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

Proceeding	91215114
Party	Plaintiff Upper Shirley Vineyards, LLC, Shirley Plantation LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SHIRLEY PLANTATION, LLC
and
UPPER SHIRLEY VINEYARDS, LLC

Opposers,

v.

STILLHOUSE VINEYARDS, LLC

Applicant.

Opposition No.: 91215114

Application No.: 85/947,562

Mark: SHIRLEY PLANTATION

OPPOSERS' RESPONSE TO MOTION TO DISMISS

Shirley Plantation, LLC and Upper Shirley Vineyards, LLC (hereinafter “Shirley” and “Upper Shirley” respectively and “Opposers” collectively) by and through its undersigned counsel hereby file this response to Applicant’s Motion to Dismiss. Opposers have standing to oppose the registration of the mark SHIRLEY PLANTATION, for all the reason more fully set forth below.

Applicant Stillhouse Vineyards, LLC., (“Applicant”) is operated by Philip Carter Strother at a location over 140 miles from the locale known as Shirley, Virginia. Mr. Strother has embarked on a program of misappropriation of the

names, trademarks (some of which are registered), and goodwill of the Shirley Plantation and of the Carter Family. Specimens supplied with Applicant's application comprise the front and back label for a wine bottle. The back label states:

Shirley Plantation is Virginia's first plantation (1613), America's oldest family owned business (1638), and is the most intact 18th century estate in Virginia. Today Shirley continues as a working plantation, a family home, a National Historic Landmark, and a direct link between the past and the present. In 1762, the Carter family received international acclaim for producing 'excellent' wine in Virginia.

The back label also includes (in background) the floor plan of the Shirley Plantation and identifies it as such. The front label states "Virginia Chardonnay" and in bolder and larger font "Shirley Plantation". All together, these labels create a consumer impression that the grapes are grown and the wine is produced at the Shirley Plantation and/or in affiliation with and sponsorship by Shirley and/or Upper Shirley. (Opposition ¶30.) Recently, Applicant has also sought to misappropriate and protect for himself the marks "Shirley" and the Carter family heraldic crest, or coat of arms. (US Trademark Appns. Ser. Nos. 86121979, and 86129686.) In furtherance of its plans for misappropriation, Applicant now seeks

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to challenge the standing of the *bona fide* Shirley Plantation and the Upper Shirley Vineyards to lodge this opposition.

Applicant's standing analysis is legally defective. Applicant does not individually address any of the seven separate allegations and grounds for opposition appearing in Paragraphs 33-39 of the Opposition. This is a fatal defect in the Motion to Dismiss, because each ground of opposition has its own distinct standing requirement (and analysis). *See e.g., Corporacion Habanos, S.A., et al. v. Rodriquez*, 99 USPQ2d 1873 (TTAB 2011). Applicant's standing analysis is also legally defective because it simply fails to address any of Shirley's or Upper Shirley's allegations of harm or damage that may result from allowing Applicant's mark to proceed to registration. (Opposition ¶¶33-39 and in the Preamble.) For these reasons alone, Applicant's motion should be denied.

Applicant has also failed to apply the proper legal standard. As the Federal Circuit has made clear, the standing requirements in an opposition or cancellation proceeding are:

Thus, the starting point for a standing determination for a litigant before an administrative agency is not Article III, but is the statute that confers standing before that agency. In the case at hand, the starting point for the

standing determination of the opposer is § 13 of the Lanham Act, which provides:

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor

15 U.S.C. § 1063.

Section 13 of the Lanham Act establishes a broad class of persons who are proper opposers; by its terms the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered. However, in addition to meeting the broad requirements of § 13, an opposer must meet two judicially-created requirements in order to have standing—the opposer must have a "real interest" in the proceedings and must have a "reasonable" basis for his belief of damage.

Ritchie v. Simpson, 170 F.3d 1092, 1095 (Fed. Cir. 1999).

Thus, at the pleading stage all that is required is that an opposer allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. *Id.* A claim of likelihood of confusion that is not wholly without merit, including claims

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based on current ownership of a valid and subsisting registration, or prior use of a confusingly familiar mark, meet this test. *See* TBMP §309.93(b). This test may also be met by prospective applicants, including applicants seeking to file intent to use applications for the same or similar marks for the same or similar goods and services. *American Vitamin Products, Inc. v. Dow Brands, Inc.* 22 USPQ 2d 1313 (TTAB 1992). The reasonable basis for a belief in damage may also be established by a direct commercial interest - - by the opposers' prior registered trademarks and by the marketing of products similar to that for which registration is sought. *Cunningham v Laser Golf Corp.*, 222 F. 3d 943 (Fed. Cir. 2000).

