this arrangement. (*Id.*).

Between March 7th and May 24th, the parties exchanged emails that confirm this arrangement and discussed the planning of the reception and development for the label of the wine. (App. Exh. 2). The label design included the TM symbol to designate that Philip Carter Winery intended for this to be used as a trademark. Shirley Plantation agreed to and approved the label. (*Id.*). On May 2, 2013, an email was sent from Janet Appel, the Director of the Shirley Plantation Foundation, acknowledging that this wine is a “new line” for Philip Carter Winery. (*Id.*). On May 24, 2013, the Philip Carter Winery chardonnay labeled Shirley Plantation and also referred to as Shirley Chardonnay was bottled and immediately placed into commerce through the on-site tasting room at Philip Carter Winery and was sent to Philip Carter Winery’s wine club, the “Carter Charter Wine Club Package”. (App. Exhs 1, 2, 11, 12).



On May 30th, Randy Carter was anxious to discuss “marketing opportunities [they could] work on together” and wanted Philip Strother to visit Shirley Plantation. (App. Exh. 2). So on June 16, 2013, Philip Strother met with Randy Carter and Janet Appel at Shirley Plantation to discuss the continued plans for cross-marketing by the two organizations. (*Id.*). At this meeting Philip Strother presented a bottle of the recently bottled Philip Carter Winery Shirley Plantation Chardonnay to Randy Carter. At that meeting the parties’ discussions included:

- Planning a wine reception at Shirley Plantation for Philip Carter Winery wines.
- Shirley Plantation’s gift shop selling all of the Philip Carter Winery wines and the costs to be charged to Shirley Plantation for the wines.
- Establishment of a permanent Philip Carter Winery tasting room at Shirley Plantation. The parties walked the property to scout potential sites for such a tasting room. During the visit and then again in an email, Philip Strother suggested that the tasting room facility be located overlooking the James River to take advantage of the natural scenery.
- Building a visitor center at Shirley Plantation, which would include the Philip Carter tasting room and a Virginia wine history museum. (*Id.*).

After this meeting Philip Strother was excited at the marketing prospects and was ready to move into formal arrangements and joint ventures with Shirley Plantation, but Randy Carter suggested that they should “crawl before [they] walk.” (*Id.*).

Randy Carter wanted the next step to be a tour of the facilities of Philip Carter Winery. (*Id.*). Philip Strother obliged by hosting the next meeting on-site at Philip Carter Winery on July 17, 2013. (*Id.*). Philip Strother showed Randy Carter and Janet Appel the behind the scenes working of the winery in action. (*Id.*). From July 17th until the wine tasting event on October 12, 2013, the parties

stayed in communication to finalize plans for the event and made plans for beyond the first event. (*Id.*). During this period, Philip Carter Winery promoted Shirley Plantation to increase awareness of the property, and also used Mr. Strother's connections to invite the Governor of Virginia, First Lady of Virginia, and Secretary of Agriculture to the October 12th event. (App. Exh. 4, 13). During this period, Shirley Plantation developed a press release, signage for its gift shop, and an invitation for the event that specifically mentions that the wines are produced and owned by Philip Carter Winery. (App. Exhs 2, 5).

At the October 12th event, Tayloe Dameron was in attendance and Philip Strother learned of the plans for Mr. Dameron to open a winery right next door to Shirley Plantation and planned to name it Upper Shirley Vineyards. (App. Exh. 2). Mr. Strother expressed his concern to Randy Carter that having a winery named Shirley next door would potentially damage the new Shirley Chardonnay and the cross-marketing and tasting room plans they had been working on all summer. (*Id.*).

Within a few weeks after the October 12th event, Randy Carter broke off the relationship and cross-marketing plans with Philip Carter Winery. Charles and Randy Carter then expressed opposition to Philip Carter Winery's use of the SHIRLEY PLANTATION and SHIRLEY marks for the first time. (*Id.*).

On November 14, 2013 Upper Shirley Vineyards, LLC filed a request for extension of time to oppose Applicant's Shirley Plantation mark, which Philip Carter Winery had filed on May 31, 2013, shortly after the wine had entered commerce. (App. Exh. 7). On November 18, 2013, Philip Carter Winery filed an application for the SHIRLEY trademark showing a first date in commerce of May 24, 2013. (*Id.*). Upper Shirley Vineyards, LLC then filed its own trademark application for Upper Shirley Vineyards on November 25, 2013. (*Id.*).

It turns out that Tayloe Dameron, Randy and Charles Carter's neighbor and friend since 2002, had been planning a winery since at least early 2012. (Opp. Dameron Dec. 1). Upper Shirley Vineyards, LLC was formed on April 3, 2012 and began planting grapes for future wine production. (*Id.*). This was about 1 year before Randy Carter initiated the conversation with Philip Carter Winery. Randy Carter then had Philip Strother to the Shirley Plantation grounds, under the pretense of prospects of a long term joint venture, to pick his brain about tasting room concepts, where Philip Strother told them about how the wine industry works. Philip Strother even shared his thoughts about how the ideal location for a tasting room was overlooking the river. Randy Carter then insisted on visiting Philip Carter Winery's facilities. Philip Strother then explained and showed them how to promote and hold the launch of a new wine. Randy and Charles Carter invited Mr. Dameron to the event. Then after the event broke off all relationships with Philip Carter Winery and took opposition positions to its use of Shirley and even the Philip Carter Winery Logo.

Mr. Dameron said his preparation to enter the wine industry was "deliberate, focused, and fruitful" and he learned such methods in his 20-year career in investment banking. (*Id.*). He now has built a building overlooking the river in preparations for his winery. (App. Exh. 26). Shirley Plantation, LLC, Upper Shirley Vineyards, LLC, and Charles Carter then initiated these opposition proceedings to prevent trademark protections essential for the Philip Carter Winery brand which has been built through a lot of hard work by Philip Carter Strother. (App. Exh. 7).

## ARGUMENT

### **I. The Opposers have not used the designation at issue as a trademark or have abandoned previously held trademark rights therefore are unable assert a real interest in this proceeding.**

To succeed in an opposition proceeding an opposer must prove by a preponderance of the evidence that: (1) he has standing to oppose the mark; and (2) there are valid grounds why the applicant is not entitled under law to register the mark it claims. *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 187 (C.C.P.A. 1982). Under the Lanham Act an opposer must believe they would suffer some kind of damage if the mark is registered, but also must have “real interest” in the proceedings and must have a “reasonable basis” for this belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). An opposer then is required to “prove (1) that it owns a valid mark.” *Netjets Inc. v. Intellijet Grp., LLC*, Case No. 2:12-cv-00059, 11-12 (S.D. Ohio, 2013) quoting 15 U.S.C. § 1114(a). The first thing we should look at is to see if the Opposers have actually used the same of similar designations as a trademark. See *Rock & Roll Hall of Fame & Museum. Inc. v. Gentile Prods.*, 134 F.3d 749, 753 (6th Cir. 1998). This will show us to what extent any belief of damages is reasonable because without any valid mark being used in commerce the Opposers have no enforceable trademark rights or damages.

