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Our File: 2778-157

Trademark Trial and Appeal Board  
United States Patent & Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

*Re: American Italian Pasta Company v. Barilla .G.E.R. Fratelli-Societa Per Azioni*  
*Opposition No. 91161373 / 78136703*

Dear Sir:

We enclose for filing with the Trademark Trial and Appeal Board  
**APPLICANT'S REPLY IN FURTHER SUPPORT OF MOTION FOR SUMMARY  
JUDGMENT AND MOTION TO REOPEN.**

No fee is believed necessary. The Commissioner for Trademarks is hereby  
authorized to draw on the deposit account of Rothwell, Figg, Ernst & Manbeck, Account  
No. 02-2135, if a fee is deemed necessary.

Please call if there are any questions.

Very truly yours,

Carla C. Calcagno

CCC/jea  
Enclosure



03-27-2006

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #25

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

American Italian Pasta Company )

Opposer, )

v. )

Barilla G. E R. Fratelli-Società Per Azioni )

By change of name), )

Applicant. )

OPPOSITION NO. 91161373

**APPLICANT'S REPLY IN FURTHER SUPPORT OF**  
**MOTION FOR SUMMARY JUDGMENT AND**  
**MOTION TO REOPEN**

**I. INTRODUCTION AND RESTATEMENT OF THE ISSUES**

**A. Applicant Has Moved for Summary Judgment on Three Separate and Independent Grounds**

As clearly set forth on page 1 of Applicant's brief, Applicant moved for summary judgment on three separate and independent grounds. These are:

- (1) that Opposer's alleged word mark AMERICA'S FAVORITE PASTA is inherently merely descriptive;
- (2) that Opposer's alleged word mark AMERICA'S FAVORITE PASTA is incapable as a matter of law from acquiring such distinctiveness; and
- (3) that Opposer's alleged word mark AMERICA'S FAVORITE PASTA has not acquired distinctiveness.

It is well-settled that the Board may enter partial summary judgment and should do so where it would result in a savings of time and judicial economy for the Board. Fed. R. Civ. P. 56 and TBMP §528.

Attempting to deflect the Board from a clear and unambiguous record, Opposer begins its brief by arguing that Applicant's Motion argues only that Opposer's mark has not acquired distinctiveness. This argument is utterly wrong. As described above, Applicant moved for summary judgment on three separate and independent grounds.

Opposer expressly concedes that its alleged mark is merely descriptive. Thus the Board must enter partial summary judgment on this basis. As to the remaining grounds, and as more fully described below, Opposer failed to counter Applicant's substantial evidence that Opposer's alleged mark is incapable of and has in fact not acquired distinctiveness. Because of this, the Board must enter summary judgment in Applicant's favor.

## **II. STANDARDS FOR SUMMARY JUDGMENT**

As Opposer points out, the standards for summary judgment are well settled. A motion for summary judgment is a pre-trial device to dispose of cases in which the "the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." See, *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Anderson v. Liberty Lobby Inc.*, 477 U.S. 242 (1986).

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *Id.* This

burden may be met by showing (that is pointing out) "that there is an absence of evidence to support the non-moving party's case." *Id.*

Further, when the moving party's motion is supported by evidence sufficient, if not opposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the non-moving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence by affidavit or as otherwise provided by Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. *Id.* A factual dispute is genuine if only on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *Id.*

Under this standard, Applicant respectfully submits that there is no genuine issue of material fact and that Applicant is entitled to judgment as a matter of law.

These material facts are as follows:

**A. Material Facts Not in Dispute For Purposes of Applicant's Motion for Summary Judgment**

The parties agree on all material facts in this case. The Board may confirm this simply by reviewing Applicant's Statement of Material Facts below, and by comparing it to Opposer's Statement of Facts at pages 1 through 7.

- Applicant, Applicant, filed an application to register the mark "APPLICANT – AMERICA'S FAVORITE PASTA" as a trademark for goods subsequently defined as "pasta, pasta products, namely meals consisting primarily of pasta, macaroni salad, pasta salad, and sauces for pasta" in International Class 30. Applicant filed this application on June 18, 2002.

