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

Proceeding	92071386
Party	Plaintiff Globefill Incorporated
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GLOBEFILL INCORPORATED, Petitioner, v. CALAVERA TEQUILA COMPANY LLC., Registrant.	Cancellation No.: 92071386 Registration No.: 4580425 Mark: SKULL

Atty Dkt. No. 045275.021007

PETITIONER'S REPLY BRIEF IN SUPPORT OF
MOTION FOR SUMMARY JUDGMENT

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and 37 C.F.R. § 2.127(e)(1), Petitioner Globefill Incorporated ("Globefill" or "Petitioner"), submits this reply brief in further support of its motion for summary judgment (TTABVUE 11).

Registrant, Calavera Tequila Company LLC ("Registrant"), argues in opposition to the motion that because it has apparently engaged in some test marketing of its product, there is a genuine issue of material fact as to whether the Registrant's SKULL mark has been in "use in commerce" as required by the Lanham Act. (*See* TTABVUE 13). However, none of Registrant's arguments address the crux of Petitioner's motion, that is, that the subject registration is *void ab initio* because there was no lawful use in commerce as of August 30, 2013 (the deadline for filing a statement of use). The fact that a Certificate of Label Approval (COLA) apparently issued on March 15, 2014, does nothing to dispute the facts on which the Board can and should grant summary judgment.

Any "test marketing" efforts that took place subsequent to August 30, 2013, are immaterial for purposes of this motion and for purposes of the validity of the subject registration. The registration should be cancelled as *void ab initio* because Respondent has offered no evidence that it had been using the mark in commerce as of the critical date. Registrant acknowledges the authorities cited by Petitioner in its motion for the proposition that there can be no "lawful use in commerce" absent a valid COLA when the subject goods are alcoholic beverages, yet cites an inapposite, nonprecedential case for the proposition that there needs to be some prior predetermination of a "use" being "unlawful" in order for the Board to find "unlawful use."

Churchill Cellars, Inc. v. Brian Graham, 2012 WL 5493578 (TTAB Oct. 19, 2012), relied on by Registrant, is a nonprecedential case that was expressly criticized by the Board in the precedential case of *Scott Stawski v. John Gregory Lawson*, 129 U.S.P.Q.2d 1036 (TTAB Dec. 21, 2018). Additionally, *Churchill Cellars* involved a priority dispute, not the question of whether an existing registration should be cancelled as *void ab initio* for failure to have used the mark in commerce as of the statement of use due date. The evidentiary burden of showing priority of use in a Section 2(d) contest is significantly relaxed as compared to the statutory requirement of having use in commerce to support the maturation of a trademark application into a registration. Thus, in addition to being overruled and nonprecedential, the *Churchill Cellars* case is inapposite to the case at hand. The Board should decline Registrant's attempt to rely on it.

Instead, the Board should follow the guidance of the precedential *Tao Licensing* case. *Tao Licensing, LLC v. Bender Consulting Ltd. d/b/a Asian Pacific Beverages*, 125 U.S.P.Q.2d 1043, 2017 WL 6336243 (TTAB 2017). Although Registrant attempts to distinguish this case by noting that it was decided after the full trial period and not on summary judgment, Registrant has

not disputed the fundamental fact, admitted in its discovery responses, that it has *never* made a sale of SKULL vodka to anyone. With *Tao Licensing* establishing that mere discussions with, or provision of samples of alcohol to, potential distributors are not sufficient to support use in commerce as of the deadline for submitting a statement of use, it would be a waste of judicial resources to deny summary judgment and require this case to proceed to trial. Even on the present record, Registrant's admission that it has *never* sold any alcoholic beverage under the SKULL mark, COLA or not, "underscores the[] preliminary nature" of any purported test or marketing efforts since no sales have come to fruition in the past seven years since the mark was purportedly first used in commerce. *Tao Licensing*, 125 U.S.P.Q.2d at 1055.

Similarly, the precedential decision in *Scott Stawski v. John Gregory Lawson*, 129 U.S.P.Q.2d 1036 (TTAB Dec. 21, 2018) establishes that distribution of an alcohol product without a valid COLA is "not use in commerce, in accordance with the statutory definition of 'bona fide use in the ordinary course of trade.'" Insofar as there is no genuine issue of material fact as to whether Registrant was using the SKULL mark in lawful United States commerce as of August 30, 2013, the Board should find the subject registration *void ab initio* and order that it be cancelled.

Respectfully submitted,

BAKER & HOSTETLER LLP

Dated: March 19, 2020

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 19, 2020, a true and correct copy of the foregoing Petitioner's Reply Brief in Support of Motion for Summary Judgment was served upon Registrant's counsel, Jeffrey L.Van Hoosear and Brian M.Z. Reece, at the following email addresses:

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