

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

Goodman

Mailed: September 8, 2011

Opposition No. **91197089**

Los Angeles Dodgers LLC

v.

A. Stein Meat Products, Inc.

Before Quinn, Kuhlke, and Mermelstein, Administrative
Trademark Judges.

By the Board:

On December 2, 2010, applicant filed its answer and counterclaim, seeking to cancel opposer's pleaded registrations (Registration Nos. 1562301, 1571978, 1859757, 3633244, and 3797654). In lieu of filing an answer to the counterclaim, opposer filed, on January 5, 2011, a motion to dismiss under Fed. R. Civ. P. 12(b)(6). Applicant responded to the motion to dismiss by filing a cross-motion for leave to file an amended answer and counterclaim, accompanied by the amended answer and counterclaim, arguing that the motion to dismiss was now moot. In reply and in response to the cross-motion, opposer argues that applicant has conceded the motion to dismiss and that its motion for leave to amend should be denied because "the repleaded counterclaims fail to state a claim upon which relief can be granted." Opposer

also maintains its motion to strike the affirmative defense set out in paragraph 13 of the amended pleading, (paragraph 16 of applicant's original pleading), and now seeks to strike applicant's newly pleaded unclean hands defense, set out in paragraph 14 of the amended pleading.

A plaintiff to a Board proceeding may respond to a motion to dismiss by filing an amended complaint. If the amended pleading sets forth and states a claim upon which relief can be granted, the motion to dismiss normally will be moot. See TBMP Section 503.03 (3d ed. 2011).

Because it is clear that the first amended answer and counterclaim is intended to supersede the answer and counterclaim, we will consider whether the motion to dismiss is moot in view of the first amended answer and counterclaim.

We now turn our consideration to whether the amended counterclaim is legally sufficient.

In its amended counterclaim, applicant alleges that opposer's Registrations Nos. 1562301, 1571978, 1859757 are geographically deceptive under Section 2(a) and that opposer's Registration Nos. 3633244, and 3797654 are geographically deceptive under Section 2(a) and primarily geographically deceptively misdescriptive under Section 2(e)(3).

Opposer argues, in reply to its motion to dismiss and in response to applicant's cross-motion for leave to amend, that applicant's allegations in the amended counterclaim are "bald allegations of elements of the claims . . . unsupported by any factual allegations" and that applicant has failed to allege that a "substantial portion of the relevant consumers is likely to be deceived."

In reply to its motion for leave to amend, applicant argues that the "so-called 'extra elements' are not required to be pled" nor are "evidentiary matters," and that it has pled all elements of the counterclaims in sufficient detail. Applicant further submits that opposer's arguments going to the merits of these claims do not provide a basis for denying leave to amend.

To the extent that opposer has argued the merits of applicant's claims in its motion to dismiss and in response to applicant's cross-motion for leave to amend, such arguments have not been considered. In considering a motion to dismiss or a motion for leave to amend, the Board is limited to consideration of the legal sufficiency of the complaint. TBMP Sections 503.02 and 507.02 (3d ed. 2011).

The allegations required to plead a claim that a mark is geographically deceptive under Section 2(a) or a claim that a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3) are the same. See

United States Playing Card Co. v. Harbro, LLC, 81 USPQ2d 1537, 1540 (TTAB 2006), citing *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003) ("the Court of Appeals for the Federal Circuit held that the test for determining whether a mark is geographically deceptive under Section 2(a) is the same as determining whether a mark is primarily geographically deceptively misdescriptive under Section 2(e)(3).").¹

To properly allege that opposer's marks are geographically deceptive, or primarily geographically deceptively misdescriptive, applicant must allege that (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 goods bearing the mark, when in fact the goods do not come from that place, and (3) the misrepresentation would be a material factor in the consumer's decision to purchase the goods. *In re California Innovations*, 66 USPQ2d at 1854 (setting forth the same standard for geographically

¹ With respect to applicant's geographically deceptive and primarily geographically deceptively misdescriptive claims for Registration Nos. 3633244, and 3797654, the Board, on summary judgment or final decision, will consider only the Section 2(e)(3) ground. *In re California Innovations Inc.*, 66 USPQ2d at 1853 (court anticipates that "the PTO will usually address geographically deceptive marks under subsection 2(e)(3) of the amended Lanham Act rather than subsection 2(a)"). See also *Corporacion Habanos S.A. v. Guantanamera Cigars Co.*, 86 USPQ2d 1473 (TTAB 2008) ("we will give no further consideration to [opposer's] Section 2(a) claim, but consider the Section 2(e)(3) ground").

deceptive and primarily geographically deceptively misdescriptive marks).

