

ESTTA Tracking number: **ESTTA940886**

Filing date: **12/12/2018**

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	Jim Beam Brands Co.
Granted to Date of previous extension	12/12/2018
Address	222 W. Merchandise Mart Plaza Suite 1600 Chicago, IL 60654 UNITED STATES

Correspondence information	Michael D. Adams Mayer Brown LLP P.O. Box 2828 Chicago, IL 60690 UNITED STATES ipdocket@mayerbrown.com, dvirtue@mayerbrown.com, rasmus@mayerbrown.com no phone number provided
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Applicant Information

Application No	87407357	Publication date	08/14/2018
Opposition Filing Date	12/12/2018	Opposition Period Ends	12/12/2018
Applicants	Umolu, Uduimoh 18300 Greenleaf Ct, Tinley Park, IL 60487 UNITED STATES Taher, Belal 18300 N Greenleaf Ct Tinley Park, IL 60487 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: Alcoholic beverages, except beer; 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.	5459193	Application Date	11/22/2017
Registration Date	05/01/2018	Foreign Priority Date	NONE
Word Mark	BASIL HAYDEN'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1992/05/22 First Use In Commerce: 1992/05/22 Alcoholic beverages except beers		

U.S. Registration No.	4886125	Application Date	09/02/2015
Registration Date	01/12/2016	Foreign Priority Date	NONE
Word Mark	BASIL HAYDEN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1992/05/22 First Use In Commerce: 1992/05/22 Alcoholic beverages except beers; Whiskey		

U.S. Registration No.	1770863	Application Date	01/13/1992
Registration Date	05/11/1993	Foreign Priority Date	NONE
Word Mark	BASIL HAYDEN'S		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1992/05/22 First Use In Commerce: 1992/05/22 bourbon		

Attachments	87694888#TMSN.png(bytes) 86745153#TMSN.png(bytes) Notice of Opposition -- JON BASIL.pdf(67120 bytes)
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Signature	/Michael D. Adams/
Name	Michael D. Adams
Date	12/12/2018

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

In the matter of Serial No. 87/407,357
Filed: April 11, 2017
For the mark: JON BASIL / JON BASÍL
Published in the Official Gazette: August 14, 2018

JIM BEAM BRANDS CO.,)	
)	
Opposer,)	
)	
v.)	Opposition No.: Pending
)	
Uduimoh Umolo & Belal Taher,)	
)	
Applicants.)	

NOTICE OF OPPOSITION

Opposer, Jim Beam Brands Co., believes that it is being and will be damaged by registration of the mark JON BASIL / JON BASÍL in Serial No. 87/407,357 for use in connection with “alcoholic beverages, except beer; distilled blue agave liquor” in International Class 33. Accordingly, Jim Beam Brands Co. hereby opposes Serial No. 87/407,357 pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the Lanham Act), 15 U.S.C. § 1063(a).

The Parties and the Marks

1. Jim Beam Brands Co. (“Jim Beam”) is a Delaware corporation with its principal place of business located at 222 W. Merchandise Mart Plaza, Suite 1600, Chicago, Illinois 60654.

2. Jim Beam, along with its affiliates, is a world-leading consumer products company, and offers a uniquely diverse portfolio of beverage products enjoyed by millions around the world. Jim Beam’s BASIL HAYDEN’S brand is one of the most well-known whiskey brands in the United States, with a first use date of at least as early as 1992. Since at

least as early as 1992, Opposer has extensively used and registered its family of “BASIL HAYDEN’S” marks in connection with whiskey. (See Exhibit A for a non-exhaustive, representative sample of BASIL HAYDEN’S registrations in the United States). As a result of long-standing use, advertising, and promotion, the BASIL HAYDEN’S trademarks have become a distinctive indicator of Jim Beam’s goods and a valuable symbol of Jim Beam’s goodwill. Jim Beam’s BASIL HAYDEN’S registration is incontestable under 15 U.S.C. § 1065.

3. On information and belief, applicants Uduimoh Umolu and Belal Taher (“Applicants”) are Illinois residents, having an address at 18000 Greenleaf Court, Tinley Park, Illinois 60487.

4. On April 11, 2017, Applicant filed U.S. Application Serial No. 87/407,357 (hereinafter, the “JON BASÍL Application”) under Section 1(b) for the standard character mark JON BASÍL for use in connection with “alcoholic beverages, except beer; Tequila,” subsequently amended to “alcoholic beverages, except beer; distilled blue agave liquor” (hereinafter, the “JON BASÍL Mark”).

5. Jim Beam’s rights in the BASIL HAYDEN’S trademark date back to at least as early as 1992 based on its registrations and its widespread and continuous use of the BASIL HAYDEN’S trademark in U.S. commerce. (See, e.g., U.S. Reg. No. 1770863). On the other hand, the JON BASÍL Application was filed on April 11, 2017 on an intent-to-use basis. Therefore, Jim Beam has priority based on its senior use of the BASIL HAYDEN’S trademarks and its valid and subsisting registrations for the BASIL HAYDEN’S trademarks.

