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

Proceeding	91214191
Party	Defendant Boston Iced Tea Company, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>BBK PICTURES, INC.,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">vs.</p> <p>BOSTON ICED TEA COMPANY, INC.,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. : 91214191 Mark : MAGUIRE’S BOSTON ICED TEA Application Serial No. : 85/884,091</p>
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APPLICANT’S ACCELERATED CASE RESOLUTION (ACR) RESPONSE BRIEF

I. INTRODUCTION

The subject opposition is a sham and one only needs to read the sworn testimony deposition of Ms. Alysia Maltepes, sole owner of BBK Pictures, Inc. (“BBK” or “Opposer”) to see this. If this Board does nothing else but read the Deposition of Ms. Maltepes, it will reach the inescapable conclusion that the opposition is a sham and must be dismissed. What has become apparent during this proceeding is that BBK has no regard for the rules and will say or do anything to advance its own interests, including, among other things, submitting a lawyer-crafted declaration that contradicts Ms. Maltepes’ own sworn deposition testimony. For example, Ms. Maltepes’ Declaration (“Maltepes Decl.”), states at paragraph 13 that “BBK Pictures, Inc. sells its products under the BOSTON TEA Mark to grocery stores, lunch trucks, and restaurants.” But, during her deposition under oath, Ms. Maltepes unequivocally admitted that BBK has not made any sales of any product, including its tea product. See January 21, 2015 Deposition of

Alysia Maltepes (“Maltepes Depo.”, attached hereto as Exhibit “A”), 36:23-37:9. Likewise, Ms. Maltepes declares that BBK exclusively licenses use of the BOSTON TEA mark to 1300 North 9th Street, LLC. See Maltepes Decl., ¶ 11. But, when asked about whether there are any agreements between BBK and 1300 North 9th Street, LLC, Ms. Maltepes stated there are none. Maltepes Depo., 61:8-19. But, putting these brazen contradictions under oath aside, BBK’s Opposition fails for a number of other reasons.

First, BBK lacks standing to bring the subject opposition. BBK has no real interest in the outcome of this opposition because, among other things, (a) it has never sold any products, (b) it has no revenue, (c) it has no customers, and it (d) has no business operations. Maltepes Depo., 11:6-12;15:9-18:15. Even more outrageous, BBK submitted a Statement of Use to the USPTO in March of 2014, claiming use of the mark on all products in that same month – March of 2014. However, Ms. Maltepes testified in her deposition that he business did not even acquire a license to make and sell any products until December of 2014! Maltepes Depo., 21:20-22:19.

Indeed, BBK admits (as it must) that it has not been nor would be harmed by registration of Applicant’s mark. BBK cannot even articulate an ethical or philosophical basis to oppose Applicant’s application. Rather, according to the owner of BBK (Ms. Maltepes), the company just exists to “own” a claimed trademark. Even this claim of ownership, however, is based on fraud – including fraud on the USPTO, as will be shown below.

As its name implies, BBK was formed to make independent films. It claims to have made one such film, called the “*The Greek American*.” But BBK’s status as a producer of independent films bears no rational relationship to Applicant’s mark or the goods that are the subject of the Applicant’s application. As noted, BBK has no “real interest” in this proceeding. Under applicable authority, a person may only have a "real interest" if he or she has "a personal interest

in the proceeding beyond that of the general public." *Ritchie v. Simpson*, 170 F.3d 1092, 1095-1096 (Fed. Cir. 1999). BBK *admits* that it does not sell any beverage products (or any products, for that matter). BBK further *admits* that it has not been harmed or damaged (nor would be) as a result of Applicant's application to register its trademark. This is, in popular parlance, nothing more than a shake-down.

Second, BBK claims ownership of several trademarks incorporating the word "BOSTON." BBK has even gone so far as to apply for registrations of these trademarks with the USPTO. And, worse, BBK has defrauded the USPTO by submitting Statements of Use – asserting use in commerce of a wide range of beverage products – knowing that it has never sold *any* such goods in commerce. For example, among the goods listed in BBK's application to register the mark "BOSTON TEA" (for which a Statement of Use was filed on March 23, 2014), are "concentrated fruit juice, concentrates for making fruit juices, fruit drinks and fruit juices."

When asked about these claimed uses in commerce, however, BBK testified as follows:

Q: Has BBK Pictures, Inc., ever sold concentrated fruit juice under the Boston Tea label?

