

ESTTA Tracking number: **ESTTA261384**

Filing date: **01/20/2009**

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

Proceeding	91178682
Party	Plaintiff Franciscan Vineyards, Inc.
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Signature	/Linda Kurth/
Date	01/20/2009
Attachments	Request for Reconsideration.pdf ( 9 pages )(160543 bytes )

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

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Fransican Vineyards, Inc.

Opposer

Mark: DOMAINE PINNACLE  
and design

v.

Opposition No. 91178682

Domaine Pinnacle, Inc.

Serial No.: 78783236

Applicant

Filed: December 30, 2005

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**OPPOSER'S REQUEST FOR RECONSIDERATION OF BOARD'S ORDER  
DENYING MOTION TO STRIKE AFFIRMATIVE DEFENSES OF APPLICANT**

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Opposer, Franciscan Vineyards, Inc. ("Opposer"), hereby requests reconsideration under 37 C. F. R. § 2.127(b) of the Board's Order dated January 13, 2009 which denied Opposer's motion to strike Applicant's Affirmative Defenses. Opposer respectfully submits that the Board incorrectly denied the motion because it applied the wrong standards. Applicant's affirmative defenses do not amplify its pleadings in any way nor do they provide Opposer with fuller notice of Applicant's positions. Moreover, Affirmative Defenses # 2 and 4 are wholly improper because the law mandates that they must be brought by way of counterclaims and #8 cannot be alleged at all.

In the Order, the Board first acknowledged that by not responding, Applicant conceded Opposer's Motion to Strike. That fact alone was a sufficient ground on which to rule in Opposer's favor. However, the Board also stated:

Fed. R. Civ. P. 12(b) permits a party to assert in the answer the 'defense' of failure to state a claim upon which relief

may be granted. Moreover, an answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant's denial of one or more of the allegations in the complaint . . . permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration. See Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 311.02(d).

While Opposer accepts the Board's decision as to Applicant's affirmative defenses #3, and 5-7, Opposer requests reconsideration as to Applicant's other affirmative defenses.

With regard to Applicant's affirmative defense #1 alleging that Opposer did not state a cause of action, the allegations, rules, and case law that Opposer cited were apparently not considered by the Board. While Rule 12(b) permits Applicant to assert this defense, "it necessarily follows that a plaintiff may utilize this assertion to test the sufficiency of the defense in advance of trial by moving . . . to strike the 'defense' from the defendant's answer." Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, at 1222-1223 (TTAB 1995), citing S.C. Johnson & Son Inc. v. GAF Corporation, 177 USPQ 720 (TTAB 1973).

The Board regularly strikes this defense when Opposer shows that it, in fact, raised sufficient facts and allegations, especially where the non-moving party does not contest the motion. Attached as Exhibit A is an order in another matter issued by the same Interlocutory Attorney as in this matter in which he granted a motion to strike this same affirmative defense as conceded by Applicant who did not file a response and to which opposer tested it sufficiently by citing the factual allegations in its notice of opposition. There is little if no difference here.

Even if Applicant had not conceded that this defense should be stricken, Opposer demonstrated that in its Notice of Opposition it provided an abundance of facts and allegations that raised legally sufficient claims to withstand the defense. Opposer's grounds for filing its Notice of Opposition are unambiguous: Opposer has priority in the mark PINNACLES, Opposer is using the mark, there is a likelihood of confusion between its mark PINNACLES and Applicant's mark DOMAINE PINNACLE for related goods, and Opposer will be damaged if the registration is allowed. Opposer is entitled to an order striking this defense as a matter of law.

As to affirmative defenses #2 and #4, Applicant raises collateral issues as to the validity of Opposer's registrations. These defenses do not amplify defendant's denials in its pleading in any way, but instead attack Opposer's registration. The rules and case law require that such attacks simply cannot be made by way of affirmative defenses.