6. The JON BASÍL Mark is highly similar to Jim Beam’s BASIL HAYDEN’S trademarks in sight and sound, both utilizing the term “BASIL.” In addition, the JON BASÍL Mark, filed in connection with, among other things, “alcoholic beverages, except beer,” directly

overlaps with Jim Beam's BASIL HAYDEN trademark that is registered in connection with "alcoholic beverages, except beer; whiskey" (*See, e.g.*, U.S. Reg. No. 4886125) and Jim Beam's BASIL HAYDEN'S trademark that is registered in connection with "alcoholic beverages, except beer" (*See, e.g.*, U.S. Reg. No. 54591934). Accordingly, the JON BASÍL Mark is highly similar to the BASIL HAYDEN'S trademarks in appearance and commercial impression, and the applied-for goods are identical, or at least highly similar, to goods offered by Jim Beam under the BASIL HAYDEN'S trademark.

Likelihood of Confusion with Jim Beam's Prior Registrations
(Section 2(d), 15 U.S.C. § 1052(d))

7. Jim Beam repeats and re-alleges each and every allegation set forth in Paragraphs 1-6.

8. As set forth above, Jim Beam's use of and rights in the BASIL HAYDEN'S trademark long pre-date the filing of the JON BASÍL Application and Applicant's rights in the JON BASÍL Mark. As such, Jim Beam has priority based on its senior use of the BASIL HAYDEN'S trademark and its valid and subsisting registrations for the BASIL HAYDEN'S trademark. Furthermore, the JON BASÍL Mark is highly similar to the BASIL HAYDEN'S trademark in appearance and commercial impression, and proposed to be used in connection with identical, or at least highly similar, goods.

9. Applicant's junior use of a highly similar trademark in connection with identical or highly similar goods duplicates the distinctive BASIL HAYDEN'S trademark and will inevitably lead consumers to mistakenly believe that Jim Beam is the source of Applicant's goods and that Applicant is affiliated with, endorsed by, or sponsored by Jim Beam, all in violation of Jim Beam's rights in the BASIL HAYDEN'S trademark.

10. For the foregoing reasons, Jim Beam believes and alleges that it is being and will be damaged by the registration of the JON BASÍL Application.

11. Accordingly, the JON BASÍL Application should be refused pursuant to 15 U.S.C. § 1052(d).

Likelihood of Confusion with Jim Beam's Common Law Rights
(Section 2(d), 15 U.S.C. § 1052(d))

12. Jim Beam repeats and re-alleges each and every allegation set forth in Paragraphs 1-11.

13. As set forth above, Jim Beam's use of and rights in the BASIL HAYDEN'S trademark long pre-date the filing of the JON BASÍL Application and Applicant's rights in the JON BASÍL Mark. As such, Jim Beam has priority based on its senior use of the BASIL HAYDEN'S trademark and its valid and subsisting registrations for the BASIL HAYDEN'S trademark. Furthermore, the JON BASÍL Mark is highly similar to the BASIL HAYDEN'S trademark in appearance and commercial impression, and proposed to be used in connection with identical, or at least highly similar, goods.

14. Applicant's junior use of a highly similar trademark in connection with identical or highly similar goods duplicates the distinctive BASIL HAYDEN'S trademark and will inevitably lead consumers to mistakenly believe that Jim Beam is the source of Applicant's goods and that Applicant is affiliated with, endorsed by, or sponsored by Jim Beam, all in violation of Jim Beam's rights in the BASIL HAYDEN'S trademark.

15. For the foregoing reasons, Jim Beam believes and alleges that it is being and will be damaged by the registration of the JON BASÍL Application.

16. Accordingly, the JON BASÍL Application should be refused pursuant to 15 U.S.C. § 1052(d).

WHEREFORE, Jim Beam respectfully requests that judgment in the present opposition be entered in favor of Jim Beam and against Applicants and that Serial No. 87/407,357 be refused registration due to a likelihood of confusion.

Respectfully submitted,

JIM BEAM BRANDS CO.

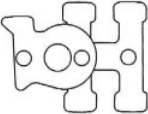
December 12, 2018

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EXHIBIT A

Representative List of Jim Beam's U.S. Applications and Registrations

Mark	Registration No.	Registration Date	Class(es)
BASIL HAYDEN'S	1770863	05-11-1993	33
BASIL HAYDEN	4886125	01-12-2016	33
BASIL  HAYDEN	3680213	09-08-2009	6, 16 & 21
BASIL HAYDEN'S	5459193	05-01-2018	33
BASIL HAYDEN'S TWO BY TWO RYE	App No. 87775059	Filing Date 01-29-2018	33
BASIL HAYDEN'S CARIBBEAN RESERVE RYE	App No. 88162481	Filing Date 10-19-2018	33