

ESTTA Tracking number: **ESTTA242098**

Filing date: **10/13/2008**

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

Proceeding	91160944
Party	Plaintiff RED BULL GMBH
Correspondence Address	Martin R. Greenstein TechMark a Law Corporation 4820 HARWOOD ROAD, 2ND FLOOR San Jose, CA 95124-5273 UNITED STATES MRG@TechMark.com, MPV@TechMark.com
Submission	Other Motions/Papers
Filer's Name	Martin R. Greenstein
Filer's e-mail	MRG@TechMark.com, MPV@TechMark.com
Signature	/Martin R Greenstein/
Date	10/13/2008
Attachments	Matador-Cuervo-#91160944-RespShowCause_Final.pdf (3 pages)(31877 bytes)

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being filed electronically via ESTTA on October 13, 2008.

/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]

RESPONSE TO ORDER TO SHOW CAUSE

In the Trademark Trial and Appeal Board's order of September 25, 2008 the Board invited Opposer to show cause why judgment should not be entered against Opposer as to Classes 3, 15, 30, 39 and 42 of its Reg. # 2,494,093 due to the deletion of those same Classes at the time of filing the Section 8 Declaration for Reg. # 2,494,093. The Board's Order noted that if its failure to file a Section 8 affidavit as to the goods and services in the deleted classes was the result of inadvertence or mistake or that the decision was based upon a valid business decision and not to avoid Applicant's counterclaim, then judgment will not be entered against Applicant.

The decision to delete the goods and services in the cited classes was not the result of inadvertent error or mistake. However, Opposer notes and respectfully submits that it had valid business grounds for deleting Classes 3, 15, 30, 39 and 42 from its registration, that those business grounds had nothing to do with the instant opposition proceeding and that Opposer was certainly not motivated by desire to avoid Applicant's counterclaim. Rather, the underlying

reason for these deletions was that at the time of filing the Section 8 Declaration of Use for Reg. # 2,494,093 Registrant lacked the requisite use or sufficient excusable non-use in commerce for those particular classes and/or goods/services. One of the requirements for the Section 8 Declaration of Use as set forth in TMEP §1604.05 states that:

“A complete affidavit or declaration under section 8 of the Act must:

...

(b) Include a statement that is signed and verified (sworn to) or supported by a declaration under §2.20 by a person properly authorized to sign on behalf of the owner, attesting to the continued use or excusable nonuse of the mark within the period set forth in section 8 of the Act. in §2.160(a)...”

These rules mandate that the Section 8 Declaration of Use can only be filed in regards to those goods/services for which there is continued use or excusable nonuse. Since Opposer did not have continued use or excusable nonuse for Classes 3, 15, 30, 39 and 42 in its Reg. # 2,494,093 it had to delete those classes at the time of filing its Section 8 Declaration. However, having no use on which to base a Section 8 Declaration is certainly not the legal equivalent of abandonment, and is certainly not a concession of lack of intent to resume use. The same is true as to the deletion of certain goods and services in the classes which are retained in the application. As the Board itself noted in the Order when discussing the sufficiency of Counterclaimant’s petition to cancel, abandonment requires non-use and intent not to resume use. The fact that a party has no use as of the due date of the Section 8 affidavit mandates that the goods and services for which there is no use be stricken - and the deletion is mandated by the law and the valid business purpose (i.e., complying with the law and PTO rules). That raises a very different question than whether there is abandonment - non-use with an intent not to resume use - and in this case acting for that valid business is not the equivalent of conceding abandonment. For that reason, Opposer submits that the judgment should not be entered against it as to the

classes stricken in their entirety, or as to the goods and services stricken from classes which remain in the cited registration.

WHEREFORE, Opposer believes it had shown good and sufficient cause and respectfully requests that judgement not be entered against Opposer as to Classes 3, 15, 30, 39 and 42 of its Reg. # 2,494,093.

Dated: October 13, 2008

Respectfully Submitted,
RED BULL GMBH
By /Martin R Greenstein/
Martin R. Greenstein
Mariela P. Vidolova
TechMark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose, CA 95124-5273
Tel: 408-266-4700; Fax: 408-864-2044
E-Mail: MRG@TechMark.com
Attorneys for Opposer/Respondent

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **RESPONSE TO ORDER TO SHOW CAUSE** is being served on October 13, 2008, on counsel for Applicant/Petitioner by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to:

Lawrence E. Abelman
Marie-Anne Mastrovito
Abelman Frayne & Schwab
666 Third Avenue
New York, NY 10017
Tel: 212-949-9022

/Martin R Greenstein/
Martin R. Greenstein/