

ESTTA Tracking number: **ESTTA1088735**

Filing date: **10/14/2020**

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	FRANCISCAN VINEYARDS, INC.
Granted to Date of previous extension	10/14/2020
Address	1178 GALLERON ROAD ST. HELENA, CA 94574 UNITED STATES
Attorney information	EDWARD F. MALUF SEYFARTH SHAW LLP 620 EIGHTH AVE. 32ND FLOOR NEW YORK, NY 10018 UNITED STATES Primary Email: emaluf@seyfarth.com Secondary Email(s): jheinbockel@seyfarth.com , cbidocket@seyfarth.com , jschachter@seyfarth.com 2122185500
Docket Number	105820-6

Applicant Information

Application No.	88799975	Publication date	06/16/2020
Opposition Filing Date	10/14/2020	Opposition Period Ends	10/14/2020
Applicant	PRISION BREWING CO LLC 8428 NW 66 STREET MIAMI, FL 33166 UNITED STATES		

Goods/Services Affected by Opposition

Class 032. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Beer; Beer, ale and lager; Beers; Black-beer; Craft beers; Malt beer; Pale beer; Wheat beer; India pale ales (IPAs)
Class 043. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bar services; Pubs; Restaurant; Restaurant and bar services; Restaurant services; Taproom services featuring craft beers

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.	3444928	Application Date	10/11/2007
Registration Date	06/10/2008	Foreign Priority Date	NONE
Word Mark	THE PRISONER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2002/08/01 First Use In Commerce: 2002/08/01 Wines		

U.S. Registration No.	6064267	Application Date	11/08/2019
Registration Date	05/26/2020	Foreign Priority Date	NONE
Word Mark	THE PRISONER WINE COMPANY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 2019/11/01 First Use In Commerce: 2019/11/01 Bar services; Catering services; Consulting services in the field of culinary arts; Restaurant services; Wine bars; Providing general purpose convention facilities; Providing general purpose facilities for exhibitions; Providing information about wine characteristics		

Attachments	PRISION BREWING CO. - NOO.pdf(362813 bytes) Reg Certs.pdf(621335 bytes)
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Signature	/John C. Heinbockel/
Name	John C. Heinbockel
Date	10/14/2020

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

In the Matter of Application Serial No. 88/799,975
Published in the Official Gazette of June 16, 2020

<p>FRANCISCAN VINEYARDS, INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>PRISION BREWING CO LLC,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. _____</p>
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NOTICE OF OPPOSITION

Opposer Franciscan Vineyards, Inc., a corporation organized under the laws of Delaware (“**Opposer**”), believes it will be damaged by registration of the mark shown in Application Serial No. 88/799,975 (the “**Application**”), and hereby opposes the same. As grounds for its opposition, Opposer alleges as follows:

1. Since long prior to the filing of the Application at issue, Opposer adopted and has continuously used the trademark THE PRISONER in interstate commerce on and in connection with wine (the “**PRISONER Mark**”). Opposer owns, among others, the following U.S. registrations, which are legally and validly registered on the Principal Register of the United States Patent and Trademark Office (“USPTO”) (collectively, the “**PRISONER Registrations**”):

Mark	Reg. No.	Goods/Services	First Use
THE PRISONER	3444928	Cl. 33: Wine	August 1, 2002
THE PRISONER WINE COMPANY	6064267	Cl. 43: Bar services; catering services; consulting services in the field of culinary arts; restaurant services; wine bars; providing general purpose convention facilities; providing general purpose facilities for exhibitions; providing information about wine	November 1, 2019

		characteristics	
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2. The PRISONER Mark has been in continuous use in U.S. commerce since at least August 2002.

3. For many years—and long prior to the filing date of the Application—Opposer and its predecessors-in-interest have marketed, advertised, distributed, and sold wine and related goods (collectively “**Opposer’s Goods**”) using the PRISONER Mark in U.S. commerce.

4. As a result of Opposer’s long-standing, nationwide, and widespread use, Opposer also owns extensive common law rights in its THE PRISONER Mark in connection with wine and related goods.

