

1 Bobby A. Ghajar (SBN 198719)
 HOWREY LLP
 2 550 South Hope Street, Suite 1100
 Los Angeles, California 90071
 3 Telephone: (213) 892-1800
 Facsimile: (213) 892-2300
 4 E-mail: ghajarb@howrey.com

5 Peter E. Moll (*admitted pro hac vice*)
 Alan S. Cooper (*admitted pro hac vice*)
 6 HOWREY LLP
 1299 Pennsylvania Avenue, N.W.
 7 Washington, D.C. 20004
 Telephone: (202) 783-0800
 8 Facsimile: (202) 383-6610

9 Attorneys for Defendant Anheuser-Busch, Inc.

10
 11 IN THE UNITED STATES DISTRICT COURT
 12 FOR THE SOUTHERN DISTRICT OF CALIFORNIA

13 _____)
 14 UNITED BRANDS COMPANY, INC.)
 15 Plaintiff)
 16 v.)
 17 ANHEUSER-BUSCH, INC.)
 18 Defendant)
 19)
 20)
 21)
 22)
 23)
 24)
 25)
 26 _____)

Civil Action No. 3:10-cv-02281- BEN (WMc)
**MEMORANDUM OF POINTS AND
 AUTHORITIES IN SUPPORT OF MOTION
 TO DISMISS PLAINTIFF’S CLAIMS FOR
 FEDERAL TRADEMARK
 INFRINGEMENT, FEDERAL
 TRADEMARK DILUTION, CALIFORNIA
 STATUTORY TRADEMARK DILUTION,
 FEDERAL TRADE DRESS
 INFRINGEMENT, COPYRIGHT
 INFRINGEMENT, CALIFORNIA
 STATUTORY TRADEMARK
 INFRINGEMENT, CALIFORNIA
 STATUTORY UNFAIR COMPETITION,
 COMMON LAW TRADEMARK
 INFRINGEMENT, AND COMMON LAW
 UNFAIR COMPETITION**
 [Fed. R. Civ. P. 12(b)(6)]
 Hearing Date: March 7, 2011
 Time: 10:30am
 Judge: Hon. Roger T. Benitez
 Courtroom No.: 3

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1 **I. INTRODUCTION**

2 Anheuser-Busch, Inc. (“A-B”) sells a line of flavored beverages branded under the TILT®
3 trademark. United Brands Company (“UBC”) has a line of flavored malt beverages that are
4 caffeinated and are sold under the totally dissimilar JOOSE brand. UBC’s original complaint alleged
5 trademark and copyright infringement and unfair competition claims. In response, A-B filed a motion
6 to dismiss the entire Complaint under Fed. R. Civ. P. Rule 12(b)(6). Rather than responding to A-B’s
7 motion, UBC filed its First Amended Complaint (“FAC”), conceding and withdrawing from the
8 original Complaint its first claim for federal trademark infringement under 15 U.S.C. § 1114(1) but
9 pursuing the rest of its original claims.¹ The Court did not issue a substantive ruling on A-B’s original
10 motion and denied it as moot.

11 UBC had clear notice of the flaws in the original Complaint, but did little in its FAC to cure
12 them. As with its original Complaint, UBC’s FAC is fatally flawed.

13 Glaringly, the FAC continues to assert a claim for statutory trademark infringement under
14 Calif. Bus. & Prof. Code § 14245 (Claim VI) even though UBS has not alleged, and cannot allege,
15 ownership of any California state trademark registration, which is a prerequisite to such a claim.

16 UBC’s copyright infringement claim (Count IV) is based on UBC’s ownership of two
17 copyright registrations. Although UBC’s FAC does not attach the designs that are actually covered by
18 the registrations (just as its original Complaint failed to do), A-B has obtained and placed them in the
19 appendix to this motion as Exhibit A. UBC’s attempt to describe, in words, the alleged similarity
20 between its copyright registrations for a depiction of a “dragon,” does not take precedent over an actual
21 comparison of its dragon against A-B’s accused TILT can design. Copyright infringement requires
22 “**substantial similarity**” between the protectable elements of the respective designs, and UBC’s
23
24

25
26 ¹ UBC does not own a federal registration of a trademark that incorporates the “Dragon Design” that
27 is the predicate for its likelihood of confusion allegation. As demonstrated by the elimination of the
28 Section 1114 federal trademark infringement claim, the marks JOOSE and “JOOSE & Design,” are so
fundamentally different from A-B’s mark TILT & Design that there cannot be any likelihood of
confusion or dilution predicated on those marks.

1 copyright for a “JOOSE Design” and the “Joose and Dragon Design” in the copyrights are not
2 “substantially similar” to A-B’s line of TILT® beverage cans.

3 UBC’s federal and state dilution claims (Claims II and V, respectively) require a showing that
4 UBC’s “Dragon Joose” can design is **famous** – that it is “widely recognized by the general consuming
5 public.” UBC added a conclusory allegation in Par. 23 of the FAC that its “DRAGON JOOSE Marks”
6 are famous, but still fails to allege sufficient facts to support this incredible claim.

7 The remainder of UBC’s claims are ostensibly directed towards A-B’s TILT® can design, and
8 the purported similarity between that design and the product design of one of UBC’s JOOSE flavors
9 called “Dragon Joose.” UBC does not own any federal trademark registration for this asserted “trade
10 dress.” The owner of an unregistered trade dress bears the burden of showing that the trade dress is
11 inherently distinctive or has acquired “secondary meaning” through advertising and public recognition.
12 As explained below, UBC’s FAC fails under Rule 12(b)(6) and the Supreme Court’s decision in
13 *Ashcroft v. Iqbal*, 556 U.S. ___, 129 S. Ct. 1937 (2009), because UBC fails to plead facts sufficient to
14 support its conclusory statement that its unregistered “trade dress” is protectable. UBC attempts to, but
15 cannot, bootstrap its sales and success of its **entire** line of JOOSE products to support the recognition
16 of its trade dress in only one of the JOOSE flavor variations. Moreover, although the FAC includes an
17 overly broad and ambiguous definition of the “DRAGON JOOSE Marks” and other conclusory
18 allegations in an effort to bolster various claims, those revised allegations are not sufficient to save the
19 FAC from dismissal. For example, the FAC seeks to create the impression that a “dragon” – a
20 common mythical creature – is UBC’s basic identifying symbol when in actuality it is only *one* of the
21 design elements on a single product within the JOOSE product line that is used with a particular flavor.
22 Similarly, UBC cannot claim exclusive rights in a black and purple color format, a common can size,
23 or the fact that producers of these products are required to display the alcohol content of their products
24 on the can. Thus, its trade dress-related claims fail as a matter of law.

25 UBC’s remaining common law and statutory unfair competition claims are doomed for similar
26 reasons. Accordingly, pursuant to Fed. R. Civ. P. 12(b)(6), the Court should dismiss UBC’s FAC in its
27 entirety for failure to state a claim. Dismissal should be with prejudice because UBC has already had
28 the opportunity to cure its Complaint, and the foregoing deficiencies cannot be cured.

1 **II. FACTUAL ALLEGATIONS IN THE FIRST AMENDED COMPLAINT**

2 UBC alleges that it sells various flavored alcoholic malt beverages under the brand name
3 JOOSE. (FAC at ¶¶ 1 and 10.) UBC also alleges that it gives each of its flavors in the JOOSE line of
4 beverages different names, one of which is “Dragon Joose”, the subject of UBC’s FAC. (*Id.* at ¶¶ 1
5 and 29.) A number of UBC’s JOOSE flavors have a representative creature or other design (*e.g.*
6 panther (Panther Joose), snake (Mamba Joose), apple design (Green Apple Flavor)). (*See* UBC’s
7 website <www.drinkjoose.com/miva/merchant.mvc>.² UBC displays eight of the flavors in its JOOSE
8 line on its product website at <www.drinkjoose.com> as depicted below:



21 UBC alleges that it has sold its JOOSE line of beverages since 2006, and the Dragon JOOSE
22 flavor as a part of that line since 2007. (FAC at ¶ 10.)

23 A-B began marketing various fruit-flavored alcoholic malt beverages under the brand name
24 TILT in 2005. (FAC at ¶ 26.) A-B refers to each of the flavors in each TILT line by the brand name
25

26 ² A-B requests that the Court take judicial notice of the depictions of UBC’s other can designs on its
27 website and a distributor’s website. *See Mack v. South Bay Beer Distributors*, 798 F.2d 1279, 1282
28 (9th Cir. 1986) (on a motion to dismiss “court may properly look beyond the complaint to matters of public record”).

