

ESTTA Tracking number: **ESTTA664837**

Filing date: **04/03/2015**

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	Turn Key Wine Brands LLC
Granted to Date of previous extension	04/04/2015
Address	132 East Carrillo Street Santa Barbara, CA 93101 UNITED STATES

Attorney information	Brett Locker Schley Look Guthrie & Locker LLP 311 East Carrillo Street Santa Barbara, CA 93101 UNITED STATES blocker@slgl-law.com Phone:805.963.4929
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Applicant Information

Application No	86391825	Publication date	02/03/2015
Opposition Filing Date	04/03/2015	Opposition Period Ends	04/04/2015
Applicant	Fireside Cider Co. LLC 865 Webster Brook Road Delhi, NY 13753 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: Hard cider

Applicant Information

Application No	86400459	Publication date	02/03/2015
Opposition Filing Date	04/03/2015	Opposition Period Ends	
Applicant	Fireside Cider Co. LLC 865 Webster Brook Road Delhi, NY 13753 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: Alcoholic beverages containing fruit; Alcoholic beverages except beers; Alcoholic beverages of fruit; Alcoholic carbonated beverages, except

beer; Hard cider

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	The mark fails to function as a trademark for the applicant's goods.

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86472811	Application Date	12/05/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WAYSIDE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2014/08/23 First Use In Commerce: 2014/10/27 Wines		

Attachments	86472811#TMSN.png(bytes) 15-04-03 Notice of Opposition - WAYSIDE.pdf(1919947 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	/brett/
Name	Brett Locker
Date	04/03/2015

Brett Locker (California State Bar No.173083)
SCHLEY LOOK GUTHRIE & LOCKER LLP
311 East Carrillo Street
Santa Barbara, CA 93101
805.963.4929
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

In the Matters of :

Trademark Application Ser. No. : 86,391,825
Filed : September 11, 2014
For the Mark : WAYSIDE
Published in the Official Gazette on : February 3, 2015;
and
Trademark Application Ser. No. : 86,400,459
Filed : September 19, 2014
For the Mark : WAYSIDE
Published in the Official Gazette on : February 3, 2015.

Turn Key Wine Brands LLC)

Opposer,)

vs.)

Fireside Cider Co. LLC)

Applicant,)

NOTICE OF OPPOSITION

- NOTICE OF OPPOSITION**
- i. The Opposer is Turn Key Wine Brands LLC, a California limited liability company (“Opposer”). Opposer’s address is 132 East Carrillo Street, Santa Barbara, CA 93101.
 - ii. Opposer’s attorneys are Brett Locker and Schley Look Guthrie & Locker LLP.
 - iii. A first Request for Extension of Time Within Which to File Notice of Opposition was timely filed by Opposer in connection with each above-referenced trademark application and accepted by the Trademark Trial and Appeal Board on February 4, 2014.

NOTICE OF OPPOSITION

Serial Nos. 86,391,825 and
86,400,459
Page 1

For the Mark: WAYSIDE

- iv. Opposer believes that it will be damaged by trademark registration of the mark that is the subject of the above-identified applications, and hereby provides notice that it opposes the same.