A: *No.*

Q: Has BBK Pictures, Inc., ever sold concentrates for making fruit juices under the Boston Tea label?

A: *No.*

Q: And has BBK Pictures, Inc., ever sold fruit drinks and fruit juices under the Boston Tea label?

A: *No.*

Maltepes Depo., 81:2-13.

Third, Opposer is not the owner of its claimed mark. Even assuming, *arguendo*, that sales of products were actually made under the "Boston Tea" mark (which is doubtful), BBK claims that those sales were made by an entirely different entity - 1300 North 9th Street LLC. So, even common law trade mark rights (if they exist at all) would not be owned by Opposer. Indeed, the nature and quality of the goods allegedly being sold are actually being controlled by a

completely different entity, 1300 North 9th Street LLC. In this regard, Opposer's application is also void because it was not filed by the person or entity that actually sells the product. Here, as admitted by the Opposer, it has not sold any goods.

And fourth, Opposer's mark is geographically deceptively misdescriptive because neither the company nor the product have any connection to Boston.

II. STATEMENT OF FACTS/PROCEDURAL HISTORY

Applicant filed its Intent-to-Use application for MAGUIRE'S BOSTON ICED TEA on March 22, 2013. The application was approved and subsequently published for opposition on August 7, 2013. Applicant has not yet filed a Statement of Use for its mark. Opposer filed its Notice of Opposition on December 14, 2013, and, following a telephone conference with the Interlocutory Attorney the parties elected to an accelerated case resolution (ACR) procedure.

III. ARGUMENT

A. Opposer Lacks Standing to Bring the Subject Opposition.

As noted in the introduction, BBK lacks standing to bring the subject opposition. BBK has no real interest in the outcome of this opposition because, among other things, (a) it has never sold any products, (b) it has no revenue, (c) it has no customers, and it (d) has no business operations. Thus, it has no interest beyond that of the general public. *Ritchie v. Simpson*, 170 F.3d 1092, 1095-1096 (Fed. Cir. 1999).

B. Opposer has Defrauded the UPSTO by Filing a Statement of Use Claiming Actual Use in Commerce of Various Beverage Products, Knowing that None of the Claimed Products Had Ever Been Sold by Opposer Under the Claimed Mark, BOSTON TEA.

As the Board is well aware, Section 1(b) of the Trademark Act permits the filing of an application to register a mark on the basis of the applicant's bona fide intention to use the mark in commerce for the identified goods or services. Before a registration can issue, however, the applicant must actually use the mark in commerce on or in connection with all the goods or services specified in the application and file an allegation of use of the mark in commerce (i.e., either an amendment to allege use under 15 U.S.C. §1051(c) or a statement of use under 15 U.S.C. §1051(d)) that states that the applicant is using the mark in commerce on or in connection with the goods or services, includes dates of use for each class, and includes one specimen evidencing such use for each class).

Here, BBK filed an intent-to-use application to register the mark BOSTON TEA on February 8, 2011 (Ser. No. 85237182). The application cites beverages in two international classes (30 and 32), namely, "tea-based beverages with fruit flavoring; tea; tea-based beverages" and "concentrated fruit juice; concentrates for making fruit juices; fruit drinks and fruit juices; fruit drinks and juices; fruit juices; fruit juice bases; fruit juice concentrates; herbal juices; mixed fruit juice; non-alcoholic beverages containing fruit juices; non-alcoholic fruit juice beverages; non-alcoholic beverages with tea flavor." And, on March 23, 2014, BBK filed a Statement of Use with the USPTO attesting to use of *all* of the goods listed in the application. And today, March 17, 2015 (the very date Applicant is submitting its brief to the Board in this action), BBK received its registration certificate from the USPTO for the "Boston Tea" mark (Reg. No. 4703971).¹

Stunningly, and further evidence of its intent to defraud the USPTO, BBK has allowed a registration to issue even after testifying under oath that BBK has *not sold any* of the goods

¹ Now that a registration has issued for BBK's application, Applicant is separately filing a Petition to Cancel BBK's registration of the "Boston Tea" mark.

listed in its application. Maltepes Depo., 36:23-37:7. Further, BBK testified under oath that it has no written agreements (of any kind) with other companies or individuals licensing or authorizing the use of the claimed mark on tea beverages or fruit juices. BBK has thus procured its registration of the “Boston Tea” mark by defrauding the USPTO. As a result, the entire registration is void.

