

ttab

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

In the matter of trademark Registration No. 2,136,776
Registration Date: February 17, 1998
For the mark: THE WELLNESS RESOURCE

WELLNESS RESOURCES, INC.,

Cancellation No. 92041697

Petitioner,

v.

GRIFFIN, NANCY M.

Registrant

03-17-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

REGISTRANT'S REPLY IN SUPPORT OF HER MOTION TO COMPEL RESPONSES;
REQUEST FOR PROTECTIVE ORDER; REQUEST FOR SANCTIONS

In the Response filed by Petitioner WELLNESS RESOURCES, INC. ("WRI"), it incorrectly concludes that the pending Motion to Compel filed by Registrant NANCY M. GRIFFIN is moot. Although WRI has provided responses, it has only done so after the need for Ms. Griffin to prepare and file a Motion to Compel. Among the relief requested by Ms. Griffin in her moving papers is an order that "WRI has waived its right to object to Ms. Griffin's discovery." Consistent with that request, Ms. Griffin has requested WRI to produce its documents without objection to the place of production.

Rather than producing the documents to Ms. Griffin, WRI is insisting that Ms. Griffin pay WRI's counsel 20 cents per page or that she retain an outside vendor to photocopy the documents. Accordingly, Ms. Griffin's motion remains viable as she seeks an order compelling WRI to produce its documents to Ms. Griffin at its expense.

TBMP 406.03 states that "On motion pursuant to 37 C.F.R. §2.120(d)(2), the board may order the place and the manner in which the documents are to be produced." Section 2.120(d)(2) simply reiterates that the TTAB can order the manner in which the

documents are produced. In No Fear Inc. v. Rule, 54 U.S.P.Q.2d 1551 (TTAB 2000), the Board granted the moving party's motion to compel and ordered the responding party to pay the cost for copying and production of the responsive documents. The Board stated, "the applicant did not timely respond and was found to have waived its right to object to discovery requests on their merits. Accordingly, it was improper for applicant, after being ordered to provide discovery responses without objection, to have raised an objection regarding place of production."

Here, Ms. Griffin waited an extended period of time to receive WRI's responses and was forced to incur the cost of filing a Motion to Compel. According to WRI's counsel, WRI has located 1827 pages which are responsive to Ms. Griffin's document requests. (See Mr. Sherrill's email message attached hereto as Exhibit A.) It is inequitable for Ms. Griffin to now be forced to pay for production of WRI's documents. It is inconsistent with the fact that WRI has waived its right to object to the document production. Accordingly, consistent with TBMP 406.03, and as a sanction, it is appropriate that Petitioner WRI be directed to copy the responsive documents and forward them to Ms. Griffin at WRI's expense. *Accord No Fear, supra*, 54 U.S.P.Q.2d at 1555; TBMP 406.03 n.161.

Prior to filing this Reply, counsel for Ms. Griffin attempted to resolve this issue with Petitioner's counsel. Attached hereto as Exhibit A are true and correct copies of the email exchange between Ms. Griffin's attorney and WRI's attorney. Because WRI has failed to voluntarily resolve this issue, the Board should now issue an order compelling WRI to produce its responsive documents at its expense.

Dated: March 17, 2004

Spaulding McCullough & Tansil LLP

By 

Warren L. Dranit
Attorneys for Registrant
Nancy M. Griffin

DECLARATION OF WARREN L. DRANIT

I, Warren L. Dranit, declare:

1. I am an attorney at law, duly licensed to practice before the Trademark Trial and Appeal Board as well as all Courts of the State of California, the United States District Court for the Northern District of California, the United States Court of Appeals for the 9th Circuit, the United States Court of Appeals for the Federal Circuit, and the United States Supreme Court.

2. I am a partner with the law offices of Spaulding McCullough & Tansil LLP, attorneys of record for Registrant Nancy M. Griffin.


3. I have first-hand, personal knowledge of the matters set forth herein and, if called upon to do so, could and would competently testify hereto.

4. Prior to filing this reply, I attempted to informally resolve the pending issue regarding document production. I was not able to resolve the issue.

5. Attached hereto as Exhibit A are true and correct copies of email correspondence between Warren L. Dranit, attorney for Respondent NANCY M. GRIFFIN, and Michael S. Sherrill, attorney for Petitioner WELLNESS RESOURCES, INC.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed this 17th day of March 2004, at Santa Rosa, California.



Warren L. Dranit

Exhibit A

From: Warren Dranit
To: michael@sherrilllaw.com
Date: 3/16/04 9:14AM
Subject: WRI v Griffin - WRI's Document Production

Mr. Sherrill,

Following up on earlier telephone conversation and having finally put some space between the large project that I was working on, I am getting back to you on the production of Wellness Resource Inc.'s documents. Specifically, I am responding to your request that Ms. Griffin pay \$0.20 per copy or hire an outside vendor to copy WRI's documents.

I am requesting that WRI produce its documents at its own expense. I believe this is an equitable approach to this situation in that WRI has brought this cancellation proceeding and has done so only after Ms. Griffin has almost many years of use of her mark. It is not an expense that Ms. Griffin should have to bear to obtain the documents that support WRI's claim. Moreover, the request is consistent with TBMP rules that permit the TTAB to order the parties to produce documents. Consistent with this approach, Ms. Griffin will also agree to produce her documents at her expense.

Please promptly advise if WRI is willing to proceed in this regard. If not, I will make the request to the TTAB. As always, I am also available to discuss the matter further.

Very Truly Yours,

/wld/

Warren L. Dranit

=====
Warren L. Dranit
Spaulding McCullough & Tansil LLP
3550 Round Barn Boulevard, Suite 306
Santa Rosa, CA 95403
(707) 524-1900
Fax: (707) 524-1906
dranit@smlaw.com
www.smlaw.com

From: "Michael S. Sherrill" <MichaelS@SherrillLaw.com>
To: "Warren Dranit" <Dranit@smlaw.com>
Date: 3/16/04 1:08PM
Subject: WEL002ZZTM01 [Wellness Resources, Inc. v. Nancy M. Griffin (Cancellation No. 92041697)]

Sherrill Law Offices, PLLC

4756 Banning Avenue, Suite 212

White Bear Lake, Minnesota 55110-3205

Telephone (651) 426-2400

Facsimile (651) 426-2322

Web Site SherrillLaw.com

WRI will not produce the documents requested by Ms. Griffin at WRI's expense. As stated previously, WRI is willing to photocopy the documents @ \$.20 per copy and mail the copies to Ms. Griffin, all at Ms. Griffin's expense, or allow an outside vendor selected by Ms. Griffin to photocopy and forward the documents to Ms. Griffin, again at Ms. Griffin's expense. WRI has located 1827 pages which are responsive to Ms. Griffin's document requests. You may wish to review TBMP 408.03 prior to filing yet another motion with the TTAB.

/s/ M. Sherrill

The information contained in or attached to this message is PRIVILEGED AND CONFIDENTIAL information intended only for the person or entity named above. If you are not the intended recipient (or someone responsible to deliver it to the intended recipient), please be aware that any dissemination or copying of this communication is STRICTLY PROHIBITED. If you receive this communication in error, please notify us by telephone immediately at 651.426.2400.

-----Original Message-----

From: Warren Dranit [mailto:Dranit@smlaw.com]
Sent: Tuesday, March 16, 2004 11:15 AM
To: michaelS@sherrilllaw.com
Subject: WRI v Griffin - WRI's Document Production

Mr. Sherrill,

Following up on earlier telephone conversation and having finally put some space between the large project that I was working on, I am getting back to you on the production of Wellness Resource Inc.'s documents. Specifically, I am responding to your request that Ms. Griffin pay \$0.20

per copy or hire an outside vendor to copy WRI's documents.

I am requesting that WRI produce its documents at its own expense. I believe this is an equitable approach to this situation in that WRI has brought this cancellation proceeding and has done so only after Ms. Griffin has almost many years of use of her mark. It is not an expense that Ms. Griffin should have to bear to obtain the documents that support WRI's claim. Moreover, the request is consistent with TBMP rules that permit the TTAB to order the parties to produce documents. Consistent with this approach, Ms. Griffin will also agree to produce her documents at her expense.

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Very Truly Yours,

/wld/

Warren L. Dranit

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Warren L. Dranit
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Santa Rosa, CA 95403
(707) 524-1900
Fax: (707) 524-1906
dranit@smlaw.com
www.smlaw.com

From: Warren Dranit
To: Sherrill, Michael S.
Date: 3/16/04 2:42PM
Subject: Re: WEL002ZZTM01 [Wellness Resources, Inc. v. Nancy M. Griffin (Cancellation No. 92041697)]

Mr. Sherrill,

Presumably you are referring to TBMP 406.03 and not TBMP 408.03. That section specifically states: "On motion pursuant to 37 CFR § 2.120(d)(2), the Board may order the place and the manner in which the documents are to be produced." Section 2.120(d)(2) simply reiterates that the TTAB can order the manner in which the documents are produced.

Here, Ms. Griffin waited an extended period of time to receive WRI's responses and was forced to incur the cost of filing a Motion to Compel. It should not now be forced to pay for the production of WRI's documents. This request is consist with the TBMP and TTAB jurisprudence. For example, in No Fear Inc. v. Rule, "the applicant did not timely respond and was found to have waived its right to object to discovery requests on their merits. Accordingly, it was improper for applicant, after being ordered to provide discovery responses without objection, to have raised an objection regarding place of production."

Here, Ms. Griffin has offered to mitigate the cost of this kind of order by producing her documents at her expense. That offer, of course, is conditioned on WRI's cooperation. I urge WRI to reconsider its position.

Very Truly Yours,

/wld/

Warren L. Dranit

=====
Warren L. Dranit
Spaulding McCullough & Tansil LLP
3550 Round Barn Boulevard, Suite 306
Santa Rosa, CA 95403
(707) 524-1900
Fax: (707) 524-1906
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From: "Michael S. Sherrill" <MichaelS@SherrillLaw.com>
To: "Warren Dranit" <Dranit@smlaw.com>
Date: 3/16/04 3:34PM
Subject: RE: WEL002ZZTM01 [Wellness Resources, Inc. v. Nancy M. Griffin(Cancellation No. 92041697)]

Sherrill Law Offices, PLLC

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White Bear Lake, Minnesota 55110-3205

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Web Site SherrillLaw.com

WRI has never unreasonably refused to produce the documents requested by Ms. Griffin. WRI remains willing and able to permit Ms. Griffin to review and make copies of the requested documents at Ms. Griffin's expense.

