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

Proceeding	92052908
Party	Defendant Joseph J. Norton
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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TRIUMBARI CORPORATION,	:	Cancellation No. 92052908
	:	
Petitioner,	:	
	:	REGISTRANT'S REPLY IN SUPPORT
	:	OF HIS MOTION TO DISMISS
v.	:	PURSUANT TO FED. R. CIV. P. 12(b)(6)
	:	
JOSEPH J. NORTON,	:	
	:	
Registrant.	:	
	:	
-----X	:	

Registrant, Joseph J. Norton, submits this Reply in support of his Motion to Dismiss pursuant to Fed. R. Civ. P. 12(b)(6) against Petitioner, Triumbari Corporation. Registrant seeks an order dismissing the Petition for Cancellation filed against Registration No. 3,323,848 on the grounds that Petitioner has no standing to challenge the validity of the registration, nor has it articulated any viable basis on which the registration should be cancelled. Petitioner's arguments in opposition to the Motion to Dismiss demonstrate a fundamental misunderstanding of the law of trademarks and trade dress and are belied by its own evidence.

**I. PROCEDURAL HISTORY**

Petitioner instituted this action in order to bolster its weak intervention motion in *Bug Juice Brands, Inc. et al. v. Great Lakes Bottling Company*, Civil Action No. 1:10CV229 (PLM) (W.D. Mich.) (hereinafter, the "Federal Action"). In the Federal Action, Registrant obtained a preliminary injunction and ultimately a Final Judgment on Consent and Permanent Injunction Order (the "Final Judgment on Consent") against Petitioner's customer Great Lakes Bottling

Company (“Great Lakes”). (Richard August 31, 2010 Decl., Ex. 6). Great Lakes was enjoined from the use and distribution of its JUNGLE JUICE fruit flavored children’s beverages in trade dress which infringed Petitioner’s BUG JUICE® brand trade dress, which is protected, in part, by Reg. No. 3,323,848 for the distinctive BUG JUICE® bottle design. (*Id.*)

Great Lakes admitted in the Federal Action that the BUG JUICE® brand trade dress, which includes the BUG JUICE® bottle design, covered by Reg. No. 3,323,848, has acquired secondary meaning, is well-known and is “valid” and enforceable.” (*Id.*, Ex. 6 at § J and ¶ 2).

## **II. ARGUMENT**

### **A. LEGAL STANDARD**

“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.’” *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009). For a claim to have “facial plausibility,” there must be enough “factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* On a Rule 12(b)(6) motion, “a court may consider documents which are not physically attached to the complaint but ‘whose contents are alleged in [the] complaint and whose authenticity no party questions.’” *eCash Technologies, Inc. v. Guagliardo*, 210 F. Supp. 2d 1138, 1144 (C.D. Cal. 2001) (a court “need not accept unreasonable inferences, unwarranted deductions of fact, or conclusory legal allegations cast in the form of factual allegations.”). Accordingly, the contents and record of the Federal Action may be considered and demonstrate that the Petition for Cancellation is implausible on its face.

**B. PETITIONER HAS FAILED TO ESTABLISH STANDING**

In order to establish standing, a party must show a belief that it is likely to be damaged by registration of the mark. *Arrow Trading Co., Inc. v. Victorinox A.G.*, Opp. No. 103,315, 2003 WL 21509858 at \*7 (T.T.A.B. June 27, 2003) (opposer failed to show reasonable basis for belief of damage). A belief of damage must be more than subjective; it must have a reasonable basis in fact. *Id.*

Petitioner claims that it “alleged a direct and personal stake in the outcome” of this proceeding in paragraph 2 of the Petition for Cancellation, as set forth in pertinent part below:

Petitioner has standing . . . and ***will be damaged*** if the registration is not cancelled because: a) the registration of the Bottle Design improperly gives the Registrant presumptive exclusive rights to a functional and non-distinctive design that should be available for all bottle manufacturers, including Petitioner, to use; and b) Registrant and his related company have brought a civil action against Great Lakes Bottling Company, . . . one of Petitioner’s customers, that is based, in part, on a claim that bottles manufactured by Petitioner infringe Registrant’s purported trademark rights in the Bottle Design and have obtained an injunction relating to the Bottle Design.

