

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: April 30, 2014

Opposition No. 91212861

Fairmont Holdings, Inc.

v.

Bacardi & Company Limited

**George C. Pologeorgis,  
Interlocutory Attorney:**

Bacardi & Company Limited (“applicant”) seeks to register the mark DEWAR’S LIVE TRUE, in standard characters, for “alcoholic beverages, except beers” in International Class 33.<sup>1</sup>

Pursuant to the Board’s January 22, 2014, order, Fairmont Holdings, Inc. (“opposer”) filed an amended notice of opposition on February 2, 2014 opposing registration of applicant’s mark based upon claims under Sections 2(a) and 2(d) of the Trademark Act.

This case now comes before the Board for consideration of applicant’s motion (filed February 21, 2014) to dismiss opposer’s Section 2(a) claim and to strike certain allegations in opposer’s amended pleading which refer to an application filed by applicant which is not the subject application of this opposition proceeding. The motion is fully briefed.

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<sup>1</sup> Application Serial No. 85859951, filed on February 26, 2013, based upon *bona fide* intention to use the mark in commerce under Section 44(e) of the Trademark Act.

**Motion to Dismiss**

The Board first turns to applicant's motion to dismiss opposer's Section 2(a) claim. In support of its motion, applicant essentially maintains that opposer has failed to allege the essential elements of a claim of false suggestion of a connection under Section 2(a) of the Trademark Act and, therefore, the claim should be stricken.

In response, opposer argues that it is not asserting a claim of false suggestion of a connection, but instead is asserting a claim of deceptiveness under Section 2(a) of the Trademark Act and that the allegations set forth in its amended notice of opposition sufficiently allege such a claim.

In reply, applicant contends that opposer's amended pleading also does not properly allege a claim of deceptiveness because opposer's amended pleading is devoid of any allegations that assert that applicant's subject mark, DEWAR'S LIVE TRUE, would leave a consumer to draw a false conclusion regarding the nature or quality of the goods identified in applicant's involved application, namely, alcoholic beverages excluding beer.

To state a proper claim of deceptiveness under Section 2(a), an opposer need only allege facts from which it may be inferred that opposer has a reasonable belief that it would be damaged by use of applicant's allegedly deceptive mark and facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase

applicant's services. An opposer asserting such a claim need not allege prior use, or any use at all, of a mark or trade name similar to applicant's mark.

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).

As a basis for its Section 2(a) deceptiveness claim, opposer alleges that that the registration of applicant's subject DEWAR'S LIVE TRUE mark is “likely to deceive or mislead consumers into mistakenly believing that Opposer and Applicant, and their trademark, marketing campaign and/or brand are affiliated or associated, thereby deceiving or leaving a consumer to draw the false

conclusion that Opposer's goods sold under its LIVE TRUE trademark, campaign and brand are a mass produced product of good quality, rather than highly specialized, hand crafted, premium quality." See ¶ 12(b) of opposer's amended notice of opposition.

Following a review of the foregoing allegations, the Board finds that opposer has failed to plead properly a claim of deceptiveness under Section 2(a) of the Trademark Act. Opposer does not affirmatively plead that applicant's involved mark DEWAR'S LIVE TRUE itself is, by inherent nature, deceptive in that it falsely attributes certain qualities to applicant's identified goods. Rather, opposer's allegations are, in effect, that purchasers are deceived into buying applicant's goods bearing the mark DEWAR'S LIVE TRUE under the mistaken belief that the goods originate from the same source as opposer's. This sort of deception is the basis for a Section 2(d), not a Section 2(a), claim. See *Springs Industries, Inc. v. Bublebee Di Stefano Ittina & C.S.A.S.*, 222 USPQ 512 (TTAB 1984).

In view of the foregoing, applicant's motion to dismiss opposer's deceptiveness claim under Section 2(a) is **GRANTED** and said claim encompassed in Paragraph 12(b) of opposer's amended notice of opposition is hereby stricken from opposer's amended pleading.<sup>2</sup>

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<sup>2</sup> Although the Board is liberal in allowing a plaintiff to amend its pleading when it has been found that a claim has been deficiently pleaded, the Board notes that it has already provided opposer an opportunity to perfect its Section 2(a) claim but opposer has failed to do so in this instance. See Board order dated January 22, 2014. Accordingly, the Board will not provide opposer another opportunity to amend its

**Motion To Strike**

The Board next turns to applicant's motion to strike. By way of its motion, applicant seeks to strike the following allegations in opposer's amended notice of opposition:

**Paragraph 8**

On September 13, 2013, BACARDI & COMPANY LIMITED also filed U.S. Trademark Application Serial Number 79/135543 seeking to register LIVE TRUE (without the DEWAR'S moniker) in international class 033 for alcoholic beverages, except beer. On October 15, 2013, an Office Action was issued against Application Serial Number 79/135543. The USPTO refused registration of LIVE TRUE pursuant to Application Serial Number 79/135543 because of a likelihood of confusion with Opposer's U.S. Registration No. 4,222,657 pursuant to Trademark Act Section 2(d), 15 U.S.C. §1052(d)., Applicant has until April 14, 2014 in which to respond to this Office Action.

**Paragraph 9**

A search of the internet further reveals that Dewar's has launched a marketing campaign using DEWARS LIVE TRUE and LIVE TRUE (without the word DEWARS) to market its Scotch.

**Paragraph 10**

Applicant, through its activities identified in Paragraphs 8 and 9 make it clear that Applicant intends to use and uses LIVE TRUE, without the DEWARS moniker, in addition to DEWAR'S LIVE TRUE, interchangeably, in relation to the goods and marketing of the goods identified in its applications.