/s/ M. Sherrill

The information contained in or attached to this message is PRIVILEGED AND CONFIDENTIAL information intended only for the person or entity named above. If you are not the intended recipient (or someone responsible to deliver it to the intended recipient), please be aware that any dissemination or copying of this communication is STRICTLY PROHIBITED. If you receive this communication in error, please notify us by telephone immediately at 651.426.2400.

-----Original Message-----

From: Warren Dranit [mailto:Dranit@smlaw.com]
Sent: Tuesday, March 16, 2004 4:43 PM
To: MichaelS@SherrillLaw.com
Subject: Re: WEL002ZZTM01 [Wellness Resources, Inc. v. Nancy M. Griffin(Cancellation No. 92041697)]

Mr. Sherrill,

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Very Truly Yours,

/wld/

Warren L. Dranit

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Express Mail mailing label number EV 089409448 US

I hereby certify that this REGISTRANT'S REPLY IN SUPPORT OF HER MOTION TO COMPEL RESPONSES; REQUEST FOR PROTECTIVE ORDER; REQUEST FOR SANCTIONS is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to:

Trademark Trial and Appeal Board
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

on March 17, 2004


Rishell E. Peretson

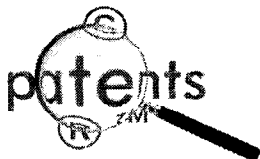
CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of is being deposited this day with the United States Postal Service, first class postage prepaid, addressed to Applicant's counsel of record as follows:

Michael S. Sherrill, Esq.
Sherrill Law Offices PLLC
4756 Banning Avenue, Suite 212
White Bear Lake, MN 55110-3205

this 17th day of March, 2004


Rishell E. Peretson



ttab

LAW OFFICES OF P.B. TUFARIELLO, P.C.
ATTORNEYS AT LAW

P. BETTY TUFARIELLO
Shareholder
24yellow@optonline.net

8 FOUNTAIN AVENUE • SELDEN, NEW YORK 11784
TELEPHONE 631-716-0091 • FAX 631-716-0094

SPECIALIZING IN PATENTS,
TRADEMARKS,
COPYRIGHTS, AND ALL
MATTERS RELATED
THERETO

March 19, 2004

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514



03-19-2004

U.S. Patent & TMO/TM Mail Rcpt Dt

Re: Cancellation No. 9202784
In re Registrant No. 2,663,203
For the mark: LONG ISLAND WINE COUNTRY
Reg. Date: December 12, 2002
Our File No.: 7040-G

Dear Sir:

Enclosed are the following items in connection with the above referenced trademark:

1. Cover Letter;
2. One Original and one copy of REGISTRANT/RESPONDENT'S LONG ISLAND WINE COUNCIL'S NOTICE OF MOTION TO SUSPEND;
3. One Original and one copy of REGISTRANT/RESPONDENT'S LONG ISLAND WINE COUNCIL'S MOTION TO SUSPEND;
4. One Original and one copy of the MEMORANDUM OF LAW IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S MOTION TO SUSPEND;
5. One Original and one copy of the DECLARATION OF PANAGIOTA BETTY TUFARIELLO, ESQ IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S MOTION TO SUSPEND; and

CERTIFICATE OF MAILING

Express Mail No. ER792923042US

Date of Deposit: March 19, 2004

I hereby certify that this correspondence is being deposited on the date with the U.S. Postal Service with sufficient postage as EXPRESS MAIL in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, Friday, March 19, 2004

Dated: 3/19/04

Panagiota Betty Tufarillo
Panagiota Betty Tufarillo

LAW OFFICES OF P.B. TUFARIELLO, P.C.
Box TTAB
Commissioner for Trademarks
Cancellation No. 9202784
Page 2

6. Self-addressed acknowledgment postcard.

Respectfully submitted,


PANAGIOTA BETTY TUFARIELLO

PBT:ac
Enclosures

c.c Gregory T. Meath, Esq. (Attorney for Petitioner)


CERTIFICATE OF MAILING

Express Mail No. ER792923042US

Date of Deposit: March 19, 2004

I hereby certify that this correspondence is being deposited on the date with the U.S. Postal Service with sufficient postage as EXPRESS MAIL in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, Friday, March 19, 2004

Dated: 3/19/04


Panagiota Betty Tufariello

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

Nidea Corporation,
a Delaware Corporation
Petitioner,

v.

03-19-2004
U.S. Patent & TMO/TM Mail Rcpt Dt

Long Island Wine Council,
a New York Corporation
Registrant.

ORIGINAL

Cancellation No. 92042784

In re: LONG ISLAND WINE COUNTRY
U.S. Reg. No. 2,663,203

I hereby certify that this correspondence and all related attachments
are being deposited with the United States Postal Service as Express
Mail in an envelope addressed to: Assistant Commissioner for
Trademarks, 2900 Crystal Drive, Arlington Va 22202-3513, on
Friday, March 19, 2004

Panagiota Betty Tufariello
PANAGIOTA BETTY TUFARIELLO

REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S
NOTICE OF MOTION TO SUSPEND


PLEASE TAKE NOTICE that upon the annexed (i) Registrant/Respondent Long Island Wine Council's Motion To Suspend, (ii) Declaration of Panagiota Betty Tufariello, Esq. and the exhibits annexed thereto, and (iii) Registrant/Respondent Long Island Wine Council's Memorandum in Support of its Motion To Suspend, which clearly show that on March 19, 2004 Registrant/Respondent filed a Motion for Judgment on the Pleadings, Registrant/Respondent Long Island Wine Council moves the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, pursuant to 37 C.F.R. §2.127(d) and TBMP 510 for an Order suspending the proceedings with respect to all matters not germane to the Motion for Judgment on the Pleadings in the above entitled action.

Respectfully Submitted,

Dated:

3/19/04
Selden, NY

THE LAW OFFICES OF P.B. TUFARIELLO, P.C.
Attorneys for Registrant Long Island Wine Council



Panagiota Betty Tufariello
Reg. No. 40,851
8 Fountain Ave
Selden, NY 11784
631-716-0091
631-716-0094(FAX)
24yellow@optonline.net

CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S NOTICE OF MOTION TO SUSPEND IN CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

by CM/ECF

by Electronic Mail

by Facsimile Transmission

by First Class Mail

by Hand Delivery

☒ by Overnight Delivery



PANAGIOTA BETTY TUFARIELLO

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

ORIGINAL

Nidea Corporation,
a Delaware Corporation
Petitioner,

Cancellation No. 92042784

v.

In re: LONG ISLAND WINE COUNTRY
U.S. Reg. No. 2,663,203

03-19-2004
U.S. Patent & TMO/TM Mail Rpt Dt

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Mail in an envelope addressed to: Assistant Commissioner for
Trademarks, 2900 Crystal Drive, Arlington Va 22202-3513, on
Friday March 19, 2004

Panagiotis Betty Tufariello
PANAGIOTA BETTY TUFARIELLO

Long Island Wine Council,
a New York Corporation
Registrant.

**REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S
MOTION TO SUSPEND**

RELIEF SOUGHT

Registrant Long Island Wine Council, respondent in the present cancellation (hereinafter "Registrant/Respondent"), moves the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, pursuant to 37 C.F.R. §2.127(d) and TBMP 510 for an Order suspending the proceedings with respect to all matters not germane to the Motion for Judgment on the Pleadings, filed by Registrant/Respondent on March 19, 2004, in the above entitled action.

GROUND'S FOR THE MOTION

When a party to a Board proceeding files a motion which is potentially dispositive of the proceedings, such as Registrant/Respondent's Motion for Judgment on the Pleadings,

filed on March 19, 2004, the case will be suspended by the Board with respect to all matters not germane to the motion. 37 C.F.R. §2.127(d) and TBMP 510.

SUPPORTING PAPERS

This motion is based on the pleadings and papers on file in this action, this Motion, the attached Notice of Motion, the accompanying Memorandum, and the Declaration of Panagiota Betty Tufariello, Esq. together with its accompanying exhibits.

Respectfully submitted:

THE LAW OFFICES OF P.B. TUFARIELLO, P.C.
Attorneys for Respondent/Registrant

3/19/04
Dated
Selden, New York

Panagiota Betty Tufariello
Panagiota Betty Tufariello (Reg. No. 40,851)
8 Fountain Ave
Selden, NY 11784
631-716-0091
631-716-0094 (fax)
24yellow@optonline.net

CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing REGISTRANT/RESPONDENT LONG ISLAND WINE COUNTRY'S MOTION FOR TO SUSPEND IN CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

— by **CM/ECF**

— by **Electronic Mail**

— by **Facsimile Transmission**

— by **First Class Mail**

— by **Hand Delivery**

X by **Overnight Delivery**



PANAGIOTA BETTY TUFARIELLO

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

ORIGINAL

Nidea Corporation,
a Delaware Corporation
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v.

Long Island Wine Council,
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Registrant.

Cancellation No. 92042784

In re: LONG ISLAND WINE COUNTRY
U.S. Reg. No. 2,663,203

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Trademarks, 2900 Crystal Drive, Arlington Va 22202-3513, on
Friday, March 19, 2004.

Panagiota Betty Tufariello
PANAGIOTA BETTY TUFARIELLO

03-19-2004

U.S. Patent & TMO/TM Mail Rcpt Dt

MEMORANDUM OF LAW IN SUPPORT OF
REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S
MOTION TO SUSPEND

Panagiota Betty Tufariello
Reg. No. 40,851
THE LAW OFFICES OF P.B. TUFARIELLO, P.C.
8 Fountain Avenue
Selden, NY, 11784
631-716-0091 phone
631-716-0094 fax

24yellow@optoline.net

PRELIMINARY STATEMENT

Long Island Wine Council , a New York corporation having a principal place of business at P.O. Box 74, Peconic, New York, 11958, and owner of U.S. Registration 2,663,203 (hereinafter "Registrant/Respondent") for the mark LONG ISLAND WINE COUNTRY, the subject registration of the Cancellation proceeding referenced herein above, submits this memorandum in support of its Motion to the Trademark Trial and Appeal Board of the United States Patent & Trademark Office, pursuant to 37 C.F.R. §2.127(d) and TBMP 510 for an Order suspending the proceedings with respect to all matters not germane to the Motion for Judgement on the Pleadings, filed by Registrant/Respondent on March 19, 2004, in the above entitled action.