For a statement to give rise to fraud, the following requirements must be met:

1. The statement must be false;
2. The statement must be a material representation;
3. The person making the statement must have done so with the intent to deceive the Patent and Trademark Office.

In re Bose Corp., 580 F.3d 1240, 1243-44 (Fed.Cir.2009); *see also Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed.Cir.1986). Fraud “involves a willful withholding from the Patent and Trademark Office by an applicant or registrant of material information of facts which, if disclosed to the office, would have resulted in the disallowance of the registration sought or to be maintained.” *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (T.T.A.B.1981); *see also Kemin Indus., Inc. v. Watkins Prods., Inc.*, 192 USPQ 327, 329 (T.T.A.B.1976). If fraud can be shown in the procurement of a registration, **the entire resulting registration is void**. *General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car Inc.*, 17 USPQ2d 1398, 1401 (S.D. Fla. 1990), *aff'g General Rent-A-Car Inc. v. General Leaseways, Inc.*, Canc. No. 14,870 (TTAB May 2, 1998); cited in *Medinol Ltd v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003).

A statement in a statement of use regarding the use of the mark on goods or services is material to the issuance of the registration, because a registration will not be granted for goods or services in connection with which the mark has not been used. (*Herbaceuticals, Inc v Xel*

Herbaceuticals, Inc., 86 USPQ 2d 1572, 1576 (TTAB 2008); *Hurley International LLC v Volta*, 82 USPQ2d 1339 (TTAB 2007)). Indeed, an applicant may not file a statement of use until the applicant has made use of the mark in commerce on or in connection with all goods/services specified in the notice of allowance, unless the applicant files a request to divide. See Trademark Rule 2.88(c);8 TMEP § 1109.03.

As noted above, Opposer’s “BOSTON TEA” application covered a wide-range of goods in International Classes 030 and 032.² And, Opposer submitted its Statement of Use on March 23, 2014, with claimed first use and first use in commerce dates of March 14, 2014. However, in deposition, BBK admitted that it has never sold any products, including any tea products:

- Q: Has BBK Pictures made any sales?
- A: Of the film?
- Q: No, of any product.
- A: No.
- Q: Including your tea product.
- A: No. Like I said, BBK owns the trademark. That's all it does really.

Maltepes Depo., 36:23-37:7.

For the avoidance of doubt, BBK was asked about the specific products in its trademark application – each of which BBK claimed had been sold under the “Boston Tea” mark at least as early as March 2014 – during the testimony deposition in this matter on January 21, 2015, nearly a full year after the alleged use:

- Q: Has BBK Pictures, Inc., ever sold concentrated fruit juice under the Boston Tea label?
- A: No.
- Q: Has BBK Pictures, Inc., ever sold concentrates for making fruit juices under the Boston Tea label?

² The goods listed include: Tea-based beverages with fruit flavoring; tea; Tea-based beverages; Concentrated fruit juice; Concentrates for making fruit juices; Fruit drinks and fruit juices; Fruit drinks and juices; Fruit juices; Fruit juice bases; Fruit juice concentrates; Herbal juices; Mixed fruit juice; Non-alcoholic beverages containing fruit juices; Non-alcoholic fruit juice beverages; Non-alcoholic beverages with tea flavor.

A: No.
Q: And has BBK Pictures, Inc., ever sold fruit drinks and fruit juices under the Boston Tea label?
A: No.
Q: How about fruit juices?
A: No.
Q: How about herbal juices?
A: No.
Q: Mixed fruit juices?
A: No.
Q: How about non-alcoholic beverages containing fruit juices?
A: No.
Q: Non-alcoholic fruit juice beverages?
A: No.
Q: And non-alcoholic beverages with tea flavor?
A: No.

Maltepes Depo., 81:6-82:4.

Here, Opposer knowingly made a material representation to the USPTO in order to obtain registration of its trademark for the identified goods, despite not having ever sold *any* of the goods listed in the Statement of Use. It is undeniable that the Statement of Use would not have been accepted but for Opposer's misrepresentation, since the USPTO will not issue a registration covering goods upon which the mark has not been used. (*Medinol Ltd v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003)). Accordingly, Opposer's fraudulent application should be deemed void.