Petition for Cancellation, at ¶ 2 (emphasis added). Petitioner’s allegation of damage is purely speculative and is based on mischaracterizations of the record evidence.

Reg. No. 3,323,848 is registered in Class 32 for “fruit flavored beverages,” not Class 21, which covers plastic bottles. As Petitioner does not manufacture fruit flavored beverages but plastic bottles which it sells to beverage manufacturers, it is not a competitor of Registrant.

Moreover, Petitioner’s claim that Registrant’s enforcement of his rights in his registration will cause “damage” to its business of selling empty beverage bottles misses the mark. The scope of a registration is limited to the goods recited therein. 15 U.S.C. § 1057(b); *In re Save Venice New York, Inc.*, 259 F.3d 1346, 1353 (Fed. Cir. 2001). Accordingly, Reg. No. 3,323,848 protects the BUG JUICE® bottle design with respect to fruit flavored beverages only. As the

existence of Reg. No. 3,323,848 in no way prevents Petitioner from selling plastic bottles, its damage claim is without merit and purely speculative.

Petitioner also mischaracterizes the claims in the Federal Action. Registrant and his related company, Bug Juice Brands, Inc., never claimed that “bottles manufactured by Triumbari infringe the registration at issue.” Opposition, at 4. Moreover, the Final Judgment on Consent does not prohibit “Triumbari from selling certain bottles to Great Lakes.” *Id.*

The Final Judgment on Consent does not prohibit Petitioner from selling bottles to any entity, provided that the bottles sold are not used to infringe the BUG JUICE® trade dress specified in the Final Judgment on Consent. (Richard August 31, 2010 Decl., Ex. 6). The Final Judgment on Consent enjoins Petitioner’s customer, Great Lakes, from using trade dress elements that are likely to cause confusion with the BUG JUICE® brand trade dress elements for fruit flavored beverages. (*Id.*).

Petitioner failed to show a “real interest” and is unable to demonstrate a “reasonable” basis for its belief of damage. On this basis, the Petition for Cancellation should be dismissed.

### **C. PETITIONER’S CLAIM OF FUNCTIONALITY IS DEFICIENT**

Petitioner argues that its functionality claim is viable because it (1) “delineated all of the purportedly functional elements of the bottle design”; (2) alleged that the BUG JUICE® bottle design was a product configuration which could never be inherently distinctive; and (3) alleged that “other similar bottle designs are widely used by other manufacturers and marketers of bottles.” Opposition, at 5-6. Petitioner’s allegations of functionality are fatally deficient.

**1. NO ALLEGED ADVERSE IMPACT UPON PETITIONER'S ABILITY TO COMPETE EFFECTIVELY**

To state a claim for cancellation on grounds of functionality, a claimant “must not only point to certain advantages of the . . . design, but also demonstrate that depriving them of these advantages will have a materially adverse impact upon their ability to compete effectively . . . .” *Northwestern Corp. v. Gabriel Mfg. Co., Inc.*, No. 95 C 2004, 1996 WL 251433, at \*6 (N.D. Ill. May 8, 1996). Petitioner failed to set forth any allegations regarding advantages of Registrant’s trade dress configuration or how the deprivation of those advantages would “adversely impact” Petitioner’s ability to compete in the fruit flavored children’s beverage market (the only market to which Reg. No. 3,323,848 is directed) or how manufacturing a different bottle design would raise its production and marketing costs. *Id.* The Petition for Cancellation contains no factual matter supporting a plausible claim of functionality. *Iqbal*, 129 S. Ct. at 1949.

**2. SUPREME COURT PRECEDENT PROTECTS THE BUG JUICE® BOTTLE DESIGN AS PRODUCT PACKAGING**

Petitioner’s argument that the bottle design covered by Reg. No. 3,323,848 is “product configuration” trade dress and, therefore, can never be inherently distinctive and is entitled to protection only upon a showing of secondary meaning is flat out wrong. Opposition, at 5-6. The Supreme Court in *Wal-Mart Stores, Inc. v. Samara Bros. Inc.*, 529 U.S. 205, 215 (2000), specifically noted that a “a classic glass Coca-Cola bottle, for instance, may constitute packaging for those consumers who drink the Coke and then discard the bottle.” Further, numerous registrations exist for bottle configurations used as product packaging for scotch whiskies, rum, wine and water. (Richard October 7, 2010 Decl., Ex. 2). All of these marks are registered in the class for the goods contained in the bottles, namely, Class 32, *not* in Class 21 for bottles. (*Id.*). In any event, in granting the preliminary injunction, the court in the Federal Action necessarily

