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

Proceeding	91197089
Party	Defendant A. Stein Meat Products, Inc.
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Attachments	Reply Memorandum ISO Motion to Amend.pdf ( 8 pages )(57242 bytes )

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

In re Application Serial No. 77/750,645  
Filed: June 3, 2009  
For Mark: BROOKLYN BURGER (Stylized)  
Published in the Official Gazette: April 27, 2010

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LOS ANGELES DODGERS, LLC,	:	
	:	
Opposer,	:	Opposition No. 91197089
	:	Serial No. 77750645
v.	:	
	:	
A. STEIN MEAT PRODUCTS, INC.,	:	
	:	
Applicant.	:	
	:	
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**APPLICANT’S REPLY BRIEF IN SUPPORT OF ITS CROSS-MOTION FOR LEAVE  
TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIMS**

In its Opposition to Applicant’s motion to amend, Opposer relies on sporting fans’ interest in nostalgia. The Trademark Law, however, protects current use of trademarks. It does not serve merely to maintain nostalgia of bygone days. In order to obtain a trademark registration, an Applicant must first allege actual and current use of the mark in interstate commerce. To maintain the registration, the Applicant must file an affidavit of continuing use. The Principal Register of the Trademark Office is no place for nostalgia.

Nevertheless, at this stage of the proceedings, the only issue is the sufficiency of the pleadings, not the likelihood of success on the merits. Most of Opposer’s arguments address the merits of the counterclaims, not the sufficiency of the pleadings. Because the alleged deficiencies in the original Counterclaims have been cured by the amended Counterclaims,

Opposer's motion to dismiss should be denied, Applicant's motion to amend should be granted, and the suspension of these proceedings should be lifted.

The bases for Opposer's opposition to Applicant's motion to amend are: (1) the proposed amended Counterclaims fail to allege two supposed "essential elements" of the claims, namely, that "a substantial portion of the relevant consumers is likely to be deceived" and "the goods 'have no significant connection' with Brooklyn"; and (2) proposed factual allegations are not supported by evidence. Neither assertion provides a basis to deny Applicant's motion to amend. The so-called "extra elements" are not required to be pled. In addition, Applicant is not required to plead evidentiary matters in the Counterclaims.

**A. Applicant Is Entitled To Amend Under Rule 15(a)(1), Fed. R. Civ. P.**

Rule 15(a) of the Federal Rules of Civil Procedure provides that leave to amend "shall be freely given when justice so requires." *Foman v. Davis*, 371 U.S. 178, 182 (1962) ("this mandate is to be heeded"). Indeed, "the Board ... has recognized that 'amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (TTAB 1993). Opposer has not alleged that the proposed amendments would violate settled law, or that Opposer would suffer any prejudice by the amendments. For this reason alone, the motion to amend should be granted.

Moreover, Applicant was not required to file a *motion* to file an amended answer and counterclaims, because the Federal Rules permit Applicant to file an amended pleading once as a matter of right, within 21 days after service of Opposer's motion to dismiss. Fed. R. Civ. P.

15(a)(1)(B). Applicant's proposed amended pleading was filed within 21 days after service of Opposer's motion to dismiss. Therefore, the amendments should be allowed as of right.

**B. Applicant Has Pled All Elements of the Counterclaims In Sufficient Detail**

Opposer argues that Applicant's factual allegations (such as "Opposer's goods do not originate in Brooklyn") are "unsupported by any factual allegations." (Opposer's Reply Brief (hereafter "Br.") at 4.) This argument makes no sense because the allegations are factual. Moreover, Applicant is not required to plead evidentiary matters, as they are matters of proof not pleading. See T.B.M.P. § 309.03(a)(2) (citing *McCormick & Company v. Hygrade Food Products Corp.*, 124 U.S.P.Q. 16, 17 (TTAB 1959)); T.B.M.P. § 503.02 (plaintiff need not submit proofs to support its claims).

