

ESTTA Tracking number: **ESTTA912795**

Filing date: **07/31/2018**

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 | WILLIAM GRANT & SONS LIMITED |
| Granted to Date of previous extension | 08/01/2018 |
| Address | THE GLENFIDDICH DISTILLERY DUFFTOWN, BANFFSHIRE, SCOTLAND, 0 UNITED KINGDOM |

| | |
|----------------------|---|
| Attorney information | Brian P. Gregg MCNEES WALLACE & NURICK 100 PINE STREET HARRISBURG, PA 17108 UNITED STATES Email: trademarks@mcneeslaw.com, bgregg@mcneeslaw.com Phone: 717-232-8000 |
|----------------------|---|

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 87667513 | Publication date | 04/03/2018 |
| Opposition Filing Date | 07/31/2018 | Opposition Period Ends | 08/01/2018 |
| Applicant | Barnstormer Distilleries Inc 6969 S Main St Rockford, IL 61102 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: Distilled spirits

Grounds for Opposition

| | |
|--------------------------------------|------------------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
| Dilution by blurring | Trademark Act Sections 2 and 43(c) |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 346426 | Application Date | 01/13/1937 |
| Registration Date | 05/25/1937 | Foreign Priority Date | NONE |
| Word Mark | GRANT'S | | |

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|---------------------|--|
| Design Mark | GRANT'S |
| Description of Mark | NONE |
| Goods/Services | Class 033. First use: First Use: 1887/00/00 First Use In Commerce: 1887/00/00 BLENDED SCOTCH WHISKY (IN BOTTLES ONLY) |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 5228707 | Application Date | 07/07/2015 |
| Registration Date | 06/20/2017 | Foreign Priority Date | NONE |
| Word Mark | GRANT'S ELEMENTARY | | |
| Design Mark | GRANT'S ELEMENTARY | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 033. First use: First Use: 2016/07/12 First Use In Commerce: 2016/07/12 Alcoholic beverages, namely, scotch whisky | | |

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|-------------|---|
| Attachments | 71387744#TMSN.png(bytes) 86684888#TMSN.png(bytes) A6479817.pdf(12560 bytes) A6479088.pdf(92879 bytes) A6479083.pdf(100264 bytes) |
|-------------|---|

| | |
|-----------|------------------|
| Signature | /Brian P. Gregg/ |
| Name | Brian P. Gregg |
| Date | 07/31/2018 |

3. Opposer has used the GRANT'S Mark in interstate commerce in the United States continuously since 1887 in connection with the distribution, sale, marketing, advertising and promotion of distilled spirits.

4. In addition to the registered GRANT'S and GRANT'S ELEMENTARY marks noted above, Opposer has sold its distilled spirits under an extensive family of marks that contain the term GRANT'S, including the marks GRANT'S FAMILY RESERVE, GRANT'S MASTER BLENDER'S EDITION, GRANT'S ALE CASK FINISH, GRANT'S SHERRY CASK FINISH, GRANT'S NORDIC OAK FINISH, GRANT'S SIGNATURE, GRANT'S 8 YEAR OLD, GRANT'S SELECT RESERVE, GRANT'S RARE 18 YEAR OLD, GRANT'S 25 YEAR OLD and GRANT'S ELEMENTARY (collectively the "GRANT'S Family of Marks").

5. As a result of its widespread, continuous, and exclusive use of the GRANT'S Mark and the GRANT'S Family of Marks to identify its distilled spirits and Opposer as their source, Opposer owns valid and subsisting federal statutory and common law rights to the GRANT'S Mark and each individual mark within the GRANT'S Family of Marks.

6. Opposer's GRANT'S Mark and its GRANT'S Family of Marks are distinctive to both the consuming public and Opposer's trade.

7. Opposer has expended substantial time, money, and resources marketing, advertising, and promoting the distilled spirits sold under the GRANT'S Mark and GRANT'S FAMILY of Marks for over 130 years.

8. Opposer's GRANT'S whisky is a global brand with over 4,000,000 cases sold annually worldwide.

9. As a result of its distinctiveness and widespread use and promotion throughout the United States, Opposer's GRANT'S Mark is a famous trademark within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. 1125(c), and became famous prior to the filing date of the opposed application or any other priority date on which the Applicant may rely.

10. Upon information and belief, Applicant, Barnstormer Distilleries, Inc. DBA Grant View Distillery, with an address at 6969 S. Main St., Rockford, Illinois 61102, on November 1, 2017 filed trademark Application Serial No. 87/667,513 to register the proposed mark GRANT VIEW DISTILLERY for "distilled spirits" in International Class 33.

