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

Proceeding	91245259
Party	Defendant Umolu, Uduimoh, Taher, Belal
Correspondence Address	UMOLU, UDUIMOH, ELLIS UMOLU, UDUIMOH, ELLIS 18300 GREENLEAF CT, TINLEY PARK, IL 60487 umolu12@gmail.com, umolu16@gmail.com no phone number provided
Submission	Answer
Filer's Name	Uduimoh Ellis Umolu
Filer's email	umolu12@gmail.com
Signature	/UduimohEllisUmolu/
Date	01/22/2019
Attachments	Signed Answer to Opposition f Jan 21 2019.pdf(225140 bytes)

**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
Published in the Official Gazette: August 14, 2018

JIM BEAM BRANDS CO.,

Opposition No. Pending
Serial No. 87/407,357
Mark: JON BASÍL

Opposer,

v.
Uduimoh Umolu & Belall Taher,

Applicant.

ANSWER TO NOTICE OF OPPOSITION

Applicants Uduimoh Umolu and Belall Taher (the “Applicant”), product owners of the Federal Trademark Application Serial No. 87/407,357 for the mark JON BASÍL, believe that their product is highly dissimilar to Jim Beam’s Basil Hayden whiskey, that the trademarks for the two goods are distinct and therefore hereby answer the notice of opposition filed by Jim Beam Brands Co. (the “Opposer”) as follows. To the extent not explicitly admitted, all allegations in the opposition are denied.

1. The Applicant lacks sufficient information to form a belief as to the truth of the matters alleged in Paragraph 1 of the Notice of Opposition and therefore the Applicant denies these matters.
2. The Applicant lacks sufficient information to form a belief as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and thereby denies each and every allegation therein.
3. The Applicant admits to being Illinois residents and that Belall Taher has a residence at 18300 Greenleaf Court, Tinley Park, Illinois 60487.
4. The Applicant admits to the matters in Paragraph 4 of the Notice of Opposition.

5. The Applicant lacks sufficient information to form a belief as to the truth of the matters alleged with respect to BASIL HAYDEN'S trademark and thereby denies this allegation. The applicant admits that the JON BASÍL trademark application was filed on April 11, 2017, but otherwise denies each and every allegation contained in Paragraph 5.
6. The Applicant denies each and every allegation contained in Paragraph 6 of the Notice of Opposition.
7. The Applicant repeats denials to each and every allegation set forth in Paragraph 7 of the Notice of Opposition and repeats denials set forth in Paragraphs 1-6.
8. The Applicant lacks sufficient information to form a belief as to the truth of the matters alleged in Paragraph 8 pertaining to Jim Beam's use of the BASIL HAYDEN trademark and therefore the Applicant denies these matters. The Applicant otherwise denies each and every other allegation contained in Paragraph 8.
9. The Applicant denies each and every allegation contained in Paragraph 9 of the Notice of Opposition.
10. The Applicant denies each and every allegation contained in Paragraph 10 of the Notice of Opposition.
11. The Applicant denies each and every allegation contained in Paragraph 11 of the Notice of Opposition.
12. The Applicant denies each and every allegation contained in Paragraph 12 of the Notice of Opposition and repeats its denials set forth in Paragraphs 1-11.
13. The Applicant lacks sufficient information to form a belief as to the truth of the matters alleged in Paragraph 13 pertaining to the Opposer's use of the BASIL HAYDEN trademark and therefore the Applicant denies these matters. The Applicant otherwise denies each and every other allegation contained in Paragraph 13.
14. The Applicant denies each and every allegation contained in Paragraph 14 of the Notice of Opposition.

15. The Applicant denies each and every allegation contained in Paragraph 15 of the Notice of Opposition.
16. The Applicant denies each and every allegation contained in Paragraph 16 of the Notice of Opposition.

Affirmative Allegations

17. The alcohol market is a \$71.69 billion market comprised of numerous easily differentiated spirits.¹ Within the alcohol market, tequila, a market that sells roughly 17.2 million 9-litre cases per year, and whiskey, a market that sells about 64 million 9-litre cases per year, are but two of the distinct types of spirits that exist.² The Applicant's trademark was filed to cover a "distilled blue agave liquor,"³ or tequila – a clear spirit originated in Mexico and created by fermenting agave. The Opposer's mark is for a "whiskey"⁴ – a normally brown spirit created by fermenting grain. The Opposer, upon information and belief, produces only whiskey products and, under the Basil Hayden brand in particular, the Opposer produces solely bourbon whiskey and dark rye whiskey products.⁵ Tequila is significantly different in both color, taste and commercial impression from whiskey. Given this difference, Opposer's mark and Applicant's mark are for goods that are highly dissimilar and distinguishable and it is highly unlikely to cause confusion, mistake or deception between the two marks to an average reasonable consumer of alcoholic beverages.
18. As shown in Exhibit A attached hereto, the wording, color, style and label of the Applicant's product, associated with the JON BASÍL mark is extremely distinct in appearance and

¹ See Leading Spirits Brands Worldwide, 2017 | Statistic, STATISTA,

² *Id.*; See also U.S. Sales Volume of Tequila, 2017 | Statistic, STATISTA, <https://www.statista.com/statistics/311633/us-sales-volume-of-tequila/> (last visited Jan 21, 2019).

