

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

Baxley

Mailed: December 21, 2010

Opposition No. **91190791**

Opposition No. **91192828**

Cancellation No. **92049013**

Contessa Premium Foods, Inc.

v.

Ina Garten, LLC

Before Walters, Walsh and Mermelstein,
Administrative Trademark Judges.

By the Board:

In these consolidated proceedings, Contessa Premium Foods, Inc. ("plaintiff") opposes registration of Ina Garten, LLC's ("defendant") application to register the mark BAREFOOT CONTESSA in standard character form for various goods in International Classes 29 and 30¹ and application to register the same mark for various goods in International

¹ Application Serial No. 77550245, filed August 19, 2008, for "jams; curds; fruit preserves" in International Class 29 and "dessert mousse mixes; pudding mixes; mixes for bakery goods; cake mixes; cookie mixes; frosting mixes; icing mixes; pancake mixes; waffle mixes; muffin mixes; marshmallow mixes; coffee; chocolate; hot chocolate; flavoring syrups; topping syrups" in International Class 30. The application is based on an assertion of a bona fide intent to use the mark in commerce on "dessert mousse mixes; pudding mixes." With regard to the remaining goods, the application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), with defendant alleging March 2006 as the date of first use anywhere and date of first use in commerce. This application is the subject of Opposition No. 91190791.

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Classes 29 and 30.² Plaintiff also petitions to cancel defendant's registration for the mark BAREFOOT CONTESSA in typed form for goods in International Classes 29, 30, 31, and 32 and "retail store services featuring gourmet foods and books" in International Class 35.³ As grounds for opposition and cancellation, plaintiff alleges that: (1) defendant committed fraud by making material

² Application Serial No. 77526128, filed July 18, 2008, for "fruit-based snack foods; potato-based snack foods; vegetable-based snack foods; nut and seed-based snack bars; snack mix consisting primarily of processed fruits, processed nuts and/or raisins; processed nuts; dips; dairy-based snack foods excluding ice cream, ice milk and frozen yogurt" in International Class 29 and "grain-based snack foods; grain-based chips; grain-based food bars also containing dried fruits and nuts; granola snacks; snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn; snack cakes; cookies; crackers; bakery goods; bakery desserts; dessert puddings; brownies; candy; salad dressings; sauces; marinades; spice rubs; flavor enhancers used in food products; frozen appetizers consisting primarily of dough" in International Class 30. This application is based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), and is the subject of Opposition No. 91192828.

³ Registration No. 2892226, issued October 12, 2004, based on a use-based application filed on November 22, 2000. In addition to the recited services, the goods identified therein are: "dips, namely, vegetable, yogurt, fish and herb based dips; hummus, chili, stews ribollita, soups, namely, gazpacho and chowders; salads except macaroni, rice and pasta; cranberry sauce; apple sauce, dried fruits, processed nuts, candied nuts, snack mix consisting primarily of processed fruits, processed nuts and/or raisins; processed peas with wasabi flavoring" in International Class 29, "vegetable strudel, vegetable cobblers, spring rolls, coffee, bread crumbs, croutons, granola, cakes, namely sour cream coffee cake; candy, namely, strawberry flavored laces; quesadilla, salsa" in International Class 30, "fresh vegetables and fresh nuts" in International Class 31, and "orange juice, grapefruit juice, lemonade; non-alcoholic cocktail mixes" in International Class 32. As the dates of first use anywhere and dates of first use in commerce, defendant alleges 1979 for International Classes 29 and 30, 1994 for International Class 31, 1997 for International Class 32, and 1978 for International Class 35.

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misrepresentations of fact regarding goods on which defendant used or had a bona fide intent to use the involved BAREFOOT CONTESSA mark; and (2) dilution by blurring of plaintiff's allegedly "famous" trademark CONTESSA for "food products." Defendant, in its answers, denied the salient allegations of the notices of opposition and the amended petition to cancel. The Board consolidated these proceedings in a December 29, 2009, order.

On June 17, 2010, defendant filed a motion for summary judgment in its favor on plaintiff's pleaded grounds of fraud and dilution. In response thereto, plaintiff filed (1) a brief in response to the motion for summary judgment on the dilution ground, and (2) a motion to take additional discovery under Fed. R. Civ. P. 56(d)⁴ with regard to the fraud ground. The motion for Rule 56(d) discovery and the motion for summary judgment on the dilution ground have been fully briefed.

