

ESTTA Tracking number: **ESTTA1256341**

Filing date: **12/23/2022**

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

Proceeding no.	91276157
Party	Plaintiff ZHS IP Americas SÃ rl
Correspondence address	PATRICK K STEELE STEELE IP LAW, PLLC 12345 JONES ROAD SUITE 200 HOUSTON, TX 77070 UNITED STATES Primary email: tmdocketing@steeleiplaw.com Secondary email(s): patrick_k_steele@yahoo.com 832-678-2349
Submission	Motion to Amend Pleading/Amended Pleading
Filer's name	Janice Housey
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Date	12/23/2022
Attachments	SOLI 91276157 Motion to Amend Notice of Opposition 12 23 22.pdf(573144 bytes) SOLI 91276157 Amended Notice of Opposition 12 23 22.pdf(675976 bytes) SOLI 91276157 Amended Notice of Opposition redline 12 23 22.pdf(701727 bytes)

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

<p>ZHS IP Americas Sàrl, Opposer,</p> <p>v.</p> <p>Gamba Vineyards & Winery, LLC Applicant.</p>	<p>Opposition. No. 91276157</p> <p>Ser. No. 90522420</p> <p>Mark: SOLI</p>
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**OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION
AND MEMORANDUM OF POINTS AND AUTHORITIES**

NOTICE OF MOTION AND MOTION

Opposer ZHS IP Americas Sàrl ("Opposer") hereby moves pursuant to Rule 15 of the Federal Rules of Civil Procedure to grant Opposer leave to amend its Notice of Opposition filed on May 12, 2022. In support of this motion, Opposer encloses its Memorandum of Points and Authorities and its proposed Amended Notice of Opposition. Opposer respectfully requests that the amended Notice be accepted as the operative pleading.

Respectfully submitted,

Date: December 23, 2022

By: /s/ Janice Housey
Janice Housey
jhousey@litmuslaw.com
Litmus Law PLLC
PO Box 777
Berryville, Virginia 22611
Phone: 703-957-5274
Attorney for Opposer

MEMORANDUM OF POINTS AND AUTHORITIES

Opposer moves for leave to file an amended Notice of Opposition. Opposer recently appointed new counsel. Opposer's proposed amended pleading includes textual changes to clarify Opposer's original claims and the addition of a dilution claim. Opposer's amendment would not materially change the scope of this proceeding or the evidence to be adduced in discovery. Given the early stage of these proceedings, the total lack of prejudice to Opposer, and the Board's broad authority to grant amendments at any time, leave to amend is warranted.

I. FACTUAL BACKGROUND

On May 12, 2022, Opposer filed its Notice of Opposition to Applicant's application to register its SOLI mark. The Board instituted this proceeding on that same date and Applicant answered on June 21, 2022. The parties have completed their initial discovery conference but have not yet exchanged initial disclosures, engaged in written discovery or document production. A Consented Motion to Extend was filed and granted on July 26, 2022. A copy of Opposer's proposed amended Notice of Opposition is attached hereto.

II. ARGUMENT

Trademark Rule 2.115, 37 C.F.R. § 2.107, and Fed. R. Civ. P. 15(a) encourage the Board to look favorably on motions to amend pleadings, stating that "leave shall be freely given when justice so requires." *See also Embarcadero Technologies, Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1523 (TTAB 2016). In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings. *Foman v. Davis*, 371

U.S. 178, 182 (1962); *ChaCha Search Inc. v. Grape Technology Group Inc.*, 105 USPQ2d 1298, 1300 (TTAB 2012).¹

A. There Has Been No Undue Delay or Prejudice to Applicant.

Opposer has appointed new counsel and simultaneously is filing a Notice of Appearance. Opposer, with its new counsel, has reviewed the claims put forth in the original Notice of Opposition and has determined that an additional claim of dilution is warranted. In addition, Opposer is amending some of the text for clarity, consistency and comports with typical Trademark Trial and Appeal Board pleadings. There has been no undue delay by Opposer in amending its Notice since this proceeding is still at its initial stages before the parties have engaged in any discovery. In determining whether the other party would be prejudiced by allowance of the proposed amendment, the timing of the motion for leave to amend plays a large role. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007). The Board routinely grants such motions for proceedings in the "pre-trial phase." *See, e.g., United States Olympic Comm. v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993) (granting opposer's motion to amend and explaining that applicant would not be prejudiced).

In fact, the Board has allowed amendments to pleadings at much later stages than that requested by Opposer. *See Metromedia Steakhouses Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1206-07 (TTAB 1993) (permitting motion to amend after close of discovery as additional discovery would not be necessary); *Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (permitting motion to amend filed prior to opening of petitioner's testimony period).

¹ The Supreme Court has specifically held that courts are to heed Rule 15(a)'s mandate that amendments are to be granted "freely." *Foman v. Davis*, 371 U.S. 178, 182 (1962).