1 and color, e.g. TILT Green. See <www.anheuser-busch.com/brandPages/tilt.html>.³ Recently, A-B
2 re-designed the can in which it sells its TILT beverages. (*Id.* at ¶ 28.) Each of A-B’s TILT product
3 cans shown below now feature a different color – red, blue, green or purple – (which designate the
4 beverage’s flavor (e.g. green is lemon-lime flavored and red is cherry). These colors are blended with a
5 mottled black background. (*Id.*)



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17 A-B’s TILT can prominently features the trademark TILT in large lowercase letters displayed
18 horizontally beneath two dragons, one on each side of a large stylized letter “T” imprinted on a shield.
19 None of UBC’s JOOSE cans, including its “Dragon Joose” flavor, contain any corresponding element.
20 UBC’s “Dragon Joose” beverage can uses an entirely black background with purple design elements.
21 (*Id.* at ¶ 1.) A-B’s TILT can features two highly stylized dragons holding a crown. (*Id.* at ¶ 27.)
22 UBC’s “Dragon Joose” can features a dragon surrounding the JOOSE brand name, which is aligned on
23 the can in vertical print in stylized, white capital letters. (*Id.* at ¶ 1.) From a visual standpoint, the word
24

25
26
27 ³ A-B also requests the Court to take judicial notice of the name of its products in the TILT line as
28 shown on its website as a matter of public record. *Id.*

1 JOOSE is by far the prominent feature on the can. As shown in Par. 29 of the FAC, the designs that
2 surround the word “JOOSE” on UBC’s cans – including the purple dragon – are difficult to perceive.

3 A-B’s and UBC’s respective TILT and JOOSE cans both display their alcoholic content as well
4 as a brief description of the beverage, as is common with respect to many alcoholic beverage products.
5 See <http://www.anheuser-busch.com/beerVerified.html>.⁴ See also Cal. Bus. & Prof. Code § 25204(a);
6 27 C.F.R. § 7.71(a) (outlining requirement to identify alcohol content).
7

8 UBC asserts a variety of alleged intellectual property rights in its FAC. With regard to
9 trademark rights, UBC owns federal trademark registrations only of the word JOOSE in standard
10 characters and the word JOOSE in stylized letters surrounded by some ornamentation, shown directly
11 below. (FAC at ¶ 16.)

12
13 JOOSE

14
15 (word mark)



16
17 (JOOSE & Design)

18 The FAC deletes an allegation that UBC owns a pending federal Application Serial No.
19 85/139,185 for the “Dragon Design” mark (asserted in ¶ 16 of the original Complaint). That
20 unregistered mark has been refused registration by the U.S. Patent and Trademark Office (“USPTO”).
21 The USPTO found that consumers would not perceive the Dragon Design “as an independent element
22 with a separate and distinct commercial impression to indicate the source of the goods.” In other
23 words, the USPTO found that the Dragon element of the “Dragon Joose” can does not function as a
24 trademark.⁵

25
26 ⁴ A-B requests the Court to take judicial notice of the alcoholic content displayed on its various
alcoholic beverages as shown on its website as a matter of public record. See *Mack*, 798 F.2d at 1282.

27 ⁵ A-B requests the Court to take judicial notice of the public record consisting of the communication
28 from the Examining Attorney in the U.S. Patent and Trademark Office, dated January 12, 2011 in
Application Serial No. 85/139,185 which contains this and other objections to registration of the
(Continued...)

1 The FAC does not plead that UBC owns an issued, subsisting federal or California state
2 registration for any Dragon Design trademark. (*See id.* at ¶¶ 16 and 17.) UBC does not own or plead
3 ownership of a federal or California state trademark registration for its asserted can design or trade
4 dress packaging.

5 UBC’s copyright infringement claim (Claim IV) is grounded upon two copyright registrations
6 that it obtained on September 27, 2010, copies of which are now attached to the FAC as Exhibits A
7 and B. (*Id.* at ¶ 14.) Those registrations are limited to a depiction of its dragon design alone and its
8 dragon with JOOSE in stylized letters, as follows:
9



22 The FAC does not allege any facts regarding specific sales figures or advertising figures for its
23 “Dragon Joose” product. Rather, the only sales figures relate to the entire line of JOOSE products.
24 (*Id.*, at ¶ 20.) Additionally, UBC alleges that it has spent substantial dollars in promoting its JOOSE
25

26 (...Continued)

27 Dragon Design mark. A true copy of the January 12, 2011 office action is annexed hereto as Exhibit
28 B.

1 *line* of beverages, but does not indicate what portion of the alleged substantial investment is for the
2 “Dragon Joose” product. (*Id.* at ¶ 20.) Further, UBC only alleges that the “Dragon JOOSE Marks” are
3 prominently featured “in advertisements and promotions,” but does not allege any facts relating to any
4 reference or highlighting of any of the alleged elements of the Dragon Joose trade dress in such
5 advertisements, or indicate the number or reach of such advertisements. (*See id.* at ¶ 20.)

6
7 **III. ARGUMENT**

8 A. STANDARDS APPLICABLE TO RULE 12(b)(6) MOTION TO DISMISS FOR
9 FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

10 Rule 12(b)(6) authorizes this Court to dismiss a cause of action that fails to state a claim upon
11 which relief can be granted. Dismissal of a claim is proper if the complaint fails to allege an element
12 which is necessary to the relief sought. *Moore’s Federal Practice* § 12.34[4][a]; *see also Bruns v.*
13 *NCUA*, 122 F.3d 1251, 1257 (9th Cir. 1997) (liberal interpretation of a complaint “may not supply
14 essential elements of the claim that were not initially pled”).

15 For purposes of this motion, the Court must accept all well-plead factual allegations of the FAC
16 as true and construe them in favor of the non-moving party. *North Star Int’l v. Arizona Corp.*
17 *Comm’n.*, 720 F.2d 578, 580 (9th Cir. 1983) (declining to consider hypothetical situation and issues
18 without foundation in complaint). However, “conclusory allegations of law and unwarranted
19 inferences are insufficient to defeat a motion to dismiss for failure to state a claim.” *Anderson v. Clow*
20 (*In re Stac Elecs. Sec. Litig.*), 89 F.3d 1399, 1403 (9th Cir. 1996).

22 A dismissal under Rule 12(b)(6) can be based on either the lack of cognizable legal theory or
23 the lack of sufficient facts alleged under a cognizable legal claim. *SmileCare Dental Group v. Delta*
24 *Dental Plan*, 88 F.3d 780, 783 (9th Cir. 1996). A complaint must contain “factual content that allows
25 the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.”
26 *Ashcroft v. Iqbal*, 129 S.Ct. at 1949. “Where a complaint pleads facts that are ‘merely consistent with’
27 a defendant’s liability, it ‘stops short of the line between possibility and plausibility of entitlement to
28

1 relief.” *Id.* In this respect, “[a] plaintiff’s obligation to provide the ‘grounds’ of his ‘entitlement to
2 relief’ requires more than labels and conclusions, and a formulaic recitation of the elements of a cause
3 of action will not do.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). The Court need not
4 accept as true allegations that are conclusory, unwarranted deductions of fact, or unreasonable
5 inferences. *Sprewell v. Golden State Warriors*, 266 F.3d 979, 988 (9th Cir. 2001). “Threadbare
6 recitals of the elements of a cause of action, supported by mere conclusory statements” will not suffice.
7 *Iqbal*, 129 S. Ct. at 1949; *see also North Star Int’l*, 720 F.2d at 583 (dismissing complaint found to be
8 “vague, conclusory, and general” which did “not set forth any material facts in support of the
9 allegations”).

11 Dismissal should be with prejudice and without leave to amend where any amendment would
12 prove futile. *Partington v. Bugliosi*, 56 F.3d 1147, 1162 (9th Cir. 1995) (denying motion to amend as
13 futile “[b]ecause it is clear that the deficiency in [the] complaint could not have been overcome by
14 amendment); *see, e.g., Campbell v. Walt Disney Co.*, 718 F. Supp.2d 1108 (C.D. Cal. 2010) (for a
15 copyright infringement claim, lack of substantial similarity cannot be cured by amendment).
16

17 B. PLAINTIFF FAILS TO STATE CLAIMS FOR TRADE DRESS INFRINGEMENT
18 AND FALSE DESIGNATION OF ORIGIN UNDER 15 U.S.C. § 1125(a) (CLAIM I)

19 In order to state a claim for trade dress infringement under § 43(a) of the Federal Trademark
20 Act, 15 U.S.C. § 1125(a), UBC must demonstrate that its asserted trade dress: (1) is nonfunctional; (2)
21 is either inherently distinctive or has acquired a secondary meaning; and (3) is likely to be confused
22 with the design of A-B’s TILT product by members of the consuming public. *One Industrials, LLC v.*
23 *Jim O’Neal Distributing*, 578 F.3d 1154, 1166 (9th Cir. 2009). Just as the claim for federal trademark
24 infringement in UBC’s original Complaint was fatally flawed due to the dissimilarity of the marks, the
25 amended trade dress infringement claim fails to state a claim because the elements comprising UBC’s
26 alleged trade dress are common features of similar product packaging and do not counter the
27

1 fundamental dissimilarity between the word marks JOOSE and TILT which are the principal
2 commercial identities that the public would rely on in identifying the source of the products in issue.

