ESTTA Tracking number: **ESTTA494831**
Filing date: **09/17/2012**

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

Proceeding	92055682
Party	Defendant The Central America Bottling Corporation
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Date	09/17/2012
Attachments	Indigo Studios v The Concentrate - Respondent's Reply.pdf (7 pages)(222232 bytes)

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

INDIGO STUDIOS, INC	)	
	)	
Petitioner,	)	Cancellation No. 92055682
	)	U.S. Registration No. 3,643,274
v.	)	Mark: MISCELLANEOUS DESIGN
	)	
THE CONCRETE MANUFACTURING COMPANY OF IRELAND,	)	
	)	
Respondent.	)	
	)	

RESPONDENT'S REPLY TO PETITIONER'S RESPONSE TO MOTION TO DISMISS

In its response to The Central American Bottling Corporation's ("CAB Corp.'s") 1/, Motion to Dismiss ("Response"), Petitioner, Indigo Studios, Inc. ("Petitioner" or "Indigo Studios") argues 1) that its fraud claim has been sufficiently pled and 2) that Petitioner's claim is based on more than copyright ownership. But Petitioner's arguments do not change what was actually pleaded in the Petition for Cancellation ("Petition") and what was pleaded by Petitioner was woefully short of the particularity needed to support an allegation of fraud and completely devoid of any allegation of ownership by petitioner of **trademark-type** (as opposed to

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1/ In the Response, Petitioner "questions the standing of CAB Corp. to respond to allegations of fraud perpetrated by a third party, the Concentrate Manufacturing Company of Ireland, the actual Respondent in its application for the Mark." See Response, p.1, FN 1. A Motion to Substitute CAB Corp. for the Concentrate Manufacturing Company of Ireland as Respondent in the above-referenced proceeding was filed on August 13, 2012. First, Petitioner's comment does not make logical sense since the party that Petitioner says is the actual Respondent and the party it alleges committed the fraud (Concentrate Manufacturing Company of Ireland) was also **not** the party that originally applied for the mark or which signed the documents Petitioner alleges were fraudulent. Rather, Caribbean Flavors, Ltd. was the original applicant in the application for the subject registration. Moreover, not only did Petitioner not oppose the Motion to Substitute, Petitioner also expressly consented to the Motion to Substitute. To the extent Petitioner attempts to oppose the Motion to Substitute in its Response, CAB Corp. objects on the grounds that such opposition is untimely and waived.

copyright) rights. Indeed, only in its Response (and not in the Petition), Petitioner for the first time baldly alleges that the Indigo Cat Artwork serves as a source identifier. Furthermore, these allegations appearing for the first time in the Response do not establish that the Indigo Cat Artwork serves as a source identifier and are actually admissions that Petitioner is without any trademark-like rights in the Indigo Cat Artwork. See Response, pp. 5-6. Because the Petition for Cancellation fails to plead facts sufficient to support an allegation of fraud and because copyright claims are outside of the Board's jurisdiction, CAB Corp. respectfully requests that its Motion to Dismiss be granted.

I. PETITIONER'S FRAUD CLAIM IS INSUFFICENTLY PLED.

Without an allegation of Petitioner's trademark rights in the Indigo Cat Artwork, the Petition will fail to state a claim for fraud because it cannot then allege that Respondent was aware of Petitioner's trademark rights, the basis for Petitioner's alleged fraud claim. Petitioner attempts to save its fraud claims from dismissal by arguing that the Petition for Cancellation included allegations that Petitioner had acquired trademark-like rights in the Indigo Cat Artwork. In support of this, Petitioner points to 2 allegations in its Petition:

- Paragraph 3: "In or about 2002 Petitioner's representatives posted two (2) images from the Kool Kat art on their website as "stock images" for licensing by Petitioner's customers. One of these images was the Indigo Cat. The webpage is clearly marked with a copyright notice, and provides Petitioner's contact information for prospective licensees of the work. The webpage offering the Kool Kat art for licensing is located at http://www.indigostudios.com/stock/illus_055.shtml, and a screen shot of the page is attached as Exhibit B, along with a screen shot of the licensing

information and copyright notice which appear when interested website visitors click on the Indigo Cat. "

- Paragraph 2: "The works were cartoon drawings of a distinctive green cat having human attributes, and were entitled 'Kool Kat art'; they are attached as Exhibit A. One of the three drawings showed the cat with its arms crossed and wearing sunglasses (the 'Indigo Cat')."

