

ESTTA Tracking number: **ESTTA1028110**

Filing date: **01/10/2020**

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	Laird & Company
Granted to Date of previous extension	01/12/2020
Address	ONE LAIRD ROAD SCOBENVILLE, NJ 07724 UNITED STATES

Attorney information	JOHN W. MCGLYNN RATNERPRESTIA 2200 RENAISSANCE BLVD, SUITE 350 KING OF PRUSSIA, PA 19406 UNITED STATES tmde@ratnerprestia.com, jwmcglynn@ratnerprestia.com 6104070700
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Applicant Information

Application No	88398254	Publication date	07/16/2019
Opposition Filing Date	01/10/2020	Opposition Period Ends	01/12/2020
Applicant	Margaritaville Enterprises, LLC 256 Worth Ave., Suite Q-R Palm Beach, FL 33480 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
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Applicant Information

Application No	88398235	Publication date	07/16/2019
Opposition Filing Date	01/10/2020	Opposition Period Ends	
Applicant	Margaritaville Enterprises, LLC 256 Worth Ave., Suite Q-R Palm Beach, FL 33480 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

Applicant Information

Application No	88515215	Publication date	09/17/2019
Opposition Filing Date	01/10/2020	Opposition Period Ends	
Applicant	Margaritaville Enterprises, LLC 256 Worth Ave., Suite Q-R Palm Beach, FL 33480 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: Wine, table wine, sparkling wine, fortified wine; wine-based cocktails, wine coolers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	324021	Application Date	07/23/1934
Registration Date	05/07/1935	Foreign Priority Date	NONE
Word Mark	FIVE O'CLOCK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1934/07/13 First Use In Commerce: 1934/07/13		

	GIN		
U.S. Registration No.	324022	Application Date	07/23/1934
Registration Date	05/07/1935	Foreign Priority Date	NONE
Word Mark	FIVE O'CLOCK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1934/07/13 First Use In Commerce: 1934/07/13 GIN		

Attachments	71354218#TMSN.png(bytes) 71354217#TMSN.png(bytes) Notice of Opposition.pdf(191819 bytes)
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Signature	/jwm/
Name	JOHN W. MCGLYNN
Date	01/10/2020

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

In the Matter of Application Nos.: 88398254, 88398235 and 88515215
Marks: IT'S 5 O'CLOCK SOMEWHERE, IT'S 5 O'CLOCK SOMEWHERE and IT'S FIVE
O'CLOCK SOMEWHERE
Filed: July 15, 2019, April 23, 2019 and April 23, 2019

Laird & Company,

Opposer,

v.

Margaritaville Enterprises, LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Laird & Company (“Opposer”) believes that it will be damaged by registration of IT'S 5 O'CLOCK SOMEWHERE and IT'S FIVE O'CLOCK SOMEWHERE (“Applicant’s Applied-For Marks”) appearing in U.S. Application Nos. 88398254, 88398235 and 88515215 (“Applications”) and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Opposer is a corporation organized under the laws of New Jersey and has a place of business at One Laird Road, Eatontown NJ 07724.

2. Upon information and belief, Margaritaville Enterprises, LLC (“Applicant”) is a limited liability company organized under the laws of Delaware with an address at 256 Worth Ave., Suite Q-R, Palm Beach FL 33480.

3. Opposer is the owner of rights in a design mark comprised of a clock above FIVE O’CLOCK as well as rights in FIVE O’CLOCK in standard characters for use in connection with alcoholic beverages, including gin, vodka and rum.

4. Opposer owns U.S. Registration Nos. 324021 and 324022 (“Registrations”) for



and FIVE O’CLOCK (“Opposer’s Marks”) for “gin,” both of which have a filing date of July 23, 1934, registration date of May 07, 1935, and first use dates of July 13, 1934. A copy of the records from the USPTO’s Trademark Status and Document Retrieval (TSDR) database showing the current status and title of the Registrations is submitted herewith.

5. The Registrations are valid and in full force and effect.

6. Through continuous and uninterrupted use and promotional and marketing activities for over 85 years, Opposer’s Marks have come to be recognized throughout the United States as identifying alcoholic beverages, including gin, vodka and rum, emanating from or associated with Opposer. As a result, Opposer has developed a valuable reputation and acquired goodwill in connection with Opposer’s Marks.

7. Opposer is also the owner of pending U.S. Application No. 88569591, filed August 7, 2019, in connection with “Alcoholic beverages, except beer; liquor; distilled spirits;

vodka; gin; rum; spiced rum.” for the following intended stylization (“Opposer’s Pending Application”):



8. Applicant’s Applications were filed on July 15, 2019 and April 23, 2019, for “Distilled spirits;” and “Wine, table wine, sparkling wine, fortified wine; wine-based cocktails, wine coolers” (“Applicant’s Goods”).