STATEMENT OF THE FACTS

On or about December 22, 2003, nIdea Corporation, a Delaware Corporation doing business as Longislandwinecountry.com at 370 Interlocken Blvd., Suite 410 Broomfield, Co., 80021, (hereinafter "Petitioner") petitioned the Trademark Trial and Appeals Board (hereinafter "TTAB") to cancel U.S. Registration No. 2,663,203.

On or about February 8, 2004, Registrant/Respondent Long Island Wine Council and owner of U.S. Registration 2,663,203 for the mark LONG ISLAND WINE COUNTRY, for use in connection with Association services, namely, promoting the interests or awareness of regional wineries in International class 042 (hereinafter "the Subject Registration") served its Answer to Petitioner's Complaint both on Petitioner and the TTAB.

Discovery is currently pending. The Discovery period opened on January 28, 2004 and is currently scheduled to close on July 26, 2004.

On or about March 19, 2004 Registrant/Respondent Long Island Wine Council filed its motion papers with the TTAB for the purpose of obtaining a Judgement on the Pleadings (Tufariello Decl. Exs. 16-19).

ARGUMENT

The TTAB has made it clear that “when a party to a Board proceeding files a motion which is potentially dispositive of the proceedings, such as a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgement, the case will be suspended by the Board with respect to all matters not germane to the motion.” *see* 37 C.F.R. § 2.127 (d); TBMP 510 at 500-48.

Thus, in Electronic Industries Association v. Patrick H. Potega DBA Lifestyle Technologies, 1999 TTAB LEXIS 189, 50 USPQ2d 1775 (TTAB 1999), the Board suspended the proceedings pending the disposition of a motion for discovery sanctions because it included a request for an entry of judgement. In DAK Industries, Inc. v. Daiichi Kosho Co., Ltd., 1994 TTAB LEXIS 31, 35 USPQ2d 1434 (TTAB 1995), the Board suspended proceedings pending the disposition of a motion for judgement on the pleadings. In Pegasus Petroleum Corporation v. Mobil Oil Corporation, 1985 TTAB LEXIS 17, 227 USPQ 1040 (TTAB 1985), the Board suspended proceedings pending the disposition of a motion for summary judgement and deferred a subsequent motion to suspend for civil action until after it issued its decision on the motion for summary judgment.

In Leeds Technologies Ltd. v. Topaz Communications Ltd., 65 USPQ2d 1303 (TTAB 2002), the Board took it one step further. It treated the proceedings as if they had been suspended as of the filing date of the potentially dispositive motion and reset the time for opposer to serve discovery responses following the issuance of its decision on opposer’s motion for judgement on the pleadings.

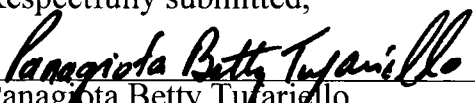
Accordingly, in keeping with traditional notions of *stare decisis*, the TTAB in the present matter, must also suspend proceedings with respect to all matters not germane to the Motion for Judgement on the Pleadings, as of its date of filing, i.e. March 19, 2004, since such motion is potentially dispositive of the proceeding.

CONCLUSION

For all of the reasons set forth above, the TTAB should grant Registrant/Respondent's Motion to Suspend the proceedings with respect to all matters not germane to the Motion for Judgement on the Pleadings, filed by Registrant/Respondent on March 19, 2004, in the above entitled action.

Dated: March 19, 2004

Respectfully submitted,


Panagiota Betty Tufariello

Reg. No. 40,851

THE LOW OFFICE OF P.B. TUFARIELLO, P.C.

8 Fountain Avenue

Selden, NY, 11784

631-716-0091 phone

631-716-0094 fax

24yellow@optoline.net

CERTIFICATE OF SERVICE

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Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

☐ by CM/ECF

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☐ by Facsimile Transmission

☐ by First Class Mail

☐ by Hand Delivery

☒ by Overnight Delivery


PANAGIOTA BETTY TUFARIELLO

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

ORIGINAL

Nidea Corporation,
a Delaware Corporation
Petitioner,

v.

03-19-2004

U.S. Patent & TMO/TM Mail Rcpt Dt

Long Island Wine Council,
a New York Corporation
Registrant.

Cancellation No. 92042784

In re: LONG ISLAND WINE COUNTRY
U.S. Reg. No. 2,663,203

I hereby certify that this correspondence and all related attachments
are being deposited with the United States Postal Service as Express
Mail in an envelope addressed to: Assistant Commissioner for
Trademarks, 2900 Crystal Drive, Arlington Va 22202-3513, on
Friday, March 19, 2004

Panagiota Betty Tufariello
PANAGIOTA BETTY TUFARIELLO

DECLARATION OF PANAGIOTA BETTY TUFARIELLO, ESQ.
IN SUPPORT OF REGISTRANT/RESPONDENT
LONG ISLAND WINE COUNCIL'S
MOTION TO SUSPEND

I, Panagiota Betty Tufariello, hereby declare as follows:

1. I am a shareholder in the law firm THE LAW OFFICES OF P.B. TUFARIELLO, P.C. located at 8 Fountain Ave, Selden, New York 11784, attorneys of record for Registrant/Respondent Long Island Wine Council (hereinafter "Registrant/Respondent").

2. I am a member of good standing of the bar of the state of New York, the United States District Courts for the Eastern and Southern Districts of New York, as well as the bar of the United States Patent and Trademark Office..

3. I am fully familiar with the facts in this matter.

4. Annexed hereto as **Exhibit 16** is a copy of REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S NOTICE OF MOTION FOR JUDGEMENT ON THE PLEADINGS, which was filed with the Court on March 19, 2004.

5. Annexed hereto as **Exhibit 17** is a copy of REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S MOTION FOR JUDGEMENT ON THE PLEADINGS, which was filed with the Court on March 19, 2004.

6. Annexed hereto as **Exhibit 18** is a copy of the MEMORANDUM OF LAW IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S MOTION FOR JUDGEMENT ON THE PLEADINGS, which was filed with the Court on March 19, 2004.

7. Annexed hereto as **Exhibit 19** is a copy of the DECLARATION OF PANAGIOTA BETTY TUFARIELLO, ESQ. IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S MOTION FOR JUDGEMENT ON THE PLEADINGS, which was filed with the Court on March 19, 2004.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

3/19/04

Dated

Panagiota Betty Tufariello

Panagiota Betty Tufariello (40,851)

CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing DECLARATION OF PANAGIOTA BETTY TUFARIELLO, ESQ. IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNTRY'S MOTION TO SUSPEND IN CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

— by CM/ECF
— by Electronic Mail
— by Facsimile Transmission
— by First Class Mail
— by Hand Delivery
☒ by Overnight Delivery


PANAGIOTA BETTY TUFARIELLO

16

Nidea Corporation,
a Delaware Corporation
Petitioner,

V.

X

In re: LONG ISLAND WINE COUNTRY
U.S. Reg. No. 2,663,203

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Panagiota Betty Tufariello
PANAGIOTA BETTY TUFARIELLO

**Long Island Wine Council,
a New York Corporation
Registrant.**

X

PLEASE TAKE NOTICE that upon the annexed (i) Registrant/Respondent Long Island Wine Council's Motion for Judgement on the Pleadings (ii) Declaration of Panagiota Betty Tufariello, Esq. and the exhibits annexed thereto, and (iii) Registrant/Respondent Long Island Wine Council's Memorandum of Law in Support of its Motion for Judgement on the Pleadings, Registrant Long Island Wine Council moves the Trademark Trial and Appeal Board of the United States Patent & Trademark Office for an Order issuing a Judgement on the Pleadings in the above entitled action, mandating that Petitioner take nothing by its petition, dismissing the petition with prejudice and setting forth such other and further relief as the TTAB deems just and proper.

Respectfully Submitted,

Dated:

03/19/04
Selden, NY

THE LAW OFFICES OF P.B. TUFARIELLO, P.C.
Attorneys for Registrant Long Island Wine Council

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Panagiota Betty Tufariello
Reg. No. 40,851
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Selden, NY 11784
631-716-0091
631-716-0094(FAX)
24yellow@optonline.net

CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing NOTICE OF MOTION FOR JUDGEMENT ON THE PLEADINGS IN CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

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Panagiota Betty Tufariello
PANAGIOTA BETTY TUFARIELLO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Nidea Corporation,
a Delaware Corporation
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Cancellation No. 92042784

In re: LONG ISLAND WINE COUNTRY
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PANACOTA BETTY TUFARIELLO

**REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S
MOTION FOR JUDGEMENT ON PLEADINGS**

RELIEF SOUGHT

Registrant Long Island Wine Council, respondent in the present cancellation (hereinafter "Registrant/Respondent"), moves for judgment on the pleadings in this matter under Fed. R. Civ. P. 12(c) and under TBMP 504.

GROUND'S FOR THE MOTION

The pleadings in this action are closed, and on the undisputed facts appearing from the pleadings, Registrant Long Island Wine Council is entitled to judgement as a matter of law. In particular, the pleadings show that all material allegations are admitted in the pleadings, no material issues of fact remain to be resolved, and Registrant/Respondent is entitled to the judgement as a matter of law because petitioner has failed to state a claim upon

which relief may be granted and the pleadings contain no further factual allegations that can properly support any of the statutory grounds Petitioner has set forth for the cancellation.

SUPPORTING PAPERS

This motion is based on the pleadings and papers on file in this action, this Motion, the attached Notice of Motion, the accompanying Memorandum of Law, and the Declaration of Panagiota Betty Tufariello, Esq. together with its accompanying exhibits.