#### *a. Upper Shirley Vineyards is not in commerce at all.*

It is well established that trademark rights require a mark to actually be used in commerce. See *Id.*; *Allard Enters., Inc. v. Advanced Programming Resources, Inc.*, 146 F.3d 350, 356 (6th Cir.

1998) (noting one of the "bedrock principles" of trademark law is that ownership rights flow from actual use in the market); *See also* 15 U.S.C. § 1127. The Lanham Act defines use in commerce as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127.

The Opposer Upper Shirley Vineyards is not in commerce in any class. There is not a dispute that Upper Shirley Vineyards has used anything resembling the Philip Carter Logo in commerce or anywhere and Upper Shirley Vineyards did not oppose that application. However, Upper Shirley Vineyards has also provided no evidence in either the Opposers' Brief or during the discovery process to show any bona fide use of not just a mark relating to this proceeding, but any mark whatsoever. No sales receipts, no financial statements, no pictures of customers at a facility. The closest thing we have to evidence showing any commercial activity is a statement from one of the owners of Upper Shirley Vineyards stating that it has "opened a tasting room" and that it "intends" to produce wine. (Opp. Dameron Dec. 8, 9) It however did not give any dates that it may have opened its tasting room or when it intends to produce wine. Upper Shirley Vineyard's entire statement for standing is the fact that it has an intent to use application, but at the time of publication for opposition of Applicant's "Shirley Plantation" mark and at the time of filing of Applicant's "Shirley" mark, Upper Shirley Vineyards lacked even an intent to use filing. Upper Shirley Vineyards did conveniently file an Intent to Use trademark application on November 25, 2013, 11 days after it requested an extension for time to oppose Applicant's "Shirley Plantation" application and well after Applicant's first use in commerce. Upper Shirley Vineyard's standing in the case is manufactured and should not be allowed to prevent Applicant's registration.

In the Argument section of the Opposers' Brief, Upper Shirley Vineyards is not even mentioned. The Opposers make no case for Upper Shirley Vineyards standing or commercial activity. Not a

single argument as to why Applicant's applied for marks would damage their prospective business or cause customer confusion between the 2 vineyards. Upper Shirley Vineyards was essentially nonresponsive and the silence is deafening. The evidence of this proceeding shows that Upper Shirley Vineyards has not used the word Shirley in commerce as a trademark under the Lanham Act, thus has no reasonable basis to believe it would be damaged by Applicant's registration. Even if it is found that Upper Shirley Vineyards claims of potential damage are reasonable and meets the minimum requirements for standing, it has not proved that it has priority of use even based on the intent to use application filing date because it did not seek to prove anything at all in the Opposers' brief. Its opposition should fail.

*b. Charles Carter is an individual who is not operating as a sole proprietor and holds no trademarks personally that would be affected by Applicant's applied for marks thus Charles Carter's opposition should fail.*

Charles Carter is only opposing the registration for the Philip Carter Winery Logo. Mr. Carter is an individual who is opposing Applicant's registration based on the antiquated and long since abolished in this country rule of primogeniture. *See e.g An act for regulating conveyances* (Oct. 1785) (an act authored and championed by Thomas Jefferson in the Virginia General Assembly to clarify the means by which land is transferred. It abolished the feudal English property rule of primogeniture, which automatically passed inheritances to the eldest son.). Even in the United Kingdom they have recently done away with primogeniture in the royal line of succession. *Succession to the Crown Act 2013*, 2013 c. 20. Mr. Carter claims sole ownership and rights in all

facets of the law to the Carter Family over the hundreds if not thousands of descendants that can trace their lineage to Robert Carter of Virginia. The idea that Mr. Carter would be damaged by any of the applied for marks is like a person with the last name McDonald opposing the registration of the McDonalds trademark because the McDonalds brothers who founded McDonalds were not the oldest direct male descendant from a specific McDonald in Ireland. It has no basis in law or reality.

All of this is irrelevant because Mr. Carter is not in commerce as required by the Lanham Act. Much like Upper Shirley Vineyards, the Opposers have provided no evidence of Mr. Carter's commercial activities. Mr. Carter's participation as a party to this proceeding is without standing because there is no reasonable basis to believe he would be damaged. Without bona fide use of a trademark in commerce, Mr. Carter has no trademark rights to enforce. His opposition should fail.

*c. Shirley Plantation LLC has not been in commerce since 2008 thus abandoning any trademark rights and should have its registration of Shirley Plantation trademark canceled.*

A mark is deemed abandoned when, among other reasons, its use has been discontinued with intent not to resume. 15 U.S.C. § 1127. If a party does not use a mark for 3 consecutive years it shall be "prima facie evidence of abandonment." *Id.*; *see also Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925 (TTAB 2014); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997). Many cases of abandonment occur when an owner was once using a mark in commerce and ceases to do so for one reason or another. *Netjets Inc.* at 23.

That is what has happened here. Shirley Plantation, LLC was founded in 2003 and at some point was transferred the ownership rights to “Shirley Plantation” trademarks with the serial numbers 75508950 and 75509350. There is no evidence of Shirley Plantation, LLC conducting commercial activity of any kind after the year 2008. In the Opposers’ Brief they provide a lot of evidence before 2008, with most coming in the 1990’s. The only piece of evidence after 2008 is a map of visitors from 2014. In discovery, the last financial statement provided by Opposers for Shirley Plantation, LLC is for the year 2008. (App. Exh. 14). The year 2008 also coincides with the establishment of a completely new nonprofit entity called the Shirley Plantation Foundation, which is completely separate from Shirley Plantation, LLC. (App. Exh. 15). Shirley Plantation Foundation was formed on July 11, 2008. (*Id.*). The website shirleyplantation.com makes it very clear that the historical venue, museum, and gift shop are operated by the Shirley Plantation Foundation. (*Id.*). Historical tours, museums, and gift shops are the classification descriptions for Shirley Plantation, LLC’s registered trademarks. (App. Exh. 7). In fact, internet archives show that shirleyplantation.com was promoting the foundation at least as early as June 12, 2010. (App. Exh. 15). Emails from Randy Carter and Janet Appel to Philip Strother in 2013 list Janet Appel as the Director of the Shirley Plantation Foundation and Randy Carter as the Deputy Director. (App. Exh. 2). A press release promoting the joint marketing effort for Applicant’s Shirley Plantation Chardonnay clearly shows the Shirley Plantation Foundation as the owner operators of the plantation stating that donations will “help to ensure that Shirley Plantation will remain open to the public.” (App. Exhs. 2, 5). Even after specific request during the discovery process, Opposers failed to provide documentation showing specifically Shirley Plantation, LLC in commerce after 2008, and also failed to provide any licensing agreement between Shirley Plantation, LLC and Shirley Plantation Foundation. (App. Exh. 16). Shirley



Plantation, LLC has also failed to show any licensing agreements between itself and Upper Shirley Vineyards. (*Id.*).

