

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

CME

Mailed: September 19, 2013

Opposition No. 91210103

The Coca-Cola Company

v.

Alberto Soler d/b/a Coki Loco
and Miriam Soler

By the Trademark Trial and Appeal Board:

This case now comes up on applicants' motion to dismiss, filed April 22, 2013, their addendum thereto, filed July 15, 2013, and applicants' motion to consolidate, filed May 5, 2013. The motions are fully briefed. We construe opposer's response to the motion to consolidate as a combined response/cross-motion to bifurcate consolidation and suspend the proceedings.

We address first applicants' service of the motions. Opposer asserts that it never received the service copies of the motions. However, the certificates of service attached to the motions indicate service on opposer via first-class mail (and e-mail). Moreover, opposer timely filed a response to the motion to consolidate, and opposer has consented to opposer's late-filed response to the motion to

dismiss. Accordingly, the issue of service is moot and we will consider the motions and the responses thereto.¹

We next address applicants' motion to consolidate this proceeding with Opposition No. 91209094. In support of their motion, applicants argue that consolidation will save time, effort and expense because the opposer is the same in both oppositions and "has relied upon its registration and prior use of its ... Coca-Cola and Coke-formative marks," in both oppositions. Applicants further assert that the involved marks both "consist of the word Coki and Cola and Cola and Coki" and that opposer has alleged the same claims in each of the oppositions. Motion to Consolidate, p. 3.

In opposition to the motion, opposer argues that the mark COLA DE COKI involved in Opposition No. 91209094 is different from the mark COKI COLA HAPPY MOTION involved in Opposition No. 91210103 such that consolidation would not be judicially efficient. Response/Cross Motion, p. 5. Opposer further asserts that the "facts surrounding the selection of each mark and intent to use each mark are also likely to

¹ The Board reminds the parties that e-mail service is permitted only upon mutual agreement of the parties. Trademark Rule 2.119(b)(6). If the parties do not stipulate to e-mail service, then service must be made in one of the other manners provided for in Trademark Rule 2.119(b)(1)-(5). Moreover, "[e]very paper" filed with the Board "must be served upon the other parties." Trademark Rule 2.119(a) (emphasis added). Accordingly, the parties are reminded that they are required to comply with their certificates of service. For example, if a certificate of service indicates service via first-class mail, then the filing must be served in that manner on the date set forth in the certificate of service.

differ" and "[o]pposer's claims may be prejudiced [by consolidation] by the relative strength or weakness of the COLA DE COKI mark as opposed to the COKI COLA HAPPY MOTION mark and the potential for confusion in discussing both marks in the same context." *Id.* at pp. 5-6. In view of these objections, opposer cross-moves to consolidate the proceedings *only* with respect to the issue of priority and the claim of fraud and to suspend any bifurcated consolidated cases pending the publication of several pending applications that opposer alleges are "under common ownership" with the involved applications. Consolidation Response, pp. 2-4.

In their reply brief, applicants argue that opposer's proposed bifurcated consolidation would delay proceedings rather than create judicial efficiencies, particularly if the consolidated cases are suspended pending the publication of applications that "might never reach the opposition stage." Consolidation Reply Brief, p. 6.

Consolidation is discretionary with the Board and may be ordered when cases involving common questions of law or fact are pending before the Board. See Fed. R. Civ. P. 42(a); *see also* TBMP § 511 (3d ed. rev.2 2013). Here, the oppositions involve different *pro se* applicants and different marks identifying different goods and services. Indeed, because of the differences in the involved goods and

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services, opposer has pled some marks in Opposition No. 91210103 that are in addition to those pled in Opposition No. 91209094. Given all of these differences, any savings in time, effort and expense from consolidation would be outweighed by the prejudice and inconvenience that would be caused thereby, particularly because applicants are not represented by counsel. *Cf. Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441-42 (TTAB 1973) (denying consolidation because the issues in the cases differed).

With respect to opposer's cross-motion, the Board agrees with applicants that such an approach would unnecessarily complicate matters and would result in significant inefficiencies and delays. Moreover, as applicants note, the pending applications identified by opposer may never be approved for publication. Indeed, of the eight applications that opposer cites, four have been abandoned and two are suspended.

For all of these reasons, consolidation of the proceedings is not appropriate in any manner and both applicants' motion and opposer's cross-motion for consolidation are hereby **DENIED**. If, however, applicants stipulate that they function as a single legal entity

because they are involved in the same business in single control of the marks involved in the oppositions, the Board will reconsider the issue of consolidation with respect to all of the claims in the proceedings.

We now consider applicants' motion to dismiss opposer's claims of priority² and likelihood of confusion, dilution and fraud.³ With respect to opposer's claims of likelihood of confusion and dilution, applicants argue that opposer has failed "to plead acquired distinctiveness [and] stronger distinctiveness for dilution," Motion to Dismiss, pp. 1-2, and has "unknowingly conceded descriptiveness in a different [Board] proceeding." Addendum, p. 1. Applicants also assert that opposer "has failed to plead [its] original and first mark" and that such a pleading is necessary because if opposer's "golden mark can not stand then all the marks that came after that are now pleaded to claim priority, will also fall [sic]." Dismiss Reply, at pp. 4-5. With respect to opposer's fraud claim, applicants argue that the claim "should be dismissed unless [opposer] amends the opposition to state the simple claim that the application was filed in

² Priority is not a claim, but is a required element of a likelihood of confusion claim under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). See *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008).

³ Applicants have not moved to dismiss opposer's claim that the involved application is *void ab initio*.

the wrong owner's name..." Motion to Dismiss, p. 3.