3 In Par. 12 (repeated in Par. 54) of the FAC, UBC provides a list of purportedly non-functional
4 elements of its “trade dress.” The first six elements principally relate to UBC’s use of the mark
5 “JOOSE,” which A-B does not use. As to the third element, (c), “the prominent use of a one-syllable
6 word mark,” not only is that a common element for beverage products, but as UBC’s FAC
7 acknowledges, A-B has been using the TILT® word mark long before UBC even created the JOOSE
8 product. Par. 54 also alleges that the following largely commonplace elements result in a distinctive
9 trade dress: a “prominent stylized graphic of a dragon”; the mark JOOSE in large white letters in a
10 stylized, archaic font; the prominent use of a one-syllable work mark (*i.e.*, JOOSE); the mark JOOSE
11 is surrounded by a “shield” design; the mark DRAGON JOOSE is displayed beneath the design
12 elements as the bottom of the can; the use of a 24 ounce can; the use of a “zig-zag” line surrounding
13 the alcohol content volume at the top portion of the can; and the display of the alcoholic volume within
14 a small badge or banner beneath the mark JOOSE.⁶ UBC’s original Complaint alleged that UBC uses
15 a dark background with colored elements; the FAC now alleges that the Dragon Joose product uses a
16 “distinctive purple and black color scheme.”⁷

17
18
19 However, a simple comparison of UBC’s and A-B’s cans for their respective products in their
20 entireties reveals that a substantial portion of the packaging elements UBC alleges as similarities are
21 either not in fact similar or consist of commonplace or functional elements for beverage cans that
22

23 _____
24 ⁶ There is a serious question as to whether UBC has the rights in the trade dress it is claiming. The
25 owners of “Four Loko,” one of UBC’s JOOSE competitors, has sent UBC a cease and desist letter
26 alleging that the JOOSE beverage infringes the Four Loko trade dress, in response to which UBC filed
27 a declaratory judgment and infringement action in this Court, *see* ECF No. 1, Case No. CV-0048 WQH
28 (BGS) (filed 1-10-11).

⁷ The Court will also note that UBC’s FAC includes a depiction of a portion of UBC’s line of
JOOSE products, only one of which has a “purple and black color scheme.” Likewise, only one of A-
B’s flavors (grape) uses the color purple.

1 cannot form the basis for a trade dress claim. Functional or commonplace elements that UBC attempts
2 to assert rights in include white lettering (FAC ¶ 54.b), centering the name of the product on a can
3 (FAC ¶ 54.e), displaying the alcohol volume content (as required by law), and offering product in a 24
4 ounce can.⁸ (FAC at ¶¶ 54.f-h.) Significantly, however, the respective dragon designs, fonts and
5 overall can design used by each party are different. *See Toho Co. Ltd. v. Sears, Roebuck & Co.*, 645
6 F.2d 788, 790 (9th Cir.1981) (affirming 12(b)(6) dismissal of § 1125(a) claim based on no likelihood
7 of confusion where parties used different representations of a creature). Although UBC now asserts
8 that it uses a “shield” design⁹, the stylization around the JOOSE design is not readily discernable as a
9 “shield” and in any case is fundamentally different from the shield design that surrounds the mark
10 TILT on A-B’s product.
11

12 The FAC essentially alleges that UBC’s “inherently distinctive” trade dress consists of the 24
13 oz. can referred to in Par. 54.f., and the visual elements described in Paras. 54.a.-54.e. and 54.g.-54.i.
14 that are displayed on that product can. The Supreme Court has held that trade dress is either product
15 design or product packaging, and if a trade dress is product design it can never be inherently
16 distinctive. *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 214-15 (2000). In this case, the
17 **product design’s** visual elements are an integral part of, and are physically “inseparable” from the
18 product design (*i.e.*, the 24 oz. can); thus, UBC must allege and prove secondary meaning in
19 connection with its asserting a § 43(a) trade dress infringement claim. *See Continental Laboratory*
20
21

22 ⁸ “The two trade dresses are similar in overall appearance only to the extent that they both feature
23 “aggressive” graphics and bold accent colors against dark backgrounds. However, these elements are
24 widely employed in the crowded energy drink market and are therefore unlikely to lead to confusion as
25 to source.” *Hansen Beverage Co., v. National Beverage Corp.*, 493 F.3d 1074, 1079 (9th Cir. 2007)
26 *vacated by, appeal dismissed by* 499 F.3d 923 (9th Cir., Aug. 17, 2007). Although the Ninth Circuit
27 vacated its opinion in *Hansen* due to the mootness of the dispute because the parties settled before the
28 opinion issued, the Ninth Circuit’s finding about beverage can’s color scheme is still persuasive.

⁹ Interestingly, in ¶ 12.d. of the original Complaint, UBC alleged that the mark JOOSE is surrounded
by a “crown” design. The only logical explanation of how a “crown” became a “shield” is UBC’s
belated recognition that the mark TILT on A-B’s product is displayed in a background design that
could be described as a “shield.” UBC’s confusion argument is moving target.

1 *Products, Inc. v. Medax International, Inc.*, 114 F. Supp.2d 992, 999 (S.D. Cal. 2000). UBC’s claim of
2 protectable trade dress rights is fundamentally deficient as a matter of law because UBC has not
3 alleged secondary meaning for such product design trade dress, and cannot do so given the common
4 use of both that size can and the common use of the elements in UBC’s claimed trade dress by others
5 in the beverage industry.
6

7 To the extent that UBC alleges its trade dress consists of “product packaging,” the trade dress
8 infringement claim fails because the FAC does not allege facts showing that consumers recognize the
9 “Dragon Joose” packaging – separate and apart from the trademark JOOSE – as an indication of
10 source. *See Wal-Mart Stores*, 529 U.S. at 214-15 (“where it is not reasonable to assume consumer
11 predisposition to take...packaging as indication of source ... inherent distinctiveness will not be
12 found”).¹⁰
13

14 As shown on page 3 above, the “Dragon Joose” beverage, which is the only UBC product that
15 bears the asserted trade dress, is one of at least 8 beverage designs used by UBC to sell its JOOSE malt
16 beverage products. There is no consistency between these beverage can designs from which one could
17 conclude that the “Dragon Joose” can design serves as a source identifier for the entire JOOSE line of
18 products. Rather, it is the prominently placed word marks JOOSE and TILT that serve as the source
19 identification for the parties’ respective products and the differences in these visually dominant word
20 marks preclude any confusion.¹¹ *See Trovan Ltd. v. Pfizer, Inc.*, 107 Fed. Appx. 788, 790 (9th Cir.
21

22
23 ¹⁰ As noted above, the U.S. Patent and Trademark Office reached the same conclusion in refusing
24 registration of UBC’s pending federal application to register the Dragon Design trademark. *See*
25 Exhibit B.

26 ¹¹ *See Hansen Beverage*, 493 F.3d at 1079 (“The appearance of the competing trade dress speaks for
27 itself. Monster products are distinguishable from the other energy drinks on the market largely because
28 the word ‘Monster’ and a large ‘M’ are prominently displayed on the cans. Freek's trade dress does
not feature either of these source-identifying marks; instead, it displays prominently its own trade
name (‘Freek’) along with a distinctive depiction of a distorted and frightening face (the so-called
‘Freek Man’). These very significant differences weigh heavily against a finding that consumer
confusion is likely to result from the overall look of the packaging.”)

1 2004) (unpublished) (similarity reduced where defendant used its house mark in conjunction with the
2 sale of its product); *Aurora World, Inc. v. TY Inc.*, 2009 U.S. Dist. LEXIS 129128 (C.D. Cal. Dec. 15,
3 2009) (“presence of such a prominent tag bearing Ty's logo negates a claim of confusion”).

4 The same flaws in UBC’s claim for trade dress infringement also preclude a finding that A-B
5 has used any false designation of origin.

