

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

wbc

Mailed: May 12, 2016

Opposition No. 91224932

*Sazerac Brands, LLC*

*v.*

*McCormick Distilling Co., Inc.*

**By the Trademark Trial and Appeal Board:**

This case now comes before the Board on Sazerac Brands, LLC's ("SB") motion to dismiss McCormick Distilling Co., Inc.'s ("MDC") counterclaim for failure to state a claim of genericness and abandonment filed February 5, 2016 in lieu of an answer to the counterclaim. The motion has been fully briefed. The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion and does not recount them here, except as necessary to explain the Board's order.

A motion to dismiss under Rule 12(b)(6) is a test of the sufficiency of a complaint. *See* TBMP § 503.02 (2015). To survive such a motion, a plaintiff need only allege sufficient factual matter that would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Circ. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187

(CCPA 1982). Specifically, “a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Young v. AGB Corp.*, 47 USPQ2d at 1754; see *Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955; TBMP § 503.02. In particular, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

As a preliminary matter, SB, in its motion, prematurely includes arguments and exhibits related to the merits of MDC’s counterclaims in addition to arguing that such claims are insufficiently pleaded. At the motion to dismiss stage, the Board does not consider the merits of the plaintiff’s standing or its claims, but only considers whether the pleading is sufficient to state a claim to relief that is plausible on its face. *Bell Atl. Corp. v Twombly*, 550 U.S. 544, 570 (2007); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case”). In view thereof, and inasmuch as the parties devote much of their arguments to the sufficiency of the pleadings, the Board

has not considered the multitude of arguments on the merits that both parties have made in considering the motion to dismiss.<sup>1</sup>

*Standing*

SB has not argued that MDC has not pleaded standing. A counterclaimant's standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding. *See Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331, 1332 (TTAB 2013); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005). In noting it is a defendant in the opposition initiated by SB, MCD standing is thus, properly pleaded.

***Genericness***

The Board now turns to whether MDC has adequately pleaded its ground of genericness. A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), *citing H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. Trademark Act § 14(3); *see In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638,

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<sup>1</sup> It is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon a motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (motion to dismiss does not involve determination of case merits).

19 USPQ2d 1551 (Fed. Cir. 1991); *H. Marvin Ginn*, 228 USPQ 528. Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *H. Marvin Ginn*, 228 USPQ at 530. To allege a mark is generic, a party must affirmatively allege that the mark is generic as applied to the specific goods and services for which the mark is registered. See Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3); see also *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001); *H. Marvin Ginn*, 228 USPQ 528; *Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1062 (TTAB 2010); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007). Additionally, a party may not seek to cancel a Principal Register registration over five years old on the ground that it is generic, where the genericness claim is made only as to a portion of the mark and not the entire mark. See *Montecash LLC*, 95 USPQ2d at 1061.

MDC seeks to cancel SB’s registrations for FIREBALL for “liqueurs”<sup>2</sup> and “whiskey.”<sup>3</sup> MDC alleges that FIREBALL is generic of alcoholic cocktails for which the main ingredient is liqueur, whiskey or other alcoholic beverages; that the genus of the goods is liqueur, whiskey or other alcoholic beverages; that published recipes featuring drinks called “fireball” do not reference SB’s products; and that the primary significance of FIREBALL to the relevant purchasing public is an alcoholic beverage which is comprised of whiskey or liqueur. 6 TTABVue at pp. 3-4.

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<sup>2</sup> Registration No. 2852432.

<sup>3</sup> Registration No. 3550110.

Inasmuch as MDC specifies the genus of the goods as liqueur and whisky and that the relevant public primarily understands the term to refer to the genus of the goods, the counterclaim of genericness is adequately pleaded. *See Magic Wand Inc.*, 19 USPQ2d at 1552 (“[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration.”); *H. Marvin Ginn Corp.*, 228 USPQ at 530. In view thereof, the motion to dismiss the counterclaim of genericness is **denied**.

### ***Abandonment***

A trademark registration may be cancelled if the mark has become “abandoned.” *See* Trademark Act §45, 15 U.S.C. §1127; *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 (TTAB 2007). A mark can become abandoned by any act or omission of the registrant which causes the mark to lose its significance as an indication of origin. *See e.g., Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881 (TTAB 2006); *Nobelle.com LLC v. Qwest Communications Internat’l Inc.*, 66 USPQ2d 1300 (TTAB 2003); *Leatherwood Scopes Internat’l Inc. v. Leatherwood*, 63 USPQ2d 1699 (TTAB 2002). “A mark is deemed to be abandoned only when it has lost *all* capacity as an indication of source.” *Nobelle.com LLC*, 66 USPQ2d at 1307 *citing Wallpaper Manufacturers, Ltd. v. Crown Wallcovering Corporation*, 680 F.2d 755, 214 USPQ 327, 335-36 (CCPA 1982).

In support of its claim of abandonment, MDC alleges that SB abandoned its marks in the registrations at issue because there is widespread, uncontrolled use of FIRE-BALL by third parties in connection with alcoholic beverages; that SB has not policed

its marks; and that SB has caused the “term ‘fireball’ to lose its significance as a trademark, if it ever served as such.” 6 TTABVue at pp. 5-6.

Insofar as MDC alleges SB has no control over its mark because it has not policed its mark and that as a consequence of the alleged lack of control, the mark has lost its significance as a source-indicator; the counterclaim of abandonment is adequately pleaded. In view of the foregoing, SB’s motion to dismiss the counterclaim of abandonment is hereby **denied**.

Proceedings herein are resumed. Dates are reset as follows:

Answer to Counterclaim Due	June 1, 2016
Deadline for Discovery Conference	July 1, 2016
Discovery Opens	July 1, 2016
Initial Disclosures Due	July 31, 2016
Expert Disclosures Due	November 28, 2016
Discovery Closes	December 28, 2016
Plaintiff's Pretrial Disclosures	February 11, 2017
30-day testimony period for plaintiff's testimony to close	March 28, 2017
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	April 12, 2017
30-day testimony period for defendant and plaintiff in the counterclaim to close	May 27, 2017
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	June 11, 2017
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	July 26, 2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	August 10, 2017
15-day rebuttal period for plaintiff in the counterclaim to close	September 9, 2017
Brief for plaintiff due	November 8, 2017
Brief for defendant and plaintiff in the counterclaim due	December 8, 2017

Brief for defendant in the counterclaim and reply  
brief, if any, for plaintiff due

January 7, 2018

Reply brief, if any, for plaintiff in the counter-  
claim due

January 22, 2018

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