

ESTTA Tracking number: **ESTTA688429**

Filing date: **08/07/2015**

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	R.S. Lipman Company, LLC
Granted to Date of previous extension	08/08/2015
Address	411 GREAT CIRCLE DRIVE NASHVILLE, TN 37228 UNITED STATES

Attorney information	KEATON OSBORNE BRADLEY ARANT BOULT CUMMINGS LLP 1600 DIVISION STREET, SUITE 700 NASHVILLE, TN 37203 UNITED STATES kosborne@babco.com, karth@babco.com Phone:615.252.2358
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Applicant Information

Application No	86525440	Publication date	06/09/2015
Opposition Filing Date	08/07/2015	Opposition Period Ends	08/08/2015
Applicant	Destiladora Del Valle de Tequila, S.A de C.V CARRETERA INTERNACIONAL #102 Tequila, 46403 MEXICO		

Goods/Services Affected by Opposition

Class 032. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Beer
Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Distilled Spirits; Tequila

Grounds for Opposition

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

U.S. Registration No.	3341165	Application Date	06/06/2005
Registration Date	11/20/2007	Foreign Priority Date	NONE
Word Mark	EL DIAMANTE DEL CIELO		

Design Mark	EL DIAMANTE DEL CIELO
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Tequila

U.S. Registration No.	4658849	Application Date	04/15/2014
Registration Date	12/23/2014	Foreign Priority Date	NONE

Word Mark	EL DIAMANTE DEL CIELO
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Design Mark	
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Description of Mark	The mark consists of the wording "EL DIAMANTE DEL CIELO", the wording "EL DIAMANTE DEL" appears inside a banner above the word "CIELO", ornamental designs comprised of curved lines and miscellaneous shapes appear above the banner and beneath the word "CIELO".
Goods/Services	Class 033. First use: First Use: 2014/02/01 First Use In Commerce: 2014/02/01 Distilled Spirits

Attachments	78644536#TMSN.png(bytes) 86252900#TMSN.png(bytes) Cielo Opposition.pdf(382955 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 Overnight Courier on this date.

Signature	/keaton osborne/
Name	KEATON OSBORNE
Date	08/07/2015

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

In the Matter of Application Serial No. 86525440
For the Trademark: CIELO AZUL
Published in the *Official Gazette* on June 9, 2015

R.S. LIPMAN COMPANY, LLC,)	
)	
Opposer,)	
)	
v.)	OPPOSITION NO. _____
)	
DESTILADORA DEL VALLE DE)	
TEQUILA, S.A DE C.V)	
)	
Applicant.)	

NOTICE OF OPPOSITION

R.S. Lipman Company, LLC, (“Opposer”), having its principal place of business at 411 Great Circle Road, Nashville, Tennessee 37228, believes it would be damaged by the registration of the standard character mark CIELO AZUL in International Class 32 for “Beer” and International Class 33 for “Distilled Spirits; Tequila” (“Applicant’s Mark”) filed by Destiladora Del Valle de Tequila, S.A de C.V (the “Applicant”) as an intent-to-use application, U.S. Application Serial No. **86525440** (the “Application”), on February 5, 2015.

Opposer hereby opposes registration of Applicant’s Mark based on the following grounds:

1. Opposer believes that it would be damaged, and avers that it actually would be damaged, by the registration on the Principal Register of the Applicant’s Mark **CIELO AZUL**, which is the subject of Application Serial No. **86525440**.

2. Applicant seeks to register Applicant's Mark for "Beer" and "Distilled Spirits; Tequila", as evidenced by the publication of the Application in the *Official Gazette* and the Applicant's Mark shown therein on or about June 9, 2015.

3. Opposer is a distributor of alcoholic beverages, including beer and tequila, and services all trade channels including retail, grocery, convenience stores, and bars and restaurants.

4. Opposer distributes tequila under its registered trademarks (1) EL DIAMANTE DEL CIELO (U.S. Reg. No. 3341165), which has a date of first use in commerce of September 2005, and (2) EL DIAMANTE DEL CIELO (design plus words) (U.S. Reg. No. 4658849), which has a date of first use in commerce of February 2014. True and accurate copies of the registration certificates for U.S. Reg. No. 3341165 and U.S. Reg. No. 4658849 are attached hereto as **Exhibit A** and **Exhibit B**, respectively. The trademark subject to U.S. Reg. No. 3341165 has become incontestable pursuant to 15 U.S.C. § 1065. These marks have been associated in the mind of the relevant public with Opposer, and the phrase continues to be understood as a reference to the Opposer and its goods and services.

5. Collectively, U.S. Reg. No. 3341165 and U.S. Reg. No. 4658849 shall be hereinafter referred to as "Opposer's CIELO Marks."

6. Opposer's CIELO Marks have priority over Applicant's Mark.

7. Opposer has operated its business since at least as early as 1939 and has an extensive portfolio of trademarks for various beers, wines and spirits, including Opposer's CIELO Marks for tequila.

8. Opposer promotes and encourages the connection between Opposer and the EL DIAMANTE DEL CIELO brand by prominently using Opposer's CIELO Marks on the web, on bottle labels, and on advertising, among other uses.

9. The public generally (and particularly that portion consuming the Opposer's goods and services) recognizes that the Opposer's CIELO Marks refer to Opposer and its goods and services.

