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

Proceeding	91228751
Party	Defendant Marble Distilling Company, LLC
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Date	08/09/2016
Attachments	ANSWER TO NOTICE OF OPPOSITION for Moonlite dated 9-August-2016.pdf(1000258 bytes)

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

In the Matter of Application Serial No.: 86536406
For the Mark: MOONLIGHT EXPRESSO
Application Filing Date: February 16, 2015
Publication in the Official Gazette Date: January 05, 2016

MOONLITE BAR-B-Q INN, INC., a Kentucky Corporation, Opposer, v. **MARBLE DISTILLING COMPANY, LLC**, d/b/a Marble Distilling Company, a Colorado limited liability company Applicant.	Opposition No.: 91228751

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ANSWER TO NOTICE OF OPPOSITION

COMES NOW Applicant Marble Distilling Company, LLC, d/b/a Marble Distilling Company ("Applicant"), by and through the undersigned counsel, and for its Answer to the Notice of Opposition filed by Moonlite Bar-B-Q Inn, Inc., a Kentucky Corporation ("Opposer"), hereby states as follows:

Responses To Preliminary Statement

Applicant admits that it is a limited liability company organized under the laws of Colorado, having a principal place of business located at 150 Main St., Carbondale, CO 81623 – 9342; and by way of further answer, Applicant admits that on February 16, 2015 it filed with the United States Patent and Trademark Office ("USPTO") its trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO ("Application") for the goods listed in International Class 033 (namely; alcohol beverages except beers), which had a publication in the Official Gazette on January 05, 2016; and by way of further answer, Applicant denies that Opposer will be damaged by the registration in the USPTO for the Mark: MOONLIGHT EXPRESSO; and by way of further answer, Applicant states that it lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in the preliminary statement of the Notice of Opposition and, therefore, denies such allegations pursuant to Rule 8(b)(5) of the Federal Rules of Civil Procedure.

Responses To Individual Allegations

1. In response to paragraph 1 of the Notice of Opposition, Applicant admits that on February 16, 2015 it filed with the USPTO its Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO, and that on or about April 1, 2015, Applicant commenced a bona fide use of the Mark: MOONLIGHT EXPRESSO in the ordinary, course of trade, for the goods listed in International Class 033 (namely; alcohol beverages except beers); specifically, an alcoholic beverage produced by distillation that has been flavored with coffee.

2. Applicant states that it lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 2 of the Notice of Opposition, including without limitation, that Opposer offers goods and services relating to restaurant

services, including the sale of beer and wine; food; food products; catering services; and food carry-out services (collectively hereinafter "restaurant services") offered by Opposer under, *inter alia*, the trademarks, MOONLITE; MOONLITE BAR-B-Q INN; and the Moon Design (collectively hereinafter "MOONLITE") and, therefore, denies such allegations pursuant to Rule 8(b)(5) of the Federal Rules of Civil Procedure.

3. Applicant states that the allegations contained in paragraph 3 of the Notice of Opposition are vague, unintelligible, and/or subject to varying interpretations in so far as they contain the irrelevant terms "extensively used" and, therefore, denies such allegations; and by way of further answer, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in paragraph 3 of the Notice of Opposition and, therefore, denies such allegations pursuant to Rule 8(b)(5) of the Federal Rules of Civil Procedure.

4. Applicant states that it lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 4 of the Notice of Opposition and, therefore, denies such allegations pursuant to Rule 8(b)(5) of the Federal Rules of Civil Procedure.

5. Applicant states that it lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 5 of the Notice of Opposition and, therefore, denies such allegations pursuant to Rule 8(b)(5) of the Federal Rules of Civil Procedure.