In response to Applicant's motion to amend, Opposer argues the merits of the counterclaims, rather than providing any basis for denial of the motion. Thus, Opposer essentially argues that the amended counterclaims should be dismissed for failure to state a claim for relief, pursuant to Rule 12(b)(6), Fed. R. Civ. P. When deciding a motion to dismiss, the Board must accept well-pleaded allegations as true. T.B.M.P. § 503.02; *Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1999). Thus, Opposer's belief that Applicant's allegations will "fail on their face" for lack of evidence is not relevant to the motion to amend. At this stage, the Board must presume that the allegations are true.

The elements of a claim for cancellation based on geographically deceptively misdescriptiveness are:

- (1) the primary significance of the mark is a generally known geographic location,
- (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the good bearing the mark, when in fact the goods do not

come from that place, and (3) the misrepresentation was a material fact in the consumer's decision.

*In re California Innovations, Inc.*, 329 F.3d 1334, 1341 (Fed. Cir. 2003). All required elements have been pled by Applicant. Opposer's assertion that the Federal Circuit added an additional element – that a substantial portion of the relevant consumers is likely to be deceived – is incorrect. (Br. at 5 (citing *In re Spirits International, N.V.*, 563 F.3d 1347, 1353 (Fed. Cir. 2009))). *Spirits International* concerned the appropriate inquiry for determining materiality (the third claim element listed above) where the mark at issue was a foreign language mark. The case did not alter the pleading requirements for geographically deceptively misdescriptive marks. See, e.g., *Guantanamera Cigar Co. v. Corporacion Habanos, S.A.*, 729 F.Supp.2d 246, 252 (D.D.C. 2010) (the elements set forth in *California Innovations* constitute the proper legal standard); *In re Jonathan Drew, Inc. d/b/a Drew Estate*, 97 U.S.P.Q.2d 1640, 2011 WL 481329 (T.T.A.B. 2011) (citing the same standard).

Further, Opposer asserts that an “essential and missing element” from Applicant's counterclaims is an allegation that “the goods have no significant connection with Brooklyn at all.” (Br. at 5.) However, as stated above, the three elements of the claim have been pled, and the so-called missing element referred to by Opposer is not an element of the claim. Notably, Opposer has not cited any case law to support its assertion that such allegation is a required element of the claim. The cases relied upon by Opposer do not alter the legal standard for geographically deceptively misdescriptive marks. *In re Opryland USA Inc.*, 1 U.S.P.Q.2d 1409 (T.T.A.B. 1986), is inapplicable because it predates NAFTA, which changed the Lanham Act, and, in particular, the standards for determining whether a mark is primarily geographically

deceptively misdescriptive. See *California Innovations*, 329 F.3d at 1336-1342.<sup>1</sup> *In re JT Tobacconists*, 59 U.S.P.Q.2d 1080 (T.T.A.B. 2001), also is inapplicable because it did not involve standards for allegations that a mark is geographically deceptively misdescriptive, but rather involved the determination of whether the mark was primarily geographically descriptive. Further in *JT Tobacconists*, the “Minnesota Cigar Company” goods were packaged and shipped from Minnesota (the geographic location at issue). Likewise, *In re Joint-Stock Company Baik*, 80 U.S.P.Q.2d 1305, 1310 (T.T.A.B. 2006), is readily distinguishable for nearly the same reasons, i.e. because (a) the case did not involve an analysis of the standards for allegations that a mark is geographically deceptively misdescriptive, but rather involved the determination of whether the mark was primarily geographically descriptive; and (b) the goods at issue contained an ingredient which indeed originated in the geographic region at issue. Finally, *In re Spirits of New Merced, LLC*, 85 U.S.P.Q.2d 1614 (T.T.A.B. 2007), also is distinguishable for the same reasons. In *Spirits of New Merced*, the Board found on the merits “that the goods come from Yosemite.” *Id.* at 1621. Importantly, none of these cases alters the standards test set forth in *California Innovations*, or replaces the “geographic origin” allegation with a more loosely defined allegation of “connection” or “relationship” with a geographic location. Therefore, there is no basis for Opposer’s assertion that the required elements of the Counterclaims have not been pled, or have not been pled adequately.

