

UNITED STATES PATENT AND TRADEMARK
OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

BUTLER

Mailed: August 13, 2008

Cancellation No. 92049013

CONTESSA PREMIUM FOODS, INC.

v.

**INA GARTEN LLC, substituted for
GARTEN FOOD CORPORATION¹**

**Before Seeherman, Grendel and Kuhlke, Administrative Trademark
Judges.**

By the Board:

Petitioner seeks to cancel respondent's registration for the mark BAREFOOT CONTESSA for, *inter alia*, food products and beverages in Classes 29, 30, 31, and 32.² Petitioner alleges fraud in the procurement of respondent's registration as grounds for the complaint. This case now comes up on respondent's fully briefed motion, filed April 28, 2008, to dismiss or, alternatively, for a more definite statement. Contemporaneously with its motion, respondent filed its answer denying the salient allegations of the petition to cancel.³

¹ In view of the assignment recorded at Reel 3750, Frame 0833, Ina Garten LLC is hereby substituted for Garten Food Corporation and the caption of this proceeding is so amended. See TBMP §512.01 (2d ed. rev. 2004).

² Registration No. 2892226, issued on October 12, 2004, claiming first use anywhere and first use in commerce as of 1978 (Class 35). The mark is also registered for "retail stores services featuring gourmet foods and books" in Class 35. However, the petition to cancel does not include Class 35.

³ Contrary to petitioner's position, a motion to dismiss is considered timely even if filed contemporaneously with an answer. See TBMP §503.01 (2d ed. rev.

Petitioner, after asserting that it is being damaged by respondent's registration, alleges as follows:

1. Garten Food Corporation ("GFC") is the listed owner of United States Trademark Registration No. 2,892,226 ("the '226 Registration") for BAREFOOT CONTESSA. The goods identified in the '226 registration are "dips, namely, vegetable, yogurt, fish and herb based dips; hummus, chili, stews ribollita, soups, namely, gazpacho and chowders; salads except macaroni, rice and pasta; cranberry sauce; apple sauce, dried fruits, processed nuts, candied nuts, snack mix consisting primarily of processed fruits, processed nuts and/or raisins; processed peas with wasabi flavoring" in International Class 029, and "vegetable strudel, vegetable cobblers, spring rolls, coffee, bread crumbs, croutons, granola, cakes, namely sour cream coffee cake; candy, namely, strawberry flavored laces; quesadilla, salsa" in International Class 030, and "fresh vegetables and fresh nuts" in International Class 031, and "orange juice, grapefruit juice, lemonade; non-alcoholic cocktail mixes" in International Class 032. The '226 Registration has a filing date of November 22, 2006 (*sic*)⁴ and an issuance date of October 12, 2004.
2. GFC is not entitled to continued registration of the '226 Registration because GFC committed fraud in the procurement of that registration.
3. Contessa alleges on information and belief that GFC or its agent made material representations of fact in its application and/or during the prosecution of its application, that GFC knew or should have known were false.
4. Contessa alleges on information and belief that GFC was not using the subject mark of the '226 Registration on all of the goods identified in the registration at the time it filed the Use-Based application or when it may have submitted any other subsequent and relevant declaration of use during the prosecution of the application.
5. Contessa alleges on information and belief that GFC or its agent made these false statements with the intent to induce authorized agents of the United States Patent and Trademark Office to grant the '226 Registration, and, reasonably relying upon the truth

2004). Thus, petitioner's objection that respondent's motion is untimely is overruled.

⁴ The filing date of the underlying application was November 22, 2000.

of said false statements, the PTO did, in fact, grant this registration to GFC.

6. The continuous registration of the subject mark of the '226 Registration is causing injury to Contessa's business plans, is impairing Contessa's rights in its own trademarks for CONTESSA, is inconsistent with Contessa's rights, and will continue to cause injury to Contessa until the registration is cancelled.

In support of its motion, respondent argues that petitioner has not sufficiently alleged its standing because petitioner fails to allege it is using the same or similar mark on the same or related goods and services; and because petitioner's general allegation of injury does not aver how any marks petitioner owns are impaired, or any business plans of petitioner are impacted, by the existence of respondent's registration. As to petitioner's fraud claim, respondent argues that petitioner proffers vague and conclusory allegations which do not meet the heightened pleading requirements of Fed. R. Civ. P. 9(b), and that the petition to cancel, as it stands, would allow petitioner to go on an unlawful "fishing expedition." Respondent alternatively moves for a more definite statement as to petitioner's standing and the basis for the fraud claim.

