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

Proceeding no.	91287963
Party	Defendant Brandon House Group, N.A. Corporation
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Submission	Motion to Dismiss - Rule 12(b)
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Date	02/10/2024
Attachments	91287963 Motion to Dismiss.pdf(114111 bytes) 91287963 Memorandum in Support of Motion to Dismiss.pdf(216715 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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IN THE MATTER OF:)	
)	
DUCA DI SALAPARUTA S.P.A.)	
OPPOSER)	OPPOSITION NUMBER: 91287963
)	
V.)	
)	
BRANDON HOUSE GROUP,)	
N.A. CORPORATION)	
APPLICANT)	

**APPLICANT’S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH
RELIEF CAN BE GRANTED**

Applicant, Brandon House Group, N.A. Corporation (“Applicant”), pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Trademark Rule 503, hereby moves the Board for dismissal of Opposer’s Opposition, against Applicant, as Opposer has failed to state a claim upon which relief can be granted. Specifically, Opposer has provided no factual basis with respect to the allegations giving rise to Opposer’s Opposition. Additionally, Opposer’s claims against Applicant are barred to the extent that Applicant’s mark was not found to have a likelihood of confusion with Opposer’s mark by a USPTO Examining Attorney.

WHEREFORE, Applicant respectfully requests that the Court issue an Order dismissing Opposer’s Opposition against Applicant in its entirety, with prejudice.

Respectfully submitted this the 10th day of February, 2024,

s/William A. Wooten
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Certificate of Service

In accordance with Trademark Rule 2.119, I certify that a copy of this Motion was served on the following on February 10th , 2024, via email at the email address indicated below and via posting through ESTTA:

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**APPLICANT’S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH
RELIEF CAN BE GRANTED AND SUPPORTING MEMORANDUM OF LAW**

Under Federal Rule of Civil Procedure 12(b)(6) and Trademark Rule 503, Applicant Brandon House Group, N.A. Corporation (hereinafter, “Applicant”) hereby moves for the entry of an order dismissing Opposer’s Notice of Opposition (Dkt. 1).

- Opposer’s claims of a likelihood of confusion with Opposer’s trademark is nothing more than an assertion of confusion with no factual basis.
- Opposer’s claims of a lack of bona fide intent on the part of Applicant to use the “CORVUS” mark is nothing more than an assertion of a lack of intent with no factual basis.
- Finally, Opposer’s Opposition is overall based on pure assertion with no factual basis.

For these reasons, as explained in greater detail below, Applicant respectfully requests that the Court dismiss Opposer’s Notice of Opposition with prejudice.

FACTUAL BACKGROUND

This is a case involving trademark opposition against Applicant’s trademark application. Opposer filed this action on October 31, 2023 (Notice of Opposition, Dkt. 1) seeking cancellation of

Trademark Application No. 97546487 for “CORVUS” in Class 033.

Opposer is an Italian company and the owner and user of the trademark CORVO (*Id.* at ¶ 4). Opposer alleges that it is or would be damaged by issuance of registration for the mark in these classes due to a likelihood of confusion between CORVO and CORVUS. (*Id.*). Opposer also alleges that Applicant does not have, and did not have at the time of filing, a bona fide intent to use the CORVUS mark in commerce as applied-for or as otherwise as is required under § 1 of the Lanham Act, 15 U.S.C. § 1051(b). (*Id.* at ¶ 5). Opposer provides no factual basis for these claims, presenting them as mere conclusions of fact.

STANDARD OF LAW

For purposes of a motion to dismiss, the Court must take all the factual allegations in the complaint as true. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face. *Id.* A claim has facial plausibility when the Opposer pleads factual content that allows the court to draw the reasonable inference that the Applicant is liable for the misconduct alleged. *Id.* Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice, and allegations of fraud must be pled with particularity. *Id.*; Fed. R. Civ. P. 9(b). When there are well-pleaded factual allegations, a court should assume their veracity and then determine whether they plausibly give rise to an entitlement to relief. *Id.* at 679. A legal conclusion, including one couched as a factual allegation, need not be accepted as true on a motion to dismiss, nor are mere recitations of the elements of a cause of action sufficient. *Id.* at 678; *Fritz v. Charter Township of Comstock*, 592 F.3d 718, 722 (6th Cir. 2010).

