

ESTTA Tracking number: **ESTTA790884**

Filing date: **12/21/2016**

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	Consejo Regulador de la Denominacion de Origen Rioja
Granted to Date of previous extension	12/21/2016
Address	Estambreira 52 Logrono, 26006 SPAIN

Attorney information	Justin R. Young Dineff Trademark Law Limited 160 North Wacker Drive Chicago, IL 60606 UNITED STATES jyoung@dineff.com Phone:3123381000
----------------------	---

Applicant Information

Application No	86973400	Publication date	08/23/2016
Opposition Filing Date	12/21/2016	Opposition Period Ends	12/21/2016
Applicant	BAI Brands, LLC 1800 E. State Street, Suite 153 Hamilton, NJ 08609 UNITED STATES		

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: Non-alcoholic beverages containing fruit juices; fruit flavored beverages; fruit-flavored drinks; fruit based beverages; fruit based beverages enhanced with antioxidants; fruit flavored beverages enhanced with antioxidants; soft drinks; Fruit flavoured carbonated drinks; soft drinks enhanced with antioxidants; Fruit flavoured carbonated drinks enhanced with antioxidants

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is primarily geographically deceptively misdescriptive	Trademark Act Section 2(e)(3)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Geographic indication which, if used on or in	Trademark Act Section 2(a)

connection with wine or spirits, identifies a place other than the origin of the goods	
--	--

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	692578	Application Date	01/26/1959
Registration Date	02/02/1960	Foreign Priority Date	NONE
Word Mark	CONSEJO REGULADOR DENOMINACION ORIGEN RIOJA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class A. First use: First Use: 0 First Use In Commerce: 0 Wines from the Rioja District in Spain		

Attachments	72066416#TMSN.png(bytes) Opposition 86973400 12-21-16.pdf(140981 bytes)
-------------	---

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	/justinryoung/
Name	Justin R. Young
Date	12/21/2016

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

In the matter of Application Serial No **86/973400**
For the mark **BAI RIOJA ROOT BEER**
Published in the "Official Gazette" of **August 23, 2016**

<hr/>)	
Consejo Regulator de la)	
Denominación de Origen "Rioja")	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
BAI Brands, LLC)	
)	
Applicant,)	
<hr/>)	

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

Consejo Regulator de la Denominación de Origen "Rioja" ("Opposer"), an entity organized under the laws of Spain, having its principal place of business at Estrambrera, 52, Logrono, 26006, Spain, believes that it will be damaged by the registration of the mark "BAI RIOJA ROOT BEER," shown in Serial Number 86/973400 in Class 32 and hereby opposes same in accordance with 15 U.S.C. § 1063 and 37 C.F.R. § 2.101.

As grounds for the opposition, Opposer alleges as follows:

1. Commencing long prior to Applicant's filing date and any priority date that could be alleged by Applicant, Opposer has caused its certification mark "Consejo Regulator Denominacion Origen RIOJA" to be used in commerce in connection with the sale of wine from the Rioja District in Spain.

2. Opposer is the owner of, and will rely herein upon, its Federal Registration No. 692578 for the certification mark “Consejo Regulador Denominacion Origen RIOJA.” This registration is, in all aspects, valid, subsisting and is conclusive evidence of Opposer’s exclusive right to use the mark covered by such registration in commerce on the goods set forth in such registration (*See Exhibit “A”*).

3. In addition to the above Registered Mark, Opposer has extensive common law rights in the certification mark “RIOJA” for goods and services related to the wine industry (together with the mark under Reg. No. 692578 referred herein as “Opposer’s RIOJA marks”).

4. Opposer has controlled use of the RIOJA marks by others to certify that wines originate from the Rioja region of Spain, and that the wine meets other specifications established by Opposer.

5. By virtue of the aforesaid extensive use and control, consumers have come to recognize and associate Opposer’s RIOJA marks with Opposer and the products and services it certifies. As a result, Opposer has acquired substantial and valuable goodwill in Opposer’s RIOJA marks, and the marks have become a distinctive indicator of the quality and origin of goods and services bearing Opposer’s RIOJA marks, prior to the filing date of the opposed application and prior to any priority date that can be relied upon by Applicant.