Respectfully submitted:

THE LAW OFFICES OF P.B. TUFARIELLO, P.C.
Attorneys for Respondent/Registrant

3/19/04
Dated
Selden, New York

Panagiota Betty Tufariello
Panagiota Betty Tufariello (Reg. No. 40,851)
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Selden, NY 11784
631-716-0091
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CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing REGISTRANT/RESPONDENT LONG ISLAND WINE COUNTRY'S MOTION FOR JUDGEMENT ON THE PLEADINGS IN CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

— by **CM/ECF**

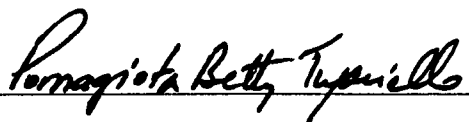
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PANAGIOTA BETTY TUFARIELLO

Reorder No. 5105
JULIUS BLUMBERG, INC.
NYC 10013
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PANAGIOTA BETTY TUFARIELLO

X

MEMORANDUM OF LAW IN SUPPORT OF
REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S
MOTION FOR JUDGEMENT ON THE PLEADINGS

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PRELIMINARY STATEMENT

Long Island Wine Council , a New York corporation having a principal place of business at P.O. Box 74, Peconic, New York, 11958, and owner of U.S. Registration 2,663,203 (hereinafter "Registrant/Respondent") for the mark LONG ISLAND WINE COUNTRY, the subject registration of the Cancellation proceeding referenced herein above, submits this memorandum in support of its Motion For Judgement on the Pleadings, pursuant to Fed. R. Civ. P. 12(c) and TBMP 504. Registrant/Respondent seeks such Judgement because, as is set forth in more detail below, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved. Accordingly, Registrant/Respondent Long Island Wine Council is entitled to judgment on the substantive merits of the controversy, as a matter of law.

PROCEDURAL HISTORY

On or about December 22, 2003, nIdea Corporation, a Delaware Corporation doing business as Longislandwinecountry.com at 370 Interlocken Blvd., Suite 410 Broomfield, Co., 80021, (hereinafter "Petitioner") petitioned the Trademark Trial and Appeals Board (hereinafter "TTAB") to cancel U.S. Registration No. 2,663,203. A copy of Petitioner's Cancellation Petition (hereinafter "Complaint") as filed with the TTAB is appended hereto as **Exhibit 1** for the TTAB's convenience.

On, or about, February 8, 2004, Registrant/Respondent Long Island Wine Council and owner of U.S. Registration 2,663,203 for the mark LONG ISLAND WINE COUNTRY, for use in connection with Association services, namely, promoting the interests or awareness of regional wineries in International class 042 (hereinafter "the Subject Registration") served its Answer to Petitioner's Complaint both on Petitioner and the TTAB. A copy of the Answer as filed with the TTAB is appended hereto as **Exhibit 2** for the TTAB's convenience.

Discovery is currently pending. The Discovery period opened on January 28, 2004 and is currently scheduled to close on July 26, 2004.

STATEMENT OF FACTS

As set forth above, Registrant/Respondent Long Island Wine Council is the owner of the Subject Registration (Complaint ¶ 5; see also Complaint Exhibit B). Registrant/Respondent filed the application which matured into the Subject Registration, *i.e.*, Application Serial No. 78/052,477, on March 11, 2001 (Complaint ¶ 5; see also Complaint Exhibit B).

During the prosecution of Application Serial No. 78/352,477, Registrant/Respondent was capable of overcoming the Examiner's refusal to register Registrant/Respondent's mark LONG ISLAND WINE COUNTRY on the basis that the mark was primarily geographically descriptive of the Registrant/Respondent's services (Tufariello Decl. Ex. 1). It did so by showing that the mark had acquired distinctiveness through continuous use for over five years (Tufariello Decl. Ex. 2). Accordingly, Registrant/Respondent's mark LONG ISLAND WINE COUNTRY was registered on the Principal Register on December 17, 2002 (Tufariello Decl. Ex 3 and Ex. 4).

Respondent first began using its mark LONG ISLAND WINE COUNTRY in connection with its association services in 1987 (Complaint Ex. B; Answer ¶ 14). Since that time, it has continuously used and continues to use its registered mark LONG ISLAND WINE COUNTRY in connection with its services (Answer ¶ 14). It has promoted and continues to promote its association services under its LONG ISLAND WINE COUNTRY trademark through the present (Answer ¶ 15). It has expended thousands of dollars in marketing, advertising and promoting itself as the source of the LONG ISLAND WINE COUNTRY Association Services (Answer ¶ 15). As a consequence of such extensive advertising and promotion, Respondent has developed recognition for its LONG ISLAND

WINE COUNTRY association services and has acquired and now enjoys a valuable reputation and good will under its LONG ISLAND WINE COUNTRY trademark (Answer ¶ 15).

In contrast, Petitioner's use of the mark LONGISLANDWINECOUNTRY.COM started almost twelve years after Respondent's. Specifically, Petitioner admits that (i) it obtained a domain name registration of LONGISLANDWINECOUNTRY.COM on March 23, 1999, not sooner (Complaint ¶ 1; see also Complaint Ex. A); (ii) it was not until September 1, 1999, that it began operating under the internet domain name trademark and trade name designation LONGISLANDWINECOUNTRY.COM, in connection with an online magazine dedicated to the wines, locale and lifestyle of Long Island's wine country (Complaint ¶ 2); and (iii) it was not until at least 2001 that it began using LONGISLANDWINECOUNTRY.COM in connection with offering guided tours of the Long Island Wine country (Complaint ¶ 2).

As Petitioner's pleadings clearly show, Petitioner never filed nor perfected an intent-to-use trademark application for the registration of its alleged trademark and trade name designation LONGISLANDWINECOUNTRY.COM that could have placed its use of said trademark and trade name designation ahead of Respondent's use of its mark LONG ISLAND WINE COUNTRY in 1987. Accordingly, there is no question that, by Petitioner's own admissions, Petitioner's use of the mark LONGISLANDWINECOUNTRY.COM is and will continue to remain junior to Respondent's use of its mark LONG ISLAND WINE COUNTRY.

ARGUMENT

- I. AN ORDER GRANTING JUDGEMENT ON THE PLEADINGS IS APPROPRIATE WHERE ALL MATERIAL ALLEGATIONS ARE ADMITTED IN THE PLEADINGS, NO MATERIAL ISSUES OF FACT REMAIN TO BE RESOLVED, AND MOVING PARTY IS ENTITLED TO THE JUDGEMENT AS A MATTER OF LAW.

The TTAB has stated that "a motion for judgment on the pleadings is designed to

provide a means of disposition of cases when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings. A motion for judgment on the pleadings has utility when all the material allegations are admitted in the pleadings and only questions of law remain.” CBS Inc.v. Mercadante, 23 USPQ2d 1784 (TTAB 1992) (citing Wright & Miller, Federal Practice and Procedure: Civil 2d § 1367 (1990)); Chatam International Inc. v. Abita Brewing Co., 49 U.S.P.Q.2d 2021 (TTAB 1998) (citing Fed. R. Civ. P. 12(c)); Rickson Gracie LLC v. Gracie, 67 USPQ2d 1702 (TTAB 2003) (citing 5A Wright and Miller, Federal Practice and Procedure: Civil 2d Section 1367 (2d ed. 2003); TBMP Section 504.02); Leeds Technologies Ltd. v. Topaz Communications Ltd., 65 USPQ2d 1303 (TTAB 2002)(citing See e.g. , Austad v. U.S. 386 F.2d 147 (9th Cir. 1967)).

Thus, “a motion for judgment on the pleadings should be granted only if the moving party clearly establishes that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law.” Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (TTAB 1982)(citing Wright & Miller, Federal Practice and Procedure: Civil 2d § 1368 (1990)); CBS Inc., 23 USPQ2d at 1784 (citing Wright & Miller, Federal Practice and Procedure: Civil 2d § 1368 (1990)); Chatam International Inc., 49 U.S.P.Q.2d at 2021 (citing Baroid Drilling Fluids supra ; 5A Charles A. Wright and Arthur R. Miller, Federal Practice and Procedure , Section 1367 (1990)); Leeds Technologies Ltd, 65 USPQ2d at 1303(citing Baroid Drilling Fluids, supra); International Telephone and Telegraph Corporation v. International Mobile Machines Corporation, 218 USPQ 1024 (TTAB 1983)(emphasis added).

“For purposes of a motion for judgment on the pleadings, all well-pleaded factual allegations of the nonmoving party are assumed to be true and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party.” Baroid Drilling Fluids, 24 USPQ2d at 1048 (citing Wright & Miller, Federal Practice and

Procedure: Civil 2d § 1368 (1990)); CBS Inc., 23 USPQ2d at 1784(citing Wright & Miller, Federal Practice and Procedure: Civil 2d § 1368 (1990)); Chatam International, 49 U.S.P.Q.2d at 2021 (citing Baroid, supra ; Wright and Miller; supra at Section 1367); Leeds Technologies Ltd., 65 USPQ2d at 1303 (citing Austad v. U.S., 386 F.2d 147 (9th Cir. 1967)).

Keeping all of the above in mind when deciding whether to grant a judgement on the pleadings, the TTAB first turns to the petitioner's cancellation petition to evaluate the grounds upon which the petitioner bases his cancellation petition and establish the facts that are promulgated by the petitioner in support of such grounds. Then the TTAB turns to the respondent's pleadings to determine which facts the respondent actually or constructively admits to, which facts actually or constructively the respondent controverts and whether the respondent has raised any affirmative defenses. Based on its findings, if the TTAB decides that (i) all material allegations are admitted in the pleadings, (ii) no material issues of fact remain to be resolved, and (iii) Registrant/Respondent is entitled to the judgement as a matter of law, then the TTAB will issue an Order granting the moving party a Judgement on the Pleadings. Baroid Drilling Fluids Inc., 24 USPQ2d at 1048; Care Corporation et. al. v. Nursecare International, Inc., 216 USPQ 993 (TTAB 1982); CBS Inc., 23 USPQ2d at 1784; Chatam International, 49 U.S.P.Q.2d at 2021; International Telephone, 218 USPQ at 1024; Leeds Technologies Ltd., 65 USPQ2d at 1303; Rickson Gracie LLC, 67 USPQ2d at 1702.

