

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

GCP

Mailed: November 3, 2013

Opposition No. 91210863

Chris Economides III

v.

Thanco Products & Imports,
Inc.

By the Trademark Trial and Appeal Board:

This case now comes before the Board for consideration of (1) applicant's motion (filed June 28, 2013) to dismiss the notice of opposition for failure to state a claim upon which relief may be granted; (2) opposer's motion (filed August 8, 2013) to strike applicant's reply brief in support of its motion to dismiss on the ground that applicant's reply brief is untimely; and (3) opposer's motion (filed July 28, 2013) to amend his pleading. The motions are fully briefed.

Background

Applicant has filed two applications seeking to register the mark GOT OUZO? in standard characters; one for "T-shirts, sweatshirts, and caps" in

International Class 25¹ and the other for “coffee cups, tea cups and mugs” in International Class 21.²

On May 29, 2013, opposer filed a notice of opposition opposing the registration of applicant’s GOT OUZO? marks on the following grounds: (1) deceptiveness under Section 2(a) of the Trademark Act; (2) false suggestion of a connection of a national symbol under Section 2(a) of the Trademark Act; (3) mere descriptiveness under Section 2(e)(1) of the Trademark Act; (4) geographic descriptiveness under Section 2(e)(2) of the Trademark Act; (5) fraud; (6) improper prosecution of applicant’s involved applications; (7) violation of a geographic indication under Section 2(a) of the Trademark Act; and (8) interference with a foreign owner’s mark.

Opposer’s Motion to Strike Applicant’s Reply Brief

We first turn to opposer’s motion to strike applicant’s reply brief in support of its motion to dismiss as untimely. For the reasons stated below, opposer’s motion to strike is **DENIED**.

As noted above, applicant filed its motion to dismiss on June 28, 2013. Opposer filed and served its response to applicant’s motion to dismiss on July 16, 2013. Applicant filed its reply brief in support of its motion to dismiss on August 5, 2013.

¹ Application Serial No. 77369646, filed on January 11, 2008, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming October 11, 1999 as both the date of first use and the date of first use in commerce.

² Application Serial No. 77378572, filed on January 23, 2008, based on an allegation of use under Section 1(a) of the Trademark, claiming August 28, 2007 as both the date of first use and the date of first use in commerce.

Trademark Rule 2.127(a) provides, in relevant part, that “a reply brief, if filed, shall be filed within fifteen days from the date of service of the brief in response to the motion.” Moreover, Trademark Rule 2.119(c) provides, in relevant part, that “[w]henver a party is required to take some action with a prescribed period after the service of a paper upon the party by another party and the party is served by first-class mail, “Express Mail, “ or overnight courier, 5 days shall be added to the prescribed period. The record demonstrates that opposer served its response to applicant’s motion to dismiss by first-class mail on July 16, 2013. Accordingly, by operation of Trademark Rules 2.127(a) and 2.119(c), applicant was allowed until August 5, 2013 in which to file and serve its reply brief in support of its motion to dismiss. Since applicant did file and serve its reply brief on August 5, 2013, applicant’s reply brief is timely. In view thereof, opposer’s motion to strike applicant’s reply brief as untimely is **DENIED**. Accordingly, applicant’s reply brief in support of its motion to dismiss has been considered by the Board in its determination herein.

Applicant’s Motion to Dismiss

To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *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, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that the plaintiff has standing and that a valid ground for opposition exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. 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 such motion, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. *See Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976).

A. **Standing**

A party has standing to oppose a particular application when it demonstrates that it 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).

In this instance, while opposer affirmatively alleges that he sells clothing at Greek Orthodox Churches and festivals and that he will be damaged by registration of applicant's involved marks, *see* ¶ 1 of the notice of opposition, opposer nonetheless fails to allege sufficient facts that demonstrate he has a real interest, that is, a personal stake, in opposing registration of applicant's marks. Specifically, opposer does not affirmatively allege that he sells his clothing items under the mark GOT OUZO? or any other similar mark.³ Further, opposer does not allege that he is a competitor of applicant, or that he is in any way engaged in the provision or sale of related goods or services such that he has an interest in using the GOT OUZO? mark. *See, e.g., Consolidated Foods Corp. v. Big Red, Inc.*, 226 USPQ 829, 831 (TTAB 1985); *Federal Glass Co. v. Corning Glass Works*, 162 USPQ 279, 282-83 (TTAB 1969). *See also McCarthy on Trademarks and Unfair*

³ In his response to applicant's motion to dismiss, opposer contends that he has already properly set forth his standing to pursue this opposition since he has already alleged his standing regarding the GOT OUZO? mark in Cancellation No. 92053525. Initially, the Board notes that the plaintiff in the aforementioned cancellation was Apollo Graphics & Marketing, a corporation, and not opposer as an individual. Even assuming *arguendo* that opposer herein was the plaintiff in Cancellation No. 92053525, the fact that opposer may have properly alleged his standing in that cancellation proceeding is of no avail. Each Board proceeding is based on its individual record. Accordingly, opposer's contention that he has already properly set forth his standing in this opposition proceeding is not well taken.

