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

Proceeding	91217792
Party	Plaintiff Andale Energy Drink Co., LLC
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Submission	Motion to Dismiss - Rule 12(b)
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Date	11/07/2014
Attachments	Motion to Dismiss Applicant's First Counterclaim for Likelihood of Confusion.pdf(118809 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Andale Energy Drink Co., LLC,	)	
	)	
Opposer,	)	Opposition No. 91217792
	)	Serial No. 85/891,919
v.	)	Mark: DALÉ
	)	
ACP IP, LLC,	)	
	)	
Applicant.	)	
	)	
	)	

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**MOTION TO DISMISS APPLICANT'S FIRST COUNTERCLAIM FOR LIKELIHOOD**

**OF CONFUSION**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure, Opposer, Andale Energy Drink Co., LLC ("Opposer") respectfully submits this Motion to Dismiss Applicant, ACP IP, LLC's ("Applicant") first counterclaim for likelihood of confusion on the ground that the allegations stated therein do not state a plausible claim for relief.

**INTRODUCTION**

On August 11, 2014, Opposer filed a Notice of Opposition against Appl'n Ser. No. 85/891,919, owned by Applicant, to which Applicant filed its Answer and Counterclaims on September 19, 2014. Opposer now moves to dismiss Applicant's first counterclaim for "likelihood of confusion", which is based on allegations in ¶¶ 3, 4, 6, and 8 which, even if assumed to be true,

cannot state a plausible claim for relief as a matter of law.

**APPLICANT'S COUNTERCLAIM IS IMPLAUSIBLE AND SHOULD BE DISMISSED**

To survive a motion to dismiss, a complaint must “state a claim to relief that is plausible on its face”. TMBP § 503.02; *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1950, 173 L. Ed. 2d 868 (2009) (“[O]nly a complaint that states a plausible claim for relief survives a motion to dismiss”); *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 545, 127 S. Ct. 1955, 167 L. Ed. 2d 929 (2007) (“Asking for plausible grounds does not impose a probability requirement at the pleading stage; it simply calls for enough facts to raise a reasonable expectation that discovery will reveal evidence [to support plaintiff's claims]”). Here, the counterclaim for "likelihood of confusion" does not state a plausible claim for relief and should be dismissed.

Applicant's first counterclaim for "likelihood of confusion" is based entirely on allegations that "DALÉ " is a "prominent lyric" in the music of an unrelated third party, "Armando Perez p/k/a Pitbull", and that Applicant (but not Mr. Perez) has used DALÉ for musical recordings, live performances, apparel, and as "tagline" for advertising the beverages and automobiles of unrelated third parties since 2004. Counterclaims, ¶¶ 3-4. Applicant's allegations, even if assumed to be true, fall far short of alleging a plausible claim of Applicant's prior use of DALÉ for "energy drinks" or even related goods or services.

First, even if Applicant has used DALÉ for "musical recordings", Applicant's alleged "musical recordings" are simply too different from Applicant's "energy drinks" and related beverages to state a plausible claim of likelihood of confusion. Applicant's bare allegations that these completely disparate goods "overlap" is simply implausible and insufficient.

Second, Applicant cannot plausibly allege a likelihood of confusion between DALÉ for "live performances" or "apparel" and ANDALE for "energy drinks" and similar beverages. Energy drinks and "live performances" and "apparel" are simply unrelated goods and services, and Opposer should not be forced to engage in extensive discovery on the issue of the relatedness of beverages, apparel, and live musical performances. *See Twombly, supra* ("[a]sking for plausible grounds does not impose a probability requirement at the pleading stage; it simply calls for enough facts to raise a reasonable expectation that discovery will reveal evidence [to support the claims]."). Applicant's allegations of an "overlap" between these disparate goods and services are simply too implausible to support a claim of likelihood of confusion.

Last, Opposer alleges that it has used DALÉ "in television commercials for products such as soft drinks, alcoholic beverages and automobiles, since at least as early as 2004"; ¶ 4; and more specifically that "it used the mark DALÉ in connection with national and international endorsements for soft drinks, beer and other related beverages, including Dr. Pepper, Budweiser and Voli Vodka". ¶ 6. Although unclear, Applicant appears to allude to use and/or licensing of the image or likeness of a *third party* (Mr. Perez) and his alleged verbal "tagline" DALÉ (concededly a mere song lyric, ¶ 4) for the promotion and/or endorsement of the beverages of *unrelated third parties*. Such alleged use of DALÉ for the goods of others (and not even by the Applicant) is not a trademark or service mark use within the meaning of Section 45, and thus cannot establish priority of use of DALÉ as a matter of law.

It is axiomatic that a mark is used on goods when "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if

the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale" *and* "the goods are sold or transported in commerce"; and "on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce. . . .". 15 U.S.C. § 1127 (Section 45 of the Lanham Act). Here, Mr. Perez's alleged use of DALÉ for the beverages of *others* is not a trademark use by *Applicant* and is insufficient to establish priority of use of DALÉ for beverages.<sup>1</sup> Nor has Applicant alleged that any licensee or related company is using DALÉ for beverages such that the use (for *beverages*) inures to the benefit of Applicant. Nor has Applicant alleged the word DALÉ was ever affixed or placed on the goods in any manner. Rather, the allegations support only a conclusion that Applicant has verbally uttered the word DALÉ in commercials to promote the goods of others—not any goods of Applicant. Such verbal utterances to promote the goods of others is not trademark use of DALÉ for beverages by Applicant, and thus cannot establish priority of use for beverages as a matter of law.

Even assuming DALÉ—a mere song lyric—is an element of Mr. Perez's image or likeness, the utterance of DALÉ in the commercials of others is not service mark use because Applicant has not sufficiently alleged any cognizable beverage-related services of its own. For example, simply uttering DALÉ in the beer commercials of others, without any allegation or even a suggestion that *Applicant* (as opposed to third party beverage producers) would be perceived as the *source* of those commercials, is not service mark use within the meaning of Section 45 of the Lanham Act. On these facts—assuming their truth—no consumer could perceive *Applicant* as the

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<sup>1</sup> Applicant's alleged use of DALÉ for "automobiles" is irrelevant.

source of the beverage advertisements. Rather, consumers would assume that the advertisements originated from the beverage producers—not from Applicant or Mr. Perez—neither of whom produce beverages.<sup>2</sup> Simply stated, none of these alleged activities could possibly rise to the level of establishing trademark or service mark rights for energy drinks or related goods or services. Applicant's claim is not only implausible, it is impossible to prove as a matter of law. Accordingly, Applicant's first counterclaim for "likelihood of confusion" should be dismissed with prejudice.

### CONCLUSION

Based on the foregoing, Opposer's Motion to Dismiss should be granted, and Applicant's first counterclaim for "likelihood of confusion" should be dismissed with prejudice.

Respectfully submitted,

Date: November 7, 2014

By:     /Paulo A. de Almeida/      
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<sup>2</sup> Applicant does not allege that it produces beverages.

**PROOF OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **MOTION TO DISMISS APPLICANT'S FIRST COUNTERCLAIM FOR LIKELIHOOD OF CONFUSION** has been served on Jaime Rich Vining, the listed Correspondent for Applicant, on November 7, 2014, via First Class U.S. Mail, postage prepaid to:

Jaime Rich Vining  
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/Paulo A. de Almeida/  
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