6
7 C. PLAINTIFF FAILS TO STATE CLAIMS OF “TRADEMARK INFRINGEMENT”
8 UNDER 15 U.S.C. § 1125(a) (CLAIM II)

9 UBC has withdrawn the fundamentally flawed claim asserted in the original Complaint for
10 trademark infringement under § 32(1) of the Federal Trademark Act, 15 U.S.C. § 1114(1). However,
11 the second claim for relief asserted in the FAC, Paras. 62-68, seeks to re-cast its trademark
12 infringement claim as arising under § 43(a) of the Federal Trademark Act, 15 U.S.C. § 1125(a). That
13 allegation is essentially redundant because the first claim for relief in the FAC, Paras. 53-61, alleges
14 that A-B is using a false designation of origin which is expressly contemplated by § 43(a)(1)(A) and
15 the eighth claim in the FAC, Paras. 122-128, alleges a claim for common law trademark infringement.
16 The present motion addresses the flaws in UBC’s false designation of origin and common law
17 trademark infringement claims and need not be repeated here.

18
19 D. PLAINTIFF FAILS TO STATE A CLAIM FOR FEDERAL TRADEMARK
20 DILUTION (CLAIM III)

21 UBC’s claim for trademark dilution under § 43(c) of the Federal Trademark Act, 15 U.S.C.
22 §1125(c), as alleged in Paras. 76 and 77 of the FAC, is that UBC’s DRAGON JOOSE Marks are likely
23 to be diluted and tarnished by A-B’s “unauthorized commercial use of the DRAGON JOOSE Marks in
24 connection with the advertisement, offering for sale and/or sale of Defendant’s Products. . . .”

25 The “DRAGON JOOSE Marks” are defined in Par. 18 of the FAC as consisting of the
26 DRAGON JUICE Trade Dress, the Dragon Design mark, the State Dragon Joose Marks, and the
27 JOOSE Marks. Given UBC’s definition of DRAGON JOOSE Marks, it is difficult to comprehend the
28

1 § 43(c) dilution claim as pleaded in Paras. 76 and 77 of the FAC because A-B simply is not using any
2 of the DRAGON JOOSE Marks. However, assuming *arguendo* that UBC’s § 43(c) dilution claim is
3 directed to A-B’s marketing and sale of the TILT & Design product shown in Par. 27 of the FAC, it
4 still fails to state a claim upon which relief can be granted for the reasons stated below.

5
6 1. UBC’s § 43(c) Dilution Claim Fails to Allege Sufficient Facts to
7 Establish that the DRAGON JOOSE Marks Are Famous within the
8 Meaning of § 43(c)(2)(A)

9 A dilution claim under § 43(c) can only be brought to protect a trademark or trade dress which
10 has become “**famous.**” Section 43(c)(2)(A) defines a famous mark for dilution purposes as one that
11 “is widely recognized by the general consuming public of the United States as a designation of source
12 of the goods or services of the mark’s owner.” Examples of famous marks include COCA-COLA,
13 INTEL, KODAK and BUDWEISER. Thus, dilution is “reserved for a select class of marks -- those
14 marks with such powerful consumer associations that even non-competing uses can impinge their
15 value.” *Thane International, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 907 (9th Cir. 2002) (no dilution
16 where plaintiff had not even made minimal showing of the required level of fame among the general
17 consuming public, as opposed to simply among bicycle enthusiasts); *Avery Dennison Corp. v.*
18 *Sumpton*, 189 F.3d 868, 875 (9th Cir. 1999) (“to meet the ‘famousness’ element of protection under the
19 dilution statutes, a mark must be truly prominent and renowned”); *Planet Coffee Roasters, Inc. v. Dam*,
20 2009 U.S. Dist. LEXIS 70775, *8-*9 (C.D. Cal. Aug. 12, 2009) (“[d]ilution protection extends only to
21 those whose mark is a ‘household name.’”)

22
23 Par. 71 of the FAC pleads in conclusory fashion that the “DRAGON JOOSE Marks are
24 famous” and achieved that elevated status prior to A-B’s use of the new TILT can in 2010. The broad
25 definition of “DRAGON JOOSE Marks” includes marks such as “JOOSE” that are not at issue in this
26 case. Moreover, the FAC does not allege sufficient facts to establish that the “DRAGON JOOSE
27
28

1 Marks” are famous within the meaning of § 43(c)(2)(A), namely, that such Marks are “widely
2 recognized by the general consuming public in the United States.”

3 UBC’s § 43(c) dilution claim is based solely on its DRAGON JOOSE product which, as shown
4 by Paras. 10, 11 and 29 of the FAC, is only a *single* flavor in UBC’s line of alcoholic beverages. (FAC
5 at ¶¶ 10, 15.)¹² The JOOSE line of beverages only recently came into existence in 2006, and the
6 “Dragon Joose” flavor was not launched until 2007 (*Id.*, ¶ 10.) – a claim that is odds with UBC’s
7 allegation in a recently-filed complaint in this Court.¹³ Regardless, the limited time in which UBC has
8 sold its “Dragon Joose” flavor is insufficient to make the design of the can “truly prominent and
9 renowned” or a “household name.” *See Avery Dennison Corp.*, 189 F.3d at 875; *Planet Coffee*
10 *Roasters, supra*, 2009 U.S. Dist. LEXIS 70775, *8-*9.

11
12 Moreover, the sales figures pleaded in Par. 20 of the FAC relate to UBC’s *entire line* of JOOSE
13 flavored malt beverages (of which there are many) and are not limited to the “Dragon Joose” flavor.
14 Accordingly, it is not possible even to draw an inference, much less make a clear determination, as to
15 what percentage of the alleged \$160,000,000 sales is comprised of the “Dragon Joose” component of
16 the JOOSE product line.

17
18 The FAC apparently attempts to remedy this situation in several ways. First, Par. 70 alleges
19 that the “Dragon Joose” component is the “most popular and recognized” of UBC’s line of JOOSE
20 products and that, since its launch in 2007, the “Dragon Joose” component “has comprised a
21 significant percentage of sales of all of the JOOSE line of products.” However, there is no
22

23
24
25 _____
26 ¹² The only “JOOSE” can that displays the Dragon Design is the DRAGON JOOSE flavor. (FAC at ¶
27 29.)

28 ¹³ As noted in footnote 6, UBC has filed a trademark infringement complaint in this Court against
another beverage manufacturer. Contrary to its allegations here, in that complaint, it alleges that it
launched the “Dragon Joose” flavor “in mid-2008.” *See* ECF No. 1, 11-CV-00048-WGH at ¶8.

1 specification of what that “significant” percentage is and no way to determine any dollar amount of
2 such sales and over specific period of time.

3 Second, UBC includes the new allegation in Par. 72 that the DRAGON JOOSE Marks have
4 appeared in several on-line and print magazines and newspapers. Apart from the ambiguity of the
5 DRAGON JOOSE Marks definition, as explained above, UBC provides no information regarding
6 which magazines and newspapers the DRAGON JOOSE Marks have appeared in, much less their
7 circulation, and there is no information with respect to how many hits any online magazine in which
8 the “DRAGON JOOSE Marks” appeared received over any time period. Accordingly, the new
9 allegations in Par. 72 are insufficient to support the conclusion that the DRAGON JOOSE Marks (let
10 alone the DRAGON JOOSE trade dress itself) are “widely recognized by the general consuming public
11 of the United States as a designation of source of the goods or services of the mark’s owner.” §
12 43(c)(2)(A).
13

14
15 Third, Par. 73 of the FAC alleges that its products sold under the “DRAGON JOOSE Marks”
16 are advertised and sold in 47 states, but provides no specification of the amount of sales or advertising
17 expenditures in those states that were directed to the DRAGON JOOSE products as distinguished from
18 the entire JOOSE product line.

19 Finally, in new Par. 75 of the FAC, UBC alleges that it owns (federal) registrations of its
20 JOOSE and JOOSE & Design marks. It is true that one of the elements to be considered in
21 determining whether a mark is famous in a dilution context is whether the mark is registered. *See* §
22 43(c)(2)(A)(iv). However, the registered marks in this context are JOOSE and JOOSE & Design –
23 **neither of which** include the Dragon Design element. The fundamental differences between the
24 trademarks JOOSE and JOOSE & Design and A-B’s trademark TILT is the obvious reason why the
25 FAC eliminated the § 1114 federal infringement claim pleaded in the original Complaint (which was
26 based solely on the federal registrations of JOOSE and JOOSE & Design). The uncontested fact that
27
28

1 UBC does not own any federally registered trademark that includes the Dragon Design weighs heavily
2 in favor of a finding that the plaintiff’s mark is not famous in a § 43(c) dilution context. *See, Network*
3 *Automation, Inc. v. Hewlett-Packard Co.*, 2009 U.S. Dist. LEXIS 125835, *34 (C.D. Cal. Sept. 14,
4 2009) (granting summary judgment dismissing dilution claim).

