

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

CME

Mailed: February 3, 2014

Opposition No. 91210103

The Coca-Cola Company

v.

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

**Before Cataldo, Taylor, and Greenbaum,
Administrative Trademark Judges.**

By the Board:

This case now comes up on applicants' request for reconsideration, filed September 30, 2013 ("RFR"), and "motion to dismiss," filed October 4, 2013, which is essentially a combined motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) and a motion for sanctions presumably under the Board's inherent authority to sanction ("Motion"). Opposer opposes the RFR.¹ The Motion is fully briefed.

Request for Reconsideration

Applicants filed a motion to dismiss the above-captioned opposition proceeding on April 22, 2013 ("April 2013 Motion")

¹ In response to the RFR, opposer sets forth arguments regarding its payment of the opposition filing fee. However, payment of the filing fee is not at issue in this proceeding, and therefore, this argument will be given no consideration.

and a motion to consolidate this proceeding with Opposition No. 91209094 on May 5, 2013 ("May 2013 Motion"). Opposer's response to the April 2013 Motion was untimely, but opposer requested "leave" to file a late response alleging that applicants did not serve the April 2013 Motion as required by Trademark Rule 2.119(a). See Response to April 2013 Motion, pp. 1-2. For the same reason, opposer requested "leave" to file its response to the May 2013 Motion even though its response to the May 2013 Motion was timely. See Response to May 2013 Motion, p. 2. In reply, applicants argued that opposer's allegations regarding service were "false" and that opposer was "advocating unethically" and acting in "bad faith." Reply to April 2013 Motion, pp. 1 and 4 and Reply to May 2013 Motion, pp. 1-2 and 4-5. Notwithstanding these assertions, applicants consented to opposer's late-filed response to the April 2013 Motion. See Reply to April 2013 Motion, p. 4.

On September 19, 2013, the Board issued an order (the "Prior Order"): (1) determining that the issue of service was moot because applicants consented to opposer's late-filed response to the April 2013 Motion and opposer's response to the May 2013 Motion was timely, see Prior Order, pp. 1-2;² (2) denying the April 2013 Motion to dismiss opposer's claims of

² The Board also noted that the certificates of service attached to applicants' motions indicated service on opposer via first-class mail and e-mail on the date that the motions were filed.

likelihood of confusion and dilution, *see id.* at p. 10; (3) granting the April 2013 Motion to dismiss opposer's fraud claim and allowing opposer time to replead a claim of fraud, *see id.*; and (4) denying the May 2013 Motion to consolidate on grounds that the proceedings involve different *pro se* applicants and different marks identifying different goods and services,³ *see id.* at p. 4. Applicants seek reconsideration of the Prior Order on only two points, namely, denial of the April 2013 Motion to dismiss opposer's dilution claim and on the ground that the Board failed to address applicants' arguments regarding opposer's alleged "false statements" regarding applicants' service of the motions.

A request for reconsideration requires that the Board consider whether "based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 518 (3d ed. rev.2 2013). A request for reconsideration "may not properly be used to introduce additional evidence, nor should it be devoted simply to reargument of the points presented in a brief on the original motion." *Id.*

³ Opposer's cross-motion to consolidate the proceedings with respect to the issue of priority and the claim of fraud only was also denied. *See* Prior Order, p. 4.

With respect to dilution, applicants argue that opposer must allege not only that its marks are famous, but that opposer must specify whether its marks are inherently distinctive or have acquired distinctiveness. See RFR, pp. 2-4. This is substantially a reargument of applicants' April 2013 Motion (p. 1-2), and as such, is improper.⁴ See TBMP § 518.

With respect to service of the motions, the Board did not err when it declined to consider applicants' arguments. As set forth in the Prior Order, the issue of service was moot because applicants consented to opposer's late-filed response to the April 2013 Motion and opposer's response to the May 2013 Motion was timely. Accordingly, the parties' arguments regarding service were immaterial to the Board's decision to consider opposer's response briefs.

In view of the foregoing, applicants' RFR is hereby **DENIED**.

⁴ Moreover, while the degree of inherent or acquired distinctiveness of opposer's alleged famous marks is a factor to be considered in determining whether opposer has **proven** dilution by blurring, as stated in the Prior Order, to adequately state a claim for dilution, opposer must **plead** only that: (1) its pleaded marks are famous, (2) that the marks became famous prior to applicants' priority date; and (3) the involved mark is likely to dilute the distinctive quality of the pleaded marks. See 15 U.S.C. § 1125(c); see also *Research in Motion Ltd. v. Defining Presence Marketing Group, Inc. and Axel Ltd. Co.*, 102 USPQ2d 1187, 1197 (TTAB 2012); *National Bank Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1494-95 (TTAB 2010). Opposer has pleaded each of these elements in its notice of opposition.

