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

Proceeding	92062314
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF REGISTRATION NO. 3,850,126
for the mark JOE’S TASTY TRAVELS & Design
registered September 21, 2010

TRADER JOE’S COMPANY,)	Cancellation No. 92062314
)	
Petitioner,)	
)	
v.)	
)	
DOWNRIGHT HEALTHY FOODS L.P.,)	
)	
Registrant.)	
_____)	

PETITIONER’S OPPOSITION TO RESPONDENT’S MOTION TO DISMISS

Petitioner Trader Joe’s Company (“Trader Joe’s”) hereby submits its brief in opposition to Respondent Downright Healthy Foods L.P.’s motion to dismiss the Petition to Cancel (the “Petition”). For the reasons set forth below, Trader Joe’s respectfully requests that the Trademark Trial and Appeal Board deny Respondent’s motion and allow the cancellation proceedings to go forward.

I. INTRODUCTION

The Board should deny Respondent’s motion to dismiss. Over the past six decades, Petitioner Trader Joe’s has grown from a small chain of convenience stores in the Los Angeles area into a nationwide chain of nearly 400 grocery stores. It has done so by using the mark TRADER JOE’S to identify not only its retail grocery stores and services, but also the vast majority of food and beverage products it sells in its stores. Trader Joe’s has worked tirelessly to ensure that its customers closely associate Trader Joe’s and its TRADER JOE’S marks with original, high-quality products at low prices. Trader Joe’s has also developed a family of marks

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that build off the fame and goodwill of its TRADER JOE'S mark, such as TRADER JOE-SAN for Japanese food, TRADER MING'S for Chinese food, and TRADER DARWIN'S for vitamins and mineral supplements.

Trader Joe's brought this cancellation action to challenge a mark, JOE'S TASTY TRAVELS & Design (the "Mark"), that has had no apparent use in commerce for nine years (or ever) but whose continuing registration is causing injury and damage to the valuable goodwill that Trader Joe's has built up in its trademarks. Accepting all of the allegations as true, as the law requires on a motion to dismiss, Trader Joe's Petition states three valid grounds for cancellation. The Petition's abandonment ground is amply supported by Respondent's nonuse for at least three years, as alleged in the Petition, which is prima facie evidence that the Mark has been abandoned. 15 U.S.C. § 1127. The Petition also states a valid ground for fraud by setting forth the specific false statement that Respondent made to the USPTO concerning its bona fide intention to use the Mark and properly pleading the other elements of the claim. Finally, the Petition pleads facts sufficient to show that Respondent lacked a bona fide intent to use the Mark at the time it filed its trademark application. In light of the USPTO's policy of clearing deadwood registrations from the Principal Register, the Board should find an exception to Section 14's five-year time bar and cancel Respondent's registration because the underlying application was void *ab initio*.

In short, Respondent's motion is meritless, and it should be denied in its entirety. In the alternative, if the Board is inclined to grant any part of Respondent's motion, Trader Joe's respectfully requests leave to amend the Petition to allege additional facts supporting its claims.

II. STATEMENT OF FACTS

Respondent filed application Serial No. 78/925,445 on July 10, 2006 pursuant to Section 44(d) of the Lanham Act, on the basis of a previously filed Canadian trademark application.

Petition to Cancel (“Pet.”) ¶ 1. As required by Section 44(d), Respondent submitted a sworn declaration stating that Respondent had “a bona fide intention” to use the mark JOE’S TASTY TRAVELS & Design in commerce in connection with the goods identified below:

