

ESTTA Tracking number: **ESTTA926722**

Filing date: **10/05/2018**

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	SANTERO FRATELLI & C. I.V.A.S.S. SPA a.k.a. SANTERO F. LLI & C. I.V.A.S.S. SPA
Granted to Date of previous extension	10/07/2018
Address	Via Cesare Pavese, 28 Santo Stefano Belbo (CN), 12058 ITALY
Correspondence information	William Bak Howson & Howson LLP 350 Sentry Parkway, Bldg 620, Ste 210 Blue Bell, PA 19422 UNITED STATES docketing@howsoniplaw.com, wbak@howsoniplaw.com 2155409216

Applicant Information

Application No	87675598	Publication date	04/10/2018
Opposition Filing Date	10/05/2018	Opposition Period Ends	10/07/2018
Applicant	Santera Spirits LLC c/o Carol van Wijnen 2025 Broadway 19F New York, NY 10023 UNITED STATES		

Goods/Services Affected by Opposition


Class 033. First Use: 2014/11/30 First Use In Commerce: 2014/11/30 All goods and services in the class are opposed, namely: Alcoholic beverages, namely, distilled blue agave liquor

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.	4173294	Application Date	05/09/2011
Registration Date	07/17/2012	Foreign Priority	NONE

		Date	
Word Mark	ROSÁ# MOSCATO SANTERO S SINCE 1958		
Design Mark			
Description of Mark	<p>The mark consists of a shield with a letter "S" in the center and crown above the shield. There is a heraldic lion on the left and right sides of the shield. There is a banner centered below the shield and lions containing the wording "SINCE 1958". The word "ROSÁ#" appears centered below the banner. The word "MOSCATO" appears centered below the word "ROSÁ#". The word "SANTERO" appears centered below the word "MOSCATO".</p>		
Goods/Services	Class 033. First use: First Use: 1981/02/28 First Use In Commerce: 1981/02/28 alcoholic beverages except beers		

U.S. Registration No.	5023655	Application Date	05/20/2015
Registration Date	08/16/2016	Foreign Priority Date	NONE
Word Mark	9 5 8 SANTERO		
Design Mark			

Description of Mark	The mark consists of the numbers "9", "5" and "8" in black above the word "SANTERO" also in black. A red diamond appears between the numbers "9" and "5", and "5" and "8".
Goods/Services	Class 033. First use: First Use: 2016/02/05 First Use In Commerce: 2016/02/05 wines

Attachments	76707528#TMSN.png(bytes) 86635561#TMSN.png(bytes) Notice_of_Opposition.pdf(174292 bytes)
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Signature	/William Bak/
Name	William Bak
Date	10/05/2018

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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SANTERO FRATELLI & C. I.V.A.S.S. SPA, a.k.a.
SANTERO F. LLI & C. I.V.A.S.S. SPA

Opposer,

v.

SANTERA SPIRITS LLC,

Applicant.

In re Serial No. 87/675,598

Mark: SANTERA

Published: April 10, 2018

Opposition No. _____

NOTICE OF OPPOSITION

SANTERO FRATELLI & C. I.V.A.S.S. SPA ("Opposer") believes it will be damaged by registration of SANTERA in Application No. 87/675,598 (the "Opposed Application") filed by SANTERA SPIRITS LLC ("Applicant") for use in connection with goods of record in International Class 033.



Opposer hereby opposes registration of Applicant's SANTERA mark in connection with goods in International Class 003.

As grounds for opposition, Opposer alleges that:

1. Opposer, SANTERO FRATELLI & C. I.V.A.S.S. SPA, is an Italian joint stock company, with its principal place of business at Via Cesare Pavese, 28, Santo Stefano Belbo (CN) I-12058, Italy. Opposer offers for sale various types of wines.

2. For many years, before the alleged November 30, 2014 date of first use in interstate U.S. commerce of the Opposed Application, Opposer has used SANTERO and variations thereof in connection with sales of wines.

3. In addition to the common law rights, Opposer owns registrations including the dominant word SANTERO throughout the world in connection with the sale of wines, including, among others, the following registrations issued by the United States Patent and Trademark Office (the "Office"):

Registration Number	Mark	International Class(es)	Earlier of Filing Date or Date of First Use (at least as early as)
4,173,294	<p>S SINCE 1958 ROSÉ MOSCATO SANTERO</p>  <p>ROSÉ MOSCATO SANTERO</p>	033	February 28, 1981
5,023,655	<p>9·5·8 SANTERO</p>  <p>9·5·8 SANTERO</p>	033	May 20, 2015

4. The registrations referenced above are valid and subsisting, in full force and effect, and constitute *prima facie* evidence and/or conclusive evidence of Opposer's exclusive right to use the marks in commerce in connection with the goods specified in the registrations. The dominant word in both of the above referenced marks is SANTERO.

5. Registration No. 4,173,294 is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065, and constitutes conclusive evidence of Opposer's exclusive right to use the mark in commerce in connection with the goods specified in the registration.

6. During the longstanding use of marks including the dominant word SANTERO, Opposer has expended considerable time, money, and other resources in advertising and publicizing the sale of goods bearing SANTERO.

7. On November 7, 2017, Applicant filed a 1(a) Use-based application in the U.S. Patent and Trademark Office for SANTERA as shown in the Opposed Application.

8. The Opposed Application covers the following goods, in International Class 033: Alcoholic beverages, namely, distilled blue agave liquor.

9. Alcoholic beverages, namely, distilled blue agave liquor, are commonly offered for sale in U.S. commerce to consumers in stores that additionally offer for sale wines and other alcoholic beverages in nearby locations in the same store to the same consumers.

10. Applicant's SANTERA mark is visually, aurally, and conceptually similar to the dominant word SANTERO in Opposer's registered marks and the goods listed in the Opposed Application are sufficiently related to the goods offered by Opposer under Opposer's registered marks as to be likely to cause confusion, or to cause mistake, or deception of, consumers.

11. Opposer believes that it will be damaged by registration of Applicant's SANTERA mark under 15 U.S.C. §§1063, on the grounds that Applicant's use and registration of SANTERA so resembles the Opposer's Marks used by Opposer in the United States as to be likely, when used on or in connection with the goods identified in the Application, to cause confusion, mistake, or to deceive consumers, with consequent injury to Opposer and to the public, in violation of 15 U.S.C. §1052(d).

12. Opposer reasonably believes that consumers, upon encountering Applicant's Mark used in connection with Applicant's goods, are likely to believe that such goods emanate from, are authorized or sponsored by, or are in some other way affiliated with Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's SANTERA mark in Application No. 87/675,598 and respectfully requests that the registration sought by Applicant be refused.

Dated: October 5, 2018

Respectfully submitted,
HOWSON & HOWSON LLP
Attorneys for Opposer,

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