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

Proceeding	92061664
Party	Defendant BBK Pictures, Inc.
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Attachments	BBKPictures.Reply to Petitioners Opposition to Motion to Dismiss.pdf(136176 bytes )



that BBK's BOSTON TEA mark is primarily geographically deceptively misdescriptive and that the Registrant of BBK's BOSTON TEA mark is not the owner of the mark. On July 21, 2015, BBK Pictures filed a Motion to Dismiss the Cancellation Proceeding on grounds that the substance of Petitioner's Petition to Cancel had not been timely asserted. On August 11, 2015 Petitioner filed its Opposition to Registrant's Motion to Dismiss the Cancellation Proceeding, to which BBK Pictures now replies.

## II. Argument

In its Opposition to BBK's Motion to Dismiss, Boston Iced Tea Company defends the untimely filing of its Petition for Cancellation by arguing it did not have an opportunity to file such a petition or counterclaim until after BBK Pictures' trademark application registered on March 17, 2015 and BBK Pictures asserted its registration in its April 1, 2015 Reply Brief in the Opposition Proceeding. For the reasons that follow, this argument lacks merit.

### **A. Petitioner Had Notice that BBK's Application Served as the Basis of the Opposition Proceeding Prior to the Filing of Its Answer.**

Petitioner asserts that BBK Pictures relied on its registration for the first time during the Opposition Proceeding on April 1, 2015 and therefore that Petitioner could not have had a basis for filing its compulsory counterclaim or Petition to Cancel until that time. However, Petitioner has been on notice of the basis for BBK's Opposition from the time of BBK Pictures' filing of the Notice of Opposition. The TTAB application form for a Notice of Opposition requires that the Opposer clearly identify the "Mark Cited By Opposer as Basis for Opposition."<sup>1</sup> BBK Pictures clearly indicated on its Notice of Opposition cover sheet that the mark serving as the basis for its Opposition was U.S. *Application* No. 85237182, for the word mark BOSTON TEA. Moreover,

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<sup>1</sup> See Opposition Docket Entry 1, Filed and Fee, cover sheet.

BBK Pictures stated in the Notice of Opposition that the basis of its opposition was likelihood of confusion between its word mark BOSTON TEA and Petitioner's later-filed word and design mark that also prominently featured the wording "Boston" and "Tea."<sup>2</sup> Petitioner cannot now reasonably assert that it lacked notice of BBK Pictures' reliance on its pending application for BOSTON TEA as the basis for filing a Notice of Opposition until April 1, 2015.

**B. The TTAB Recognized BBK Pictures' Standing to Bring the Opposition in Reliance on its Application in May 2014**

On May 8, 2014, the Trademark Trial and Appeal Board issued an Order in the Opposition Proceeding in which it made certain determinations based on its review of the pleadings. In its Order, it denied Petitioner's attack on the sufficiency of BBK Pictures' pleadings by stating that "Opposer's filing of its trademark application constitutes constructive use [of its trademark], such that opposer's claim is sufficiently based upon a claim of prior use of an allegedly similar mark."<sup>3</sup> Based on this Order, Petitioner has had knowledge of BBK Pictures' reliance on its word mark BOSTON TEA for purposes of the Opposition Proceeding from at least as far back as the Board's May 2014 order.

**C. BBK Pictures Asserted its Registration as Soon as it was Issued and Did Not Cause Undue Delay**

Petitioner cites the fact that BBK Pictures caused delay in the expedited schedule as a basis for its untimely counterclaim, however this is an unfair characterization of the timeline of events and of which party is to be blamed for any delay in these proceedings. BBK Pictures' original reply brief was due on January 14, 2015. BBK Pictures did require delay of depositions, however the

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<sup>2</sup> See Opposition Docket Entry 1, Filed and Fee, at paragraph 16 ("The Alleged Mark so resembles *Opposer's BOSTON TEA Mark* as to be likely, when used on or in connection with the goods identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's Alleged Mark is therefore unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. Section 1052(d).") (emphasis added).

<sup>3</sup> See Opposition Docket Entry 5, Board's Order Re Telephone Conference, at page 3.

delay was based on valid health reasons of its intended 30(b)(6) witness. The delay required limited extensions of the Opposition Proceeding deadlines, making BBK Pictures' reply brief due on April 1, 2015. This amounts to an approximately *2.5 month delay* in the Opposition Proceeding, during which time Petitioner was on notice that BBK Pictures was relying on its application for BOSTON TEA in the Opposition Proceeding which was filed December 24, 2013. It is Petitioner who has and continues to cause *significant* delay in this matter by waiting more than *twenty months* after the time the Notice of Opposition was filed to finally assert grounds for this Cancellation Proceeding. Petitioner has provided no valid excuse for the untimely filing of its Petition without notice to the Board.

### III. Conclusion

Petitioner Boston Iced Tea Company's petition for cancellation should be dismissed because the substance of its petition for cancellation has not been timely asserted. Accordingly, Registrant BBK Pictures respectfully asks the Board to dismiss this cancellation proceeding with prejudice.

RESPECTFULLY SUBMITTED,  
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Dated: August 28, 2015

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Registrant's Reply to Petitioner's Opposition to Registrant's Motion to Dismiss the Cancellation Proceeding for Failure to State a Claim under Rule 12(b)(6) has been served this day, August 28, 2015, on Roger N. Behle, Jr. Esquire, counsel for Petitioner Boston Iced Tea Company, Inc., via First Class Mail, postage prepaid, and electronic mail at the following address:

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