6. Notwithstanding Opposer’s prior established rights in Opposer’s RIOJA marks, Applicant has filed Application No. 86/973400 with the United States Patent and Trademark Office on April 12, 2016 for registration of the mark “BAI RIOJA ROOT BEER” for “*non-alcoholic beverages containing fruit juices; fruit flavored beverages; fruit-flavored drinks; fruit based beverages; fruit based beverages enhanced with antioxidants; fruit flavored beverages enhanced with antioxidants; soft drinks; Fruit flavoured carbonated drinks; soft*”

drinks enhanced with antioxidants; Fruit flavoured carbonated drinks enhanced with antioxidants” in International Class 33, as evidenced by the publication of said mark in the *Official Gazette* of the August 23, 2016 issue.

7. Pursuant to Opposer’s request of September 19, 2016, the Board extended Opposer’s time to oppose the present application until December 21, 2016.

8. Application filed on December 15, 2016 a post-publication amendment of its Application No. 86/973400 to limit the scope to cover “*non-alcoholic beverages containing fruit juices; Non-alcoholic soft drinks; Non-alcoholic Fruit flavoured carbonated drinks; Non-alcoholic soft drinks enhanced with antioxidants; Non-alcoholic Fruit flavoured carbonated drinks enhanced with antioxidants; all the foregoing being non-alcoholic and expressly excluding wine.*”

9. Applicant’s application to register the mark “BAI RIOJA ROOT BEER” is without Opposer’s consent or permission.

10. There is no issue as to priority. The filing date of Applicant’s mark is subsequent to the registration date of Opposer’s certification mark, the first use date of Opposer’s RIOJA marks and the introduction and use of Opposer’s RIOJA marks to the marketplace and the purchasing public.

11. The mark “BAI RIOJA ROOT BEER” that Applicant seeks to register is confusingly similar to Opposer’s RIOJA marks in appearance, sound, and meaning and, thus, the use and registration thereof is likely to create the same overall impression on consumers and to cause confusion, mistake, and deception as to the source or origin of Applicant’s goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer’s RIOJA marks.

12. Applicant's goods are so closely related to Opposer's goods that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant is in some way connected or affiliated with, or sponsored by Opposer, all to Opposer's irreparable damage.

13. Likelihood of confusion in this case is enhanced by the fact that consumers associate Opposer's RIOJA marks with goods approved, or endorsed by Opposer; furthermore, purchasers of Applicant's goods are prospective purchasers of goods bearing Opposer's RIOJA marks, and vice-versa.

14. Applicant's mark "BAI RIOJA ROOT BEER" will be marketed and sold to the same consumers and through the same trade channels than Opposer's RIOJA marks, therefore, is likely to cause confusion or mistake, or to deceive, within the meaning of Section §2(d) of the Trademark Act.

15. Applicant's mark "BAI RIOJA ROOT BEER" denotes, is, and will be understood by United States consumers as denoting, that Applicant's goods originate from Rioja, Spain.

16. Applicant is limited liability company organized under the laws of the State of New Jersey and Applicant's goods will not come from, or otherwise originate in, Rioja, Spain.

17. The relevant public consumer is likely to believe that the place identified in Applicant's mark – RIOJA – describes Applicant's goods, and their geographic origin, when in fact Applicant's goods will not come from Rioja, Spain.

18. Consumers' mistaken belief that Applicant's goods will come from Rioja, Spain, would be a material factor in such consumers' purchasing decision.

19. Applicant's mark "BAI RIOJA ROOT BEER" so closely resembles Opposer's RIOJA marks that it is deceptive in that it falsely suggests a connection with or approval by

Opposer, in violation of Section §2(a) of the Trademark Act. Indeed, Applicant's mark points uniquely to Opposer, and purchasers will assume that goods offered under Applicant's alleged mark are connected with or approved by Opposer.

