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

Proceeding	91267970
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Attachments	2021-08-10 Motion to Dismiss Opposers Claim Under Section 2a of the Lanham Act.pdf(165630 bytes)

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

TRUCENTA HOLDINGS LLC,

Opposer,

v.

BREEZE SMOKE LLC,

Applicant.

Opposition No.: 91267970

Mark: BREEZE SMOKE

Serial No. 90/012,117

**MOTION TO DISMISS
OPPOSER’S CLAIM UNDER SECTION 2(a) OF THE LANHAM ACT**

Applicant, Breeze Smoke LLC (“Applicant” or “Breeze Smoke”), by its attorneys Honigman LLP, hereby brings this Motion to Dismiss Trucenta Holdings LLC’s (“Opposer” or “Trucenta”) Second Ground of Opposition for “False Designation of Origin” under Section 2(a) of the Lanham Act.

BACKGROUND

Breeze Smoke is engaged in the business of offering and selling high quality, well-known, and immensely popular tobacco and vaping products, including disposable electronic vaping devices throughout the United States through, *inter alia*, authorized retail stores and distributors. Breeze Smoke Counterclaim, ¶ 6.¹ Breeze Smoke has used various iterations of the trademark “BREEZE,” including but not limited to BREEZE SMOKE, in connection with the offer and sale of disposable electronic cigarettes and related products since at least as early as May 2019 (the “BREEZE Marks”). *Id.* at ¶ 7. Breeze Smoke owns the following U.S. federal trademark applications for its BREEZE Marks:

¹ Breeze Smoke’s Answer and Counterclaim are being filed contemporaneously with this Motion to Dismiss.

Mark	App. No.	App. Date	Goods
BREEZE SMOKE	90/012,117	June 20, 2020	Class 34: Disposable Electronic Cigarettes <i>First Use Date: at least as early as March 1, 2020</i>
BREEZE PLUS	90/246,820	October 10, 2020	Class 34: Disposable Electronic Cigarettes <i>First Use Date: at least as early as March 1, 2020</i>
BREEZE PALM	90/650,997	April 16, 2021	Class 34: cigarette wraps; cigarette rolling papers; wraps in the nature of tobacco wraps; tobacco wraps; pre-rolled smoking cones; rolling paper cones
BREEZE PRO	90/555,765	March 2, 2021	Class 34: Disposable Electronic Cigarettes

Id. at ¶ 8, Ex. A to Counterclaim.

Breeze Smoke also owns well-established common law rights in its BREEZE Marks in connection with disposable electronic cigarettes. *Id.* at ¶ 12. Examples of Breeze Smoke’s uses of its BREEZE Marks are shown below.





Id.


Breeze Smoke’s BREEZE electronic cigarette products are promoted, offered and sold through a number of online retail platforms, as well as at a substantial number of bricks-and-mortar locations throughout the United States. *Id.* at ¶ 13. Breeze Smoke also extensively advertises its products on its website <https://www.breezesmoke.com/>. *Id.*

Breeze Smoke has spent substantial time, effort, and money advertising and promoting goods in connection with its BREEZE Marks and has derived substantial revenue from sales of products in connection with its BREEZE Marks. *Id.* at ¶ 15. Through its continuous use of the BREEZE Marks and expenditure of significant advertising and marketing dollars in connection therewith, Breeze Smoke has generated substantial goodwill from and developed widespread consumer recognition in the BREEZE Marks. *Id.* at ¶ 16.

Trucenta And Its “BREEZE” Marks


According to United States Patent and Trademark Office (“USPTO”) filings, Trucenta is a Michigan LLC with an address at 1675 E. Maple Rd., Troy, Michigan 48083. 1 TTABVUE 5. Trucenta is listed as the applicant or registrant of a number of United States Trademark Applications

and Registrations for marks incorporating the term “BREEZE,” including those set forth in the below chart:

	Mark	App./Reg. No.	Goods	Filing Date	Reg./ First Use Dates
1	BREEZE	90/292,582	<p>Class 3: Electronic cigarette liquid comprised of essential oils; to the extent any of the foregoing involves use of cannabis, such cannabis shall have a delta-9 THC concentration of not more than 0.3% on a dry weight basis</p> <p>Class 5: Plant extracts for pharmaceutical purposes, namely, for the treatment of nausea, anxiety, pain, glaucoma, seizures, multiple sclerosis and Crohn's Disease; to the extent any of the foregoing involves cannabis, such cannabis shall have a delta-9 THC concentration of not more than 0.3% on a dry weight basis</p> <p>Class 34: Electronic cigarette liquids comprised of flavoring in liquid form, other than essential oils, used to refill electronic cigarette cartridges; to the extent any of the foregoing involves use of cannabis, such cannabis shall have a delta-9 THC concentration of not more than 0.3% on a dry weight basis; smoking pipes; smoking pipe cleaners; electronic smoking pipes; oral vaporizers for smokers</p>	11/2/2020	N/A (Filed Under Section 1B)
2		90/292,579	Class 3: Electronic cigarette liquid comprised of essential oils; to the extent any of the foregoing involves use of	11/2/2020	N/A (Filed Under