C. Opposer is Not the Owner of its Own Alleged "BOSTON TEA" Mark

In an application under §1(b) or §44 of the Trademark Act, 15 U.S.C. §1051(b) or §1126, the applicant must be entitled to use the mark in commerce on the application filing date, and the application must include a verified statement that the applicant has a bona fide intention to use the mark in commerce. 15 U.S.C. §§1051(b)(3)(A), 1051(b)(3)(B), 1126(d)(2), and 1126(e). When the person designated as the applicant was not the person with a bona fide intention to use the mark in commerce at the time the application was filed, the application is void. *Am. Forests*

v. Sanders, 54 USPQ2d 1860, 1864 (TTAB 1999), *aff'd*, 232 F.3d 907 (Fed. Cir. 2000) (holding an intent-to-use application filed by an individual void, where the entity that had a bona fide intention to use the mark in commerce on the application filing date was a partnership composed of the individual applicant and her husband).

If the party applying to register the mark is in fact the owner of the mark, but there is a mistake in the manner in which the name of the applicant is set out in the application, the mistake may be corrected by amendment. *U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc.*, 183 USPQ 613 (Comm'r Pats. 1974). However, the application may not be amended to designate another entity as the applicant. 37 C.P.R. §2.71(D); TMEP §803.06. An application filed in the name of the wrong party is void and cannot be corrected by amendment. *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689 (TTAB 1991).

The facts in this case clearly establish that BBK is not the owner of the alleged “Boston Tea” mark and was not when that application was filed. Indeed, Opposer admitted that 1300 North 9th Street LLC, not BBK Pictures, Inc., was the company allegedly conducting the sales of the products bearing the “Boston Tea” label:

Q: Has BBK Pictures made any sales?

A: Of the film?

Q: No, of any product.

A: No.

Q: Including your tea product.

A: No. Like I said, BBK owns the trademark. That's all it does really.

Q: What do you mean, that's all it does?

A: It owns the trademark. And so our production company is the warehouse, which we sell out of.

Q: So the production company is the warehouse. Is that different than BBK Pictures, Inc.?

A: Yes.

Q: And what's the name of the production company?

A: The manufacturing company that makes the iced tea is 1300 North 9th Street, LLC.

Maltepes Depo., 36:23-37:21.

- Q. How many different products has BBK Pictures sold using the [Boston Tea] label we see in Trial Exhibit-2, Page 80?
- A. How many pictures or products has BBK sold?
- Q. Right. Products, with that label.
- A. It hasn't sold any because we don't run that out of BBK.
- Q. What written agreements, if any, exist between BBK Pictures and the 1300 North 9th Street, LLC entity?
- A. What do you mean?
- Q. Well, do those two entities have any written agreements between them?
- A. For example?
- Q. Any written agreements. Any documents at all that express an agreement or understanding between those two companies?
- A. I don't believe so, no.

Maltepes Depo., 60:23-61:19.

- Q. So is it accurate to say that all of the sales are made by 1300 North 9th Street, LLC from the warehouse?
- A. Yeah. Yes.

Maltepes Depo., 63:11-14.

- Q. Are any of the ingredients that are used in any of the BBK, Inc., beverage products organic?
- A. Okay. When you say BBK products, BBK owns the trademark. It doesn't sell the product.

Maltepes Depo., 85:4-9.

Corporations are not “related companies” within the meaning of §5 of the Trademark Act, 15 U.S.C. §1055, merely because they have the same stockholders, directors, or officers, or because they occupy the same premises. *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1243 (TTAB 2007) (holding that the fact that both the applicant corporation and the corporate user of the mark have the same president and controlling stockholder, and share the same

premises, does not make them related companies); *In re Raven Marine, Inc.*, 217 USPQ 68, 69 (TTAB 1983) (holding statement that both the applicant corporation and the corporate user of the mark having the same principal stockholder and officer is insufficient to show that the user is a related company). Even if the two entities were assumed to be related parties, the owner is the party who controls the nature and quality of the goods sold or services rendered under the mark. The owner is the only proper party to apply for registration. 15 U.S.C. §1051. This situation is a non-correctable error as outlined in TMEP Section 1201.02(c). If an application is filed in the name of corporation A and a sister corporation (corporation B) owns the mark, the application is void as filed, because the applicant is not the owner of the mark. *Great Seats*, 84 USPQ2d at 1244 (holding §1(a) application void where the sole use and advertising of the mark was made by a sister corporation who shared the same president, controlling shareholder, and premises as the applicant).

