



Attorney Docket No.: 248111US33

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

TEQUILA CENTINELA, S.A. de C.V.,

Opposer,

v.

BACARDI & COMPANY LIMITED,

Applicant.

TTAB

Opposition No.: 91/160,956
Appln. Serial No. 78/149,334

The Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, VA 22202-3514

OPPOSER'S OPPOSITION TO APPLICANT'S RENEWED MOTION TO DISMISS

Preliminary Statement

Opposer, Tequila Centinela, S.A. de C.V. ("Centinela"), herein opposes Applicant's Renewed Motion to Dismiss. Centinela's Amended Notice of Opposition (filed on August 18, 2004) sets forth a short and plain statement of how it will be damaged and the grounds for its Opposition, in accordance with Trademark Rule 2.104. *See Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995). Centinela's Amended Notice of Opposition (i) clarifies the legal grounds for objection to the registration of Applicant's Application Serial No. 78/149,334 for TEQUILA CAZADORES REPOSADO ETC. & Design, and (ii) is legally sufficient to survive Applicant's renewed motion to dismiss the captioned Opposition.



09-22-2004

Uncontested Facts

The following facts are matters of public record and/or are conceded by Applicant:

1. On July 31, 2002, Applicant filed Application Serial No. 78/149,334 for the mark TEQUILA CAZADORES RESPOSADO ETC. & Design for "alcoholic beverages, namely tequila" (App's Renewed Mtn. to Dismiss, p. 2).

2. In a related proceeding, Opposition No. 91/123,436, Applicant opposed Centinela's Application Serial No. 76/112,825 for the mark CABRITO & Design for alcoholic beverages, based in part on likelihood of confusion with Applicant's mark TEQUILA CAZADORES RESPOSADO ETC. & Design (App's Renewed Mtn. to Dismiss, p. 2).

3. In Opposition No. 91/123,436, Applicant will rely, at least in part, on the registration issuing from Application Serial No. 78/149,334 as part of its grounds for Opposition (App's Renewed Mtn. to Dismiss, p. 3).

4. In Opposition No. 91/123,436, Centinela challenged Applicant's ownership of the mark TEQUILA CAZADORES RESPOSADO ETC. & Design of Application Serial No. 78/149,334, as well as Applicant's ownership of the mark CAZADORES of Registration No. 1,863,882 (App's Renewed Mtn. to Dismiss, p. 2).

5. In the captioned Opposition, Centinela filed its Notice of Opposition on June 21, 2004. On July 29, 2004, Applicant moved to dismiss Centinela's Notice of Opposition for its failure to properly assert grounds for relief. On August 18, 2004, Centinela responded to Applicant's motion to dismiss, and simultaneously moved to amend its Notice of Opposition. Centinela attached a proposed Amended Notice of Opposition to its papers. On September 2, 2004, Applicant renewed its motion to dismiss, attacking the adequacy of Centinela's Amended Notice of Opposition.

Argument

I. The Amended Notice of Opposition Adequately Pleads a Claim for Relief

A. Pleading Requirements

To survive a motion to dismiss, all that is required of Centinela is to provide a short and plain statement of how it will be damaged and the grounds for its Opposition. Trademark Rule 2.104; *Order of Sons of Italy*, 36 USPQ2d at 1222 (TTAB 1995). Centinela's Amended Notice of Opposition meets these requirements.

B. Standing

Applicant criticizes Centinela's Notice of Opposition as "not [having] stated any basis for damages" (App's Renewed Mtn. to Dismiss, p. 4). This is the incorrect standard, and in any event Applicant's assertion is incorrect.

As the Board stated in *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385-86 (TTAB 1991):

The standing question is an initial and basic inquiry made by the Board in every inter partes case; that is to say, standing is a threshold inquiry. This inquiry is directed solely to establishing the personal interest of the plaintiff. The continuing pronouncements of the Federal Circuit leave us with the understanding that there is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding. The Court has stated that an opposer need only show "a personal interest in the outcome of the case beyond that of the general public." (Citations omitted). Once this threshold has been crossed, the opposer may rely on any ground that negates applicant's right to the registration sought. (Emphasis added.)

The Board also equates "standing" with the requirement of showing "damage" as specified in Trademark Act Section 13, 15 U.S.C. § 1063:

The term "damage" as used in Section[] 13 of the Act, 15 USC []§ 1063 ..., concerns specifically a party's standing to file an opposition A party may establish standing to oppose ... by showing that it has a "real interest" in the case, that is, a personal interest in the outcome of the proceedings and a reasonable

basis for its belief in damage. There is no requirement that actual damage be pleaded and proven in order to establish standing. (Emphasis added.)

