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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.
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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.	:	
Respondent.	:	

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

RESPONDENT'S ANSWER TO PETITION FOR CANCELLATION (WITH CORRECTION OF TYPOGRAPHICAL ERROR) AND AMENDED COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S REGISTRATION NOS. 2579008, 1541794 1935272, AND 2494093

Pursuant to the Order of the Trademark Trial and Appeal Board issued September 25, 2008, Applicant hereby submits its Amended Counterclaim which has been revised in accordance with the Board Order. Applicant also repeats its Answer to the Notice of Opposition which has remained unchanged except for the correction of a typographical error in paragraph 3 of the Answer. In this paragraph, the wording "contained in paragraph 1" h as been corrected to read "contained in paragraph 3."

I. ANSWER TO NOTICE OF OPPOSITION

In answer to the Notice of Opposition, Applicant states:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Notice of Opposition, and therefore denies same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 2 of the Notice of Opposition, and therefore denies same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Notice of Opposition, and therefore denies same.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Notice of Opposition, and therefore denies same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Notice of Opposition, and therefore denies same.

6. Applicant admits that it filed Application No. 78/152459 on August 8, 2002, and that the application was based on Applicant's intention to use the mark MATADOR on the goods enumerated in the application. Applicant denies that the application as filed covered "non-alcoholic cocktail mixes for mixing with alcoholic beverages," however, this is the current description of goods in Class 32. The Application also covers "prepared alcoholic cocktails; tequila, tequila liqueurs" in Class 33.

7. Applicant denies the allegations in Paragraph 7 of the Notice of Opposition because they are misleading.

8. Applicant admits the allegations in Paragraph 8 of the Notice of Opposition.

9. Applicant denies the allegations in Paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations in Paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations in Paragraph 11 of the Notice of Opposition and further notes that Applicant's mark has been misidentified as MATADOR ENERGY DRINK.

12. Applicant denies the allegations in Paragraph 12 of the Notice of Opposition and further notes that Applicant's mark has been misidentified as MATADOR ENERGY DRINK.

13. Applicant denies the allegations in Paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations in Paragraph 14 of the Notice of Opposition.

15. Applicant admits that U.S. Registration No. 1,199,016 was canceled under Section 8 of the Trademark Act on March 29, 2003, however, Applicant denies the remaining allegations in Paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations in Paragraph 16 of the Notice of Opposition.

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed in its entirety and that a registration be issued with respect to the subject application.

II. COUNTERCLAIM TO CANCEL THE REGISTRATIONS PLEADED IN THE NOTICE OF OPPOSITION

Pursuant to Trademark Rules 2.114(b)(2), Tequila Cuervo la Rojena, S.A. de C.V. ("Cuervo") hereby counterclaims for cancellation of Registration Nos. 1541794, 1935794, 2494093, and 2579008.

A. Registration No. 1541794

1. Opposer relies on its ownership of Registration No. 1,541,794 (hereinafter, "Opposer's '794 Registration") as a basis for its Opposition against the Applicant's mark.

2. Opposer's '794 Registration covers the stylized mark RED BULL (hereinafter, "Opposer's '794 Mark) in connection with "malt liquor."

3. Opposer's '794 Registration was originally owned by The Stroh Brewery Company and was assigned to Pabst Brewing Company in April 30, 1999.

4. Opposer's '794 Registration was assigned from Pabst Brewing Company to Red Bull GmbH on July 31, 2001.

5. On information and belief Opposer is not currently using Opposer's '794 Mark in connection with malt liquor.

6. On information and belief Opposer has not made use of Opposer's '794 Mark in connection with the malt liquor for at least the past three years.

7. On information and belief, even if Opposer's '794 Mark is currently being used for malt liquor, Opposer does not control the nature and quality of the goods.

8. On information and belief, Opposer's '794 Mark has lost all trademark significance as a result of Opposer's failure to control the nature and quality of the malt liquor currently sold under this mark.

