

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: September 29, 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 June 10, 2016, to dismiss Opposer's amended notice of opposition, filed May 20, 2016. The motion is fully briefed.

The Board has carefully considered the parties' arguments with respect to Applicant's motion and presumes the parties' familiarity with the factual bases for their filings, and does not recount the facts or arguments here, except as necessary to explain the decision.

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).

Construing the allegations in the amended notice of opposition in the light most favorable to Opposer, the Board finds that Opposer has adequately pleaded a claim for priority and likelihood of confusion under Section 2(d) of the Trademark Act, as well as claims for descriptiveness under Section 2(e)(1) of the Trademark Act and genericness.¹

With respect to the priority element of a claim under Section 2(d) of the Trademark Act, Opposer alleges that “water of wine or wine water ... is the statement of identity for Opposer’s unique product” and “Opposer has prior use of the statement of identity using water from wine to describe its unique product

¹ Applicant does not challenge Opposer’s allegations of standing, 13 TTABVUE 4, which the Board finds sufficient.

Opposer’s allegations of counterfeiting and patent infringement are outside the scope of this proceeding, and therefore, cannot form a basis for relief in this proceeding. *Conolty v. Conolty O’Connor NYC LLC*, 111 USPQ2d 1302, 1309 (TTAB 2014) (the Board’s jurisdiction is limited to determining the right to register a mark); *see also* TBMP § 102.01 (2016).

under various brand names including Eau de Vin and Aqua Win Naturale.” 12 TTABVUE 2, Introductory Paragraph. Moreover, it is reasonable to infer from paragraph 4 of the amended notice of opposition that Opposer alleges prior use of the mark EAU DE VIN “in commerce² as early as 2008” and prior use of the mark AQUA VIN NATURALE “in interstate commerce in 2009,” both for “a water from wine product.” 12 TTABVUE 3, ¶ 4; *see, e.g., Johnson v. Obschestvo s Ogranitchennoy*, 104 USPQ2d 2037, 2038 (TTAB 2012) (a claimant may survive a motion to dismiss by pleading “factual content that allows the Board to draw a reasonable inference that the [claimant] has standing and a valid claim [for opposition].³ The Board finds that such allegations are sufficient to plead Opposer’s priority. Opposer also has sufficiently alleged that Applicant’s involved mark is likely to cause confusion with Opposer’s EAU DE VIN and AQUA VIN NATURALE marks. *Id.* at 2 and 4-5, Introductory and Conclusory paragraphs and paragraph 9.

The Board further finds that the following allegations are sufficient to state claims that Applicant’s mark is merely descriptive for the goods identified in the involved application, namely, “flavored water; water beverages” and that Applicant’s mark is generic for Applicant’s goods: (1) “VINEAU is clearly recognized

² The Trademark Act defines “commerce” as “all commerce which may lawfully be regulated by Congress.” 15 U.S.C. § 1127.

³ Applicant argues that the exhibits attached to Opposer’s amended notice of opposition do not support Opposer’s allegations of priority, but whether Opposer can prove priority is an issue to be considered after the introduction of evidence at trial. *See Ad. Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) (“A motion made under Rule 12(b)(6) challenges the legal theory of the complaint, not the sufficiency of any evidence that might be adduced.”); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case....”).

in the French language as ‘wine water,’” *Id.* at 2, ¶ 1; and (2) “Applicant’s mark is generic by itself to simply describe wine flavored water (wine water), which is a combination of a flavor and a non-descript water source to make a mixture of two or more ingredients and not a singular product.”⁴ *Id.* at 4, ¶ 7.

In view of the foregoing, Applicant’s motion to dismiss is DENIED. Notwithstanding this determination, based on Opposer’s filings in this proceeding, the Board reiterates the recommendation that Opposer retain counsel to represent it in this proceeding. 11 TTABVUE 6.

Proceedings are resumed and dates are reset as follows:

Time to Answer	10/30/2016
Deadline for Discovery Conference	11/29/2016
Discovery Opens	11/29/2016
Initial Disclosures Due	12/29/2016
Expert Disclosures Due	4/28/2017
Discovery Closes	5/28/2017
Plaintiff’s Pretrial Disclosures Due	7/12/2017
Plaintiff’s 30-day Trial Period Ends	8/26/2017
Defendant’s Pretrial Disclosures Due	9/10/2017
Defendant’s 30-day Trial Period Ends	10/25/2017
Plaintiff’s Rebuttal Disclosures Due	11/9/2017
Plaintiff’s 15-day Rebuttal Period Ends	12/9/2017

⁴ With respect to Opposer’s allegations that Applicant’s mark is generic, the Board notes that a mark may be found generic where it is proven to be the generic name for a subset of the identified goods. *In re Wm. B. Coleman, Co.*, 93 USPQ2d 2019, 2024-25 (TTAB 2010) (refusing registration of ELECTRIC CANDLE COMPANY for “light bulbs; lighting accessories, namely, candle sleeves; lighting fixtures” where the evidence demonstrated that the relevant public “would readily understand the term to identify a type of lighting fixture, namely, electric candles.”); *In re Central Sprinkler Co.*, 49 USPQ2d 1194, 1197 (Comm’r Pat. 1998) (“The broad general category of goods involved here is sprinklers for fire protection. However, a product may be in more than one category, and here applicant’s goods also fall within the narrower category of sprinklers for fire protection of attics. We find that the term ‘attic’ would be understood by the relevant public as referring to that category of goods.”).

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.