Shirley Plantation, LLC's failure to utilize its marks in commerce for nearly 10 years more than meets the requirement for presumption of abandonment. Furthermore, Shirley Plantation, LLC has made no efforts to either license to or enforce its rights against the Shirley Plantation Foundation, Upper Shirley Vineyards, or any of the other 144 trademark registrations listed in the USPTO trademark database when you complete a TESS search of "Shirley". (App. Exh. 20). Because of this it can be assumed that Shirley Plantation, LLC makes no plans to resurrect its usage of its "Shirley Plantation" mark. Shirley Plantation, LLC is a party in this opposition, not Shirley Plantation Foundation. Because Shirley Plantation, LLC has abandoned its trademarks its opposition to the Applicant's applied for marks should fail for failure to have enforceable trademark rights and lacking priority over the Applicant. It should also have its currently registered trademarks canceled.

All of the Opposers in this proceeding lack even the most elemental requirement of the Lanham Act to prove damage to a trademark. The Opposers have failed to show any bona fide use in commerce; at least not in the last 10 years. Without use in commerce, the Opposers lack any enforceable trademark rights. Without enforceable trademark rights, Opposers cannot have a reasonable basis for their belief of damage. Even if their belief is enough to establish standing in this case, the Opposers' failure to assert any enforceable trademark rights causes their opposition to the Applicant's applied for marks to fail. Granting trademark protections to entities and individuals with no evidence of use in commerce would be an injustice and a disservice to the rule of law and American trademark tradition.

**II. Applicant's applied for marks, Shirley Plantation and Shirley, present no likelihood of confusion because Applicant's and Opposers' marks are in different goods and services, and they are in different trade channels, therefore Applicant's applications should not be denied registration under 15 U.S.C. § 1052(d).**

Section 2(d) of the Lanham Act provides that a proposed mark should only be refused registration if Opposers prove that it:

“[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

To prevail in this opposition proceeding under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), Opposers must show that (1) they have valid, prior, proprietary rights in the SHIRLEY PLANTATION and SHIRLEY marks; and (2) Applicant's use of the marks SHIRLEY PLANTATION and SHIRLEY are likely to cause confusion among consumers as to the sponsorship, affiliation or connection of goods under the mark. *See Hilson Research Inc. v. Society for Human Res. Mgmt.*, 27 U.S.P.Q.2d 1423, 1429 (T.T.A.B. 1993). It is well established in trademark proceedings that to determine likelihood of confusion under Section 2(d), the Board analyzes all of the relevant, probative facts as they relate to the 13 “Dupont Factors” originally established by *In re E.I Du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973). The two most important factors in any analysis are the extent of similarity of the marks and similarity between the goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976). These main factors along with any other relevant DuPont Factors as shown by the facts of each

particular case together determine if the likelihood of confusion warrants denial of registration. *See Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 233 U.S.P.Q. 1281, 1282 (Fed. Cir. 1984) (considering only the relevant du Pont factors). Opposers fail to provide a reasonable assertion of confusion because they cannot establish even the two main factors of similarity of marks and similarity of goods.

*a. Applicant's and Opposers' priority of marks.*

For an action against registration an opposer must show that it has valid and prior rights to the marks in question.

As discussed above, two of the three Opposers, Upper Shirley Vineyards and Charles Carter, are not in commerce based on the facts of this case, thus Applicant has priority of use over these parties and Opposers' argument does not dispute this. This leaves only Opposer Shirley Plantation, LLC and Applicant, Philip Carter Winery. If the Board decides to look passed the fact that Shirley Plantation Foundation took over operations of what is commonly known as Shirley Plantation in 2008, without being assigned or licensed Shirley Plantation, LLC's rights in its registered marks, then we must make an examination of Shirley Plantation, LLC's opposition in this proceeding as if it has continuously been in commerce and Shirley Plantation Foundation does not exist.

As stated in Applicant's applications, the marks SHIRLEY PLANTATION and SHIRLEY have been in commerce since at least as early as May 24, 2013. (App. Exhs. 1, 2, 7, 11, 12, 13, 18, 22). The design mark for the Philip Carter Winery Logo has been in commerce since February 1, 2008. (App. Exh. 10).

Shirley Plantation, LLC's two marks were registered on March 21, 2000. Shirley Plantation, LLC would have priority of use over Philip Carter Winery, while Upper Shirley Vineyards and Charles Carter would not.

*b. Similarity of the marks*

The first element of the DuPont Factors is to examine the similarity of the marks in appearance, meaning, sound, connotation, and commercial impression. The phrase commercial impression here is whether the “marks convey a similar general meaning and produce the same mental reaction.” *Possible Grounds for Refusal of a Mark*, United States Patent and Trademark Office <https://www.uspto.gov/trademark/additional-guidance-and-resources/possible-grounds-refusal-mark>, March 26, 2018 (providing the example of city woman and city girl producing the same impression). Commercial Impression does not mean creating a false connection, which is covered by Section 2(a) of the Lanham Act, as the Opposers suggest.

Applicant does not seek to waste the Board's time by trying to argue that Applicant's mark SHIRLEY PLANTATION does not have the same appearance as Shirley Plantation, LLC's mark SHIRLEY PLANTATION. There could be an argument made that SHIRLEY and SHIRLEY PLANTATION provide a different commercial impression because the term plantation is not a word commonly used in the English lexicon due to its association with slavery. But the dominant feature of SHIRLEY PLANTATION is SHIRLEY which makes them similar enough. Just as SHIRLEY PLANTATION and UPPER SHIRLEY VINEYARDS are similar in appearance and commercial impression once you strip away the descriptive terms of plantation and vineyards. Two of the

Opposers who filed a joint brief have marks that stand at odds with one another. If Philip Carter Winery's applied for mark of Shirley cannot be registered then neither can Upper Shirley Vineyards' because Upper Shirley Vineyards and Shirley Plantation, LLC are two separate entities, owned by different individuals. The Opposers have collectively ignored such a fact in their pursuit to stop Philip Carter Winery's branding strategy. Perhaps this is why an argument by Upper Shirley Vineyards is not included in Opposers' Brief. It seems the Opposers are trying to have their cake and eat it too.