Non-alcoholic beverages; fruit juices and drinks; vegetable juices and drinks; fruit and vegetable juices and drinks; bottled, carbonated and non carbonated water; coffee; coffee, espresso, and cappuccino mixes; beverage powders; drink crystals; loose and bagged black, green and herbal teas; coffee beans; sodas and colas; carbonated and noncarbonated drinks; dairy based beverages; all types of edible nuts, namely candied nuts, chocolate covered nuts, fresh nuts, raw nuts, unprocessed nuts, shelled nuts, roasted nuts, processed nuts, salted nuts, unsalted nuts, flavoured nuts; edible seeds; pumpkin and sunflower seeds; dried fruits; dried fruit mixes; dried fruit and nut mixes; trail mixes; fruit chips; preserved fruits; sugared fruits; dried prunes, dates, raisins and coconut; glazed fruits; glazed cherries; jams and jellies; confectionery, namely chocolate and candy; spices and seasonings; soup mixes; condiments; sauces; soya sauces; vinegars; various uncooked pastas and noodles; egg noodles; salad dressings; spreads; dips; salsas; snack foods, namely potato chips, puffed corn snacks, sesame sticks, crackers, wafers, cheese puffs, corn based snacks, pretzels, cookies, biscuits, tortilla chips, corn chips; puffed cheese flavoured products; croutons; baking goods, namely cake mixes, muffin mixes, brownie mixes, pastry mixes, baking decorations, chocolate chips and peanut butter chips, candy mints, baking crumbs, baking powder, baking soda, crust mixes, fruit jelly powders, graham crumbs, corn starch, vanilla extract, fruit fillings; syrups; extracts and food colourings for human consumption; flavoured and unflavoured gelatins; yeast; cocoa powder; white, brown, and raw sugar and sugar substitutes; marshmallows; popped and popping corn of various flavours; microwaveable popcorn; seasonings for popcorn; frozen entrees; frozen fruits and vegetables; prepared foods; canned goods; cooking oils; edible oils for human consumption; oil based salad dressings; flours; grains; cereals; lentils; pulses; rolled oats and oatmeal; wheat germ; rices; pickled vegetables and fruits; peanut brittle; peanut butter and other nut butters; honey; soy based products and beverages.

Id. ¶ 2. In the more than nine years since application Serial No. 78/925,445 was filed,

Respondent has not used the Mark in commerce in connection with any of the goods identified above. *Id.* ¶ 4.

On September 21, 2010, Respondent's trademark application matured to registration on the basis of Section 44(e), and Respondent was issued U.S. Registration No. 3,850,126 (the "Registration") for the mark JOE'S TASTY TRAVELS & Design for the following goods:

International Class 29: Dairy based beverages; edible nuts, namely, candied nuts, shelled nuts, roasted nuts and processed nuts; processed salted, unsalted and flavored nuts; processed edible seeds; processed pumpkin and sunflower seeds; dried fruit, dried fruit mixes, dried fruit and nut mixes, and fruit chips; trail mixes containing dried fruits, seeds and nuts; preserved fruits; sugared fruits, namely, crystallized fruit and candied fruits; dried prunes, dates, raisins and coconut; glazed fruits, glazed cherries, jams and jellies; soup mixes; condiments, namely, pepper oil; sauces, namely, cranberry sauce; spreads, namely, cheese spreads, fruit-based spreads, hummus; dips, namely, bean dip, dairy-based dip, and snack dip; snack foods, namely, potato chips; baking goods, namely, fruit-based fillings for cakes and pies; unflavored and unsweetened gelatins; frozen entrees consisting primarily of meat, fish, poultry or vegetables; frozen vegetarian entrees; frozen fruits and vegetables; edible oils for human consumption; lentils; pulses; pickled fruits and vegetables; peanut butter and nut butters; soy-based foods, namely, soy-based chips, soy-based food bars, soy-based snack food.

International Class 30: Coffee, coffee beans; coffee, espresso and cappuccino mixes containing coffee powder; loose and bagged black, green and herbal teas; chocolate covered nuts; confectionery, namely, chocolate and candy; spices and seasonings; condiments, namely, pepper sauce, ketchup, mustard, mayonnaise, relish; sauces, namely, chili sauce, hot sauce, dipping sauces, barbeque sauces, pizza sauce, fish sauce, tomato sauce, teriyaki sauce, soy sauce, tamari sauce, tartar sauce, steak sauce, and ready-made sauces; vinegar, salsa; uncooked pasta and noodles, including egg noodles; salad dressings, oil based salad dressings; spreads, namely, cocoa spreads and spreads containing chocolate and nuts; snack foods, namely, puffed corn snacks, sesame sticks, crackers, wafers, cheese flavored puffs, corn-based snacks, pretzels, cookies, biscuits, tortilla chips and corn chips; croutons; baking goods, namely, cake mixes, muffin mixes, brownie mixes, pastry mixes, chocolate chips, peanut butter confectionery chips, candy mints, baking powder, baking soda, crust mixes for pies, fruit jelly powders, graham cracker crumbs, corn starch, vanilla extract used as a flavoring, yeast, cocoa powder, flours, and white, brown and raw sugar and sugar substitutes; baking goods, namely, candy cake decorations; syrups, namely, corn syrups, maple syrups, pancake syrups, chocolate syrups; extracts, namely, natural and artificial extracts used as a flavoring; flavored and sweetened gelatins; marshmallows; popped and popping corn of various flavors, microwaveable popcorn, seasonings for popcorn; frozen entrees consisting primarily of pasta or rice; processed grains; processed cereals; rolled oats and oatmeal; wheat germ; rice; peanut brittle; honey; and graham crumbs.