The concept of "undue delay" is inextricably linked with the concept of prejudice to the nonmoving party. *See Marshall Field & Co. v. Mrs. Field Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989). There is no conceivable prejudice to Applicant in allowing Opposer to amend its Notice of Opposition.

B. Opposer Has No Bad Faith and the Amendment Is Not Futile.

Opposer does not have any dilatory motive or bad faith in seeking to amend its Notice. This is Opposer's first request to amend and it's being filed shortly after the appointment of new counsel. *See Am. Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010) (no abuse of amendment privileges where applicant sought to amend its pleading for the first time).

Opposer's revised text and additional claim are far from the types of "futile" change to a pleading that would bar amendment. *See, e.g., Be Sport, Inc. v. al-Jazeera Satellite Channel*, 115 USPQ2d 1765 (TTAB 2015) (amendment was futile where it sought to add a proposed defense barred by *res judicata*).

III. CONCLUSION

In light of the early stage of this proceeding, the Board's liberal policy in favor of granting amendments (especially those as modest as the ones sought by Opposer), and a complete lack of prejudice to Applicant, Opposer respectfully requests that the Board grant its motion for leave to amend in order to litigate all issues relevant to this action on the merits. Opposer also requests that the proceedings be suspended pending the decision on this Motion.

Respectfully submitted,

Date: December 23, 2022

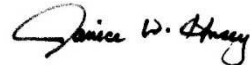
By: /s/ Janice Housey
Janice Housey
jhousey@litmuslaw.com

Litmus Law PLLC
PO Box 777
Berryville, Virginia 22611
Phone: 703-957-5274
Attorney for Opposer

CERTIFICATE OF SERVICE

On this 23rd day of December 2022, a true and correct copy of the foregoing OPPOSER'S MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION AND MEMORANDUM OF POINTS AND AUTHORITIES is being sent via email addressed as follows:

J. Scott Gerien
Dickensen, Peatman & Fogarty
1500 First Street, Ste 200
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**


ZHS IP Americas Sàrl, Opposer, v. Gamba Vineyards & Winery, LLC Applicant.	Opposition. No. 91276157 Ser. No. 90522420 Mark: SOLI
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AMENDED NOTICE OF OPPOSITION

Opposer, ZHS IP Americas Sàrl, with an address of Avenue Reverdil 14, 1260 Nyon, Switzerland (hereinafter "Opposer"), by and through its attorneys, hereby states that it will be damaged by registration of the mark SOLI (hereinafter "Applicant's Mark"), Ser. No. 90522420, by Gamba Vineyards & Winery, LLC (hereinafter "Applicant") and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:




1. Opposer is a limited liability company organized and existing under the laws of Switzerland, with address at Avenue Reverdil 14, 1260 Nyon, Switzerland.
2. Opposer, through its affiliates and licensees, operates in the distilled spirits industry as a producer and distiller. Opposer, through its affiliates and licensees, produces and sells alcoholic beverages, including vodka, under its STOLI trademark.
3. Based upon information and belief, Applicant is a California limited liability company with an address at P.O. Box 578, Fulton, California 95439.

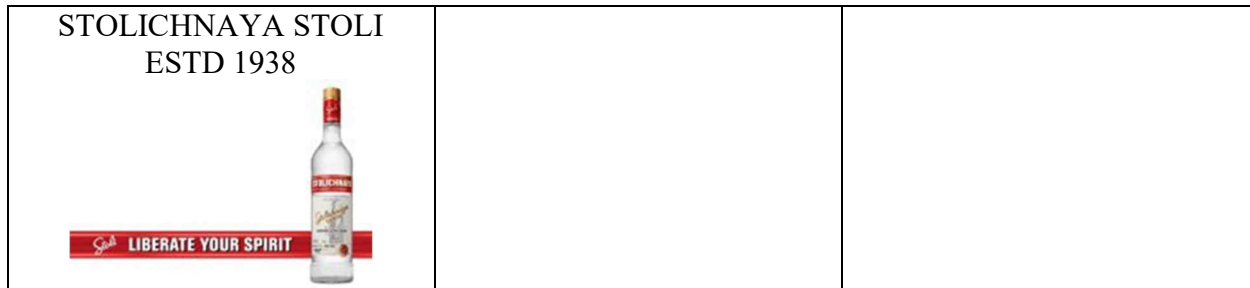
4. Opposer is the exclusive owner of the STOLI trademark and the following trademark registrations and applications:

Mark	Reg. No./Ser. No.	Goods
STOLI	1244735	Vodkas (Class 33)
STOLI	4629969	Ginger beer (Class 32)
STOLI BLUEBERI	3110643	Prepared alcoholic cocktail; Vodka (Class 33)
STOLI CRUSHED	5465193	vodka based beverage made with natural fruit juices; distilled spirits specialty based with natural fruit juices (Class 33)
STOLI PEACHIK	3526585	ALCOHOLIC BEVERAGES, NAMELY, SPIRITS BEING BEVERAGES; VODKA; VODKA BASED DRINKS; PREPARED ALCOHOLIC COCKTAILS (Class 33)
STOLI RAZBERI	2175465	Vodka (Class 33)
STOLI VANIL	2192600	Vodka (Class 33)
<i>Stoli Blueheri</i>	3110644	Prepared alcoholic cocktail; Vodka (Class 33)
<i>Stoli Strasheri</i>	2205863	Vodka (Class 33)
STOLICHNAYA STOLI & Design 	4449444	Alcoholic beverages, namely, vodka, flavored vodka, vodka with flavoring, vodka-based beverages, vodka-based alcoholic cocktails (Class 33)
STOLI GOLD & Design	5566750	Alcoholic beverages, except beers; spirits; vodka (Class 33)

		
<p>STOLI SALTED KAREMEL STOLICHNAYA & Design</p> 	4445584	Alcoholic beverages, namely, vodka, flavored vodka, vodka with flavoring, vodka-based beverages, vodka-based alcoholic cocktails (Class 33)
<p>STOLI OHRANJ & Design</p> 	3076475	Vodka (Class 33)
<p>STOLI OHRANJ & Design</p> 	3076407	Vodka (Class 33)
<p>STOLICHNAYA STOLI VANIL & Design</p> 	2898451	Vodka (Class 33)
<p>STOLICHNAYA STOLI CITROS & Design</p> 	4613960	Alcoholic beverages, namely, vodka, flavored vodka (Class 33)
<p>STOLICHNAYA STOLI STRASBERI & Design</p>	2552858	Vodka (Class 33)

		
<p>STOLICHNAYA STOLI RAZBERI & Design</p> 	2204355	Vodka (Class 33)
<p>STOLICHNAYA STOLI BLUEBERI BLUEBERRY FLAVORED RUSSIAN VODKA & Design</p> 	3331722	Vodka; Prepared alcoholic cocktail (Class 33)
<p>STOLICHNAYA STOLI BLUEBERI BLUEBERRY FLAVORED RUSSIAN VODKA & Design</p> 	3341339	Prepared alcoholic cocktail; Vodka (Class 33)
<p>STOLICHNAYA ESTABLISHED 1938 STOLI CUCUMBER THE ORIGINAL STOLICHNAYA STOLI ESTD 1938 & Design</p> 	5907498	Alcoholic beverages, except beers; spirits; vodka; flavored vodka; vodka based beverage made with natural cucumber flavors; distilled spirits specialty based with natural cucumber flavors (Class 33)
<p>STOLICHNAYA STOLICHNAYA STOLICHNAYA STOLI & Design</p>	5672765	Alcoholic beverages, except beers; Spirits; Vodka (Class 33)

		
<p>STOLICHNAYA THE ORIGINAL STOLICHNAYA MADE WITH CERTIFIED ALPHA GRADE SPIRIT STOLICHNAYA STOLI THE ORIGINAL & Design</p> 	<p>5421335</p>	<p>Alcoholic beverages, except beers; spirits; vodka (Class 33)</p>
<p>STOLI LIBERATE YOUR SPIRIT & Design</p> 	<p>90761837 (Notice of Allowance issued Oct. 25, 2022)</p>	<p>Alcoholic beverages, except beers; alcoholic preparations for making beverages, namely, alcoholic cocktail mixes, alcoholic bitters, alcoholic fruit extracts, liqueurs; spirits; vodka; vodka based alcoholic beverages and cocktails; vodka based alcoholic beverages made with natural fruit juices; specialty distilled spirits based with natural fruit juices; liqueurs (Class 33)</p>
<p>STOLI LIBERATE YOUR SPIRIT STOLI IMPORTED STOLI STOLICHNAYA ESTABLISHED 1938 THE ORIGINAL STOLICHNAYA VODKA MADE WITH CERTIFIED ALPHA GRADE VODKA 40% ALC./VOL. (80 PROOF) 750ML BATCH 12711 PREMIUM VODKA ESTD 1938 SIGNATURE THE ORIGINAL</p>	<p>90761952 (Notice of Allowance issued Dec. 6, 2022)</p>	<p>Alcoholic beverages, namely, vodka (Class 33)</p>



The trademarks shown in these registrations and applications are hereinafter referred to as the "STOLI Trademarks" and the registrations thereof as the "STOLI Registrations" and the registrations and applications thereof, together, as the "STOLI Registrations and Applications." The STOLI word mark shown in Registration No. 1244735 is hereinafter referred to as the "STOLI Word Trademark."

5. Opposer has been using its STOLI Trademarks in connection with alcoholic beverages since at least as early as November 1980.

6. Since that time, Opposer has established extensive and valuable goodwill in the STOLI Trademarks and has spent significant amounts of time and money establishing this goodwill.