*c. Similarity of the Goods*

Even if two marks are found to be similar, the Board should only find that a likelihood of confusion exists if the goods are related enough that "consumers are likely to assume (mistakenly) that they come from a common source." *Id.* The analysis of related line of goods must be done on the basis of the goods set forth in the application. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990). The goods must not be identical but instead sufficiently related in such a way that it causes a mistaken belief by the consumer that the items originate from the same producer. However, the courts have established that for two types of goods or services to be related "something more" than just one establishment offering for sale a specific type of good must exist. *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 1236 (CCPA 1982). In *In re Coors Brewing Co.*, the Court held that the examining attorney was unable to provide something more and "the Board's finding that beer and restaurant services are related is not supported by substantial evidence." *In re Coors Brewing Co.*, 343 F.3d 1340, 1346 (Fed. Cir., 2003).

The examining attorney pointed to the fact that some restaurants brew and serve their own private label beer, but the Court held that that alone is not enough to support a conclusion that consumers would likely conclude “that beer and restaurant services with similar marks emanate from the same source.” *Id.* Coors provided evidence showing that the number of restaurants vastly outweighed the number of breweries and while some restaurants do sell private label beer, there was nothing to suggest such restaurants were common. *Id.* The Board pointed to a few dual registrations of both restaurant services and beer, but the Court actually found that to turn against the Board because the number of such dual registrations was so small that it actually helped prove that such instances were uncommon. *Id.* The Court concluded that because these were uncommon that any relation between the sources of the services and goods was “*de minimis.*” *Id.* The Court specifically stated that to find the two related would “overturn the requirement of Jacobs that a finding of relatedness between food and restaurant services requires “something more” than the fact that restaurants serve food.” *Id.* The Court then stated in dicta that it is not unusual for restaurants to produce private label foodstuffs such as ice cream or coffee, but that does not mean “that any time a brand of ice cream or coffee has a trademark that is similar to the registered trademark of some restaurant, consumers are likely to assume that the coffee or ice cream is associated with that restaurant.” *Id.* The Court expressed grave concern for establishing a principle where simply because a restaurant sold a type of food that it would automatically be able to prevent any food or drink item from registering a trademark with a similar name and specifically said, “the potential consequences of adopting such a principle would be to limit dramatically the number of marks that could be used by producers of foods and beverages.” *Id.* The Court compared its ruling to another case where the Court made the opposite holding for two similar marks with the services, “distributorship services in the field of automotive parts” and “service station oil and lubrication change services.” *Id.* at 1347 citing *In re Shell Oil Co.*,

992 F.2d 1204, 1206 (Fed.Cir.1993). The Court in *Shell* found that the two industries would share virtually all of the same customers and the services were so close that it would likely cause confusion. *In re Shell Oil*, 992 F.2d at 1207-08. The Court in *Coors* analogized that for the facts of the *Shell* case to be more like the *Coors* case, the facts would have to be changed to a department store and private label automotive parts. *In re Coors*, 343 F.3d at 1347. Department stores sometimes sell private label automotive parts but that alone is not enough to establish that the services are so closely related that a mark used in oil change services would cause confusion with a similar mark used by a department store. *Id.* For goods and services to be considered similar for purposes of determining likelihood of confusion they must be more than somewhat related, and specifically that relation must be more than simply a type of store sometimes selling a specific line of goods.

The services of “retail gift shop services” and “museum services including guided and unguided historical tours on-site” are not closely related enough to the goods of “wine” to cause consumer confusion. The goods and services present in this proceeding are like the situation that was present in *Coors*, except the goods and services have even less of a connection. One could see the concern of the Board of potential confusion with beers and restaurants having the same name and the Court decided that wasn’t enough. In this opposition, the Board is asked to make the illogical connection that a gift shop at a museum is related enough to wine to be considered de facto identical. This is asking the Board to make an even more distant connection than the connection between restaurants and beverages because restaurants exist for the sole purpose to sell food and beverages. Gift shops exist to sell, anything. Gift shops, like any general retail establishment have no close ties to any particular good. If gift shops are known for anything it is items like postcards, t-shirts, stuffed animals, coffee mugs, and other trinkets. To say there is a close relationship between a gift shop and

wine, would be to completely redefine the phrase close relationship and put retail establishments in an elevated position within trademark law where the classification system does not apply.

If the Board does find a relationship between the goods and services in this opposition then it should require the “something more” standard established in *Jacobs* and affirmed in *Coors* for restaurants and beverages, where the Opposers need to provide “something more” than the fact that a restaurant sells alcohol when dealing with similar or identical marks on beverages and food. *Jacobs*, 668 F.2d at 1236; *In re Coors*, 343 F.3d at 1346. The Opposers make no mention of the something more standard in their brief and do not argue that something more exists in this particular situation. The Opposers do attempt to make the same exact evidentiary argument that failed for the Board in *Coors* where it showed search results of trademark registrations in both beer and restaurant services. Here the Opposers provide evidence that only 30 marks are registered for both gift shop and wines. Like with the Board’s argument in *Coors* this small number of overlapping marks serves to show just how uncommon the overlap of gift shops and wines are. A TESS search reveals 105,927 records for the goods and services of wine, and 94,683 for gift shop services. Only 30 overlap. In *Coors*, the research showed that while there were 812,000 restaurants in the United States there were only 1,450 brewpubs or microbreweries which came out to 18 one-hundredths of one percent of all restaurants. *In re Coors*, 343 F.3d at 1346. In the situation in this proceeding, less than 3 one-hundredths of one percent of all wine makers have a gift shop, or if you look at it from the other point of view barely over 3 one-hundredths of one percent of gift shops have a corresponding wine label. Either way you look at it, that is substantially less of an overlap than the beer/restaurant scenario that was rejected by the Court in *Coors*. Like with *Coors*, any relation between gift shops and wine are *de minimis* and does not warrant a presumption of identical goods. Opposers lean heavily on the case *In re Opus One Inc.* in their argument to show that gift shops and wine should be treated as identical. *In re Opus One*



*Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001). *Opus* is a case where there was a wine and restaurant with similar marks, however Opposers ignore that *Opus* acknowledges and requires the “something more” requirement of *Jacobs* and instead discuss it as though it is a per se rule. *Id.* at 1814. *Opus* also is another situation where it is a restaurant with a beverage (like *Coors* and *Jacobs*), which comes up more often because it is more natural to worry about confusion between those two than it is between a gift shop and wine. There is nothing more that ties these two types of goods and services together. A ruling that gift shops and wine are sufficiently related would bring about the very thing that the Court in *Coors* feared by “limit[ing] dramatically” the number of marks that could be used. Giving gift shop owners carte blanche trademark rights over anything sold in a gift shop would render all other classifications meaningless. Opposers admit that they do not currently sell wine in the gift shop, so we are not discussing something that is commonly sold in gift shops. In thirteen states wine cannot even be sold outside of liquor stores. *The bizarre thing that happens when grocery stores can't sell booze*, The Washington Post, Christopher Ingraham, [https://www.washingtonpost.com/news/wonk/wp/2016/05/14/why-more-grocery-stores-should-sell-booze/?utm\\_term=.5acf2bd3e826](https://www.washingtonpost.com/news/wonk/wp/2016/05/14/why-more-grocery-stores-should-sell-booze/?utm_term=.5acf2bd3e826), May 14, 2016, visited March 26, 2018 (Tennessee’s General Assembly voted to allow wine sales in grocery stores in 2017 so the number was reduced to 13 from 14 since the article was written). This situation is just something that could *potentially* be sold in a gift shop. Had the courts created a per se rule in the restaurant/food and beverage situation, you only would be limiting the number of marks for food and beverages, but in the situation before us virtually anything could be sold in a gift shop. This would cause a much more devastating limitation than the one before the Court in *Coors*. Any business no matter how big or small could open a gift shop and prevent registration in literally any good category. This is much more akin to the analogy the Court provides in *Coors* where a department store could stop automotive supplies because some