11. Applicant's application is based on its intent to use the GRANT VIEW DISTILLERY mark.

12. Opposer's GRANT'S Mark and its GRANT'S Family of Marks has priority over the proposed mark because Opposer's use and registration dates predate the Applicant's filing date or any other date on which the Applicant may rely for purposes of priority.

13. Applicant's proposed mark, GRANT VIEW DISTILLERY, is confusingly similar to Opposer's GRANT'S Mark and the GRANT'S Family of Marks. Applicant's mark begins with the dominant term GRANT which is nearly identical to Opposer's GRANT'S Mark other than being in the non-possessive form. Opposer's GRANT'S Mark is incorporated in each

member of the GRANT'S Family of Marks causing Applicant's mark to be confusingly similar to each member of that family and, by virtue of having a family of GRANT'S marks, consumers are more likely to believe that Applicant's mark is another member of that family and, therefore, an indication of the source of Opposer's goods.

14. The goods covered by the Applicant's Application Serial No. 87/667,513 are identical to the goods Opposer offers under its GRANT'S Mark and GRANT'S Family of Marks. All goods in question as between Opposer and Applicant are distilled spirits.

FIRST GROUND FOR OPPOSITION -- LIKELIHOOD OF CONFUSION

15. The Applicant's proposed mark is barred from registration because it consists of or comprises a mark which so resembles Opposer's previously used and registered GRANT'S Mark and GRANT'S Family of Marks as to be likely, when used in connection with the alleged goods of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

SECOND GROUND FOR OPPOSITION -- DILUTION

16. Opposer's GRANT'S Mark is distinctive and a "famous mark" within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

17. Opposer's GRANT'S Mark became distinctive and famous prior to the filing date of Applicant's application or any other date on which Applicant may seek to rely for purposes of priority.

18. Registration by Applicant of the proposed mark GRANT VIEW DISTILLERY for Applicant's proposed goods would be likely to impair the distinctiveness, and cause dilution by blurring, of Opposer's famous GRANT'S Mark in violation of 15 U.S.C. § 1125(c). Accordingly, pursuant to 15 U.S.C. § 1063, the proposed mark GRANT VIEW DISTILLERY is not entitled to registration.

WHEREFORE, Opposer respectfully prays that its opposition be sustained and that registration to Applicant be refused.

McNEES WALLACE & NURICK LLC

Dated: July 31, 2018

By /Brian P. Gregg/

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EXHIBIT 1

EVIDENCE OF OPPOSER'S TRADEMARK REGISTRATIONS

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GRANT'S

| | |
|------------------------------|--|
| Word Mark | GRANT'S |
| Goods and Services | IC 033. US 049. G & S: BLENDED SCOTCH WHISKY (IN BOTTLES ONLY). FIRST USE: 18870000. FIRST USE IN COMMERCE: 18870000 |
| Mark Drawing Code | (1) TYPED DRAWING |
| Serial Number | 71387744 |
| Filing Date | January 13, 1937 |
| Current Basis | 1A;44E |
| Original Filing Basis | 1A;44E |
| Registration Number | 0346426 |
| Registration Date | May 25, 1937 |
| Owner | (REGISTRANT) WILLIAM GRANT & SONS LIMITED A LIMITED-LIABILITY COMPANY GREAT BRITAIN 82 GORDON STREET SCOTLAND SCOTLAND (LAST LISTED OWNER) WILLIAM GRANT & SONS LIMITED CORPORATION BY CHANGE OF NAME FROM UNITED KINGDOM THE GLENFIDDICH DISTILLERY DUFFTOWN, BANFFSHIRE SCOTLAND |
| Assignment Recorded | ASSIGNMENT RECORDED |
| Priority Date | June 15, 1933 |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |
| Affidavit Text | SECT 12C. SECT 15. SECTION 8(10-YR) 20170610. |
| Renewal | 5TH RENEWAL 20170610 |
| Live/Dead Indicator | LIVE |

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GRANT'S ELEMENTARY

Word Mark GRANT'S ELEMENTARY

Goods and Services IC 033. US 047 049. G & S: Alcoholic beverages, namely, scotch whisky. FIRST USE: 20160712. FIRST USE IN COMMERCE: 20160712

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86684888

Filing Date July 7, 2015

Current Basis 1A

Original Filing Basis 1B

Published for Opposition April 5, 2016

Registration Number 5228707

Registration Date June 20, 2017

Owner (REGISTRANT) William Grant & Sons Limited CORPORATION UNITED KINGDOM The Glenfiddich Distillery Dufftown Banffshire **Scotland** UNITED KINGDOM

Attorney of Record William M. Merone

Prior Registrations 0346426

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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