Once an opposer meets the requirements for standing it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052. *Coach Services, Inc. v. Triumph Learning LLC*, 689 F.3d 1356, 1377 (Fed. Cir. 2012); *Corporacion Habanos S.A., et al. v Rodriquez*, 99 USPQ2d 1873 (TTAB 2011).

Shirley and Upper Shirley meet the standing requirements set forth above. Among other things, Shirley has a "real interest" because Shirley has rights to and prior registrations for SHIRLEY PLANTATION. (Opposition ¶¶ 25, 26). Shirley also sells private labeled products in its gift shops that bear the SHIRLEY PLANTATION name and has sold (in its gift shop) and served wine at numerous public and private events for years. (Opposition ¶¶ 15-17). Upper Shirley has a

“real interest” because it has filed an intent to use application for UPPER SHIRLEY VINEYARDS for use with wines (Opposition ¶ 27). Opponents are likely to be harmed by the registration of SHIRLEY PLANTATION by Applicant given that it suggests a false connection with them (Opposition ¶ 34) and it is deceptive, suggesting that the product inside Applicant’s packaging originates with Shirley or Upper Shirley or originates at the location recognized as “Shirley” or “Upper Shirley” (Opposition ¶ 33). These facts alone establishes the direct commercial interest - - the reasonable basis for belief in damages as set forth in *Cunningham v. Laser Golf Corp.*, 222 F. 3d 943 (Fed. Cir. 2000).

Since Shirley and Upper Shirley have a “real interest” in this proceeding and a “reasonable basis” for believing that they will be harmed by the prospective registration of all SHIRLEY PLANTATION for use with wines, Shirley and Upper Shirley have a right to assert any grounds for Opposition. *Coach Services, Inc. v. Triumph Learning LLC*, 689 F.3d 1356, 1377 (Fed. Cir. 2012); *Corporacion Habanos S.A., et al. v Rodriquez*, 99 USPQ2d 1873 (TTAB 2011). This direct commercial interest in the outcome of the Opposition proceeding of both Shirley and Upper Shirley is an interest which extends beyond that of being a mere intermeddler. *American Vitamin Products, Inc. v. Dow Brands, Inc.*, 22 USPQ 2d 1313 (TTAB 1992).

Applicant asserts that opposers must be marketing an identical product in the same class of goods in order to have standing in a trademark opposition proceeding, citing to an old Sixth Circuit decision *Mishakawa*. That is neither a correct statement of the law nor is it controlling. *DuPont*, the leading case on factors relating to the likelihood of confusion that is commonly applied in TTAB decisions, evaluates relatedness of goods and services as but one factor in the likelihood of confusion analysis. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Applicant also apparently believes that the pleading and standing requirements of Article III Courts are somehow applicable to administrative law proceedings, citing cases such as *Twombly* and *Mishakawa*. That is plainly misguided. McCarthy on Trademarks and Unfair Competition, 20:24 n. 8; *Coach Services, Inc. v. Triumph Learning LLC*, *supra*; *Ritchie v. Simpson*, *supra*.

Further, Applicant even goes so far as to assert that Shirley and Upper Shirley lack standing based on a lack of license from either the Virginia Department of Alcoholic Beverage Control or the Alcohol and Tobacco Tax and Trade Bureau. There is simply no such standing requirement to oppose a trademark application for a mark for use with wines that tends to mislead consumers, is geographically misleading and is deceptive.

Finally, the Motion to Dismiss is legally defective in that it seeks a dismissal of the opposition “with prejudice with no further opportunity to amend”. (Motion p. 5). Applicant offers no legal support for such an extraordinary relief, and there is none. At a minimum, should the TTAB decide that Opposers have somehow failed to properly plead standing in this matter, Opposers maintain that leave should be liberally granted to allow Opposers the opportunity to amend the Opposition to satisfy those requirements. *See* TBMP §503.03 and Fed. R. Civ. P. 15(a).

CONCLUSION

For all the foregoing reasons, Applicant's Motion to Dismiss should be denied, and the Opposition allowed to proceed. At the very minimum, should the TTAB decide that Opposers' Notice of Opposition has somehow failed to meet the pleading requirements for standing, Opposer requests that leave be granted allowing Opposers' to amend their pleading.

Date: April 21, 2014

Respectfully submitted,



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CERTIFICATE OF ELECTRONIC TRANSMISSION

The undersigned hereby certifies that on this 21st day of April 2014, the foregoing *Opposers' Response to Motion to Dismiss* was deposited with the United States Patent and Trademark Office, Trademark Trial and Appeal Board via electronic filing through their website at <http://estta.uspto.gov/>.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 21st day of April 2014, the foregoing *Opposers' Response to Motion to Dismiss* was served upon Applicant by delivering a true and correct copy of same to counsel for Applicant via first class mail, return receipt requested, as follows:

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Date: April 21, 2014



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