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

Proceeding	91160944
Party	Plaintiff RED BULL GMBH
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Submission	Motion to Dismiss - Rule 12(b)
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/Martin R Greenstein/
Martin R. Greenstein

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RED BULL GMBH. **Opposer/Respondent** **v.** **TEQUILA CUERVO LA ROJENA, S.A. DE C.V.** **Applicant/Petitioner.**	**Opposition No.: 91-160,944** Trademark: **MATADOR** **Serial No.: 78/152,459** [Opposed in Class 32 Only]

MOTION TO STRIKE OR REQUIRE AMENDMENT OF COUNTERCLAIMS

Pursuant to Rules 8 and 12 of the Federal Rules of Civil Procedure and Sections 505.01 and 506.01 of the Trademark Board Manual of Procedure, Opposer/Respondent Red Bull GmbH ("Red Bull", "Opposer" or "Respondent"), hereby moves the Trademark Trial and Appeal Board for an order striking or dismissing the Counterclaims filed by Applicant/Petitioner, Tequila Cuervo la Rojena, S.A. de C.V. ("Tequila Cuervo", "Applicant" or "Petitioner"). In the alternative, Opposer moves for an order that Applicant revise its counterclaims to be short and concise, and to be limited to the relevant issues and classes of goods involved in this Opposition.

I. Applicant's Counterclaims are Primarily Discovery Requests and Fail to Comply With Rule 8, F.R.C.P.

Rule 8 of the Federal Rules of Civil Procedure states, in pertinent part:

Rule 8. General Rules of Pleading

> (a) Claims for Relief.
> A pleading that states a claim for relief must contain:
> (1) a short and plain statement of the grounds for the court's jurisdiction, unless the court already has jurisdiction and the claim needs no new jurisdictional support;
> (2) a short and plain statement of the claim showing that the pleader is entitled to relief; and
> (3) a demand for the relief sought, which may include relief in the alternative or different types of relief.

As the Southern District of New York explained many years ago:

> The Federal Rules of Civil Procedure envision a system of simplified pleadings that give notice of the general claim asserted, allow for the preparation of a basic defense, narrow the issues to be litigated, and provide a means for quick disposition of sham claims. Federal pleadings are designed for integration into a system of pre-trial motions, discovery and conferences, which further sharpen the claims to be litigated and which expedite the process of adjudication.
> Complaints which ramble, which needlessly speculate, accuse, and condemn, and which contain circuitous diatribes far removed from the heart of the claim do not comport with these goals and this system; such complaints must be dismissed.

Prezzi v. Berzak, 57 F.R.D. 149, 151 (D.N.Y. 1972)[citations omitted]. Opposer respectfully submits that Applicant's Counterclaims do not comport with the clear standard set by Rule 8.

TBMP Section 313.01 states that: "A counterclaim is the legal equivalent of a separate petition to cancel. Thus the provisions of 37 CFR 2.111 through 2.115, governing petitions to cancel, are applicable to counterclaims."

Further, following F.R.C.P. Rule 8, TBMP Section 309.03(a)(2) states that "a petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled...and (2) a short and plain statement of the ground(s) for cancellation". The rule specifies that "The elements of a claim should be stated simply, concisely, and directly".

In response to the Notice of Opposition, Applicant filed a set of counterclaims contained in 385 paragraphs (the counterclaim has 383 numbered paragraphs, but paragraph numbers 35, 51, 61, and 71 were used twice, and numbers 52 and 111 were not used). Paragraphs numbered 5-9, 18-22, 29-371, and 378-380 are alleged on information and belief. The majority of these paragraphs are of the tri-part form:

> a. On information and belief Opposer is not currently using the mark RED BULL in connection with [insert name of one or more good or service] in Opposer's [insert registration number] Registration.
>
> b. On information and belief Opposer has not made use of the mark RED BULL in connection with [insert name of the good or service from the preceding paragraph] identified in Opposer's [insert registration number] Registration for at least the past three years.
>
> c. On information and belief with respect to [insert name of the good or service from the preceding paragraph] Opposer has abandoned the mark shown in the [insert registration number] Registration through non-use or the abandonment of the mark on these goods.