10. Applicant has filed the intent-to-use Application for a federal trademark registration with no geographical or other restrictions. If Applicant's Mark is allowed to register and Applicant begins to use the mark in interstate commerce, there is a strong likelihood of confusion with Opposer's goods and services.

11. First, the Applicant's Mark would be confusingly similar to Opposer's CIELO Marks. The proposed CIELO AZUL mark would be confusingly similar to the pre-existing marks for EL DIAMANTE DEL CIELO.

12. The sight, sound, meaning, and commercial impression of these marks are confusingly similar.

13. The most prominent feature of the Opposer's CIELO Marks and the Applicant's Mark is CIELO.

14. Additionally, Applicant's Mark for CIELO AZUL translates from the Spanish to "blue sky." The words of Opposer's CIELO Marks translate from the Spanish to "The Diamond of the Sky."

15. These translations are confusingly similar.

16. Second, the goods and services to be associated with the Applicant's Mark—alcoholic beverages, namely, tequila—would unavoidably and impermissibly overlap with the goods described and offered by the Opposer – distilled spirits. With regard to the Applicant's Mark in International Class 32, the goods "Beer" are highly related to the Opposer's goods. Thus, the goods offered under each mark are highly similar and even identical in some instances,

and the concurrent use of the subject marks in connection with the intended goods is likely to cause consumer confusion.

17. The Applicant's goods and the Opposer's goods would likely be encountered by consumers through similar trade channels under similar conditions, contributing further to consumer confusion.

18. Given these similarities, the Opposer will be damaged by registration and use of Applicant's Mark at least in part because the Applicant's Mark and the associated goods, as listed in the Application, are likely to cause confusion, mistake and deception with Opposer, with Opposer's CIELO Marks, and with the goods and services offered by Opposer. Therefore, registration of Applicant's Mark on the Principal Register and the presumptions that would arise thereby would be inconsistent with Opposer's rights. The Application is therefore due to be refused pursuant to 15 U.S.C. § 1052(d).

19. The registration of Applicant's Mark is inconsistent with Opposer's prior rights in Opposer's CIELO Marks, is inconsistent with Opposer's statutory grant of exclusivity of use of the Opposer's CIELO Marks, and would destroy Opposer's investment and goodwill in the Opposer's CIELO Marks.

20. The fee in the amount of \$600.00 is being submitted simultaneously herewith in accordance with 37 C.F.R. § 2.6(a)(17), representing \$300.00 for each of the two classes opposed. The Commissioner is authorized to debit the deposit account of Bradley Arant Boult Cummings LLP (deposit account No. 504293) for any deficiency in the required fee.

21. Opposer reserves the right to amend this Notice of Opposition upon further investigation and discovery.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Destiladora Del Valle de Tequila, S.A de C.V by mailing said copy on August 6, 2015, via Federal Express International Priority to:

DESTILADORA DEL VALLE DE TEQUILA, S.A DE C.V
CARRETERA INTERNACIONAL #102
Tequila, Mexico, 46403

/Keaton Osborne/

Keaton Osborne, Attorney for Opposer

AUTHORIZATION TO CHARGE
DEPOSIT ACCOUNT

If, after processing the enclosed correspondence, any charges, fees, or sums due remain unpaid in connection with this correspondence, I hereby authorize the Commissioner of Patents and Trademarks to charge all such remaining fees, charges, and other sums due to Deposit Account Number 504293.

 /Keaton Osborne/
Keaton Osborne, Attorney for Opposer

Exhibit A

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

United States Patent and Trademark Office

Reg. No. 3,341,165

Registered Nov. 20, 2007

TRADEMARK
PRINCIPAL REGISTER

EL DIAMANTE DEL CIELO

BLAVOD EXTREME SPIRITS USA, INC. (DELA-
WARE CORPORATION)

SUITE 211

381 MALLORY STATION ROAD

FRANKLIN, TN 37067

FOR: TEQUILA, IN CLASS 33 (U.S. CLS. 47 AND
49).

FIRST USE 9-0-2005; IN COMMERCE 9-0-2005.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

THE ENGLISH TRANSLATION OF THE MARK IS
THE DIAMOND OF THE SKY.

SN 78-644,536, FILED 6-6-2005.

JAY BESCH, EXAMINING ATTORNEY

Exhibit B

United States of America

United States Patent and Trademark Office



Reg. No. 4,658,849

Registered Dec. 23, 2014

Int. Cl.: 33

TRADEMARK

PRINCIPAL REGISTER

R.S. LIPMAN COMPANY, LLC (TENNESSEE LIMITED LIABILITY COMPANY)
411 GREAT CIRCLE DRIVE
NASHVILLE, TN 37228

FOR: DISTILLED SPIRITS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 2-1-2014; IN COMMERCE 2-1-2014.

OWNER OF U.S. REG. NOS. 3,341,165 AND 3,444,553.

THE MARK CONSISTS OF THE WORDING "EL DIAMANTE DEL CIELO". THE WORDING "EL DIAMANTE DEL" APPEARS INSIDE A BANNER ABOVE THE WORD "CIELO", ORNAMENTAL DESIGNS COMPRISED OF CURVED LINES AND MISCELLANEOUS SHAPES APPEAR ABOVE THE BANNER AND BENEATH THE WORD "CIELO".

THE ENGLISH TRANSLATION OF "EL DIAMANTE DEL CIELO" IN THE MARK IS "THE DIAMOND OF THE SKY".

SER. NO. 86-252,900, FILED 4-15-2014.

RONALD MCMORROW, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office