

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

GCP

Mailed: September 10, 2012

Opposition No. 91204681

Entrepreneur Media, Inc.

v.

Alibaba Group Holding Limited

**By the Trademark Trial and Appeal Board:**

This case now comes before the Board for consideration of opposer's motion (filed July 24, 2012) to strike certain allegations asserted in applicant's counterclaim on the ground that such allegations are not pertinent or relevant to applicant's asserted counterclaim of genericness and/or mere descriptiveness. The motion has been fully briefed.

Subsequent to the filing of the aforementioned motion, the Board, in its discretion, suggested that the issues raised in opposer's motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (3d ed. rev. 2012). The Board contacted counsel for the parties to determine the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 2:00 p.m. EDT on Thursday, September 6, 2012. The conference was held as scheduled among Mark Finkelstein and

Lucy Jewett Wheatley, as counsel for opposer, Eric Ball and Stephen R. Garcia, as counsel for applicant, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

**Opposer's Motion to Strike**

For the reasons discussed below, opposer's motion to strike is **GRANTED**, in part, and **DENIED**, in part.

As background, on April 11, 2012, opposer filed a notice of opposition against applicant's involved application for the mark NETREPRENEUR on the grounds of priority and likelihood of confusion and dilution. On May 21, 2012, applicant filed its answer to the notice of opposition. On June 11, 2012, applicant filed a motion to amend its answer to assert a counterclaim against opposer's nine pleaded registrations on the grounds of genericness and/or mere descriptiveness. By order dated June 15, 2012, the Board, *inter alia*, noted that applicant failed to submit the appropriate fee for its counterclaim and allowed applicant time to do so. On June 15, 2012, applicant filed a communication with the Board

authorizing the Board to deduct the appropriate fee for the counterclaim from applicant's counsel's deposit account. On July 3, 2012, the Board issued an order modifying its previous June 15, 2012 order to the extent that applicant's motion to amend its answer to assert a counterclaim was now deemed granted.

We now turn to opposer's motion to strike. In support thereof, opposer maintains that applicant's counterclaim consists of 44-pages, including 336 paragraphs of allegations. Opposer contends that the vast majority of these allegations are immaterial and impertinent to the counterclaim being asserted and should be stricken. In particular, opposer seeks to strike Paragraphs 2-44, 54-196, 201, 211, 221, 231, 240, 249, 258, 268, 297, 295, 304, 313, 323, and 331. Opposer argues that the aforementioned paragraphs are not targeted to the goods and services or registered marks set forth in opposer's pleaded registrations and, therefore, are not relevant to applicant's asserted counterclaim of genericness and mere descriptiveness. Instead, opposer contends that applicant's wide ranging allegations concern opposer's alleged "claims of exclusive rights" to each of the marks for goods and services broader than those specifically identified in opposer's pleaded registrations.

In response, applicant essentially argues that the allegations set forth in its counterclaim are directly related

to opposer's claimed rights in opposer's pleaded marks, the scope of the goods and services purportedly covered by opposer's pleaded registrations, and applicant's genericness and mere descriptiveness claims.

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP 506 (2d ed. rev. 2004). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Nonetheless, the Board grants motions to strike in appropriate instances.

As with any pleading, applicant's counterclaim should consist of a short and plain statement showing why applicant believes it will be damaged by the continued existence of opposer's pleaded registrations, as well as stating the ground(s) for cancellation. *See* Trademark Rule 2.112(a). As noted above, applicant's counterclaim consists of 44 pages, including 336 paragraphs of allegations. While we recognize that opposer has pleaded nine registrations and that applicant may assert allegations for cancellation on the grounds of genericness and/or mere descriptiveness against each one of

them, if appropriate, we nonetheless find that the amount of allegations asserted in applicant's counterclaim are excessive and unnecessary.