5
6 In sum, there is no reasonable factual predicate for the conclusory allegation in Par. 74 of the
7 FAC that “[p]roducts sold under its DRAGON JOOSE Marks are recognized by the consuming public
8 on a nationwide basis as originating from one source.” As explained, UBC cannot save itself through a
9 creative definition of “DRAGON JOOSE Marks,” which includes more than just the alleged trade
10 dress. Even so, UBC does not and cannot allege that the DRAGON JOOSE *packaging* is “widely
11 recognized by the *general* consuming public.” Merely paraphrasing the definition of fame set forth in
12 §43(c)(2)(A), without any alleged factual foundation, is not legally sufficient to state a claim for relief
13 under § 43(c). *See Planet Coffee Roasters, Inc. v. Dam*, 2009 U.S. Dist. LEXIS 70775 at *9 (finding
14 that “Plaintiff has not alleged facts sufficient to show that its mark is nationally famous.”)
15

16 2. The Fundamental Differences Between UBC’s Federally Registered
17 Marks JOOSE and JOOSE & Design and A-B’s Mark TILT & Design
18 Precludes a Viable Claim for Trademark Dilution under § 43(c) of the
19 Federal Trademark Act Based on UBC’S Registered Marks

20 To the extent that the § 43(c) dilution claim pleaded by UBC is based on the pleaded federal
21 registrations of the trademarks JOOSE and JOOSE & Design identified in Par. 16 of the FAC, it fails
22 to state a claim upon which relief can be granted because the trademarks JOOSE and JOOSE & Design
23 are not identical or nearly identical to A-B’s mark TILT & Design, which is the established high
24 degree of similarity required for a dilution claim. *See Playboy Enterprises, Inc. v. Welles*, 279 F.3d
25 796, 806 (9th Cir. 2002) (“PMOY” could not as a matter of law dilute “Playmate of the Year” because
26 terms were “not identical or nearly identical”); *Thane Intern.*, 305 F.3d at 905-06 (finding that test for
27 similarity is more stringent than in infringement context); *Visa International Service Assoc. v. JSL*
28 *Corp.*, 610 F.3d 1088, 1090 (9th Cir. 2010) (granting summary judgment on a dilution claim because

1 the marks were “effectively identical”); *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 2009
2 U.S. Dist. LEXIS 50542, *19 (N.D. Cal. June 1, 2009) (Ninth Circuit “continues to recognize the
3 ‘identical or nearly identical’ requirement” for dilution under the Trademark Dilution Revision Act of
4 2006) (citation omitted); *Planet Coffee Roasters*, 2009 U.S. Dist. LEXIS 70775 at *8-*9; *see also, EA*
5 *Entertainment Television, Inc. v. Entertainment One GP Ltd.*, 363 Fed. Appx. 510 (9th Cir. 2010)
6 (unpublished) (party claiming dilution “must demonstrate that the marks are ‘identical’ or ‘nearly
7 identical’ so that a ‘significant segment of the target group of customers sees the two marks as
8 essentially the same’”) (citations omitted). The fundamental dissimilarity between these marks
9 precludes any finding of likelihood of dilution, which is a critical prerequisite for liability for dilution
10 under § 43(c).

12 E. PLAINTIFF FAILS TO STATE A CLAIM FOR COPYRIGHT INFRINGEMENT
13 (CLAIM IV)

14 In order to state a cognizable copyright infringement claim, UBC must allege ownership of a
15 valid copyright, and the copying of constituent elements of the work that are original to it. *Feist*
16 *Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991). The copying element requires proof of
17 access to the copyrighted work and a showing that the allegedly infringing work is **substantially**
18 **similar** to the protected elements of the copyrighted work. UBC has alleged ownership of two
19 copyright registrations for what it calls its “Dragon Design,” but the FAC does not attach illustrations
20 of the actual designs that are covered by those copyright registrations. (FAC at ¶14, Exs. A and B)
21 (attaching extracts without the deposit copy of the designs). In the face of A-B’s attacks on UBC’s
22 original complaint, the FAC alleges that “The NEW TILT Design prominently displays a dragon
23 design that surrounds the name of the beverage and comprises the vast majority of the front side of the
24 product can” and “the Dragon Design and Dragon Design with Logo [i.e. the JOOSE mark surrounded
25 by a dragon] Copyrights ... used on UNITED Brands’ DRAGON JOOSE product cans which also
26 prominently feature a dragon design that surrounds the name of the beverage, comprising the vast
27
28

1 majority of the front side of the product can.” (FAC at ¶ 81.) UBC concludes that “the NEW TILT
2 Design looks substantially similar to United BRANDS” Dragon Design Copyrights.” (FAC at ¶ 84.)

3 Notwithstanding these allegations, UBC’s copyright claim fails because it cannot prove
4 substantial similarity as a matter of law.¹⁴ The Ninth Circuit has found that “[t]here is ample authority
5 for holding that when the copyrighted work and the alleged infringement are both before the court,
6 capable of examination and comparison, non-infringement can be determined on a motion to dismiss.”
7 *Christiansen v. West Pub Co.*, 149 F.2d 202, 203 (9th Cir. 1945) (affirming 12(b)(6) dismissal of
8 copyright infringement claim where only similarities between maps was the outline of the United
9 States and the manner of grouping, neither of which was original to plaintiff or protectable under
10 copyright law). “To constitute infringement there must be a substantial copy of the whole or of a
11 material part of the copyrighted work.” *Id.* Courts have routinely granted Rule 12(b)(6) motions to
12 dismiss for copyright infringement where, as here, the requisite substantial similarity is not present.
13 *E.g.*, *Campbell*, 718 F. Supp.2d at 1114-1115; *Capcom Co. v. MKR Group, Inc.*, 2008 U.S. Dist. LEXIS
14 83836, *2 (C.D. Cal. Oct. 10, 2008); *Thomas v. Walt Disney Co.*, 2008 U.S. Dist. LEXIS 14643, *17
15 (N.D. Cal. Feb. 14, 2008); *Zella v. E.W. Scripps Co.*, 529 F. Supp. 2d 1124, 1138 (C.D. Cal. Dec. 18,
16 2007); *Identity Arts v. Best Buy Enterprises Services, Inc.*, 2007 U.S. Dist. LEXIS 32060, *82 (N.D.
17 Cal. Apr. 18, 2007); *Lake v. Columbia Broadcasting System, Inc.*, 140 F. Supp. 707, 709 (S.D. Cal.
18 Jan. 5, 1956).

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¹⁴ In order to conduct a substantial similarity analysis, A-B requested and obtained copies of the deposit material from UBC for its asserted copyrights, Registration Nos. VA 1-736-747 and VA 1-737-466 which are attached hereto as Exhibit B. “Documents whose contents are alleged in a complaint and whose authenticity no party questions, but which are not physically attached to the pleading, may be considered in ruling on a Rule 12(b)(6) motion to dismiss” without converting the motion to dismiss into a motion for summary judgment. *Branch v. Tunnell*, 14 F.3d 449, 454 (9th Cir. 1994). Moreover, under Fed. R. Evid. 201, a court may take judicial notice of “matters of public record.” *Mack*, 798 F.2d at 1282. The deposit material for UBC’s copyright registrations are both documents whose contents are alleged in the complaint and matters of public record and thus may be considered on the motion to dismiss.