In response, petitioner argues that its allegation of injury is sufficient to plead its standing because the allegation encompasses its commercial interest in its own CONTESSA marks. Petitioner argues that it specifically pled facts supporting its fraud claim at paragraph Nos. 3-5 of the complaint. Alternatively, petitioner asks for leave to amend the petition to cancel should the Board find the pleading insufficient.

In reply, respondent argues that petitioner fails to provide specificity for its fraud claim because it does not identify the false representation and it does not identify the goods allegedly not in use at the time of such representation. Pointing out that its application was pending for four years before it registered, respondent contends that "petitioner cannot simply canvas (*sic*) 4 years of correspondence with the USPTO with general allegations of misrepresentation." Similarly, pointing out that its mark is registered for over 35 items, respondent argues that petitioner's failure to identify the specific goods upon which respondent purportedly had no use "would create an opportunity for unfettered discovery on use dates concerning every product covered by a registration." In addition, respondent argues that petitioner has not identified any harm it has incurred as a result of respondent's purported conduct or any direct and personal stake in the outcome of this proceeding.⁵

In order to withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought; that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration of applicant's mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670

⁵ No consideration is given to respondent's supplemental reply brief, filed June 23, 2008. Once a timely reply brief is filed, the Board will consider no

F.2d 1024, 213 USPQ 185 (CCPA 1982). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); Fed. R. Civ. P. 12(b)(6); and TBMP §503.02 (2d. ed. rev. 2004).

Turning first to petitioner's allegations of standing, a petition to cancel, stating the grounds relied thereon, may be brought by any person who believes he is or will be damaged by the registration of a mark. See Trademark Act §14. In order to meet the standing requirement, a plaintiff need only show that it has a real interest, a personal stake, in the outcome of the proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987).

Here, petitioner stated that it believes it is being damaged by the continued registration of respondent's mark. Petitioner also alleged in paragraph No. 6 that it owns trademarks for the term CONTESSA and that respondent's registration impairs petitioner's trademark rights. Petitioner further alleged injury to its business plan. However, petitioner has not articulated the nature of its trademark rights or aspects of its business

further papers in support of or in opposition to a motion. See Trademark Rule

plan that it believes are affected. Thus, petitioner has not alleged sufficient facts as to its damage that, if proven at trial, would establish that it has a real interest in this case beyond that of the general public and, thus, would establish petitioner's standing to maintain this proceeding.

We turn next to the sufficiency of petitioner's fraud claim. Fraud in the procurement of a registration is a valid, cognizable ground for cancellation of a registration. See Trademark Act §14(3); and *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321 (TTAB 1992). Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981). That is, the time, place and contents of the false representations, the facts misrepresented, and identification of what has been obtained, shall be stated with specificity. See *Saks, Inc. v. Saks & Co.*, 141 USPQ 307 (TTAB 1964).

In view of the numerous items listed in the identification of goods covering several international classes, we find that petitioner's claim of fraud is not set forth with particularity because it does not identify the specific goods (the facts misrepresented) for which applicant purportedly was not using its mark either at the time it filed its application or when any

other papers were filed asserting use of the mark for the identified goods.

In view thereof, respondent's motion to dismiss is well-taken. However, if the allegations of fraud are not sufficiently particularized, the proper remedy is not to dismiss the case, but to require the pleader to amend to correct the deficiency. See J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* §20:58 (2008). Moreover, upon a determination on a motion to dismiss that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading. See TBMP §503.03 (2d ed. rev. 2004).

Accordingly, petitioner's alternative request for leave to file an amended petition to cancel is granted. Petitioner is allowed until **THIRTY DAYS** from the mailing date of this order in which to file and serve its amended petition to cancel with respect to its allegations of standing and with respect to its fraud claim. Petitioner is reminded of its obligations under Fed. R. Civ. P. 11. Consequently, the Board expects petitioner to list only those goods as to which petitioner has a good faith claim that respondent misrepresented its use of the mark. Operative dates, including the due date for respondent's answer, are reset as follows:

Time to Answer	10/15/2008
Deadline for Discovery Conference	11/14/2008
Discovery Opens	11/14/2008

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Initial Disclosures Due	12/14/2008
Expert Disclosures Due	4/13/2009
Discovery Closes	5/13/2009
Plaintiff's Pretrial Disclosures	6/27/2009
Plaintiff's 30-day Trial Period Ends	8/11/2009
Defendant's Pretrial Disclosures	8/26/2009
Defendant's 30-day Trial Period Ends	10/10/2009
Plaintiff's Rebuttal Disclosures	10/25/2009
Plaintiff's 15-day Rebuttal Period Ends	11/24/2009

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 Rule 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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