9. On information and belief Opposer has abandoned the mark shown in Opposer's '794 Registration through non-use or the abandonment of the mark.

10. Applicant used the mark MATADOR in the U nited States in connection with tequila well in advance of the September, 1985 first use date claimed in Opposer's '794 Registration.

11. Although Applicant temporarily suspended use of the mark MATADOR, Applicant intended to, and has in fact, resumed use of the mark. Hence, the mark was never abandoned.

12. Opposer has alleged a likelihood of confusion between the '794 Mark and Applicant's mark MATADOR for "tequila."

13. If Opposer shows a likelihood of confusion between the marks MATADOR and Opposer's '794 Mark in this Opposition, Opposer's '794 Registration should be cancelled because Applicant has priority.

B. Registration No. 1,935,272

14. The Opposer relies on its ownership of Registration No. 1,935,272 (hereinafter, "Opposer's '272 Registration") as a basis for its Opposition against the Applicant's mark.

15. Opposer's '272 Registration covers the word mark RED BULL in connection with "malt liquor".

16. Opposer's '272 Registration was originally owned by The Stroh Brewery Company and was assigned to Pabst Brewing Company in April 30, 1999.

17. Opposer's '272 Registration was assigned from Pabst Brewing Company to Red Bull GmbH on July 31, 2001.

18. On information and belief Opposer is not currently using the mark RED BULL in connection with malt liquor.

19. On information and belief Opposer has not made use of the mark RED BULL in connection with malt liquor for at least the past three years.

20. On information and belief, even if the mark RED BULL is currently being used for malt liquor, Opposer does not control the nature and quality of the goods.

21. On information and belief, the mark RED BULL has lost all trademark significance as a result of Opposer's failure to control the nature and quality of malt liquor sold under this mark.

22. On information and belief, Opposer has abandoned the mark shown in Opposer's '272 Registration through non-use or the abandonment of the mark.

23. Applicant used the mark MATADOR in the United States in connection with tequila well in advance of the September, 1985 first use date claimed in Opposer's '272 Registration.

24. Although Applicant temporarily suspended use of the mark MATADOR, Applicant intended to, and has in fact, resumed use of the mark. Hence, the mark was never abandoned.

25. Opposer has alleged a likelihood of confusion between Opposer's '272 Mark and Applicant's mark MATADOR for "tequila."

26. If Opposer shows a likelihood of confusion between the marks MATADOR and the mark RED BULL In this Opposition, Opposer's '272 Registration should be cancelled because Applicant has priority.

C. <u>Registration No 2,494,093</u>

27. Opposer's Registration No. 2,494,093 ("Opposer's '093 Registration") currently covers the mark RED BULL on a variety of goods and services in class 12, 14, 16, 18, 20, 25, 26, 28, 32, 34, and 35.

28. On April 1, 2008, Opposer filed a Section 8 Affidavit in order to maintain Opposer's '093 Registration for the goods and services with which Opposer allegedly was using the mark RED BULL at the time the Section 8 Affidavit was filed.

29. Prior to the submission of the Section 8 affidavit maintaining O pposer's '093 Registration, the registration also covered goods and services in classes 2, 5, 29, 30, 39, 41, and 42; however, all the goods and services in these classes were deleted from Opposer's '093 Registration when the Section 8 Affidavit was filed because the mark RED BULL was not in use on these goods and services.

30. When filing the Section 8 affidavit maintaining the Opposer's '093 Registration Opposer also deleted goods and services with which the mark was not being used from Classes 12, 14, 16, 18, 20, 26, 28, 34, and 35.

31. The underlying application for registration of the mark shown in Opposer's '093 Registration was filed on February 2, 1995 and was assigned Serial No. 75/979618. Application Serial No. 75/979618 was based on a home registration under Section 44(e) of the Trademark Act and included a claim that Opposer had a bona fide intention to use the mark in commerce in connection with the goods and services listed in the application.