International Class 31: Edible nuts, namely, fresh nuts, raw nuts and unprocessed nuts; unprocessed edible seeds; unprocessed grains.

International Class 32: Non-alcoholic beverages, namely, carbonated beverages, beverages containing fruit juice, low calorie soft drinks, non-alcoholic beverages with tea flavor, fruit juices, fruit drinks, vegetable juices, vegetable drinks, fruit and vegetable juices, fruit and vegetable drinks; beverage powders and crystals, namely, used in the preparation of fruit drinks; colas; sodas in the nature of soda water, and flavored soda water; carbonated and non-carbonated soft drinks; soy-based beverages not being milk substitutes.

Id. ¶¶ 1–2. In the more than five years since the Registration issued, the Mark has not been used in commerce in connection with the goods identified in the Registration. *Id.* ¶¶ 4, 14.

On September 25, 2015, Trader Joe’s filed a petition to cancel the Registration asserting the following grounds for cancellation: (1) abandonment of the Mark; (2) fraud in the procurement of the Registration; and (3) void *ab initio* for lack of bona fide intent to use the Mark. *Id.* ¶¶ 3–6. Respondent filed the instant motion to dismiss on November 4, 2015.

III. ARGUMENT

A motion to dismiss for failure to state a claim is a test solely of the legal sufficiency of a petition. *See Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 1160–61 (Fed. Cir. 1993). To withstand such a motion, a petition need only allege facts that, if proven, establish that the petitioner is entitled to the relief sought. *Young v. AGB Corp.*, 152 F.3d 1377, 1380 (Fed. Cir. 1998); *Doyle v. Al Johnson’s Swedish Restaurant & Butik Inc.*, 101 U.S.P.Q.2d 1780, 1782 (T.T.A.B. 2012). All material allegations in the petition are accepted as true and construed liberally in favor of the non-moving party. *See Advanced Cardiovascular Sys.*, 988 F.2d at 1161. A petition alleges a valid ground for cancellation if it “contain[s] sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). In particular, a claim “has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is

liable for the misconduct alleged.” *Id.* Each of the grounds for cancellation contained in Trader Joe’s Petition easily meets this standard.

A. Trader Joe’s Petition States a Valid Ground for Cancellation Based on Abandonment.

A claim for cancellation of a registration may be filed at any time if the registered mark has been abandoned. *See* 15 U.S.C. § 1064(3). A mark is deemed abandoned “[w]hen its use has been discontinued with intent not to resume such use”; “[n]onuse for 3 consecutive years” is “prima facie evidence of abandonment.” 15 U.S.C. § 1127. A prima facie showing of abandonment “creates a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use.” *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010). This rebuttable presumption of abandonment based on three years of nonuse may also be “invoked against a Section 44(e) registrant”—like the Respondent in this case—“who never begins use of the mark or who discontinues using the mark.” *City Nat’l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 U.S.P.Q.2d 1668, 1678 (T.T.A.B. 2013). Once the rebuttable presumption of abandonment arises, the trademark owner then bears the burden “to produce evidence that he either used the mark during the statutory period or intended to resume use.” *Crash Dummy Movie*, 601 F.3d at 1391.

To survive a motion to dismiss a claim for abandonment, a petition need only allege facts that set forth a prima facie case based on three years of nonuse. *See Otto Int’l, Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1863 (T.T.A.B. 2007). Trader Joe’s Petition clearly satisfies this requirement. The facts alleged in the Petition, which must be accepted as true, are: (1) the Registration issued on September 21, 2010 for a wide range of goods across four International Classes and (2) Respondent has not used the Mark in commerce for the goods identified in the Registration since the date it issued more than five years ago or at any point in the past nine

years. *See* Pet. ¶¶ 1–2, 4–6. Based on Respondent’s nonuse of the Mark for at least three years, the Mark is presumed abandoned and Respondent now bears the burden of rebutting that presumption. 15 U.S.C. § 1127; *City Nat’l Bank*, 106 U.S.P.Q.2d at 1678–79 (granting petition to cancel on ground of abandonment where the registration holder had not used the mark in commerce since the registration issued, resulting in over three years of nonuse, and failed to rebut the statutory presumption of abandonment).