Applicants further assert that opposer has failed to plead that applicants "intended to deceive the USPTO." Dismiss Reply, p. 6 (internal quotations omitted).

In response, opposer argues that (1) it has alleged ownership of several federal registrations and use of its pleaded marks "prior to use by [applicant], which, upon information and belief, has not commenced"; (2) there is no requirement that opposer claim acquired distinctiveness to establish its claims; (3) it has alleged that applicants' mark is similar in sight, sound and meaning to the pleaded marks and that the parties' goods and services "are substantially identical"; (4) it has sufficiently pled dilution by alleging that the pleaded marks are famous and became famous prior to the filing date of the involved application, and that the involved mark is likely to dilute the pleaded marks by blurring and tarnishment; (5) applicants "appear to believe that [their] misrepresentation [as to ownership of the application] is acceptable if it is intended to deceive someone other than the USPTO"; and (6) it has sufficiently asserted a claim for fraud by alleging a false statement of material fact that applicants "knew or should have known" was false or misleading. Dismiss Response, pp. 3-7.

A motion to dismiss under Rule 12(b)(6) is a test of the sufficiency of the complaint. To survive a motion to dismiss, a claimant need only allege sufficient factual matter as would, if proved, establish that 1) it has standing to maintain the claims, and 2) a valid ground exists for opposing the mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). 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, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).

Opposer has sufficiently pled its standing⁴ as well as priority⁵ and likelihood of confusion by alleging current

⁴ Because opposer has sufficiently pled its standing on one ground, it has the right to assert any other ground in its notice of opposition. See TBMP § 309.03(b) and cases cited in footnote 18 therein.

⁵ In response to the motion to dismiss, opposer seems to argue that the issue of priority turns on whether it can establish use or registration prior to the use of applicant's mark. However, "[f]or priority purposes, applicant can, at the very least, rely on the filing date of its application, [July 10, 2012]." See *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825,

ownership of prior valid and subsisting registrations and a non-frivolous claim of likelihood of confusion. See Notice of Opposition, ¶¶ 2-3, and 6-11; see also *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (setting forth the evidentiary factors in determining a likelihood of confusion claim); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1505 (TTAB 2007) (establishing priority based on prior use and pleaded registrations); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (standing established by properly making pleaded registration of record and asserting a non-frivolous likelihood of confusion claim); and TBMP §§ 309.03(b) and 309.03(c)(A) and (B). Contrary to applicants' assertion, there is no requirement that opposer plead its oldest registration. Opposer need only plead sufficient facts asserting priority and a likelihood of confusion, which it has done here. Moreover, applicants' argument that the notice of opposition is insufficient because opposer has not alleged that its pleaded marks have acquired distinctiveness and has allegedly admitted that the pleaded marks are descriptive is not well-taken. Such arguments are collateral attacks on the validity of opposer's

1834 (TTAB 2013) (citing *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991)). However, this does not change the fact that opposer has adequately pled its priority. See Notice of Opposition, ¶¶ 2-3 and 7-8.

registrations and will not be heard in the absence of a counterclaim against the pleaded registrations.⁶

Opposer has also sufficiently pled the elements of a dilution claim alleging that its pleaded "COCA-COLA Marks" are famous, that they became famous prior to the filing date of the involved intent-to-use application, and that applicants mark is likely to dilute opposer's marks by blurring and tarnishment. Notice of Opposition, ¶ 12; see also *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012) (reciting the three elements of a dilution claim).

We now turn to opposer's claim of fraud. The Federal Circuit in *In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) held that "a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO." *Id.* at 1940-41 (recognizing "a material legal distinction between a 'false' representation and a 'fraudulent' one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like" and explaining that "absent the

⁶ A counterclaim that a mark is merely descriptive is not available against a registration that is more than five years old or against a mark registered under the 1905 Act that was republished pursuant to 15 U.S.C. § 1062(c) more than five years ago. 15 U.S.C. § 1064.

requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act...."). The Board finds that the notice of opposition does not sufficiently allege a claim of fraud because opposer has not alleged that applicants made a materially false statement with the intent to deceive the Patent and Trademark Office.⁷

In view of the foregoing, applicants' motion to dismiss opposer's likelihood of confusion and dilution claims is **DENIED**, but their motion to dismiss the fraud claim is **GRANTED** to the extent that the fraud claim is **dismissed without prejudice**. Opposer is allowed until **October 7, 2013** to file an amended notice of opposition asserting an adequately pled claim of fraud.

Dates are reset as follows:

Time to File Any Amended Complaint	10/7/2013
Time to Answer ⁸	10/27/2013
Deadline for Discovery Conference	11/26/2013
Discovery Opens	11/26/2013
Initial Disclosures Due	12/26/2013

⁷ Moreover, contrary to the assertion in opposer's response brief, the allegation that a party "knew or should have known" is no longer the standard for evaluating a claim of fraud. A claimant must prove by clear and convincing evidence that the defendant acted with a "[s]ubjective intent to deceive" in prosecuting the involved application. *Id.* at 1941.

⁸ Each applicant must sign a combined answer. TBMP § 311.01(b).

Expert Disclosures Due	4/25/2014
Discovery Closes	5/25/2014
Plaintiff's Pretrial Disclosures	7/9/2014
Plaintiff's 30-day Trial Period Ends	8/23/2014
Defendant's Pretrial Disclosures	9/7/2014
Defendant's 30-day Trial Period Ends	10/22/2014
Plaintiff's Rebuttal Disclosures	11/6/2014
Plaintiff's 15-day Rebuttal Period Ends	12/6/2014

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