1 In order to prove copying sufficient to withstand a Rule 12(b)(6) motion to dismiss, UBC must
2 show that A-B's TILT can is substantially similar to protected elements alone of UBC's copyrighted
3 designs; non-protectable ideas or uncopyrightable elements of UBC's design may not be considered.
4 *Cavalier v. Random House, Inc.*, 297 F.3d 815, 822 (9th Cir. 2002). The Ninth Circuit uses the
5 extrinsic test to evaluate substantial similarity which examines specific criteria including "the type of
6 artwork involved, the materials used, the subject matter, and the setting for the subject." *Sid & Marty*
7 *Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) (noting
8 that substantial similarity "may often be decided as a matter of law). "[E]xpressions that are standard,
9 stock, or common to a particular subject matter or medium are not protectable under copyright law."
10 *Satava v. Lowry*, 323 F.3d 805, 810 (9th Cir. 2003). Further, where there is only a narrow range of
11 expression then copyright protection is "thin" and "protects against only virtually identical copying."
12 *See Satava*, 323 F.3d at 810 (finding that realistic depictions of live animals entitled to thin copyright
13 protection).
14
15

16 Therefore, the proper comparison here is not UBC's **written** description of the alleged
17 similarities (FAC ¶¶ 81-82, and 85) but a comparison of UBC's two copyrights (**not** the overall trade
18 dress of its cans) against the entirety of A-B's TILT can. UBC's copyrights cover **only** the dragon
19 design element from its can. UBC's copyright protection is further limited because of the nature of the
20 design: a dragon. Because the depiction of a dragon is dictated by common or standard features and
21 characteristics – *e.g.*, a reptilian body, elongated neck, and scaly skin, often with large bat-like wings
22 and a spiked tail – those features are not protectable under copyright law. As such, UBC's "dragon"
23 design is entitled to "thin" copyright protection, which would require UBC to show virtual identical
24 copying to sustain an infringement case. *See Satava*, 323 F.3d at 810. As explained below, UBC
25 cannot meet this standard or even a more lenient "substantial similarity" standard.
26
27
28

1 As the Court will observe, based on a facial comparison of the copyrighted designs with A-B's
2 TILT can (as is the proper comparison), the overall designs, including the depicted dragons, are
3 different. A-B's TILT can features the side, mirror view of two dragons facing each other in a crest-
4 like formation, while UBC's JOOSE can depicts the front view of a single dragon, which is difficult to
5 perceive. A-B's dragons are more stylized and appear to form a wreath-like design around a stylized
6 letter "T" while UBC's dragon appears to be rendered in a more life-like manner. A-B's dragon design
7 clearly depicts the wings on both dragons; UBC's dragon does not appear to have any wings. UBC's
8 dragon has large, pronounced claws and protruding talons, while A-B's dragons have smaller, muted
9 claws. Significantly, UBC's dragon is posed surrounding the JOOSE name; A-B's dragons are posed
10 on other side of a crown (which is not found in UBC's copyright). One of UBC's copyrighted designs
11 prominently features its JOOSE mark surrounded by its dragon design, A-B's dragon designs are
12 separated from its distinctly different TILT mark. The list of differences dwarfs the lone similarity:
13 that both parties use images of dragons.
14

15
16 UBC does not and cannot own a monopoly on dragon designs. The mere fact that UBC depicts
17 a dragon on its can does not prevent A-B from depicting different dragons on its product. As a matter
18 of law, this limited similarity is insufficient to meet the substantial similarity required for copyright
19 infringement. *See Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901 (9th Cir. 1987) (cannot rely "upon any
20 similarity in expression resulting from either the physiognomy of dinosaurs or from the nature of
21 stuffed animals); *Aurora World*, 2009 U.S. Dist. LEXIS 129128 at *49 (cannot claim infringement
22 based on the fact that defendant sells a toy depicting the same animal as plaintiff's toy); *see also Toho*,
23 645 F.2d at 790 (on a 12(b)(6) motion no likelihood of confusion where parties used different
24 representations of a creature). In an analogous situation, one U.S. District Court in California
25 dismissed a copyright infringement claim on a Rule 12(b)(6) motion, finding that there were no
26 extrinsic similarities between the works except for the presence of a raisin shaped body and head,
27
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1 which merely resulted from “the common idea of an anthropomorphic raisin,” and these elements were
2 totally dissimilar in appearance such that without being told “it could just as easily be concluded that
3 one is a prune and the other is a potato.” *Cory Van Rijn, Inc. v. California Raisin Advisory Bd.*, 697 F.
4 Supp. 1136, 1144 (E.D. Cal. 1987).

5
6 To the extent that UBC bases its copyright infringement claim on any alleged similarity in the
7 typefaces or fonts on the cans, Congress has expressly considered and declined to grant copyright
8 protection to typeface. The Copyright Office itself has denied registration to “mere variations in
9 typographic ornamentation or lettering.” *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 55 to 56
10 (1976); 2 *Patry on Copyright* § 4:19 (2010). As such, similarity in the fonts used for the lettering on
11 the cans, if any, cannot be considered in a copyright infringement analysis.

12
13 Beyond the dissimilarity to the limited material covered by UBC’s copyright registrations,
14 other extrinsic material on A-B’s TILT can further underscores the dissimilarity between A-B’s TILT
15 product and UBC’s copyrighted material. *See Identity Arts*, 2007 U.S. Dist. LEXIS 32060 at *82
16 (granting 12(b)(6) motion where “there is no underlying group of elements or source of information”
17 that was “plainly identical” to plaintiff’s work). Again, the proper comparison is not UBC’s isolated
18 “Dragon Design” against an isolated depiction of A-B’s mirrored dragons, but the comparison of
19 UBC’s copyrighted designs against the TILT can. A-B’s line of TILT products prominently features
20 its distinctly different brand name, TILT®, and uses various design schemes, including different
21 colored text. *See Christiansen*, 149 F.2d at 203 (in affirming 12(b)(6) dismissal of copyright
22 infringement claim court noted “entirely different color scheme” and “numerous other dissimilarities”).
23 Accordingly, UBC’s copyright infringement claim should be dismissed because its registered
24 copyrights are not “virtually identical” or “substantially similar” to A-B’s accused line of TILT
25 products.
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1 F. PLAINTIFF FAILS TO STATE A CLAIM FOR CALIFORNIA STATUTORY
2 DILUTION UNDER CALIF. BUS. & PROF. CODE § 14247 *ET SEQ.* (CLAIM V)

3 UBC's claim for California Statutory Dilution under Cal. Bus. & Prof. Code § 14247 fails for
4 the same reasons as its federal dilution claim discussed above in Section III.D. It is well settled that
5 the analysis of a dilution claim under § 14247 is essentially the same as that applied to a federal
6 dilution claim under § 43(c). *Panavision Int'l, L.P. v. Toebben*, 141 F.3d 1316, 1324 (9th Cir. 1998);
7 *Jarritos, Inc. v. Los Jarritos*, 2007 U.S. Dist. LEXIS 32245, *55-56 (N.D. Cal. May 2, 2007) reversed
8 on other grounds, *Jarritos v. Reyes*, 345 Fed. Appx. 215 (9th Cir. 2009) (unpublished); *Nike, Inc. v.*
9 *Nikepal Int'l, Inc.*, 2007 U.S. Dist. LEXIS 66686, *15 n. 7 (E.D. Cal. Sept. 7, 2007).

10 In Par. 95 of the FAC, UBC's makes the conclusory allegation that the "line of JOOSE flavored
11 malt beverages has been tremendously successful both nationally and in California." However, as
12 explained above in Section III.D., this allegation and the other new allegations in Paras. 96-98 of the
13 FAC, which essentially parallel the allegations in Paras. 70, 72 and 73, are insufficient to plead the
14 fame requirement under § 14247.¹⁵ Accordingly, UBC's claim for California statutory trademark
15 dilution should be dismissed.

16 G. PLAINTIFF FAILS TO STATE A CLAIM FOR CALIFORNIA STATUTORY
17 TRADEMARK INFRINGEMENT UNDER CALIF. BUS. & PROF. CODE § 14245
18 (CLAIM VI)

19 The FAC, at Paras. 107-115, purports to assert a claim for California statutory trademark
20 infringement under Calif. Bus. & Prof. Code § 14245. However, UBC again has failed to allege an
21 essential element of such a cause of action, namely, ownership of a California state registration, which
22 requires dismissal pursuant to Rule 12(b)(6).

23 A claim for trademark infringement under Calif. Bus. & Prof. Code § 14245 requires that the
24 plaintiff plead ownership of a California state registration of the mark which is allegedly infringed. *Id.*

25 _____
26 ¹⁵ Under § 14247, "a mark is famous if it is *widely recognized by the general consuming public of*
27 *this state*, or by a geographic area of this state, as a designation of source of the goods or services of
28 the mark's owner." (Emphasis added.)

(Continued...)

