

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

CME

Mailed: April 27, 2016

Opposition No. 91225185

NowEau Inc.

v.

*Don Sebastiani & Sons International
Wine Negotiants*

By the Trademark Trial and Appeal Board:

This case now comes up on Applicant's motion, filed January 11, 2016, to dismiss this proceeding without leave to replead for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6). The motion is fully briefed.¹

The Board has carefully considered the parties' arguments with respect to Applicant's motion and presumes the parties' familiarity with the factual bases for

¹ The "certificate of service" attached to Opposer's motion is sufficient to meet the requirements for a certificate of mailing. *See* Trademark Rule 2.190. Accordingly, Opposer's brief is treated as having been filed on January 28, 2016, which is the date Opposer deposited the brief in the mail. *See* Trademark Rule 2.197.

Opposer filed a duplicate copy of its brief through ESTTA – the Board's electronic filing system. It was not necessary for Opposer to file its brief again through ESTTA, and Opposer should avoid making duplicate filings in the future. The Board further notes that it encourages parties to file all papers through ESTTA, which operates in real time and provides a tracking number that the filing has been received. For assistance in using ESTTA, call 571-272-8500.

their filings, and does not recount the facts or arguments here, except as necessary to explain the decision.²

A motion to dismiss under Fed. R. Civ. P. 12(b)(6) is a test of the sufficiency of the complaint. To survive a motion to dismiss, a claimant need only allege sufficient factual matter as would, if proved, establish that: (1) it has standing to maintain the claim; and (2) a valid ground exists for opposing the mark. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Id.* (citing *Twombly*, 550 U.S. at 555). “For purposes of determining the motion, all of [the claimant’s] well-pleaded allegations must be accepted as true, and the [claim] must be construed in the light most favorable to [the claimant]. The pleading must be construed so as to do justice, as required by Fed. R. Civ. P. 8(e).” *Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010).

Applicant does not challenge *pro se*³ Opposer’s allegations of standing. 4 TTABVue 5. Rather, Applicant argues that the notice of opposition fails to state a

² There is one exception. Opposer’s filing of February 19, 2016 is in the nature of a surreply, and therefore, the Board has not considered this paper. *See* Trademark Rule 2.127(a).

³ Information for parties representing themselves *pro se* is provided at the end of this order.

claim upon which relief can be granted. Based on a review of the notice of opposition and Opposer's brief in opposition to the motion, it appears that Opposer intended to allege a claim for priority and likelihood of confusion⁴ as well as claims that Applicant's mark is merely descriptive or generic for the goods identified in the involved application.⁵

"To allege a valid ground for opposition under Section 2(d), Opposer need only allege that it has valid proprietary rights that are prior to those of Applicant, or that it owns a registration which Applicant has not counterclaimed to cancel, and that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion." *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1030 (TTAB 2015) (citing 15 U.S.C. § 1052(d)). Opposer has not alleged ownership of a prior registration, but it has alleged use of the "fanciful name 'Eau de Vin'" subject to "US Trademark [S]erial [N]o. 86810563." Notice of Opposition, ¶ 3. It is clear from these allegations that Opposer is pleading proprietary rights in EAU DE VIN,⁶ but the

⁴ Opposer's reference in its brief to Section 43(a) of the Trademark Act is misplaced. As Applicant points out, the Board does not have jurisdiction to entertain a claim pursuant to Section 43(a) of the Trademark Act. *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985); *Elec. Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984). A claim of likelihood of confusion and priority in a Board proceeding is made pursuant to Section 2(d) of the Trademark Act.

⁵ The notice of opposition includes allegations that Applicant's use of VINEAU "is against food labeling law" and "must be preceded by the word 'Imitation.'" In its opposition brief, Opposer explains that it made these allegations "not as grounds for denial of [Applicant's] mark, but as corroborating evidence for relief." 7 TTABVUE 8. Accordingly, Opposer has correctly acknowledged that the manner in which Applicant uses the involved mark is not within the jurisdiction of the Board. *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1591 (TTAB 2011).

⁶ Applicant argues at length that Opposer cannot claim proprietary rights in EAU DE VIN because it "is generic for the product [Opposer] is selling." 4 TTABVUE 2. Whether EAU DE VIN is a generic term for Opposer's goods, concerns whether Opposer can prove prior

goods and services for which Opposer claims proprietary rights in its mark is entirely unclear. More specifically, one cannot discern from the notice of opposition whether Opposer is claiming proprietary rights in EAU DE VIN for the process of making potable wine water, the goods or services identified in the pleaded application, or both. Opposer also has not adequately pleaded prior rights in EAU DE VIN. In its response brief, Opposer indicates that it filed its pleaded application “after having used EAU DE VIN as a suggestive mark since 2008.” But the notice of opposition is devoid of such allegations and there are no other allegations in the notice of opposition that may be construed as pleading priority in EAU DE VIN.⁷ In addition, Opposer has not pleaded that Applicant’s mark is likely to cause confusion with any mark in which Opposer has prior rights.