32. On information and belief Opposer did not have a bona fide intention to use the mark RED BULL on all of the goods and services listed in Application Serial No. 75/979618 at the time the application was filed. The goods with which it is believed that Opposer did not have a bona fide intention to use the mark RED BULL at the time the application was filed include, but are not limited to, bleaching and detergents for laundry use, all purpose disinfectants, preparations for destroying vermin, fungicides and herbicides for domestic use, anti-skid chains, seat belts and shoulder harnesses, type writers, bond paper, computer ribbons, pen ink cartridges, plastic bubble wrap for packaging, printing type, whips, harnesses and saddlery, hangers for clothing, fishing rods, reels and tackle, meat extracts, dried and cooked preserved fruits and vegetables, edible oils and fats, tapioca, sago, motor car rental, and boarding house services.

33. On information and belief, upon reasonable reliance of the truth of Opposer's misrepresentations and false statements that it had a bona fide intention on using the mark on all the goods and services in Application Serial No. 75/979618, the Examiner allowed the mark for publication and eventual registration.

34. On information and belief, had the Examiner been aware that Opposer's claim that it had a bona fide intention to use the mark on all the goods and services in the application was false, the Examiner would have refused registration of the mark shown in Application Serial No. 75/979618.

35. Opposer's '093 Registration should be found to be void in its entirety based on fraud in view of the Opposer's false statements as to its bona fide intention to use the mark in the application for registration.

36. Applicant used the mark MATADOR in the United States in connection with tequila well in advance of the February 28, 1995 filing date of Application Serial No. 75/979618.

37. Although Applicant temporarily suspended use of the mark MATADOR, Applicant

intended to, and has in fact, resumed use of the mark. Hence, the mark was never abandoned.

38. Opposer has alleged a likelihood of confusion between Opposer's '093 mark and Applicant's mark MATADOR for "tequila."

39. If Opposer shows a likelihood of confusion between the marks MATADOR and Opposer's '093 Mark in this Opposition, Opposer's "093 Registration should be cancelled because Applicant has priority.

D. <u>Registration No. 2,579,008</u>

40. The Opposer relies on its ownership of Registration No. 2,579,008 ("Opposer's '008 Registration") as a basis for its Opposition against the Applicant's mark.

41. Opposer's '008 Registration covers the mark BULL in connection with "non-alcoholic beverages, namely, soft drinks; and energy and sports drinks"

42. On information and belief Opposer is not currently using the mark BULL in connection with the goods identified Opposer's '008 Registration.

43. On information and belief Opposer has not made use of the mark BULL in connection with the goods identified in Opposer's '008 Registration for at least the past three years.

44. On information and belief, Opposer has abandoned the mark shown in Opposer's '008 Registration through non-use or the abandonment of the mark.

45. Applicant used the mark MATADOR in the United States in connection with tequila well in advance of the January, 1987 first use date claimed in Opposer's '008 Registration.

46. Opposer has alleged a likelihood of confusion between Opposer's '008 Mark and Applicant's mark MATADOR for "tequila."

47. If Opposer shows a likelihood of confusion between the marks MATADOR and Opposer's '008 Mark in this Opposition, Opposer's '008 Registration should be cancelled because Applicant has priority.

WHEREFORE, Applicant-Petitioner believes that it is being and/or will be damaged by the continued subsistence of Opposer's '794, '272, '093 and '008 Registrations and respectfully requests that the Board grant the Applicant-Petitioner's counterclaim and cancel said registrations.

Respectfully submitted,

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

Date: October 14, 2008

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION (WITH CORRECTION OF TYPOGRAPHICAL ERROR) AND COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S REGISTRATION NOS. 2,579,008; 1,541,794; 1,935,272 AND 2,494,093** was served by first class mail, postage prepaid, this 14TH day of October, 2008 upon counsel for Opposer:

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MARIE-ANNE MASTROVITO