

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

coggins

Mailed: September 10, 2013

Opposition No. 91209303

Carriage House Imports Ltd.

v.

Bosca S.p.A.

**By the Board:**

Now before the Board is applicant's motion (filed May 17, 2013) to dismiss the notice of opposition for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6). The motion is full briefed.

Procedural Issues

To the extent that applicant's motion seeks to dismiss the notice of opposition based on contractual estoppel and licensee estoppel, it is premature and will be given no consideration. See TBMP § 503.04 (3d ed. rev.2 2013); and *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 (TTAB 2009). As opposer correctly points out (see Brief in Opp. pp. 6-7), applicant improperly included with its motion to dismiss matter outside the

pleadings. The matter has been excluded and not considered for purposes of determining the motion to dismiss.

To the extent that applicant's motion argues the merits of the claims, rather than the sufficiency of those claims, such arguments are inappropriate on a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), and they have been given no consideration.

Motion to Dismiss

A motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of the complaint. To withstand a motion to dismiss for failure to state a claim in a Board opposition proceeding, the opposer need only allege such facts in the notice of opposition as would, if proved, establish that (1) it has standing, and (2) a valid ground exists for opposing the subject application. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the

speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346 (Fed. Cir. 2010).

For purposes of determining the motion, the notice of opposition must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(e). All of opposer's well-pleaded allegations must be accepted as true, and the claims must be construed in the light most favorable to opposer. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Standing

Opposer must allege facts in the notice of opposition which, if ultimately proven, would establish that opposer has a real interest in the proceeding and a reasonable basis for the belief that it will be damaged by the issuance of a registration. *Herbko Int'l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

Applicant alleges that it has been using for several years the mark VERDI SPUMATE in commerce on alcoholic beverages, and that it is the exclusive importer and distributor of certain beverages sold under the mark VERDI in the United States. See Notice of Opp., paras. 4 and 6.

These allegations, read in conjunction with the other allegations in the complaint, demonstrate that opposer has a direct commercial interest in this opposition proceeding and thus, if proved, would establish its standing. In view thereof, opposer has sufficiently pleaded its standing, and the motion to dismiss is **denied** as to opposer's standing.

Priority and Likelihood of Confusion

In order to properly state a claim of priority and likelihood of confusion, opposer must plead that (1) applicant's mark, as applied to its goods, so resembles opposer's mark as to be likely to cause confusion, mistake or deception; and (2) opposer has either priority of use or a federal registration of opposer's pleaded mark. See Fed. R. Civ. P. 8(a); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

As to priority, opposer alleges that it "has been using the trademark VERDI SPUMANTE" in the United States "for many years prior to the filing [date] of the" subject application. Notice of Opp., para. 4. Opposer then specifically alleges that it has used the mark since March 3, 1995, on alcoholic brewed malt beverages, and since June 2, 2004, on wine. *Id.* It is noted that 1995 is earlier than the November 11, 2011 filing date of the use-based application, but it is later than the June 1, 1993 dates of use claimed in the subject application.

The Board agrees with applicant that, at least as to opposer's priority, "[t]he claims made in [the notice of opposition] and the logic behind those claims are difficult to understand." Motion, p. 2. Because of the multiple alternative scenarios pleaded in a non-linear way, even upon tedious examination it is difficult to determine whether opposer has sufficiently alleged priority of its pleaded mark. It is unclear on what date, exactly, opposer alleges that applicant began using the subject mark. A review of the brief in opposition is unhelpful, as opposer does not address this issue in its brief. Paragraph 7 of the notice of opposition alleges that applicant may have a priority date of June 1, 1993 - a date earlier than opposer's claimed date of March 3, 1995. Opposer does not clearly allege that it used its mark prior to applicant's use.

Opposer, appears to rely on its licensor's registration for priority and likelihood of confusion (see paras. 3 and 13). Opposer, as the licensee and not the owner of pleaded Registration No. 2228600, must allege (and later prove) its common law rights prior to applicant's priority date.

*Hydro-Dynamics Inc. v. George Putnum and Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Licensees may enforce trademark rights, but must allege (and eventually establish) priority through evidence of use and may not rely on their licensor's registrations. As to likelihood of

confusion, opposer pleads a likelihood of confusion of the subject mark with a registration opposer does not own. See Notice of Opp., paras. 13-14. It is opposer's mark, not the mark of another, which opposer must use in its allegation of a likelihood of confusion with the mark in the subject application.

In view of the above, opposer has not sufficiently pleaded priority or likelihood of confusion, and the motion to dismiss is **granted** as to this claim.

Fraud

Fraud in applying for a registration occurs when an applicant knowingly makes a false, material representation of fact with the intent of obtaining a registration to which it is otherwise not entitled. See *In re Bose Corp.*, 476 F.3d 1331, 91 USPQ2d 1938, 1939-1940 (Fed. Cir. 2009); and *Torres v. Cantine Torresella S.r.L.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). The allegations must be alleged with particularity, rather than by implied expression, and must allege that applicant knowingly made a false, material representation in the subject application with the intent to deceive the Office. *In re Bose Corp.*, 91 USPQ2d at 1941.

Opposer bases its claim of fraud on two theories: (1) that applicant provided incorrect dates of use for "wine" in the application and, (2) that applicant was not using the

mark on the other goods (i.e., "alcoholic beverages except beer") listed in the application as of the filing date of the use-based application.