Competition, § 20:11 (4th ed. 2004)("Standing is presumed when the mark sought to be registered is allegedly descriptive of the goods and the opposer is one who has a sufficient interest in using the descriptive term in his business.").

Even though the Board accepts opposer's allegations as true for purposes of the motion to dismiss, we find that opposer has failed to set forth sufficient allegations to support his standing to bring this opposition proceeding. Accordingly, applicant's motion to dismiss is **GRANTED** to the extent that opposer is allowed the time set forth below in which to file an amended notice of opposition in which opposer properly pleads his standing.

B. Deceptiveness

In order to plead a proper claim of deceptiveness under Section 2(a) of the Trademark Act, opposer must plead that (1) applicant's involved mark misdescribes the identified goods and/or services, (2) consumers would be likely to believe the misrepresentation, and (3) the misrepresentation would materially affect potential purchasers' decision to purchase the product or service. *See In re Bulge*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

Furthermore, a proper pleading of "deceptiveness" under Section 2(a) requires the plaintiff to do more than parrot the language of Section 2(d). The latter provision of the Trademark Act prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services. By contrast, Section 2(a) of the Act prohibits registration of marks which lead a

consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. *See, e.g. Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992)(issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990)(issue was whether use of THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete).

Following a review of opposer's notice of opposition, we find that opposer's pleading is devoid of any allegations which set forth a proper a claim of deceptiveness under Section 2(a) of the Trademark Act. In view thereof, applicant's motion to dismiss is **GRANTED** with regard to opposer's deceptiveness claim.

C. **False Suggestion Of A Connection Of A National Symbol**

As one of his grounds for opposition, opposer alleges that the term OUZOU is a national symbol of Greece and therefore cannot be trademarked. *See* ¶ 6 of notice of opposition. The Board construes these allegations as a claim of false suggestion of a connection with a national symbol.

Under Section 2(a) of the Trademark Act, a trademark may be refused registration if, *inter alia*, it consists of matter which falsely suggests a

connection with a national symbol. 15 U.S.C. § 1052(a). A “national symbol” is subject matter of unique and special significance that, because of its meaning, appearance, and/or sound, immediately suggests or refers to the country for which it stands. *In re Consol. Foods Corp.*, 187 USPQ 63 (TTAB 1975).

In order to assert properly a ground of false suggestion of a connection with a national symbol under Section 2(a) of the Trademark Act, opposer must plead that (1) applicant’s mark is the same or a close approximation of a national symbol; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to a particular national symbol or nation; (3) that the particular nation is not connected with the goods sold by applicant under the mark; and (4) that the national symbol is of sufficient fame or reputation that when applicant’s mark is used on its goods, a connection with a particular nation would be presumed.

As with opposer’s claim of deceptiveness, we find that opposer’s pleading does not set forth a proper claim of false suggestion of a connection of a national symbol under Section 2(a) of the Trademark Act. Accordingly, applicant’s motion to dismiss is **GRANTED** with regard to opposer’s false suggestion of a connection with a national symbol claim.

D. **Claim Based Upon Geographic Indication under Section 2(a)**

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), prohibits the registration of a designation that consists of or comprises “a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after [January 1, 1996].”

This provision of § 2(a) applies if the applicant’s identification of goods: (1) specifically includes wines or spirits; or (2) describes the goods using broad terms that could include wines or spirits (e.g., alcoholic beverages).

We note that the identification of goods identified in applicant’s involved applications do not identify goods which specifically include wines or spirits or that could include wines and spirits. Accordingly, opposer’s claim based upon a geographic indication under Section 2(a) of the Trademark Act is unavailable as a matter of law. Accordingly, applicant’s motion to dismiss opposer’s claim of a violation of a geographic indication under Section 2(a) of the Trademark Act is **GRANTED**.

E. Mere Descriptiveness

In order to assert properly a ground of mere descriptiveness under Section 2(e)(1) of the Trademark Act, opposer must assert that applicant’s mark describes an ingredient, quality, characteristic, feature, function, purpose or use of applicant’s identified services. *See e.g., In re Gyulay*, 820 F.2d 1216, 3 UPSQ2d 1009 (Fed. Cir. 1987). Opposer’s pleading fails to do so. In view

thereof, applicant's motion to dismiss opposer's mere descriptiveness claim is **GRANTED** to the extent noted below.

F. **Primarily Geographically Descriptive**

In order to assert properly a claim of geographic descriptiveness under Section 2(e)(2) of the Trademark Act, opposer must assert that (1) the primary significance of applicant's involved mark is a generally known geographic location;⁴ (2) the goods or services originate in the place identified in the mark; and (3) purchasers would likely believe that the good or services originate in the geographic place identified in the mark.

