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

Proceeding	91243938
Party	Defendant Antonio Maccieri
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Submission	Motion to Dismiss - Rule 12(b)
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Date	12/11/2018
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91243938
Applicant	Antonio Maccieri
Opposer	Pernod Ricard Portugal-Distribuição, S.A.

**Applicant's Motion To Dismiss For Failure To State A Claim
Upon Which Relief Can Be Granted**

Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, Applicant Antonio Maccieri ("Applicant"), hereby moves to dismiss the claim of false suggestion of a connection in Opposer's Pernod Ricard Portugal-Distribuição, S.A.'s ("Opposer") Notice of Opposition to Application No. 87/823757. Applicant's brief in support of this motion is attached.

Opposer's Notice of Opposition fails to state statutory grounds upon which it is based and it fails to sufficiently plead facts to establish cause of action for false suggestion of a connection.

It is noted that Applicant's time in which to answer the Notice of Opposition is tolled pending the outcome of the present Motion to Dismiss.

Respectfully submitted,



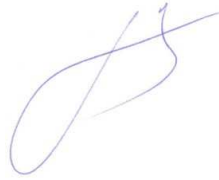
Date: December 11, 2018

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Certificate of Service

I hereby certify that a copy of this paper was served on this date December 11, 2018 upon Opposer's Attorney of Record at its email addresses of record, as follows:

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Justin R. Young

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

Proceeding	91243938
Applicant	Antonio Maccieri
Opposer	Pernod Ricard Portugal-Distribuição, S.A.

**Applicant's Brief In Support Of Its Motion To Dismiss For Failure To State A
Claim Upon Which Relief Can Be Granted**

Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP § 503, Applicant Antonio Maccieri ("Applicant"), hereby moves to dismiss the claim of false suggestion of a connection in Opposer's Pernod Ricard Portugal-Distribuição, S.A.'s ("Opposer") Notice of Opposition to Application No. 87/823757.

1. Introduction

Opposer filed a Notice of Opposition alleging two opposition grounds: (1) Priority and likelihood of confusion under Section 2(d) of the Trademark Act; and (2) False suggestion of a connection under Section 2(a) of the Trademark Act. However, Opposer has failed to state a claim for relief as to the false suggestion of a connection claim. As such, the Notice of Opposition should be dismissed for the reasons set forth below.

2. Standard of Review

Proceedings before the Board are governed by the Federal Rules of Civil Procedure, except where otherwise provided by the Trademark Rules of Practice. 37 C.R.F. § 2.116(a). Where a complaint or counterclaim is legally insufficient, Rule 12(b)(6) of the Federal Rules of Civil Procedure permits a defendant to seek the dismissal for "failure to state a claim upon which relief can be granted."

Specifically, in the context of an opposition "to withstand a motion to dismiss, petitioner need only allege such facts which, if proved, would establish that petitioner is entitled to the relief sought: that is, (1) petitioner has standing to bring the proceeding, and (2) a valid statutory ground exists for [denying] the registration." *Corporacion Habanos, S.A. v. Rodriguez*, 99 U.S.P.Q.2d 1873, 1874 (TTAB 2011); TBMP § 503.02.

Pursuant to TBMP § 503, “for purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim.”

A motion to dismiss for failure to state a claim is a test of the legal sufficiency of the petition. *Space Base Inc. v. Stadis Corp.*, 17 U.S.P.Q.2d 1216, 1219 (TTAB 1990). Although the Board must accept all of the petitioner’s allegations as true, it may not “ignore facts alleged in the complaint that undermine the plaintiff’s claim.” See *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2D 1203, 1205 (TTAB 1997). While all well-pled facts are accepted as true, legal conclusions are not entitled to the same presumption. *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937 (2009).

Claim of False Suggestion of a Connection
Trademark Act Section 2(a)

A properly pleaded claim in a Notice of Opposition requires a statement that (1) sets forth the elements of the claim plainly and succinctly and (2) provides sufficient detail to give the applicant a clear idea of the opposer’s complain and the legal basis for recovery. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985). Opposer’s Notice of Opposition does not properly plead a claim under Section 2(a) that satisfies both of these requirements.

1. Opposer Has Not Properly Pleaded the Essential Elements of Claim Under Section 2(a) of the Lanham Act.

The entirety of Opposer assertion on this ground are in Paragraph 13 of its Notice of Opposition that states: “*Opposer previously has used in commerce, in connection with its MACIEIRA-branded products, the name and mark MACIEIRA, such that that name or mark has become a name or identify of substantial reputation that is closely identified with Opposer. Applicant’s applied-for mark is highly similar to the previously used name and mark MACIEIRA so as to be likely, when applied to the goods and services set forth in the application at issue, to point uniquely to Opposer, and to falsely suggest a*

connection with Opposer within the meaning of 15 U.S.C. § 1052(a).” In addition, the Opposition cover sheets states that Opposer has based its Opposition, in part, on Section 2(a) of the Lanham Act.

Section 2(a) of the Lanham Act prohibits registration of a mark that

Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USC §3501(9)]) enters into force with respect to the United States.