20. Because of the related nature of the goods, and the similarity of the marks, use and registration of Applicant's mark 'BAI RIOJA ROOT BEER' is likely to cause confusion, mistake or deception that Applicant is sponsored by or affiliated with Opposer in violation of Section §2(a) of the Trademark Act and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), Article 22.1, causing further damage to Opposer, and those persons authorized to use Opposer's RIOJA marks.

21. Applicant's mark "BAI RIOJA ROOT BEER" is geographically deceptively misdescriptive within the meaning of Section §2(e)(3) of the Trademark Act for lack of the requisite nexus with Rioja, Spain, and, therefore, registration of the mark must be refused.

22. If Applicant is permitted to use and register its marks for its goods, as specified in the application herein opposed, confusion resulting in damage and injury to Opposer will likely occur.

23. If Applicant were granted the registration herein opposed it would thereby obtain at least a *prima facie* exclusive right to its mark and the use thereof. Such registration will be a source of damage and injury to Opposer.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 86/973400 be refused, and for such other and further relief as the Commissioner of Patents and Trademarks shall deem proper and required by the Principles of Equity and Good Conscience.

Consejo Regulador de la Denominación de Origen "Rioja"

A handwritten signature in blue ink, consisting of a large, stylized loop followed by a vertical stroke and a horizontal stroke extending to the right.

Dated: December 21, 2016

By and through their attorney
Justin R. Young
DINEFF TRADEMARK LAW LIMITED
160 North Wacker Drive
Chicago, Illinois 60606
Phone (312) 338-1000
Email: jyoung@dineff.com

EXHIBIT

“A”

Generated on: This page was generated by TSDR on 2016-09-28 12:30:59 EDT

Mark: CONSEJO REGULADOR DENOMINACION ORIGEN RIOJA



US Serial Number: 72066416

Application Filing Date: Jan. 26, 1959

US Registration Number: 692578

Registration Date: Feb. 02, 1960

Register: Principal

Mark Type: Certification Mark

Status: The registration has been renewed.

Status Date: Feb. 03, 2010

Mark Information

Mark Literal Elements: CONSEJO REGULADOR DENOMINACION ORIGEN RIOJA

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Design Search Code(s): 05.03.10 - Other branches with leaves, with or without fruit

05.09.02 - Grapes

26.11.08 - Rectangles comprised of letters, numerals or punctuation and letters, numerals or punctuation forming the perimeter of a rectangle or bordering the perimeter of a rectangle.

Certification Statement: THE MARK CERTIFIES REGIONAL ORIGIN.

Foreign Information

Foreign Registration Number: 272,289

Foreign Registration Date: Dec. 16, 1953

Foreign Application/Registration Country: SPAIN

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Wines from the Rioja District in Spain

International Class(es):

U.S Class(es): A - Primary Class

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: Yes

Currently 44E: Yes

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Consejo Regulador de la Denominacion de Origen "Rioja"

Owner Address: ESTRAMBRERA, 52
26006 Logrono
SPAIN

Legal Entity Type: COMPANY

State or Country SPAIN
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Laurel V. Dineff

Docket Number: TM4193US33

Attorney Primary Email Address: info@wwipps.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Laurel V. Dineff
WWIPPS, Inc.
160 North Wacker Drive
Chicago, ILLINOIS 60606
UNITED STATES

Phone: 312-251-2500

Fax: 312-251-2510

Correspondent e-mail: info@wwipps.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Laurel V. Dineff

Phone: 312-251-2500

Fax: 312-251-2510

Domestic Representative e-mail: info@wwipps.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Feb. 03, 2010	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	68502
Feb. 03, 2010	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Feb. 01, 2010	TEAS SECTION 8 & 9 RECEIVED	
Oct. 22, 2008	CASE FILE IN TICRS	
Nov. 02, 2000	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
Nov. 02, 2000	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Feb. 17, 2000	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Feb. 02, 1980	REGISTERED AND RENEWED (FIRST RENEWAL - 20 YRS)	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Renewal Date: Feb. 02, 2010

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Feb. 03, 2010

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91200843](#)

Filing Date: Jul 22, 2011

Status: Terminated

Status Date: Dec 06, 2012

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: La Rioja Import & Export, LLC