department stores sell automotive supplies. *In re Coors*, 343 F.3d at 1347. After all if there is a close tie between this particular type of retail store, why would all retail establishments not be closely related to the goods they sell? Letting a small gift shop in a historical home in rural Virginia have automatic likelihood of confusion over all goods would set a precedent that would set a standard where a small-box retailer in a rural town could prevent the registration in almost any category of goods. Wine is not closely related to the services of retail gift shops and museum historical tours and at best should be held to the same standard as beverages and restaurants where “something more” must be required to be shown. The Opposers in this case do not provide evidence to show that there is something more relating these to goods and services, so the goods and services in this case are not closely related.

*d. Different channels of trade.*

Opposers’ and Applicant’s registrations do not contain any limitations on the channels of trade, so the Board should presume the goods and services are offered in the normal and usual channels of trade for such products to all potential consumers. *Centraz Industries, Inc. V. Spartan Chemical Co., Inc.*, 77 U.S.P.Q.2d 1698 (TTAB 2006); *Squirtco v. Tomy Corp.*, 216 U.S.P.Q. 937, 940 (Fed. Cir.1983).

Applicant’s wines have or do in fact actually travel in what would be considered the normal trade channels for wines. Applicant’s wines have previously been sold in retail stores, and are currently sold online, and on-site at the winery. (App. Exh. 17). The registered marks of the Opposers are in the categories of “retail gift shop services” and “museum services including guided and unguided

historical tours on-site.” Opposers’ Brief makes no assumptions as to the normal channels of trade because it is relying on a legal assumption that the goods and services are per se identical so the channels of trade are identical. They make no other argument for the trade channels being similar. The facts, however, are that the channels of trade of these goods and services are very different. A bottle of wine can be shipped anywhere in the world and sold in a variety of ways such as those already mentioned. They could be in a grocery store, put into a gift basket, sold online, at wine specific stores, and the list of channels goes on. The Opposers service by definition is a store front and a museum that are stationary. These are services and not goods, so they will travel in completely different channels of trade. You would not expect to purchase a historical on-site tour at a grocery store. The difference in channels of trade further demonstrates the difference between the Applicant’s and Opposers’ goods and services and shows that there is not a likelihood of confusion.

Opposers’ also make an argument for “substantial potential for confusion” based on overlap of customers but do so outside of their channels of trade argument. This argument is based solely on the opinion of the Opposers. In fact, it says “in my opinion.” (Opp. C. Carter Dec. 25). It then goes on to opine on where Applicant can and cannot sell its wines based on its business model. This mere opinion that visitors of a winery could potentially also visit a historical home has no basis in fact or law and should be given no weight by the Board.

- e. *Wine drinkers are sophisticated consumers, and most sales occur in an intimate environment at the Applicant's facilities, so there is no likelihood of confusion.*

The Dupont Factors also call for the Board to examine if consumers in the target market are sophisticated purchasers. This analysis often includes looking at the price point of which the goods are sold. *See e.g. Recot Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000). The Court has suggested that wines priced at less than \$20 a bottle would have more potential to be subject to impulse buys. *Leelanau Wine Cellars, Ltd. v. Black & Red, Inc.*, 502 F.3d 504, 519 (6th Cir., 2007). In addition to price it is also important to look at the channels in which the company sells its products. *Id.* at 520. The Court in *Leelanau Wine* found that two wineries with similar marks were not in conflict in part because the Defendant's wines were sold mostly through a tasting room. *Id.* It found that buying wines sold in a tasting room "is a more deliberative process and would imply a greater level of consumer care in selection." *Id.* It went as far as saying that it could be assumed "that the likelihood of confusion would be reduced if not eliminated in such an environment." *Id.* Examining the price point and trade channels are essential for determining if there is a likelihood of confusion.

The wines of Applicant are priced for a more sophisticated wine consumer, and are mostly sold through its tasting room located on-site. The average cost of a bottle of Philip Carter Winery wine is \$32.50. (App. Exh. 18). Significantly above the \$20 threshold set in *Leelanau Wine*. These are not \$9 wines that a consumer impulse buys at the grocery store. Consumers of Philip Carter Winery wines have a more sophisticated palate and seek wines with higher quality. The fact that Philip Carter Winery wines, including the Shirley chardonnay, have won many national awards, and that such a fact is discussed by online reviewers that have visited the winery shows

the quality of fame of the Philip Carter Winery brand and wines. (App. Exh. 19). In addition to its price, most sales take place in a way where the consumer is specifically seeking out a wine produced by Philip Carter Winery. Much like the winery in *Leeanau Wine*, most of the Applicant's sales take place in its tasting room located on the same property where the wines are produced or on the Philip Carter Winery website (<http://www.pcwinery.com/wines/>). CITE. Opposers even admit this fact. (Opp Dameron Dec. 12). Because of the price of Applicant's wines and that most consumers purchase them in an environment where there can be no confusion as to their source there is no likelihood of confusion with the Opposers.

*f. Fame of the Marks*

Famous marks are entitled to broader protections, but the Opposers' mark is not famous. A famous mark has "extensive public recognition and renown." *Bose Corp. v. QSC Audio Prod's Inc.*, 293 F.3d 1367, 1371 (Fed.Cir.2002). The "fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp.*, 293 F.3d at 1371. In the case *Citigroup Inc. v. Capital City Bank Group Inc.*, the Board had used evidence from studies to show that CITIBANK was recognized with specificity 90-95% of the time. *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 1355 (Fed. Cir., 2011). Fame as it relates to trademark is reserved for so-called household brands. *See e.g. Id.* (CITIBANK for banking and financial services); *Bose* at 1367 (BOSE for electronics); *Recot Inc. v. M.C. Becton*, 54 U.S.P.Q.2d 1894, 1899 (Fed. Cir. 2000) (FRITO-LAY for food); *American Sugar Refining Co. v.*

*Andreassen*, 296 F.2d 783, 784, 132 USPQ 10, 11 (CCPA 1961) (DOMINO for sugar); *Hunt Foods & Indus., Inc. v. Gerson Stewart Corp.*, 367 F.2d 431, 435, 151 USPQ 350, 352 (CCPA 1966) (HUNT'S for canned food products); *Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1843 (TTAB 1989) (TIFFANY for jewelry, silver, and similar items); *R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 USPQ 856, 860 (TTAB 1978) (WINSTON for cigarettes). Famous under the Lanham Act is interpreted by the Board and Courts as what one would traditionally define as famous.

