

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

Baxley

Mailed: February 12, 2009

Opposition No. 91178682

Franciscan Vineyards, Inc.

v.

Domaines Pinnacle, Inc.

By the Trademark Trial and Appeal Board:¹

On January 13, 2009, the Board issued an order in which it denied opposer's motion (filed October 24, 2008) to strike the affirmative defenses set forth in applicant's answer to opposer's amended notice of opposition. The Board found therein that the affirmative defenses at issue were amplifications of the denials set forth in such answer. On January 20, 2009, opposer filed a request for partial reconsideration of that order.² No response thereto is of record.

Opposer contends that the Board could have granted the motion to strike as conceded; that opposer is entitled to a determination as to the sufficiency of applicant's

¹ Brian D. Brown, who issued the January 13, 2009 order, has left the Trademark Trial and Appeal Board.

² Opposer also filed a motion to compel discovery on January 22, 2009. However, the Board denied that motion in a February 2, 2009 order.

affirmative defense no. 1 that opposer fails to state a claim upon which relief can be granted; that the Board erred in finding that affirmative defense nos. 2, 4, and 8 amplify the denials of the amended notice of opposition because they constitute a collateral attack on opposer's pleaded registration.

The premise underlying a motion for reconsideration, modification or clarification under Trademark Rule 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. The motion should be limited to a demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. See TBMP Section 518 (2d ed. rev. 2004).

Regarding opposer's contention that the Board could have granted the motion to strike as conceded, Trademark Rule 2.127(a) states in relevant part that "[w]hen a party fails to file a brief in response to a motion, the Board **may** treat the motion as conceded." (emphasis added) The Board, in its discretion, may decide any uncontested motion on the merits. Moreover, even if the interlocutory attorney formerly assigned to this case granted a motion to strike as

conceded in a non-precedential order in another proceeding, that order has no bearing upon this proceeding.³

However, the Board finds that the denial of the motion to strike was in error with regard to affirmative defense no. 1, i.e., that opposer has failed to state a claim upon which relief can be granted. When a defendant has pleaded such an affirmative defense, a plaintiff may test the sufficiency of that defense by moving under Fed. R. Civ. P. 12(f) to strike that defense from the defendant's answer. See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). Accordingly, the Board will review the amended notice of opposition to determine its sufficiency.

A legally sufficient complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the subject registration. See, e.g., *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992). Opposer has adequately pleaded its standing through the allegations in paragraphs 1-6 of

³ Because additional evidence may not be presented with a request for reconsideration, the copy of the Board order from Opposition No. 91181670 that opposer included as an exhibit to the request for reconsideration is not properly before the Board and has received no consideration. See TBMP Section 518 (2d ed. rev. 2004).

the amended notice of opposition. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). Further, opposer has provided fair notice of a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), with regard to pleaded Registration No. 997378 only through the allegations in paragraphs 3-12 of the amended notice of opposition.⁴ See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48 (TTAB 1978). Accordingly, the Board finds that the amended notice of opposition states a claim upon which relief can be granted, and applicant's affirmative defense no. 1 is hereby stricken.

Further, the Board erred in determining that affirmative defense nos. 2 and 4 are merely amplifications of the denials set forth in the answer to the amended notice

⁴ However, to the extent that opposer intends to rely upon its prior common law rights in support of its Section 2(d) claim, the amended notice of opposition does not identify with specificity the variations of the pleaded PINNACLES mark and the "wide range of goods and services" upon which opposer uses its marks. Without such information, opposer has not provided fair notice of the prior common law rights upon which it intends to rely in support of such claim.

Because the Board has determined that opposer has pleaded a valid ground for denying registration of applicant's involved mark, it is unnecessary to determine whether the second proposed claim set forth in the amended notice of opposition is legally sufficient.

of opposition. In these affirmative defenses, applicant alleges that opposer uses its pleaded registered PINNACLES mark only as a varietal for wine and not as a trademark for wine or any other goods. These affirmative defenses are a collateral attack upon opposer's pleaded Registration No. 997378 for that mark, which may only be raised by way of a compulsory counterclaim. See Trademark Rules 2.106(b)(2) and 2.114(b)(2); TBMP Section 313.01 (2d ed. rev. 2004). Accordingly, the Board finds that affirmative defense nos. 2 and 4 are legally insufficient and are hereby stricken.

In addition, the Board erred in its determination that affirmative defense no. 8 is an amplification of the denials set forth in the answer to the amended notice of opposition. Taken together, the entire third sentence of affirmative defense no. 8 and the allegation in the first sentence thereof that the pleaded registered mark is "primarily geographically descriptive" constitute a collateral attack upon the pleaded registration which may only be raised by way of a compulsory counterclaim. See *id.* Moreover, because pleaded Registration No. 997378 was issued more than five years ago, an allegation that the mark is primarily geographically descriptive is untimely. See Trademark Act Section 14(3), 15 U.S.C. Section 1064(3). Accordingly, the entire third sentence and the wording "primarily geographically descriptive, therefore" in the first sentence

thereof are legally insufficient and therefore stricken. Affirmative defense no. 8 otherwise essentially alleges that, because opposer's goods come from the base of the Pinnacles National Monument, the pleaded mark is "not ... strong" and is therefore entitled to a limited scope of protection. As such, it amplifies the denials set forth in the answer and therefore acceptable, except as noted.

In view thereof, the request for reconsideration is granted to the extent set forth in the foregoing.

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date of this order to serve initial responses to any outstanding written discovery requests. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE:	March 24, 2009
Plaintiff's 30-day testimony period to close:	June 22, 2009
Defendant's 30-day testimony period to close:	August 21, 2009
Plaintiff's 15-day rebuttal testimony period to close:	October 5, 2009

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Opposition No. **91178682**

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.