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

Proceeding	91204681
Party	Defendant Alibaba Group Holding Limited
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Date	08/13/2012
Attachments	Response to Motion To Strike.pdf (4 pages)(104441 bytes)

meet the high burden of showing that Applicant's allegations regarding: (1) the genus of Opposer's goods and services; (2) the strength of Opposer's ENTREPRENEUR-based marks ("Opposer's Marks"); or (3) the generic meaning of those marks; have no bearing on this case. Accordingly, the Board should deny the Motion.

Opposer claims that the allegations in paragraphs 2-44, 54-196, 201, 211, 221, 231, 240, 249, 258, 268, 287, 295, 304, 313, 323, and 331 of the counterclaim are extraneous, immaterial, and impertinent. But Opposer does not specifically address a single allegation. Nor does Opposer provide substantive or specific reasons supporting its argument. Rather, Opposer's sole support for its claim is the conclusory statement that these allegations ". . . are not targeted to the goods and services set forth in EMI's registrations." Applicant disagrees. The allegations are directly related to Opposer's claimed rights in Opposer's Marks, the scope of the goods and services purportedly covered by Opposer's registrations, and Applicant's genericness and descriptiveness counterclaims. *See e.g.*, Counterclaim ¶¶ 138 ("Opposer claims exclusive rights to the ENTREPRENEUR-based marks for all goods and services listed in Registration No. 2,263,883") and 201 ("The term 'entrepreneur' is a generic designation for the pursuit of business opportunities").

For example, Paragraphs 2-10 are relevant allegations relating to the strength of and generic nature of Opposer's Marks. Paragraphs 11-16 are relevant allegations relating to third-party use of Opposer's generic Marks. Paragraphs 17-44, 54-144, 152-173, and 175-195 are relevant allegations relating to the scope of the goods and services covered by Opposer's Marks. Specifically, these allegations aid in defining the genus of Opposer's claimed goods and services. *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 228 USPQ 528, 530 (Fed. Cir. 1986) (explaining that the first step in evaluating the genericness of a mark is determining the

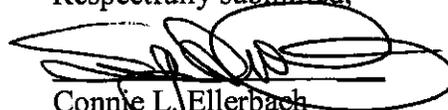
“genus” of the claimed goods and services.). Paragraphs 145-151, 174, 196, 240, 258, 295, 313, and 331 are relevant allegations as they further aid in defining the genus of Opposer’s claimed goods and services and the scope of Opposer’s claimed rights in Opposer’s Marks. And, Paragraphs 201, 211, 221, 231, 249, 268, 287, 304, and 323 are especially relevant allegations as they relate to the meaning of Opposer’s Marks and the public’s understanding that Opposer’s Marks are generic designations for the claimed goods and services. *Ginn*, 228 USPQ at 530. Clearly, Applicant’s allegations that Opposer’s Marks are generic are central issues in this case; Opposer’s arguments to the contrary are nonsensical. Thus, each of the allegations discussed above is relevant, has bearing on the issues in the case, and should not be stricken from the Applicant’s counterclaim.

Finally, regarding Opposer’s argument that Applicant’s counterclaim is in contravention of 37 CFR § 2.112(a), Applicant respectfully calls the Board’s attention to the fact that Opposer included nine registrations as grounds for its opposition to the Application. Applicant was compelled to address each of Opposer’s Registrations in the counterclaim; as such, the length of the counterclaim is warranted and not in contravention of § 2.112(a).

In light of the above, Applicant respectfully requests that the Board deny the Motion.

Dated: August 13, 2012

Respectfully submitted,



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PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Mountain View, California.

I am over the age of eighteen years and not a party to the within cause; my business address is 801 California Street, Mountain View, California 94041. On the date indicated below, I served the within Applicant's Opposition to Opposer's Motion to Strike Immaterial and Impertinent Matters from Counterclaims, on the interested parties in said cause, by placing a true copy thereof enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Mountain View, California, addressed as follows:

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I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 13th day of August, 2012.



Nanette Barranti