Opposer relies on *Major League Baseball v. Sed Non Olet Denarius*, 817 F. Supp. 1103, 1133 (S.D.N.Y. 1993), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994), for its

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<sup>1</sup> *Opryland USA* also did not involve a geographically deceptively misdescriptive analysis, but rather a primarily geographically descriptive analysis. Further, in *Opryland USA*, the “Nashville Network” had its corporate offices in Nashville, produced a not insubstantial portion of its programs in Nashville, and transmitted its television signal from Nashville, which indicated that its services originated from Nashville. 1 U.S.P.Q.2d at 1412.

suggestion that Applicant's counterclaims will not succeed on the merits. But the Board's inquiry at this stage is not whether the counterclaims will ultimately prove successful, but rather whether the amended counterclaims state a claim for relief. Moreover, Opposer's reliance on *Sed Non Olet* contradicts arguments that it made to the Board in support of its motion to strike the affirmative defense set forth in paragraph 13 of Applicant's First Amended Answer and Counterclaims.<sup>2</sup> In those arguments, Opposer asserted that the *Sed Non Olet* decision is not precedential, and also allegedly has no persuasive effect.<sup>3</sup> Opposer cannot have it both ways. Apparently, Opposer now agrees that the *Sed Non Olet* decision indeed has persuasive effect.<sup>4</sup>

### **C. Applicant's Unclean Hands Defense Is Adequately Pled**

Opposer has argued that Applicant's unclean hands defense as set forth in paragraph 14 of the First Amended Answer and Counterclaims allegedly would not survive a motion to strike and, therefore, should not be allowed, because it is duplicative of the counterclaims and attacks the validity of the registrations. Neither contention requires that the affirmative defense be stricken. An allegation that Opposer's rights are premised on deceptive conduct (including geographically deceptive conduct), renders unclean hands an available defense to Opposer's

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<sup>2</sup> Paragraph 13 of Applicant's First Amended Answer and Counterclaims reads as follows: "Opposer's marks which are the subject of U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 are entitled only to a narrow scope of protection. See *Major League Baseball v. Sed Non Olet Denarius*, 817 F. Supp. 1103, 1133 (S.D.N.Y. 1993), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994)."

<sup>3</sup> In *Sed Non Olet*, the Court held that Opposer abandoned its trademarks long ago, and resumed use in a very limited manner which "dramatically" narrowed the scope of protection to which its marks were entitled. 563 F.3d at 1134.

<sup>4</sup> The *Sed Non Olet* decision, however, is not persuasive (nor preclusive) as to the issue of geographically deceptively misdescriptive, as the Court in that case did not discuss that issue, but rather summarily denied the counterclaims without any discussion or legal analysis.

claim for equitable relief. *Havana Club Holding, S.A. v. Galleon, S.A.*, 1998 WL 150983 at \*5, 49 U.S.P.Q.2d 1296 (S.D.N.Y. 1998).

### CONCLUSION

Applicant respectfully requests that the Board grant its motion to amend. In its opposition to Applicant's motion to amend, Opposer raised issues regarding the sufficiency of the pleadings under Rule 12(b)(6), Fed. R. Civ. Therefore, the issues raised by Opposer are before the Board, and should be decided in favor of Applicant for the reasons stated herein. Applicant further requests that the suspension of these proceedings be lifted so that discovery may commence.

Respectfully submitted,  
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/Robert T. Maldonado/

Dated: March 1, 2011

By: \_\_\_\_\_  
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **APPLICANT'S REPLY BRIEF IN SUPPORT OF ITS CROSS-MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIMS** was served on this 1st day of March, 2011 by First Class mail on the following attorney for Opposer:

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