Respondent’s contention that the Petition does not specify “which, if any, of the goods listed in the registration are the subject of Petitioner’s claim” is irrelevant. *See* Mot. at 7. The Registration claims trademark rights for dozens of goods across four International Classes, and Respondent has not used the Mark in commerce for at least three years on *any* of the claimed goods. *See* Pet. ¶¶ 4, 8, 14. Accordingly, the Petition seeks cancellation of the Registration in its entirety. *See id.* ¶ 17. To the extent Respondent is able to rebut the statutory presumption of abandonment with regard to one or more of the goods identified in the Registration, the Petition also seeks partial cancellation “to eliminate all goods for which Respondent has abandoned use of the mark.” *Id.*; *see also Johnson & Johnson & Roc Int’l S.A.R.L. v. Obschestvo s Ogranitchennoy*, 104 U.S.P.Q.2d 2037, 2039 (T.T.A.B. 2012) (partial abandonment is a valid ground for cancellation). The Petition thus provides fair notice of Trader Joe’s theory of abandonment, and no more is required at this stage of the proceedings. *See Otto*, 83 U.S.P.Q.2d at 1863.

In sum, because Trader Joe’s Petition alleges facts establishing a prima facie case that the Mark has been abandoned due to at least three years of nonuse, the Petition states a valid ground for cancellation based on abandonment. The Board should therefore deny Respondent’s motion to dismiss Trader Joe’s abandonment claim.

B. Trader Joe’s Petition States a Valid Ground for Cancellation Based on Fraud.

A petition adequately states a claim of fraud where it alleges that the registrant “obtained its registration fraudulently by knowingly making a false, material representation of fact with the intent to deceive the United States Patent and Trademark Office.” *Caymus Vineyards v. Caymus Med., Inc.*, 107 U.S.P.Q.2d 1519, 1522 (T.T.A.B. 2013); *Petróleos Mexicanos v. Intermix S.A.*, 97 U.S.P.Q.2d 1403, 1408 (T.T.A.B. 2010). Although “the circumstances constituting fraud” must be pled “with particularity,” “[m]alice, intent, knowledge, and other conditions of a person’s mind may be alleged generally.” Fed. R. Civ. P. 9(b); *see also Caymus*, 107 U.S.P.Q.2d at 1522.

The Petition clearly identifies the specific false statement that Respondent through its attorney¹ made to the USPTO in connection with its trademark application—namely, that it had “a bona fide intention” to use the Mark in commerce in connection with dozens of specified goods. Pet. ¶ 2. Contrary to Respondent’s assertions, the Petition also contains facts to support the falsity of this statement—that “over nine years after Respondent filed the Application,” it has not used the Mark “in commerce in connection with any of the goods identified in the Application.” *Compare* Mot. at 5 with Pet. ¶ 8. Respondent also erroneously contends that its post-application lack of use has no bearing on the falsity of its sworn statement to the USPTO about its bona fide intention to use the Mark “at the time the underlying application was filed.” Mot. at 5. Respondent is effectively asking the Board to weigh the evidence, which is improper on a motion to dismiss. *See Miller v. Currie*, 50 F.3d 373, 377 (6th Cir. 1995). Moreover, the facts alleged in the Petition—Respondent’s statement to the USPTO about its bona fide intention

¹ “It is well settled that a client is bound by the actions of its attorney.” *Caymus*, 107 U.S.P.Q.2d at 1523 n.5.

to use the Mark and its subsequent nine years of nonuse—have the requisite “facial plausibility” that would allow a court to easily infer that Respondent’s statement was false. *Iqbal*, 556 U.S. at 678.

The Petition also contains facts sufficient to support the allegation that Respondent acted with an intent to deceive. Although such intent need only be averred generally, *Caymus*, 107 U.S.P.Q.2d at 1522, Respondent’s lack of any use of the Mark provides ample evidence of its intent. See *In re Bose*, 580 F.3d 1240, 1241 (Fed. Cir. 2009). Because evidence of deceptive intent is rarely available, “such intent can be inferred from indirect and circumstantial evidence”—here, Respondent’s nine years of nonuse since its Application was filed. *Bose*, 580 F.3d at 1241.