7. As a result of Opposer's use of the STOLI Trademarks, the STOLI Trademarks have become the valuable property of Opposer.

8. Opposer's STOLI Registrations are *prima facie* evidence of the validity of the registered marks and of the registration of the marks, Opposer's ownership of the STOLI Trademarks, and Opposer's exclusive right to use the registered marks in commerce on or in connection with the goods specified in the registrations.

9. Opposer's Registration Nos. 1244735, 2175465, 2192600, 4613960, and 4629969 are incontestable, and thus are *conclusive* evidence of the validity of the registered marks shown

therein, of the registration of the marks, of Opposer's ownership of the marks and of Opposer's exclusive right to use the marks in connection with the goods listed therein,

10. Opposer has developed extremely valuable goodwill in its STOLI Trademarks by virtue of its long-term use of these marks in commerce, its promotion of its distilled spirits products under the STOLI Word Trademark for more than forty (40) years, and the impeccable quality and excellence of these products sold throughout the United States. Consumers familiar with distilled spirits and even the general public have come to know and recognize the STOLI Trademarks and associate the same with alcoholic beverages ("Opposer's Goods").

11. Based on Opposer's prior use of the STOLI Trademarks (continually since at least as early as 1980 for the STOLI Word Trademark) for goods in International Class 33, Opposer has priority in its STOLI Trademarks over any first use date that could be claimed by Applicant.

12. Due to Opposer's longstanding and continuous use of the STOLI Trademarks in connection with Opposer's Goods, the STOLI Trademarks have become well-known as designating Opposer's Goods.

13. Applicant filed its trademark application (the "Application") for Applicant's Mark on February 10, 2021, and recited the following goods: Alcoholic beverages, except beer ("Applicant's Goods").

14. Based upon information and belief, Applicant has not used the SOLI mark in commerce and thus, Opposer has priority in its STOLI Trademarks.

15. Opposer's actual and continuing use of its STOLI Word Trademark in commerce predates any constructive use date Applicant can claim for SOLI by more than 40 years.

16. Applicant's use and registration of Applicant's Mark for the goods listed in the Application is likely to cause confusion, mistake, and/or lead to deception as to the origin of

Applicant's Goods in violation of Sections 32 and 43(a) of the Lanham Act, 15 U.S.C. §§1114 and 1125(a).

17. Applicant's Mark, SOLI, is confusingly similar to Opposer's STOLI Word Trademark and the STOLI Trademarks.

18. On information and belief, Opposer's Goods sold under Opposer's STOLI Trademarks travel in the same or similar channels of trade as those in which Applicant's Goods sold under Applicant's Mark travel or will travel.

19. The goods recited in the Application are identical to, or closely related to, Opposer's Goods.

20. Consumers familiar with Opposer's STOLI Trademarks would be likely to buy Applicant's Goods under the mistaken belief that the products are produced and/or sold by Opposer.

21. Vodka sold under the STOLI Trademarks has had and continues to have impressive ratings from the Beverage Testing Institute ("BTI") since Opposer's Goods first reviewed by BTI in 2006. Noteworthy BTI reviews of Opposer's Goods include the following:

- STOLI vodka has received a 97-point BTI platinum medal every time the brand has been submitted for expert evaluation in BTI vodka competitions;
- STOLI vodka has won a total of nine, 97-point BTI platinum medals in nine distinct BTI vodka competitions up to and including 2020 (no vodka brand has ever scored above 97 points in a BTI competition or expert evaluation);
- STOLI vodka has received BTI's prestigious "2020 Best Vodka" award. This win places Opposer's vodka sold under its STOLI Trademarks in an esteemed category as a nine-time winner, unbeaten.

22. Applicant's use and/or registration of Applicant's Mark would be likely to cause confusion or mistake or to deceive as to the affiliation, connection, or association of Applicant with Opposer (where none exists), and/or as to the origin, sponsorship, and approval of Applicant's Goods and other commercial activities by Opposer (where none exists), all to Opposer's irreparable harm.

23. Opposer's STOLI Word Trademark is distinctive and famous within the meaning of 15 U.S.C § 1125(c). Applicant's Mark is likely to cause dilution of the distinctive quality of Opposer's STOLI Word Trademark in violation of U.S.C § 1125(c), to the harm and damage of Opposer and the public. Therefore, registration of Applicant's Mark should be refused under U.S.C. §§ 1052 and 1063(a).

24. If Applicant is granted a registration for Applicant's Mark, Applicant would thereby obtain *prima facie* evidence of its ownership of, and exclusive right to use Applicant's Mark in commerce, all to the detriment of Opposer.

WHEREFORE, Opposer prays that this Opposition be granted and that registration of the Application be denied.

