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

Proceeding	91236279
Party	Plaintiff Frito-Lay North America, Inc.
Correspondence Address	TIFFANI D OTEY Womble Bond Dickinson (US) LLP ONE WEST FOURTH STREET WINSTON-SALEM, NC 27101 UNITED STATES Email: tiffani.otey@wbd-us.com, jacob.wharton@wbd-us.com
Submission	Opposition/Response to Motion
Filer's Name	Tiffani D. Otey
Filer's email	tiffani.otey@wbd-us.com, jacob.wharton@wbd-us.com, trademarkswinston@wbd-us.com, sarah.keefe@wbd-us.com, laura.kees@wbd-us.com, angie.wicker@wbd-us.com
Signature	/Tiffani D. Otey/
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Attachments	Lets Tailgate_2d Response to Motion to Dismiss.pdf(235470 bytes )

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

**In the Matter of Trademark Application No. 87249836**

Mark : LET'S TAILGATE!  
Applicant : Chef's Touch Sales and Marketing, LLC  
Serial No. : 87249836  
Filed : November 28, 2016  
Published : April 25, 2017

**FRITO-LAY NORTH AMERICA, INC.** )  
 )  
 )  
 **Opposer,** )  
 )  
 **v.** ) **Opposition No. 91236279**  
 )  
 **CHEF'S TOUCH SALES** )  
 **AND MARKETING, LLC** )  
 )  
 **Applicant.** )  
 )

**OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S  
REPLY OR RENEWED MOTION TO DISMISS PURSUANT TO RULE 12(b)(6)**

On November 15, 2017, Applicant Chef's Touch Sales and Marketing, LLC ("Applicant") filed a Reply in Support of Applicant's Motion ("Applicant's Reply") (Doc. No. 14). In the Reply, Applicant makes arguments concerning Opposer's *Amended* Notice of Opposition. Applicant's Reply appears to argue that its original motion ("Applicant's Motion") was still valid, or pertains to Opposer's Amended Notice of Opposition, neither of which are the case. Because of these new arguments, and out of an abundance of caution, Opposer Frito-Lay North America, Inc. ("Opposer") submits this opposition in the event that the Trademark Trial and Appeal Board ("Board") construes Applicant's Reply as a renewed motion or new motion to dismiss Opposer's Amended Notice of Opposition pursuant to FED. R. CIV. P. 12(b)(6). Opposer

is mindful of Trademark Board Manual of Procedure § 502.02(b), which provides that no further papers should be filed after a reply to a motion. However, because Applicant's most recent filing, although termed a "reply" in support of Applicant's Motion to Dismiss filed September 29, 2017 and effectively served on October 16, 2017, makes substantive arguments against Opposer's *Amended* Notice of Opposition, Opposer files this Response to avoid an unintentional concession that Applicant's Motion pertains to Opposer's *Amended* Notice of Opposition or constitutes a renewed motion to dismiss.

### **Procedural History**

On September 29, 2017, Applicant filed a motion to dismiss this opposition proceeding on the basis that Opposer failed to state a claim upon which relief can be granted. Service for Applicant's Motion was effective on Monday, October 16, 2017 when Applicant emailed a copy of Applicant's Motion to Opposer pursuant to Trademark Rule 2.119(b). *See* Doc. No. 9. In response to Applicant's Motion, Opposer filed concurrently on November 3, 2017 both a brief response to Applicant's Motion and an Amended Notice of Opposition in accordance with the provisions of Trademark Board Manual of Procedure § 503.03. Pursuant to Trademark Board Manual of Procedure § 503.03, Applicant's September 29, 2017 motion was made moot by Opposer's filing its Amended Notice of Opposition. However, on November 15, 2017, Applicant filed Applicant's Reply in Support of Applicant's Motion to Dismiss which made substantive arguments that Opposer's newly filed *Amended* Notice of Opposition also failed to state a claim upon which relief could be granted. Although termed a reply, Applicant's arguments attacking Opposer's Amended Notice of Opposition could potentially be construed by the Board as a renewed motion to dismiss, or a second motion to dismiss, Opposer's Amended Notice of Opposition, necessitating Opposer's response.