TBMP 303.03; *see also Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (standing requires only that the party seeking cancellation believe that it is likely to be damaged by the registration).

Centinela's Amended Notice of Opposition adequately asserts Centinela's standing to maintain this Opposition. Centinela asserted its rights in the CABRITO & Design mark and Centinela's reasonable belief of damage to its rights in that mark should Application Serial No. 78/149,334 (for the mark TEQUILA CAZADORES RESPOSADO ETC. & Design) proceed to registration (Amended Ntc. of Opp., ¶¶ 2-4, 7-9).

C. Grounds for Opposition

Applicant also contends that Centinela "has failed to allege any statutory or other reasonable basis for it to be granted judgment in the opposition" (Applicant's Renewal Motion to Dismiss, p. 1). Again, Applicant's assertion is incorrect.

One statutory ground for opposition is likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). To survive a motion to dismiss, all that is required of Centinela is to provide a short and plain statement of its priority of trademark rights and likelihood of confusion. *See Otto Roth & Co. v. Universal Foods Corp.*, 209 USPQ 40, 43 (CCPA 1981), *on remand*, 215 USPQ 1140 (TTAB 1982).

Centinela adequately plead its grounds for opposition. Centinela asserted its priority of rights in the mark CABRITO & Design and Applicant's claim of likelihood of confusion with its TEQUILA CAZADORES RESPOSADO ETC. & Design mark in Opposition No. 91/123,436. Centinela also asserted, hypothetically, likelihood of confusion between Centinela's CABRITO

& Design mark and Applicant's TEQUILA CAZADORES RESPOSADO ETC. & Design mark (Amended Ntc. of Opp., ¶¶ 6-9).

“For purposes of ruling on a motion to dismiss ..., a reviewing court [here, the Board] must accept as true all well-pled and material allegations of the complaint [here, Centinela's Amended Notice of Opposition], and must construe the complaint in favor of the complaining party [here, Centinela].” *Ritchie v. Simpson*, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999). Viewed from this standard, Centinela's Notice of Opposition sufficiently pleads standing and grounds for relief. Matters of Centinela's “credibility” and “pro[ofs] at trial” (Applicant's Renewed Motion to Dismiss, p. 4) are the subjects of later discovery.

II. Applicant's Papers Do Not Need Meet the High Standard for a Motion to Dismiss

As it recognizes in its Renewed Motion to Dismiss (at p. 3), Applicant must “meet a high standard” before Centinela's Amended Notice of Opposition will be dismissed by the Board. Dismissal is appropriate only if “it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief.” *Conley v. Givson*, 355 U.S. 41, 45-46 (1957); *see also Stanspec Co. v. Amer. Chain & Cable Co.*, 531 F.2d 563, 566 (CCPA 1976). Applicant has not met this standard, and its motion to dismiss should be denied. Centinela's Amended Notice of Opposition meets the requirements for pleading its standing and grounds for relief.

III. Applicant's Papers Do Not Explain Why Centinela's Motion to Amend its Notice of Opposition Should Be Denied

Leave to amend a party's pleading is to “be freely given when justice so requires.” Rule 15(a), Fed. R. Civ. P., as applied to Board proceedings through Trademark Rules 2.116(a) and (c). Applicant has not claimed any prejudice as a result of Centinela's requested amendment.

After Centinela's Motion to Amend is granted, Applicant will still have a full opportunity for discovery on the merits of Centinela's amended claims, which will allow for a full adjudication on the merits. *See Space Base, Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1216, n.1 (TTAB 1990) (motion to amend pleadings granted in the interest of justice, and judicial economy served by allowing all claims to go forward and be adjudicated in one proceeding). Opposer has not delayed in bringing its motion to amend, and Applicant will not be prejudiced by the amendment. The grounds for Centinela's requested amendment only became apparent in responding to Applicant's original Motion to Dismiss, filed on July 29, 2004.

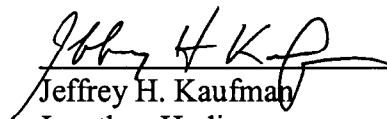
Conclusion

Accordingly, Applicant's Renewed Motion to Dismiss the Opposition should be denied. Opposer's earlier-filed motion for leave to file its Amended Notice of Opposition should be granted.

Respectfully submitted,

TEQUILA CENTINELA, S.A. de C.V.

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S RENEWED MOTION TO DISMISS** was served on counsel for Applicant, this 22nd day of September, 2004, by sending same via First Class mail, postage prepaid, to:

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