Date: December 23, 2022

Respectfully submitted,

By: /s/ Janice Housey
Janice Housey
jhousey@litmuslaw.com
Litmus Law PLLC
PO Box 777
Berryville, Virginia 22611
Phone: 703-957-5274
Attorney for Opposer

CERTIFICATE OF SERVICE

On this 23rd day of December 2022, a true and correct copy of the foregoing AMENDED NOTICE OF OPPOSITION is being sent via email addressed as follows:

J. Scott Gerien
Dickensen, Peatman & Fogarty
1500 First Street, Ste 200
Napa, CA 94559
tmdept@dpf-law.com

A handwritten signature in black ink, appearing to read "Janice W. Atney". The signature is written in a cursive style with a large initial 'J'.

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

~~In the Matter of Application Serial No. 90/522,420
for the mark SOLI
Published in the Official Gazette on April 12, 2022~~

~~ZHS IP Americas Sàrl, §
§
Opposer §
§
v. § Opposition No. §
§
Gamba Vineyards & Winery, LLC, §
§
Applicant §~~

<p><u>ZHS IP Americas Sàrl,</u> <u>Opposer,</u></p> <p><u>v.</u></p> <p><u>Gamba Vineyards & Winery, LLC</u> <u>Applicant.</u></p>	<p><u>Opposition No. 91276157</u></p> <p><u>Ser. No. 90522420</u></p> <p><u>Mark: SOLI</u></p>
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AMENDED NOTICE OF OPPOSITION

Notice is given by
Opposer, ZHS IP Americas Sàrl, with an address of Avenue Reverdil 14, 1260 Nyon,
Switzerland (hereinafter "Opposer"), by and through its attorney, that it believes attorneys, hereby
states that it will be damaged by ~~the registration of the mark shown in U.S. trademark application~~
~~Serial No. 90/522,420 filed on February 10, 2021 and seeking registration of the mark SOLI~~
(hereinafter "Applicant's Mark"), Ser. No. the Application") for goods listed in ~~International Class~~

~~033. The Application was filed 90522420, by Applicant Gamba Vinyards Vineyards & Winery, LLC (hereinafter “Applicant”);”) and Opposer hereby opposes the same. As grounds for this Opposition, Opposer hereby states alleges as follows:~~

1. Opposer is a limited liability company organized and existing under the laws of Switzerland, with address at Avenue Reverdil 14, 1260 Nyon, Switzerland.

~~2. The application herein opposed was filed on February 10, 2021 and was published for opposition on April 12, 2022.~~







~~3.2. Opposer, through its affiliates and licensees, operates in the distilled spirits industry as a producer and distiller. Opposer, through its affiliates and licensees, produces and sells alcoholic beverages, namely, including vodka, in connection with the use of under its marks STOLI discussed further in paragraphs 5 and 6 below trademark.~~

~~4.3. Based upon information and belief, Applicant is a California limited liability company with an address at P.O. Box 578, Fulton, California 95439. Applicant seeks to register the mark SOLI without claim to any particular font style, size, or color, as a trademark for International Class 033 for use in connection with “Alcoholic beverages, except beer” as evidenced in the Application published for opposition on April 12, 2022. On information and belief, Applicant intends to sell alcoholic beverages in connection with its use of the mark made the subject of the Application.~~

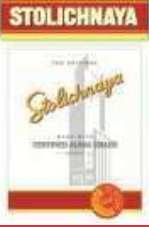



~~4. Opposer is the exclusive owner of the STOLI trademark and the following trademark registrations and applications:~~

<u>Mark</u>	<u>Reg. No./Ser. No.</u>	<u>Goods</u>
<u>STOLI</u>	<u>1244735</u>	<u>Vodkas (Class 33)</u>
<u>STOLI</u>	<u>4629969</u>	<u>Ginger beer (Class 32)</u>
<u>STOLI BLUEBERI</u>	<u>3110643</u>	<u>Prepared alcoholic cocktail; Vodka (Class 33)</u>

<u>STOLI CRUSHED</u>	<u>5465193</u>	<u>vodka based beverage made with natural fruit juices; distilled spirits specialty based with natural fruit juices (Class 33)</u>
<u>STOLI PEACHIK</u>	<u>3526585</u>	<u>ALCOHOLIC BEVERAGES, NAMELY, SPIRITS BEING BEVERAGES; VODKA; VODKA BASED DRINKS; PREPARED ALCOHOLIC COCKTAILS (Class 33)</u>
<u>STOLI RAZBERI</u>	<u>2175465</u>	<u>Vodka (Class 33)</u>
<u>STOLI VANIL</u>	<u>2192600</u>	<u>Vodka (Class 33)</u>
<u><i>Stoli Blueheri</i></u>	<u>3110644</u>	<u>Prepared alcoholic cocktail; Vodka (Class 33)</u>
<u><i>Stoli Strasher</i></u>	<u>2205863</u>	<u>Vodka (Class 33)</u>
<u>STOLICHNAYA STOLI & Design</u> 	<u>4449444</u>	<u>Alcoholic beverages, namely, vodka, flavored vodka, vodka with flavoring, vodka-based beverages, vodka-based alcoholic cocktails (Class 33)</u>
<u>STOLI GOLD & Design</u> 	<u>5566750</u>	<u>Alcoholic beverages, except beers; spirits; vodka (Class 33)</u>
<u>STOLI SALTED KARAMEL STOLICHNAYA & Design</u> 	<u>4445584</u>	<u>Alcoholic beverages, namely, vodka, flavored vodka, vodka with flavoring, vodka-based beverages, vodka-based alcoholic cocktails (Class 33)</u>

