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

Proceeding	92053211
Party	Plaintiff Constellation Brands, Inc.
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Attachments	Motion to Strike Affirmative Defense 12-13-10.doc.pdf ( 7 pages )(185594 bytes )

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

In the Matter of Registration No. 3478479  
Registered: July 29, 2008

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Constellation Brands, Inc.

Cancellation No.: 92053211

Petitioner

Mark: MIXED BLACKS

v.

Reg. No.: 3478479

Rudd Wines, Inc.

Filed: March 19, 2008

Registrant

Issued: July 29, 2008

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**PETITIONER'S MOTION TO STRIKE REGISTRANT'S SECOND AFFIRMATIVE  
DEFENSE FROM REGISTRANT'S ANSWER TO THE PETITION FOR  
CANCELLATION**

Petitioner, Constellation Brands, Inc. ("Petitioner"), hereby moves to strike the first affirmative defense of Registrant Rudd Wines, Inc.'s ("Registrant") Answer to the Petition for Cancellation. For the foregoing reasons, the alleged defenses do not provide Registrant with a legally sufficient or legally supportable defense to the Petition for Cancellation. As such, the defense is insufficient.

This motion has been made within the time prescribed in Fed. R. Civ. P. 12(f) and is thereby timely. Petitioner feels that the instant motion will be helpful in narrowing and limiting the issues in this proceedings and thereby also serving as a guide in conducting discovery. As stated in 2A Moores Federal Practice paragraph 12.21[3]:

Although courts are reluctant to grant motions to strike, where a defense is legally insufficient, the motion should be granted in order to save the parties unnecessary expenditure in time and money in preparing for trial.

Petitioner's grounds for this motion are set forth below.

## **Registrant's Second Affirmative Defense Should Be Stricken**

Petitioner believes Registrant's Second Affirmative Defense in Registrant's Answer should be stricken and reads as follows:

2. Petitioner has filed to state a claim for which relief can be granted under 15 U.S.C. Section 1064(a); thus the Petition should be dismissed.

Registrant's has alleged that Petitioner's pleading is insufficient and simultaneously has provided no factual basis for its contention. Pursuant to 15 U.S.C. § 1064 [Section 14 of the Trademark Act], "A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905.."

Petitioner has standing and pursuant to TBMP 303.03, Petitioner has alleged grounds for the cancellation based upon the fact that (i) Registrant's mark so resembles Petitioner's mark as to be likely, when used on or in connection with the goods or services applied for to cause confusion, or to cause mistake, or to deceive and thus result in damage to Petitioner; and (ii) That Registrant's mark would dilute the distinctive quality of Petitioner's mark resulting in damage to Petitioner.

The forgoing grounds are specifically set forth in Petitioner's pleading and, if one or more is proven, Petitioner will be entitled to the relief which it is seeking. As such, Petitioner has clearly stated a claim upon which relief can be granted and is entitled to an order striking the

defense set forth in Affirmative Defense No. 2. See *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973).

Registrant's asserted defense questions the sufficiency of Petitioner's pleading and Petitioner's standing. While Rule 12(b) permits Registrant to assert the above defense, "it necessarily follows that a plaintiff may utilize this assertion to test the sufficiency of the defense in advance of trial by moving . . . to strike the 'defense' from the defendant's answer." *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, at 1222-1223 (TTAB 1995), citing *S.C. Johnson & Son Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973).

The following factors set forth in *Order of Sons of Italy* govern a motion to strike a defense of failure to state a claim upon which relief may be granted.

1. To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an Petitioner need only allege such facts as would, if proved, establish that (1) the Petitioner has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration.
2. For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Petitioner's well pleaded allegations must be accepted as true, and the notice of opposition must be construed in the light most favorable to Petitioner.
3. Dismissal for insufficiency is appropriate only if it appears certain that the Petitioner is entitled to no relief under any set of facts which could be proved in support of its claim.
4. The standing question is an initial inquiry directed solely to establishing the personal interest of the plaintiff. A Petitioner need only show "a personal interest in the outcome of the case beyond that of the general public."

Petitioner, in its Petition to Cancel, has alleged, *inter alia*, the following:

- Among the wines produced or that may in the future be produced by Petitioner and its related companies are a wide variety of red wines and red wine blends, including blends that are commonly referred to as "mixed blacks." (Pet.Canc. ¶ 3).
- Petitioner has a right equal to that of Registrant to use "mixed blacks" to describe its red wine blends. (Pet.Canc. ¶ 4).