- Applicant based this application on its bona fide intent-to-use the mark in commerce.
- Applicant disclaimed exclusive rights to the phrase "AMERICA'S FAVORITE PASTA."
- Opposer has used the phrase AMERICA'S FAVORITE PASTA continuously since September 1997.
- Opposer has used the Design Mark only since May 2002, *i.e.*, one month before the filing of the opposed application. **Exhibit O**, Hage Declaration
- Opposer has sold 950 million packages bearing the phrase AMERICA'S FAVORITE PASTA.
- Opposer admitted that its sales were and are primarily only regional in nature. **Exhibit H2 and H3** to Hage Declaration, **p. 6, ¶ 16**.
- Opposer admitted that: "*as a matter of law, 'AMERICA'S FAVORITE PASTA' is self-laudation or mere puffery used by many third parties to claim general superiority for their products.*" **Exhibit J, p. 17, ¶ 1, lines 1-2**.
- Opposer admitted that "*the self-laudatory phrase is in widespread use in many fields by both merchants and consumers as to claim general superiority for their product.*" **Exh. J, pp. 16-17**.
- Opposer admitted that as used by Opposer, "*as a matter of law . . . 'AMERICA'S FAVORITE PASTA' .... is nothing more than highly subjective blustering or boasting.*" See, **Exhibit K, p. 9**.
- The Eighth Circuit has held: "By combining the term 'favorite' with 'America's,

[Opposer] claims Mueller's pasta has been well liked or admired over time by America." Ex. M, pp. 391.

- Opposer has *admitted* that its use is a laudatory term or "mere puffery."  
Opposer's Brief, page 12.

**III. PARTIAL SUMMARY JUDGMENT SHOULD BE ENTERED ON COUNT 1 THAT OPPOSER'S ALLEGED WORD MARK "AMERICA'S FAVORITE PASTA" IS INHERENTLY MERELY DESCRIPTIVE**

As indicated above, Opposer has not ever attempted to argue that its mark is not merely descriptive. Opposer concedes that its alleged word mark AMERICA'S FAVORITE PASTA is inherently merely descriptive. As counsel states at page 12 of its brief "AIPC does not dispute that AMERICA'S FAVORITE PASTA is a laudatory term or puffery."

Laudatory terms or mere puffery are as a matter of law merely descriptive. *See, e.g., In re Nett Designs*, 236 F.3d 1339 (Fed. Cir. 2001) [The Ultimate Bike Rack held merely descriptive]; *In re Carvel Corporation*, 223 USPQ 65 (TTAB 1984), [holding AMERICA'S FRESHEST ICE CREAM to be incapable, and summarizing the law differentiating between laudatory marks susceptible of protection and those for which no amount of secondary meaning is possible]; and *In re Boston Beer Company Limited Partnership*, 198 F. 3d 1370 (Fed. Cir 1999) ["Where the record shows that the laudatory phrase sought to be appropriated is a common phrase used descriptively by others before and concurrently with the alleged owner's use and is nothing more than an inherent claim of superiority, protection must be refused".]

The Board should enter judgment on the ground that AMERICA'S FAVORITE PASTA is merely descriptive. To do so would save time and money for the parties and the Board by preventing Applicant from having to re-litigate matter that is already undisputed on the record.

**IV. PARTIAL SUMMARY JUDGMENT SHOULD ALSO BE ENTERED ON THE GROUND THAT OPPOSER'S ALLEGED WORD MARK "AMERICA'S FAVORITE PASTA" IS INCAPABLE AS A MATTER OF LAW FROM ACQUIRING DISTINCTIVENESS**

**A. Entering Summary Judgment On This Ground Is Entirely Appropriate**

Attempting to divert the Board's focus from the merits of the issues, Opposer asserts that the Board may not determine as a matter of law that a mark is generic on summary judgment. This proposition of law is utterly wrong.

In *Commerce Bank Corp., Inc. v. Bank Atlantic*, 285 F.Supp.2d 475 (D.N.J. 2003), the District Court of New Jersey held, on summary judgment, that the mark AMERICA'S MOST CONVENIENT BANK was of such laudatory nature as to be barred from trademark protection.

In numerous cases, the Board, the Federal Circuit and other courts have decided on summary judgment that an alleged mark is generic. *See, e.g., Bell South Corporation v. Data National*, 60 F.3d 1565 (Fed. Cir. 1995) [holding WALKING FINGERS logo generic based on extensive third party use by public and competitors].

Indeed, if anything the issue of whether or not a mark is for public policy reasons incapable of exclusive protection is uniquely suited for summary judgment. For once a mark is determined to be incapable, no amount of secondary meaning evidence can resurrect it.