## Arguments

Pursuant to Trademark Board Manual of Procedure §§ 502.02 and 503, Opposer opposes Applicant's Motion to Dismiss this proceeding pursuant to FED. R. CIV. P. 12(b)(6) based on Opposer's Amended Notice of Opposition. Based on the Board's prevailing legal standard, both Opposer's original Notice of Opposition and Opposer's Amended Notice of Opposition sufficiently plead Opposer's standing and grounds for bringing the instant action. Accordingly, Applicant's Motion should be denied.

### LEGAL STANDARD

A motion to dismiss pursuant to FED. R. CIV. P. 12(b)(6) for failure to state a claim upon which relief can be granted is a test *solely* of the legal sufficiency of a complaint. *Covidien LP v. Masimo Corp.*, 109 U.S.P.Q.2d 1696, 1697 (T.T.A.B. 2014) (emphasis added). "Dismissal under FED. R. CIV. P. 12(b)(6) is appropriate only if it appears to a certainty that [the non-moving party] is entitled to no relief under *any* state of facts which could be proved in support of a claim." *Flash & Partners S.P.A. v. I.E. Mfg. LLC*, 95 U.S.P.Q.2d 1813, 1815 (T.T.A.B. 2010) (emphasis in original). In reviewing a motion to dismiss, the Board will construe all allegations in a complaint so as to do justice, with an eye toward determining whether the complaint contains any allegations which would entitle the complainant to the relief sought. FED. R. CIV. P. 8(e) (2017); TMBP §503.02 (2017). Similarly, whether a complainant has carried its evidentiary burden of proof with respect to any or all of its allegations in the complaint is irrelevant to the decision on a 12(b)(6) motion—the complainant's burden of proof is considered only at the trial stage. *Covidien LP*, 109 U.S.P.Q.2d at 1697, n.3; TBMP § 503.02.

To withstand a motion to dismiss under Rule 12(b)(6), a complaint must "state a claim for relief that is plausible on its face." *Ashcroft v. Iqbal*, 566 U.S. 662, 678 (2009).

“Determining whether a complaint states a plausible claim for relief [is] a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Id.* at 679. In that regard, the Board has consistently held that to state a claim that is plausible on its face in an opposition or cancellation proceeding, a complainant “need only allege sufficient factual content that, if proved, would allow the Board to conclude, or draw the reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark.” *Covidien*, 109 U.S.P.Q.2d at 1697 (citing *Doyle v. Al Johnson’s Swedish Rest. & Butik, Inc.*, 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012)); *Flash & Partners S.P.A.*, 95 U.S.P.Q.2d at 1815; *see also* TBMP § 503.02 and FED. R. CIV. P. 8(a) (a “short and plain statement” of jurisdiction, claims, and relief is all that is required to state a claim for relief).

Regarding standing, under Board precedent, a complaint sufficiently pleads standing to maintain an opposition proceeding where the complainant alleges a direct, personal stake in the outcome of the proceeding, and the allegations in support of its belief of damage have a reasonable basis in fact. *Petroleos Mexicanos v. Intermix, S.A.*, 97 U.S.P.Q.2d 1403, 1405 (T.T.A.B. 2010); *see also* TBMP § 309.03(b). If a complainant establishes standing with regard to at least one valid ground for opposition in a proceeding, the complainant also has the right to assert any other ground for refusal of a registration that has a reasonable basis in fact. *Id.* at 1406; TBMP § 309.03(b). A complainant sufficiently pleads a valid ground for opposing a mark when the complaint alleges a statutory ground that negates the applicant’s right to the registration that is the subject of the proceeding. *Flash Partners S.P.A.*, 95 U.S.P.Q.2d at 1816.

#### OPPOSER’S ALLEGATIONS OF STANDING

Applicant appears to challenge Opposer’s Amended Notice of Opposition on the basis that it fails to sufficiently plead Opposer’s standing to maintain this proceeding. Applicant

appears to take issue with Paragraph 2 of Opposer's Amended Notice of Opposition wherein Opposer asserts "Upon information and belief, Applicant intends to manufacture and sell snack foods in conjunction with the [LET'S TAILGATE!] Mark. Accordingly, Opposer is a competitor of Applicant." It Appears Applicant interprets this paragraph as asserting Opposer's intent to use the subject trademark. However, Opposer's Paragraph 2 assert's Opposer's belief, based on Applicant's trademark application that is the subject of this proceeding, that *Applicant* has an intent to use the subject trademark in conjunction with the goods set forth in the application, namely snack food.<sup>1</sup> Further Opposer's Paragraph 2 asserts that Opposer, who also sells snack foods, is a competitor of Applicant. In conjunction with Paragraphs 1, 3-5, and 13 of Opposer's Amended Notice of Opposition, Opposer alleges further that Opposer, as a competitor of Applicant in the snack food business, has an equal right to use the subject mark or variations thereof because it is a common, descriptive, laudatory call to action commonly used by the public.