- Upon information and belief, the Registrant has abandoned the mark covered by the Registration. The Cancellation is, therefore, appropriate under Section 14(3) of the Lanham Act, 15 U.S.C. Section 1064(3). (Pet.Canc. ¶ 8).
- Upon information and belief, the Registrant has not used the mark covered by the Registration for at least three (3) years. (Pet.Canc. ¶ 10).
- Registrant's failure to make use of its alleged mark in the United States for a period of three (3) years is *prima facie* evidence of abandonment. . (Pet.Canc. ¶ 11).
- Upon information and belief, the sole use by Registrant of MIXED BLACKS was on a 2003 EDGE HILL Napa Valley red wine, of which only 90 cases were produced. (Pet.Canc. ¶ 12).
- Alternatively, Petitioner seeks to cancel the registration for MIXED BLACKS on the basis that the same is descriptive of the goods recited in the registration. (Pet.Canc. ¶ 14).
- Upon information and belief, Registrant, when it applied to register MIXED BLACKS on the Supplemental Register, conceded that the mark is descriptive of the goods set forth in the registration sought to be cancelled. . (Pet.Canc. ¶ 15).
- Upon information and belief, Zinfandel, Petite Sirah, Grenache, Mouvedre, Carignane, and Alicante Boushet are grape varieties commonly known as "blacks. (Pet.Canc. ¶ 17).
- Upon information and belief the relevant consumer/public associates "mixed blacks" with red wine blends. (Pet.Canc. ¶ 18).
- Petitioner, as a producer and purveyor of wine, including red wine blends, is being harmed by the continued registration to Registrant of a mark which is descriptive of the red wine blends, as the same will create a cloud on Petitioner's right to use the term "Mixed Black " to describe red wine blends. (Pet.Canc. ¶ 19).
- Alternatively, Petitioner seeks to cancel the registration for MIXED BLACKS on the basis that the term is a generic term for a blend of red wines. (Pet.Canc. ¶ 20).
- Petitioner, as a producer and purveyor of wine, including red wine blends is being harmed by the continued registration to Registrant of a mark which is a generic term for a blend of red wines, as the same will create a cloud on Petitioner's right to use the term "MIXED BLACKS" as a generic term for blends of red wine of that name. (Pet. Canc. ¶ 21).

- The continued existence of Reg. No. 3478479 creates a serious cloud on Petitioner's continued right to use, alone or in combination, for the goods set forth in its application. (Pet. Canc. ¶ 22).

The forgoing allegations are specifically set forth in Petitioner's pleading and, if proven, Petitioner will be entitled to the relief which it is seeking. Further, when Petitioner's claims are viewed in the light most favorably to Petitioner, they clearly assert a sufficient claim of standing beyond that of the general public. Petitioner has stated a legally sufficient claim upon which relief can be granted and is entitled to an order striking the defenses set forth in paragraph 2 of Registrant's Answer. *See, S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973).

Fed. R. Civ. P. 8(d)(2) specifically provides "A party may set out two or more statements of a claims or defense alternatively or hypothetically, either in a single count or defense or in separate ones." Even if Petitioner's pleading is construed as a hypothetical pleading of likelihood of confusion, the Board has determined that that is appropriate, "where a petitioner's standing is based on its inability to secure registration of its mark, albeit it is the senior user, because the registered mark has been cited as a reference by the Examining Attorney." Home Juice Company v. Runglin Companies Inc., 231 USPQ 897, 899 (TTAB 1986) citing John T. Clark Co. v. Colgate-Palmolive Co., 169 USPQ 498, 499 (TTAB 1971); Yard-man, Inc. v. Getz Exterminators, Inc., 157 USPQ 100, 105 (TTAB 1968), citing Old Monk Olive Oil Co. v. Southwestern Coca-Cola Bottling Co., 118 F.2d 1015, 49, USPQ 192 (CCPA 1941).

Petitioner has stated a legally sufficient claim upon which relief can be granted and is entitled to an order striking Registrant's First Affirmative Defense. *See, S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973). The defense pleaded is insufficient as a matter of law.

Petitioner submits it is entitled to an order striking Registrant's Second Affirmative Defense.

WHEREFORE, Petitioner respectfully moves that its motion to strike the second affirmative defense of Registrant's Answer be granted in all respects.

Respectfully submitted,

BAKER AND RANNELLS PA

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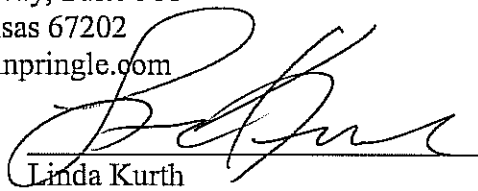
Dated: December 13, 2010

CERTIFICATE OF SERVICE

I hereby certify a copy of the foregoing Petitioner's Motion to Strike Registrant's Second Affirmative Defense from Registrant's Answer to the Petition for Cancellation was served on counsel for Registrant, this <sup>th</sup> day of December, 2010, by sending same via First Class Mail, postage prepaid, to:

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Dated: December/3, 2010

  
Linda Kurth