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

Proceeding	91212861
Party	Defendant Bacardi & Company Limited
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Attachments	91212861 LIVE TRUE BACO Reply in Support of Motion to Dismiss final.pdf(67152 bytes )



Appeals for the Federal Circuit, has required a three-part test for deceptiveness: (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods? (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods? (3) If so, is the misdescription likely to affect a significant portion of the relevant consumers' decision to purchase? *In re White Jasmine LLC*, 106 USPQ2d 1385 (TTAB 2013) [precedential], citing *In re Budge Mfg. Co.*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). It is clear that there is no basis for such a claim in the present proceeding. Applicant's mark is not descriptive or misdescriptive of any good or service, nor would any consumer have such a belief.

If deceptiveness (or any claim, including false association) under Section 2(a) were as easy to allege as Opposer seems to believe, such 2(a) claims would be part of virtually every trademark opposition wherein Section 2(d) claims were made. However, because Section 2(a) is designed to protect very specific issues, Section 2(a) claims are very rare in TTAB opposition or cancellation proceedings (and not even common in *ex parte* appeals before this Board). As noted in the Interlocutory Attorney's Order from the Discovery Conference in the subject proceeding regarding deceptiveness, "Section 2(a) of the [Trademark] Act prohibits registration of marks which lead a consumer to draw a false conclusion about **the nature or quality of goods or services...**" The example provided related to whether the use of PARMA for meat products would deceive consumers into believing that the goods originated from Parma (Italy). *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). Other examples of *inter partes* proceedings properly raising Section 2(a) issues are:

- ORGANIC ASPIRIN for supplements, wherein the goods offered under the mark did not include aspirin *Bayer Aktiengesellschaft v. Stamatios Mouratidis*, Opposition No. 91185473 (May 21, 2010)
- THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB1990)
- CERTIFIED HEARING AID AUDIOLOGIST as part of a collective membership mark deceived consumers into believing that hearing aid dealers possessed training and education of audiologists *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798 (TTAB1984)
- SOFTHIDE for imitation leather material deceived consumers by leading them to conclude goods were made of real leather *Tanners' Council of America, Inc. v. Samsonite Corporation*, 204 USPQ 150 (TTAB1979)

In the instant case, there is no similarity between the present facts at issue and the types of facts raised in valid Section 2(a) claims. Rather, it appears clear that Opposer is trying to expand a likelihood of confusion claim into a Section 2(a) claim for reasons that are not readily apparent but may relate to Opposer's inability to support priority as required for a successful Section 2(d) claim. Seemingly, Opposer's argument is that consumers are "deceived into" buying Applicant's goods under the mistaken belief that they originate from the same source as Opposer's. This Board has held that this is the basis for a Section 2(d), not a Section 2(a), claim. See *Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512 (TTAB1984) and *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993).

Accordingly, Opposer's claims under Section 2(a) should be dismissed.

**II. Applicant's Other Application Is Not Relevant to the Subject Proceeding and All Allegations Referencing Such Application Should Be Stricken.**

As noted in Applicant's Motion to Dismiss, Opposer has sought to improperly include another (unpublished) application filed by Applicant into the subject opposition. In its response to this Motion, Opposer makes a variety of suppositions, baseless claims and assertions regarding Applicant's marks and Applicant's intentions with regard to its marks. It is for exactly these reasons that Applicant has moved to have the application that is not ripe for opposition removed from the subject proceeding.

**CONCLUSION**

WHEREFORE, Applicant hereby requests that the Board:

(1) Dismiss Opposer's Section 2(a) claim;

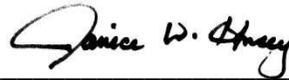
(2) Strike paragraph 8, paragraphs 9, 10 and 12(d) (to the extent that the same be stricken as they relate solely to a trademark application not the subject of the present proceeding) and paragraph 12(c) of Opposer's Amended Notice of Opposition.

In light of the fact that Opposer has already had an opportunity to amend its Notice of Opposition (and in fact, has had the benefit of a TTAB Interlocutory Attorney's explicit instructions regarding a properly pled Notice of Opposition) and has not requested leave to amend its opposition further in the event that Applicant's Motion to Dismiss is granted, Applicant respectfully requests that no further leave to amend be granted and that the opposition proceed based upon the allegations remaining after the Board issues its decision on the subject motion.

Upon the determination of the subject Motion, Applicant requests that a new date be set by which it can answer the remaining allegations in Opposer's Amended Notice of Opposition and re-file its counterclaim for cancellation.

Respectfully submitted,

Bacardi & Company Limited



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Date: March 16, 2014

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## CERTIFICATE OF SERVICE

I hereby certify that on this 16th day of March 2014, a true and correct copy of the foregoing APPLICANT'S REPLY BRIEF IN SUPPORT OF MOTION TO DISMISS OPPOSER'S SECTION 2(a) CLAIM AND TO STRIKE CERTAIN PLEADINGS AND MOTION TO SUSPEND PROCEEDINGS PENDING DISPOSITION OF MOTION is being sent by email to:

[kim@kkolbacklaw.com](mailto:kim@kkolbacklaw.com)

Kim Kolback  
Law Offices of Kimberly Kolback  
1395 Brickell Ave., Suite 800  
Miami, FL 33131

A handwritten signature in black ink that reads "Janice W. Housey". The signature is written in a cursive, flowing style.

Janice W. Housey