9. Opposer has obtained extensions of time to oppose the Applications.

10. Opposer’s use and registration of Opposer’s Marks predates Applicant’s filing dates. Accordingly, Opposer’s rights are senior to Applicant’s rights.

11. Applicant’s Applied-For Marks incorporate the literal elements of Opposer’s Marks.

12. Applicant’s Applied-For Marks are confusingly similar to Opposer’s Marks in appearance, sound and commercial impression.

13. The goods identified in the Applications include or are closely related to goods identified in the Registrations.

14. The Applications and Registrations contain no trade channel limitations or restrictions, so the goods listed in the Applications and Registrations are presumed to travel in the same trade channels and be marketed to the same class of purchasers.

15. Due to the similarity between Applicant's Applied-For Marks and Opposer's Marks and the parties' overlapping and related goods, consumers are likely to believe that Applicant's Goods originate from Opposer or are otherwise approved, endorsed or sponsored by Opposer, resulting in a likelihood of confusion in the marketplace and damage to Opposer.

16. In the alternative, if Applicant's Applied-For Marks are permitted to mature to registration and use by Applicant, some consumers are likely to believe that Opposer's Goods originate from or are otherwise approved, endorsed or sponsored by Applicant, or that Opposer is infringing or otherwise trading on the goodwill of Applicant, causing a likelihood of reverse confusion and associated damages to Opposer.

17. Applicant's Applications are part of a pattern of activity by Applicant that threatens to dilute and diminish the scope of protection Opposer enjoys in Opposer's Marks and Registrations therefor, which pattern of activity includes Applicant filing U.S. Application No. 88308876 for 5 O'CLOCK COCKTAILS, filed Feb. 20, 2019, for "Alcoholic beverage produced from a brewed malt base with natural flavors," which application was refused registration by the USPTO based upon Opposer's Registrations.

18. Applicant's pattern of activity further includes serially filing Applications to register variations of FIVE O'CLOCK SOMEWHERE in class 33, including U.S. App. No. 85613556 for IT'S FIVE O'CLOCK SOMEWHERE, filed May 1, 2012; U.S. App. No. 85932529 for FIVE O'CLOCK SOMEWHERE, filed May 15, 2013, and U.S. App. No. 86896006 for IT'S 5 O'CLOCK SOMEWHERE, filed February 3, 2016, all of the foregoing for "Wine, table wine, sparkling wine, fortified wine; wine-based cocktails, wine coolers," and all of the foregoing abandoned for failure to file a Statement of Use after the filing of five Extensions of Time to file a Statement of Use.

19. Applicant's pattern of serially filing intent-to-use applications without actual use over a period of more than seven years is evidence that Applicant lacks a bona fide intent to use Applicant's Applied-For Marks, which Opposer hereby alleges, on such information and belief, as another basis for this Opposition.

20. Applicant's 88398254 and 88515215 applications and its 5 O'CLOCK COCKTAILS application have been cited by the USPTO in a Prior-Filed Application(s) Advisory in an Office Action issued in connection with Opposer's Pending Application, which indicates that if one or more of the cited applications registers, Opposer's mark may be refused registration because of a likelihood of confusion. Applicant's Applications are therefore already causing damage to Opposer by delaying Opposer's ability to register formatives and variations of its own longstanding marks, and publication of Applicant's Applications threatens to increase this delay by up to three years, even if Applicant's Applications never mature to registration.

21. Applicant does not have Opposer's consent to use, register, or reserve rights in Applicant's Applied-For Marks.

22. Registration and/or publication of Applicant's Applied-For Marks will cause irreparable damage to Opposer under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Respectfully submitted,

Dated: January 10, 2020

By: /jwm/
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Rex A. Donnelly
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King of Prussia, PA 19406
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radonnelly@ratnerprestia.com

*Attorneys for Opposer,
Laird & Company*

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Mark: FIVE O'CLOCK



US Serial Number: 71354218

Application Filing Date: Jul. 23, 1934

US Registration Number: 324021

Registration Date: May 07, 1935

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Jul. 19, 2014

Mark Information

Mark Literal Elements: FIVE O'CLOCK

Standard Character Claim: No

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

Design Search Code(s): 17.01.02 - Clock faces (alone); Clock radios; Watch faces (alone); Radios with clock; Clocks

Related Properties Information

Claimed Ownership of US Registrations: 0314918

Publish Previously Registered Mark: Yes

Previously Registered Mark Publication Date: May 10, 1955

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: GIN

International Class(es): 033

U.S Class(es): 049 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 13, 1934