Respondent overreaches by suggesting that statements made on “information and belief” can never be used to support allegations of fraud. See Mot. at 4. If Respondent were correct, an injured party would never be able to cancel a fraudulently procured registration under Section 44(e) where, as here, the relevant information is within the possession and control of the Respondent. As the Board has previously held, the primary means of demonstrating a lack of bona fide intent to use a mark is documentary evidence evincing such an intent. See *Honda Motor Co. v. Winkelmann*, 90 U.S.P.Q.2d 1660, 1662 (T.T.A.B. 2009). Because this documentary evidence typically consists of internal corporate documents, a petitioner would rarely (if ever) possess such evidence and facts when preparing a petition to cancel without the benefit of discovery. See *id.* Trader Joe’s should not be required to prove a negative without the benefit of discovery as a prerequisite to filing a cancellation petition, nor should Trader Joe’s be punished for conservatively relying on “information and belief” language in its allegations.

As for the remaining two elements—that Respondent “knowingly” made a false representation and that it was material—these too are adequately pled. The Petition alleges that Respondent “knew” its statement “was false or misleading”—a general averment about Respondent’s state of mind that satisfies Federal Rule of Civil Procedure 9(b).² Pet. ¶ 9; *see Caymus*, 107 U.S.P.Q. 2d at 1522. And the Petition sets forth how the false statement was material to the issuance of the Registration—“But for the false statement in the Application, the United States Patent and Trademark Office would not have approved the Application for registration for the goods identified in the Registration.” Pet. ¶ 10.

Because the Petition properly alleges that Respondent procured its Registration “fraudulently by knowingly making a false, material representation of fact with the intent to deceive the United States Patent and Trademark Office,” *Caymus*, 107 U.S.P.Q.2d at 1522, the Petition states a valid claim for fraud. Respondent’s motion to dismiss the fraud claim should thus be denied.

C. Trader Joe’s Petition States a Valid Ground for Cancellation Based on Lack of Bona Fide Intent to Use.

Under Section 44—the Lanham Act’s incorporation of certain international agreements involving trademark law, including the Paris Convention—a foreign trademark applicant seeking priority from a foreign application or registration must file a declaration of bona fide intention to use the mark in commerce in the United States. 15 U.S.C. § 1126(d)–(e). Trader Joe’s alleges that Respondent—who, for more than nine years, has *never* used the Mark in commerce in connection with any of the goods identified in the Application—lacked a bona fide intention to

² Registrant complains about the Petition’s use of the phrase “knew or should have known,” but this isolated statement should not be given undue weight. Pet. ¶ 9. Paragraphs 10 and 12 consistently refer to Respondent’s statement as “knowingly” false. Indeed, as the Federal Circuit has previously noted, “one should not unduly focus on the phrase ‘should know’ and ignore the facts of the case,” which here raise an inference of intent to deceive. *See Bose*, 580 F.3d at 1245.

use the Mark in commerce when it submitted its Section 44(d) application in 2006. Pet. ¶¶ 3–4. This lack of bona fide intent renders the trademark application underlying the Registration void *ab initio* and mandates cancellation of the Registration. See *Sandro Andy, S.A. v. Light Inc.*, No. 12 CIV. 2392 HB, 2012 WL 6709268, at *2–3 (S.D.N.Y. Dec. 27, 2012) (discussing a similar bona fide intent requirement for Madrid Protocol applications under Section 66). Trader Joe’s thus states a third, independent ground for cancellation of the Registration.

Respondent cites no cases standing for the proposition that Trader Joe’s lack of bona fide intent challenge is barred by Section 14. The Federal Circuit has stressed that Section 44 is not meant to give foreign registrants any “advantage in the *maintenance* of [their] registration” over U.S. registrants. *Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1578 (Fed. Cir. 1990) (emphasis added). Yet Respondent’s position, if adopted, would do just that: It would confer incontestable status on a mark that *Respondent has never claimed to have used in commerce*. Whereas Sections 1(a) and 1(b) require the registrant to file a statement of use before a registration will issue, Section 44 does not. In fact, a Section 44 registrant is not required to provide *any* evidence that it has actually used the registered mark until its Section 8 declaration of use becomes due *between the fifth and sixth years after* the date of registration. 15 U.S.C. § 1058. Thus, whereas a Section 1(a) or Section 1(b) registrant only benefits from Section 14’s limits on cancellation proceedings after at least five years of using its mark, Respondent’s proposed reading of Section 14 would apply these benefits to Section 44 registrants, like Respondent, before any claimed use. Moreover, under Respondent’s proposed reading, a Section 44 registrant would be shielded from challenges to its declared intention to use the mark *for a full year before* having to confirm that it has followed through on that representation.

