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

Proceeding	92066154
Party	Plaintiff The Brooklyn Brewery Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

THE BROOKLYN BREWERY
CORPORATION,

Petitioner,

v.

THE VILLAGE VOICE, LLC

Registrant.

Cancellation No. 92066154

Mark: BROOKLYN POUR

Registration No. 4,388,012

**BROOKLYN BREWERY CORPORATION'S PARTIAL OPPOSITION TO
REGISTRANT/COUNTERCLAIMANT'S MOTION TO AMEND**

Petitioner/Counterdefendant The Brooklyn Brewery Corporation (“Petitioner”) partially opposes Registrant/Counterclaimant’s (“Registrant”) Motion to Amend its Counterclaims. Specifically, Petitioner opposes the addition of Counterclaims B (non-use) and C (fraud on the PTO) in Registrant’s Proposed Amended Complaint, because they are legally deficient. Furthermore, because this was Registrant’s second attempt to plead these claims, Registrant should be denied any further attempts to amend.

I. PROCEDURAL HISTORY

On May 15, 2017, Petitioner filed a petition to cancel Registrant’s mark BROOKLYN POUR based on prior use and a likelihood of confusion with Petitioner’s marks, including the mark BROOKLYN for beer. (Dkt. 1.) On June 29, 2017, Registrant filed its answer and counterclaims. (Dkt. 4.) In its counterclaims, Registrant sought to cancel Petitioner’s registration for BROOKLYN because it is allegedly a “phantom registration,” and a “mutilation of [] other trademarks” and the specimens accompanying the application did not match the mark in the application drawing. (*Id.* at ¶¶ 6-9.) Registrant’s argument boiled down to an allegation

that because Registrant's BROOKLYN mark was displayed with other words, including in the specimens, the Examining Attorney erred in permitting the mark to register. (*See id.*)

Petitioner filed a motion to dismiss Registrant's counterclaims. (Dkt. 6.) Petitioner argued that "[a]n examining attorney's decisions on examination requirements . . . are not statutory grounds for refusing registration. Therefore, any error by the examining attorney on those matters cannot form the basis of an *inter partes* challenge to the registrability of the mark." (*Id.* (citing 3 *Gilson on Trademarks* § 9.03[2][j] at 9-141)). Petitioner also explained that the BROOKLYN mark is a "house mark" that "conveys a distinct commercial impression" and thus "can be registered alone and apart from any other product marks with which they may appear." (*Id.* at 5 (citing *in Re Servel, Inc.*, 181 F.2d 192, 195-96 (C.C.P.A. 1950); TMEP § 807.12(d)).

Rather than defend its counterclaims, Registrant filed a motion to amend its Answer in order to assert new counterclaims. (Dkt. 10.) As shown below, Registrant's proposed amended counterclaims B (non-use) and C (fraud on the PTO) are legally deficient and thus Registrant's motion for leave to amend should be denied with prejudice to the extent that Registrant seeks to assert those two counterclaims.

II. ARGUMENT

"Where the moving party seeks to add a new claim, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend." *Fair Isaac Corp. v. Consumerinfo.com, Inc.*, 91178303, 2010 WL 9597363, *1 (TTAB June 30, 2010) (citing *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937 (Fed. Cir. 1990)). The Board applies the same test to determine futility as it does in deciding a motion to dismiss under Federal Rule of Civil Procedure 12(b)(6). *See Humanetics Corp. v. Neways, Inc.*, 123,123, 2003 WL 22022072, at *3 (TTAB Aug. 21, 2003) (denying motion to amend as futile because proposed claim would not withstand a motion to dismiss).

Here, permitting Registrant to amend its counterclaims in order to add Counterclaims B (non-use) and C (fraud on the PTO) would serve no useful purpose, because those two counterclaims are deficient as a matter of law.

A. Counterclaim B for Non-Use Fails as a Matter of Law

To survive Petitioner’s challenge, Registrant’s proposed counterclaims “must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements” are insufficient to survive a motion to dismiss. *Id.* at 677.

Registrant’s allegations in support of its non-use counterclaim (Counterclaim B) are “naked assertions devoid of further factual enhancement.” *Id.* Registrant alleges that “the Brewery has never used . . . ‘Brooklyn’ **as a trademark**” and “did not have bona fide use of . . . ‘Brooklyn’ **as a trademark** as early as November 1987, or thereafter.” (Dkt. 10 ¶¶ 21-22 (emphasis added).) These conclusory allegations unsupported by any facts do not satisfy the pleading requirements of Rule 8(a) and do not provide notice to Petitioner of the grounds for Registrant’s counterclaim. *See id.*

Even more critically, Registrant’s non-use allegation is refuted by the specimens accompanying Petitioner’s trademark application. The prosecution file history for Petitioner’s registration for BROOKLYN (Reg. No. 5,216,092) including the specimens is automatically of record and the Board should rely on it in deciding this motion. *See, e.g., Anderson v. Kimberly-Clark Corp.*, 570 Fed. App’x 927, 932 (Fed Cir. 2014) (consideration of materials “integral to the plaintiff’s claims” proper on Rule 12(b)(6) motion). Petitioner submitted specimens of use of

