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

Proceeding	92049013
Party	Plaintiff Contessa Premium Foods, Inc.
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TRADEMARK
Docket No. 110.2*17/Z41

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

Contessa Premium Foods, Inc., Petitioner, v. Garten Food Corporation, Registrant.	Cancellation No. 92049013 Trademark BAREFOOT CONTESSA Registration No. 2,892,226 Registered October 12, 2004

PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM OR, ALTERNATIVELY, FOR A MORE DEFINITE STATEMENT AND MOTION FOR SUSPENSION

I. INTRODUCTION

Registrant Ina Garten LLC's ("Garten" or "registrant") untimely and defective Motion to Dismiss for Failure to State a Claim ("Rule 12(b)(6) Motion") and alternative Motion For a More Definite Statement ("Rule 12(e) Motion") must both fail because neither motion was filed prior to the filing of an Answer. Rather, Garten filed this defective motion contemporaneously with its Answer to Petitioner Contessa Premium Foods, Inc.'s ("Contessa" or "petitioner") Petition for Cancellation.

The Rules of Civil Procedure clearly state that both motions must be filed before the filing of a responsive pleading. Thus, the Trademark Trial and Appeal Board ("Board") should deny both motions.

II. REGISTRANT'S UNTIMELY RULE 12(B)(6) MOTION FAILS WHERE PETITION PLEADS DAMAGES AND FRAUD

Under the Federal Rules of Civil Procedure ("Rules"), as applied to proceedings before the Board via Trademark Rule 116(a), a motion to dismiss for failure to state a claim upon which relief can be granted "*must* be made before pleading if a responsive pleading is allowed,"

including an answer. Rule 12(b) (emphasis added). Registrant filed its Answer contemporaneously with its Rule 12(b)(6) Motion and is therefore late and/or untimely under the Rules.

A late motion to dismiss for failure to state a claim is treated as a motion for judgment on the pleadings under Rule 12(c). Fed. Civ. P. Before Trial, § 9:320 (Rutter Group 2007) (citing *Patel v. Contemporary Classics of Beverly Hills*, 253 F.3d 123, 125 (2d Cir. 2001); *Jones v. Greninger*, 188 F.3d 322, 324 (5th Cir. 1999); *Aldabe v. Aldabe*, 616 F.2d 1089, 1093 (9th Cir. 1980)). In ruling on a motion for judgment on the pleadings, the Board construes the allegations in the petition in the light most favorable to the nonmoving party and all well-pleaded facts alleged in the complaint are assumed true. *Leed Techs. Limited v. Topaz Communications Ltd.*, 2002 WL 1478473 (TTAB 2002). "A party may not obtain judgment on the pleadings if the nonmoving party's pleading raises issues of fact which, if proved, would establish the nonmoving party's entitlement to judgment." *T.M. Pacific Co., Ltd. v. The Body Shop Int'l, PLC*, 1998 TTAB LEXIS 431, at * 7 (TTAB 1998) (citing *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 U.S.P.Q.2d 1048 (TTAB 1992)).

In this context, the Board is required to analyze Contessa's Petition for Cancellation ("Petition") by assuming all facts alleged therein are true, along with all fact raised by the allegations. The Board must also draw all inferences in Contessa's favor under the standards discussed. Contrary to respondent's allegations, Contessa pled factual allegations of damages resulting from respondent's continued '226 Registration. Contessa also plead factual allegations of fraud committed by respondent in procuring the '226 Registration.

Contessa pled that 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." Pet. at ¶ 6. Assuming these allegations and all corresponding facts

that may be raised by the allegations as true, as the Board must under a Rule 12 (c) analysis, petitioner's pleading presents sufficient facts to show injury to it from respondent's continued registration. *See* J. McCarthy, *McCarthy on Trademarks & Unfair Competition*, § 20:46 (7th ed. 2007) (alleging a real commercial interest in own marks provides a basis for damages).

Similarly, Contessa specifically pled facts supporting fraud. Contessa pled in its Petition that respondent "or its agent made material representations of fact in its application and/or during the prosecution of its application, that [respondent] know or should have known were false." Pet. ¶ 3. Contessa also pled that respondent "was not using the subject mark of the '226 Registration on all of the goods identified in the registration at the time it field the Use-Based application or when it may have submitted any other subsequent and relevant declaration of use during the prosecution of the application." Pet. ¶ 4. Finally, Contessa plead that respondent "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 of said false statements, the PTO did, in fact, grant this registration." Pet. ¶ 5.

Looking as these specifically pled allegations and any associated facts that may be raised by the allegations, under a Rule 12(c) analysis, Contessa pled fraud with the specificity required by Rule 9(b) and this Board. *See Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q. 2d 1205, 1210 (TTAB 2003) (finding fraud from misstatement of use of a mark in a Statement of Use); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986) ("Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.").

Respondent's Rule 12(b)(6) Motion, properly analyzed as a Rule 12(c) motion because it was untimely filed, must fail as a judgment on the pleadings because Contessa's Petition for Cancellation raises factual issues regarding damages resulting from the continued '226 Registration and respondent's fraud in obtaining that registration.

III. RESPONDENT'S UNTIMELY RULE 12(E) MOTION FAILS BECAUSE RESPONDENT ANSWERED THE PETITION

Respondent's untimely Rule 12(e) motion should be denied. The fact Respondent filed an Answer is sufficient proof that the allegations contained in Contessa's Petition are clear and concise. Otherwise, Respondent could not have filed an Answer.

Under Rule 12(e), "[t]he motion *must* be made before filing a responsive pleading." Rule 12(e) (emphasis added). Further, a "motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself." *Robert Burton Assocs., Ltd. v. DRL Enters., Inc.*, 2005 WL 547738 (TTAB 2005) (denying motion for a more definite statement).

Respondent's Rule 12(e) Motion fails on three grounds. First, respondent filed the motion contemporaneously with its Answer, and not before as required by Rule 12(e). Second, respondent's ability to answer indicates the Petition for Cancellation is not vague or ambiguous. Third, an untimely Rule 12(e) Motion is not analyzed as any other type of Rule 12 motion. It is simply untimely.

IV. PETITIONER ALTERNATIVELY ASKS FOR LEAVE TO AMEND

In the unexpected event that this Board grants responder's Rule 12(b)(6) / 12(c) or Rule 12(e) Motion, or any portion thereof, Contessa requests the Board grant Contessa leave to file an amended Petition for Cancellation. *See Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 2001 WL 431506 (TTAB 2001) ("The Board freely grants leave to amend pleadings if found . . . to be insufficient, particularly where the challenged pleading is the initial pleading.").

V. CONCLUSION

Respondent's Rule 12(b)(6) Motion fails because it was filed contemporaneously with respondent's Answer. This late motion still fails a under Rule 12(c) analysis because the

allegations, assumed to be true, in the Petition for Cancellation raise factual issues to be determined during the cancellation proceeding. Finally, respondent's Rule 12(e) Motion fails for reasons similar to its Rule 12(b)(6) Motion, it was late and respondent's Answer is a clear indication that the Petition for Cancellation provides sufficient clarity.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

DATED: May 12, 2008

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CERTIFICATE OF SERVICE

I certify that on May 12, 2008, the foregoing **PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM OR, ALTERNATIVELY, FOR A MORE DEFINITE STATEMENT AND MOTION FOR SUSPENSION** is being served by mailing a copy thereof by first-class mail addressed to:

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