In addition to providing foreign registrants with an unfair advantage in the maintenance of their registrations, *see Imperial Tobacco*, 899 F.2d at 1578, Respondent’s argument also contravenes Congress’s primary rationale for requiring a declaration of bona fide intent to use from Section 44 applicants: to prevent the Principal Register from becoming cluttered with “deadwood” (*i.e.*, marks unused for some or all of the goods identified in their registrations). *See generally* Daniel R. Bereskin, et al., *Bona Fide Intent to Use in the United States and Canada*, 100 TRADEMARK REP. 709 (2010). The elimination of deadwood has also been the subject of renewed efforts by the USPTO in recent years. *See* U.S. Patent & Trademark Office, PTO-T-2012-0031, *Request for Comments Regarding Amending the First Filing Deadline for Affidavits or Declarations of Use or Excusable Nonuse* (Aug. 10, 2012); U.S. Patent & Trademark Office, *Post Registration Proof of Use Pilot Final Report* (Aug. 25, 2015).

The Board has previously held that Section 14’s enumerated grounds for cancellation after five years are not exhaustive. *See, e.g., British-American Tobacco Co. v. Philip Morris Inc.*, 55 U.S.P.Q.2d 1585, 1590 (T.T.A.B. 2000) (concluding that Section 14 should not be read to apply a five-year time limit to claims based on Article 8 of the Pan American Convention). Section 14 must be construed in a manner that is consistent with the stated purpose of Section 44 and the Paris Convention—to put foreign and domestic trademark owners on equal footing. *See* Paris Convention for the Protection of Industrial Property, arts. 2, 6^{quinquies}, Mar. 20, 1883, 21 U.S.T. 1583, 828 U.N.T.S. 305. Respondent’s reading directly contravenes this purpose.

As discussed in Part III.B above, Trader Joe’s has pled facts sufficient for the Board to infer that Trader Joe’s is likely to obtain in discovery all evidence necessary to prove that Respondent lacked a bona fide intent to use the mark. *See, e.g., Spirits Int’l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 U.S.P.Q.2d 1545 (T.T.A.B. 2011)

(lack of bona fide intent established through respondent's discovery responses). Thus, the Board should deny Respondent's motion to dismiss Trader Joe's void *ab initio* claim.

D. Trader Joe's Allegations of Likelihood of Confusion Establish Standing and Do Not Purport to Bring a Separate Claim.

Respondent misapprehends the significance of Trader Joe's allegations of likelihood of confusion: Trader Joe's asserts a likelihood of confusion between Respondent's mark JOE'S TASTY TRAVELS and Trader Joe's registered mark TRADER JOE'S to establish Trader Joe's standing to file the petition, not as a separate basis for cancellation of Respondent's mark. *See Imperial Tobacco*, 899 F.2d at 1580 n.7. "While likelihood of confusion could not be the basis for cancellation after five years, such allegations can afford standing." *Id.* Respondent's challenge to Paragraph 19 of the petition therefore lacks merit.

IV. CONCLUSION

Because each of the three bases for cancellation asserted in the Petition have been adequately pled, Respondent's motion should be denied on all grounds.³

WHEREFORE, Trader Joe's requests the Board deny Respondent's Motion to Dismiss on all grounds. In the event that the Board should find the petition in any way insufficient, Trader Joe's respectfully requests the Board dismiss the relevant claim or claims without prejudice, granting Trader Joe's leave to amend to remedy any deficiencies.

³ Should the Board grant Registrant's motion to dismiss as to any of Trader Joe's claims, Trader Joe's respectfully requests leave to file an amended Petition. Such requests are routinely granted. *See, e.g., Asian & W. Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, 1480 (T.T.A.B. 2009) (granting leave to amend fraud claim); *Otto Int'l*, 83 U.S.P.Q.2d at 1864 (granting leave to amend claims of abandonment and misrepresentation of source). Indeed, "it is the policy of the Board to allow parties to amend insufficient pleadings." *Zoba Int'l Corp. DBA CD Digital Card*, Cancellation No. 9205182, 2011 WL 1060727, at *5 (T.T.A.B. Mar. 10, 2011) (citing *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1208 (T.T.A.B. 1997)).

Dated: November 24, 2015

Respectfully submitted,

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