	Mark	App./Reg. No.	Goods	Filing Date	Reg./ First Use Dates
			<p>cannabis, such cannabis shall have a delta-9 THC concentration of not more than 0.3% on a dry weight basis</p> <p>Class 5: Plant extracts for pharmaceutical purposes, namely, for the treatment of nausea, anxiety, pain, glaucoma, seizures, multiple sclerosis and Crohn's Disease; to the extent any of the foregoing involves cannabis, such cannabis shall have a delta-9 THC concentration of not more than 0.3% on a dry weight basis</p> <p>Class 34: Electronic cigarette liquids comprised of flavoring in liquid form, other than essential oils, used to refill electronic cigarette cartridges; to the extent any of the foregoing involves use of cannabis, such cannabis shall have a delta-9 THC concentration of not more than 0.3% on a dry weight basis; smoking pipes; smoking pipe cleaners; electronic smoking pipes; oral vaporizers for smokers</p>		Section 1B)
3	BREZZE	90/292,558	<p>Class 14: Ornamental lapel pins</p> <p>Class 16: Decals; Posters; Stickers; Plastic food storage bags for household use</p> <p>Class 18: Handbags; Wallets; Backpacks; Book bags; Sports bags; All-purpose reusable carrying bags</p>	11/2/2020	N/A (Filed Under Section 1B)

	Mark	App./Reg. No.	Goods	Filing Date	Reg./ First Use Dates
			<p>Class 21: Containers for household use; Insulating sleeve holders for beverage cans; Plastic storage containers for domestic use; Plastic storage containers for household use; Portable coolers, non-electric</p> <p>Class 34: Ashtrays for smokers; Cigarette rolling papers; Smokers' rolling trays; Cigarette lighters; Tobacco grinders</p>		
4	BREEZE	90/292,552	<p>Class 14: Ornamental lapel pins</p> <p>Class 16: Decals; Posters; Stickers; Plastic food storage bags for household use</p> <p>Class 18: Handbags; Wallets; Backpacks; Book bags; Sports bags; All-purpose reusable carrying bags</p> <p>Class 21: Containers for household use; Insulating sleeve holders for beverage cans; Plastic storage containers for domestic use; Plastic storage containers for household use; Portable coolers, non-electric</p> <p>Class 34: Cigarette rolling papers; Smokers' rolling trays</p>	11/2/2020	N/A (Filed Under Section 1B)
5	BREEZE	90/256,675	Class 34: Ashtrays for smokers; Lighters for smokers; Tobacco grinders	10/15/2020	N/A (Filed Under Section 1B)
6	BREEZE	6296005	Class 25: Beanies; hats; hooded sweatshirts; long-sleeved shirts; shirts; sweaters; tank tops; graphic T-shirts;	6/19/2019	Reg. Date: 3/16/2021

	Mark	App./Reg. No.	Goods	Filing Date	Reg./ First Use Dates
			short-sleeved or long-sleeved T-shirts; sweat shirts; T-shirts; tee shirts; woolly hats		Claimed First Use Date: 4/6/2020
7		6296004	Class 25: Beanies; hats; hooded sweatshirts; long-sleeved shirts; shirts; sweaters; tank tops; graphic T-shirts; short-sleeved or long-sleeved T-shirts; sweat shirts; T-shirts; tee shirts; woolly hats	6/19/2019	Reg. Date: 3/16/2021 Claimed First Use Date: 4/6/2020

See 1 TTABVUE 5-7, 12-26. The applications set forth above are based on intent-to-use the covered marks in United States commerce and do not allege any first use dates. *See id.* The registrations set forth above each claim a first use anywhere date of February 2, 2020 and a first use in commerce date of April 6, 2020. *See* Breeze Counterclaim, ¶ 18. These dates are after Breeze Smoke’s date of first use of its BREEZE Marks in commerce, which was at least as early as May 2019. *Id.*

Trucenta instituted this Opposition proceeding against Breeze Smoke’s U.S. Trademark Application No. 90/012,117 for BREEZE SMOKE on March 3, 2021. *See* 1 TTABVUE. In its Notice of Opposition, Trucenta alleges prior rights in its “BREEZE” marks based on its U.S. Trademark Application Nos. 88/462,141 (now Reg. No. 6,296,004); 88/462,147 (now Reg. No. 6,296,005); 90/256,675; 90/292,552; 90/292,558; 90/292,579; and 90/292,582. *See id.*

Trucenta brings three claims against Breeze Smoke in the Opposition: (1) Likelihood of Confusion based on Section 2(d) of the Lanham Act; (2) “False Designation of Origin” based on Section 2(a) of the Lanham Act; and (3) a claim that Breeze Smoke’s BREEZE SMOKE mark is allegedly merely descriptive under Section 2(e)(1) of the Lanham Act and therefore unregistrable.