To properly plead a claim of descriptiveness under Section 2(e)(1) of the Trademark Act, a plaintiff must affirmatively plead that the mark merely describes an ingredient, quality, characteristic, function, feature, purpose or use of the goods or services identified in the involved application. *See In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). To sufficiently plead a claim for genericness, a plaintiff must allege that the mark is generic for the specific goods or

proprietary rights necessary to prevail on a Section 2(d) claim. Because a motion to dismiss is a test solely of the legal sufficiency of a complaint, “not the sufficiency of any evidence that might be adduced” the Board has given this argument no consideration. *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

⁷ Moreover, the Board does not take judicial notice of applications, and therefore, in determining Applicant’s motion, the Board does not consider any alleged dates of first use in the pleaded application. *See UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009); *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 and n.8 (TTAB 2009); *see also*, TBMP § 503.02 (2015).

services identified in the application. *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001); *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 989-90, 228 USPQ 528, 530 (Fed. Cir. 1986). Further, a plaintiff must plead sufficient facts to allege that members of the relevant public primarily use or understand the applicant's mark to refer to the genus of goods and/or services at issue. *H. Marvin Ginn Corp.*, 228 USPQ2d at 530.

Opposer has alleged that Applicant's mark VINEAU "is clearly recognized in the French language as 'wine water,'" and that VINEAU "can not be used as a fanciful trademark for any flavored water or water beverage," but these allegations alone are not sufficient to meet the pleading requirements for claims of descriptiveness and genericness as set forth above.

In view of the foregoing, Applicant's motion to dismiss is **GRANTED IN PART** to the extent that the Board finds that Opposer has failed to adequately plead a claim upon which relief can be granted, but **DENIED IN PART** to the extent Applicant seeks dismissal of the opposition without leave to replead. The Board, in its discretion, finds that it is appropriate to allow Opposer an opportunity to replead. Accordingly, Opposer is allowed until **May 20, 2016** from the mailing date of this order to file an amended notice of opposition that adequately sets forth claims for priority and likelihood of confusion, descriptiveness and/or genericness, failing which the opposition may be dismissed with prejudice. Applicant is allowed until **June 10, 2016** to file an answer to any amended notice of opposition.

Pro Se Information

Patent and Trademark Rule 11.14 permits an entity to represent itself, but it is strongly advisable for a party who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The United States Patent and Trademark Office (USPTO) cannot aid in the selection of an attorney. As the impartial decision maker, the Board may not provide legal advice; it may provide information solely as to procedure.

Any party who does not retain counsel should be familiar with the authorities governing this proceeding, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP), and the Trademark Rules of Practice (37 C.F.R. Part 2), both accessible directly from the Board's web page: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Also on the Board's web page are links to ESTTA, the Board's electronic filing system at <http://estta.uspto.gov>, and TTABVUE, for case status and prosecution history at <http://ttabvue.uspto.gov/ttabvue>.

Trademark Rules 2.119(a) and (b) require that every paper filed in the USPTO in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney. Proof of service must be made before the paper will be considered by the Board. Accordingly, copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement,

whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (name and address of opposing counsel or party).

Signature _____

Date _____

Strict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

This *inter partes* proceeding is similar to a civil action in a federal district court. The parties file pleadings and a range of possible motions. This proceeding includes designated times for disclosures, discovery (discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, to ascertain the facts underlying an adversary's case), a trial period, and the filing of briefs. The Board does not preside at the taking of testimony; all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.

Proceedings Resumed and Dates Reset

Proceedings are resumed and dates are reset as follows:

Time to File an Amended Notice of Opposition	5/20/2016
Time to Answer	6/10/2016
Deadline for Discovery Conference	7/10/2016
Discovery Opens	7/10/2016
Initial Disclosures Due	8/9/2016
Expert Disclosures Due	12/7/2016
Discovery Closes	1/6/2017
Plaintiff's Pretrial Disclosures Due	2/20/2017
Plaintiff's 30-day Trial Period Ends	4/6/2017
Defendant's Pretrial Disclosures Due	4/21/2017
Defendant's 30-day Trial Period Ends	6/5/2017
Plaintiff's Rebuttal Disclosures Due	6/20/2017
Plaintiff's 15-day Rebuttal Period Ends	7/20/2017

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.

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.