The Board has promulgated specific standards for pleading a claim arising under Section 2(a) of the Lanham Act. Specifically, the Board requires that the Opposer specifically alleges that (1) the challenged mark is the same or a close approximation of Opposer’s previously used name, identity, or persona, (2) Applicant’s mark would be recognized as such, (3) Applicant is not connected with Opposer or the goods that it provides under its registered mark; and (4) Opposer’s name, identity, or persona is sufficiently famous with respect to the relevant goods and services, so that the relevant public will assume that Applicant’s goods are connected with Opposer. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 217 USPQ 505, 507-510 (Fed. Cir. 1983); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985); *Canovas v. Venezia*, 220 USPQ 660, 661-62 (TTAB 1983). The Opposer must also allege that Opposer’s name, identity, or persona enjoyed the requisite level of fame before the Applicant either filed or began using the mark, i.e., Applicant’s mark pointed solely and unmistakably to Opposer as of those dates. *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d 1894, 1899 (TTAB 1992); *The Board of Trustees of the University of Alabama v. BAMA - Werke Curt Baumann*, 231 USPQ 408, 410 (TTAB 1986). It is critical to understand that a claim of false suggestion of a connection under Section 2(a) pertains specifically to a connection with the plaintiff as an organization and not merely the use of confusingly similar marks. *See McDonnell Douglas Corp.* at 48 (“Since the mark sought to be canceled is

“DataStat”, which does not remotely resemble petitioner’s corporate name, McDonnell Douglas, it is highly questionable whether any such connection could be alleged.”).

Opposer’s Notice of Opposition does not allege the above-referenced elements essential to a properly pleaded claim under Section 2(a) of the Lanham Act. Opposer’s Notice of Opposition does not allege that Applicant’s “ANTONIO MACCIERI WINEMAKER & Design” mark is the same or a close approximation of Opposer’s name, identity, or persona, i.e. Opposer’s legal name “Pernod Ricard Portugal-Distribuição, S.A.,” that Applicant’s “ANTONIO MACCIERI WINEMAKER & Design” mark would be recognized as such; or that Opposer’s name, identity, or persona is sufficiently famous with respect to the relevant goods and services, so that the relevant public will assume that Applicant’s goods are connected with Opposer. In addition, Opposer’s Notice of Opposition does not allege that Applicant’s “ANTONIO MACCIERI WINEMAKER & Design” mark solely and unmistakably points to Opposer as an organization (as “Pernod Ricard Portugal-Distribuição, S.A.”) and prior to Applicant’s first use of the “ANTONIO MACCIERI WINEMAKER & Design” mark or prior to the filing date of Applicant’s application for the “ANTONIO MACCIERI WINEMAKER & Design” mark. As such, Opposer has completely failed to properly plead any of the essential elements of a claim under Section 2(a).

2. Opposer Has Not Properly Alleged the Requisite Facts Necessary to Support a Claim Under Section 2(a) of the Lanham Act.

Opposer has also not alleged facts, which if proven, would establish the above referenced essential elements of a claim under Section 2(a) of the Lanham Act. “Mere parroting of the requisite elements [of a Section 2(a) false suggestion of a connection claim] without sufficient factual support therefore is insufficient to meet the pleading requirements set down by the Board...” *McDonnell Douglas Corp.* at 48.

Here, not only has Opposer failed to properly plead any of the essential elements of a claim under Section 2(a), but Paragraph 13 of Opposer’s Notice of Opposition containing Opposer’s Section 2(a) allegation consists of only legally conclusive language. There are no alleged facts in support of the claims in Paragraph 13. Furthermore, merely showing ownership of a mark, as claimed in Paragraph 12 of the Notice of Opposition, without any further facts does not show that the mark serves as

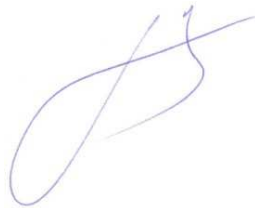
Opposer's name, identity, or persona, that the mark is solely and unmistakably associated with Opposer as an organization, or that the mark has the requisite amount of fame to support a claim under Section 2(a).

Opposer is, in fact, incapable of alleging any such facts because Opposer's alleged mark is not the identity or persona of Opposer as an organization. The name "Pernod Ricard Portugal-Distribuição, S.A." is Opposer's identity or persona and it is surely not Opposer's contention that Applicant's "ANTONIO MACCIERI WINEMAKER & Design" mark creates a false suggestion of a connection with the name "Pernod Ricard Portugal-Distribuição, S.A." Such an allegation would be completely outrageous. Instead, it appears that Opposer is confusing claims under Section 2(a) and Section 2(d) of the Lanham Act, since, at most, Paragraphs 12 and 13 of Opposer's Notice of Opposition recite claims under Section 2(d) of the Lanham Act due to a likelihood of confusion between the parties' marks. *See Miller Brewing Co., v. Anheuser Busch, Inc.*, 27 USPQ2d 1711, 1713 (TTAB 1993).

Conclusion

For the reasons set forth above, this motion should be granted in its entirety, Opposer's claim of false suggestion of a connection must be dismissed with prejudice for failure to state claims upon which relief may be granted.

Respectfully submitted,



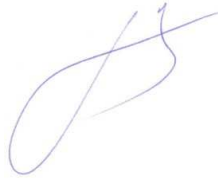
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Certificate of Service

I hereby certify that a copy of this paper was served on this date December 11, 2018 upon Opposer's Attorney of Record at its email addresses of record, as follows:

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A handwritten signature in blue ink, appearing to read "Justin R. Young", is positioned above a horizontal line.

Justin R. Young