

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Opposition No. 91214683 (parent)

Opposition No. 91214685
Opposition No. 91214687
Opposition No. 91214771
Opposition No. 91214942
Opposition No. 91215830
Opposition No. 91215829
Opposition No. 91215831
Opposition No. 91216913

Nancy Justus

v.

The Legendary Hatfield & McCoy
Family Brand, LLC

Opposition No. 91217613

The Legendary Hatfield & McCoy
Family Brand, LLC

v.

Nancy Justus

(as consolidated)

Before Bucher, Lykos, and Gorowitz,
Administrative Trademark Judges.

The Board previously issued orders in Opposition Nos. 91214683 (order issued on June 23, 2014), 91214685 (order issued on June 23, 2014),

91214687 (order issued on June 23, 2014), 91214771 (order issued on July 2, 2014), 91214942 (order issued on July 1, 2014), and 91215830 (order issued on July 17, 2014). Upon further consideration, the Board hereby *vacates* these orders.

After our review of the records in each of these proceedings, as well as the others involving the parties, we find it necessary to take a comprehensive approach in maintaining these cases.

With that in mind we, *sua sponte*, hereby consolidate Opposition Nos. 91214683, 91214685, 91214687, 91214771, 91214942, 91215830, 91215829, 91215831, 91216913, and 91217613. The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in **Opposition No. 91214683** as the “parent” case. As a general rule, from this point on, only a single copy of any submission should be filed herein, but each submission should include all nine proceeding numbers in the caption thereof. The only exceptions are that any amended notices of opposition and the answer to each notice of opposition must be filed in the respective corresponding proceeding.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any

differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

This consolidated case now comes up for consideration of Applicant's¹ motions to dismiss (filed in Opposition Nos. 91214683, 91214685, 91214687, 91214771, 91214942, 91215830, 91215829, 91215831, and 91216913) Opposer's notices of opposition under Fed. R. Civ. P. 12(b)(6) for failure to state a claim. The motions are fully briefed in all but Opposition No. 91216913. Rather than wait for fully briefing in Opposition No. 91216913, we elect to consider all the motions without further delay.

We have not relied on any extraneous materials in deciding the motions to dismiss and have determined the sufficiency of Opposer's pleadings by looking solely to the pleadings themselves. We note that the pleadings themselves and the briefs from each party on the motions to dismiss are nearly identical. Where they are not we have provided for the nuances of each proceeding when appropriate in our decision.

In support of its motions to dismiss, Applicant argues that the notices of opposition fail to state a claim upon which relief can be granted or, alternatively in some cases, that Opposer's claim for standing or damage is insufficient as a matter of law.²

¹ Throughout this opinion, "Applicant" refers to "The Legendary Hatfield & McCoy Family Brand, LLC" and "Opposer" refers to Nancy Justus (although these positions are reversed in Opp. No. 91217613).

² To the extent Applicant asserts that Opposer is inconsistent in her allegations, the Board notes that Opposer may set forth two or more statements of a claim

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. *Id.* The tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions. Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice. Only a complaint that states a plausible claim for relief survives a motion to dismiss. *See Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50 (2009), citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 555-56 (2007). To survive a motion to dismiss, a complaint must contain "enough facts to state a claim to relief that is plausible on its face." *Bell Atlantic Corp. v. Twombly*, 550 U.S. at 570. The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed. R. Civ. P. 8(e); *see also Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007). Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment. *Advanced Cardiovascular Systems*, 26 USPQ2d at 1041.

alternatively or hypothetically and if Opposer makes alternative statements, the pleading is sufficient if any one of them is sufficient. *See* Fed. R. Civ. P. 8(d).

Standing

As an initial matter, we address Applicant's contention in the motions to dismiss regarding Opposer's lack of standing in these matters.

In the case of a notice of opposition, the standing requirement has its basis in Section 13 of the Trademark Act which provides in relevant part that "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register, ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor...." 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), 50 USPQ2d at 1025-26. If a plaintiff sufficiently alleges standing on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. See *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011).