GROUNDS FOR OPPOSITION

1. Fireside Cider Co. LLC (“Applicant”) filed the trademark application assigned Serial Number 86,391,825 (“Applicant’s First Application”) in the United States Patent and Trademark Office (“PTO”) on September 11, 2014 (“Applicant’s First Filing Date”) to register the mark WAYSIDE (the “Mark”) for use in connection with “Hard cider” in International Class 33 (“Applicant’s First I.D. of Goods”).
2. Applicant filed the trademark application assigned Serial Number 86,400,459 (“Applicant’s Second Application” and collectively with Applicant’s First Application, “Applicant’s Applications”) in the PTO on September 19, 2014 (“Applicant’s Second Filing Date”) to register the Mark for use in connection with “Alcoholic beverages containing fruit; Alcoholic beverages except beers; Alcoholic beverages of fruit; Alcoholic carbonated beverages, except beer; Hard cider” in International Class 33 (“Applicant’s Second I.D. of Goods” and collectively with Applicant’s First I.D. of Goods, “Applicant’s Goods”).
3. Each of Applicant’s Applications was filed in reliance upon § 1(b) of the Trademark Act, 15 U.S.C. §1051(b), on the stated basis of Applicant’s *bona fide* intention to use the mark in commerce.
4. Opposer is informed and believes that Applicant has not used the Mark in commerce as of the date of this Notice of Opposition’s submission to the Trademark Trial and Appeal Board.
5. Opposer is engaged in the commercial production of wines. Opposer has used the Mark in commerce in connection with the sale of wines since before Applicant’s First Filing date, at least as early as June 27, 2014. Opposer is the owner of the exclusive right to use the Mark in commerce in connection with wines and related goods and services because Opposer first used the Mark in commerce in connection with wines before any other person or entity, including Applicant, used the Mark in commerce in connection with wines or any related goods or services.
6. Opposer filed the trademark application assigned serial number 86,472,811 (“Opposer’s Application”) with the PTO on December 5, 2014 to register the Mark for use in connection with “wines” in International Class 33 (“Opposer’s Goods”).
7. Opposer’s Application for trademark registration of the Mark was filed in reliance upon §1(a) of the Trademark Act, 15 U.S.C. §1051(a), on the basis of Opposer’s actual use of the Mark in commerce.
8. Within Opposer’s Application, Opposer alleged that Opposer first used the Mark in commerce “[a]t least as early as” October 27, 2014, and that Opposer first used the Mark anywhere “[a]t least as early as” August 23, 2014.

9. At and before the time that Opposer submitted Opposer's Application to the PTO, Opposer's attorney of record lacked complete information about the dates and natures of Opposer's first uses and first uses in-commerce of the Mark. Accordingly, Opposer's counsel caused Opposer's Application to allege Opposer's *latest* first use and first use in-commerce dates in good faith on the basis of the limited information then possessed by such counsel. Specifically, Opposer's counsel conservatively used the date that Opposer first shipped wine under the Mark as the basis for the allegation within Opposer's Application that Opposer's first date of use of the Mark in commerce was *at least as early as* October 27, 2014. Similarly, Opposer's counsel conservatively used the date that Opposer first sought a Certificate of Label Approval ("COLA") relative to Opposer's labels displaying the Mark from the Alcohol and Tobacco Tax and Trade Bureau (the "TTB") as the basis for the allegation within Opposer's Application that Opposer's *latest* first date of use of the Mark "anywhere" was *at least as early as* August 23, 2014. However, these dates were not the dates that Opposer first used the Mark in commerce and/or first used the Mark anywhere. The actual date of Opposer's first use of the Mark in commerce, per 15 U.S.C. § 1127, is at least as early as June 27, 2014. In addition, the actual date of Opposer's first use of the Mark anywhere is at least as early as March 29, 2000, the date that its related company Wayside, LLC first used the Mark (as described in paragraph 10).
10. Wayside, LLC (California Entity No. 200009010086), a California limited liability company that was organized on March 29, 2000, has been commercially involved with vineyards, fruit orchards, wineries, winemaking and wines since its organization in California, approximately fifteen years before Applicant's submission of the first of Applicant's Applications. Wayside, LLC is a related company (relative to Opposer) in accordance with 15 U.S.C. § 1055 and 15 U.S.C. § 1127.
11. Stowell Road Wine Warehouse, Inc. (California Entity No. C1855390) is a related company (relative to Opposer) in accordance with 15 U.S.C. § 1055 and 15 U.S.C. § 1127. On July 31, 2014, Stowell Road Wine Warehouse, Inc. filed a fictitious business name statement (FBN No. 2014-0002244) with the County of Santa Barbara, within the State of California. Wayside, LLC and Stowell Road Wine Warehouse, Inc. are referred to herein as "Opposer Related Companies".
12. Absent proactive measures adopted by the parties, Applicant's registration and use of the Mark is likely to cause confusion, mistake or deception in the minds of prospective purchasers and actual purchasers as to the origin or source of Applicant's Goods.
13. Absent proactive measures adopted by the parties, Applicant's registration and/or use of the Mark is likely to cause confusion, mistake or deception in the minds of prospective purchasers and actual purchasers as to the origin or source of Opposer's Goods.
14. Absent proactive measures adopted by the parties, Applicant's registration and use of the Mark is likely to cause confusion, to cause mistake or to deceive as to the affiliation, connection or association of Applicant with Opposer and/or the Opposer Related

Companies, and/or as to the origin, sponsorship or approval of Applicant's goods from, of or by Opposer and/or the Opposer Related Companies.