In order to state a proper claim of genericness, a plaintiff need only allege that the registered term is generic as applied to the **specific goods and services** for which it is registered. See, e.g., *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). Moreover, a claim of genericness must state that the mark, as a whole, is generic for the identified goods and/or services and not that a portion of the mark may be generic. Likewise, with regard to a claim of mere descriptiveness, a plaintiff need only allege that the mark is merely descriptive of the **specific goods and/or services identified in each registration** and, if the mark is registered under Section 2(f) of the Trademark Act, that the mark has not acquired distinctiveness. See 15 U.S.C. §§ 1052(e)(1) and *Yamaha Intern. Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

Keeping the foregoing in mind, the Board carefully reviewed applicant's counterclaim and agrees, in part, with opposer's contention that a vast majority of the allegations set forth in applicant's counterclaim are not directed to the specific goods and services recited in opposer's pleaded registrations or the subject marks identified therein or opposer's exclusive rights thereunder and, therefore, are not

pertinent to applicant's asserted counterclaim of genericness and mere descriptiveness. For example, Paragraphs 17-44 and 54-196 largely consist of allegations regarding opposer's alleged exclusive rights to the mark ENTREPRENEUR for goods or services broader than those specifically identified in opposer's pleaded registrations. Moreover, we note that applicant's allegations regarding opposer's exclusive rights to the mark NETREPRENEUR are impertinent to applicant's counterclaim inasmuch as opposer has not pleaded ownership rights, either by common law or by registration, for the mark NETREPRENEUR. Similarly, we find that the allegations set forth in Paragraphs 201, 211, 221, 231, 240, 249, 258, 268, 297, 295, 304, 313, 323, and 331 do not directly concern opposer's pleaded marks used in association with the specific goods and/or services identified in opposer's pleaded registration and, therefore, are immaterial to applicant's asserted claims of genericness and mere descriptiveness.

However, the Board does find that the allegations set forth in Paragraphs 2-16 in applicant's counterclaim are relevant and material to applicant's claims of genericness and/or mere descriptiveness and provide opposer with fuller notice of the basis for applicant's asserted counterclaim.

In view of the foregoing, opposer's motion to strike is **granted** with regard to Paragraph Nos. 17-44, 54-196, 201, 211, 221, 231, 240, 249, 258, 268, 287, 295, 304, 313, 323, and 331

and, therefore, these paragraphs are hereby stricken from applicant's counterclaim. Opposer's motion to strike, however, is denied with regard to Paragraphs 2-16 and, therefore, these allegations will remain part of applicant's pleading.

Proceedings herein are resumed. Trial dates, beginning with the deadline for the parties' discovery conference, are reset as follows:

Deadline for Discovery Conference	<b>October 8, 2012</b>
Discovery Opens	<b>October 8, 2012</b>
Initial Disclosures Due	<b>November 7, 2012</b>
Expert Disclosures Due	<b>March 7, 2013</b>
Discovery Closes	<b>April 6, 2013</b>
Plaintiff's Pretrial Disclosures Due	<b>May 21, 2013</b>
30-day testimony period for plaintiff's testimony to close	<b>July 5, 2013</b>
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	<b>July 20, 2013</b>
30-day testimony period for defendant and plaintiff in the counterclaim to close	<b>September 3, 2013</b>
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	<b>September 18, 2013</b>
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	<b>November 2, 2013</b>
Counterclaim Plaintiff's Rebuttal Disclosures Due	<b>November 17, 2013</b>
15-day rebuttal period for plaintiff in the counterclaim to close	<b>December 17, 2013</b>
Brief for plaintiff due	<b>February 15, 2014</b>
Brief for defendant and plaintiff in the counterclaim due	<b>March 17, 2014</b>

Brief for defendant in the  
counterclaim and reply brief, if any,  
for plaintiff due

**April 16, 2014**

Reply brief, if any, for plaintiff in  
the counterclaim due

**May 1, 2014**

In each instance, a copy of the transcript of  
testimony, together with copies of documentary exhibits,  
must be served on the adverse party within thirty days after  
completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark  
Rules 2.128(a) and (b). An oral hearing will be set only  
upon request filed as provided by Trademark Rule 2.129.