In this way, Applicant goes through each and every item of goods and services identified in all four registrations pleaded by Opposer, even though most of the goods and services identified in one of the registrations are not relevant here.

Opposer objects to the counterclaims as not being "a short and plain statement of the claim showing that the pleader is entitled to relief" as required by Rule 8. Rather, the counterclaims are a long series of allegations that are largely redundant and mostly irrelevant and unrelated to the issues of this opposition. In effect, what Applicant has propounded here is not a counterclaim, but a lengthy and very thinly disguised series of requests for admissions - most of which address goods and services completely unrelated to the issues in the opposition (and which would be objected to as beyond the scope of permissible discovery if propounded as requests to admit). There is no basis for presenting discovery requests under the notice pleading of Rule 8, and therefore the counterclaims should be stricken.

II. Even if not Viewed as Improper Disguised Discovery Requests, the 385 Separate Paragraphs of Applicant's Counterclaims are Largely Irrelevant

Furthermore, most of the paragraphs of the counterclaims are irrelevant to this proceeding. The application opposed herein is for the mark MATADOR for:

Non alcoholic cocktail mixes for mixing with alcoholic beverages (class 32)

and for

Prepared Alcoholic cocktails; tequila, tequila liqueurs (class 33).

However, Opposer opposed as to the Class 32 goods only, and did not oppose as to Class 33. The Notice of Opposition pleaded U.S. Registrations Nos. 1,541,794 (RED BULL, stylized, for malt liquor in class 32); 1,935,272 (RED BULL, for malt liquor in class 32); 2,494,093 (RED BULL for a wide variety of goods and services, including "flavored ices; milkshakes, frozen yoghurt and ice cream," in class 30, and "mineral waters and aerated waters and other non-alcoholic beverages, namely, flavored waters; soft drinks; and sports drinks," in class 32); and 2,579,008 (BULL, for non-alcoholic beverages, namely, soft drinks; and energy and sports drinks, in class 32). Thus, the relevant goods here all relate to providing or serving drinks of some sort. By not opposing Applicant's Class 33 goods and by the choice of pleaded registrations, Opposer has clearly demonstrated and effectively limited the area presenting likelihood of confusion. Therefore all other goods and services outside of this area have no bearing upon the issues in this case.

Rather than limit the counterclaim to those goods relevant to the proceeding, Applicant's counterclaim includes over three hundred paragraphs relating to goods and services not relevant here. If Applicant believes there is a likelihood of confusion with respect to those other goods and services, Applicant should so allege and put those otherwise unrelated

and irrelevant goods and services at issue. However, absent such allegations, at a minimum, Opposer submits that paragraphs 29– 284 and 297– 371 should be stricken.

Under Rule 12(f) of the Federal Rules of Civil Procedure, the Board may strike from a pleading any insufficient defense or any redundant, immaterial, or impertinent allegation. *Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570 (TTAB 1988). Although motions to strike are generally not favored, *id.,* the vast majority of the 385 separate paragraphs set forth in the counterclaim herein have no bearing on the possible issues in this case. If not stricken, paragraphs 29– 284 and 297– 371 of the counterclaim would require Opposer to invest substantial amount of time, finances and efforts in answering the counterclaim and in responding to the likely eventual discovery as to goods and services that have no relevance to the issues at hand, all to the prejudice of Opposer. Such discovery would itself be subject to objection as not relevant or likely to lead to relevant evidence. Pursuant to Section 506.01 of TBMP "... the Board grants motions to strike in appropriate cases". For the reasons above and the arguments provided, Opposer believes this matter presents an "appropriate case" within the meaning of Section 506.01. Thus, the Board should strike these paragraphs now, before the parties have to spend time and money on costly discovery, testimony, argument and briefing.