1 TTABVUE 10-11. As the entire grounds for its second claim under Section 2(a), Trucenta alleges:

Applicant's BREEZE SMOKE mark consists of a false designation of origin that is likely to cause confusion, cause mistake and to deceive as to the affiliation, connection or association of the Applicant with Trucenta and as to origin, sponsorship, or approval of Applicant's goods by Trucenta under Section 2(a) of the Lanham Act . . .

Id. at 10.

For the reasons set forth below, this claim is legally deficient and there are no facts Trucenta could allege to support a Section 2(a) claim against Breeze Smoke. Because Trucenta has not stated, and cannot state, a claim under Section 2(a), this claim must be dismissed with prejudice as a matter of law.

LEGAL STANDARD

A motion to dismiss for failure to state a claim upon which relief can be granted is a test of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). To survive a motion to dismiss, a complaint must "state a claim to relief that is plausible on its face." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 (TTAB 2013). 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." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 555); *see also Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014).

ARGUMENT

Trucenta's purported claim under Section 2(a) must be dismissed. Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a), bars the registration on either the Principal or the Supplemental Register of a designation that consists of or comprises matter which, with regard to

persons, institutions, beliefs, or national symbols, falsely suggests a connection with them. To properly assert a claim of false suggestion of a connection under Section 2(a), an Opposer must plead that (1) Applicant's mark is the same as or a close approximation of Opposer's previously used name or identity; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) Opposer is not connected with the goods sold by Applicant under the mark; and (4) Opposer's name or identity is of sufficient fame or reputation that when Applicant's mark is used on its goods, a connection with Opposer would be presumed. *Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 USPQ2d 1025, 1031-32 (TTAB 2015); *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008).

In this case, Opposer has failed to allege *any* of the elements of a legally sufficient claim under Section 2(a). Opposer has not identified its "name or identity," nor has Opposer alleged any facts even suggesting that such name or identity has achieved any fame, nor has it alleged any facts remotely indicating that Breeze Smoke's mark would point "uniquely and unmistakably" to Trucenta. Opposer merely alleges that Breeze Smoke's BREEZE SMOKE mark is similar to Opposer's "BREEZE" marks. But Trademark Act Section 2(a) is intended to protect the unauthorized use of the persona of a person or institution *which is not a trademark or trade name* upon which a Section 2(d) claim can be made. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982); *see also Hornby v. TJX Cos., Inc.*, 87 USPQ2d 1411, 1427 (TTAB 2008) (finding that use of the mark TWIGGY on children's clothing would be recognized as pointing uniquely and unmistakably to petitioner, who was recognized as a famous British model, and that consumers would presume an association with petitioner). Section 2(a) "is *not about likelihood of confusion*

with trademarks.” In re Wielinski, 49 USPQ2d 1754, 1757 (TTAB 1998). Trucenta has alleged *no facts* upon which a Section 2(a) claim can be based. Nor can it: Trucenta’s purported Section 2(a) claim sounds *entirely* in alleged likelihood of confusion with trademarks. Further, because there are no facts that Trucenta could allege to support a claim of false suggestion of a connection, allowing Trucenta the opportunity to cure the defective 2(a) claim would serve no useful purpose. Trucenta’s Section 2(a) claim should therefore be dismissed with prejudice. *See Sun Hee Jung v. Magic Snow, LLC*, 124 USPQ2d 1041, 1044 (TTAB 2017).

CONCLUSION

Based on the foregoing, Breeze Smoke respectfully requests that Trucenta’s Second Ground of Opposition for “False Designation of Origin” under Section 2(a) of the Lanham Act be dismissed with prejudice as a matter of law.

Respectfully submitted,

Date: August 10, 2021

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CERTIFICATE OF TRANSMITTAL

I hereby certify that on August 10, 2021, I caused this correspondence to be transmitted electronically in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA).

/Mary A. Hyde/

One of the Attorneys for

Applicant/Counterclaimant Breeze Smoke LLC

CERTIFICATE OF SERVICE

I hereby certify that on August 10, 2021, I served a true and correct copy of the foregoing document upon Opposer/Counterclaim Defendant Trucenta Holdings LLC by sending the same via electronic mail to:

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