

TTAB

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By: Thomas M. Galgano  
Thomas M. Galgano, Esq.

Dated: 4/24/08

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

In the Matter of Trademark Registration No. 2,892,226  
For the mark BAREFOOT CONTESSA  
Date Registered: October 12, 2004

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Contessa Premium Foods, Inc. )  
222 West Sixth Street, 8<sup>th</sup> Floor )  
San Pedro, CA 90731-3316 )

Petitioner, )

vs. )

Ina Garten LLC )  
46 Newtown Lane )  
East Hampton, NY 11937 )  
(assigned by Garten Food )  
Corporation) )

Registrant. )

-----X

# 76172249

CANCELLATION NO.: 92049013

Asst. Commissioner of Trademarks  
P.O. Box 1451  
ATTN: TTAB  
Alexandria, VA 22313-1451



U.S. Patent & TMO/TM Mail Rpt Dt. #34

**MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM OR,  
ALTERNATIVELY, FOR A MORE DEFINITE STATEMENT  
AND MOTION FOR SUSPENSION**

Pursuant to Fed.R.Civ.P. 12(b)(6), Registrant, Ina Garten LLC hereby moves to dismiss the above-identified Petition for Cancellation on the grounds that it fails to

state a claim upon which relief may be granted or alternatively, pursuant to Fed.R.Civ.P. 12(e), for a more definite statement. Registrant also requests that the proceedings be suspended pending the Board's decision on this Motion and to reset the discovery and testimony periods for this proceeding to run from the date of the Board's decision on this Motion. This Motion is being filed concurrently with Registrant's Answer to Petition for Cancellation.

The Petition for Cancellation fails to state a claim upon which relief may be granted for the following reasons:

1. Registrant has not alleged, as is required, that it has or will be damaged by the registration.
2. Registrant has not alleged, as is required, sufficient grounds for the cancellation.

Pursuant to 37 CFR §2.112(a):

The petition for cancellation must set forth a short and plain statement showing why the petitioner believes he, she, or it is or will be damaged by the registration, state the grounds for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration.

A party petitioning to cancel a federally registered trademark is required to plead and prove that it has standing and that there is a valid ground for the cancellation of the registration. *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100 (TTAB 2007) (citing *Young v. AGB Corp.*, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)). Here, the Petition fails to allege both why Petitioner was or will be damaged by the registration and sufficient grounds for cancellation of the registration.

"It is well settled that in order to state a claim upon which relief can be granted in a cancellation proceeding, it must be asserted that petitioner will be damaged by the continued existence of the registration sought to be canceled; that is, that such registration is inimical to an equal or superior right of the petitioner to use the same or a similar term in connection with goods or services which are similar or commercially related to those of respondent." *Crown Wallcovering Corporation v. The Wall Paper Manufacturers Limited*, 188 USPQ 141, 143 (TTAB 1975). Thus, a petitioner must allege facts tending to show damage, for example, that there is a likelihood of confusion between the respective marks. *General Mills, Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840 (TTAB 1979). The rationale of this practice is to require a petitioner to show that it has standing to petition to cancel a registration, that is, that the petitioner has a personal interest in the proceeding, as opposed to being a mere third party intermeddler. *Id.*

"Thus, where a petition to cancel is based on the ground of abandonment or fraud, the petitioner must allege not only the elements relative to the charge of abandonment or fraud but also that it is using the same or a similar mark for the same or similar goods or services, together with a direct or hypothetical pleading of likelihood of confusion." *Crown Wallcovering Corporation*, 188 USPQ at 144.

Here, the petitioner merely sets forth general and conclusory allegations that it would be damaged as a result of the registration and thus fails to sufficiently allege standing. The Petitioner generally alleges that registration of the mark is causing injury to its business plans and impairing rights in its own trademarks, but does not identify those marks nor business plans. Furthermore, Petitioner fails to allege that it is using the same or similar mark for the same or similar goods and the requisite likelihood of confusion. Therefore, Petitioner has failed to allege it has standing to cancel the registration.

In addition, pursuant to Trademark Rule 2.116(a), the sufficiency of petitioner's pleading of a claim of fraud is governed by FRCP 9(b), which provides as follows:

*(b) Fraud, Mistake, Condition of the Mind.* In all averments of fraud or mistake, the circumstances constituting fraud or mistake shall be stated with particularity. Malice, intent, knowledge, and other condition of mind of a person may be averred generally. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203 (TTAB 1997).

The Board has interpreted Rule 9(b) as requiring that the "pleader must state the time, place and content of the false representation, the fact misrepresented and what was obtained or given up as a consequence of the fraud." *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 672 (TTAB 1977). Here, the Petitioner alleges no more than vague and conclusory allegations which fail to meet the heightened pleading requirement for allegations of fraud. Thus, the Petition for Cancellation fails to state a claim upon which relief may be granted. Indeed, to allow this petition to stand would improperly grant Petitioner an unlawful "fishing expedition" into Registrant's mark and business.

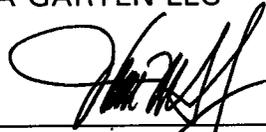
In the alternative, Applicant moves for a more definite statement pursuant to Fed. R. Civ.P 12(e). The Petition for Cancellation is vague and indefinite and fails to clearly identify the Petitioner's standing and the basis on which the Petition for Cancellation has been filed.

Finally, Registrant requests that the proceedings be suspended pending the Board's decision on this Motion and to reset the discovery and testimony periods for this proceeding to run from the date of the Board's decision on this Motion.

In view of the above, it is respectfully submitted that the Petition for Cancellation fails to state a claim upon which relief may be granted. Accordingly, it is respectfully requested that the Petition for Cancellation be dismissed with prejudice. In the alternative, Registrant requests that the Petitioner be required to serve a more definite statement regarding its standing and the grounds on which the Petition for Cancellation is based. It is also requested that the proceedings be suspended pending the Board's decision on this Motion and to reset the discovery and testimony periods for this proceeding to run from the date of the Board's decision on this Motion.

Respectfully Submitted,

INA GARTEN LLC



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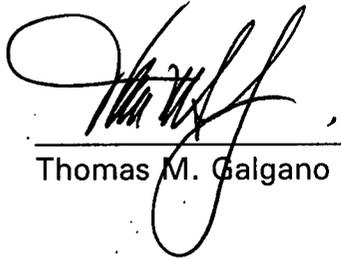
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM OR, ALTERNATIVELY, FOR A MORE DEFINITE STATEMENT AND MOTION FOR SUSPENSION** has this 24<sup>th</sup> day of April, 2008 been sent by first-class mail to:

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Thomas M. Galgano

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