Motion Seeking to Dismiss Purported Amended Complaint

In response to the Prior Order and applicants' RFR, opposer filed a combined "amended notice of opposition and response to applicants' motion for reconsideration" ("Response"). Opposer did not submit any amended complaint with its brief, but instead explained the factual basis for and argued the merits of a proposed fraud claim in its Response and asked that the Board "add this claim of fraud to the claims established in [o]pposer's previous Notice of Opposition." Response, pp. 3-5. Applicants move to dismiss opposer's purported amended notice of opposition on the ground that it does not constitute "a plain and short statement" of the claims as required by Fed. R. Civ. P. 8. Motion, p. 3.

A notice of opposition, including any amended notice of opposition, must include a short and plain statement alleging opposer's standing and one or more grounds for opposition. Trademark Rule 2.104. "The elements of each claim should be stated simply, concisely and directly ... [and] [a]ll averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances." TBMP § 309.03(a)(2). Opposer's brief is just that - a brief - and it does not satisfy the requirements of Trademark Rule 2.104. Because opposer did not file any proper amended complaint, applicants' Motion is moot

and will be given no further consideration to the extent that it seeks to dismiss a non-existent amended complaint.

If opposer remains interested in amending its complaint to assert a claim of fraud, or any other claim,⁵ its recourse, as always, is to file a motion to amend pursuant to Fed. R. Civ. P. 15, accompanied by an amended complaint that complies with Trademark Rule 2.104 and asserts opposer's standing and each of its claims for relief. See TBMP § 507.01.

Motion For Sanctions

Applicants seek sanctions in the form of dismissal of the opposition, with prejudice,⁶ based on allegations that opposer violated "state and federal civil and criminal laws," namely, 18 U.S.C. § 2510-2511, Trademark Rule 2.122(c), Rules 402, 403, 405, 408, 502, 607, 609, 612, 616 and 801-803 of the Federal Rules of Civil Procedure, and the TTAB/ABA rules of professional conduct, and that opposer "intentionally did not comply with ... consented email service" when it filed its Response to the RFR. Motion, pp. 2-3 and Reply, pp. 2-3. In support of their Motion, applicants argue that opposer filed a copy of "privileged" e-mail correspondence from applicants and disclosed "a[n]

⁵ The first page of opposer's brief indicates an intent to add a claim of false suggestion of a connection, but the Prior Order did not grant opposer leave to amend to add such a claim, and opposer does not further address such a proposed claim in its brief.

⁶ Applicants "object" to the Board's purported "alternative choice" of sanctions "to strike from the record" opposer's Response. Motion, p. 4.

intercepted wire communication recorded conversation between the parties." Motion, pp. 2-3. Applicants further request that opposer "produce for examination the recorded conversation..." *Id.* at p. 2.

Applicants have not submitted any evidence to support their contention that opposer taped one of the parties' telephone conferences. Moreover, opposer denies the allegation claiming that it merely described in its Response its "recollection" of the telephone conference. Response to Motion, p. 2. However, even if applicants had submitted evidence to support their allegations, the Board has no jurisdiction to decide issues of civil or criminal liability, and therefore, cannot impose sanctions based on applicants' **allegations** or, for that matter, any evidence applicants may submit therewith, that opposer has violated "civil and criminal laws." TBMP § 102.01 ("The Board is empowered to determine only the right to register [trademarks]."); *see also McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) ("[T]he Board's jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings."), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. den'd*, 552 U.S. 1109 (2008); *American-International Travel*

Service, Inc. v. AITS, Inc., 174 USPQ 175, 179 (TTAB 1972) (no jurisdiction to determine whether opposer violated criminal statute).

Moreover, as the Board has previously advised, the attorney-client privilege does not apply here because the communication at issue was not between an attorney and his or her client, but instead was between applicants and the attorney **for applicants' adversary**. See Order of November 14, 2013, p. 3; see also Fed. R. Evid. 502(g)(1) (defining the attorney-client privilege as applicable to "confidential attorney-**client** communications."). The work product doctrine also does not apply to such communications. See Fed. R. Evid. 502(g)(2) (defining "work product protection" as the protection applicable to material "prepared in anticipation of litigation or for trial.").

Similarly, there is no basis for concluding that opposer violated Fed. R. Evid. 408 as there is nothing in the Response or its exhibits concerning any specific negotiation or any settlement position taken by either party related to this proceeding.⁷

⁷ In the e-mail correspondence attached to opposer's Response, co-applicant, Alberto Soler, indicates that he is "trying to push good for a peaceful resolution" but he does not propose any specific proposal or otherwise further discuss settlement.

For the reasons discussed above, there also is no evidence to support applicants' contention that opposer's attorney violated the Office's rules of professional conduct⁸ or that opposer or its attorney acted in any other manner that would subject opposer to sanctions of any kind, including entry of judgment against it.⁹

Finally, as the Board pointed out in the Prior Order (p. 2, n.1), e-mail service is permitted **only upon mutual agreement of the parties**. Trademark Rule 2.119(b)(6). Applicants have not provided any evidence that the parties had mutually agreed to e-mail service as of the date that opposer filed its Response to the RFR. Moreover, opposer asserts that it consented only to the "option" of service by e-mail in addition to the other methods of service provided in Trademark Rule 2.119(b).