**B. Opposer Has Failed to Create Any Triable Issue of Fact As To Whether It Is Incapable**

In its opening brief, Applicant fully and articulately set forth the case law from the Federal Circuit and the TTAB as to whether and when a mark is incapable of acquiring exclusive protection. These tests are: (1) is the designation devoid of the modicum of uniqueness, ingenuity, originality sufficient to produce the threshold capability of consumer source

recognition; and (2) is the designation of such common, laudatory, and descriptive nature that ordinary purchasers would not be likely to consider that it indicated origin? See, *In re Carvel Corporation*, 223 USPQ 65 (TTAB 1984), [holding AMERICA'S FRESHEST ICE CREAM to be incapable, and summarizing the law differentiating between laudatory marks susceptible of protection and those for which no amount of secondary meaning is possible] and *In re Boston Beer Company Limited Partnership*, 198 F. 3d 1370 (Fed. Cir 1999) ["Where the record shows that the laudatory phrase sought to be appropriated is a common phrase used descriptively by others before and concurrently with the alleged owner's use and is nothing more than an inherent claim of superiority, protection must be refused".] Opposer does not even attempt to distinguish these cases.

The uncontroverted evidence in this case establishes that thousands of persons use AMERICA'S FAVORITE plus the name of the goods as self-laudatory phrase to boast of their products quality. Four competitors use the same phrase AMERICA'S FAVORITE PASTA. **Exhibit D**, Hage Declaration. Numerous companies use the phrase AMERICA'S FAVORITE to boast of their products. **Exhibit D-G**, Hage Declaration. In its opening brief, Applicant submitted hundreds of entries showing that numerous third parties used the phrase before and after Opposer entered the market. **Exhibit D-6**, Hage Decl. Opposer has added to this evidence. Anne Willoughby's Report attached as **Exhibit 7-A** to Opposer's brief testifies that:

"The phrase AMERICA'S FAVORITE is an expression that has been used since the founding of our country to express patriotic ideals. A Google search turned up 647,000 uses of this phrase (see **Exhibit G**) and most of these are pure puffery, i.e., America's Favorite Son." . . . In the case of Mueller's, the consumer can "Taste why Mueller's is America's favorite pasta." This phrase is completely subjective and is considered puffery by consumers."



Opposer's argument that the Board should ignore Applicant's evidence of laudatory use by the public and by Opposer's competitors is utterly unsupported. It is well settled that laudatory third party use of the phrase at issue can establish the generic significance of a mark on summary judgment where, as here, no other direct evidence of consumer recognition is submitted. *See, e.g., Bell South Corporation v. Data National Corporation*, 50 F.3d 1565 (Fed. Cir. 1995). As the Federal Circuit stated:

The cases have recognized that competitor use is evidence of genericness. *See e.g., Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 1578 13 U.S.P.Q.2d (BNA) 1444, 1446 (Fed. Cir. 1990) [testimony of competitor's president of generic use by competitor]; see also 1 McCarthy, *supra*, at §12.01[7](b). . . . The Board also stated that because of the widespread use the public "will not regard the logo as a trademark but merely as an informational symbol which denotes yellow pages." While consumer surveys may be a preferred method of proving genericness under the proper test of purchaser understanding, we are satisfied that on the facts of this case genericness has been established under that test.

**V. OPPOSER HAS FAILED TO CREATE A GENUINE ISSUE OF MATERIAL FACT THAT ITS MARK ACQUIRED DISTINCTIVENESS**

Nor has AIPC created a genuine issue of material fact that AMERICA'S FAVORITE PASTA has acquired distinctiveness. Even accepting all relevant material allegations as true, AIPC has failed to identify *a single dollar* spent on advertising the AMERICA'S FAVORITE PASTA phrase or any direct evidence of consumer recognition.

Under *In re Boston Beer Company Limited Partnership*, 198 F.3d 1370 (Fed. Cir. 1990) and numerous similar cases, sales figures alone will not create a genuine issue of material fact that a highly laudatory mark has acquired distinctiveness. *See, e.g., Commerce Bancorp, Inc. v. Bankatlantic*, 285 F.Supp.2d 475, 487 (D.N.J. 2003) [However, while Commerce has made substantial efforts to advertise in the mid-Atlantic region, its advertising efforts reach a small

percentage of customers in Florida. There is no directed advertising effort made to customers located in Florida, nor is there any plan to advertise to states other than New York, New Jersey, Delaware, and Pennsylvania, and perhaps Connecticut and other states located north of the mid-Atlantic region in the future]; *Degido v. West Group Corporation*, 344 F.3d 506, 514-515 (6<sup>th</sup> Cir. 2004) [even assuming that length and continuity of use is favorable to Plaintiff, the wide use of the phrase "law office(s)" weighed against a finding of secondary meaning. . . The court also found advertising figures to be low]

The closest evidence Opposer submits to attempt to prove acquired distinctiveness is an unsubstantiated opinion of an uncredentialed expert who without supporting evidence testifies that consumers would view the phrase as a source indicator. Under *Daubert v. Merrell Dow*, 509 U.S. 519 (1993) and other Supreme Court cases, this "evidence" should be excluded.