Specifically, by alleging that Opposer uses its mark merely as the name of a variety for wine rather than as a trademark and makes no other use of it, Applicant directly alleges that Opposer's registration is invalid. TBMP § 3.1102(b) provides, "The Board will not entertain a defense that attacks the validity of a registration pleaded by the plaintiff **unless the defendant timely files a counterclaim** or a separate petition to cancel the registration." Applicant has not filed any counterclaims, and these affirmative defenses must be stricken as a matter of law. *See also* Textron, Inc. v. Gillette Co., 180 USPQ 152, 153 (TTAB 1973) (stating that **the TTAB considers it to be mandatory** that a party assert as a counterclaim any claim which, at the time of serving his pleading, he has against the adverse party if the counterclaim arises out of the subject

matter of the transaction or occurrence which is the subject matter of the other party's claim).

Questioning the validity of a registration does not amplify a defense, but initiates a collateral attack against it. Applicant's defenses don not give Opposer fuller notice of the position which Applicant plans to take in defense of its right to registration. The Board did not apply the above legal standard, and Opposer respectfully requests that it does so now. The Board should strike Affirmative Defenses # 2 and #4, and require Applicant to file counterclaims.

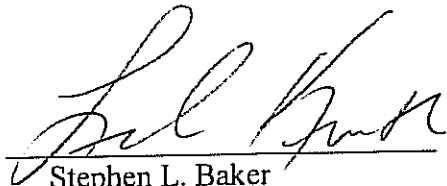
Opposer requests that same relief as to Applicant's affirmative defense #8, wherein Applicant improperly attacked Opposer's registration as being geographic. As Opposer stated, the registration is incontestable and cannot be attacked on this basis. Opposer respectfully points out again that the United State Supreme Court has held an incontestable registration is immune to attacks based on descriptiveness, geographic or otherwise. Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 105 S.Ct. 658, 224 USPQ 327, 300 (1985). A defense questioning the validity of an incontestable registration as geographic defense does not merely amplify Applicant's pleading or give Opposer fuller notice of Applicant's position. Instead, this defense again collaterally attacks Opposer's registration. This defense cannot even be made by way of counterclaim. As such, Opposer is entitled as a matter of law to have this defense stricken.

Reconsideration is requested granting Opposer's motion.

Dated: January 20, 2009

Respectfully submitted,  
BAKER & RANNELLS

By:



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EXHIBIT A

UNITED STATES PATENT AND TRADEMARK  
OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

ac

Mailed: April 8, 2008

Opposition No. 91181670

Goya Foods, Inc.

v.

Gotera, Inc.

**Brian D. Brown, Interlocutory Attorney**

Opposer's motion to strike (filed February 14, 2008) applicant's first affirmative defense contained in its answer to the notice of opposition is hereby granted as conceded. Accordingly, applicant's first affirmative defense is hereby stricken from the record and will be given no further consideration by the Board.

Continuing, the parties' stipulated motion filed March 14, 2008 to limit interrogatories to 25 and limit depositions to 10 is granted.

With interrogatories and depositions now limited per the parties' stipulated motion, trial dates remain as set in the Board's institution order.

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By



this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242 FinalRuleChart.pdf>

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

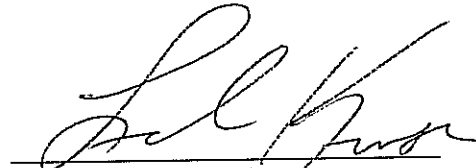
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>

CERTIFICATE OF SERVICE

I hereby certify a copy of the foregoing Opposer's REQUEST FOR RECONSIDERATION OF OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES in re: Franciscan Vineyards, Inc. v. Domaine Pinnacle, Inc., Opposition No. 91178682 was served on counsel for Applicant, this \_\_\_ day of January, 2009 by sending same via Email and First Class Mail, postage prepaid, to:

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DATED: January 20, 2009

  
Linda Kurth