found that the BUG JUICE® brand package trade dress was either inherently distinctive or had established secondary meaning. Moreover, the district court entered the Final Judgment on Consent which explicitly states that the BUG JUICE® trade dress is valid, has acquired secondary meaning and is well-known. (Richard August 31, 2010 Decl., Ex. 6 at §§ D and J). Findings of the court incorporated into the Final Judgment on Consent bind the parties and those in privity with them.

**3. PETITIONER'S SPECIOUS ARGUMENT OF NON-DISTINCTIVENESS**

Petitioner's argument that the bottle design in Reg. No. 3,323,848 is not distinctive because it sold unspecified "similar" bottles to unspecified customers in unspecified countries in 1996 is without factual or legal foundation. Under the Supreme Court's ruling in *Iqbal, supra*, this allegation is simply not plausible and is belied by the declarations of Dominic Triumbari, Petitioner's "principal" dated August 25 and September 21, 2010. (Richard October 7, 2010 Decl., Exs. 3-4).

First, Mr. Triumbari claimed that the bottle used in connection with the JUNGLE JUICE trade dress (the "Bottle at Issue") was initially produced in August 2005 and has since been distributed to various customers. (Richard October 7, 2010 Decl., Ex. 3 at ¶ 4). The application which matured to registration as Reg. No. 3,323,848 was filed on December 25, 2004 and claimed a date of first use of January 3, 1997, long prior to Petitioner's initial claimed date of first use of 2005. Mr. Triumbari later conceded that Petitioner first sold the Bottle at Issue in the U.S. in March 2006. (*Id.*, Ex. 4 at ¶ 3). Accordingly, Petitioner's claims regarding lack of distinctiveness based on its sale of "similar bottles" in 1996 and the sale of the Bottle at Issue in 2006 to one customer in "Puru (sic) Indiana" is not plausible. (*Id.*).

**D. PETITIONER'S FRAUD CLAIM HAS NO LEGAL BASIS**

Petitioner argues that its allegations of fraud are adequate because it “delineated specific statements that Norton knowingly made to the Examining Attorney in connection with the registration” and these statements were not made upon information and belief. Opposition, at 6-7. As Petitioner provides no facts regarding the alleged false statements “knowingly made,” its fraud allegations fail to meet the requirements of Rule 9 and the *Iqbal* plausibility standard.

Where an applicant believes in good faith that it is the senior user, its ownership oath is not fraudulent. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1206 (T.T.A.B. 1997) (failure to disclose the rights of another does not constitute fraud); *Kelly Servs. Inc. v. Greene's Temporaries Inc.*, 25 U.S.P.Q.2d 1460, 1462-63 (T.T.A.B. 1992) (good faith belief that applicant's ownership rights are superior does not constitute fraud); 6 *McCarthy on Trademarks and Unfair Competition*, § 31:77 (4th ed. 2010). Petitioner's claim that Registrant should have disclosed the existence of its “similar” bottles or the Bottle at Issue is legally deficient.

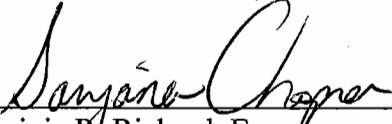
Petitioner's fraud claim, which is based on: (1) Registrant's alleged knowledge of Petitioner's sale of “similar bottles” to unspecified customers in unspecified countries; and (2) the sale of the Bottle at Issue prior to the submission of the July 31, 2006 Norton Declaration, is implausible. Opposition, at 6. Petitioner provides no documentary evidence reflecting its alleged sale of “similar” bottles in 1996 in the U.S., the Bottle at Issue in 2006 in the U.S. or explanation as to how Registrant would know of such sales.



**III. CONCLUSION**

Registrant requests that Petitioner's Petition for Cancellation be dismissed with prejudice without leave to replead, and that this proceeding be dismissed in its entirety.

Dated: New York, New York  
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