

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: November 6, 2009

Opposition No. 91191056

White Rock Distilleries,
Inc.

v.

Franciscan Vineyards, Inc.

**Before Quinn, Zervas and Cataldo, Administrative Trademark
Judges**

By the Board:

This case now comes up for consideration of applicant's motion to dismiss Counts I and III of the notice of opposition for failure to state a claim upon which relief may be granted, filed August 17, 2009.

Background

Applicant seeks registration of PINNACLES RANCHES, in standard characters, for "Wines."¹ In its notice of opposition, opposer alleges prior use of, and ownership of a pending application for, PINNACLE for "vodka."² As grounds for opposition, opposer alleges that: (1) applicant's mark "is primarily geographically descriptive of the location of

¹ Application Serial No. 77598674, filed October 2, 2008, with RANCHES disclaimed, claiming a date of first use in commerce of May 2004.

² Application Serial No. 78166136, filed September 20, 2002, and amended to allege a date of first use in commerce of April 18, 2003.

origin of Applicant's wine as such location is just a few miles from an area ... known as 'Pinnacles Ranch' ... [and] consumers will correctly perceive the term as the name of a geographic location;" Notice of Opposition ¶¶ 7-8; (2) applicant's mark "is used [only] in an ancillary non-trademark manner that merely provides information regarding the geographic origin of Applicant's goods, which goods are sold under a different mark, namely, ESTANCIA ...;" Id. ¶ 12; and (3) applicant "committed fraud on the USPTO by withholding material information regarding" the "geographic significance of the term 'Pinnacles Ranches.'" Id. ¶¶ 14-15.

The parties hereto are also involved in Opposition No. 91185984, in which opposer herein is the applicant. In that case, the Board issued an order on September 17, 2009 (the "Prior Order") denying a motion filed by applicant (opposer herein) for leave to amend its fraud counterclaim, finding the proposed amended fraud counterclaim to be "futile." The proposed amended fraud counterclaim found to be futile in Opposition No. 91185984 is essentially identical to opposer's fraud claim in this case.

Applicant's Motion and Opposer's Response

Applicant argues that because it made no misrepresentation in connection with its application, and "had no obligation or duty to disclose to the Examining

Attorney some little known geographic significance to its mark," opposer has failed to state a claim for fraud. Applicant further argues that opposer's claim of geographic descriptiveness is deficient because opposer does not "specifically assert that the 'primary' significance of the mark PINNACLES RANCHES is a 'generally known' geographic location" (emphasis in original).

Opposer argues, however, that its fraud claim is sufficiently pled, and implicitly that applicant had a duty to inform the Office of the alleged geographic significance of its mark. Opposer also argues that its allegation of geographic descriptiveness is sufficient, and that a specific allegation that PINNACLES RANCHES is a "generally known" geographic location is unnecessary.

Decision

The standard for evaluating applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) is as follows:

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief, sought. See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); Kelly

Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992); and TBMP §503.02 (2d. ed. rev. 2004). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); see also 5A Wright & Miller, Federal Practice And Procedure: Civil 2d §1357 (1990). ... The purpose of a Rule 12(b)(6) motion is to challenge "the legal theory of the complaint, not the sufficiency of any evidence that might be adduced" and "to eliminate actions that are fatally flawed in their legal premises and destined to fail ..." Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra at 26 USPQ2d 1041.

Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536, 1538 (TTAB 2007); see also, Young v. AGB Corp., 152 F.3d 1377, 1379, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998).

Turning first to opposer's fraud claim, which, as noted above, is essentially identical to the fraud claim discussed in the Prior Order, we find that it too is insufficiently pled for the reasons stated in the Prior Order. In fact, as held in the Prior Order, applicant had no obligation, statutory or otherwise, to disclose the alleged geographic significance of PINNACLE or PINNACLES to the Office.

The position of the Trademark Trial and Appeal Board is fallacious in that it is based on the assumption that registrant

had a "duty" to disclose to the Patent Office that the Italian word "fiocco" meant staple rayon. No authority is cited by the board for this proposition. Any "duty" owed by an applicant for trademark registration must arise out of the statutory requirements of the Lanham Act ... The mere withholding of information as to the meaning of the Italian word "fiocco" is not such a fraudulent withholding of information as to warrant cancellation of the mark.

Bart Schwartz International Textiles, Ltd. v. Federal Trade Commission, 289 F.2d 665, 129 USPQ 258, 260 (CCPA 1961); see also, Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde, 6 USPQ2d 1205, 1209 (TTAB 1988) ("As to the allegation that applicant committed fraud by failing to advise the Examining Attorney that DOURTHE is a surname with no other significance, we note that in the examination process it is the burden of the Examining Attorney to prove that a mark is primarily merely a surname."); Pennwalt Corp. v. Sentry Chemical Co., 219 USPQ 542, 553 (TTAB 1983) (applicant not obligated to disclose whether use of term is in compliance with statute or regulation, absent inquiry by Office); DS Waters of America, Inc. v. Princess Abita Water, L.L.C., 539 F.Supp.2d 853, (E.D. La. 2008) (even if ABITA SPRINGS water is not from Abita Springs, failure to disclose this fact does not constitute fraud on the Office or inequitable conduct). Accordingly, applicant's motion to dismiss Count III of the notice of opposition is hereby **GRANTED**.

Turning next to Count I, alleging that applicant's mark is primarily geographically descriptive under 15 U.S.C. § 1052(e)(2), we find that this claim is adequately pled. Opposer alleges that PINNACLES RANCHES is "primarily geographically descriptive of the location of origin of Applicant's wine," specifically "an area in Monterey County, California known as 'Pinnacles Ranch.'" Notice of Opposition ¶ 7. Opposer further alleges that "consumers will correctly perceive the term as the name of a geographic location." Id. ¶ 8. This is enough, especially where opposer specifically cites the applicable statutory provision. Applicant's argument that opposer failed to allege that the "primary" significance of the mark is a geographic location is belied by opposer's specific allegation that "the primary significance of 'Pinnacles Ranches' is the name of a geographic location." Id. ¶ 11. Applicant's argument that opposer failed to allege that the geographic location is "generally known" is belied by opposer's allegations that the "primary significance" of PINNACLES RANCHES is geographic, and that "consumers will correctly perceive the term as the name of a geographic location." Id. ¶¶ 8, 11. Applicant, like the applicant in Fair Indigo, "has confused the requirements for pleading" with "the requirements for proving," at trial, opposer's claims. Fair Indigo, 85 USPQ2d at 1538. Accordingly,

applicant's motion to dismiss Count I of the notice of opposition is **DENIED**.

Conclusion

Applicant's motion to dismiss Count III of the notice of opposition is granted and its motion to dismiss Count I is denied. Applicant is allowed until **December 7, 2009** to answer the remaining portions of the notice of opposition. Proceedings herein are resumed, and disclosure, conferencing, discovery and trial dates are reset as follows:

Time to Answer	December 7, 2009
Deadline for Discovery Conference	January 6, 2010
Discovery Opens	January 6, 2010
Initial Disclosures Due	February 5, 2010
Expert Disclosures Due	June 5, 2010
Discovery Closes	July 5, 2010
Plaintiff's Pretrial Disclosures	August 19, 2010
Plaintiff's 30-day Trial Period Ends	October 3, 2010
Defendant's Pretrial Disclosures	October 18, 2010
Defendant's 30-day Trial Period Ends	December 2, 2010
Plaintiff's Rebuttal Disclosures	December 17, 2010
Plaintiff's 15-day Rebuttal Period Ends	January 16, 2011

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

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on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