With respect to paragraph 3, Petitioner argues that because it was offering the Indigo Cat Artwork "for licensing by Petitioner's customers," it was using the Indigo Cat Artwork as a source identifier. To the contrary, Petitioner's explanation is actually an admission of just the opposite, namely that the Indigo Cat Artwork is not a source indicator for Petitioner but rather, as can be seen from Exhibit B to the Petition, one among a large number of "stock images," referred to as "Illustration[s]" on Petitioner's website, that are available to *license* to a third party (perhaps to be used in the future by a third party as a source indicator or for other non-source identifying purposes). 2/ Indeed, in the context of Petitioner's website, the alleged license to the Kool Kat art is a reference to a **copyright** license, not a **trademark** license. See Petition, ¶ 3, Exhibit B. This admission should itself warrant not only the Board granting the Motion but also denying Petitioner's alternative request to allow it to amend the Petition as the admission is fatal to Petitioner's claim to have standing.

With respect to paragraph 2, while it is true that a trademark must be distinctive in order to be protected, the use of the word "distinctively" in the phrase "distinctively green" used to

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2/ Petitioner has not, however, alleged that any third party has used the mark as a source identifier under license.

describe the color of the cat depicted in the Indigo Cat Artwork is certainly not an allegation of trademark-like rights. 3/

Additionally, Petitioner tries to argue that it has pled the fraud claim with particularity by, for the first time, making reference to the November 28, 2008 declaration of Andrea M. Bond. Even assuming the inclusion of this reference is sufficient to meet the heightened pleading standard for fraud claims, it is irrelevant because it does not appear anywhere in the Petition and is introduced only in the Response. The Petition does not make any reference to this declaration and instead summarily concludes that the subject registration was obtained by fraud. Petitioner's introduction of new allegations in its Response cannot excuse the insufficiency of the allegations in the Petition.

Because Petitioner has failed to allege trademark-like rights in the Indigo Cat Artwork (because it has none) such that the applicant could not possibly have made any fraudulent statements regarding Petitioner's alleged trademark rights, or applicant's awareness of such rights, since none existed, and because the Petition fails to plead fraud with any particularity, the Petition fails to plead that CAB Corp.'s predecessors made a knowingly, false, material representation to the United States Patent and Trademark Office and, accordingly, Petitioner's fraud claim should be dismissed. And because Petitioner has effectively admitted in its Response that its use of the Indigo Cat Artwork was not used in a trademark-like manner, Petitioner's request to be given leave to amend its Petition should be denied.

3/ CAB Corp. also notes that had Petitioner alleged any trademark-like rights in the Indigo Cat Artwork and a likelihood of confusion with the mark in CAB Corp.'s U.S. Registration No. 3,643,274, CAB Corp. is also the owner of U.S. Reg. No. 2101903 registered in 1997 with a first use in commerce date of 1994 for an earlier version of the KOOL KAT Mark making CAB Corp. the prior user of the KOOL KAT Mark. Indeed, the first use of the KOOL KAT Mark by CAB Corp.'s predecessors precedes any allegations made by Petitioner regarding the Indigo Cat Artwork by 5 years.

II. PETITIONER ADMITS THAT IT DOES NOT HAVE STANDINGG TO BRING TRADEMARK CLAIMS, ONLY COPYRIGHT CLAIMS, WHICH ARE OUTSIDE OF THE BOARD'S JURISDICTION.

Finally, for the reasons discussed above, Petitioner's allegation which it makes for the first time in its Response (and never alleged in its Petition) that it is relying upon "its established common law rights" in its trademark because it "posted [the Indigo Cat Artwork] online for two (2) years as a distinctive mark of Petitioner, then registered it [as a **copyright** registration, not a trademark registration]" is completely without merit. Response, p. 7. Not only are none of these allegations present in the Petition and are all newly introduced in the Response, the fact the Indigo Cat Artwork was one of many "stock images" posted online and available for copyright licensing is the antithesis of functioning as a source identifier for Petitioner's business. Again, Petitioner's admission as to its use of the Indigo Cat Artwork in a manner that is anything but trademark-like use, is not only fatal to the Petition as pleaded, it is fatal to its ability to amend its pleading so as to be able to establish standing and Petitioner's request to do so should be denied as being futile.

III. CONCLUSION

For the foregoing reasons, Respondent CAB Corp. respectfully requests that the Board grant its motion to dismiss Petitioner's Petition for Cancellation for failure to state a claim on which relief can be granted and deny Petitioner's request for leave to amend.

Respectfully Submitted,

HOGAN LOVELLS US LLP

Dated: September 17, 2012

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that on the 17th day of September, 2012, the foregoing RESPONDENT'S REPLY TO PETITIONER'S RESPONSE TO MOTION TO DISMISS was served upon the following correspondents-of-record via electronic mail and First Class mail:

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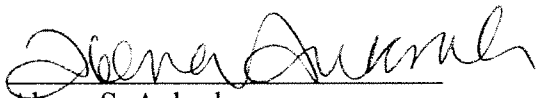

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