In each notice of opposition, Opposer has pleaded ownership of application Serial No. 85869214 for the mark HATFIELD AND MCCOY MOONSHINE THE DRINK OF DEVIL ANSE HATFIELD, in standard characters, for "spirits and liquors; and whisky." Opposer has also pleaded that the Office has issued a non-final office action regarding Opposer's pleaded application,

citing Applicant's subject marks, and advising Opposer that Applicant's subject applications may present a bar to registration of Opposer's pleaded application. Clearly, these facts, if proved, would be sufficient to establish Opposer's standing to pursue this case. *See Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

In addition, Opposer has alleged common law rights in the mark HATFIELD & MCCOY MOONSHINE used with "various products, such as decals, flasks, t-shirts, sweatshirts, and tote bags" in ways analogous to trademark use. This allegation of common law rights in an allegedly similar mark for allegedly related goods is sufficient to plead her standing. *See Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009).

In considering the motions, we look at each claim in turn.

I. Geographically Deceptively Misdescriptive or Geographically Descriptive

In order to set forth a proper claim that a mark is geographically deceptively misdescriptive, Opposer must plead that (1) the primary significance of the mark is a generally known geographic location; (2) the goods or services do not originate in the place identified in the mark; (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark; and (4) the misrepresentation is a material factor in a significant portion of the relevant consumer's decision to buy the goods or use the services. *In re California Innovations, Inc.*, 3290 F.3d 1334, 1341, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003).

In order to properly state a claim that a mark is primarily geographically descriptive, Opposer must allege facts, which if proven, establish that (1) the primary significance of the mark is a generally known geographic location; (2) the goods or services do not originate in the place identified in the mark; and (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark.

Applicant argues that Opposer, in alleging that “Hatfield & McCoy refers to a historical feud involving patriarchs and their families” (Notice of Opposition ¶¶ 2 and 3), has failed to plead that Applicant’s mark is primarily geographically descriptive. Applicant’s Responsive Brief, p. 2. We disagree. Following a review of Opposer’s notice of opposition, we find that Opposer has sufficiently pleaded a claim of geographic misdescriptiveness or the alternative claim of geographic descriptiveness. Opposer alleges that the term HATFIELD & MCCOY is “popularly applied as a descriptive term for the Historic Feud Area”; that the “public is likely to believe that Applicant’s goods come from the Historic Feud Area”; that this belief would “materially influence consumers to purchase the goods because they would expect Applicant’s goods to originate there” and that the goods to be sold under Applicant’s marks “will not originate from the Historic Feud Area.” Notice of Opposition ¶¶ 24-31 in Opposition Nos. 91214683, 91214685, 91214687, 91214771, 91214942, 91214830, and 91215831; Notice of Opposition ¶¶ 22-29 in Opposition No. 91215829; Notice of Opposition ¶¶ 23-30 in Opposition No. 91216913. In the alternative, Opposer alleges Applicant’s marks are

primarily geographically descriptive in the event that Applicant “establishes that its goods originate in the Historic Feud Area” and that purchasers would be likely to believe that the goods of Applicant originate in the geographic place identified in its marks. *Id.* In so doing, Opposer has satisfied the pleading requirements for both the geographic misdescriptiveness claim and the alternative claim of geographic descriptiveness.

II. Primarily Merely a Surname

In order to state a claim under Trademark Act Section 2(4)(e), the notice of opposition must allege that the primary significance of the opposed marks is that of a surname.

Opposer alleges that both “Hatfield” and “McCoy” are common surnames and that “[a]pplicant’s mark should not be registered because the primary significance of Applicant’s mark is as a surname.” Notice of Opposition ¶¶ 33, 34, and 36. Such allegations are sufficient for pleading that a mark is primarily a surname. We note Applicant’s argument that the claim necessarily fails because “Hatfield & McCoy” refers to double surnames; nonetheless, we think this is a matter to be determined on summary judgment or at trial.