III. Applicant's Allegations of Abandonment are Fatally Defective.

With respect to most if not all of the goods and services covered by Opposer's pleaded registrations, Applicant alleges:

> On information and belief with respect to [good or service] Opposer has abandoned the mark shown in the [registration number] Registration through non-use or the abandonment of the mark on these goods.

As such, Applicant has alleged that Opposer has abandoned its registrations "through non-use or the abandonment of the mark on [the] goods."[1] Opposer submits that these allegations are inadequate to plead abandonment.

Under the Lanham Act, 15 USC §1127:

> A mark shall be deemed to be "abandoned" if either of the following occurs:
> (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.
> (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

Thus, abandonment requires non-use and an intent not to resume use. Despite numerous allegations "on information and belief," Applicant does not plead that there is no intent to resume use, nor does Applicant plead that the mark RED BULL in Opposer's pleaded registrations has become generic. Therefore, the pleadings are defective to show abandonment, and should be stricken.

IV. Applicant's Counterclaims are Vague and Ambiguous

In addition, those portions of the pleadings that claim that Opposer "has abandoned the mark ... through the abandonment of the mark ..." are circular and unintelligible and should be stricken and a more definite, clear statement should be required. TBMP section 505.01 states that "if ... a pleading to which responsive pleading must be made is so vague or

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[1] Opposer does not understand the circular phrase "has abandoned the mark ... through the abandonment of the mark ..." and Opposer objects to each of these allegations as being unintelligible on that basis, and incapable of response. The allegation of "abandonment ... through the abandonment must be stricken or clarified.

ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement". The allegations that Opposer "has abandoned the mark ... through the abandonment of the mark ..." certainly meet this test.

V. Applicant's Allegations do not Demonstrate Applicant has Standing to Cancel Opposer's Registration No. 2,494,093 Except as to Classes 32 and 33.

The Notice of Opposition alleges facts relating to class 32 goods, and a likelihood of confusion with respect to use of Applicant's mark for class 32 goods and certain other beverages or drinks. The Notice of Opposition also cited four registrations, all of which recite class 32 goods. The Counterclaims seek to cancel each of those registrations. However, Registration No. 2,494,093 includes numerous goods and services that are unrelated to and have no bearing on this opposition.[2]

As discussed above, Applicant has alleged that Opposer does not use the mark in question for various irrelevant goods and services, see Applicant's counterclaim, paragraphs 29– 284 and 297– 371. There is no issue in the opposition relating to those goods and services, and Applicant has no standing to petition to cancel the '093 registration with respect to those goods and services.[3] Therefore, with respect to Registration No. 2,494,093, the Counterclaims should be limited to a partial cancellation under Section 18.

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[2]Registration No. 2,494,093 also covers "flavored ices; milkshakes, frozen yoghurt and ice cream" in class 30, goods Opposer admits are arguably relevant to likelihood of confusion in this proceeding. However, in addition to classes 30 and 32, Registration No. 2,494,093 also includes unrelated goods in classes 3, 5, 12, 14, 16, 18, 20, 25, 26, 28, 30, 34, 35, 39, 41, and 42.

[3]Opposer understands that Applicant has inherent standing to petition to cancel Opposer's class 32 registrations, but Opposer is aware of no authority that grants standing to cancel registrations or classes with regard to which there is no likelihood of confusion, or which are otherwise wholly unrelated to the issues involved in the underlying opposition.

WHEREFORE, Opposer/Respondent respectfully request that the Counterclaims be denied in their entirety, and that the registrations of Opposer/Respondent be allowed to remain on the Register. In the alternative, Opposer/Respondent respectfully requests that Applicant be ordered to submit an amended counterclaim which complies with Rule 8, and which satisfies or eliminates the other objections raised herein.

Respectfully Submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **MOTION TO STRIKE OR REQUIRE AMENDMENT OF COUNTERCLAIMS** is being served on February 4, 2008, on counsel for Applicant/Petitioner by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to:
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