There is no question that Opposer's "BOSTON TEA" application is void *ab initio* and should not have been approved; it suffers from a fatal defect under the law and the mark should not be allowed to mature to registration.

D. Opposer's "BOSTON TEA" Mark is Primarily Geographically Deceptively

Misdescriptive.

A mark is primarily geographically deceptively misdescriptive under 15 U.S.C. §1052(e)(3) if the following is shown:

- (1) The primary significance of the mark is a generally known geographic place or location.
- (2) The goods for which applicant seeks registration do not originate in the geographic place identified in the mark.

- (3) Purchasers would be likely to make a goods-place association; that is, purchasers would be likely to believe that the goods originate in the geographic place identified in the mark.
- (4) The misrepresentation regarding the geographic origin of the goods would be a material factor in a significant portion of the relevant consumers' decision to buy the goods.

See, In re Miracle Tuesday, LLC, 695 F.3d 1339, 1343, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012) (citing, *In re Cal. Innovations Inc.*, 329 F.3d 1334, 1341, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003)); *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1373, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003); TMEP §1210.01(b). see also, *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 1353, 90 USPQ2d 1489, 1493 (Fed. Cir. 2009) (holding that the test for materiality incorporates a requirement that a “significant portion of the relevant consumers be deceived”).

As stated in TMEP 1210.05(c)(i) for products, in determining "materiality," this Board has stated that it looks to evidence regarding the probable reaction of purchasers to a particular geographical term when it is applied to particular goods. See *In re House of Windsor, Inc.*, 221 USPQ 53, 56 (TTAB 1983), recon. denied, 223 USPQ 191 (TTAB 1984). Materiality, or the lack thereof, may be established inferentially based on indirect evidence such as gazetteer entries and third-party websites. See *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1098 (TTAB 2012). To establish a prima facie case of deceptiveness, the Examining Attorney must provide sufficient evidence that the misdescriptive quality or characteristic would be a material factor in the purchasing decision of a significant portion of the relevant consumers. To do so, the Examining Attorney must provide evidence that the misdescriptive quality or characteristic would make the product or service more appealing or more desirable, and not less desirable, to prospective purchasers. TMEP 1203.02(d); *In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 (TTAB 2013) (citing *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694, 1698-99

(TTAB 1992)). A product or service is usually more desirable because of objective standards or criteria that provide an objective inducement to purchase the goods and/or services beyond that of mere personal preference.

In assessing whether a misdescription would affect the decision to purchase, for example, the evidence may show that goods deemed “organic” because they are produced in compliance with objective criteria can also be more costly, provide health benefits, and satisfy a social policy of reducing the impact on the environment by utilizing chemical-free growing practices. The evidence also must suffice to indicate that the misdescriptive quality or characteristic would affect the purchasing decision of a significant portion of the relevant consumers. TMEP 1203.02(d)(i); *In re Spirits Int’l, N.V.*, 563 F.3d 1347, 1353, 90 USPQ2d 1489, 1493 (Fed. Cir. 2009).

Here, Opposer has admitted that its products and ingredients are not from Boston and could not articulate any reason why the word Boston was used as part of its mark. *Maltepes Depo.*, 74:22-76:8. And the products are not even sold in the Boston area, but rather (and to the extent there are even any sales), in New Jersey and Philadelphia. *Maltepes Depo.*, 24:2-7.³

IV. CONCLUSION

In light of the foregoing, Applicant respectfully requests that this Board dismiss Opposer’s Opposition with prejudice.

Dated: March 17, 2015

FOLEY BEZEK BEHLE & CURTIS, LLP

³ In light of the *Maltepes Depo.*, and now that Applicant has additional factual support for the same, Applicant hereby moves to amend its Answer to re-allege its affirmative defense of Geographic Misdescriptiveness, which facts were not available to Applicant at the pleading stage.

/Roger N. Behle, Jr./
Roger N. Behle, Jr.
Attorney for Applicant
Boston Iced Tea Company, Inc.

CERTIFICATE OF SERVICE

It is hereby certified that on the 17th day of March, 2015, the foregoing ACCELERATED CASE RESOLUTION (ACR) RESPONSE BRIEF was served on Opposer by sending a copy thereof to:

BBK PICTURES, INC.
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Opposer, by first-class, postage-prepaid mail. Electronic copies were also served via email.

Dated: March 17, 2015

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./
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