Opposers' SHIRLEY PLANTATION does not rise to the level of fame required for special treatment under the Lanham Act. While there has been a Shirley Plantation in some form or another for many years, operated by various different entities, by no stretch of the imagination is the Shirley Plantation, LLC's mark SHIRLEY PLANTATION famous. It is by no means famous, even by historical plantation standards. A famous plantation would be Thomas Jefferson's Monticello or George Washington's Mount Vernon. It is safe to assume, and Opposers offer no evidence to the contrary other than their own opinions, that nearly all of the general public would be unaware of Shirley Plantation. Even if we take Opposers' visitors figures for which they provide no evidence, only 0.009% of the population of the United States visited their site last year. This is a far cry from the over 90% recognition provided from actual survey evidence from *CITIBANK*. In fact, the Philip Carter Winery and SHIRLEY mark of Philip Carter Winery is more famous, having won awards in national wine competitions. (App. Exh. 19).

For the fame element of the Dupont Factors, the Opposers change their strategy by presenting its mark as a whole, SHIRLEY PLANTATION, while when arguing the Dupont Factor of similarity it argues that the PLANTATION must be dropped as merely descriptive in order to make it more like Applicant's SHIRLEY mark. The Opposers again want their cake and to eat it too. The Opposers

present as evidence of their mark's fame the lack of other registrations of SHIRLEY PLANTATION and how they defend their mark, but if you use their requirements established under the similarity Dupont Factor, and strip away the word plantation as descriptive there are 37 live registrations containing SHIRLEY outside of Opposers' and Applicant's registrations. (App. Exh. 20). Including many that are items that could be sold in a gift shop, such as jewelry and t-shirts. (*Id.*). If the Board were to allow Opposers' logic to stand most, if not all of these registrations, would be subject to cancellation. It should also be noted that Opposers' have not initiated opposition proceedings for the 144 registrations found on the TESS search for "Shirley," which shows that they have not sought to defend this mark. (*Id.*). In fact, as previously stated, it is partnering in this opposition with an entity, that if we follow the argument and logic in Opposers' Brief, is infringing on Shirley Plantation, LLC's mark. Opposers' argument is full of opinion with no fact or evidence to support it. They claim licensing agreements but offer no proof. They claim \$25,000 in advertising but offer no proof. They claim policing but offer no proof. They then close with a circular argument that because Applicant is using a similar mark then their's must be famous. If the Board were to consider the Shirley Plantation, LLC mark famous then it would render the fame Dupont Factor meaningless because literally every mark would be considered famous.

For all of the foregoing reasons, Opposers have failed to prove by a preponderance of the evidence that there is any likelihood of confusion, let alone a significant potential. The Dupont Factors heavily weigh against the Opposers.

### III. Applicant's applied for marks do not suggest a connection with Shirley Plantation, LLC.

Applicant's applied for mark does not make a false connection with Opposers because a reasonable consumer would not think the companies to be connected. Opposers put forth the notion that Applicant's label gives an overall impression that the SHIRLEY wine is sponsored or affiliated with Shirley Plantation, LLC thus should be refused registration under Section 2(a). Opposers once again, in an effort to maneuver and cover both Applicant's SHIRLEY and SHIRLEY PLANTATION applications, go back to removing plantation from Opposers' registration because it is descriptive. This again leads to the suggestion that if Applicant's applied for mark "by its very nature falsely suggests a connection" then the many other registered marks containing "Shirley" must as well. *FBI v. Societe M. Bril & Co.*, 187 USPQ 685, 687 (D.D.C.1975). There is no denying that Applicant's branding strategy is to tell the history of his family, the Carter Family. The deputy director of the Shirley Plantation Foundation's, Randy Carter, press release regarding the Philip Carter Winery explains it as:

"Today, Philip Carter Strother, a direct descendant of the Robert "King" Carter family, owns and operates the Philip Carter Winery and was instrumental in the passage of The Virginia Farm Winery Zoning Act which promotes the economic vitality of the Virginia wine industry. As a way of honoring **his** family legacy, Philip Carter Strother labels the **wines from his vineyard** according to Carter family estates such as the Shirley Plantation Chardonnay, the Cleve Virginia Red Wine, the Sabine Hall Virginia Viognier, the Nomini Hall Virginia Cabernet Franc, and the Rosewell Rose Wine." (App. Exhs. 2, 5) (emphasis added). (App. Exhs. 2, 5).



This excerpt from those associated with Shirley Plantation when working to promote Philip Carter Winery's Shirley Plantation Chardonnay shows that they acknowledged Philip Carter Strother as a member of the family and that the wine Shirley Plantation Chardonnay belongs to Philip Carter Winery. The Shirley Plantation Foundation gift shop that sold Philip Carter Winery wines even worked up a business card that clearly states the wines are labeled for Carter family estates and that customers can "contact the Philip Carter Winery in Hume, Virginia" to order. (App. Exh. 2). Assuming that Shirley Plantation, LLC and the Shirley Plantation Foundation are actually one and the same, which Applicant does not accept, the Opposers were not concerned about a false connection, actually promoted the wine themselves, and pointed consumers to the source for purchasing.

Opposers throughout their brief for some reason infer that Shirley Plantation, LLC and all of Carter Family history are the same exact thing. They even go so far as to suggest that the owner of Philip Carter Winery, Philip Carter Strother, is not a member of the Carter family, which is just absolutely not true. (See quote from Randy Carter above and App. Exh. 1). Philip Carter Strother is a direct descendant just the same as Charles Carter. Opposers go to great lengths to argue that when taken as a whole, Applicant's marketing suggests a sponsorship by Shirley Plantation, LLC of the Shirley wines. However, if you look at the entire bottle and marketing, you will see where it clearly states "PRODUCED & BOTTLED BY PHILIP CARTER WINERY 4366 STILLHOUSE ROAD HUME VIRGINIA 22639." (App. Exhs. 2, 8). In fact, it was Randy Carter of the Shirley Plantation Foundation that wrote the language that was on the back of the 2012 vintage of Shirley Plantation chardonnay made by the Applicant. (App. Exh. 2). This was done when the two parties were working together, before Charles Carter decided to work with his neighbor on the creation of a winery that ultimately was named Upper Shirley Vineyards. Starting with the 2013 vintage the back label was

changed to the standard back label for Philip Carter Winery and the word “plantation” was removed from the name of the wine. (App. Exh. 8). Applicant’s intent is a connection with its owner’s family, not Shirley Plantation, LLC. The Carter Family is an old and historic family which had several estates and plantations in Virginia, which is where several of the Applicant’s wine names are derived. Granting Opposers sole rights to the Carter family history or adjudicating them one and the same would even prevent the other historic sites like Cleve, Nomini Hall, and Rosewell from utilizing the Carter family history. The connection that is made by Philip Carter Winery’s marketing and branding is clearly a connection to its owner’s own family history, not Shirley Plantation, LLC.