We find that opposer has failed to set forth any allegations in its pleading to support a claim that applicant's involved marks are primarily geographically descriptive. Accordingly, applicant's motion to dismiss opposer's claim of geographic descriptiveness is **GRANTED** to the extent noted below.

F. **Fraud**

To assert a viable claim of fraud, the plaintiff must allege with particularity, rather than by implied expression, that the defending party knowingly made a false, material representation in the procurement of or maintenance of or renewal of a registration with the intent to deceive the U.S. Patent and Trademark Office. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1942 (Fed. Cir. 2009).

⁴ A geographic location may be any term identifying a country, city, state, continent, locality, region, area, or street. *See* TMEP § 1210.02 (October 2013).

Further, fraud in procuring or maintaining a trademark registration may occur when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of fact in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it otherwise is not entitled. *Id.*

In his notice of opposition, opposer fails to identify a single misrepresentation applicant knowingly made during the prosecution of its involved applications which would constitute fraud. Further, opposer fails to allege any facts that would demonstrate that applicant had a willful intent to deceive the USPTO. Instead, opposer merely parrots the statutory language for fraud which does not provide any notice to applicant of the basis of opposer's asserted fraud claim.

Accordingly, we find that opposer's fraud claim is deficiently pleaded. In view thereof, applicant's motion to dismiss opposer's fraud claim is **GRANTED** to the extent noted below.

G. **Improper Prosecution**

In his notice of opposition, opposer attempts to assert a claim that the Office improperly allowed applicant additional time to address issues set forth in an office action issued by the examining attorney who prosecuted applicant's applications. Additionally, opposer questions the sufficiency of the evidence of

secondary meaning applicant submitted with its response to the examining attorney's office action.

The Board notes that foregoing issues solely concern the *ex parte* prosecution of applicant's involved applications and, therefore, an alleged error on the part of the Office in correctly prosecuting applicant's involved applications does not constitute a ground for opposition. *See Saint-Grobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.* 66 USPQ2d 1355 (TTAB 2009).

Accordingly, applicant's motion to dismiss opposer's claim of improper prosecution is **GRANTED**.

H. **Interference with a Foreign Owner's Mark**

As one of his grounds for opposition, opposer alleges that the "[t]he mark 'OUZO' has been used internationally by J. Barbayiannis Ouzo Company since at least 1860 including sales in the United States. They have trademarks in Greece as well as other countries and would have common law trademark rights in the United States, if any existed." *See* ¶ 5 of Notice of Opposition.

To the extent opposer seeks to oppose the registration of applicant's marks on the ground that applicant's marks interfere with a third-party's mark (in this instance, J. Barbayiannis Ouzo Company's alleged rights in the mark OUZO), opposer's claim must fail. "Ordinarily, a party should not be heard on a third party's rights, that is, allowed to sue to vindicate the rights of another." *See Jewelers Vigilance Committee, Inc. V. Ullenberg Corp.*, 853 F.2d 888, 892, 7 USPQ2d 1628, 1631 (Fed. Cir. 1988). In other words, to the extent opposer is

suggesting that the prior use of the term OUZO in the United States by a foreign party, namely, J. Barbayiannis Ouzo Company, prohibits the registration of applicant's involved marks, we find that opposer cannot rely on such prior trademark rights of third parties to assert a ground for opposition either himself or on behalf of third parties.

Accordingly, applicant's motion to dismiss opposer's claim that applicant's marks interfere with the proprietary rights of a foreign third-party is

GRANTED.

In light of the foregoing, applicant's motion to dismiss the notice of opposition is **GRANTED** in its entirety.

Notwithstanding, the Board generally grants leave to amend pleadings that have been found insufficient, upon challenge under Fed. R. Civ. P. 12(b)(6) and/or Fed. R. Civ. P. 12(e).

In view thereof, opposer is allowed until **twenty (20) days** from the mailing date of this order in which to file and serve an amended notice of opposition which properly sets forth allegations regarding his standing to bring this opposition proceeding, as well as allegations which support claims of deceptiveness, false suggestion of a connection of a national symbol, mere descriptiveness, geographic descriptiveness, and fraud, or whichever of these claims or others, if any, may be properly asserted based on the circumstances of the case, failing which the notice of opposition will be dismissed with prejudice. Opposer is precluded from re-asserting claims of improper prosecution,

interference with a foreign party's trademark rights, or violation of a geographic indication under Section 2(a) of the Trademark Act.⁵

In turn, applicant is allowed until **twenty (20) days** from the date indicated on the certificate of service of opposer's amended notice of opposition to file an answer or otherwise plead to the amended pleading, if filed.