6. In response to paragraph 6 of the Notice of Opposition, Applicant denies that its bona fide use of the Mark: MOONLIGHT EXPRESSO in the ordinary, course of trade, for the goods listed in International Class 033 (namely; alcohol beverages except beers); specifically, an

alcoholic beverage produced by distillation that has been flavored with coffee is "*so closely related to opposer's goods and services… [that it] will cause confusion"* in that said Applicant's alcohol beverage is unequivocally distinguishable from said restaurant services offered by Opposer under the mark MOONLITE and by way of further answer, Applicant denies the remaining allegations contained in paragraph 6 of the Notice of Opposition.

7. Applicant denies these allegations contained in paragraph 7 of the Notice of Opposition for the reasons including, without limitation, each and every response contained in the above–referenced paragraph 6 of the Notice of Opposition.

8. Applicant denies these allegations contained in paragraph 8 of the Notice of Opposition for the reasons including, without limitation, each and every response contained in the above–referenced paragraph 6 of the Notice of Opposition; and by way of further answer, upon information and belief, Opposer has no intent-to-use application pending with the USPTO nor has commenced a bona fide use of the Mark: MOONLIGHT EXPRESSO in the ordinary, course of trade, for the goods listed in International Class 033 (namely; alcohol beverages except beers); specifically, an alcoholic beverage produced by distillation that has been flavored with coffee.

9. In response to paragraph 9 of the Notice of Opposition, Applicant admits that Opposer as no control – nor should it – over the nature and quality of Applicant's goods listed in International Class 033 (namely; alcohol beverages except beers); specifically, an alcoholic beverage produced by distillation that has been flavored with coffee under Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO; and by way of further answer, Applicant denies the remaining allegations contained in paragraph 9 of the Notice of Opposition.

10. Applicant denies these allegations contained in paragraph 10 of the Notice of Opposition for the reasons including, without limitation, each and every response contained in the above–referenced paragraph 6 of the Notice of Opposition.

11. In response to paragraph 11 of the Notice of Opposition, Applicant states that the allegation of a granting of a registration a trademark is prima facie exclusive right to use that mark, constitutes a legal conclusion to which no response is necessary; and by way of further answer, Applicant denies the remaining allegations contained in paragraph 11 of the Notice of Opposition for the reasons including, without limitation, each and every response contained in the above–referenced paragraph 6 of the Notice of Opposition.

First Affirmative Defense

12. Opposer fails to state a claim upon which relief can be granted.

Second Affirmative Defense

13. Opposer has no priority in the disputed mark(s) of MOONLITE, including without limitation, Opposer's reliance on unregistered common law rights provides it with no priority in that Opposer cannot establish that said disputed mark(s) is distinctive, either inherently or through secondary meaning.

Third Affirmative Defense

14. Opposer has no priority in the Mark: MOONLIGHT EXPRESSO.

Fourth Affirmative Defense

15. Opposer does not own trademark rights in the Mark: MOONLIGHT EXPRESSO.

Fifth Affirmative Defense

16. Applicant's Mark: MOONLIGHT EXPRESSO, when applied to the goods identified in Applicant's trademark application in the Matter of Application Serial No.:

86536406, listed in International Class 033 (namely; alcohol beverages except beers), is not likely to cause confusion, to cause mistake or deception with a mark "MOONLITE" allegedly owned by Opposer; or in the alternative, the extent of potential confusion is *de minimis.*

Sixth Affirmative Defense

17. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), in that the goods offered by Applicant and Opposer are so distinct in different international classes that consumers are unlikely to be confused, mistaken, or deceived into believing Applicant is connected with, otherwise authorized, sponsored, or licensed by Opposer, or in the alternative, the extent of potential confusion is *de minimis*; specifically, Applicant commenced a bona fide use of the Mark: MOONLIGHT EXPRESSO in the ordinary, course of trade, for the goods listed in International Class 033 (namely; alcohol beverages except beers), which is an alcoholic beverage produced by distillation that has been flavored with coffee (as distinguishable from said restaurant services offered by Opposer marketed under the mark MOONLITE).