Correspondent Address: JERRY D HAYNES
LAW OFFICE OF JERRY D HAYNES
12550 BISCAYNE BLVD STE 800
MIAMI FL , 33181
UNITED STATES

Correspondent e-mail: jdhlaw@mac.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
LA RIOJA	Abandoned - After Inter-Partes Decision	77910862	

Plaintiff(s)

Name: Consejo Regulador de la Denominacion de Origen Rioja

Correspondent Address: JUSTIN R YOUNG
DINEFF TRADEMARK LAW LIMITED
160 NORTH WACKER DRIVE
CHICAGO IL , 60606
UNITED STATES

Correspondent e-mail: jyoung@dineff.com, tmlaw@dineff.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CONSEJO REGULADOR DENOMINACION ORIGEN RIOJA	Renewed	72066416	692578

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jul 22, 2011	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jul 22, 2011	Aug 31, 2011
3	PENDING, INSTITUTED	Jul 22, 2011	
4	D'S COMMUNICATION	Sep 06, 2011	
5	TRIAL DATES RESET	Sep 07, 2011	
6	ANSWER	Sep 29, 2011	
7	ANSWER NOTED; DATES REMAIN AS SET	Oct 06, 2011	
8	D'S APPEARANCE OF COUNSEL/POWER OF ATTORNEY	Oct 18, 2011	
9	ANSWER	Oct 25, 2011	
10	DATES REMAIN AS PREVIOUSLY SET	Dec 06, 2011	
11	P'S MOT TO SUSP PEND SETLMT NEGOTIATIONS	Dec 15, 2011	
12	SUSPENDED	Dec 29, 2011	
13	RESPONSE DUE 30 DAYS (DUE DATE)	Oct 19, 2012	Nov 18, 2012
14	BOARD'S DECISION: DISMISSED AS MOOT	Dec 06, 2012	
15	TERMINATED	Dec 06, 2012	
16	D'S MAIL RETURNED BY POST OFFICE	Jan 02, 2013	

Side - 1



**NOTICE OF ACCEPTANCE OF §8
DECLARATION AND §9 RENEWAL
MAILING DATE: Feb 3, 2010**

The declaration and renewal application filed in connection with the registration identified below meets the requirements of Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§1058 and 1059. The declaration is accepted and renewal is granted. The registration remains in force.

For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

REG NUMBER: 0692578
MARK: CONSEJO REGULADOR DENOMINACION ORIGEN RI ETC.
OWNER: Consejo Regulador de la Denominacion de

Side - 2

UNITED STATES PATENT AND TRADEMARK OFFICE
COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VA 22313-1451

FIRST-CLASS MAIL
U.S POSTAGE
PAID

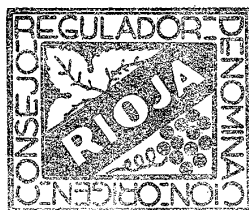
Laurel V. Dineff
WWIPPS, Inc.
160 North Wacker Drive
Chicago, IL 60606

United States Patent Office

692,578
Registered Feb. 2, 1960

PRINCIPAL REGISTER Certification Mark (Goods)

Ser. No. 66,416, filed Jan. 26, 1959



Consejo Regulador de la Denominacion de Origen
"Rioja" (Spanish company)
Milicias 1
Logrono, Spain

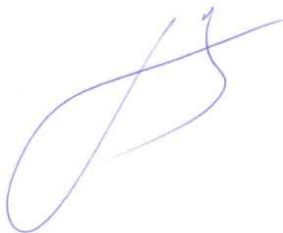
For: WINES FROM THE RIOJA DISTRICT IN
SPAIN, in CLASS A.
The mark certifies regional origin.
Owner of Spanish Reg. No. 272,289, dated Dec. 16,
1953.

AFFIDAVIT SEC. 8.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served on this date December 21, 2016, upon Applicant's attorney's correspondence address of record by First-Class mail, postage prepaid, as follows:

Jonathan A. Hyman
Knobbe Martens Olson & Bear, Llp
2040 Main Street, 14th Floor
Irvine, California United States 92614



Justin R. Young