As to the first theory, it is well settled that a misstatement of a date of first use in commerce is not fraudulent provided that there has been use of the mark in commerce prior to the filing date of the application. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 630 (TTAB 1986). Opposer alleges that applicant did not use the mark on wine until 2004 - a date which is well before the November 11, 2011 filing date of the application. As explained in *Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009), the critical issue is whether the mark was in use in connection with the identified goods as of the filing date of a use-based application. That is, if the subject mark was in use in commerce on wine as of the filing date, then applicant's claimed dates of first use, even if false, do not constitute fraud because the dates of use are not material to the Office's decision to approve a mark for publication. See *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983) ("The [Trademark] Examining Attorney gives no consideration to alleged dates of first use in determining whether conflicting marks should be published for opposition."). Opposer does not allege that applicant did

not make use of its mark on wine as of the filing date of the application. Indeed, opposer appears to concede that applicant was, in fact, using the mark on wine. See, generally, the notice of opposition, and the Brief in Opp., p. 12. Thus, opposer's allegations of fraud as to wine, even when the allegations are taken a true, do not state a claim of fraud. In view thereof, the motion to dismiss is **granted** as to opposer's claim of fraud based on allegedly incorrect dates of use for wine.

As to the second theory, the Board notes that the entirety of the identification of goods in the subject application reads as "wines and alcoholic beverages except beers." See the ESTTA Notice of Opposition cover form and the preamble to the notice of opposition attached thereto. The Board takes judicial notice of the definition of "wine," and notes that wine is an alcoholic beverage.<sup>1</sup> Wine, as a specific good, is, therefore, contemplated by the broader wording "alcoholic beverages except beers." As the Board explained in *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1915-16 (TTAB 2007):

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<sup>1</sup> The Board may take judicial notice of dictionary definitions. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). Wine is "an alcoholic drink made from grapes, or less commonly an alcoholic drink made in a similar way but from other fruits" (*see* <http://dictionary.cambridge.org/dictionary/american-english/wine>) and "an alcoholic drink made from grapes" (*see* <http://www.macmillandictionary.com/dictionary/american/wine>).

As long as the general product terminology encompasses the specific product terminology in an identification of goods, and there is use on the specific product, there can be no fraud; that is, there is nothing fraudulent in providing an identification of goods that includes both a broad product term and a specific product term so long as the applicant/registrant is using its mark on the specific product, and the specific product is encompassed within the broad product term (assuming that the broad product term is sufficiently definite for purposes of registration).

Inasmuch as opposer does not allege that applicant was not using the mark on wine as of the application filing date (and, as noted above, opposer appears to concede that applicant was using the mark on wine), wine is encompassed within the broad language of "alcoholic beverages except beers," and the Board presumes that the wording "alcoholic beverages except beers" is sufficiently definite for purposes of registration because opposer does not allege otherwise and the Examining Attorney apparently accepted this wording, opposer's claim of fraud based on the inclusion of the goods "alcoholic beverages except beers" does not state a claim of fraud. In view thereof, the motion to dismiss is **granted** as to opposer's claim of fraud based on alleged non-use of "alcoholic beverages except beer" as of the filing date of the application.

Summary

Inasmuch as opposer has sufficiently pleaded standing, applicant's motion to dismiss is **denied**, in part, as to

standing; however, inasmuch as opposer has not sufficiently alleged a ground of priority and likelihood of confusion or fraud, applicant's motion to dismiss is **granted**, in part, as to priority and likelihood of confusion and fraud.

Opposer May Re-plead

Opposer is allowed until **October 1, 2013**, in which to file an amended notice of opposition which properly asserts a ground for opposition, **failing which** the opposition will be dismissed with prejudice. Although the Board does not restrict the grounds applicant may allege, it appears that re-alleging a ground of fraud under either theory presented in the original complaint would be futile.

Possible Resolution

In view of the nature of the dispute between the parties - i.e., whether applicant, as it is identified in the subject application as Bosca S.p.A., is really Bosca Cora S.p.A., the registrant as identified in Registration No. 2228600 - it is highly recommended that the parties work together to settle the matter. For example, the parties may consider filing a consented motion to amend the subject application to set forth applicant's correct name. See TMEP § 1201.02(c) ("If the party applying to register the mark is, in fact, the owner of the mark, but there is a mistake in the manner in which the name of the applicant is set out in the application, the mistake may be corrected by

amendment."), and Trademark Rule 2.133(a) ("An application subject to an opposition may not be amended in substance ... except with the consent of the other party ... and the approval of the Trademark Trial and Appeal Board....").

The parties should not unnecessarily increase the cost of this proceeding or ask to Board to expend its scarce resources if the parties can simply and easily resolve their controversy by settlement.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Amended Complaint Due	10/1/2013
Time to Answer	10/23/2013
Deadline for Discovery Conference	11/22/2013
Discovery Opens	11/22/2013
Initial Disclosures Due	12/22/2013
Expert Disclosures Due	4/21/2014
Discovery Closes	5/21/2014
Plaintiff's Pretrial Disclosures	7/5/2014
Plaintiff's 30-day Trial Period Ends	8/19/2014
Defendant's Pretrial Disclosures	9/3/2014
Defendant's 30-day Trial Period Ends	10/18/2014
Plaintiff's Rebuttal Disclosures	11/2/2014
Plaintiff's 15-day Rebuttal Period Ends	12/2/2014

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

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Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.