III. Section 2(a)- False Suggestion of a Connection

We turn next to whether Opposer has properly pleaded a Section 2(a) claim of false suggestion of a connection. The notice of opposition must allege facts, which if proven, establish that (1) the defendant’s mark is the same as or a close approximation of plaintiff’s previously used name or identity; (2)

the defendant's mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the plaintiff is not connected with the goods or services sold by defendant under its mark; and (4) the plaintiff's name or identity is of sufficient fame or reputation that when defendant's mark is used on its goods or services, a connection with plaintiff would be presumed. *See In re White*, 73 USPQ2d 1713 (TTAB 2004). *See also University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *The Ritz Hotel Limited v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466 (TTAB 1990).

In this instance, Opposer has failed to allege that Applicant's marks are the same or a close approximation of *Opposer's identity* and that Applicant's involved marks would be recognized as such, i.e., that they point uniquely and unmistakably to Opposer's persona and/or identity. Further Opposer has failed to allege that Opposer's identity and/or persona (which, unless Opposer also claims that her pleaded mark is her identity, is not her pleaded mark) is of sufficient fame or reputation that when Applicant's marks are used on its goods, a connection with Opposer would be presumed. Therefore, we find that Opposer's claims of a false suggestion of a connection are deficiently pleaded.

IV. Likelihood of Confusion

To properly state a claim under Section 2(d), Opposer must plead (1) that Applicant's mark(s), as applied to its goods or services, so resembles Opposer's mark or trade name as to be likely to cause confusion, mistake, or deception; and (2) priority of use of its pleaded mark(s). *See Hydro-Dynamics*

Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987) (“The common law and the Lanham Act require that trademark ownership be accorded to the first *bona fide* user.”) (citation omitted).

In her pleadings, as we have noted above, Opposer alleges that “[s]ince on or about December 30, 2012, Opposer has sold and continues to sell various products, such as decals, flasks, t-shirts, sweatshirts, and tote bags bearing the mark ‘Hatfield & McCoy Moonshine’ from her location in Gilbert WV, which use by Opposer is analogous to trademark use and is in both intrastate and interstate commerce.”³ Notice of Opposition ¶ 13. Additionally, but for the pleading in Opposition No. 91214683, Opposer alleges that Applicant’s marks resemble Opposer’s common law mark. Notice of Opposition ¶ 44 in Opposition Nos. 91214685, 91215829, and 91216913; ¶ 46 in Opposition Nos. 91214687, 91214771, 91214942, 91215830 and 91215831.

We find that these allegations are sufficient to assert a claim of priority and likelihood of confusion.⁴ To the extent that the pleading in Opposition No. 91214683 fails to allege that Applicant’s marks resemble Opposer’s

³ We note that Opposer’s allegations of first use since December 20, 2012 predate the filing dates of Applicant’s involved intent-to-use applications.

⁴ We observe that Opposer, in further support of her claims of likelihood of confusion, alleges that Applicant’s subject marks create a likelihood of confusion with various third party common law users and marks registered to third parties. Opposer, however, may not rely upon third party marks as a basis for her likelihood of confusion claim. Opposer may only rely on her own pleaded marks.

common law marks, however, we find that the asserted claim of likelihood of confusion is deficient.

V. Lack of *Bona Fide* Intent to Use

Applicant also asserts that Opposer's claim that Applicant did not have a *bona fide* intent to use its marks in commerce must also be dismissed because the relevant allegations constitute threadbare recitals of the elements of the cause of action and consist of merely conclusory statements. We disagree. To state a proper claim of a lack of *bona fide* intent with regard to an intent-to-use application, which is the case here, a plaintiff need only allege that defendant did not have a *bona fide* intent to use the mark in commerce as of the filing date of the defendant's involved application. See TBMP Section 309.03(c)(5) (2014) and cases cited therein. In her pleadings, Opposer alleges that at the time Applicant's applications were filed, Applicant lacked the demonstrated capacity to market and/or manufacture the goods identified in Applicant's applications; that Applicant did not have a *bona fide* intention to use Applicant's marks in commerce for the specified goods when it filed its intent-to-use applications; and applicant's applications are therefore void *ab initio* pursuant to 15 USC Section 1051(b). We find that the aforementioned allegations are sufficient to assert a claim of lack of *bona fide* intent to use the mark in commerce.

