

ESTTA Tracking number: **ESTTA1218686**

Filing date: **06/30/2022**

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 has filed a petition to cancel the registration indicated below.

Petitioner information

Name	TOUCHSTONE CELLARS, LLC		
Entity	Limited liability company	Citizenship	California
Address	3348 PAUL DAVIS DRIVE, SUITE 101 MARINA, CA 93933 UNITED STATES		

Attorney information	LEELA MADAN MADAN LAW PLLC 2808 CAROLINE ST., STE. 201-A HOUSTON, TX 77004 UNITED STATES Primary email: leela@madan-law.com Secondary email(s): admin@madan-law.com 7133644796		
Docket no.			

Registration subject to cancellation

Registration no.	6201352	Registration date	11/17/2020
Register	Principal		
Registrant	Delicato Vineyards 12001 S. HIGHWAY 99 MANTECA, CA 95336 UNITED STATES		

Goods/services subject to cancellation


Class 033. First Use: Jul 14, 2020 First Use In Commerce: Jul 14, 2020 All goods and services in the class are subject to cancellation, namely: Wine

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Mark cited by petitioner as basis for cancellation

U.S. application no.	88800256	Application date	02/17/2020
Register	Supplemental		
Registration date	NONE	Foreign priority date	NONE

Word mark	BOLD WINE CO.
Design mark	
Description of mark	NONE
Goods/services	Class 033. First use: First Use: Aug 30, 2016 First Use In Commerce: Aug 30, 2016 Alcoholic beverages, except beer; Wine

Attachments	88800256#TMSN.png(bytes) Petition to Cancel Reg No 6201352 for BOLD WINE FOR A REBELLIOUS TIME .pdf(168301 bytes)
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Signature	/LM/
Name	Leela Madan, Attorney for Petitioner
Date	06/30/2022

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

In re Registration No.:6,201,352
Trademark: BOLD WINE FOR A REBELLIOUS TIME
Filed: May 9, 2019
Registered: November 17, 2020

TOUCHSTONE CELLARS, LLC)	
)	
Petitioner,)	
)	Petition to Cancel No.: _____
v.)	
)	
DELICATO VINEYARDS)	
)	
Registrant.)	
)	
)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

BOX TTAB – FEE

PETITION TO CANCEL

TOUCHSTONE CELLARS, LLC, a California limited liability company located and doing business at 3348 Paul Davis Drive, Suite 101, Marina, California 93933 (“Petitioner”), believes that it will be damaged by the continued registration of “BOLD WINE FOR A REBELLIOUS TIME”, U.S. Registration No. 6,201,352 (the “Registration”), registered on November 17, 2020, for “wine” in International Class 033 (“Registrant’s Mark”) and owned by DELICATO VINEYARDS (“Registrant”), and therefore petitions the cancellation of same. As grounds for cancellation of Registrant’s Mark, Petitioner alleges as follows:

Petitioner and Petitioner’s “BOLD WINE CO.” Trademark

1. Petitioner is a premier producer, bottler, and seller of a variety of wines under several different labels, including BOLD WINE CO. Petitioner began its operations in 2014 by master sommelier, Chris Miller, who believes that more time should be spent in the vineyards than in the winery by focusing on cool-climate organic and sustainable vineyards to produce balanced wines that showcase their origin more than their winemaking. Petitioner began commercially using the name “BOLD WINE CO.” (“Petitioner’s Mark”) as a trademark in connection with one of its lines of wines on or about April 25, 2018, after first obtaining its Certificate of Label Approval (COLA) from the Alcohol and Tobacco Tax and Trade Bureau (“TTB”) in August 2016.

2. In connection with its “BOLD WINE CO.” line of wines, Petitioner has made extensive and continuous commercial use of the name “BOLD WINE CO.” in connection with the sale of wines via its mailing list, tasting room, fine dining restaurants, as well as online and in retail stores throughout the United States since at least as early as April 25, 2018.

3. In connection with its “BOLD WINE CO.” line of wines, Petitioner has successfully placed its line of “BOLD WINE CO.” wines in most, if not all, Whole Foods markets nationwide, as well as most, if not all, Total Wine & More retail locations, just to name a few, in addition to sales through its website www.seaboldcellars.com and those described in Paragraph 2.