We note initially that plaintiff's bifurcated briefing in response to the motion for summary judgment is inappropriate. Plaintiff may file only one brief not to exceed twenty-five pages in response to the motion for summary judgment. See Trademark Rules 2.127(a) and 2.127(e)(1). Thus, even if plaintiff could respond on the merits to defendant's motion for summary judgment on the

⁴ Formerly Fed. R. Civ. P. 56(f).

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dilution ground, plaintiff should have waited until the Board had first decided the motion for Rule 56(d) discovery on the fraud ground, and then filed a single brief in response to the motion for summary judgment that addressed both the fraud and dilution grounds.

In addition, we have *sua sponte* reviewed the claims set forth in the operative complaints herein. Regarding plaintiff's pleaded fraud claims in each of the operative complaints, fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of specific facts in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). Because intent is a required element to be pleaded for a claim of fraud, allegations that a party made material representations of fact that it "knew or should have known" were false or misleading are insufficient. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Further, pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are also insufficient.

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See *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009).

Addressing, first, the fraud claims in the notice of opposition in Opposition No. 91190791 and the amended petition to cancel in Cancellation No. 92049013, plaintiff alleges in relevant part that defendant made representations of fact in its involved application Serial No. 77550245 and the application for involved Registration No. 2892226 regarding certain specific goods on which defendant either was using or had a bona fide intent to use the involved BAREFOOT CONTESSA mark; and that, "[b]ased on the result of research conducted by [plaintiff], and based on [plaintiff's] current awareness of [defendant's] business activities at the time the [involved a]pplication was filed," defendant was not using the mark on certain specific goods and did not have a bona fide intent to use the mark on certain other specific goods at the time such applications were filed. Notice of opposition of Opposition No. 91190791 at paragraphs 1-5, amended petition to cancel of Cancellation No. 92049013 at paragraphs 1-6. Plaintiff further "alleges on information and belief" that defendant made such material representations of fact that it "knew or should have known were false" and that defendant made these representations of fact with the intent of inducing the USPTO to approve the applications for publication. Notice

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of opposition of Opposition No. 91190791 at paragraphs 6-7, amended petition to cancel of Cancellation No. 92049013 at paragraphs 7-8. These allegations are insufficient pleadings of fraud claims because plaintiff has merely alleged "upon information and belief" that defendant made material representations of fact that it "knew or should have known" were false. Further, plaintiff has not alleged that respondent either had actual knowledge that that the representations at issue were false or that respondent made those representations with reckless disregard as to their truth or falsity.⁵ See *In re Bose Corp.*, *supra*.

Accordingly, the pleaded fraud claims in Opposition No. 91190791 and Cancellation No. 92049013 are insufficient.

Turning next to the pleaded fraud claim in Opposition No. 91192828, such claim is based on an allegation of a knowingly false representation of material fact regarding defendant's bona fide intent to use the mark on certain specified goods identified in involved application Serial No. 77526128 with the intent of inducing the USPTO to

⁵ Although the allegations are made "upon information and belief," such allegations are based in addition on "research conducted on behalf of [plaintiff] and ... [plaintiff's] current awareness of [defendant's] business activities at the time the [involved application] was filed." Notice of opposition of Opposition No. 91190791 at paragraphs 4-5; amended petition to cancel of Cancellation No. 92049013 at paragraphs 3-6. See *Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold LLC*, 95 USPQ2d 1185 (TTAB 2010).

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approve the application for publication.⁶ However, such claim is based solely upon information and belief.⁷

Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold LLC, supra; Asian and Western Classics B.V. v. Selkow, supra at 1479. Accordingly, the pleaded fraud claim in Opposition No. 91192828 is insufficient.

Based on the foregoing, plaintiff has failed to plead a fraud claim in any of the above-captioned proceedings. Because a party cannot obtain judgment on an unpleaded claim, defendant's motion for summary judgment on the fraud claims and petitioner's motion for Rule 56(d) discovery on that claim are both moot. However, plaintiff may, within thirty days from the mailing date set forth in this order, file amended pleadings stating proper claims of fraud.

Turning to plaintiff's pleaded dilution claims, such claims require allegations that: (1) the plaintiff's mark is famous and distinctive; (2) the plaintiff's mark(s)

⁶ We note, however, that the allegations in paragraphs 5-7 combining the references "material misrepresentation," "knew that the statement was false," and "with the intent to induce ... the USPTO to grant the [a]pplication" constitute an allegation of defendant's intent. See *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086 (TTAB 2010).