<p><u>STOLI OHRANJ & Design</u></p> 	<p><u>3076475</u></p>	<p><u>Vodka (Class 33)</u></p>
<p><u>STOLI OHRANJ & Design</u></p> 	<p><u>3076407</u></p>	<p><u>Vodka (Class 33)</u></p>
<p><u>STOLICHNAYA STOLI VANIL & Design</u></p> 	<p><u>2898451</u></p>	<p><u>Vodka (Class 33)</u></p>
<p><u>STOLICHNAYA STOLI CITROS & Design</u></p> 	<p><u>4613960</u></p>	<p><u>Alcoholic beverages, namely, vodka, flavored vodka (Class 33)</u></p>
<p><u>STOLICHNAYA STOLI STRASBERI & Design</u></p> 	<p><u>2552858</u></p>	<p><u>Vodka (Class 33)</u></p>
<p><u>STOLICHNAYA STOLI RAZBERI & Design</u></p> 	<p><u>2204355</u></p>	<p><u>Vodka (Class 33)</u></p>
<p><u>STOLICHNAYA STOLI BLUEBERI BLUEBERRY FLAVORED RUSSIAN VODKA & Design</u></p>	<p><u>3331722</u></p>	<p><u>Vodka; Prepared alcoholic cocktail (Class 33)</u></p>

		
<p><u>STOLICHNAYA STOLI</u> <u>BLUEBERI BLUEBERRY</u> <u>FLAVORED RUSSIAN</u> <u>VODKA & Design</u></p> 	<p><u>3341339</u></p>	<p><u>Prepared alcoholic cocktail;</u> <u>Vodka (Class 33)</u></p>
<p><u>STOLICHNAYA</u> <u>ESTABLISHED 1938 STOLI</u> <u>CUCUMBER THE</u> <u>ORIGINAL STOLICHNAYA</u> <u>STOLI ESTD 1938 & Design</u></p> 	<p><u>5907498</u></p>	<p><u>Alcoholic beverages, except</u> <u>beers; spirits; vodka; flavored</u> <u>vodka; vodka based beverage</u> <u>made with natural cucumber</u> <u>flavors; distilled spirits</u> <u>specialty based with natural</u> <u>cucumber flavors (Class 33)</u></p>
<p><u>STOLICHNAYA</u> <u>STOLICHNAYA</u> <u>STOLICHNAYA STOLI &</u> <u>Design</u></p> 	<p><u>5672765</u></p>	<p><u>Alcoholic beverages, except</u> <u>beers; Spirits; Vodka (Class</u> <u>33)</u></p>
<p><u>STOLICHNAYA THE</u> <u>ORIGINAL STOLICHNAYA</u> <u>MADE WITH CERTIFIED</u> <u>ALPHA GRADE SPIRIT</u> <u>STOLICHNAYA STOLI THE</u> <u>ORIGINAL & Design</u></p>	<p><u>5421335</u></p>	<p><u>Alcoholic beverages, except</u> <u>beers; spirits; vodka (Class</u> <u>33)</u></p>

		
<p><u>STOLI LIBERATE YOUR SPIRIT & Design</u></p> 	<p><u>90761837</u> <u>(Notice of Allowance issued Oct. 25, 2022)</u></p>	<p><u>Alcoholic beverages, except beers; alcoholic preparations for making beverages, namely, alcoholic cocktail mixes, alcoholic bitters, alcoholic fruit extracts, liqueurs; spirits; vodka; vodka based alcoholic beverages and cocktails; vodka based alcoholic beverages made with natural fruit juices; specialty distilled spirits based with natural fruit juices; liqueurs (Class 33)</u></p>
<p><u>STOLI LIBERATE YOUR SPIRIT STOLI IMPORTED STOLI STOLICHNAYA ESTABLISHED 1938 THE ORIGINAL STOLICHNAYA VODKA MADE WITH CERTIFIED ALPHA GRADE VODKA 40% ALC./VOL. (80 PROOF) 750ML BATCH 12711 PREMIUM VODKA ESTD 1938 SIGNATURE THE ORIGINAL STOLICHNAYA STOLI ESTD 1938</u></p>  	<p><u>90761952</u> <u>(Notice of Allowance issued Dec. 6, 2022)</u></p>	<p><u>Alcoholic beverages, namely, vodka (Class 33)</u></p>

The trademarks shown in these registrations and applications are hereinafter referred to as the "STOLI Trademarks" and the registrations thereof as the "STOLI Registrations" and the

registrations and applications thereof, together, as the "STOLI Registrations and Applications."
The STOLI word mark shown in Registration No. 1244735 is hereinafter referred to as the "STOLI
Word Trademark."