Trial Schedule

Proceedings herein are resumed and trial dates, including the close of discovery and disclosure deadlines, are reset as follows:

Deadline for Discovery Conference	12/31/2013
Discovery Opens	12/31/2013
Initial Disclosures Due	1/30/2014
Expert Disclosures Due	5/30/2014
Discovery Closes	6/29/2014
Plaintiff's Pretrial Disclosures Due	8/13/2014
Plaintiff's 30-day Trial Period Ends	9/27/2014
Defendant's Pretrial Disclosures Due	10/12/2014
Defendant's 30-day Trial Period Ends	11/26/2014
Plaintiff's Rebuttal Disclosures Due	12/11/2014
Plaintiff's 15-day Rebuttal Period Ends	1/10/2015

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.

⁵ In light of this order, opposer's motion to amend his pleading is deemed moot and will be given no further consideration. Notwithstanding, we note that opposer's motion to amend is deficient inasmuch as opposer failed to include a signed copy of his proposed amended pleading with his motion to amend. See TBMP § 507.01 (3d ed. rev. 2 2013).

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

As a final matter, the Board notes that applicant stated in its response to opposer's motion to strike applicant's reply brief that opposer has never actually served applicant with his notice of opposition or any other document filed with the Board and that applicant only learned of opposer's filings though its diligent monitoring of the TTABVue record for this case.

Trademark Rule 2.101(b) reads in relevant part as follows:

Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board and must serve a copy of the opposition, including any exhibits, on the attorney of record for the applicant or, if there is no attorney, on the applicant or on the applicant's domestic representative, if one has been appointed, at the correspondence address of record in the Office. The opposer must include with the opposition proof of service pursuant to § 2.119 at the correspondence address of record in the Office.

(emphasis added).

The Board notes that the foregoing rule does not require an opposer to provide proof of receipt of a notice of opposition, but only proof of service thereof. The Board notes that opposer's certificate of service indicates that a copy of the notice of opposition was served upon applicant by mail at the address indicated therein. Accordingly, in the absence of facts rebutting service, actual service is presumed. Trademark Rule 2.119(a) (certificate of service constitutes *prima facie* proof of service). Moreover, the fact that the

service copy of the notice of opposition, as well as any other filings made by opposer, were not received does not negate opposer's *prima facie* proof of actual service, because non-receipt may have resulted from other causes, such as misdelivery. Further, despite applicant's alleged non-receipt of a service copy of the notice of opposition or opposer's other filings, i.e., motion to amend the pleadings and motion to strike, we find no harm to applicant under the circumstances inasmuch as applicant is clearly on notice of the notice of opposition and its contents, as well as opposer's other filings, since applicant's current counsel, D. Peter Harvey of the law firm of Harvey Siskind LLP, filed a timely response to opposer's notice of opposition, as well as timely responses to opposer's motion to amend and motion to strike.

In order to avoid any further confusion regarding service of papers in this matter, **the parties are hereby ordered to serve courtesy copies of any future filings with the Board by email (except for documents responsive to written document requests), in addition to service by first-class mail.**

Pro Se Information for Opposer

It appears that opposer is representing himself. Opposer may do so. However, it is obvious from opposer's pleading, his motion to strike applicant's reply brief in support of applicant's motion to dismiss, and his failure to file a proper motion to amend his pleading that opposer is unfamiliar with U.S. trademark laws, as well as the technicalities of the procedural law involved in Board proceedings. Accordingly, the Board highly

recommends that opposer obtain competent trademark counsel. It is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in a Board proceeding to secure the services of an attorney who is familiar with such matters.

The U.S. Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though it may provide information as to procedure. If opposer does not retain counsel, then opposer will have to familiarize himself with the rules governing this proceeding. Strict compliance with the Trademark Rules of Practice and all other applicable rules is expected of all parties, even those representing themselves.

Electronic Resources

Opposer may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the Board's homepage at

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

The Board's homepage provides electronic access to these and other materials including the Board's standard protective order, answers to frequently asked questions, the ESTTA filing system^[1] (<http://estta.uspto.gov>) for Board filings, and TTABVUE (<http://ttabvue.uspto.gov/ttabvue>) for case status and prosecution history.

Service of Papers

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent

and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which opposer may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of Service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon [insert name of party served] by forwarding said copy, via [insert manner of service (e.g., first class mail)], to: [insert name and address].

The certificate of service must be signed and dated. *See* TBMP § 113 (3d ed. rev. 2 2013).

Nature of Board Proceedings

^[1] Use of electronic filing with ESTTA is strongly encouraged. This electronic file system operates in real time. *See* TBMP § 110.09 (3d ed. rev. 2 2013).

Opposer is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

Representation

As referenced above, opposer is strongly encouraged to obtain trademark counsel who is acquainted with the technicalities of the procedural and substantive law involved in Board proceedings.