4. Petitioner has established common law rights to the “BOLD WINE CO.” mark through its extensive sales of wine throughout the United States under “BOLD WINE CO.”, that predate both the filing date and alleged date of first use of Registrant’s Registration. Petitioner has acquired valuable goodwill in the “BOLD WINE CO.” mark through its use in commerce in the United States since at least as early as April 25, 2018, in connection with the sale of wines. The “BOLD WINE CO.” mark has come to indicate Petitioner as the source of these goods in the

minds of the purchasing public. Thus, Petitioner has priority of use through its common-law rights in the “BOLD WINE CO.” mark.

5. Petitioner’s “BOLD WINE CO.” mark is prominently displayed on its wine bottle labels in a distinct, stylized font, in connection with bright colors used to show what kind of wine is in the bottle and the color of the grapes used to make the wine. Petitioner’s “BOLD WINE CO.” mark and the labels described herein are clearly visible in its online listings and easy to spot in stores, in restaurants, and in its tasting room.

6. Petitioner is the owner of pending Trademark Application Serial No. 88/800,256 for the standard character mark for “BOLD WINE CO.” (“Petitioner’s Mark”), filed on February 17, 2020, for “Alcoholic beverages, except beer; Wine” in International Class 033.

7. Upon information or belief, Petitioner and Registrant are competing producers, bottlers, and sellers of wine and alcoholic beverages in the same field and geographic markets who market and sell their products in similar or identical markets and outlets.

8. The continued presence of the Registrant’s Mark on the federal trademark register constitutes an obstacle to Petitioner’s intended registration of its “BOLD WINE CO.” trademark.

9. For the reasons set forth in Paragraphs 1-8, Petitioner has standing to bring this Petition and to assert each of the causes of action herein.

Registrant and the Registration

10. According to the records of the United States Patent & Trademark Office (USPTO), the Registrant is a California corporation with a listed address of 12001 South Highway 99, Manteca, California 95336.

11. According to the records of the USPTO, on May 9, 2019, Registrant filed Application Serial No. 88/422,676, which ultimately matured into the Registration for Registrant's Mark for "BOLD WINE FOR A REBELLIOUS TIME" on November 17, 2020.

12. According to the records of the USPTO, Registrant claimed use of the Registrant's Mark as of July 14, 2020, which is long after Petitioner established its rights to the name "BOLD WINE CO." by obtaining COLA approval in August 2016, and long after Petitioner began commercial use of the mark "BOLD WINE CO." in connection with the sale of its line of wines in April 2018.

13. Upon information or belief, Registrant owns or manages a variety of subsidiary entities which sell a variety of wines and alcoholic beverages.

14. Upon information or belief, Registrant has used Registrant's Mark in connection with its line of "1924 Wines" but has used at least three variations and departures from Registrant's Mark, including "BOLD WINES FROM A REBELLIOUS TIME", "BOLD WINES FOR A REBELLIOUS TIME", and "THIS IS A BOLD WINE FROM A REBELLIOUS TIME" (*emphasis added to show distinction from Registrant's Mark*).

15. There is no relationship nor has there ever been any relationship between Petitioner and Registrant and Registrant has not been authorized by Petitioner to use "BOLD WINE FOR A REBELLIOUS TIME" or any of the above-described variations, nor has it been authorized to obtain a trademark registration for same.

**COUNT I: REGISTRANT'S REGISTRATION IS VOID DUE TO PETITIONER'S
PRIOR USE OF THE MARK AND DUE TO LIKELIHOOD OF CONFUSION WITH
PETITIONER'S MARK**

16. Petitioner incorporates paragraphs 1 through 15 by reference and realleges the same.

17. “It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.” *Sengoku Works Ltd. v. RMC Int’l. Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996).

18. As asserted above, Petitioner has established common law rights to the “BOLD WINE CO.” mark through its extensive sales of wine to customers throughout the United States under “BOLD WINE CO.”, that predate the filing date and alleged date of first use of Registrant’s Registration. Thereby, Petitioner asserts a claim of priority of use in commerce of “BOLD WINE CO.” in Petitioner’s Mark in connection with the production and sale of “Alcoholic beverages, excluding beers; Wine” in International Class 033.

19. In addition to its claim of priority of use in commerce, Petitioner also asserts that, as stated in the Final Office Action, issued by the USPTO on December 30, 2021 (“Final Office Action”), the Registrant’s Mark so resembles Petitioner’s “BOLD WINE CO.” mark, as to be likely, when used on or in connection with the specified goods, *i.e.*, wine, to cause confusion, or to cause mistake, or to deceive. *See Final Office Action*.

20. Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742,

1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

21. As stated in the Final Office Action, registration of Petitioner's Mark is refused because of a likelihood of confusion with the Registrant's Mark. In particular, the USPTO examining attorney stated in the Final Office Action that [a]s in the present case, where the goods and/or services of an applicant and registrant are identical or virtually identical, the degree of similarity between the marks required to support a finding that confusion is likely declines. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(b).” The examining attorney goes on to explain that “[i]n this case, [Petitioner's] mark is the wording “BOLD WINE CO.” appearing in standard characters. Registrant's mark is the wording “BOLD WINE FOR A REBELLIOUS TIME” appearing in standard characters. [Petitioner's] mark is highly similar to registrant's mark(s) in appearance, sound, and commercial impression.” *See Final Office Action*.

22. In the Final Office Action, the examining attorney further states that “[c]onsumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. *See Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); *see also In re Detroit Athletic Co.*, 903

F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”).” In the Final Office Action, the examining attorney goes on to say that “[h]ere both marks have the same initial two words “BOLD WINE” and identical first words and this is the portion of the mark consumers are likely to focus. Therefore the marks are highly similar... [and b]ecause the marks are highly similar, purchasers are likely to believe that the goods emanate from the same source. Therefore, the marks are confusingly similar, and the first prong of the likelihood of confusion test is met.”

23. With regard to the comparison of the goods, in the Final Office Action, the examining attorney first states that “[d]etermining likelihood of confusion is based on the description of the goods stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).” The examining attorney further explains that “[t]he goods are compared to determine whether they are similar, commercially related, or travel in the same trade channels. *See Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).” And finally, the examining attorney states that “[t]he compared goods and/or services need not be identical or even competitive to find a likelihood of confusion. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the

mistaken belief that [the goods and/or services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).”

24. Using the aforementioned reasoning, the examining attorney in the Final Office Action concludes that “the identified wine goods are identical. Therefore, it is presumed that the channels of trade and class(es) of purchasers are the same for these goods and/or services. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1372, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)). Thus, [Petitioner’s] and registrant’s goods and/or services are related... [and that t]he evidence shows that purchasers are accustomed to encountering the goods of the [Petitioner] and registrant offered under the same mark. Therefore, purchasers are likely to believe the goods emanate from the same source. Accordingly, the goods of [Petitioner] and the registrant are considered related for purposes of the likelihood of confusion analysis, and the second prong of the test is met.”

25. Applicant hereby incorporates the Final Office Action in its entirety by reference, the full text of which can be found at www.tsdr.uspto.gov.

26. In view of the above, Petitioner asserts that the Registrant’s Mark so resembles Petitioner’s “BOLD WINE CO.” mark, as to be likely, when used on or in connection with the specified goods, *i.e.*, wine, to cause confusion, or to cause mistake, or to deceive, as stated in the Final Office Action issued by the USPTO.

27. In view of the above, Petitioner asserts that the Registrant is not entitled to retain the rights associated with the Registration or to the legal presumptions that the Registration creates.

28. Petitioner asserts that the continued presence of the Registration on the federal trademark register constitutes a barrier to Petitioner's intended registration of Petitioner's Mark.

29. The Registration, thus, should be cancelled due to Petitioner's clear prior commercial use of the "BOLD WINE CO." mark in commerce in connection with the production and sale of wine and in view of the likelihood of confusion between the Petitioner's "BOLD WINE CO." mark and Registrant's Mark.

PRAYER FOR RELIEF

30. WHEREFORE, Petitioner respectfully requests that registration of the Registrant's Mark shown in Registration No. 6,201,352 be cancelled and this Petition to Cancel be sustained in favor of the Petitioner.

Dated: June 30, 2022

Respectfully Submitted,



Leela Madan
Attorney for Petitioner
MADAN LAW PLLC

CERTIFICATE OF SERVICE

It is hereby certified that on June 30, 2022, a copy of the foregoing **PETITION TO CANCEL** was sent by email to the representative designated by as Attorney for Registrant at the correspondence address of record obtained from the TTAB, as follows:

Simone M. Katz-O'Neill
Delicato Vineyards
12001 S. Highway 99
Manteca, California 95336
trademark@delicato.com
Attorney for Registrant



Leela Madan