Conclusion

Applicant's motions to dismiss are granted as to the false suggestion of a connection claims, and the likelihood of confusion claim in Opposition No.

91214683. The motions are denied as to the geographically deceptively misdescriptive or geographically descriptive claims, the primarily merely a surname claims, and the likelihood of confusion claims in Opposition Nos. 91214685, 91214687, 91214771, 91214942, 91215830, 91215829, 91215831, and 91216913, and the lack of *bona fide* intent to use claims.

The Board generally grants leave to amend pleadings that have been insufficient upon challenge under Fed. R. Civ. P. 12(b)(6). In view thereof, Opposer is allowed **twenty (20) days** from the mailing date of this order to file amended notices of opposition in each proceeding, if it is appropriate to do so, consistent with the discussion above, failing which the consolidated oppositions will proceed only on the following claims: the geographically deceptively misdescriptive or geographically descriptive claims, the primarily merely a surname claims, and the likelihood of confusion claims in Opposition Nos. 91214685, 91214687, 91214771, 91214942, 91215830, 91215829, 91215831, and 91216913, and the lack of *bona fide* intent to use claims.⁵ Applicant is allowed **until October 15, 2014**, to file answers to the amended notices of opposition filed by Opposer (if Opposer files such amended notices) or to the original notices of opposition (in the event Opposer does not file amended notices of opposition).

Proceedings are resumed. Discovery and trial dates are reset as follows:

⁵ The claims in Opposition No. 91217613 will proceed, of course, on the claims pleaded therein.

All answers due:	October 15, 2014
Deadline for discovery conference:	November 15, 2014
Discovery opens:	November 15, 2014
Initial disclosures due:	December 15, 2014
Expert disclosures due:	April 14, 2015
Discovery closes:	May 14, 2015
Opposer's pretrial disclosures due:	June 28, 2015
Opposer's 30-day testimony period as plaintiff in the first nine oppositions ⁶ to close:	August 12, 2015
Applicant's pretrial disclosures due:	August 27, 2015
Applicant's 30-day testimony period as defendant in the first nine oppositions and as plaintiff in Opposition No. 91217613:	October 11, 2015
Opposer's pretrial disclosures for rebuttal in the first nine oppositions and as defendant in Opposition No. 91217613 due:	October 26, 2015
Opposer's 30-day testimony period as defendant in Opposition No. 91217613 and for rebuttal as plaintiff in the first nine oppositions to close:	December 10, 2015
Applicant's rebuttal disclosures as plaintiff in Opposition No. 91217613 due:	December 25, 2015
Applicant's 15-day rebuttal testimony period as plaintiff in Opposition No. 91217613 to close:	January 24, 2015
Brief for Opposer as plaintiff in the first nine oppositions due:	March 24, 2016
Brief for Applicant as defendant in the first nine oppositions and as plaintiff in Opposition No. 91217613 due:	April 23, 2016
Brief for Opposer as defendant in Opposition No. 91217613 and reply brief, if any, as plaintiff in the first nine oppositions due:	May 23, 2016
Reply brief, if any, for Applicant as plaintiff in Opposition No. 91217613 due:	June 7, 2016

⁶ For purposes of clarification the "first nine oppositions" (as listed in the caption of this order) are as follows: 91214683, 91214685, 91214687, 91214771, 91214942, 91215830, 91215829, 91215831, and 91216913.

In each instance, a 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.