³ See U.S. Application Serial No. 87/407,357

⁴ See, e.g., U.S. Reg. No. 4886125

⁵ See Kentucky Straight Bourbon Whiskey | Premium | Basil Hayden's®, BASIL HAYDENS, <https://www.basilhaydens.com/bourbon-whiskey> (last visited Jan 21, 2019). See also Made to share., BOURBON VS. WHISKEY: WHAT IS JIM BEAM® BOURBON?, <https://www.jimbeam.com/en-us> (last visited Jan 21, 2019)

commercial impression from that of the Opposer, making it highly unlikely that any customer confusion would exist between the goods associated with these marks.

19. Alternatively, any similarity between the two marks is limited to the word “basil,” which is not distinctive as “basil” is a common word in relation to beverages and food and so no single entity should have exclusive rights to use that word. See, for example, the following registrations of marks including the word “Basil” for wine, beer or alcoholic beverages.

558315 – GIN MARE MEDITERRANEAN GIN COLLECCIÓN DEATOUR. DISTILLED FROM OLIVES. THYME. ROSEMARY AND BASIL

5079262 – HOUNDS OF BASIL

5193125 – LEMON AND LIME BASIL KÖLSCH STYLE ALE

20. Further, the word “Basil” in the Applicant’s and the Opposer’s marks are highly dissimilar in pronunciation. The Applicant uses the word “Basíl,” with an accented “i” so that the word is pronounced bə'sil, while the “basil” included in the Opposer’s mark is without an accent and is pronounced, on information and belief, as follows: bāzəl. Further, taken in their entirety, the words JON BASÍL are neither identical nor highly similar to the words BASIL HAYDEN, taken in their entirety. This difference in pronunciation, and in the complete wording of each mark, makes it even more unlikely that any average consumer of alcohol would confuse the two marks.

21. The Applicant’s product is currently sold in thirty (30) stores in the Chicago area of the United States. In each store in which it is sold, the Applicant’s product is shelved alongside other tequila products, in a completely separate shelving area than such store’s whiskey products. Since the Applicant’s goods began being sold forty-five (45) days ago, there has been no evidence of customer confusion between the Applicant’s and the Opposer’s goods or marks, and no evidence of any other damage to the Opposer’s brand.

22. The Applicant's good is actively marketed and sold at a premium price (in excess of \$32 per 750 milliliter bottle) to the young, urban professional consumer of premium tequila products. Advertising for the Applicant's product has included Instagram posts by local and national rap artists and social media influencers directly attributing the product, and the JON BASÍL brand, to the Applicant. The Opposer's mark, on advice and belief, is marketed primarily to an older, sophisticated whiskey consumer. Therefore, the clientele for the Applicant is likely to be very distinct from that of the Opposer. Further, consumers of premium alcohol beverages usually exercise a relatively high degree care of sophistication when deciding between alcoholic beverages.⁶ Since both the Applicant and the Opposer target sophisticated, careful alcohol consumers, rather than impulse buyers of alcohol, it is highly unlikely that such sophisticated consumers of alcohol will confuse a premium tequila product with a whiskey product or otherwise attribute the Applicant's mark and product to the Opposer.⁷
23. The Applicant affirmatively alleges that as a result of its usage of its mark JON BASÍL since adoption, the mark is a valuable asset of the Applicant and carries considerable goodwill and customer acceptance of its tequila product sold under its unique and distinctive mark.

WHEREFORE, due to the high cumulative dissimilarity between the Applicant's and the Opposer's marks, and the goods associated therewith, the Applicant requests that the Notice of Opposition be denied and that the Trademark Trial and Appeal Board permit the Applicants to register the proposed mark in Application Serial Number 87/407,357 in the United States Patent and Trademark Office.

⁶ See *Star Indus.m Inc. v. Bacardi & Co.*, 412 F.3d, 371, 390 (2d. Cir. 2005)

⁷ *Id.*

Dated: January 21, 2019

Respectfully Submitted,

Uduimoh Ellis Umolu

By, Uduimoh Umolu

Umolu12@gmail.com

18300 Greenleaf Court

Tinley Park, Illinois 60487

Telephone: +1773.573.8097

Applicant

Exhibit A

Comparison of Jon Basil Tequila Bottle and Basil Hayden Bottle

Jon Basil Tequila Bottle and Label	Basil Hayden Whiskey Bottle and Label ⁸
	

⁸ Basil Hayden's on Instagram • Photos and Videos, INSTAGRAM, <https://www.instagram.com/explore/locations/61465784828/basil-haydens?hl=en> (last visited Jan 21, 2019).

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Answer to Notice of Opposition has been served on Attorneys for Opposer by forwarding said copy on January 21, 2019, via email, to Daniel P. Virtue, dvirtue@mayerbrown.com.

Dated: January 21, 2019

Uduimoh Ellis Umolu

Uduimoh Umolu