⁷ To prevail on a fraud claim based on an allegedly false assertion of a bona fide intent to use a mark in commerce, plaintiff must plead and later establish not only a lack of a bona fide intent to use the mark at the time the application was filed, but must also establish that defendant knowingly made the false statement of a bona fide intent to use the mark in commerce with an intent to deceive the USPTO. See *SmithKline Beecham Corp. v. Omnisource DDS, LLC*, ___ USPQ2d ___ (TTAB, Opposition No. 91178539, December 10, 2010).

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became famous prior to the defendant's date of first use or constructive first use date of its involved marks; and (3) registration of the defendant's marks would dilute the distinctive quality of the plaintiff's famous mark(s). See *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

Plaintiff has adequately pleaded dilution claims with regard to its CONTESSA mark for "food products" in paragraphs 8-9 of the notice of opposition of Opposition No. 91190791 and in paragraphs 9-10 of the amended petition to cancel in Cancellation No. 92049013. However, because plaintiff has not alleged in the notice of opposition of Opposition No. 91192828 that its pleaded CONTESSA marks are famous and that they became famous prior to use or constructive use of the mark, the dilution claim in that proceeding is insufficient. Accordingly, we will consider respondent's motion for summary judgment with regard to the dilution claims in Opposition No. 91190791 and Cancellation No. 92049013 only. Defendant's motion for summary judgment in Opposition No. 91192828 on plaintiff's pleaded dilution claim is moot. Applicant may, within thirty days from the mailing date set forth in this order, file an amended pleading alleging a proper claim of dilution in Opposition No. 91192828.

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Regarding defendant's motion for summary judgment on the dilution claims in Opposition No. 91190791 and Cancellation No. 92049013, summary judgment is appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

Defendant seeks entry of summary judgment in its favor on the dilution claims in Opposition No. 91190791 and 92049013 on the grounds that plaintiff's pleaded marks are not famous and that the marks at issue are not substantially similar.⁸ After reviewing the parties' arguments and

⁸ In determining whether a mark or trade name is likely to cause dilution by blurring, the Board may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

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evidence, we find that disposition of the dilution claims in Opposition Nos. 91190791 and 92049013 is unwarranted. At a minimum, there are genuine issues of material fact as to whether plaintiff's pleaded CONTESSA marks are famous and as to whether plaintiff's CONTESSA marks and defendant's BAREFOOT CONTESSA marks are substantially similar to the extent required to establish dilution.⁹

In view thereof, defendant's motion for summary judgment in its favor on plaintiff's pleaded dilution claims in Opposition No. 91190791 and Cancellation No. 92049013 is denied.¹⁰

In view of the Board's general practice of allowing plaintiffs whose claims have been found insufficient an opportunity to file an amended complaint which corrects

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

Trademark Act Section 43(c)(2)(B), 15 U.S.C. Section 1125(c)(2)(B).

⁹ The fact that we have identified and discussed only these genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are the only issues which remain for trial.

¹⁰ The evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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noted defects, plaintiff is allowed until thirty days from the mailing date set forth in this order to file amended notices of opposition in Opposition Nos. 91190791 and 91192828 and an amended petition to cancel in Cancellation No. 92049013 which correct the noted pleading defects in both its fraud claims and the dilution claim set forth in Opposition No. 91192828.¹¹ Defendant is allowed until thirty days from the date of service of such amended complaints to file separate answers thereto. The parties are allowed until thirty days from the mailing date set forth in this order to serve responses to any outstanding interrogatories and document requests. Remaining dates herein are reset as follows.

Expert Disclosures Due	1/25/11
Discovery Closes	2/24/11
Plaintiff's Pretrial Disclosures	4/10/11

¹¹ Plaintiff is reminded that, under Trademark Rule 11.18(b), [b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP Section 527.02 (2d ed. rev. 2004). Accordingly, unless plaintiff knows of facts that support each claim it intends to raise herein or has a good faith belief that evidence showing the factual basis for those claims is likely to be obtained after a reasonable opportunity for discovery or investigation, it should withdraw those claims.

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Plaintiff's 30-day Trial Period Ends	5/25/11
Defendant's Pretrial Disclosures	6/9/11
Defendant's 30-day Trial Period Ends	7/24/11
Plaintiff's Rebuttal Disclosures	8/8/11
Plaintiff's 15-day Rebuttal Period Ends	9/7/11

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

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.