

ESTTA Tracking number: **ESTTA544733**

Filing date: **06/24/2013**

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

Proceeding	91209303
Party	Defendant BOSCA S.P.A.
Correspondence Address	LORI S MEDDINGS MICHAEL BEST & FRIEDRICH LLP 100 E WISCONSIN AVE STE 3300 MILWAUKEE, WI 53202-4108 UNITED STATES mkeipdocket@michaelbest.com
Submission	Reply in Support of Motion
Filer's Name	Laura M. Konkel
Filer's e-mail	lmkonkel@michaelbest.com, lsmeddings@michaelbest.com, mkeipdocket@michaelbest.com
Signature	/Laura M. Konkel/
Date	06/24/2013
Attachments	06 24 2013 Reply in Support of Motion to Dismiss - VERDI SPUMANTE.PDF(210966 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

Carriage House Imports Ltd.,

Opposer,

v.

Bosca S.p.A.,

Applicant.

Opposition No.: 91209303

Application No.: 85470074

Mark: VERDI SPUMANTE

APPLICANT'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS

Pursuant to 37 C.F.R. § 2.127(a) and Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 502.02(b), Applicant submits this reply to Opposer's Response to Bosca's Motion to Dismiss ("Opposer's Response"). Applicant's Motion to Dismiss asked the Board to dismiss the opposition because (1) it is barred by contractual estoppel, (2) it is barred by licensee estoppel and (3) the Notice of Opposition fails to state likelihood of confusion and fraud claims upon which relief can be granted.

The fatal flaws in Opposer's fraud claim are fully addressed in the Motion to Dismiss and will not be repeated here. It is certain beyond any doubt that Opposer cannot, under any circumstances, prevail on this claim. This is evidenced by Opposer's lack of substantive response to Applicant's arguments on the issue of fraud. *See* Opposer's Response at 12.

All other arguments made in Opposer's Response as to why the Motion to Dismiss should be denied boil down to a single, baseless allegation that Opposer knows to be untrue: that Bosca S.p.A., the owner identified in the '074 Application, and Bosca Cora S.p.A., the owner identified in the '600 Registration and party identified in Opposer's Exclusive Distribution Agreement, *might be* two different entities. Specifically, Opposer argues that its opposition is not barred by

contractual estoppel under the terms of its Exclusive Distribution Agreement because "the Exclusive Distribution Agreement is between Opposer and Bosca Cora S.p.A." and "there is a genuine issue as to whether Bosca Cora S.p.A. and Applicant are the same entity."¹ *Id.* at 7. Second, Opposer argues that its opposition is not barred by licensee estoppel under the terms of its Exclusive Distribution Agreement because "there is a genuine issue as to whether Applicant and Bosca Cora S.p.A. [the named party in the Exclusive Distribution Agreement that grants Opposer its trademark license] are in fact the same entity or two different names for the same entity." *Id.* at 8. Finally, Opposer argues that its likelihood of confusion claim should not be dismissed because "if Applicant's name Bosca S.p.A. refers to Luigi Bosca & Figli S.p.A. rather than Bosca Cora S.p.A., then the same mark, as used in connection with closely related goods, is owned by two different companies" (emphasis added) and concurrent use of the marks is likely to cause confusion. *Id.* at 11-12. As discussed below, Opposer knows that Applicant is the same company that owns the '600 Registration and is a party to its Exclusive Distribution Agreement. There is no "genuine issue" here. There are only Opposer's suppositions about what *might* be true *if* they were two different companies. Opposer's arguments and opposition must therefore fail.

Opposer acknowledged Applicant's explanation in the '074 Application file that "Bosca S.p.A." and "Bosca Cora S.p.A." refer to the same entity. Notice of Opposition at ¶ 3 ("During the prosecution of the ['074] Application, it was represented in the Response to the Office

¹ In any event, Applicant disagrees with Opposer's claim that even if Applicant and Bosca Cora S.p.A. are the same entity, making the Exclusive Distribution Agreement and its arbitration clause applicable, the opposition is not barred by contractual estoppel because an arbitrator does not have jurisdiction to decide the issue of trademark registrability and impose his or her findings on the Board. Applicant's position on this point is supported by *Carsonite International Corp. v. Energy Absorption Systems, Inc.*, Cancellation No. 92044355 (September 12, 2005) [not precedential], wherein the Board dismissed a petition to cancel because the federal district court already decided that, pursuant to an agreement, arbitration between the parties was "the appropriate forum for any dispute, including, for example, the validity of a registered mark."