All of these allegations taken together undoubtedly meet the Board's standard for pleading standing in this matter. As explained above, the Board has consistently held that an opposer sufficiently pleads facts to demonstrate standing to maintain an opposition where the complaint alleges a direct, personal stake in the outcome of the proceeding, and the allegations in support of its belief of damage have a reasonable basis in fact. *Petroleos Mexicanos*, 97 U.S.P.Q.2d at 1405 (citing *Ritche v. Simpson*, 50 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1999)); TBMP § 309.03(b). This standard, articulated by the Federal Circuit, and applied by the Board, is a liberal one. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 U.S.P.Q.2d 1750, 1760 (T.T.A.B. 2013); *see also Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1844

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<sup>1</sup> If Applicant does not have an intent to use the subject mark, then Applicant's application to register is void and should be rejected on that ground alone.

(T.T.A.B. 2000) (standing is the more liberal of the two elements required to prevail in a Board proceeding); *see also* TBMP § 303.03 (“There is no requirement that a plaintiff show a personal interest in the proceeding different from or ‘beyond that of the general public’ in order to establish standing. There is also no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in an opposition or cancellation proceeding.”).

Where an opposer pleads descriptiveness or failure to function as a trademark as its basis for opposition, the requisite personal stake in the outcome of an opposition proceeding may be established by pleading that opposer is engaged in the sale of the same or related products or services and that opposer has an interest in using the term descriptively in its business. TBMP § 309.03(b). Based on the standards articulated above, Opposer has sufficiently pled facts to establish standing in the instant proceeding. Accordingly, Applicant’s Motion must be denied.

OPPOSER’S FACTUAL ALLEGATIONS REGARDING FAILURE OF APPLICANT’S  
MARK TO FUNCTION AS A TRADEMARK

Applicant alleges that Opposer’s allegations “comprise only speculative claims” “without further support over the question of the functionality of Applicant’s mark.” However, a review of Opposer’s pleadings makes clear that Opposer’s Amended Notice of Opposition sufficiently alleges facts that, if proven, entitle Opposer to relief in the nature of refusal of Applicant’s registration for Applicant’s Mark.

A complainant sufficiently pleads a valid ground for opposing a mark when the complaint alleges a statutory ground that negates the applicant’s right to the registration that is the subject of the proceeding. *Flash Partners S.P.A.*, 95 U.S.P.Q.2d at 1816. There is no question that failure to function as a trademark is a valid statutory ground for opposing Applicant’s Mark under Sections 1, 2 and 45 of the Lanham Act. *See* 15 U.S.C. §§ 1051, 1052 and 1063; *see e.g.*

*D.C. One Wholesaler, Inc. v. Chien*, 120 U.S.P.Q.2d 1710 (T.T.A.B. 2016) (sustaining opposition and cancellation for I <3 NY mark on the ground that the mark failed to function as a trademark); *In re Volvo Cars of N. Am. Inc.*, 46 U.S.P.Q.2d 1455, 1460 (T.T.A.B. 1998) (refusing registration for DRIVE SAFELY used in connection with automobiles and structural parts therefor for failure to function as a mark because it would be perceived as an everyday, commonplace safety admonition); *In re Manco*, 24 U.S.P.Q.2d 1938, 1942 (T.T.A.B. 1992) (refusing registration of THINK GREEN for products advertised to be recyclable and to promote energy conservation for failure to function as a mark because it merely conveys a message of environmental awareness or ecological consciousness); accord TMEP § 1202.04(b) (2017) (explaining when widely used messages must be refused trademark registration for failure to function as a trademark). To sufficiently plead facts to state a claim under Sections 1, 2 and 45 for failure to function as a trademark, Opposer need only allege facts that, if proven, would establish that Applicant's mark merely conveys an ordinary, familiar concept or sentiment that is used by a variety of sources in the marketplace, rather than distinguishes Applicant's goods from those of others. *See e.g., Island Co. LLC v. Abercrombie & Fitch Co.*, No. 13-80333-CIV, 2014 WL 12489851, at \*4 (S.D. Fla. Feb. 19, 2014) (counter-claimant adequately stated a claim for failure to function as a trademark where pleadings alleged that registrant's mark "does not and cannot identify and distinguish the source of [registrant's] goods as recited in its trademark application from the goods of others" and "[registrant] should not have been issued the '762 Registration in light of the mantra's failure to function as a trademark.").