A product being named after a historical site does not suggest a connection or sponsorship by that site. Applicant’s marketing clearly states that the wine is “named for Shirley Plantation” not produced there or sponsored by. Just as there are many products that have been registered that are named for historical homes and locations. For example, TESS searches reveal that there are 332 records for “White House,” 71 records for “Mount Vernon,” and 130 records for “Monticello.” (App. Exh. 21). Does this mean that MONTICELLO VINEYARDS, registration number 2837602, makes a false connection with the home of Thomas Jefferson, which is far more famous than Shirley Plantation and thus could more easily be mistakenly connected? MONTICELLO ASSOCIATES, registration number 1774429, even goes as far as using a picture of the home at Monticello in its logo, but the Board found no Section 2(a) connection. (*Id.*). There is no false connection between these brands named for historical homes, and there is no false connection caused by the Applicant’s applied for marks.

**IV. Applicant made bona fide use of the applied for marks on or before the filing dates.**

In January 2008, Applicant chose the name Shirley for its chardonnay vineyards, which was then conveyed to visitors of the winery who took tours of the grounds. (App. Exh. 1). On May 24, 2013, Philip Carter Winery's Shirley Plantation, also sometimes shortened in speech and advertising as Shirley, was bottled using grapes from Philip Carter Winery's Shirley Vineyards. (App. Exhs. 1, 2, 11). The wine was immediately placed into commerce. (App. Exhs. 2, 11, 12). This can be seen from Philip Carter Winery's inventory log where 30 cases were removed from storage for sale. (App. Exh. 11). You can also see in an email dated May 30, 2013 from Philip Carter Strother to Randy Carter and Janet Appel telling them he plans to "send [them] this month's Carter Charter Wine Club Package, which includes the Shirley Chard and the Nomini Cab Franc, along with the Carter Gazette that profiles both estates. (App. Exh. 2). Finally, Philip Carter Winery's financial reports show that in the year 2013 sold 1,440 bottles of the 2012 Chardonnay which is the first branded with any SHIRELY mark. (App. Exh. 12). In business, it is customary to launch a product well before a formal party is thrown to celebrate a release. This is commonly referred to as a soft launch. The release held at the Shirley Plantation was nothing more than a marketing event and took place many months after the actual release of the product into commerce. The Opposers statement that no evidence has been produced to show use in commerce is untrue. The evidence shows that Applicant used the SHIRLEY and SHIRLEY PLANTATION marks in commerce on or before the application filing date.

The Philip Carter Winery Logo has been in use since Philip Carter Strother purchased Stillhouse Vineyards and changed the name in February 2008. (App. Exh. 10). The logo appears on almost all

of the winery's bottles, its sign, glasses, and many other things. Opposers' do not deny the logo was used in commerce before registration. (App. Exh. 18).

**V. Applicant has used the applied for mark SHIRLEY in interstate commerce.**

Opposers claim that Applicant has not used the mark SHIRLEY in interstate commerce. This claim is made even though in Opposers' Brief and declaration they admit that Applicant's winery makes sales to out-of-state tourists. (Opp. Dameron Dec. 12-15). In fact, Applicant caters to out of state visitors on-site where it has its Shirley vines shown on tours and sells Shirley branded to the guests, while also selling Shirley branded wines on the internet across the country. (App. Exh. 22). You can see in just one example of reviews posted on the third-party site, TripAdvisor.com, that Philip Carter Winery has served visitors from Virginia, Louisiana, Maryland, Washington, D.C., and Queensland, Australia. (*Id.*). The name Shirley has been used since the winery opened in 2008 for its Shirley vineyard blocks and on its chardonnay since 2013. You can see from Opposers' own documents that the wine was called Shirley chardonnay since its inception in May of 2013. (App. Exh. 5). The marks SHIRLEY PLANTATION, SHIRLEY, and the Philip Carter Winery Logo have been used in interstate commerce.

**VI. Applicants applied for mark application No. 86/129686, the Philip Carter Winery Logo, is not likely to cause confusion because Opposers do not use anything similar as a trademark and the Opposers do not sell similar goods.**

As stated at length above, to prevent registration of a mark under Section 2(d) Opposers must show a likelihood of confusion with a mark in commerce and such potential confusion is examined through the Dupont Factors. *In re E.I Du Pont*, 177 U.S.P.Q. at 567.

*a. Opposers are not using a similar mark in commerce and present no evidence of such usage.*

Applicant restates its argument from above that Opposers simply have not used anything resembling the Philip Carter Winery Logo in commerce. Because Opposers do not own a U.S. registration, in order to prevail on a claim under Trademark Act § 2(d), they bear the burden of demonstrating a proprietary interest acquired through use of its mark prior to either the filing date of Applicant's application or Applicant's proven date of first use, whichever is earlier. *See Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); and *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993). Opposers' asserted common-law mark, the Carter family coat of arms, must be "distinctive," in the sense that it is used as an indicator of source and has at least some inherent or acquired ability to fulfill that function. *See Otto Roth*, 209 USPQ at 44; *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990). Opposers' mark is not distinctive on its face and they have provided no evidence that it has served as an indicator of source for any goods or services.

The Opposers use several examples of personal use of a Carter coat of arms to argue that it has trademark rights to that image. One such example is a cup which Charles Carter has purportedly consumed beer and wine from. (Opp Brief pg 39, Opp Exh. 13). The Opposers present several other items bearing the image of a Carter coat of arms but fail to show any items that are actually in commerce. Household goods of an individual do not count as items in commerce, and to have any actionable trademark rights the designation must be used as a trademark in commerce. *Rock & Roll Hall of Fame*, 134 F.3d at 753. Opposers do claim that the same Carter coat of arms was used on price tags in the gift shop but provide no picture of such tags and say that the last time they were used was in 1979. CITE. Opposers say that they feel that Applicant should be stopped because Charles Carter feels that he has sole rights to use any Carter coat of arms imagery because he is the “most senior male in the Carter family.” (Opp. C. Carter Dec. 8). According the 2010 United States Census, the last name Carter was held by 376,966 individuals making it the 49th most common surname, and this does not include people like Philip Carter Strother, who is a direct descendant of the same Carters as Charles Carter through his maternal lineage. (App. Exh. 25). This strong push for family honor is not based in law and is particularly interesting because on the Shirley Plantation Foundation website, again not a party to this case even though it runs the historical site and gift shop, the about section focuses more on the Hill family history as it was the Hill family who actually founded Shirley Plantation. (App. Exh. 23). The design mark for the Philip Carter Winery Logo has been in commerce since February 1, 2008. (App. Exh. 10). Opposers’ are not using anything as a trademark that resembles the Philip Carter Winery Logo, thus have no enforceable trademark rights and also lack priority over the Applicant.