5. By virtue of the excellence of Opposer’s Goods, the PRISONER Mark has a strong and valuable reputation.

6. Notwithstanding Opposer’s prior rights in and to the PRISONER Mark, Applicant applies to register the design mark below, including the wording PRISION BREWING CO., for “Beer; Beer, ale and lager; Beers; Black beer; Craft beers; Malt beer; Pale beer; Wheat beer; India pale ales (IPAs)” in International Class 32 and “Bar services; Pubs; Restaurant; Restaurant and bar services; Restaurant services; Taproom services featuring craft beers” in International Class 43 (the “**Opposed Mark**”). The Opposed Mark was published for opposition in the Trademark Official Gazette of June 16, 2020.



7. The goods and services for which Applicant seeks registration in International Class 32 and 43 are related to the goods and services with which Opposer uses the PRISONER Mark.

8. Opposer requested and received an extension of time to file its opposition until October 14, 2020.

FIRST CLAIM FOR RELIEF
(Likelihood of Confusion)

9. Opposer repeats and re-alleges the allegations in preceding paragraphs 1 through 8, inclusive, as if fully set forth herein.

10. Opposer used the PRISONER Mark, and has continued to use the PRISONER Mark, without interruption in U.S. commerce prior to Applicant's adoption, use, and application to register the Opposed Mark.

11. The Opposed Mark so resembles Opposer's previously used, registered, valid, and persisting THE PRISONER Mark as to be likely, when used on or in connection with the goods and services identified in the Application, to cause confusion, to cause mistake, or to deceive. The Opposed Mark is thus not registrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. 1052(d).

12. Opposer will be damaged by registration of the Opposed Mark because registration will provide Applicant with *prima facie* evidence of ownership of, and exclusive nationwide right to use, a mark that is confusingly similar to the PRISONER Mark.

WHEREFORE, Opposer prays for judgment sustaining this opposition and refusing registration to Applicant of the mark shown in the Opposed Application.

Please direct all correspondence in connection with this opposition to the undersigned.

SEYFARTH SHAW LLP

Date: October 14, 2020

By: /s/ Edward F. Maluf

Edward F. Maluf
Jeremy Schachter
John C. Heinbockel

Attorneys for Opposer
Franciscan Vineyards, Inc.
620 Eighth Ave., 32nd Floor
New York, NY 10018
Telephone: (212) 218-5500
Facsimile: (212) 218-5526

Int. Cl.: 33

Prior U.S. Cls.: 47 and 49

United States Patent and Trademark Office

Reg. No. 3,444,928

Registered June 10, 2008

TRADEMARK
PRINCIPAL REGISTER

THE PRISONER

PHINNEY, DAVID S. (UNITED STATES INDIVIDUAL)
POST OFFICE BOX 475
RUTHERFORD, CA 94573

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: WINES, IN CLASS 33 (U.S. CLS. 47 AND 49).

SER. NO. 77-302,334, FILED 10-11-2007.

FIRST USE 8-1-2002; IN COMMERCE 8-1-2002.

CHRISTINA SOBRAL, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

THE PRISONER WINE COMPANY

Reg. No. 6,064,267

Franciscan Vineyards, Inc. (DELAWARE CORPORATION)
1178 Galleron Road
St. Helena, CALIFORNIA 94574

Registered May 26, 2020

Int. Cl.: 43

CLASS 43: Bar services; Catering services; Consulting services in the field of culinary arts; Restaurant services; Wine bars; Providing general purpose convention facilities; Providing general purpose facilities for exhibitions; Providing information about wine characteristics

Service Mark

FIRST USE 11-1-2019; IN COMMERCE 11-1-2019

Principal Register

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

OWNER OF U.S. REG. NO. 3444928

No claim is made to the exclusive right to use the following apart from the mark as shown:
"WINE COMPANY"

SER. NO. 88-685,609, FILED 11-08-2019



Andrew L. Rosen

Director of the United States
Patent and Trademark Office



REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*

What and When to File:

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.