1 at (a)(1) (“A person who does any of the following shall be subject to a civil action by the owner of the
2 *registered mark*, and the remedies provided in Section 14250: (1) Uses, without the consent of the
3 registrant, any reproduction, counterfeit, copy, or colorable imitation of a *mark registered under this*
4 *chapter ...*” (Emphasis added.) Thus, ownership of a California state trademark registration is an
5 essential element of a claim for infringement under § 14245. Where a plaintiff fails to plead facts
6 establishing its ownership of a California state registration of the allegedly infringed mark, a § 14245
7 infringement claim will be dismissed pursuant to Rule 12(b)(6). *E.g., Dream Marriage Group, Inc. v.*
8 *Anastasia International, Inc.*, 2010 U.S. Dist. LEXIS 120543 (C.D. Cal. Oct. 27, 2010); *see also*
9 *Builders Square, Inc. v. Wickes Cos.*, 1985 U.S. Dist. LEXIS 16256, *13 (C.D. Cal. Sept. 4, 1985)
10 (“[p]ursuant to Cal. Bus. & Prof. Code § 14320(a) [now 14245(a)(1)], a civil action may be brought by
11 the owner of a *registered mark*”).
12

13
14 In Par. 17 of the FAC, UBC alleges that it “is the owner of pending California state trademark
15 registrations for its DRAGON JOOSE Marks including: (1) JOOSE; (2) JOOSE and Design; (3)
16 DRAGON JOOSE; and (4) Dragon Design.” Par. 18 of the FAC similarly alleges that UBC “is the
17 owner of pending California state trademark registrations for the State DRAGON JOOSE Marks listed
18 above.” The mere existence of pending applications for such a California state trademark registration,
19 which is all that UBC has alleged, does not meet the requirement § 14245 that the party-plaintiff must
20 own an issued, subsisting California state registration in order to state a claim for infringement under
21 that provision. The allegation in Paras. 17 and 108 of the FAC that UBC owns “pending California
22 state registrations” is misleading because it suggests that there are California registrations in existence
23 in some sort of “pending” status. The simple, uncontested fact is that UBC does not own any
24 California state registrations of the marks it is relying upon in this civil action.
25

26 _____
27 (...Continued)
28

1 For these reasons, UBC has failed to allege a claim for infringement under Calif. Bus. & Prof.
2 Code § 14245 upon which relief can be granted. Even if, however, UBC could prove ownership of
3 California state registrations for the JOOSE, JOOSE & Design, and Dragon Design marks, those
4 claims should be dismissed for the same reasons explained below.

5
6 H. PLAINTIFF FAILS TO STATE A CLAIM FOR UNFAIR COMPETITION UNDER
7 CALIF. BUS. & PROF. CODE § 17200 AND AT COMMON LAW (CLAIMS VII,
8 VIII AND IX)

9 The viability of the common law and statutory unfair competition claims and the common law
10 trademark infringement claim pleaded in the FAC is determined by the same analysis applicable to its
11 federal trade dress infringement and false designation of origin claims under § 43(a) discussed in
12 Section III.B. above. *See Walter v. Mattel*, 210 F.3d 1108, 1111 (9th Cir. 2000) (analysis of common
13 law and California statutory unfair competition claims is guided by same analysis as a § 43(a) federal
14 unfair competition claim). Thus, these ancillary claims should be dismissed, as well.

15 Independently, an additional basis for dismissal of UBC's common law unfair competition
16 claim and partial dismissal of UBC's statutory unfair competition claim is preemption under the
17 Copyright Act. A state law claim is preempted by the Copyright Act if a plaintiff asserts rights under
18 state law "that are equivalent" to those protected by the Copyright Act and the work falls within the
19 "subject matter" of the Copyright Act as set forth in 17 U.S.C. §§ 102 and 103. 17 U.S.C. § 301(a);
20 *Kodadek v. MTV Networks*, 152 F.3d 1209, 1212 (9th Cir. 1998). The Ninth Circuit has held that
21 claims under Calif. Bus. & Prof. Code § 17200 are preempted where the basis for the claim is the
22 copying and sale of a product that allegedly infringes plaintiff's copyrighted work. *Kodadek*, 152 F.3d
23 at 1212-1213. UBC's entire common law unfair competition claim and part of its statutory unfair
24 competition claim is based on A-B's alleged sale of beverages in cans that infringe its copyrighted
25 works. *See id.* (noting that plaintiff's "unfair competition claim incorporates by reference paragraphs
26
27
28

1 from the copyright infringement claim” in finding preemption). As such, UBC’s state law claims are
2 preempted, and should be dismissed.

3 **IV. CONCLUSION**

4 For the above-stated reasons, the UBC’s FAC should be dismissed pursuant to Rule 12(b)(6)
5 for failure to state claims upon which relief may be granted. Because UBC cannot cure the
6 deficiencies in its FAC, the dismissal should be with prejudice.
7

8 Dated: January 24, 2011

Respectfully submitted,

9 /s/ Bobby A. Ghajar
10 Bobby A. Ghajar (SBN 198719)
11 HOWREY LLP
12 550 South Hope Street, Suite 1100
13 Los Angeles, California 90071
14 Telephone: (213) 892-1800
15 Facsimile: (213) 892-2300
16 E-mail: ghajarb@howrey.com

17 and

18 Peter E. Moll (*admitted pro hac vice*)
19 Alan S. Cooper (*admitted pro hac vice*)
20 HOWREY LLP
21 1299 Pennsylvania Avenue, N.W.
22 Washington, D.C. 20004
23 Telephone: (202) 783-0800
24 Facsimile: (202) 383-6610

25 Attorneys for Defendant
26 Anheuser-Busch, Inc.
27
28

TABLE OF CONTENTS

1

2 Exhibit A – UBC’s Copyrighted
3 Designs.....1

4 Exhibit B – USPTO Office Action Issued Against UBC’s “Dragon Design” Mark, Ser. No.
5 85/139,185.....3

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-01-24 17:01:43 ET

Serial Number: 85139185 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark



Standard Character claim: No

Current Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Date of Status: 2011-01-12

Filing Date: 2010-09-27

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 114

Attorney Assigned:
HELFMAN JUDITH MICHELLE

Current Location: M5X -TMO Law Office 114 - Examining Attorney Assigned

Date In Location: 2011-01-12

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. United Brands Company

Address:

EXHIBIT B
PAGE 3

United Brands Company
10940 Wilshire Boulevard, Suite 1600
Los Angeles, CA 90024
United States
Legal Entity Type: Corporation
State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 033
Class Status: Active
alcoholic beverages produced from a brewed malt base with natural juice flavorings
Basis: 1(a)
First Use Date: 2008-06-00
First Use in Commerce Date: 2008-06-00

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

Description of Mark: The mark consists of a stylized image of a dragon.

Design Search Code(s):

04.05.01 - Dragons; Griffons
26.11.07 - Rectangles with a decorative border, including scalloped, ruffled and zig-zag edges
26.11.21 - Rectangles that are completely or partially shaded
26.11.25 - Rectangles with one or more curved sides

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-01-12 - Notification Of Non-Final Action E-Mailed

2011-01-12 - Non-final action e-mailed

2011-01-12 - Non-Final Action Written

2011-01-05 - Assigned To Examiner

2010-10-01 - Notice Of Design Search Code Mailed

EXHIBIT B
PAGE 4

2010-09-30 - New Application Office Supplied Data Entered In Tram

2010-09-30 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Nancy O. Dix

Correspondent

NANCY O. DIX

DLA PIPER LLP (US)

401 B ST STE 1700

SAN DIEGO, CA 92101-4297

Phone Number: (619) 699-2921

Fax Number: (619) 764-6701

To: United Brands Company (sdtrademark@dlapiper.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85139185 - T06686US0
Sent: 1/12/2011 7:16:36 PM
Sent As: ECOM114@USPTO.GOV
Attachments:

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION ABOUT TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85139185

MARK:

85139185

CORRESPONDENT ADDRESS:

NANCY O. DIX
DLA PIPER LLP (US)
401 B ST STE 1700
SAN DIEGO, CA 92101-4297

CLICK HERE TO RESPOND TO THIS LETTER:

<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: United Brands Company

CORRESPONDENT'S REFERENCE/DOCKET

NO:

T06686US0

CORRESPONDENT E-MAIL ADDRESS:

sdtrademark@dlapiper.com

OFFICE ACTION

STRICT DEADLINE—TO AVOID ABANDONMENT OF THIS TRADEMARK APPLICATION, THE USPTO MUST RECEIVE A COMPLETE RESPONSE TO THIS OFFICE ACTION WITHIN **6 MONTHS** OF THE ISSUE DATE.

ISSUE/MAILING DATE: 1/12/2011

The undersigned examining attorney has reviewed the above-referenced application, in accordance with section 2.61 of the Trademark Rules of Practice, 37 C.F.R. § 2.61 (2010), and has determined the following:

NO CONFLICTING MARKS

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) (2006). Trademark

MATERIAL DIFFERENCE BETWEEN DEPICTION ON DRAWING & SPECIMEN

Applicant applied to register for the special form design mark of a stylized image of a dragon positioned around a curved rectangular shaped shaded region for use on “alcoholic beverages produced from a brewed malt base with natural juice flavorings,” on September 27, 2010. Applicant submitted the date of June 30, 2008, as the date it first used the asserted mark and the date of first use of the asserted mark in commerce in connection with the identified goods.

