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

Proceeding	92056848
Party	Plaintiff Bacardi & Company Limited
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Bacardi & Company Limited :
Petitioner, :
 :
v. :
 : Cancellation No.92056848
 :
Brauerei Beck GmbH & Co. KG :
Registrant. : Reg. No. 4,293,143
 :

PETITIONER’S RESPONSE TO REGISTRANT’S MOTION TO DISMISS

Petitioner, Bacardi & Company Limited, (“Petitioner”) hereby responds to Registrant’s Motion to Dismiss. For the reasons set forth herein, Petitioner submits that the Motion to Dismiss is baseless and was filed merely for the purposes of delay. Petitioner respectfully requests a telephone conference with the Interlocutory Attorney in order to expedite a decision on this Motion and move this proceeding forward.

Preliminarily, Petitioner objects to Registrant’s attempts to introduce facts and evidence beyond the pleadings as improper and entitled to no consideration. See *Trademark Trial and Appeal Board Manual of Procedure* sect. 503.04.

Legal Standard

A court should **not** dismiss a complaint under Rule 12(b)(6) for failure to state a claim for relief “...unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claims which would entitle him to relief.” *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957). As explained in the Trademark Trial and Appeal Board Manual of Procedure: “In order to withstand such a motion [to dismiss], a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding).” See *Trademark Trial and Appeal Board Manual of Procedure* sect. 503(2) and *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1874 (TTAB 2011); *Bayer Consumer Care Ag v. Belmora LLC*, 90 USPQ2d 1587, 1590 (TTAB 2009); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theaters*, 56 USPQ2d 1538, 1539 (TTAB 2000) and other cases cited therein. Petitioner has clearly met this threshold.

This Board has already held that a petitioner need only allege enough factual matter to suggest its claim is plausible and “...raise a right to relief above the speculative level.” See *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007) and *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873 (TTAB 2011).

Rather than a pleading with sufficient allegations, Registrant is seemingly seeking “evidence” in support of Petitioner’s claims; however, that is not the standard to survive a

Motion to Dismiss. Rather, Petitioner must “...state a claim that is plausible on its face.” Petitioner is not expected to prove its allegations at the pleading stage. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

In an apparently desperate attempt to find a basis for its Motion to Dismiss, Registrant cited a case in support of its position that the well-regarded TTABLOG has called “...one of the more bizarre TTAB cases in years.” The cited case, *Robert Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780 (TTAB 2012) [precedential], involved Plaintiff’s claim that “many establishments in the classes to which Registrant’s mark [which are goats on a grass roof] apply have, because of Registrant’s marks, refrained from placing goats on their grass roofs, as a result of which Petitioner has been, and will continued [*sic*] to be, damaged in that Petitioner has been, and will continue to be, unable to satisfy his desire to take photographs of goats on grass roofs.” Surely, no careful analysis is required to distinguish this cited case from the present proceeding. It is also noteworthy that this cited case relates primarily to Plaintiff’s standing, rather than to the legal sufficiency of the actual claims at issue.

Finally, this Board must construe the complaint in the light most favorable to the Petitioner. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006), *aff’d*, unpublished No. 07-110 (Fed. Cir. July 11, 2007).

Petitioner's Dilution Claim is Sufficiently Pled.

Despite Registrant's claims to the contrary, Petitioner has pled more than sufficient facts and allegations in support of its claim of fame and dilution. In fact, the Petition to Cancel in the present proceeding offers no fewer than seven paragraphs which provide sufficient pleading bases and bolster Petitioner's claim of fame, including paragraphs 5, 7, 8, 11, 16, 17 and 18. Paragraph 5 also specifically states that Petitioner uses both BOMBAY SAPPHIRE and SAPPHIRE. Paragraph 6 includes a reference to an incontestable registration for SAPPHIRE and the exhibit attached to the Petition to Cancel includes the details of Petitioner's pled registrations.

The Trademark Trial and Appeal Board Manual of Procedure only contemplates that a successful pleading include a claim of fame and an allegation that the plaintiff's mark was famous prior to any date relied upon by Defendant. See *Trademark Trial and Appeal Board Manual of Procedure* sect. 309.03(c) Petitioner clearly meets these threshold requirements (See Petition to Cancel ¶¶ 16-17.)

Petitioner's Descriptiveness Claim is Proper.

Registrant has stated that Petitioner has ignored the fact that Petitioner's BECK'S mark is incontestable. The mark at issue is not BECK'S but rather BECK'S SAPPHIRE. Furthermore, the relevance of the status of a portion of Registrant's BECK'S SAPPHIRE mark is a fact question and subject to evidentiary requirement--not a question of sufficient pleading. As alluded to earlier, any attempts by Registrant to add extrinsic matter to this proceeding via a Motion to Dismiss is improper.

Oddly, Registrant has stated that Petitioner has “improperly” dissected its mark--yet Registrant seeks to do exactly that by calling out the BECK/BECK’S portion of its trademark as a separable part, entitled to special consideration.

This Board has previously held on a Motion to Dismiss that “just as the registration of a mark may be opposed (or cancelled, if the registration is less than five years old) on the Section 2(e)(1) ground that the entire mark, when applied to the goods or services of the applicant (or registrant), is merely descriptive of them, so too it may be on the ground that an undisclaimed portion of the mark is merely descriptive of the applicant's goods or services (and that the mark should not be registered without a disclaimer of that portion).” *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990) citing to *Textron Inc. v. Pilling Chain Co., Inc.*, 175 USPQ 621 (TTAB 1972), and *Bell v. B-I-W Group Inc.*, 174 USPQ 254 (TTAB 1972). See also *Golomb v. Wadsworth*, 592 F.2d. 1184, 201 USPQ 200 (CCPA 1979), and *C. R. Bard, Inc. v. Foley Bag Catheter, Inc.*, 394 F.2d 582, 157 USPQ 579 (CCPA 1968). As pled by Petitioner, the mark that is the subject of the present proceeding is merely a combination of *solely* non-distinctive elements (i.e., a surname and a descriptive or generic term) and therefore, registration of the same is improper. Petitioner’s assertions and allegations in this regard are clear and sufficient.

Registrant Has Not Sought to Dismiss Petitioner’s Allegations Related to Likelihood of Confusion.

While Registrant has filed a Motion to Dismiss Petitioner’s claims related to dilution and descriptiveness, Petitioner’s allegation of likelihood of confusion remains unanswered by Registrant.

WHEREFORE, Petitioner requests that Registrant's MOTION TO DISMISS be found to be baseless and Registrant thereby be found in default for failure to timely answer Petitioner's Petition to Cancel.

Respectfully submitted,

Bacardi & Company Limited



Date: May 21, 2013

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CERTIFICATE OF SERVICE

On this 21st day of May 2013, a true and correct copy of the foregoing PETITIONER'S RESPONSE TO REGISTRANT'S MOTION TO DISMISS is being sent via first class mail, postage prepaid and addressed as follows:

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