5. ~~Opposer has used the~~been using its STOLI ~~mark in interstate commerce in the~~
~~United States~~Trademarks in connection with ~~vodka~~alcoholic beverages since at least as early as
November ~~of~~ 1980.

~~6. Opposer owns U.S. Trademark registration no. 1,244,735 (hereinafter the "STOLI~~
~~registration") granted for the word mark STOLI on July 5, 1983. That STOLI registration is for~~
~~the word mark STOLI, and Opposer has 24 additional registrations that include the word STOLI.~~
~~Opposer owns two pending applications seeking registration of marks that include the word~~
~~STOLI. These 25 registrations are attached, along with information for the two pending~~
~~applications, as Exhibit "A." These documents are arranged in Exhibit "A" in reverse~~
~~chronological order, and the original STOLI registration is the last page of Exhibit "A." The 24~~
~~registrations owned by Opposer are referred to herein as the 24 additional registrations are referred~~
~~to herein as "the related registrations." Opposer has used the STOLI Trademark in interstate~~
~~commerce in the United States in connection with vodka since at least November of 1980.~~

6. Since that time, Opposer has established extensive and valuable goodwill in the
STOLI Trademarks and has spent significant amounts of time and money establishing this
goodwill.

7. As a result of Opposer's prior use of the STOLI mark in connection with
International Class 033, constitutes Trademarks, the STOLI Trademarks have become the valuable
property of Opposer.

8. Opposer's STOLI Registrations are prima facie evidence of Opposer's prior the validity of the registered marks and of the registration of the marks, Opposer's ownership of the STOLI mark Trademarks, and Opposer's exclusive right to use the STOLI mark registered marks in commerce and on or in connection with the goods specified in the STOLI registration and the related registrations, including, but not limited to, those in International Class 033 registrations.

9. Opposer's Registration Nos. 1244735, 2175465, 2192600, 4613960, and 4629969 are incontestable, and thus are conclusive evidence of the validity of the registered marks shown therein, of the registration of the marks, of Opposer's ownership of the marks and of Opposer's exclusive right to use the marks in connection with the goods listed therein.

10. Opposer has developed extremely valuable goodwill in its STOLI mark Trademarks by virtue of its longevity long-term use of usage these marks in commerce, its promotion of its distilled spirits products for an extensive period of time, e.g. under the STOLI Word Trademark for more than forty (40) years, and the impeccable quality and excellence of itsthese products sold internationally and in throughout the USA in connection with its use of the STOLI registration. With extensive use by Opposer of its STOLI registration and related registrations, consumers United States. Consumers familiar with distilled spirits and even the general public have come to know and recognize the STOLI registration in connection Trademarks and associate the same with quality vodka and related alcoholic beverages ("Opposer's Goods").

11. Based on Opposer's prior use of the STOLI registration Trademarks (continually since at least as early as 1980 for the STOLI Word Trademark) for goods in International Class 033, the33, Opposer has priority and Opposer's exclusive rights in and to the its STOLI registration

~~and related registrations are superior to Trademarks over any first use date that could be claimed by Applicant.~~

~~12. Due to Opposer's longstanding and continuous use of the STOLI registration and related marks Trademarks in connection with Opposer's Goods, the STOLI registration is a mark that has Trademarks have become well-known as designating Opposer's Goods. Applicant's mark~~

~~13. Applicant filed its trademark application (the "Application") for Applicant's Mark on February 10, 2021, and recited the following goods: Alcoholic beverages, except beer ("Applicant's Goods").~~

~~14. Based upon information and belief, Applicant has not used the SOLI mark in commerce and thus, Opposer has priority in its STOLI Trademarks.~~

~~15. Opposer's actual and continuing use of its STOLI Word Trademark in commerce predates any constructive use date Applicant can claim for SOLI by more than 40 years.~~

~~16. Applicant's use and registration of Applicant's Mark for the goods listed in the Application is likely to cause confusion, mistake, and/or lead to deception as to the origin of Applicant's Goods in violation of Sections 32 and 43(a) of the Lanham Act, 15 U.S.C. §§1114 and 1125(a).~~

~~17. Applicant's Mark, SOLI, is confusingly similar to Opposer's STOLI registration and related registrations, as well as the identical nature of the goods (alcoholic beverages) associated therewith. When the Applicant's mark SOLI is applied to goods traveling Word Trademark and the STOLI Trademarks.~~

~~18. On information and belief, Opposer's Goods sold under Opposer's STOLI Trademarks travel in the same or similar channels of trade as those sold by Opposer, it so resembles Opposer's STOLI registration and mark that it is likely to be confused therewith and mistaken,~~