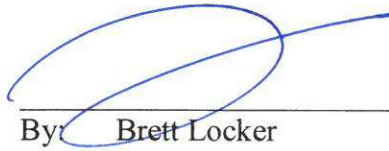
15. Opposer would be damaged by any damage directly incurred, or incurred in the first part, by the Opposer Related Companies, or either of them, as a result of Applicant's use or registration of the Mark.
16. Opposer is informed and believes that the PTO's examining attorneys, when examining Opposer's Application, likely would take the position that Applicant's Goods and Opposer's Goods travel in the same trade channels, and / or that they are likely to be purchased by the same customers in circumstances that are likely to cause consumer confusion. Indeed, on March 20, 2015, the PTO issued a Suspension Notice relative to Opposer's Application on the basis of Applicant's Applications.
17. Priority is not an issue in this case because Opposer's date of first use of the Mark in-commerce, as described within paragraph 5, precedes Applicant's First Filing Date, Applicant's Second Filing Date and Applicant's date of first use of the Mark in-commerce, *if any*. In addition, Opposer's uses of the Mark analogous to use in-commerce (including that of the Opposer Related Companies), as referenced within the final sentence of paragraph 9 and paragraphs 10 through 11, precedes Applicant's First Filing Date, Applicant's Second Filing Date and Applicant's date of first use of the Mark in-commerce, *if any*.
18. As a result of the longstanding use of the Mark by Opposer and the Opposer Related Companies in connection with vineyards, fruit orchards, winemaking, wineries and wines, relevant segments of the public associate the Mark with Opposer and the Opposer Related Companies. Accordingly, the Mark cannot function as a trademark for Applicant's Goods.
19. On or about February 14, 2015, Applicant sought to obtain a COLA from the TTB for a label identified as WAYSIDE CIDER CATSKILL (TTB ID No. 15045001000022). Also on or about February 14, 2015, Applicant sought to obtain a COLA from the TTB for a label identified as WAYSIDE CIDER HALF WILD (TTB ID No. 15045001000023). Each of the labels that are the subjects of these COLAs (and that Applicant submitted to the TTB in connection with seeking the respective COLA) identifies the subject goods as follows: "American *cider* made using wild and cultivated apples" [*emphasis added*]. Opposer is informed and believes that Applicant has not sought any other TTB COLA relative to any goods to be sold under the Mark.
20. Opposer is informed and believes that Applicant's Second Application was made without any *bona fide* / good faith intention to use the Mark in connection with all of the goods included within Applicant's Second I.D. of Goods. Specifically, Opposer is informed and believes that Applicant's Second Application was made without any *bona fide* / good faith intention to use the Mark in connection with any goods other than "hard cider".

21. Opposer is informed and believes that the circumstances surrounding Applicant's Second Application amount to a fraud on the PTO. Such fraud infects each of Applicant's Applications, and is grounds for refusal to register said applications.
22. For the foregoing reasons, the registrations sought by Applicant are contrary to the provisions of the Lanham Act, other applicable laws and public policy, and Opposer believes that it would be damaged thereby.

FOR THE REASONS STATED HEREIN, Opposer respectfully requests that the Trademark Trial & Appeal Board sustain this Opposition in favor of Opposer and refuse registration of the applications identified by Serial Nos. 86,391,825 and 86,400,459.

Respectfully submitted by:

SCHLEY LOOK GUTHRIE & LOCKER LLP

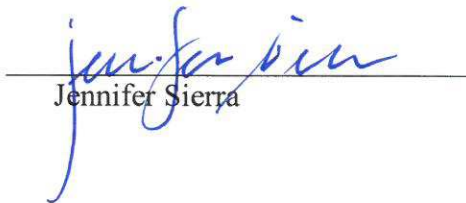


4/3/15

By: Brett Locker
Attorneys of Record for Opposer
Turn Key Wine Brands LLC

The undersigned hereby certifies that a true and complete copy of the foregoing Notice of Opposition has been served on Barbara Lipshutz by mailing said copy on Applicant's attorneys of record, Barbara Lipshutz, Jacobs & Burleigh LLP, *via* First Class Mail, postage prepaid in an envelope addressed as follows:

Barbara Lipshutz
Jacobs & Burleigh LLP
445 Park Ave. Fl. 17
New York, NY 10022-2606



Jennifer Sierra

4.3.15
Date