ESTTA Tracking number: **ESTTA194644**
Filing date: **02/25/2008**

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

Proceeding	91160944
Party	Defendant Tequila Cuervo La Rojena, S.A. De C.V.
Correspondence Address	Lawrence E. Abelman ABELMAN FRAYNE & SCHWAB 666 Third Avenue New York, NY 10017-5621 UNITED STATES MAMastrovito@lawabel.com
Submission	Other Motions/Papers
Filer's Name	Marie Anne Mastrovito
Filer's e-mail	mamastrovito@lawabel.com
Signature	/mam/
Date	02/25/2008
Attachments	20080225174217279.pdf (3 pages)(263694 bytes)

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

In the Matter Of: Trademark Application No. 78/152459 for the mark MATADOR in Classes 32 and 33 in the United States

RED BULL GMBH	:	
Opposer,	:	
v.	:	**Opposition No. 91160944**
TEQUILA CUERVO LA ROJENA, S.A. DE C.V.,	:	
Applicant.	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE OR TO REQUIRE AMENDMENT OF COUNTERCLAIMS

Applicant, **Tequila Cuervo la Rojena, S.A. de C.V** requests that the Board deny the Opposer's Motion to Strike or to Require Amendment of Counterclaims. Applicant submits that the Opposer's arguments are without merit.

A. Applicant's Counterclaims Comply with Rule 8 of FRCP

Applicant submits that the counterclaims fit well within the requirements of Rule 8. Although the counterclaims are numerous the claims consist of short and plain statements of the grounds for relief and the reasons that Applicant is entitled to the relief sought. The claims are numerous because the goods covered by Opposer's claimed registrations are numerous, and because the number of goods and services with which Applicant believes Opposer has not made use of the mark in U.S. commerce are numerous.

B. COUNTERCLAIMS ARE NOT IRRELEVANT

Applicant stresses that the counterclaims all seek cancellation in whole or in part against registrations pleaded by Opposer in its Notice of Opposition. As such, these are compulsory

counterclaims under Trademark Rule 2.106. In the Notice of Opposition, Opposer has placed these registrations in issue without any stated limitations on the scope of the goods or services covered by the registrations. The claim that the counterclaims are irrelevant to this proceeding is without merit. The scope and strength of Opposer's pleaded registration is very much a relevant issue in this proceeding.

C. ALLEGATIONS OF ABANDONMENT ARE NOT FATALLY DEFECTIVE

Applicant submits that the allegations of abandonment in the counterclaims are sufficient. Applicant has used the word "abandoned" as it is defined in 15 U.S.C. Section 1127 and therefore each use of this term by definition incorporates an intention not to resume use. There is no reason why each element of abandonment must be pleaded separately.

D. APPLICANT'S COUNTERCLAIMS ARE NOT VAGUE AND AMBIGUOUS

Applicant's statement that Opposer has abandoned the mark through "non-use or the abandonment of the mark," is not circular or unintelligible. Applicant submits that this statement clearly conveys that the mark has been abandoned either because Opposer never used the mark (non-use) or used the mark and then abandoned it. Even if the claim could have been stated with greater clarity, Opposer is easily able to admit or deny the claim of abandonment contained therein.

E. APPLICANT HAS STANDING TO CANCEL THE PLEADED REGISTRATIONS IN THEIR ENTIRETY

Applicant submits that Opposer has no basis for arguing that Applicant does not have standing to challenge the very registrations which were pleaded by Opposer, without limitation, in its Notice of Opposition. The argument that Applicant has no standing to attack registrations which have been asserted against the Applicant is non-sensical.

WHEREFORE, Applicant requests that Opposer's Motion to Strike or Require Amendment of Counterclaims be dismissed in its entirety .

Respectfully submitted,

MARIE-ANNE MASTROVITO

ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NEW YORK 10017
(212) 949-9022

Attorneys for Applicant,
Tequila Cuervo La Rojena, S. A. de C.V.

Date: February 25, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE OR TO REQUIRE AMENDMENT OF COUNTERCLAIMS was served by first class mail, postage prepaid, this 25th day of February, 2008 upon counsel for Opposer:

Martin R. Greenstein, Esq.
TECHMARK
4820 Harwood Road, 2nd Floor
San Jose, California 95124-5273

MARIE-ANNE MASTROVITO