In the present matter, there is no question that once the TTAB completes its evaluation of the parties' pleadings in the manner set forth herein above, the TTAB will definitely find that Registrant/Respondent is entitled to the judgement as a matter of law.

II. REGISTRANT/RESPONDENT IS ENTITLED TO THE JUDGMENT AS A MATTER OF LAW BECAUSE PETITIONER HAS FAILED TO STATE A CLAIM AND THE PLEADINGS CONTAIN NO ALLEGATIONS TO PROPERLY SUPPORT ANY OF THE STATUTORY GROUNDS THE PETITIONER HAS CITED AS A BASIS FOR HIS CANCELLATION PETITION.

Upon review of Petitioner's Complaint the TTAB will find that the Complaint fails to specifically set forth the subsections of 15 U.S.C. §§ 1064 and 1052, upon which Petitioner bases its Cancellation Petition¹. On the other hand, the TTAB may find

¹
15 U.S.C. § 1064 states as follows:

A petition to cancel a registration of a mark, . . . may, . . . be filed . . . by any person who believes that he is or will be damaged . . . by the registration of a mark on the principal register established by this Act . . . (1) Within five years from the date of the registration of the mark under this Act . . . (3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section subsection (a), (b), or (c) of section 2 [15 USCS § 1052] for a registration under this Act, or if the registered mark is being used by . . . the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

Furthermore, a registration can be cancelled under 15 U.S.C. § 1064 and § 1052 if it:

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USCS § 3501(9)]) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United

that Petitioner's Complaint seems to suggest that the Subject Registration is cancelable

States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USCS § 1054], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional; (f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act [enacted Dec. 8, 1993].

under (i) 15 U.S.C. §1064 (3), because the registration was obtained fraudulently or contrary to the provisions of section subsection (a), (b), or (c) of section 2 [15 USCS § 1052] for a registration under this Act, or the registered mark is being used by . . . the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used; (ii) 15 U.S.C. §§ 1064 and 1052(d) because it consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Registrant/Respondent, to cause confusion, or to cause mistake, or to deceive; and (iii) 15 U.S.C. §§ 1064 and 1052(e)(2) because it consists of a mark which when used on or in connection with the goods of the Registrant/Respondent is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USCS § 1054].

Furthermore, the TTAB will find that the only material allegations that Petitioner has made in its pleadings in support of the cancellation of the Subject Registration pursuant to the sections set forth herein above are that (i) it obtained a domain name registration of LONGISLANDWINECOUNTRY.COM on March 23, 1999, not sooner; (ii) it was not until September 1, 1999 that it began operating under the internet domain name trademark and tradename designation LONGISLANDWINECOUNTRY.COM in connection with an online magazine dedicated to the wines, locale and lifestyle of Long Island's wine country; and (iii) it was not until at least 2001 that it began using LONGISLANDWINECOUNTRY.COM in connection with offering guided tours of the Long Island Wine country. The TTAB will find nothing more, nothing less and certainly nothing that could place Petitioner's use of said trademark and trade name designation ahead of Registrant/ Respondent's use of its mark LONG ISLAND WINE COUNTRY in 1987; nor will that TTAB find anything that contradicts any of the facts raised in Registrant/Respondent's pleadings.

Similarly, when reviewing Registrant/Respondent's pleadings the TTAB will find that

the only material allegations that Registrant/Respondent's Answer and the present moving papers have made are: (i) Registrant/Respondent Long Island Wine Council is the owner of the Subject Registration (Complaint ¶ 5; see also Complaint Exhibit B); (ii) Registrant/Respondent filed the application which matured into the Subject Registration, *i.e.*, Application Serial No. 78/052,477, on March 11, 2001 (Complaint ¶ 5; see also Complaint Exhibit B); (iii) During the prosecution of Application Serial No. 78/352,477 Registrant/Respondent was capable of overcoming the Examiner's refusal to register Registrant/Respondent's mark LONG ISLAND WINE COUNTRY on the basis that the mark was primarily geographically descriptive of the Registrant/Respondent's services (Tufariello Decl. Ex. 1), by showing that the mark had acquired distinctiveness through continuous use for over five years (Tufariello Decl. Ex. 2); (iv) Registrant/Respondent's mark LONG ISLAND WINE COUNTRY was registered on the Principle Register on December 17, 2002 (Tufariello Decl. Ex 3 and Ex. 4); (v) Respondent first began using its mark LONG ISLAND WINE COUNTRY in connection with its association services in 1987 (Complaint Ex. B; Answer ¶ 14); (vi) Since that time, it has continuously used and continues to use its registered mark LONG ISLAND WINE COUNTRY in connection with its services (Answer ¶ 14); (vii) It has promoted and continues to promote its association services under its LONG ISLAND WINE COUNTRY trademark through the present (Answer ¶ 15); (viii) It has expended thousands of dollars in marketing advertising and promoting itself as the source of the LONG ISLAND WINE COUNTRY Association Services (Answer ¶ 15) and that as a consequence of such extensive advertising and promotion, Respondent has developed recognition for its LONG ISLAND WINE COUNTRY association services and has acquired and now enjoys a valuable reputation and good will under its LONG ISLAND WINE COUNTRY trademark (Answer ¶ 15). The TTAB will find nothing more, nothing less and certainly nothing that contradicts any of the facts raised in Petitioner's pleadings.

Accordingly, the TTAB will find that all material allegations are admitted in the

pleadings, no material issues of fact remain to be resolved and that the only remaining thing for the TTAB will be to find whether Registrant/Respondent is entitled to the judgement as a matter of law.

In Spring Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S., 222 USPQ 512 (TTAB 1984) a case that was brought before the TTAB as a motion for a judgement on the pleadings, but was later converted as a motion for failure to state a claim, the Court reviewed the pleadings and found that petitioner's pleadings did not contain factual allegations to properly state a statutory ground for cancellation. Accordingly, the Court found that the petitioner had failed to state a claim and dismissed the petitioner's cancellation petition. Id. (citing Lipton Industries Inc. v. Ralston Purina Company, 213 USPQ 165 (CCPA 1982).

Similarly in the present matter, Petitioner's Complaint fails to state a claim. Petitioner's registration of LONGISLANDWINECOUNTRY.COM does not qualify as trademark or trade name use. In In re Eilberg, 49 USPQ2d 1955 (TTAB 1998), the TTAB held that a term that only serves to identify the applicant's domain name or the location on the Internet where the applicant's web site appears, and does not separately identify applicant's services, does not function as a service mark. Thus, Petitioner's domain name LONGISLANWINECOUNTRY.COM cannot function as a trademark or service mark.

However, even if it could function as a trademark or service mark, the date that Petitioner first adopted and used the mark in connection with its services is so far after the date of first use of Registrant/Respondent's use of its mark LONG ISLAND WINE COUNTRY of the Subject Registration, that Petitioner has failed to state a claim upon which relief may be granted. Coupling this with the fact that the pleadings contain no further factual allegations that can properly support any of the statutory grounds the Petitioner has cited for the cancellation of the Subject Registration, makes it abundantly clear that the TTAB cannot help but find that Respondent is entitled to the judgement as a matter of law.

CONCLUSION

For all of the reasons set forth above, the TTAB should grant Registrant/Respondent's Motion for Judgment on the Pleadings; order that Petitioner take nothing by its Petition; dismiss the Petition with prejudice; and mandate such other and further relief as the TTAB deems just and proper.

Dated: March 19, 2004

Respectfully submitted,



Panagiota Betty Tufariello

Reg. No. 40,851

THE LOW OFFICE OF P.B. TUFARIELLO, P.C.

8 Fountain Avenue

Selden, NY, 11784

631-716-0091 phone

631-716-0094 fax

24yellow@optoline.net

CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing MEMORANDUM OF LAW IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNCIL'S MOTION FOR JUDGEMENT ON THE PLEADINGS on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

☐ by CM/ECF

☐ by Electronic Mail

☐ by Facsimile Transmission

☐ by First Class Mail

☐ by Hand Delivery

☒ by Overnight Delivery


PANAGIOTA BETTY TUFARIELLO



TTAB

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

In the Matter of Registration No: 2,663,203

Date of Issue: December 17, 2002

For the Mark: LONG ISLAND WINE COUNTRY



12-22-2003

U.S. Patent & TMO/TM Mail Rpt Dt #22

Nidea Corporation,
a Delaware Corporation
Petitioner,

v.

Long Island Wine Council,
a New York Corporation
Registrant.

Opposition No.:

Commissioner for Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, VA 22202

PETITION FOR CANCELLATION

NIDEA CORPORATION, a Delaware corporation, doing business as Longislandwinecountry.com and doing business at 370 Interlocken Blvd., Suite 410 Broomfield, CO 80021, believes that it will be damaged by Registration No. 2,663,203 registered by Long Island Wine Council, a New York corporation, doing business at P.O. Box 74, Peconic, New York 11958 as it relates to services in Class 42, namely Association Services, namely promoting the interests or awareness of regional wineries, and hereby petitions to cancel the registration of the mark LONG ISLAND WINE COUNTRY for these services.

|| 01/05/2004 BTMDWRS2 00000124 2663203

01 FC:6401

300.00 OP

As grounds therefore, it is alleged that:

1. Petitioner obtained a Domain Name Registration of LONGISLANDWINECOUNTRY.COM on March 23, 1999 and has maintained that registration since. A copy of this Domain Name registration (in the name of Petitioner's Corporate Agent) is appended to this petition as Exhibit "A".

2. Petitioner, since at least September 1, 1999 has been, and is now, operating under the internet domain name, trademark, and trade name designation LONGISLANDWINECOUNTRY.COM. LONGISLANDWINECOUNTRY.COM features an online magazine dedicated to the wines, locale and lifestyle of Long Island's wine country. Additionally, Petitioner has provided guided tours of the Long Island Wine Country since at least 2001. Said use has been valid and continuous since the date of first registration and use of the Petitioner's internet domain name, trademark, and trade name designation. The relevant class of the public has come to associate Petitioner with said designation.