*b. Dupont analysis.*

Even if the Board does find the Opposers to have a mark in commerce, which Applicant does not concede, then Opposers fail to prove a likelihood of confusion under the Dupont Factors.

Like above, the two main considerations are similarity of the marks and similarity of the goods and services. *Federated Foods*, 192 U.S.P.Q. at 29.

The drawing that the Opposers present in their Brief is almost identical to the Applicant's mark. It is however difficult to argue against it because it is not offered on any label for goods. This drawing very well could have been drawn based specifically on Applicant's mark. Two marks being compared under the Dupont Factors must be virtually identical in appearance, sound, connotation, and commercial impression. This drawing provided by Opposers and the examples of a similar mark being on random household items would provide a very different commercial impression. The Opposers examples of usage would not have a commercial impression as a trademark and are purely ornamental or decorative. TMEP §1202.03(a). The Opposers use of a coat of arms does not serve as an identifier of a secondary source and thus does not garner protections under trademark law. TMEP §1202.03. Because Opposers have shown no usage of the coat of arms in a non-ornamental manner, it does not have secondary meaning and should be refused trademark protections. TMEP §1202.03(c)

As stated above, Applicant and Opposers are in completely different industries. The goods and services of the parties are not similar. Without repeating the entire argument found in section II which Applicant wishes to restate here, Applicant produces and sells wine, while Opposer Shirley Plantation, LLC operated a gift shop and provided historical tours (before 2008). Upper Shirley Vineyards does not and has stated no plans to utilize any form of a coat of arms. Opposers state that the marks are associated with identical goods because the mark is on items "which are associated

with the consumption of wine or other beverages” and they are on display. (Opp Brief at 41). Trademark rights under the Lanham Act require more than display or using the mark in an ornamental fashion, it must be used in commerce. Opposers also state that wines are sold at the gift shop, even though it previously stated that they are not. (Opp Brief at 41 and 24 footnote 7). The fact is that any usage of a coat of arms mark by Opposers would be identical to the goods and services provided for its other mark SHIRLEY PLANTATION, however not in wine, and any analysis should be done based on that.

Opposers make it a point to stress that Applicant “cannot” sell its product at retail based on their opinions. (Opp Brief at 42). This fact, however, serves to show that most consumers of Applicant’s wines are making their purchases on-site at the Applicant’s tasting room, which like argued above is an environment where likelihood of confusion would be nearly impossible.

**VII. Applicant’s mark, Philip Carter Winery Logo, does not suggest a false connection with the Opposers.**

Because the Opposers do not use a coat of arms as a brand identifier, it would be impossible for Applicant’s logo to cause a false connection with Opposers under Section 2(a). Opposers continue to use Shirley Plantation, LLC and the Carter family interchangeably. The Carter family is an ambiguous group of people that have no enforceable trademarks. Furthermore, the Applicant’s owner, Philip Carter Strother, is a member of the Carter family, a fact that was admitted in a press release from the Shirley Plantation Foundation. (App. Exh. 5). Any connection established by the mark would be a connection to Philip Carter Strother’s own family, not the Opposers.



As connection relates to Shirley Plantation, LLC, Applicant hereby references and restates its argument in section III to be considered in this section and applying it to this mark as well.

**VIII. Applicant is not in violation of Federal regulations related to bottling spirits as it obtained COLA approval for its labels, and even if it was in violation it does not have any bearing on this opposition.**

The Trademark Manual states that a mark in commerce must be a lawful use to be the basis for federal registration. 37 C.F.R. §269. The Opposers suggest that Applicant is in violation of federal wine regulations by using a coat of arms as a logo. (Opp. Brief at 47). Opposers cite 27 C.F.R. § 4.64 where it prohibits use of insignia that is “likely to mislead the consumer to believe” that it is endorsed or produced by a government, organization, family, or individual. This is not a per se prohibition on usage of a coat of arms. Opposers would need to show that this usage would have a likelihood of confusion, which would first require proving in some way that a consumer would associate this Carter coat of arms with this specific person with the last name Carter or Shirley Plantation, LLC. As previously stated there is no likelihood of such confusion.

Furthermore, because this regulation is outside of the jurisdiction of the Trademark Board the Board should defer on its interpretation. The Board has examined labeling violation accusations before. *See Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, 209 USPQ 958, 964 (TTAB 1981); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045 (TTAB 1988); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270 (TTAB 1992). In the cases *Satinine*, *Kellogg*, and *General Mills*, the Board considered the unlawful use doctrine and declined to find the allegedly unlawful use to be invalid under the Trademark Act. The

Board in *Satinine* stated that there are simply too many federal regulatory acts (and that was in 1981) that it would be ill-advised for the Board to try to interpret whether particular uses were unlawful when they had little or no familiarity with those acts. *Satinine*, 209 USPQ at 964. In *Kellogg and General Mills*, registrations were challenged on the grounds that the usage of a mark had not complied with FDA labeling regulations and the violating party even admitted that its use did not comply, but the Board still did not invalidate the registration. *Kellogg*, 6 USPQ2d at 2046; *General Mills*, 24 USPQ2d at 1273. The Board in *General Mills*, stated that the Board should only find a mark unlawful under “one or more of the myriad regulatory acts... when the issue of compliance has previously been determined (with a finding of noncompliance) by a court or government agency having competent jurisdiction under the statute involved.” *General Mills*, 24 USPQ2d at 1273-74.

Applicant has submitted several COLA applications to the TTB starting in 2008 where the labels utilized the Philip Carter Winery Logo that has the coat of arms. (App. Exh. 24). No action has ever been initiated with the TTB, who has jurisdiction to enforce labeling requirements for alcohol, and the TTB has certainly never ruled Applicant’s use of a coat of arms to violate 27 C.F.R. § 4.64. Because the agency having jurisdiction under the statute involved has approved the usage of the Applicant’s applied for mark, the Board must not find that the Applicant’s use of the applied for mark is unlawful.

## **CONCLUSION**

The foregoing reasons show that Opposers have no rights to enforce, and even if they do the existence of both parties’ marks is not likely to confuse consumers. For those reasons and all the

reasons listed herein, Applicant respectfully requests for all of the Applicant's applied for marks to be granted registration.

Date: March 26, 2018

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 26th day of March 2018, the foregoing *APPLICANT'S TRIAL BRIEF* was served upon Opposers by delivering a true and correct copy of same to counsel for Opposers via electronic mail (only), as follows:

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