In this case, applicant has alleged, among other things, that "[t]he primary significance of the marks which are the subject of Opposer's Trademark Registrations is a generally known geographic location, i.e., Brooklyn, New York"; that "the goods which are recited in Opposer's Trademark Registrations . . . do not originate in Brooklyn New York"; that "purchasers would be likely to believe that the goods originate in Brooklyn, New York"; that "the misrepresentation is likely to affect a consumers' decision to buy the goods"; and that "Opposer has no present connection with Brooklyn New York, and has not had any such connection since its predecessor, the 'Brooklyn Dodgers,' left Brooklyn, New York in 1957" Paragraphs 18-23, amended counterclaim.

We find these allegations sufficient to allege a geographically deceptive claim under Section 2(a) or a primarily geographically deceptively misdescriptive claim under Section 2(e)(3).

In view thereof, applicant's cross-motion for leave to amend is granted, and the amended pleading is accepted. Opposer's motion to dismiss is denied as moot.

We now turn to opposer's motion to strike.

Opposer seeks to strike the affirmative defenses set out in paragraphs 13 and 14 of the amended answer.

The affirmative defense set out in paragraph 13 of the amended answer alleges that "opposer's marks are entitled to a narrow scope of protection." This allegation includes a "see" citation to *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius*, 817 F. Supp. 1103 (S.D.N.Y. 1993), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994).

Opposer argues that the defense is "immaterial and insufficient" and that there is "no cognizable support for its [applicant's] position", arguing the merits of the defense in relation to the cited case.

In response, applicant argues that the "affirmative defense as pled gives Opposer notice of the basis for the defense . . . and there is no basis to strike Applicant's affirmative defense that the subject marks are entitled to a narrow scope of protection."

We find that opposer seeks to strike the affirmative defense on the merits, not based on the sufficiency of the pleading.² Such an argument is premature. Accordingly, the motion to strike the affirmative defense set out in paragraph 13 of the amended answer is denied.

² We find this defense is not a true affirmative defense but an amplification of applicant's denial of likelihood of confusion.

The affirmative defense set out in paragraph 14 of the amended answer alleges that "Opposer's claim is barred by the doctrine of unclean hands by virtue of Opposer's deceptive use of the word Brooklyn in connection with the goods cited in the asserted trademark registrations, which goods do not originate in Brooklyn, New York."

With regard to this defense, opposer references its merits based argument regarding applicant's Section 2(a) and 2(e)(3) claims, also contending that the defense is an improper collateral attack on its pleaded registrations and redundant of the counterclaim.

To the extent that opposer seeks to strike this defense on its merits, the motion is denied. To the extent that opposer argues that this is an improper affirmative defense or redundant of the counterclaim, we find that this affirmative defense may remain inasmuch as opposer has alleged, in addition to ownership of its registrations, common law use of the mark. *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001) (when improper conduct relates to use of the mark, the unclean hands defense may be considered even in relation to rights acquired through use).

In view thereof, opposer's motion to strike the affirmative defense set out in paragraph 14 of the amended answer is denied.

In summary, applicant's motion for leave to file an amended answer and counterclaim is granted. Opposer's motion to dismiss the counterclaim is denied as moot, and opposer's motion to strike the affirmative defenses set out in paragraphs 13 and 14 of the amended answer is denied.

Proceedings are resumed.

Opposer's time to answer the amended counterclaim, the date for the discovery conference, disclosures, discovery, and trial are reset below:

Answer to Counterclaim Due	October 1, 2011
Deadline for Discovery Conference	October 31, 2011
Discovery Opens	October 31, 2011
Initial Disclosures Due	November 30, 2011
Expert Disclosures Due	March 29, 2012
Discovery Closes	April 28, 2012
Plaintiff's Pretrial Disclosures	June 12, 2012
30-day testimony period for plaintiff's testimony to close	July 27, 2012
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	August 11, 2012
30-day testimony period for defendant and plaintiff in the counterclaim to close	September 25, 2012
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	October 10, 2012
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	November 24, 2012
Counterclaim Plaintiff's Rebuttal Disclosures Due	December 9, 2012
15-day rebuttal period for plaintiff in the counterclaim to close	January 8, 2013
Brief for plaintiff due	March 9, 2013
Brief for defendant and plaintiff in the counterclaim due	April 8, 2013

Opposition No. 91197089

Brief for defendant in the counterclaim
and reply brief, if any, for plaintiff
due

May 8, 2013

Reply brief, if any, for plaintiff in
the counterclaim due

May 23, 2013

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.

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.