ARGUMENT

- 1. Opposer’s claims for likelihood of confusion are without merit due to a lack of overlap in the associated goods and services and a lack of factual basis.**

Opposer's first cause of action against Applicant is that Applicant's mark creates a likelihood of confusion with Opposer's mark within the meaning of Section 2(d) of The Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d). Likelihood of confusion between two marks at the USPTO is determined by a review of all the relevant factors under the du Pont test. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, "there is no mechanical test for determining likelihood of confusion and 'each case must be decided on its own facts.'" TMEP § 1207.01 (citing *du Pont*, 476 F.2d at 1361, 177 USPQ at 567). Each of the thirteen *du Pont* factors may be considered in weighing likelihood of confusion, if raised, and any one factor may be dispositive. *See* TMEP § 1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common industry, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the presence in the marketplace of a significant number of similar marks in use on similar goods/services, the existence of a valid consent agreement between the parties, or another established fact probative of the effect of use. *Id.*

Further, the likelihood of confusion refusal cannot be based on the dissection of a mark or only part of a mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). A consumer's general impression of trademarks is influenced by the actual use of the marks in their entirety, and as such, all components of the marks in question must be given appropriate weight. *See Joseph Phelps Vineyards, LLC v. Fairmont Holdings LLC*, No. 16-1089, slip op. at 4 (Fed. Cir. May 24, 2017) (Newman, J., concurring); *In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992). When a mark's unique components are given fair weight, confusion may become less

likely. *See In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992) (finding that when GIRL is given fair weight, along with VARGA, confusion between VARGA GIRL and VARGAS, for similar goods, becomes less likely); *In re Kose Corporation*, Serial No. 77519214 (TTAB April 26, 2010).

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In this case, Applicant is unable to respond to specific factual allegations from Opposer as none are made in the Notice of Opposition. Opposer’s mark is “CORVO” in IC 033 for wines. Applicant’s mark is “CORVUS” in IC 033 for vodka and spirits. Even in cases where marks may appear similar, additional terms as seemingly inconsequential as an additional “S” have been considered different enough to allow granting of a competing trademark as in the Varga Girl vs. Vargas trademark case. *See In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992) (finding that when GIRL is given fair weight, along with VARGA, confusion between VARGA GIRL and VARGAS, for similar goods, becomes less likely). Therefore, the additional “US” in “CORVUS” should prove sufficient to differentiate the marks in question, particularly when considered alongside the lack of overlap in the goods and services for each mark.

Additionally, Serial No. 97546487 is not the first Application for CORVUS filed by

Applicant. Applicant previously filed for the CORVUS mark in IC 032 and 033 under Serial No. 88223271 in 2018. The mark was published in 2019 and received no opposition from Opposer or any other body. Applicant was unable to provide use during the allowance period for that mark, and subsequently filed the mark at issue in this action upon the expiration of the previous CORVUS mark. The Examining Attorney for both marks found no likelihood of confusion with any mark, including Opposer's CORVO, and Opposer did not file any opposition to the mark until the end of the second publication period. Therefore, Opposer's opposition to Applicant's is not grounded in a bona fide expectation of a likelihood of confusion between the marks.

2. Opposer's claims of a lack of bona fide intent to use the CORVUS mark are without merit due to a lack of factual basis.

An applicant must allege a bona fide intent to use the applied-for mark in US commerce when filing an application based on an intent to use the mark under Section 1(b) of the Lanham Act (15 U.S.C. § 1051(b)(3)(B)), based on an extension of an international registration under the Madrid Protocol and Section 66(a) of the Lanham Act (15 U.S.C. § 1141f(a)), or based on a foreign registration under Section 44(e) of the Lanham Act (15 U.S.C. § 1126(e); TMEP § 1004). In this case, Applicant filed its initial trademark application on May 28, 2022, along with various required sworn statements of its intent to use the mark in commerce. (97433376 TSDR Doc. 14, dated May 28, 2022). Whether an applicant lacked a bona fide intent to use a mark is an objective determination based on all relevant circumstances (*Kelly Servs., Inc. v. Creative Harbor, LLC*, 846 F.3d 857, 864 (6th Cir. 2017); *Boston Red Sox Baseball Club L.P. v. Sherman*, 88 U.S.P.Q.2d 1581, 2008 WL 4149008, at *6 (T.T.A.B. 2008)). The applicant is not required to take concrete steps towards using the mark to have a bona fide intent. The opposer has the burden of proving that the applicant lacked a bona fide intent to use its mark. The opposer must prove by a preponderance of the evidence that the applicant lacked a bona fide intent to use the applied-for

mark. *Kelly*, 846 F.3d at 864. In this case, the Opposer has submitted no evidence to support its claim that Applicant has no bona fide intent to use the “CORVUS” mark, and therefore Opposer’s allegation must be disregarded. Additionally, Applicant’s mark is actively in use for vodka and currently sold online on numerous sites including Total Wine (<https://www.totalwine.com/spirits/vodka/vodka/corvus-vodka/p/2126240279>, accessed on Feb. 10, 2024).

CONCLUSION

For the reasons set forth above, Applicant respectfully requests the Court enter an Order:

1. Dismissing Opposer’s claims for likelihood of confusion;
2. Dismissing Opposer’s claims for no bona fide intent to use the “CORVUS” trademark;
3. Dismissing any additional related claims stemming from Opposer’s Notice of Opposition.

Respectfully submitted,

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