~~and will lead to deception or mistakes as to the origin of Applicant's goods bearing the SOLI mark and vice versa. Indeed, STOLI and SOLI are almost identical in sound, spelling and commercial impression, and are nearly identical in appearance with only the "T" being removed by Applicant to form its confusingly similar mark. Consumers familiar with in which Applicant's Goods sold under Applicant's Mark travel or will travel.~~

19. The goods recited in the Application are identical to, or closely related to, Opposer's Goods.

20. Consumers familiar with Opposer's STOLI registration and mark, and also familiar with Opposer's reputation in the spirits industry, the related registrations, and more generally alcoholic beverages industry, too, Trademarks would be likely to buy Applicant's products Goods under the mistaken belief that the products are produced and ~~sold by the Opposer, are of identical or similar quality, or that the applicant's mark SOLI is part of the range of the Opposer's STOLI registration and related registrations. According to the Beverage Testing Institute (BTI), STOLI/or~~ sold by Opposer.

21. Vodka sold under the STOLI Trademarks has had and continues to have an impressive ~~run of results ratings~~ from the Beverage Testing Institute ("BTI") since ~~its~~ Opposer's Goods first ~~review~~ reviewed by BTI in 2006. ~~The following statements about STOLI products performance in~~ Noteworthy BTI reviews ~~are self-speaking: of~~ Opposer's Goods include the following:

- STOLI vodka has received a 97-point BTI platinum medal every time the brand has been submitted for expert evaluation in BTI vodka competitions;

- STOLI vodka has won a total of nine, 97-point BTI platinum medals in nine distinct BTI vodka competitions up to and including 2020 ~~included,~~ (no vodka brand has ever scored above 97 points in a BTI competition or expert evaluation. ~~Again,~~);
- STOLI ~~Vodka~~vodka has received ~~Beverage Testing Institute's (BTI)~~BTI's prestigious "2020 Best Vodka" award. This win places STOLI Opposer's vodka sold under its STOLI Trademarks in an esteemed category as a nine-time winner, unbeaten. ~~Applicant's mark SOLI identifies the same category of goods as those of the Opposer, including goods that are identical, very closely related to, and/or similar and which in any event encompass the Opposer's goods identified by the Opposer's STOLI registration and the related registrations.~~

~~7.22. Opposer will be damaged by registration of the SOLI mark by Applicant because such registration would grant to Applicant prima facie evidence of the exclusive right to use the mark in conjunction with Applicant's products and such use Applicant's use and/or registration of Applicant's Mark would be likely to cause confusion or mistake or to deceive as to the affiliation, connection, or association of Applicant with Opposer (where none exists), and/or as to the origin, sponsorship, and approval of Applicant's products Goods and other commercial activities by Opposer (where none exists), all to Opposer's irreparable harm.~~

~~8. Such confusion would cause further irreparable harm to Opposer in that any possible defects or fault found with Applicant's goods or other commercial activities could erroneously be attributed to Opposer, thereby harming Opposer's reputation and damaging its substantial goodwill in its STOLI mark.~~

~~23. Opposer will be damaged by registration of the SOLI mark by Opposer's STOLI Word Trademark is distinctive and famous within the meaning of 15 U.S.C § 1125(c). Applicant's~~

Mark is likely to cause dilution of the distinctive quality of Opposer's STOLI Word Trademark in violation of U.S.C § 1125(c), to the harm and damage of Opposer and the public. Therefore, registration of Applicant's Mark should be refused under U.S.C. §§ 1052 and 1063(a).

9.24. If Applicant ~~because such is granted a~~ registration ~~would grant to for Applicant's~~ Mark, Applicant ~~would thereby obtain~~ *prima facie* evidence of ~~the its ownership of, and~~ exclusive right to use ~~the STOLI mark and/or exclusive right to use a mark including the word STOLI in conjunction with Applicant's goods and such use would cause irreparable harm~~ Applicant's Mark ~~in commerce, all to the detriment of~~ Opposer.

~~WHEREFORE, Opposer, ZHS IP Americas Sarl, respectfully requests that the Board deny registration of Applicant, Gamba Vineyards & Winery, LLC's SOLI mark, U.S. Trademark Serial No. 90/522,420, for International Class 033 for "Alcoholic beverages, except beer" and award Opposer all other relief to which it is justly entitled.~~

~~This Notice of Opposition is being filed electronically with the United States Patent and Trademark Office Trademark Trial and Appeal Board.~~

By: /Patrick K. Steele, #39844/ ~~WHEREFORE,~~
Opposer prays that this Opposition be granted and that registration of the ~~Application be~~
denied.

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Respectfully submitted,

Date: ~~May 12~~ December 23, 2022
Patrick K. Steele

By: /s/ Janice Housey

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On this 23rd day of December 2022, a true and correct copy of the foregoing
AMENDED NOTICE OF OPPOSITION is being sent via email addressed as follows:

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