

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Baxley

March 20, 2020

Opposition No. 91253443

*Laird & Company*

*v.*

*Margaritaville Enterprises, LLC*

**Andrew P. Baxley, Interlocutory Attorney:**

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference with the parties on March 20, 2020, after Applicant requested Board participation in writing on February 21, 2020. Present during the conference were Opposer's attorneys John W. McGlynn and Rex A. Donnelly, Applicant's attorney Joel R. Feldman, and Board interlocutory attorney Andrew P. Baxley.

The Board is an administrative tribunal that is empowered solely to determine the right to register and which has no authority to determine the right to use a mark or any infringement or unfair competition issues. *See* TBMP § 102.01 (2019). A Board *inter partes* proceeding, such as this case, is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, document requests, and requests

for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case.

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

The Board encourages the parties to discuss settlement. The Board is generous in granting consented extensions of the schedule and periods of suspension to accommodate any settlement pursuits.

Any party filing an unconsented motion to extend or suspend should notify the Board by telephone upon the filing thereof so that such motion can be resolved promptly by telephone conference. *See* Trademark Rule 2.120(i)(1); TBMP § 502.06(a). The parties should review the Trademark Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, online at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board>. The Board expects all parties appearing before it, whether or not they are represented by counsel, to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure.

The Board's standard form protective order is in effect in this proceeding to govern the exchange of confidential information and materials. *See* Trademark Rule 2.116(f). The standard protective order is online at

[https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order\\_02052020.pdf](https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order_02052020.pdf). The parties may substitute a stipulated protective agreement (signed by both parties and approved by the Board upon motion). In view of the existence of the Board's standardized protective order, the Board will not become involved in a dispute over any substitution thereof.

Neither party may serve discovery requests nor file a motion for summary judgment, except on certain limited grounds not at issue in this case, until that party has served its initial disclosures. *See* Trademark Rules 2.120(a)(3) and 2.127(e)(1). If the parties become involved in any other litigation, they should notify the Board immediately so that the Board can take appropriate action. *See* Trademark Rule 2.117(a); TBMP §§ 510.02 and 511.

All service must be made by e-mail, unless otherwise stipulated. *See* Trademark Rule 2.119. The parties' e-mail addresses of record are [tmde@ratnerprestia.com](mailto:tmde@ratnerprestia.com) and [jwmcglynn@ratnerprestia.com](mailto:jwmcglynn@ratnerprestia.com) for Opposer and [atltrademark@gtlaw.com](mailto:atltrademark@gtlaw.com) for Applicant.

In this proceeding, Applicant filed three intent-to-use applications to register the mark IT'S 5 O'CLOCK SOMEWHERE and IT'S FIVE O'CLOCK SOMEWHERE for alcoholic beverages in International Class 33.<sup>1</sup> Opposer opposes registration of Applicant's marks on grounds of (1) likelihood of confusion with its previously used

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<sup>1</sup> Application Serial No. 88398235, filed April 23, 2019, for the mark IT'S FIVE O'CLOCK SOMEWHERE for "Distilled spirits."

Application Serial No. 88398254, filed April 23, 2019, for the mark IT'S 5 O'CLOCK SOMEWHERE for "Distilled spirits."

Application Serial No. 88515215, filed July 15, 2019 for IT'S 5 O'CLOCK SOMEWHERE for "Wine, table wine, sparkling wine, fortified wine; wine-based cocktails, wine coolers."

and registered mark which include the wording FIVE O’CLOCK for “gin” in International Class 33<sup>2</sup> under Trademark Act Section 2(d), 15 U.S.C. § 1052(d) (*see King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108, 109-10 (CCPA 1974); *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA)), and (2) no bona fide intent to use the mark in commerce when Applicant filed the involved applications under Trademark Act Section 1(b), 15 U.S.C. § 1051(b) (*see Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506-07 (TTAB 1993)).

Applicant, in its answer, denied the salient allegations of the notice of opposition, and provided additional amplifications of the denials. There is no other pending litigation between the parties.

To prevail on its Section 2(d) claim, Opposer must establish that (1) it has standing to maintain this proceeding; (2) that it is the prior user of, or owns a registration for, its pleaded mark; and (3) that contemporaneous use of the parties’ respective marks on their respective goods would be likely to cause confusion, mistake or to deceive

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<sup>2</sup> The pleaded registrations are:

Registration No. 324021 for the mark FIVE O’CLOCK and design in the following form,



**FIVE O’CLOCK**, issued May 7, 1935, renewed.

Registration No. 324022 for the mark FIVE O’CLOCK in typed form, issued May 7, 1935, renewed.

Opposer also pleads its pending intent-to-use application Serial No. 88569591, filed August

7, 2019, for the mark FIVE O’CLOCK and design in the following form, , for “Alcoholic beverages, except beer; liquor; distilled spirits; vodka; gin; rum; spiced rum” in International Class 33. This application was filed after all of Applicant’s involved applications.

consumers. *See* Trademark Act Section 2(d); *King Candy Co., supra*; *Fram Trak Indus., Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2004 (TTAB 2006). Opposer's submission of a status and title copy of its pleaded registrations obtained from USPTO records as an exhibit to its notice of opposition will generally suffice to establish its standing and remove priority as an issue in this case with regard to the registered marks for the goods identified therein. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

The question of registrability of Applicant's mark must be decided on the basis of the identification of goods set forth in the involved application and the pleaded registration, regardless of what the record may reveal as to the particular nature of those goods, the particular channels of trade or the class of purchasers to which sales of the services are directed. *See Octocom Sys. Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Where the goods and/or services in an application or registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, the Board must presume that the scope of the registration encompasses all goods and/or services of the nature and type described, that the identified goods and/or services move in all channels of trade that would be normal for such goods and/or services, and that the goods and/or services would be purchased by all potential customers. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

The Board raised the possibility of resolving this case by accelerated case resolution (ACR). The parties are directed to review the Board's website regarding

ACR at <http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>. If the parties later agree to pursue ACR after some disclosures and discovery, they should notify the above-signed interlocutory attorney as soon as possible to schedule a telephone conference to further discuss how they want to go forward with ACR.

During the discovery conference, the parties agreed to a thirty-day extension of dates. Remaining dates are reset as follows.

Discovery Opens	4/22/2020
Initial Disclosures Due	5/22/2020
Expert Disclosures Due	9/19/2020
Discovery Closes	10/19/2020
Plaintiff's Pretrial Disclosures Due	12/3/2020
Plaintiff's 30-day Trial Period Ends	1/17/2021
Defendant's Pretrial Disclosures Due	2/1/2021
Defendant's 30-day Trial Period Ends	3/18/2021
Plaintiff's Rebuttal Disclosures Due	4/2/2021
Plaintiff's 15-day Rebuttal Period Ends	5/2/2021
Plaintiff's Opening Brief Due	7/1/2021
Defendant's Brief Due	7/31/2021
Plaintiff's Reply Brief Due	8/15/2021
Request for Oral Hearing (optional) Due	8/25/2021

The Board thanks the parties for their participation.