3. Petitioner has expended considerable effort and expense in promoting its trademark LONGISLANDWINECOUNTRY.COM and the services provided under such domain name, trademark, and trade name with the result that the purchasing public has come to know, rely upon, and recognize the services of Petitioner by such mark. Petitioner has an exceedingly valuable goodwill established in its mark.

4. Petitioner's registration and use of the designation LONGISLANDWINECOUNTRY.COM was made prior to the date of Registrant's Application for Registration which is dated 3-11-2001.

5. Registration No. 2,663,203 sought to be cancelled is for the trademark LONG ISLAND WINE COUNTRY, registered for use on Association Services, namely promoting the interests or awareness of regional wineries. Such services are closely related, and in some instances identical, to those of Petitioner. A copy of this trademark registration is appended to this petition as Exhibit "B".

6. If the Registrant is permitted to retain the registration sought to be cancelled, and thereby, the *prima facie* exclusive right to use in commerce the mark LONG ISLAND WINE COUNTRY on the nearly identical and identical services provided by Petitioner, confusion in trade is likely to result from any concurrent use of Petitioner's mark and that of the Registrant all to the great detriment of Petitioner, who has expended considerable sums and effort in promoting its mark.

7. In view of the similarity of Registrant's mark with Petitioner's designation, and in view of the related nature of the uses thereof, it is alleged that Registrant's mark consists of and comprises matter that may disparage and falsely suggest a connection with Petitioner.

8. Registration No. 2,663,203 was obtained fraudulently in that the formal application papers filed by Registrant, under notice of Section 1001 of Title 18 of the United States Code, stated that "...to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the above-identified mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the services of such other person, to cause confusion, or to cause mistake, or to deceive; and all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true." Said statement was

false in that the Registrant was not only aware of Petitioner's prior use, but in addition, Petitioner and Registrant worked together, and had several mutual business dealings for several years prior to and following the submission of Registrant's Application for Registration. Including but not limited to Registrant's acceptance of Petitioner's full page color advertising in Registrant's industry magazine, "The Wine Press" since 2000.

9. Said fraudulent statement was made by Registrant or its representative with the knowledge and belief that said statement was false. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration. Petitioner was damaged by said false statements and the registration issued in reliance thereon in that Petitioner, since at least 1999 has continuously used the mark LONGISLANDWINECOUNTRY.COM in connection with an online magazine dedicated to the wines, locale and lifestyle of Long Island's wine country and since at least 2001 in connection with offering guided tours of the Long Island wine country. Petitioner's continued and legal use of said mark will be impaired by the continued registration of said mark of Registrant.

9. Registrants mark should be cancelled on the ground that Registrant's mark consists of a mark which, when applied to the services of Registrant, is merely primarily geographically descriptive in that said mark is an apt and common term used to describe services of the nature involved herein. Petitioner, since at least 1999, has been, and is now, operating under the designation LONGISLANDWINECOUNTRY.COM in connection with an online magazine dedicated to the wines, locale and lifestyle of Long

Island's wine country and since at least 2001 in connection with offering guided tours of the Long Island wine country. Which services are of a related nature to Registrant's services, and which Petitioner has a valid and legal right to describe by use of the term registered by Registrant. Petitioner is likely to be damaged by registration of said term in that the *prima facie* effect of such registration will tend to impair Petitioner's right to descriptive use of said term. In view of the above allegations, Registrant is not entitled to federal registration of its alleged mark in that applicant is not entitled to exclusive use of said term in commerce on the services specified and further, that applicant's alleged mark does not function to identify applicant's services and distinguish them from those offered by others.

10. Registrant's alleged mark has not become distinctive of the Registrant's services in commerce and no customer recognition of said term as a valid mark identifying only Registrant has been achieved.

11. Registrant's mark is the common descriptive name used to describe the articles and substances included in Registrant's description of services and is a generic name of all such services provided and sold by every competitor engaged in such business. Therefore, Petitioner alleges that Registrant's term does not function to identify Registrant's goods and distinguish them from goods offered by others.

12. If the Registrant is permitted to continue to maintain its registration, the same may be deemed incontestable after five (5) years from the date of registration, and Registrant would thereby obtain an incontestable right to the use of its mark in commerce and in any event, the continued existence of such registration casts a cloud upon Petitioner's right to continue to use its designation

LONGISLANDWINECOUNTRY.COM. Such registration would thus be a source of damage and injury to the Petitioner.

WHEREFORE, Petitioner deems that it is or will be damaged by Registration No. 2,663,203 and petitions for cancellation thereof as it relates to services in Class 42. A duplicate Petition for Cancellation is being filed herewith, along with the filing fee required in § 2.6(a)(16).

The undersigned Petitioner in the above-entitled cause hereby appoints Gregory T. Meath, California Bar Number 180495, a member of the Bar of the State of California, its attorney with full power of substitution and revocation, to prosecute this cancellation proceeding, and to transact all business in the U.S. Patent and Trademark Office in connection therewith.

Respectfully submitted,

NIDEA CORPORATION

Petitioner

By 
GREGORY T. MEATH
Attorney for Petitioner

Date: December 10 2003

Law offices of
Gregory T. Meath
Attorneys & Counselors
13721 North Neeley Road
Lodi, CA 95242-9573
Ph. & Fx.: (209) 334-2643
E-mail: greggmeath@hotmail.com

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a).

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, BOX TTAB, 2900 Crystal Drive, Arlington, Virginia 22202, on December 10, 2003.

GREGORY T. MEATH



EXHIBIT "A"

Network Solutions

HOME

DOMAIN NAMES

WEB SITES

E-MAIL

BUSINESS BUILDERS

RENEW SERVICE

HELP

WHOIS

VIEW

WHOIS SEARCH RESULTS

WHOIS RECORD FOR:

longislandwinecountry.com

[Back-order this name](#)

Registrant:

Dan Auber (LONGISLANDWINECOUNTRY-DOM)
3575 Seafarer Dr.
Oceanside, CA 92054
US

Domain Name: LONGISLANDWINECOUNTRY.COM

Administrative Contact:

Auber, Dan (213319551) dan@unitedwebservices.com
United Web Services
800 Grand Ave. Suite A14
Carlsbad, CA 92008
US
760.730.1490 fax: 760.730.1480

Technical Contact:

Dan Auber (231416480) auber@cox.net
3575 Seafarer Dr.
Oceanside, CA 92054
US
760-439-2850 fax: 760-439-6918

Record expires on 23-Mar-2004.

Record created on 23-Mar-1999.

Database last updated on 9-Dec-2003 21:07:56 EST.

Domain servers in listed order:

NS.UNITEDWEBSERVICES.COM
NS1.UNITEDWEBSERVICES.COM

Get 1
for
W

\$19
1st

FIND

Fetch
DOGPFILE-C
By downloading

Actions you can take to protect your WHOIS information

SEARCH AGAIN

We
S

People Search!

Find a Business fast!

NOTICE AND TERMS OF USE: You are not authorized to access or query our WHOIS database through the use of high-volume, automated, electronic processes. The Data in Network Solutions' WHOIS database is provided by Network Solutions for information purposes only, and to assist persons in obtaining information about or related to a domain name registration record. Network Solutions does not guarantee its accuracy. By submitting a WHOIS query, you agree to abide by the following terms of use: You agree that you may use this Data only for lawful purposes and that under no circumstances will you use this Data to: (1) allow, enable, or otherwise support the transmission of mass unsolicited, commercial advertising or solicitations via e-mail, telephone, or facsimile; or (2) enable high volume, automated, electronic processes that apply to Network Solutions (or its computer systems). The compilation, repackaging, dissemination or other use of this Data is expressly prohibited without the prior written consent of Network Solutions. You agree not to use high-volume, automated, electronic processes to access or query the WHOIS database. Network Solutions reserves the right to terminate your access to the WHOIS database in its sole discretion, including without limitation, for excessive querying of the WHOIS database or for failure to otherwise abide by this policy. Network Solutions reserves the right to modify these terms at any time.

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EXHIBIT "B"



UNITED STATES PATENT AND TRADEMARK OFFICE

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Index

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Trademark Electronic Search System(Tess)

TESS was last updated on Tue Dec 9 04:21:00 EST 2003

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	URGENT DOC	REPORT	HELP
CURR LIST		FIRST DOC	PREV DOC	NEXT DOC	LAST DOC			

Logout Please logout when you are done to release system resources allocated for you.

Start List At: OR Jump to record: **Record 3 out of 6**

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark	LONG ISLAND WINE COUNTRY
Goods and Services	IC 042. US 100 101. G & S: Association services, namely, promoting the interests or awareness of regional wineries. FIRST USE: 19870000. FIRST USE IN COMMERCE: 19870000
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	78052477
Filing Date	March 11, 2001
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	September 24, 2002
Registration Number	2663203
Registration Date	December 17, 2002
Owner	(REGISTRANT) Long Island Wine Council CORPORATION NEW YORK P.O. Box 74 Peconic NEW YORK 11958
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "WINE COUNTRY" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL-2(F)

**Live/Dead
Indicator****LIVE**

PTO HOME	TRADEMARK	TESS HOME	NEW USER	SERIALIZED	FREE FORM	BRAND DOC	TOP	HELP	
CURR LIST		FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				

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CONTACT US | PRIVACY STATEMENT

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-12-09 21:25:40 ET

Serial Number: 78052477

Registration Number: 2663203

Mark (words only): LONG ISLAND WINE COUNTRY

Standard Character claim: No

Current Status: Registered.