Under *Daubert*, Ms. Willoughby's report fails to present the factual or scientific basis for her unbridled opinion. Ms. Willoughby has failed to conduct a consumer survey or even interview consumers as to their recognition of the phrase.

Moreover, in reviewing her opinion, it is clear that she provides and agrees with Applicant's factual backdrop as to why under the law the mark is incapable. As she states:

"the phrase AMERICA'S FAVORITE is an expression that has been used since the founding of our country to express patriotic ideals. A Google search turned up 647,000 uses of this phrase (see **Exhibit G**) and most of these are pure puffery, i.e., AMERICA'S FAVORITE SON."

Under the circumstances and based on this record, it is clear that Opposer has failed to meet its burden of proffering countering evidence to show that there is a genuine factual dispute for trial. A mere denial or a conclusory assertions of so called "experts" who have no possible

factual basis for their "opinions" does not defeat Applicant's Motion for Summary Judgment.

Fed. Civ. P. 56.

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Similarly, the evidence of third party registration listed in **Exhibits 8 and 9** are as a matter of law, insufficient to create any factual issue. First, as to **Exhibit 8**, Opposer has failed to submit copies of these registrations. On this basis alone, the evidence is insufficient. *See, In re Nett Design*, 236 F.3d 1339 (Fed. Cir. 2001). Moreover, of the ones submitted in **Exhibit 9**, as the Federal Circuit has recently held, these third party registrations are of no weight whatsoever in determining whether or not a phrase is incapable of acquiring distinctiveness. *Id.* ["The court finds little persuasive value in the registrations that Nett Designs submitted to the Examiner or the list of registered marks Nett Designs attempted to submit to the Board to show that the term ULTIMATE is not a laudatory descriptive phrase touting the superiority of Nett Designs' bike racks.]

**VI. THE BOARD SHOULD REOPEN DISCOVERY SOLELY FOR APPLICANT'S  
BENEFIT IF COMPLETE SUMMARY JUDGMENT IS NOT GRANTED**

If the Board does not grant complete summary judgment in Applicants favor, the Board should grant the motion to reopen to take discovery on the survey. AIPC does not even try to argue that the survey was within the scope of Applicant's discovery requests and should have been produced to Applicant sooner. AIPC's arguments that Applicant's motion is dilatory are absurd.

It is well- settled that where a party withholds documents that should have been produced sooner the adverse party is entitled to a reopening of discovery, at the very least to determine why the information was withheld and to allow complete discovery on the document. *Neville Chemical Co. v. Lubrizol Corp.*, 184 U.S.P.Q. 689, 690 (TTAB 1975).

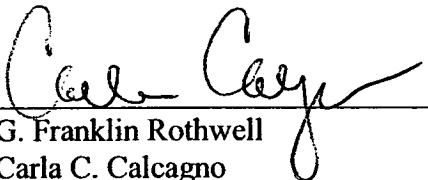
Wherefore, it is respectfully requested that the Board grant Applicant's motion for summary judgment as to each or all of the following grounds:

- (1) that Opposer's alleged word mark AMERICA'S FAVORITE PASTA is inherently merely descriptive;
- (2) that Opposer's alleged word mark AMERICA'S FAVORITE PASTA is incapable as a matter law from acquiring such distinctiveness; and
- (3) that Opposer's alleged word mark AMERICA'S FAVORITE PASTA has not acquired distinctiveness.

Alternatively, the Board should grant a reopening of discovery solely for Applicant's benefit to take discovery on the Confidential Survey, and should rule in Applicant's favor on the Motion to Extend discovery filed November 3, 2005.

Respectfully submitted,

By: \_\_\_\_\_



3-27-06

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S REPLY IN FURTHER SUPPORT OF MOTION FOR SUMMARY JUDGMENT AND MOTION TO REOPEN** was served via first-class mail, in a postage prepaid envelope, on counsel for Opposer as follows:

Thomas H. Van Hoozer, Esq.  
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This 27 day of March 2006.

  
Matthew Felten