Action, filed August 31, 2012, that "Bosca S.P.A. and Bosca Cora, S.p.A. are the same corporate entity ..."). Indeed, Applicant made this representation and provided the Examining Attorney with documentary evidence. The Examining Attorney properly accepted the document as evidence of common ownership of the '074 Application and '600 Registration. TMEP §812.01 (an applicant may submit copies of documents evidencing common ownership to overcome a likelihood of confusion refusal based on its own registration). This document, which clearly shows that "Bosca S.p.A." and "Bosca Cora S.p.A." refer to the same company, and Opposer's reference to it in the Notice of Opposition, are part of the record on which the Board's decision should be based. 37 C.F.R. § 2.122 (b) ("The file . . . of the application against which a notice of opposition is filed . . . forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.").

It is inconsequential that the '074 Application as filed did not claim ownership of the '600 Registration, despite Opposer's suggestion to the contrary. Opposer's Response at 2. Such a claim of ownership is not required. 37 C.F.R. § 2.36; TMEP § 812; *see also In re WD-40 Manufacturing Company*, Serial Nos. 78817680, 78817703 and 78826409 (March 28, 2008) [not precedential] (reversing a refusal to register that was based on the applicant's decision not to claim ownership of a prior registration).

It is certain beyond any doubt that Opposer cannot, under any circumstances, overcome its lack of standing based on contractual and licensee estoppel or prevail on its likelihood of confusion claim because it cannot demonstrate that Applicant and Bosca Cora S.p.A. are two different entities.² Bosca S.p.A. is an accepted short form name for Bosca Cora S.p.A., and, as noted above, Applicant submitted documentary evidence to the Examining Attorney. This

² Opposer even acknowledged that, when it is to Opposer's benefit, Opposer treats Applicant and Bosca Cora S.p.A. as the same entity. *See, e.g.*, Opposer's Response at 4, fn. 2 ("Count 2 (Fraud) relies on certain information that assumes that Applicant and Bosca Cora S.p.A. are not different entities").

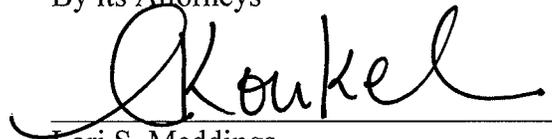
makes a likelihood of confusion between the marks identified in the '074 Application and '600 Registration impossible and Opposer a party to an agreement that prevents it from bringing this proceeding.

For the reasons stated herein and in its Motion to Dismiss, Applicant respectfully requests that the Board dismiss Opposer's opposition, which is baseless and designed to interfere with an ongoing arbitration proceeding between the parties.

Respectfully submitted,

BOSCA S.P.A.

By its Attorneys

A handwritten signature in black ink, appearing to read "Konkel", written over a horizontal line.

Date: June 24, 2013

Lori S. Meddings
Laura M. Konkel
MICHAEL BEST & FRIEDRICH LLP
One South Pinckney Street, Suite 700
Madison, Wisconsin 53703

CERTIFICATE OF SERVICE AND MAILING

I hereby certify that on June 24, 2013, a true and correct copy of the foregoing Applicant's Reply in Support of its Motion to Dismiss is being served upon Opposer's Attorney of Record via first class mail, postage pre-paid:

Alan S. Cooper
Wiley Rein LLP
1776 K Street NW
Washington, DC 20006

and that a copy of the same was filed electronically on the same date via ESTTA with the Trademark Trial and Appeal Board.

A handwritten signature in cursive script, appearing to read "Konkel", written over a horizontal line.

Laura M. Konkel