Date of Status: 2002-12-17

Filing Date: 2001-03-11

Transformed into a National Application: No

Registration Date: 2002-12-17

Law Office Assigned: TMO Law Office 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2003-02-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Long Island Wine Council

Address:

Long Island Wine Council

P.O. Box 74

Peconic, NY 11958

United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

Phone Number: (631)765-9528

Fax Number: (631)765-6237

GOODS AND/OR SERVICES

Association services, namely, promoting the interests or awareness of regional wineries

International Class: 042

First Use Date: 1987-00-00

First Use in Commerce Date: 1987-00-00

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "WINE COUNTRY"

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-12-17 - Registered - Principal Register

2002-09-24 - Published for opposition

2002-09-04 - Notice of publication

2002-07-20 - Amendment to Use approved

2002-04-29 - Approved for Pub - Principal Register (Initial exam)

2002-03-29 - Communication received from applicant

2002-04-25 - Amendment to use processing complete

2002-03-29 - Amendment to Use filed

2002-01-07 - Communication received from applicant

2001-12-22 - Communication received from applicant

2001-07-10 - Non-final action mailed

2001-07-05 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
LONG ISLAND WINE COUNCIL
PO BOX 74
PECONIC NY 11958-0074
United States
Phone Number: (631)765-9528
Fax Number: (631)765-6237

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=78052477>

12/9/2003

2

3. Registrant Long Island Wine Council lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in **Paragraph 3** of the Petition, and therefore, Denies the same.

4. Registrant Long Island Wine Council lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in **Paragraph 4** of the Petition and, therefore, Denies the same.

5. Registrant Long Island Wine Council admits that its trademark LONG ISLAND WINE COUNTRY is registered for use on Association Services, namely, promoting the interests or awareness of regional wineries. However, Registrant Long Island Wine Council Denies all other allegations set forth in **Paragraph 5** of the Petition.

6. Denied.

7. Denied.

8. Denied.

9. Denied.

10. Denied.

11. Denied.

12. The allegations contained in **Paragraph 12** of the Petition set forth conclusions of law, for which no responsive pleading is required. To the extent that a responsive pleading is required, Registrant Long Island Wine Council Denies the allegations set forth in **Paragraph 12** of the Petition.

AFFIRMATIVE DEFENSES

13. In 1987 Registrant Long Island Wine Council was the first to adopt, market, promote and use the mark LONG ISLAND WINE COUNTRY; more than twelve years prior to any use the Petitioner could allege in connection with his domain name LONGISLANDWINECOUNTRY.COM.

14. Registrant Long Island Wine Council has continuously used and continues to use its registered mark LONG ISLAND WINE COUNTRY, U.S. Registration No. 2,663,203 in connection with Association services, namely, promoting the interests or awareness of regional wineries, since the date of its first use in interstate commerce, in 1987.

15. Since 1987 Registrant Long Island Wine Council has continued to promote its association services under its LONG ISLAND WINE COUNTRY trademark through the present. Long Island Wine Council has expended thousands of dollars in marketing, advertising and promoting Long Island Wine Council as the source of the LONG ISLAND WINE COUNTRY Association Services. As a consequence of such extensive advertising and promotion, Long Island Wine Council has developed recognition for its LONG ISLAND WINE COUNTRY association services and has acquired and now enjoys a valuable reputation and good will under its LONG ISLAND WINE COUNTRY trademark.

16. Petitioner's alleged registration of the domain name LONG ISLANDWINECOUNTRY.COM, allegedly in 1999, more than twelve years after the commencement of use of the mark LONG ISLAND WINE COUNTRY by Registrant Long Island Council provides no trademark rights to such domain name. Accordingly, Registrant Long Island Wine Council is the true and valid owner of the mark LONG ISLAND WINE COUNTRY, and as such deserves to have its registration on the Principal Register maintained and continued.

17. Registrant Long Island Wine Council's mark LONG ISLAND WINE COUNTRY has acquired secondary meaning due to its use of the mark in commerce since 1987.

18. Petitioner's Cancellation and each of the purported causes set forth therein fail to state facts sufficient to entitle Petitioner to relief.

19. Petitioner's Cancellation and each of the purported causes set forth therein is barred by the Doctrine of Laches.

20. Petitioner's Cancellation and each of the purported causes set forth therein is barred by the Doctrine of Estoppel and Acquiescence.

21. Petitioners Cancellation and each of the purported causes set forth therein is barred by the Doctrine of Unclean Hands.

23. Petitioner's Cancellation and each of the purported causes set forth therein is barred by the Doctrine of Waiver.

WHEREFORE Registrant Long Island Wine Council prays that:

- A. Petitioner takes nothing by its Petition;
- B. The Petition is dismissed with prejudice;
- C. For such other and further relief as the Trademark Trial and Appeal Board deems just and proper.

Dated: February 13, 2004

Respectfully submitted,



Panagiotis Betty Tufariello

Reg. No. 40,851

THE LOW OFFICE OF P.B. TUFARIELLO, P.C.

8 Fountain Avenue

Selden, NY, 11784

631-716-0091 phone

631-716-0094 fax

24vellow@optoline.net

CERTIFICATE OF SERVICE

I hereby certify that on Friday, February 13, 2004, I caused to be served a copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following addresses:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

☐ by CM/ECF

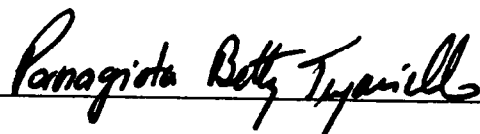
☐ by Electronic Mail

☐ by Facsimile Transmission

☐ by First Class Mail

☐ by Hand Delivery

☒ by Overnight Delivery


PANAGIOTA BETTY TUFARIELLO

Reorder No. 5105
JULIUS BLUMBERG, INC.
NYC 10013
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Nidea Corporation,
a Delaware Corporation
Petitioner,

v.

Long Island Wine Council,
a New York Corporation
Registrant.

X

Cancellation No. 92042784

In re: LONG ISLAND WINE COUNTRY
U.S. Reg. No. 2,663,203

I hereby certify that this correspondence and all related attachments
are being deposited with the United States Postal Service as Express
Mail in an envelope addressed to: Assistant Commissioner for
Trademarks, 2900 Crystal Drive, Arlington Va 22202-3513, on
Friday, March 19, 2004


PANAGIOTA BETTY TUFARIELLO

X

DECLARATION OF PANAGIOTA BETTY TUFARIELLO, ESQ.
IN SUPPORT OF REGISTRANT/RESPONDENT
LONG ISLAND WINE COUNCIL'S
MOTION FOR JUDGEMENT ON THE PLEADINGS

I, Panagiota Betty Tufariello, hereby declare as follows:

1. I am a shareholder in the law firm THE LAW OFFICES OF P.B. TUFARIELLO, P.C. located at 8 Fountain Ave, Selden, New York 11784, attorneys of record for Registrant/Respondent Long Island Wine Council (hereinafter "Registrant/Respondent").

2. I am a member of good standing of the bar of the state of New York, the United States District Courts for the Eastern and Southern Districts of New York, as well as the bar of the United States Patent and Trademark Office..

3. I am fully familiar with the facts in this matter.

4. Annexed hereto as **Exhibit 3** is a copy of Examiner's Action No. 01 mailed on

July 1, 2001 during the prosecution of U.S. Trademark Application Serial No. 78/352,477, which corresponds to U. S. Trademark Registration No. 2,663,203, the subject registration of the present cancellation.

5. Annexed hereto as **Exhibit 4** is a copy of Registrant/Respondent's letter of April 24, 2002 to the Examiner handling U.S. Trademark Application Serial No. 78/352,477, corresponding to U. S. Trademark Registration No. 2,663,203, the subject registration of the present cancellation. The letter is titled CONFIRMATION OF ACQUIRED DISTINCTIVENESS.

6. Annexed hereto as **Exhibit 5** is a copy of the Notice of Acceptance of Amendment to Use issued on July 23, 2002 in U.S. Trademark Application Serial No. 78/352,477, corresponding to U. S. Trademark Registration No. 2,663,203, the subject registration of the present cancellation.

7. Annexed hereto as **Exhibit 6** is a copy of the Notice of Publication issued on September 4, 2002 in U.S. Trademark Application Serial No. 78/352,477, corresponding to U. S. Trademark Registration No. 2,663,203, the subject registration of the present cancellation.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

3/19/04

Dated

Panagiota Betty Tufariello

Panagiota Betty Tufariello (40,851)

CERTIFICATE OF SERVICE

I hereby certify that on Friday, March 19, 2004, I caused to be served a copy of the foregoing DECLARATION OF PANAGIOTA BETTY TUFARIELLO, ESQ. IN SUPPORT OF REGISTRANT/RESPONDENT LONG ISLAND WINE COUNTRY'S MOTION FOR JUDGEMENT ON THE PLEADINGS IN CANCELLATION NO. 92042784 on the following person in the manner indicated below at the following address:

Gregory T. Meath, Esq.
Law Offices of Gregory T. Meath
Attorneys and Counselors
13721 North Neeley Road
Lodi, CA 95242

- ☐ by CM/ECF
- ☐ by Electronic Mail
- ☐ by Facsimile Transmission
- ☐ by First Class Mail
- ☐ by Hand Delivery
- ☒ by Overnight Delivery


PANAGIOTA BETTY TUFARIELLO

3

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 78/052477 Long Island Wine Council		APPLICANT Long Island Wine Council		PAPER NO.	
MARK LONG ISLAND WINE COUNTRY		ACTION NO. 01		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov <small>If no fees are enclosed, the address should include the words "On Responses - No Fee."</small>	
ADDRESS Long Island Wine Council PO BOX 74 PECONIC NY 11958-0074		MAILING DATE 07/10/01			
REF. NO.		REF. NO.			

FORM PTO-1525 (5-00)

TRADEMARK LAW OFFICE 14

Serial Number: 78/052477

Mark: LONG ISLAND WINE COUNTRY

Please Place on Upper Right Corner

of Response to Office Action ONLY

U.S. DEPT. OF COMMERCE, PAT. & TM. OFFICE

Please provide in all correspondence:

- 1. Filing Date, serial number, mark and Applicant's name.
- 2. Mailing date of this Office action.
- 3. Examining Attorney's name and AW Office number.
- 4. Your telephone number and ZIP code.

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.

For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 78/052477

The assigned examining attorney has reviewed the referenced application and determined the following.

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

GEOGRAPHICAL DESCRIPTIVENESS OF MARK

The examining attorney refuses registration on the Principal Register because the mark is primarily geographically descriptive of the applicant's services. Trademark Act Section 2(e)(2), 15 U.S.C. Section 1052(e)(2); TMEP section 1210.05.

