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

Proceeding	91197089
Party	Plaintiff Los Angeles Dodgers LLC
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Opposer's answer to any remaining counterclaim(s) and the deadlines for discovery and trial be reset.

### **MEMORANDUM IN SUPPORT OF MOTIONS**

As set forth below,<sup>1</sup> Applicant has counterclaimed to cancel all five of Opposer's pleaded registrations for marks comprising or containing the term BROOKLYN ("Opposer's BROOKLYN Registrations") based on geographical deceptiveness under section 2(a) of the Lanham Act and has counterclaimed to cancel two of Opposer's BROOKLYN Registrations, namely Registration Numbers 3,633,244 and 3,797,654, on the additional ground of primarily geographically deceptive misdescriptiveness under section 2(e)(3) of the Lanham Act. Because Applicant fails to allege (and could not allege) the essential elements of these grounds, Applicant's First through Third and Fifth through Eighth Counterclaims should be dismissed.

Applicant has also set forth affirmative defenses against Opposer's claims in the Notice of Opposition. The defenses set forth in paragraphs 13 and 14 of the Answer merely restate Applicant's counterclaims on the grounds of geographic deceptiveness and primarily geographically deceptive misdescriptiveness and thus should be stricken as procedurally impermissible and redundant; moreover, the defenses are conclusory without any factual support and constitute improper attacks on the validity of Opposer's BROOKLYN Registrations. The abandonment defense set forth in paragraph 15 of the Answer similarly should be stricken as procedurally impermissible and redundant of Applicant's Fourth Counterclaim, as conclusory because it is without factual support and as an improper attack on the validity of Opposer's Registration Number 1,859,757. The purported "defense" set forth in paragraph 16 of the

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<sup>1</sup> The facts upon which these motions are based are taken from Opposer's Notice of Opposition dated October 25, 2010 and Applicant's Answer To Notice of Opposition and Counterclaims for Cancellation dated December 2, 2010.

Answer to narrow the scope of Opposer's Registrations based upon a vacated District Court decision should be stricken as immaterial and insufficient. Finally, the laches, estoppel and acquiescence defenses set forth in paragraph 17 of the Answer should be stricken because "Applicant's longstanding, continuous use" of its mark since 2006, its stated basis for the defenses, is irrelevant to these defenses, which are measured from the time that Applicant's mark was published for opposition, not from Applicant's claimed first use date, and thus, no basis remains for Applicant's defenses.

**I. Applicant's Counterclaims Based on Geographic Deceptiveness and Primarily Geographically Deceptive Misdescriptiveness Should Be Dismissed for Failure to State a Claim**

Applicant has pled counterclaims for geographical deceptiveness pursuant to section 2(a) of the Lanham Act against each of Opposer's BROOKLYN Registrations in Applicant's First, Second, Third, Fifth and Seventh Counterclaims. Additionally, in its Sixth and Eighth Counterclaims, Applicant has pled counterclaims against two of Opposer's BROOKLYN Registrations, namely Registration Numbers 3,633,244 and 3,797,654 on the ground of primarily geographically deceptive misdescriptiveness. None of these counterclaims state a claim because Applicant fails to allege any of the essential elements of such claims; indeed, Applicant alleges no facts whatsoever to support such claims. Instead, for each counterclaim Applicant merely alleges the same conclusory, wholly unsupported allegations that the mark is either "geographically deceptive" and/or "primarily geographically deceptively misdescriptive."

The elements that establish geographic deceptiveness under section 2(a) and primarily geographically deceptive misdescriptiveness under section 2(e)(3) are the same and are "focuse[d] on deception of, or fraud on, the consumer." *In re California Innovations, Inc.*, 329 F.3d 1334, 1339, 66 USPQ2d 1853(Fed. Cir. 2003)(vacating and remanding a finding that

CALIFORNIA INNOVATIONS was primarily geographically deceptively misdescriptive for thermal bags for food and thermal wraps for cans not originating in California). Three elements must be shown for each ground:

- (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 was a material factor in the consumer's decision.

*Id.* at 1341. Additionally, the Federal Circuit requires inquiry into “whether a substantial portion of the relevant consumers is likely to be deceived.” *In re Spirits International, N.V.*, 563 F.3d 1347, 1353, 90 USPQ2d 1489(Fed. Cir. 2009) (vacated and remanded; finding that MOSKOVSKAYA was primarily geographically deceptively misdescriptive for vodka not produced or sold in Moscow or with any other connection to Moscow).

Here, Applicant's First, Second, Third, Fifth, Sixth, Seventh and Eighth Counterclaims, based on geographic deceptiveness or primarily geographically deceptive misdescriptiveness, fail to allege any facts whatsoever that would support the necessary elements of these claims.