Response to Motion, p. 2. Because there is no evidence that the parties mutually agreed to e-mail service exclusively, and in fact opposer denies this assertion, there is no basis for the Board to conclude that opposer failed to properly serve its Response to the RFR, which included a signed certificate of

⁸ The Office's rules of professional conduct are based on the American Bar Association's ("ABA's) Model Rules of Professional Conduct. TBMP § 114.08.

⁹ The remaining rules that applicants cite do not support any possible basis for entering sanctions against opposer.

service indicating service on applicants via U.S. mail on the date the Response was filed.¹⁰ See Response, p. 7.

In view of the foregoing, applicants' motion for sanctions seeking that the Board dismiss the opposition and order opposer to produce the purported recorded conversation is hereby

DENIED.¹¹

Procedural Issues

In view of the parties' filings in this case, the Board addresses a number of procedural issues.

1. Applicants have filed four motions, and one amended motion, all within six months of the institution of this proceeding. Pursuant to the Board's inherent authority to manage the cases on its docket, applicants may not file any further unconsented pre-trial motions in this proceeding without first (1) contacting both opposer and the assigned interlocutory attorney to coordinate a mutually agreeable time for the Board and the parties to participate in a telephone conference to address the basis for any proposed motion by applicants; (2) both applicants participating in such a telephone conference

¹⁰ There has been an ongoing dispute between the parties concerning service of papers in this proceeding. Going forward, the Board does not expect that the parties will argue about the method of service because on November 14, 2013, the parties stipulated to e-mail service of papers as one method of service of papers in this proceeding among the other methods of service provided in Trademark Rule 2.119(b).

¹¹ For the reasons discussed, there also is no basis for striking opposer's Response or entering any other form of sanctions against opposer.

with opposer and the assigned interlocutory attorney; and (3) receiving the Board's approval to file any proposed motion. If applicants fail to comply with this order, sanctions may be entered against them, including entry of judgment.

2. In the filings considered in this order, applicants refer to themselves as "THE RED LUNA," "THE PEOPLE OF THE RED LUNA" or "KO"; however, there is nothing in the record to indicate that either applicant has changed his or her name. If either or both applicants have legally changed their name(s), such name change(s) should be filed with the Board. In the absence of any such filing(s), the Board will not add or substitute THE RED LUNA, THE PEOPLE OF THE RED LUNA and/or KO as applicant(s) in this opposition nor may applicants refer to themselves by these names in this proceeding. See TBMP 512; see e.g., *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 n.1 (TTAB 2008) (Board will not add or substitute an opposition applicant without motion and submission of either proof of name change or assignment or proof of recordation of same with the USPTO); *Maine Savings Bank v. First Banc Group of Ohio, Inc.*, 220 USPQ 736, 737 n.3 (TTAB 1983) (case caption was not changed where the record contained no documents reflecting a name change).

In addition, the Motion and applicants' reply brief are signed by James Wright who is not an applicant of the involved

application or a party to this proceeding. Notwithstanding the fact that Mr. Wright, a non-party to this proceeding, signed the Motion and applicants' reply brief, the Board has exercised its discretion to consider the Motion and reply brief because they were also signed by both applicants to the involved application. Going forward, however, no person or entity other than the applicants to the involved application, or any attorneys that the applicants may retain to represent them in this proceeding, should sign any of applicants' motions or other papers in this proceeding. Any non-conforming filings may be given no consideration.

3. Applicants' filings considered herein include **unsigned** certificates of service.¹² Applicants are reminded that all certificates of service must be **signed by both applicants**. See Trademark Rule 2.119(a).

4. The parties are reminded that this proceeding **is not consolidated** with any other proceeding, and therefore, any filings in this proceeding should bear only the caption and opposition number of this proceeding and address only the issues raised in this case. Moreover, the parties' filings should be served only on **parties to this proceeding**.

¹² Opposer did not object to the RFR or Motion on this basis, and it appears that opposer received the service copies of applicants' RFR and Motion. Accordingly, the Board has exercised its discretion to consider applicants' filings herein.

5. Finally, the parties are hereby ordered to hold the mandatory discovery conference **with Board participation** on or before the deadline set in this Order. The Board will contact the parties to schedule a mutually agreeable date and time for the conference.

Answer, disclosure, discovery, trial and other dates are reset as follows:

Time to Answer	2/28/2014
Deadline for Discovery Conference	3/30/2014
Discovery Opens	3/30/2014
Initial Disclosures Due	4/29/2014
Expert Disclosures Due	8/27/2014
Discovery Closes	9/26/2014
Plaintiff's Pretrial Disclosures	11/10/2014
Plaintiff's 30-day Trial Period Ends	12/25/2014
Defendant's Pretrial Disclosures	1/9/2015
Defendant's 30-day Trial Period Ends	2/23/2015
Plaintiff's Rebuttal Disclosures	3/10/2015
Plaintiff's 15-day Rebuttal Period Ends	4/9/2015

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.