The applicant's mark "LONG ISLAND WINE COUNTRY" literally means "a region, territory, or large tract of land" that is known for its wines in or near "a long, narrow island of southeast New

York bordered on the south by the Atlantic Ocean."¹ The primary significance of the term "Long Island" is geographic, and applicant's services come from the geographical place named in the mark. Therefore, a public association of the services with the place is presumed. *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982).

Possible Geographically Deceptively Misdescriptiveness

If the prescribed services, however, do not originate in Long Island, the examining attorney refuses registration on the Principal Register because the mark is primarily geographically deceptively misdescriptive of the applicant's services. Trademark Act Section 2(e)(3), 15 U.S.C. Section 1052(e)(3); TMEP section 1210.06.

RECITATION OF SERVICES

The recitation of services is unacceptable as indefinite. The applicant may adopt the following recitation, if accurate. TMEP section 1301.05.

Association services, namely, promoting the interests and awareness of regional wineries and vineyards

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP section 804.09. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

RESPONSE AND COMMUNICATION

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the issue concerning the recitation of services.

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

78/052477

-3-

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.



Dawn L. Han
Trademark Attorney
Law Office 114
V (703) 308-9114 ext. 279
F (703) 308-9207
dawn.han@uspto.gov



April 24, 2002

Dawn L. Han
Trademark Attorney
Law Office 114
Commissioner for Trademarks
Fax: 703-308-9207

Dear Dawn,

**APPLICATION FOR TRADEMARK - LONG ISLAND WINE COUNTRY (78/052477)
CONFIRMATION OF ACQUIRED DISTINCTIVENESS**

Further to your phone call today, we would like to confirm that the applicant's trademark Long Island Wine Country has acquired distinctiveness through continuous use for over five years.

It has become synonymous with the Long Island Wine Council's marketing of the Long Island wine region, clearly proven by the fact that a recent CNN Moneyline program on Interstate Wine Shipment used our signage "Welcome to Long Island Wine Country" to establish from where the story was being broadcast. A recent article concerning a potential wine center that we are looking into in the area, clearly used the wording to illustrate the story (see following). The other materials provided to you previously also support the mark's acquired distinctiveness.

We would like to confirm that no claim is being made for the exclusive right to use Wine Country apart from the mark as applied.

Please let me know if you require any further information. Thank you again for your efforts on our behalf.

Sincerely,

Jane Baxter Lynn
Executive Director

1st Date

cc: Harold W. Watts, LIWC President

BUSINESS

Wine center for Riverhead?

\$45K grant approved to study feasibility

By Jeff Miller

You've driven across Long Island and you're entering the North Fork when you see a sign that says, "Welcome to Long Island Wine Country." What's that about, you might wonder.

One way to answer that question would be a wine center. To that end, the Long Island Wine Council applied for funds to conduct a feasibility study on such a center. And last week a grant came through to make it so.

"This generous funding of \$45,000 from the Empire State Development Corp. will enable us to

take a step toward investigating the possibilities," said Wine Council president Harold Watts in a press release. "A centrally located wine center, focused on educating and informing consumers about the Long

Island wine industry, could provide an important advantage for our industry and the East End's economy as a whole. The study's outcome will determine whether that is so."

The council envisions the center rising in Riverhead, at the nexus of the two forks. In addition to making geographic sense, the council believes a Riverhead placement "could make a significant contribution to the town's planned revitalization program."



Times/Review photo by Barbara Ellen Koch
Soon to be explored: the idea of a wine center in Riverhead, near the "Welcome to Long Island Wine Country" sign, to assist wine-loving visitors.

Further, the center's "ripple effect could be good for everyone on the East End. Increased demand for wine production would further encourage investment in vineyards and ensure the long-term future of agriculture on the East End. It would also generate more jobs and greater income for local businesses."

The idea grew out of "recognition of the significant developments taking place in the East End's wine industry and of the need to plan for the longer term," said the announcement, noting that it's based on similar models in France, Italy, California and New Zealand.

Said Mr. Watts, "A lot of investment both in ener-

BUSINESS PROFILE

Faucets, Sinks & More by S.N. Delia

Owners: Sal Saporito

Location: 53975 Main Road, Southold

Year Established: 1997

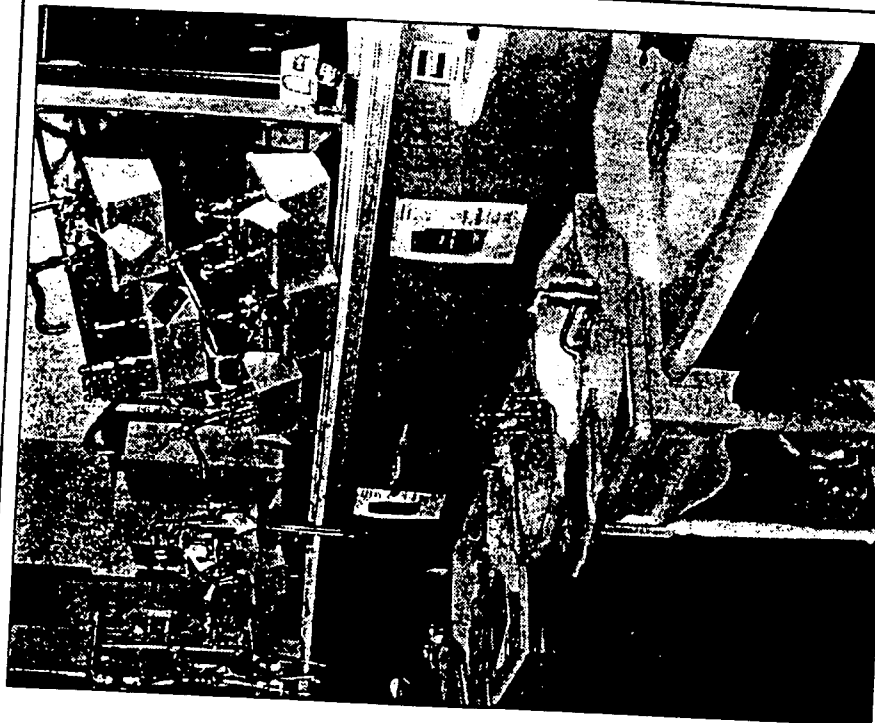
Number of Employees: 2

Profile: Faucets, Sinks & More by S.N. Delia started out as a family business in the '40s. Current owner, Sal Saporito, consolidated, focused and moved the business but kept a connection with the past in the store's name: Delia is the town in Sicily where his father was born.

The store offers a wide variety of mid- to high-end architectural and decorative hardware for cabinets and doors, as well as faucets, sinks, bathtubs and other plumbing fixtures. Products are available from suppliers all over the world, including Kohler, Aquaware, Samuel Heath, Newport Brass and GS North America.

Mr. Saporito constantly strives to expand and update his collection of hardware and fixtures and has also expanded to the Internet, where customers can shop online at www.faucetsinksandmore.com. He plans to become a member of Homeport-folio.com, Mall.com and Yahoo shopping.

He reports that he sells both to builders and plumbers and to the general public, with the bulk of his business coming from Suffolk and Nassau counties, Manhattan, Connecticut and Massachusetts. Most of his Manhattan sales come from summer residents and weekend visitors to the North Fork, and sales have met expectations despite Sept. 11.



Times-Review photo by Cindy Caprise
Some of the fixtures in stock at Faucets, Sinks & More by S.N. Delia.

Looking to the future, Mr. Saporito says, "If the business goes national through the Internet, that's fine with me, but I'm concentrating on Long Island."

gy and money, has gone into developing the region's wine industry and now, after almost 30 years, it is really taking off." The industry is cited as "one of Suffolk County's largest agricultural entities by acreage," and a key element of the East End's ever-growing renown as a tourism destination.

The wine center would enhance all that and "would provide an orientation center for people prior to coming out to the vineyards or enable them to experience the wine region right there if it is their final destination," says the announcement. "It could also help manage traffic congestion on the North and South forks by providing a hub for planned transportation."

Part one of the study would determine the need for a wine center. Part two would suggest suitable locations and delve into its economic viability.

The Wine Council credits the Empire State Development Corp. with providing technical assistance and support throughout the application process.

BUSINESS BEAT

Castello di Borghese/Hargrave Vineyard in Cutchogue brought home two bronze medals recently, from the 2002 Grand Harvest Awards Wine Competition in California, and from the Dallas Morning News 2002 Wine Competition in Texas.

UNITED STATES DEPARTMENT OF COMMERCE
ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513
Jul 23, 2002

NOTICE OF ACCEPTANCE OF AMENDMENT TO USE

Long Island Wine Council
PO BOX 74
PECONIC NY 11958-0074

TM14

ATTORNEY
REFERENCE NUMBER:

SERIAL NUMBER: 78/052477
MARK: LONG ISLAND WINE COUNTRY
OWNER: Long Island Wine Council

The amendment to allege use filed in regard to the above-identified application has been accepted. The acceptance signifies that the amendment to allege use conforms not only to the minimum requirements set forth in 37 C.F.R. Sec. 2.76(e), but also to the formal requirements set forth in 37 C.F.R. Sec. 2.76(b) and (c).

The acceptance does not signify that the application is in condition for publication. Even though the amendment to allege use has been accepted for the purpose of compliance with the formal requirements of 37 C.F.R. Sec. 2.76, the examining attorney may issue an office action as a result of the substantive review of the amendment to allege use. Furthermore, the filing of the amendment to allege use does not constitute a response to any outstanding office action. 37 C.F.R. Sec. 2.76(f). If the applicant does not respond to any outstanding office action within the time provided in that action, the application is abandoned, and no further action will be taken on the amendment to allege use. If the examining attorney issues an office action related to the amendment to allege use, that office action will restate or incorporate by reference all unresolved refusals or requirements previously stated and will establish a new six-month period for response.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sep 4, 2002

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|---------------------------------------------|-------------------------------------------|
| 1. Serial No.:
78/052,477 | 2. Mark:
LONG ISLAND WINE COUNTRY |
| 3. International Class(es):
42 | |
| 4. Publication Date:
<u>Sep 24, 2002</u> | 5. Applicant:
Long Island Wine Council |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: (202)512-1800

By direction of the Commissioner.

bookstore.gpo.gov or call on 9/24
~~8/20/02~~