Applicant does not (and cannot) allege that the goods bearing the marks covered by Opposer's BROOKLYN Registrations have no connection<sup>2</sup> with the geographical location of Brooklyn, New York. Indeed, there is a strong and well-known historical connection to Brooklyn as the home location of Opposer's historical predecessor team named the BROOKLYN ROBINS, which became the famed BROOKLYN DODGERS team that moved to the West Coast in 1957 to become the current LOS ANGELES DODGERS club owned by Opposer. Nor has Applicant

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<sup>2</sup> The cases make clear that manufacture of goods in a particular place is not the only connection that is considered. *See, e.g., In re Spirits of New Merced*, 85 USPQ2d 1614 (TTAB 2007)(YOSEMITE beer brewed 80 miles away from Yosemite Park had a connection); *In re Joint-Stock Company Baik*, 80 USPQ2d 1305 (TTAB 2006)(water from Lake Baikal as ingredient in BAIKALSKAYA vodka established a connection); *In re JT Tobacconists*, 59 USPQ2d 1080 (packaging and shipping of MINNESOTA CIGAR COMPANY cigars from Minnesota established a connection); *In re Opryland USA, Inc.*, 1 USPQ2d 1409 (NASHVILLE NETWORK for broadcasting relating to Nashville had a connection).

alleged (nor could Applicant allege) that a substantial composite of relevant consumers of Opposer's nostalgia goods, which designate a famous, historical predecessor of Opposer's current club, would believe that the goods actually originate in Brooklyn or that such a belief would be material to their purchase. Indeed, without transgressing Rule 11 pleading rules, it is difficult to imagine how Applicant could make such allegations. Instead, the correct "connection" that the relevant consumers do make is that the goods relate to the historic teams that were once located in Brooklyn and to which interested consumers maintain an allegiance.

Accordingly, Opposer's motion to dismiss Applicant's First, Second, Third, Fifth, Sixth, Seventh and Eight Counterclaims should be granted for failure to state a claim.

**II. Applicant's Affirmative Defenses Set Forth in Paragraphs 13 Through 17 Should Be Stricken As Redundant, Immaterial, Insufficient and/or an Impermissible Attack on Opposer's Registrations**

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." (2d ed. Rev. 2004). *See also* Fed. R. Civ. P. 12(f). Based upon the foregoing, and for the reasons discussed below, the Board should strike the affirmative defenses set forth in paragraphs 13 through 17 of the Answer.

**A. Applicant's Defenses of Geographic Deceptiveness, Primarily Geographic Deceptive Misdescriptiveness and Abandonment Should Be Stricken as Impermissible Attacks on Opposer's Registrations, Insufficient and Redundant**

In paragraph 13 of its Answer, Applicant sets forth an affirmative defense that all of Opposer's BROOKLYN Registrations are geographically deceptive under section 2(a). In paragraph 14 of its Answer, Applicant sets forth an affirmative defense with respect to two of Opposer's BROOKLYN Registrations, namely Registration Numbers 3,633,244 and 3,797,654, on the ground that the marks are primarily geographically deceptively misdescriptive. In

paragraph 15 of its Answer, Applicant sets forth an affirmative defense of abandonment. All three of these defenses should be stricken as improper attacks on the validity of Opposer's BROOKLYN Registrations because it is procedurally inappropriate to attack a pleaded registration except by filing a counterclaim or separate cancellation action. 37 CFR § 2.106(b)(1)(ii) ("An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration."); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 1398, 161 USPQ 46, 46 (CCPA 1969) ("the validity of the registration of a mark may be tested only by a cancellation proceeding"); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 1003, 158 USPQ 101, 104 (CCPA 1968) (allegedly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration); *Contour Chair-Lounge Co. v. The Englander Co.*, 324 F.2d 186, 188, 139 USPQ 285, 287 (CCPA 1963) ("in an opposition, this Court has always held, the validity of the opposer's registrations are not open to attack"); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986) (claims of mere descriptiveness and fraud directed at an opposer's pleaded registration, even if otherwise substantiated, cannot be entertained in the absence of a counterclaim or separate petition for cancellation).

Indeed, Applicant has pleaded counterclaims against Opposer's BROOKLYN Registrations on the same three grounds. Thus, these affirmative defenses should also be stricken because they are redundant. Section 311.02(b) of the TBMP provides "[w]hen a defense is raised by way of a counterclaim, it should not also be pleaded as an affirmative defense, because the pleading of it as an affirmative defense is unnecessary and redundant."