BROOKLYN for beer with its application. *See* Reg. No. 5,216,092 App. File, Nov. 12, 2015 Specimen. Pictures of the specimens are shown below:



The Examining Attorney accepted these specimens as proof of use of BROOKLYN as a trademark for beer.¹ *See* TMEP § 807.12 (Examining Attorney may permit mark to publish only if he or she determines that it “conveyed a separate and distinct commercial impression apart from any other matter with which the mark is or will be used on the specimen.”); *Martha White, Inc. v. Am. Bakeries Co.*, 157 U.S.P.Q (BNA) 215, 217 n.6 (1968) (this is an “ex parte question” that may not be challenged in an *inter partes* proceeding). Petitioner’s specimens of use refute Registrant’s non-use claim as a matter of law. *See, e.g., Fayetteville Investors v. Commercial Builders, Inc.*, 936 F.2d 1462, 1465 (4th Cir. 1991) (“[I]n the event of conflict between the bare allegations of the complaint and any exhibit attached [to the complaint,] . . . the exhibit prevails.”); *2d Circuit Gant v. Wallingford Bd. of Educ.*, 69 F.3d 669, 674 (2d Cir. 1995) (“document that discloses what the complaint alleges it concealed will defeat the allegation of concealment”).

¹ Registrant has not pled that Petitioner does not actually use the specimens in commerce, or only makes token use of these specimens — the only types of non-use allegations that could survive a motion to dismiss in this context. *Nor could* Registrant make these allegations without running afoul of its obligations under Federal Rule of Civil Procedure 11.

Insofar as Registrant contends that the specimens do not show use of BROOKLYN for beer that is not a proper ground for cancellation. *See Yazhong Investing Ltd.*, Can. No. 9205654, 2016 WL 1665339, at *5 (TTAB Apr. 14, 2016) (“To the extent Petitioner’s nonuse claim rests on purported insufficiency of the specimens, this is not a proper ground for cancellation.”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 U.S.P.Q.2d 2034, 2035 (T.T.A.B. 1989) (dismissing opposition premised on alleged inadequacy of specimens).

B. Counterclaim C for Fraud on the PTO Fails as a Matter of Law

Registrant’s fraud counterclaim is premised on the same deficient allegations as its non-use counterclaim. (Dkt. 10 ¶¶ 26-27.) Because Registrant’s allegations fail to satisfy the pleading requirements of Rule 8, they necessarily fail to satisfy the much more stringent requirements for pleading fraud under Rule 9(b). *See Intl. Beauty Exch., Inc. v. K&N Distributors*, Can. No. 9206364, 2017 WL 3718318, at *3 (fraud claim requires allegation of specific facts showing that petitioner “knowingly made a false, material representation in the procurement of, maintenance of, or renewal of a registration with the intent to deceive the U.S. Patent and Trademark Office.”); *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 1010 (CCPA 1981) (“Rule 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud.”).

Registrant pleads that Petitioner has not used the BROOKLYN mark “as a trademark,” but that allegation is refuted by the specimens in the prosecution file history for Petitioner’s registration for BROOKLYN. (Dkt. 10 ¶¶ 26-27.) The Examining Attorney accepted Petitioner’s specimens as proof of use of BROOKLYN for beer “as a trademark” by publishing that mark for opposition and eventually issuing a registration for that mark. *See, e.g.*, TMEP § 807.12; *Martha White*, 157 U.S.P.Q (BNA) at 217 n.6. Registrant’s proposed fraud claim based

on non-use is deficient as a matter of law because it is refuted by the specimens of use attached to Petitioner's trademark application for BROOKLYN.² See *Fayetteville*, 936 F.2d at 1465; *2d Circuit Gant*, 69 F.3d at 674. Further, as a matter of law, Registrant may not challenge the sufficiency of the specimens in this proceeding. See, e.g., *Kbt Direct, Inc. v. Olander*, Can. No. 9206230, 2016 WL 1677321, at *4 (TTAB Mar. 30, 2016) (alleged deficiency of specimens is not a basis for a claim of fraud). Thus, Registrant's proposed fraud counterclaim fails as a matter of law.

CONCLUSION

For the foregoing reasons, Petitioner asks that Registrant's motion to amend be denied with prejudice insofar as it seeks to add counterclaims B and C because this is Registrant's second attempt to plead these counterclaims. See *Dragon Bleu (Sarl) v. Venm, LLC*, 112 U.S.P.Q.2d 1925 n.10 (TTAB Dec. 1, 2014) (denying leave to amend because it would be futile—"This is Applicant's second attempt to plead its counterclaims, and we can perceive no theory by which the recited facts could be plausibly alleged to constitute fraud").

Dated: November 2, 2017

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² As with its non-use claim, Registrant does not plead that Petitioner does not use the specimens in commerce—nor could it do so as that would be patently untrue.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing *Petitioner The Brooklyn Brewery Corporation's Partial Opposition to Motion to Amend* has been served on The Village Voice, LLC by forwarding said copy on November 2, 2017 via email to:

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