Seventh Affirmative Defense

18. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), in that the common element in Applicant's and

Opposer's respective marks is the word "MOON" (factually Applicant spells its Mark as MOONLIGHT EXPRESSO and Opposer spells its Mark characteristically different as MOONLITE) is weak and therefore consumers are unlikely to be confused, mistaken, or deceived into believing Applicant is connected with, otherwise authorized, sponsored, or licensed by Opposer; or in the alternative, the extent of potential confusion is *de minimis.*

Eighth Affirmative Defense

19. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), in that the common element in Applicant's and Opposer's respective marks is the word "MOON" (factually Applicant spells its Mark as MOONLIGHT EXPRESSO and Opposer spells its Mark characteristically different as MOONLITE) that has not become such an arbitrary mark in which anytime the word is used when associated with an alcoholic beverage produced by distillation (as distinguishable from said restaurant services offered by Opposer marketed under the mark MOONLITE) that the public believes Opposer produced the distilled spirit.

Ninth Affirmative Defense

20. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), in that the common element in Applicant's and

Opposer's respective marks is the word "MOON" (factually Applicant spells its Mark as MOONLIGHT EXPRESSO and Opposer spells its Mark characteristically different as MOONLITE) is so diluted and weak in the marketplace that no one can claim exclusive rights to such word.

Tenth Affirmative Defense

21. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), given the vast number of third parties utilizing the word or a variation of the word "MOON" or the word "MOONLIGHT" or the word "MOONLITE" for the sale of beer, or wine, or food, or food products, or catering services; or food carry-out services.

Eleventh Affirmative Defense

22. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), given that Applicant's use of its Mark: MOONLIGHT EXPRESSO for an alcoholic beverage produced by distillation (as distinguishable from said restaurant services offered by Opposer marketed under the mark MOONLITE) are so dissimilarity in their entireties for appearance, sound, connotation and commercial impression.

Twelve Affirmative Defense

23. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, laches, acquiescence, and waiver, which prohibit it to content that it would be damaged by the registration of Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO for the goods listed in International Class 033 (namely; alcohol beverages except beers), given that Applicant's use of its Mark: MOONLIGHT EXPRESSO for an alcoholic beverage produced by distillation (as distinguishable from said restaurant services offered by Opposer marketed under the mark MOONLITE) are so dissimilarity in their established, likely-to-continue trade channels.

WHEREFORE, Applicant Marble Distilling Company, LLC, d/b/a Marble Distilling Company generally denies that the Opposer would be damaged by Applicant's registration of the Mark: MOONLIGHT EXPRESSO, and therefore respectfully requests that this Trademark Trial and Appeal Board of the United States Patent and Trademark Office:

I. Deny and dismiss Opposer's Notice of Opposition in all respects;

II. Grant registration to Applicant's trademark application in the Matter of Application Serial No.: 86536406 for the Mark: MOONLIGHT EXPRESSO ("Application") for the goods listed in International Class 033 (namely; alcohol beverages except beers);

III. Order Applicant have and recover its costs incurred herein; and

IV. Provide other and further relief as this Board deems just and proper under the circumstances.

Dated: August 9, 2016

KAZANAS LC

By: _____
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ATTORNEYS FOR APPLICANT

CERTIFICATE OF TRANSMISSION

I hereby certify that an original copy of the foregoing Answer to Notice of Opposition was transmitted online on this August 9, 2016 through the ESTTA page on the website of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office.

Dated: August 9, 2016

KAZANAS LC

By: _____
DAN J. KAZANAS, (MO Bar #31056)

CERTIFICATE OF SERVICE

I hereby certify that I am over the age of 18 years, not a party to this action, and that on this August 9, 2016, I caused to be served a true and correct copy of the foregoing Answer to Notice of Opposition by first-class mail to counsel for Opposer as follows:

Ted Breiner, Esq.
Breiner & Breiner, L.L.C.
115 North Henry Street
Alexandria, VA 22314

Attorneys For Opposer

Dated: August 9, 2016

KAZANAS LC

By: _____
DAN J. KAZANAS, (MO Bar #31056)