

ESTTA Tracking number: **ESTTA704876**

Filing date: **10/27/2015**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	Brown-Forman Corporation		
Entity	Corporation	Citizenship	Delaware
Address	850 Dixie Highway Louisville, KY 40210 UNITED STATES		

Attorney information	Christopher C. Larkin Seyfarth Shaw LLP 2029 Century Park East, Suite 3500 Los Angeles, CA 90067-3021 UNITED STATES clarkin@seyfarth.com, kelko@seyfarth.com Phone:(310) 277-7200		
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**Registration Subject to Cancellation**

Registration No	4659980	Registration date	12/23/2014
Registrant	Shaw-Ross International Importers, LLC 1600 N.W. 163rd Street Miami, FL 33169 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 033. First Use: 2014/09/17 First Use In Commerce: 2014/09/17 All goods and services in the class are cancelled, namely: Rum
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**Grounds for Cancellation**

The mark is merely descriptive	Trademark Act section 2(e)(1)
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Attachments	Petition to Cancel.pdf(846650 bytes )
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**Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Christopher C. Larkin/
Name	Christopher C. Larkin
Date	10/27/2015

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

In the Matter of Registration No. 4,659,980  
Issued on December 23, 2014

BROWN-FORMAN CORPORATION,

Petitioner,

v.

SHAW-ROSS INTERNATIONAL  
IMPORTERS, LLC,

Respondent.

Cancellation No.: \_\_\_\_\_

**PETITION TO CANCEL**

Petitioner Brown-Forman Corporation (“Petitioner”) believes that it will be damaged by the continued registration of the mark shown in Registration No. 4,659,980, and hereby petitions to cancel the same. As grounds for its petition, Petitioner alleges as follows:

1. Petitioner is a Delaware corporation with offices in Louisville, Kentucky.
2. Upon information and belief, respondent Shaw-Ross International Importers, LLC (“Respondent”) is a Florida limited liability company with an address of record in Miami, Florida.
3. Petitioner owns United States Trademark Registration No. 4,659,980 (the “Registration”) for the mark DOUBLE SPICE for rum. The application that matured into the Registration was filed on April 10, 2012 and the Registration issued on December 23, 2014 on the basis of claimed first use and first use of the mark in commerce on September 17, 2014.
4. During prosecution of the application that matured into the Registration, the Patent and Trademark Office requested that Respondent disclaim the exclusive right to use “SPICE” apart from the mark as shown on the ground that “spice” “presumably describes both a

feature and characteristic of the applicant's good, that being spiced rum." Respondent entered the requested disclaimer. The product with which Respondent uses the mark shown in the Registration is in fact a spiced rum, as shown on the specimen of use submitted by Respondent to obtain the Registration, a copy of which specimen is attached hereto as Exhibit 1.

5. Petitioner owns Application Serial No. 86/032,052 (the "Application") in the Patent and Trademark Office to register the mark WOODFORD RESERVE DOUBLE SPICED RYE for distilled spirits, namely, whiskey ("RESERVE DOUBLE SPICED RYE" disclaimed apart from the mark as shown) on the basis of Petitioner's intention to use the mark in commerce. The Application was filed on August 8, 2013. On April 30, 2015, the Patent and Trademark Office refused registration of Petitioner's mark under § 2(d) of the Trademark Act on the basis of the mark shown in the Registration.

6. The DOUBLE SPICE mark shown in the Registration is merely descriptive of a feature, quality, attribute, or characteristic of rum because the word "DOUBLE" in the mark means twice as large, heavy, strong, etc., or twofold in size, amount, number, extent, etc., while the word "SPICE" has been disclaimed by Respondent because it describes a feature and characteristic of rum. Upon information and belief, the DOUBLE SPICE mark shown in the Registration did not acquire distinctiveness as of the date of issuance of the Registration.

**FIRST CLAIM FOR RELIEF**  
**(Mere Descriptiveness)**

7. Petitioner repeats and realleges the allegations in preceding paragraphs 1-6 as if fully set forth herein.

8. The mark shown in the Registration is merely descriptive of the goods identified in the Registration, and did not acquire distinctiveness as of the date of issuance of the Registration, and Respondent is thus not entitled to maintain registration of the mark under § 2(e)(1) of the United States Trademark Act, 15 U.S.C. § 1052(e)(1).

9. Petitioner will be damaged by the continued registration of the mark shown in the Registration because such registration has been cited against Petitioner's application for registration of its mark WOODFORD RESERVE DOUBLE SPICED RYE.

WHEREFORE, petitioner Brown-Forman Corporation prays for judgment granting this petition to cancel and canceling Registration No. 4,659,980.

Please charge the filing fees for this cancellation to Deposit Account No. 50-2291 and direct all correspondence and communication in this cancellation to the undersigned.

Respectfully submitted,

SEYFARTH SHAW LLP

Dated: October 27, 2015

By: *s/ Christopher C. Larkin*

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Christopher C. Larkin  
Attorneys for Petitioner  
BROWN-FORMAN CORPORATION

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Los Angeles, CA 90067-3021  
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Facsimile: (310) 201-5219

# **EXHIBIT 1**



**CERTIFICATE OF SERVICE**

I hereby certify that on October 27, 2015, I served the foregoing Petition to Cancel on the respondent by mailing a copy thereof by First Class Mail, postage prepaid, addressed to respondent at respondent's correspondence address of record in the records of the Patent and Trademark Office as follows:

Shaw-Ross International  
Importers, LLC  
1600 N.W. 163rd Street  
Miami, FL 33169

*s/ Eleanor Elko*

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Eleanor Elko