Use in Commerce: Jul. 13, 1934

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: LAIRD & COMPANY

Owner Address: ONE LAIRD ROAD
SCOBEEVILLE, NEW JERSEY UNITED STATES 07724

Legal Entity Type: CORPORATION

State or Country NEW JERSEY
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: John W. McGlynn

Docket Number: LRD-F060US

Attorney Primary tmde@ratnerprestia.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent John W. McGlynn
Name/Address: RatnerPrestia
1235 Westlakes Drive, Suite 301
PO Box 980
Berwyn, PENNSYLVANIA UNITED STATES 19312

Phone: 610-407-0700

Fax: 610-407-0701

Correspondent e- tmde@ratnerprestia.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 19, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jul. 19, 2014	REGISTERED AND RENEWED (FIFTH RENEWAL - 10 YRS)	76874
Jul. 19, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	76874
Jul. 19, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76874
Jul. 07, 2014	TEAS SECTION 8 & 9 RECEIVED	
Oct. 01, 2008	CASE FILE IN TICRS	
Sep. 15, 2004	REGISTERED AND RENEWED (FOURTH RENEWAL - 10 YRS)	
Sep. 15, 2004	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jun. 29, 2004	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jun. 29, 2004	TEAS SECTION 8 & 9 RECEIVED	
Sep. 13, 1995	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	
May 04, 1995	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
May 07, 1975	REGISTERED AND RENEWED (SECOND RENEWAL - 20 YRS)	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Jul. 19, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: HIRAM WALKER & SONS, INC.

Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0820/0803](#)

Pages: 12

Date Recorded: Oct. 10, 1991

Supporting Documents: No Supporting Documents Available

Assignor

Name: [HIRAM WALKER & SONS, INC.](#)

Execution Date: Aug. 29, 1991

Legal Entity Type: CORPORATION

State or Country Where Organized: MICHIGAN

Assignee

Name: [LAIRD AND COMPANY](#)

Legal Entity Type: COMPANY

State or Country Where Organized: No Place Where Organized Found

Address: No Assignee Address Found

Correspondent

Correspondent Name: ALLAN RTNER

Correspondent Address: 500 N. GULPH ROAD
P.O. BOX 980
VALLEY FORGE, PA 19482

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: SECURITY INTEREST

Reel/Frame: [1067/0164](#)

Pages: 15

Date Recorded: Nov. 22, 1993

Supporting Documents: No Supporting Documents Available

Assignor

Name: [LAIRD & COMPANY](#)

Execution Date: Nov. 18, 1993

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW JERSEY

Assignee

Name: [UNITED JERSEY BANK/CENTRAL, N.A.](#)

Legal Entity Type: NATIONAL BANKING ASSOCIATION

State or Country Where Organized: No Place Where Organized Found

Address: CN 5316
301 CARNEGIE CENTER
PRINCETON, NEW JERSEY 085435316

Correspondent

Correspondent Name: GIORDANO, HALLERAN & CIESLA/KEA

Correspondent Address: KURT E. ANDERSON, ESQ.
125 HALF MILE ROAD
P.O. BOX 190
MIDDLETOWN, NJ 07748

Domestic Representative - Not Found

Generated on: This page was generated by TSDR on 2020-01-10 13:01:51 EST

Mark: FIVE O'CLOCK

FIVE O'CLOCK

US Serial Number: 71354217

Application Filing Date: Jul. 23, 1934

US Registration Number: 324022

Registration Date: May 07, 1935

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Amended to Principal Register: Yes

Date Amended to Current Register: Sep. 09, 1975

Status: The registration has been renewed.

Status Date: Jul. 19, 2014

Mark Information

Mark Literal Elements: FIVE O'CLOCK

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 0314918

Publish Previously Registered Mark: Yes

Previously Registered Mark Publication Date: May 10, 1955

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State or Country NEW JERSEY
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: John W. McGlynn

Docket Number: LRD-F070US

Attorney Primary tmde@ratnerprestia.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent John W. McGlynn
Name/Address: RatnerPrestia
1235 Westlakes Drive, Suite 301
PO Box 980
Berwyn, PENNSYLVANIA UNITED STATES 19312

Phone: 610-407-0700

Fax: 610-407-0701

Correspondent e- tmde@ratnerprestia.com
mail:

Correspondent e- Yes
mail Authorized:

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TM Staff Information - None

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Correspondent Name: ALLAN RTNER

Correspondent Address: 500 N. GULPH ROAD
P.O. BOX 980
VALLEY FORGE, PA 19482

Domestic Representative - Not Found

Assignment 2 of 2

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MIDDLETOWN, NJ 07748

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