Finally, like their counterpart counterclaims, all three of these defenses as pled consist merely of conclusory allegations without any supporting factual allegations whatsoever and thus

are insufficient because they fail to state a cognizable defense. An affirmative defense should be stricken as insufficient where, as here, it is unclear, nonspecific and conclusory in nature.

*Midwest Plastic Fabricators Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1989)(rejecting affirmative defense of unclean hands as unclear, non-specific and merely conclusory in nature). “Sufficient detail must be given so that [an opposer] may obtain a fair idea of the [applicant’s allegations] and of the legal basis for recovery.” *Id.* Thus, bald allegations that simply copy the language of the Lanham Act without any additional facts, claims or allegations to define, clarify or substantiate them--such as the affirmative defense claims asserted by Applicant here--do not provide fair notice (indeed, any notice) of the basis for such a defense. *McDonnell Douglas Corp. v. Nat’l Data Corp.*, 228 USPQ 45, 47 (TTAB 1985).

For all of the above reasons, the defenses set forth in paragraphs 13, 14 and 15 of the Answer should be stricken as improper, redundant and legally insufficient.

**B. Applicant’s Defense of Narrowing the Scope of Opposer’s Registrations Based Upon a Vacated District Court Decision Should Be Stricken as Insufficient and Immaterial**

In paragraph 16 of its Answer, Applicant asserts a purported “defense” based upon a decision in a vacated District Court opinion and states that the scope of Opposer’s BROOKLYN Registrations should accordingly be narrowed. This “defense” is not a defense at all and is completely insufficient and immaterial to the proceeding. It is well-settled that vacated decisions, such as the one relied upon in Applicant’s Answer, lack any precedential effect whatsoever. *University Book Store v. Board of Regents of the University of Wisconsin System*, 33 USPQ2d 1385, 1394 (TTAB 1994) (Board refused to rely on vacated decision), *citing Durning v. Citibank N.A.*, 950 F.2d 1419, 1424 n.2 (9<sup>th</sup> Cir. 1991) ([“a vacated decision has no precedential authority whatsoever”]), *In re Intelligent Medical Systems, Inc.*, 5 USPQ2d 1674,

1675 n.2 (TTAB 1987) (Board noted that a vacated decision “is not precedent”). Such a decision, therefore, certainly cannot serve as the basis for an affirmative defense to narrow the scope of Opposer’s BROOKLYN Registrations. Moreover, it is clear that, even were the decision precedential, Opposer would not be estopped from relying on the same mark against an entirely different party in different circumstances. *Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.6 (TTAB 1989) (Conclusion in District Court decision that party was licensee of respondent and was estopped from seeking cancellation of its licensor’s mark “is not binding on this Board in a different case involving a different party and a different record”). Accordingly, this defense should be stricken as insufficient and immaterial.

**C. Applicant’s Defenses of Laches, Estoppel and Acquiescence Based Upon Its Use of Its Mark Should Be Stricken as Immaterial and Insufficient**

In paragraph 17, Applicant asserts the defenses of laches, estoppel and acquiescence based on its allegation of use of its mark in commerce since 2006. These defenses cannot stand because it is well settled that these defenses are not measured from when an applicant begins using its mark but, rather, the time in which to challenge the *registration* of a mark begins when a mark is published for opposition since that is the first time that an opposer could challenge registration. *See, e.g., National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1582, 19 USPQ2d 1424 (Fed. Cir. 1991) (measure for laches runs no earlier than publication for opposition, not from knowledge of use); TBMP § 311.02(b), (acquiescence and laches “start to run ... from the time the mark is published for opposition, not from the time of knowledge of use”). Accordingly, these affirmative defenses should be stricken as immaterial and insufficient.

**CONCLUSION**

For all of the foregoing reasons, Applicant's First, Second, Third, Fifth, Sixth, Seventh and Eighth Counterclaims should be dismissed. Additionally, Applicant's affirmative defenses set forth in paragraphs 13 through 17 of its Answer should be stricken. Finally, the proceeding should be suspended pending consideration of the motions and the deadline to answer any remaining counterclaim(s) and the deadlines for discovery and trial should be reset.

Dated: New York, New York  
January 5, 2011

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that, on January 5, 2011, I caused a true and complete copy of the foregoing MOTIONS TO DISMISS COUNTERCLAIMS, TO STRIKE AFFIRMATIVE DEFENSES AND TO SUSPEND PROCEEDINGS to be sent via First Class Mail, postage prepaid, to Applicant's attorney and Correspondent of Record, Robert T. Maldonado , Esq., Cooper & Dunham LLP. 30 Rockefeller Plaza, New York, New York 10112.

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/Robert Riether /

Robert Riether