Applicant has not provided a specimen evidencing that the drawing of record is a substantially exact representation of the mark as used in commerce in connection with any of the recited goods. Trademark Rule 2.51(a) provides that “the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services.” 37 C.F.R. § 2.51(a); TMEP § 807.12(a); *see* C.F.R. § 2.72(a)(1). Under Sections 1(a) and 45 of the Trademark Act and under Rule 2.56, a specimen showing use of the mark on the goods is required in an application based on use of the mark in commerce. 15 U.S.C. §§ 1051(a), 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56; TMEP §§ 904, 904.07(a).

The specimen is the point of reference in determining whether the alleged mark shown in the drawing agrees with the mark in use. *In re Pharmavite LLC*, 91 U.S.P.Q.2d 1778, 1780 (TTAB 2009). “It is well settled that an applicant may seek to register any portion of a composite mark if that portion presents a separate and distinct commercial impression which indicates the source of applicant’s goods,” as “the applicant has some latitude in selecting the mark it wants to register.” *In re Ontario Ltd.*, 81 U.S.P.Q.2d 1446, 1448 (TTAB 2006). However, “[i]f the portion of the mark sought to be registered does not create a separate and distinct commercial impression, the result is an impermissible mutilation of the mark as used.” *Id.*

In support of use for the identified goods in International Class 33, Applicant has submitted three JPEG images, and describes these images as “a photograph of the product, a copy of the artwork and a photograph of the product as displayed for sale.” The specimen photograph demonstrates a can of flavored malt beverage, with the asserted mark appearing prominently and in conjunction with the literal element “JOOSE,” which appears at the center of the can and of the asserted mark, within the outline of the curved rectangular shape, with part of the stylized dragon design superimposed over and intermingled with its letters. The wording “DRAGON JOOSE” appears prominently below the asserted mark and integrated literal element “JOOSE.” Certain portions of the asserted mark, for example, the tail of the dragon, do not appear on the specimen can due to printing along the bottom area. The second submission is a copy of artwork, and as detailed in section 904.04(a) of the Trademark Manual of Examination Procedures, TMEP § 904.04(a), “the specimen may not be a ‘picture’ of the mark, such as an artist’s drawing or a printer’s proof that merely illustrates what the mark looks like and is not actually used on or in connection with the goods in commerce.” While not an acceptable specimen, the submission supports the determinations that the letters of the literal element “JOOSE” and asserted mark are integrated and that the entirety of the mark, such as the tail of the dragon, does not appear on the specimen can. The last submission, demonstrating a point-of-sale presentation, shows the literal element “JOOSE” prominently displayed, while the asserted mark cannot be clearly recognized.

Given the placement and integrated use of the asserted mark in conjunction with prominently placed literal element “JOOSE” at its center, and the placement and presentation of the words “DRAGON JOOSE” immediately below this image on the specimen can, potential purchasers and consumers seeing the

specimen can would perceive this integrated display to create and reinforce a unitary message of “dragon juice,” and would not perceive the design as an independent element with a separate and distinct commercial impression to indicate the source of the goods. The asserted mark is not an independent design element, but is an integral part of the message conveyed by the combination of the design and wording, and reinforced by use of the wording elsewhere on the specimen can. As the portion of the display on the specimen can sought to be registered does not create a separate and distinct commercial impression, the asserted mark is an impermissible mutilation of the display appearing on the specimen can, which on its own would not be capable of performing the trademark function of identifying the source of the merchandise to the customers on its own.

Consequently, the drawing of record is *not* a substantially exact representation of the mark as demonstrated by the specimen of record, as required by Rule 2.51(a). *See* TMEP § 807.12.

Based on examination, and explained in the analysis provided, the additional literal element “JOOSE” is material to the overall commercial impression of the mark.

Rule 2.72(a) provides that an applicant may amend the drawing of the mark only if the “proposed amendment does not materially alter the mark.” 37 C.F.R. § 2.72(a). As detailed in section 807.14 of the Trademark Manual of Examination Procedures, TMEP § 807.14 (7th ed. 2010), immaterial changes to a mark are those that do not change the commercial impression of the mark, in other words, “the new form must create the impression of being essentially the same mark.” *In re Hacot-Colombier*, 105 F.3d 616, 620, 41 U.S.P.Q.2d 1523, 1526 (Fed. Cir. 1997) (quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 U.S.P.Q. 740,743-44 (TTAB 1983)). As also detailed in TMEP § 807.14, the addition of any element that would require a further search will generally constitute a material alteration.

Applicant may not amend the mark on the drawing to conform to the display on the specimen because the essence or character of the mark would be materially altered; in other words, the depiction on the specimen creates a different commercial impression from the mark on the drawing. *See* 37 C.F.R. § 2.72(a); TMEP §§ 807.12(a), 807.14.

Therefore, Applicant must submit the following:

- (1) **One substitute specimen for the identified goods in International Class 33** showing use of the mark in commerce as it appears on the drawing, with
- (2) A statement that **the substitute specimens were in use in commerce at least as early as the filing date of the application**, verified with an affidavit or a declaration under Rule 2.20 or Rule 2.33.

See 37 C.F.R. §§ 2.56, 2.59(a), 2.193(e)(1); TMEP §§ 807.12(a), 904.05. If submitting a substitute specimen requires an amendment to the dates of use, Applicant must also verify the amended dates, in accordance with Rule 2.20. 37 C.F.R. § 2.71(c).

Applicant is strongly urged to submit the specimen electronically. If Applicant submits an online response, please note that the specimen must be a digitized image submitted in either JPEG or PDF format. 37 C.F.R. § 2.56(d)(4); TMEP § 904.02.

Examples of acceptable specimens for goods are tags, labels, instruction manuals, containers, and

photographs, showing the mark on the goods or packaging, or in displays associated with the goods at the point of sale. TMEP § 904.03.

ALTERNATIVELY, AMEND BASIS TO SECTION 1(B)

If Applicant cannot comply with the SPECIMEN requirement for the Section 1(a) basis asserted, Applicant may amend the Section 1(a) filing basis (i.e., use in commerce) to Section 1(b) (i.e., intent to use basis), for which no specimen is immediately required. *See* TMEP § 806.03(c). However, should Applicant amend the basis to Section 1(b), registration cannot be granted until Applicant later amends the application back to use-in-commerce by filing an acceptable allegation of use with a proper specimen. 15 U.S.C. § 1051(c)-(d); 37 C.F.R. §§ 2.76, 2.88; TMEP § 1103.

In order to amend to Section 1(b), the following statement is required:

Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application **as of the filing date of the application**.

15 U.S.C. § 1051(b). This statement must be verified with an affidavit or a signed declaration under 37 C.F.R. § 2.20. 37 C.F.R. §§ 2.34(a), 2.35(b)(1), 2.193(e)(1); TMEP § 806.01(b).

Pending receipt of a proper response, registration is refused because no specimen shows the proposed mark in use in commerce as a trademark for the identified goods. 15 U.S.C. §§ 1051, 1127; 37 C.F.R. §§ 2.34(a)(1)(iv), 2.56; TMEP §§ 904, 904.07(a).

If Applicant chooses to respond to this Office Action, Applicant must also respond to the following:

APPLICANT MUST AMEND DESCRIPTION OF MARK

Applicant must provide a complete description of the applied-for mark. Applications for special form marks must include an accurate and concise description that identifies all literal and design elements in the mark. *See* 37 C.F.R. § 2.37; TMEP § 808. The current description of the mark is accurate but incomplete because it does not describe all the significant aspects of the applied-for mark, specifically, it not describe the cured rectangular-shaped shaded area around which the stylized dragon borders and is positioned.

The following format is suggested:

The mark consists of a stylized image of a dragon positioned around a miscellaneously curved rectangular shaped shaded region.

Applicant must respond timely and completely to the issues raised in this Office Action. 15 U.S.C. § 1062(b); 37 C.F.R. §§ 2.62, 2.65(a); TMEP §§ 711, 718.03.

Please contact the undersigned attorney with any questions.

Sincerely,

/Judy Helfman/
Judith M. Helfman
Attorney at Law

USPTO - Trademarks
Law Office 114
(571) 272-5892 direct line

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

WHO MUST SIGN THE RESPONSE: Any response must be personally signed by (1) an individual applicant; (2) someone with legal authority to bind applicant (e.g., a corporate officer, a general partner, all joint applicants); or (3) an authorized attorney, if one is appointed to represent applicant.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

To: United Brands Company (sdtrademark@dlapiper.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85139185 - T06686US0
Sent: 1/12/2011 7:16:37 PM
Sent As: ECOM114@USPTO.GOV
Attachments:

IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION HAS ISSUED ON 1/12/2011 FOR
SERIAL NO. 85139185

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from 1/12/2011 (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the ABANDONMENT of your application.