Additionally, applicant seeks to strike subsections (c) and (d) of Paragraph 12 of opposer's notice of opposition which read as follows:

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pleading to assert a proper claim of deceptiveness under Section 2(a) of the Trademark Act.

**Paragraph 12**

Opposer will be damaged in violation of ...Section 2(d) of the Trademark Act, public policy or otherwise if Applicant is granted registration of the Opposed Mark, as it is:

(c) likely to result in high probability that Applicant will continue to use LIVE TRUE, independent of the words DEWARS, in addition to the Opposed Mark, in relation to the goods and marketing of the goods identified in its applications, in clear violation of Opposer's prior and superior rights.

(d) likely to create a legitimacy and potential claim by Applicant to a future legal right to use LIVE TRUE without the "DEWARS" moniker, in clear violation and derogation of Opposer's prior and superior rights.

In support of its motion to strike, applicant contends that, by asserting the foregoing allegations, opposer is impermissibly attempting to include another application filed by applicant into the subject opposition. Applicant also argues that by allowing these allegations to remain in opposer's amended notice of opposition applicant will be unduly burdened through discovery if the references to its LIVE TRUE mark (without the DEWAR'S moniker) are not stricken. Applicant further maintains that the foregoing allegations, even if proven, have no effect on the outcome of this proceeding and therefore should be stricken.

In response, opposer contends that that it is abundantly clear that applicant's application for the mark LIVE TRUE is not the subject of this opposition proceeding particularly since the caption, opening paragraph and prayer for relief set forth in opposer's amended pleading all clearly reference only applicant's subject application for the mark DEWAR'S LIVE TRUE.

Opposer additionally argues that the above-noted allegations were included in its amended notice of opposition merely as facts relevant to the opposition of applicant's DEWAR'S LIVE TRUE mark.

Under Fed. R. Civ. P. 12(f), the Board may grant a motion to strike from the pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); and TBMP § 506.

Moreover, it is well settled that in the context of an opposition, the determination of likelihood of confusion must be made based on a comparison of the mark(s) and goods recited in the application vis-a-vis the mark(s) and goods identified in the registration [or otherwise pleaded] and not by what evidence or argument shows those goods differently to be. *See Sealy, Incorporated v. Simmons Company*, 121 USPQ 456 (CCPA 1959); *Burton-Dixie Corporation v. Restonic Corporation*, 110 USPQ 272 (CCPA 1956); and *Hat Corporation of America v. John B. Stetson Company*, 106 USPQ 200 (CCPA 1955). Moreover, “[i]n determining likelihood of confusion in an opposition, it is the mark as shown in the application and as used on the goods described in the application which must be considered, not the mark as actually used by applicant”. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §20:04[1], p. 20-26, 27 (3d ed. 1996).

In the instant case, the determination of likelihood of confusion is not based on whether opposer's pleaded registered LIVE TRUE mark is confusingly similar to applicant's LIVE TRUE mark. Rather, the issue of likelihood of confusion is determined on whether opposer's pleaded LIVE TRUE mark is confusingly similar to applicant's subject DEWAR'S LIVE TRUE mark. Nonetheless, applicant's actual or intended use of the mark LIVE TRUE (without the use of the word DEWAR'S) also for alcoholic beverages, excluding beer may have a bearing on the likely commercial impression of applicant's subject mark, the manner in which applicant intends to market or advertise its goods under its DEWAR'S LIVE TRUE mark, as well as applicant's good faith adoption of its subject DEWAR'S LIVE TRUE mark. Thus, to this limited extent, such use may be minimally relevant to our likelihood of confusion analysis.

In view thereof, applicant's motion to strike is **DENIED**.<sup>3</sup>

### **Trial Schedule**

Proceedings are hereby resumed. Trial dates, beginning with the deadline for applicant to file and serve its answer to opposer's amended notice of opposition, as restricted by this order, are reset as follows:

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<sup>3</sup> The Board wants to make clear that, notwithstanding this order, it will not, in the context of this opposition proceeding, make any determination regarding the registrability of applicant's LIVE TRUE mark nor can it make a determination regarding whether or not applicant may use its LIVE TRUE mark in commerce. TBMP § 102.01 (3d ed. rev. 2 2013) (The Board is empowered to determine only the right to register and not the right to use a mark.).

Time to Answer Amended Notice of Opposition <sup>4</sup>	<b>5/20/2014</b>
Deadline for Discovery Conference	<b>6/19/2014</b>
Discovery Opens	<b>6/19/2014</b>
Initial Disclosures Due	<b>7/19/2014</b>
Expert Disclosures Due	<b>11/16/2014</b>
Discovery Closes	<b>12/16/2014</b>
Plaintiff's Pretrial Disclosures Due	<b>1/30/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>3/16/2015</b>
Defendant's Pretrial Disclosures Due	<b>3/31/2015</b>
Defendant's 30-day Trial Period Ends	<b>5/15/2015</b>
Plaintiff's Rebuttal Disclosures Due	<b>5/30/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>6/29/2015</b>

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

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<sup>4</sup> Applicant may, pursuant to the guidelines set forth in the Board's January 22, 2014, order, re-assert its affirmative defenses, as well as its counterclaim, in its answer to opposer's amended notice of opposition. To the extent applicant does re-assert its counterclaim, the Board will at such time issue a subsequent order resetting trial dates that incorporates applicant's counterclaim.