

ESTTA Tracking number: **ESTTA603450**

Filing date: **05/09/2014**

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	FITA PRETA, VINHOS, LDA.
Granted to Date of previous extension	05/14/2014
Address	Tapada Da Ajuda, N 84, 1 DInovisa ISA Lisboa, EM 1349-017 PORTUGAL

Attorney information	Matthew A. Becker The Law Office of Matthew A. Becker, PC 1003 Isabella Avenue Coronado, CA 92118 UNITED STATES matt@beckerlawfirm.com Phone:619-522-6760
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Applicant Information

Application No	86037544	Publication date	01/14/2014
Opposition Filing Date	05/09/2014	Opposition Period Ends	05/14/2014
Applicant	Maiorelli Capital LLC 362 Willis Avenue Mineola, NY 11501 UNITED STATES		

Goods/Services Affected by Opposition


Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Liqueur, namely espresso, blueberry, strawberry, lemon, orange, pineapple, cherry, melon, raspberry and lime liqueur


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
The mark is primarily geographically descriptive	Trademark Act section 2(e)(2)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4030300	Application Date	09/18/2009
Registration Date	09/27/2011	Foreign Priority	NONE

		Date	
Word Mark	SEXY		
Design Mark			
Description of Mark	The mark consists of the wording "SEXY", inside a magenta colored rectangular background with blue single line border. The wording "SEXY" is in white color and near the middle of the rectangular background area.		
Goods/Services	Class 033. First use: First Use: 2005/09/03 First Use In Commerce: 2007/01/03 Wines and sparkling wines		

U.S. Registration No.	3872904	Application Date	07/10/2008
Registration Date	11/09/2010	Foreign Priority Date	NONE
Word Mark	SEXY		
Design Mark			
Description of Mark	The mark consists of the wording "2005 SEXY TINTO RED WINE VINHO REGIONAL ALENTEJANO PORTUGAL", inside a magenta colored rectangular background with blue single line border. The wording "2005" is at the top, the wording "SEXY" is in the middle with the wording "TINTO RED WINE" immediately below it, and the wording "VINHO REGIONAL" is at the bottom with "ALENTEJANO" immediately below it, and "PORTUGAL" is at the very bottom. The wordings "2005" and "SEXY" are in the white color. The wordings "TINTO RED WINE", "VINHO REGIONAL ALENTEJANO", and "PORTUGAL" are in the color gray.		
Goods/Services	Class 033. First use: First Use: 0 First Use In Commerce: 0 Alcoholic beverages except beers		

Attachments	77830097#TMSN.jpeg(bytes) 79060415#TMSN.jpeg(bytes) Notice of Opposition.pdf(55045 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	/s/Matthew A. Becker
Name	Matthew A. Becker
Date	05/09/2014

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

IN THE MATTER OF APPLICATION:

Serial No.: : **86037544**
For the Mark : SEXYITALIAN
Applicant: : Maiorelli Capital, LLC
Filed: : August 14, 2013
Published in the
Official Gazette : January 14, 2014

Atty. Docket No. FPV 517.03

FITA PRETA VINHOS, LDA LLC

Opposer,

vs.

MAIORELLI CAPITAL, LLC

Applicant.

Opposition No.:

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

FITA PRETA VINHOS, LDA, LLC, a Limited Liability Company, located in Lisboa, Portugal, (hereinafter “OPPOSER”), believes that it will be damaged by the registration of application Serial No. **86037544**, filed on August 14, 2013, by Maiorelli Capital, LLC, a New York Limited Liability Company, (hereinafter “APPLICANT” or “MAIORELLI”) for the alleged mark SEXYITALIAN for use with “Liqueur, namely espresso, blueberry, strawberry, lemon, orange, pineapple, cherry, melon, raspberry and lime liquor,” in international class 033;

The specific grounds for this opposition are as follows:

1. OPPOSER is engaged in the manufacture, marketing, distribution and sale of wines and sparkling wines and related items highly similar to APPLICANT'S purported description of goods.
2. OPPOSER began using the designation "SEXY" trademark registration 4,030,300, in United States interstate commerce with wines and sparkling wines, well prior to the filing of APPLICANT'S trademark application and continues such use today.
3. OPPOSER first became aware of APPLICANT'S trademark filing upon searching the records with the United States Patent and Trademark Office.
4. APPLICANT'S alleged mark "SEXYITALIAN" is an imitation or colorable imitation of OPPOSER'S mark "SEXY" trademark registration 4,030,300 and 3,872,904. In fact, APPLICANT'S alleged mark only seeks to add a geographically descriptive (or mis-descriptive) term to OPPOSER's mark.
5. APPLICANT'S alleged mark "SEXYITALIAN" is nearly identical and/or confusingly similar to OPPOSER'S mark "SEXY."
6. OPPOSER'S mark "SEXY" is a strong mark and is inherently distinctive, or in the alternative, has become distinctive through the acquisition of secondary meaning during a period of more than 5 years in commerce.

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7. APPLICANT'S alleged mark "SEXYITALIAN" is likely, when used on or in connection with APPLICANT'S goods, to cause confusion, or to cause mistake, or to deceive due to its being confusingly similar to OPPOSER'S mark "SEXY" and its use in connection with goods that are identical to, or similar to, the goods sold by OPPOSER under its "SEXY" mark and on goods which travel in the same channels of trade as goods sold under OPPOSER'S "SEXY" mark.

8. OPPOSER has priority of use in commerce of its "SEXY" mark.

9. APPLICANT is not entitled to registration of the mark-in-opposition because it does not have the exclusive right to use the designation "SEXYITALIAN."

10. APPLICANT'S mark is not registerable under Section 2(d) of the Lanham Act in view of OPPOSER'S prior, continuous, ongoing and current use of its mark in commerce.

11. OPPOSER will be damaged by issuance of registration to APPLICANT in that OPPOSER will thereby be denied its rightful use of the designation "SEXY," as well as the ownership of any pending and future trademark applications which include such terms.

12. In view of the forgoing, OPPOSER would be damaged by the registration of APPLICANT'S claimed mark within the meaning of 15 U.S.C. § 1063.

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WHEREFORE, OPPOSER prays that this Notice of Opposition be sustained and that the registration sought by APPLICANT be denied.

DATED this 9th day of May, 2014.

Respectfully submitted,

/s/ Matthew A. Becker

MATTHEW A. BECKER
Attorney for Opposer
California State Bar No. 190,748

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PROOF OF SERVICE BY MAIL

I hereby declare:

I am over the age of 18 years and am not a party to this action. I am employed in San Diego, County. My business address is 1003 Isabella Avenue, Coronado, CA 92118.

On the date first written below, I served a true and correct copy of the attached document entitled:

NOTICE OF OPPOSITION

by causing it to be placed in a sealed envelope and deposited in the United States mail, first class postage fully prepaid and addressed to the following:

Mark J. Rosenberg
Tarter Krinsky & Drogin LLP
1350 Broadway
New York, NY 10018-7702

Dated: May 9, 2014

/s/ Matthew A. Becker

Matthew A. Becker