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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	Dancin Vineyards, LLC		
Entity	Limited Liability Company	Citizenship	Oregon
Address	PO Box 310 Jacksonville, OR 97530 UNITED STATES		

Attorney information	Sheila Fox Morrison Davis Wright Tremaine LLP 1300 SW Fifth Avenue, Suite 2400 Portland, OR 97201 UNITED STATES PDXTrademarks@dwt.com, PDXTMEenforcement@dwt.com, sheilafoxmorrison@dwt.com, StevenKlein@dwt.com (503) 241-2300		
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Registration Subject to Cancellation

Registration No.	1822081	Registration date	02/15/1994
Registrant	Sutton, John P. 2421 Pierce Street San Francisco, CA 94115 UNITED STATES		

Goods/Services Subject to Cancellation

Class 033. First Use: 1993/09/09 First Use In Commerce: 1993/09/09 All goods and services in the class are subject to cancellation, namely: wine

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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Attachments	Petition for Cancellation - ADAGIO.pdf(1500511 bytes)
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Signature	/s Steven E. Klein./
Name	Steven E. Klein
Date	11/06/2018

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

In the Matter of Trademark Registration No. 1822081
For the Mark: ADAGIO
Issued on: February 15, 1994

DANCIN VINEYARDS, LLC, an Oregon limited liability company,

Petitioner,

v.

John P. Sutton, an individual,

Respondent.

Cancellation No.

PETITION FOR CANCELLATION

Dancin Vineyards, LLC, an Oregon limited liability company having an address of PO Box 310, Jacksonville, Oregon 97530 (“Petitioner”), believes that it will be damaged by the continued registration of the trademark ADAGIO, Reg. No. 1822081, and hereby petitions to cancel same.

As grounds for the cancellation, Petitioner alleges as follows:

1. Petitioner is and has been engaged in the business of, inter alia, producing and selling wine in commerce in the United States under the mark ADAGIO since at least as early as May 25, 2012.

2. Petitioner is the owner of U.S. Trademark Application Serial No. 87/893,497, filed on April 25, 2018, for the mark ADAGIO in connection with “Wine” in Class 33 (the “Application”). Attached as Exhibit 1 is a true and correct copy of a printout of the record for the Application as reflected in the U.S. Patent and Trademark Office’s Trademark Electronic Search System.

3. On November 28, 2017, the Examining Attorney issued a Section 2(d) refusal of the Application based on Registration No. 1822081 for the mark ADAGIO mark in connection with “wine” in Class 33 (the “Registration”).

4. On information and belief, John P. Sutton is an individual with an address of 2421 Pierce Street, San Francisco, California 94115 (“Respondent”) and the owner of record of Reg. No. 1822081 for the mark ADAGIO (the “Registration”).

5. Assuming for the purposes of this pleading that the Examining Attorney reviewing the Application is correct that confusion is likely between the mark recited in the Application and the mark claimed by the Registration, the Examining Attorney’s citation of the Registration has damaged Petitioner by preventing registration of Petitioner’s ADAGIO mark.

6. Petitioner upon investigation believes that Respondent’s Registration is invalid due to abandonment.

7. On information and belief, Respondent was the plaintiff in a civil action filed in the United States District Court for the Eastern District of California (the “District Court”) captioned *John P. Sutton v. Williamsburg Winery, Ltd.*, Case No. 2:12-cv-00333-GEB-EFB (the “Action”). Attached as Exhibit 2 is a true and correct copy of the Complaint, dated February 8, 2012, filed by Respondent in the Action, which asserts claims for infringement of the Registration.¹ Attached as Exhibit 3 is a true and correct of the Answer and Counterclaim for non-infringement, dated May 9, 2012, filed in the Action by the defendants Williamsburg Winery, Ltd.

8. On information and belief, on September 23, 2013, the District Court entered judgment in the Action (the “Judgment”) on the Court’s finding that Respondent had abandoned,

¹ Copies of Exhibits 2 through 7 were accessed and retrieved by Petitioner directly from the online PACER CM/ECF electronic case filing system maintained by the District Court.

pursuant to 15 U.S.C. § 1127, the ADAGIO mark for wine claimed in Registration No. 1822081 due to Respondent having discontinued use of the mark with the intent not to resume use.

Attached as Exhibits 4 and 5 are true and correct copies of the District Court's Order Granting Defendant's Motion for Summary Judgment on the defense of abandonment and Judgment in a Civil Action entered on the same, both dated September 23, 2013.

9. On information and belief, on October 15, 2013, Respondent filed an appeal of the Judgment, captioned *John Paul Sutton v. Williamsburg Winery, Ltd.*, Appeal No. 13-17093, to the United States Court of Appeals for the Ninth Circuit (the "Appeal"). Attached hereto as Exhibit 6 is a true and correct copy of Respondent's Notice of Appeal, dated October 15, 2013.

10. On information and belief, on October 22, 2015, the Court of Appeals issued an opinion and mandate affirming the Judgment entered in the Action. Attached as Exhibit 7 is a true and correct copy of the Court of Appeals' Mandate and Opinion issued in the Appeal.

11. On information and belief, the time for Respondent to appeal from the Court of Appeals' determination Appeals has long since passed without Respondent having timely appealed. Accordingly, the Judgment in the Action has become final.

12. On information and belief, Respondent has never made bona fide use in commerce of the ADAGIO mark in connection with the sale of wine.

13. On information and belief, Respondent's non-use extends from at least as early as August 24, 1990, the date Respondent filed the application that matured into the Registration, through February 15, 1994, the date the Registration issued, through to the present.

14. On information and belief, Respondent discontinued all use of the ADAGIO mark with wine at least as early as February 24, 1994, and, in any event, no later than

September 22, 2010. On information and belief, Respondent's nonuse of the ADAGIO mark with wine continued for 3 or more consecutive years.

15. On information and belief, when Respondent discontinued all use of the ADAGIO mark with wine, he did so with the intent not to resume use in U.S. commerce of the marks in connection with wine.

16. Further, Respondent's nonuse for 3 or more consecutive years creates a presumption of abandonment. 15 U.S.C. § 1127.

17. Given all of the facts above, any rights in the ADAGIO mark covered by the Registration have been abandoned in that all use of the mark by Respondent in connection with wine has been discontinued for at least three consecutive years with no intention to resume use.

18. The abandonment of the mark covered by the Registration is grounds for cancellation of the Registration under § 14 of the Lanham Act, 15 U.S.C. § 1064 (3).

19. On information and belief, Respondent is the same party as the plaintiff-appellant in the Action and the Appeal.

20. On information and belief, the Judgment of the District Court in the Action is a final judgment on the merits of a claim that Respondent's Registration is invalid based on abandonment.

21. The claim for cancellation of the Registration for abandonment recited above is based on the same set of transactional facts as the claim in the Action, namely, Respondent's nonuse of the ADAGIO mark with wine for 3 or more consecutive years.

22. Accordingly, Respondent is barred by res judicata from relitigating the validity of the Registration.

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