Opposer's allegations in the Amended Notice of Opposition sufficiently put Applicant and the Board on notice of Opposer's claims that Applicant's mark fails to function as a trademark. Opposer specifically alleges that Applicant's mark is a commonly used phrase, that



others in the snack food marketplace consistently use Applicant's mark or similar phrases to provide information to consumers, and that as such, Applicant's mark is incapable of distinguishing Applicant's goods from the goods of others. (See Amended Not. Of Opp. ¶¶ 5-12). Accordingly, Opposer's Amended Notice of Opposition sufficiently states a claim based on failure to function as a trademark.

Moreover, Opposer's allegations are not merely legal conclusions. However, even if Opposer's allegations contain some legal conclusions, that does not prevent Opposer from stating a claim under Rule 12(b)(6). A complaint may contain allegations related to the legal standard that serves as the basis for a claim to relief, so long as there is, as is the case here, sufficient factual support. *Iqbal*, 566 U.S. at 867.

The remainder of Applicant's attacks on Opposer's claims essentially argues that Opposer cannot win its case, and therefore the case should be dismissed for failure to state a claim. That is not the legal standard for a motion based on FED. R. CIV. P. 12(b)(6). *See Covidien LP*, 109 U.S.P.Q.2d at 1697 (Rule 12(b)(6) motion tests only the sufficiency of the pleadings). Rather, the arguments Applicant makes about whether or not its alleged trademark mark can function as such are appropriate either at the summary judgment phase or at the trial phase of this proceeding. Again, Opposer is not required to meet its evidentiary burden at this stage in the proceeding, and to the extent Applicant argues that Applicant's Mark is, in fact, capable of functioning as a trademark to distinguish Applicant's goods from those of others, those arguments are premature and should not be considered. *See* TBMP § 503.02 ("Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather a final hearing or upon summary judgment, after the parties have had an opportunity to support their respective positions.")

**Conclusion**

To the extent the Board finds any deficiencies in Opposer's Amended Notice of Opposition, Opposer respectfully requests leave to file a further amended notice. However, based on all of the foregoing, Opposer requests that Applicant's Motion be denied and this proceeding advance under a new schedule as set out by the Board.

This the 21st day of November, 2017

Respectfully submitted,

WOMBLE BOND DICKINSON (US) LLP

*/Tiffani D. Otey/*

Jacob S. Wharton

Tiffani D. Otey

WOMBLE BOND DICKINSON (US) LLP

One West Fourth Street

Winston-Salem, NC 27101

Tel: (336) 747-6609

Fax: (336) 726-6986

E-Mail: [Jacob.Wharton@wbd-us.com](mailto:Jacob.Wharton@wbd-us.com)

[Tiffani.Otey@wbd-us.com](mailto:Tiffani.Otey@wbd-us.com)

Laura A. Kees

WOMBLE BOND DICKINSON (US) LLP

Atlantic Station 271 17th Street, NW

Suite 2400One

Atlanta, GA 30363-1017

Tel: (404) 879-2427

Fax: (404) 879-2927

E-Mail: [Laura.Kees@wbd-us.com](mailto:Laura.Kees@wbd-us.com)

*Attorneys for Frito-Lay North America, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S REPLY OR RENEWED MOTION TO DISMISS PURSUANT TO RULE 12(b)(6) has been served on Applicant by forwarding said on November 21, 2017, via email, to:

MANDY T GARRELS  
CERES PATENT & TECHNOLOGY LLC  
529 ONTARIO AVE, SN2  
SHEBOYGAN, WI 53081  
UNITED STATES  
mgarrels@intellectualcounsel.com  
Phone: 920-287-7933

*/Tiffani D. Otey/*

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Tiffani D. Otey