

ESTTA Tracking number: **ESTTA485273**

Filing date: **07/24/2012**

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

Proceeding	91204681
Party	Plaintiff Entrepreneur Media, Inc.
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Date	07/24/2012
Attachments	Motion to Strike.pdf ( 5 pages )(101623 bytes )

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

In the matter of Application No. 85,079,659  
For the mark NETREPRENEUR  
Filing date: July 7, 2010  
Published: December 13, 2011

ENTREPRENEUR MEDIA, INC.,

Opposer,

v.

ALIBABA GROUP HOLDING LIMITED,

Applicant.

Opposition No. 91204681

**ENTREPRENEUR MEDIA, INC.’S MOTION TO STRIKE IMMATERIAL AND  
IMPERTINENT MATTERS FROM COUNTERCLAIMS**

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and TBMP § 506, Registrant Entrepreneur Media, Inc. (“EMI”) moves the Board to strike all immaterial and impertinent allegations from the counterclaim brought by Alibaba Group Holding Limited (“Alibaba”).

Alibaba has purported to seek to cancel nine of EMI’s trademark registrations that consist of, or incorporate, ENTREPRENEUR, on the grounds of genericness and, as to certain of the marks, descriptiveness. A petition to cancel “must set forth a *short and plain statement* showing” the grounds for the petition. 37 CFR § 2.112(a) (emphasis added). Alibaba, in contravention of this rule, has filed a 44-page counterclaim, which includes 336 paragraphs of allegations.

The vast majority of these allegations is immaterial and impertinent to the counterclaims and should be stricken.

## **I. INTRODUCTION**

EMI filed this opposition proceeding regarding Alibaba's application to register the trademark NETREPRENEUR. In addition to answering the opposition, Alibaba has asserted counterclaims, contending that every mark EMI relied upon in its opposition should be cancelled.<sup>1</sup>

In its counterclaims, Alibaba has made numerous allegations that have nothing to do with whether EMI's marks are generic for their goods and services. Indeed, Alibaba has made wide ranging allegations in its 44-page counterclaim including that EMI "claims exclusive rights" to each of the marks for "services offered to entrepreneurs," for "business opportunity services," and for "business opportunity related goods." Of course, this Board must decide only whether EMI's marks are generic as applied to the goods and services described in the registrations. The extraneous allegations are immaterial and impertinent, and should be stricken.

## **II. ARGUMENT**

Pursuant to Rule 12(f) and TBMP § 506, the Board may strike from a pleading any material that is, *inter alia*, "immaterial" or "impertinent." While motions to strike are not favored, "the Board grants motions to strike in appropriate cases." TBMP § 506.01. This includes striking inappropriate allegations in a cancellation action. *E.g., Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990).

Alibaba seeks to cancel nine of EMI's trademarks that consist of, or incorporate, ENTREPRENEUR, under 15 U.S.C. §§ 1052(e)(1) and 1064(3). Under § 1052(e)(1), a mark should not be registered if it is merely descriptive or deceptively misdescriptive when used "on or in connection with the goods of the applicant." Under § 1064(3), a mark may be cancelled if,

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<sup>1</sup> The counterclaims were not part of Alibaba's original answer, and Alibaba moved to amend its answer to add the counterclaims, which motion was initially denied. Later, on July 3, 2012, the Board permitted the amendment.

among other things, the mark “becomes the generic name for the goods or services, or a portion thereof, for which it is registered.” Accordingly, under both sections, the inquiry is focused on the goods and services for which the subject mark is registered.

Alibaba alleges that EMI’s marks are generic for, or merely descriptive of, the goods and services for which its marks are registered. But Alibaba also includes a vast amount of allegations that are not targeted to the goods and services set forth in EMI’s registrations. Such allegations are immaterial and impertinent and should be stricken. Specifically, the allegations set forth in paragraphs 2-44, 54-196, 201, 211, 221, 231, 240, 249, 258, 268, 287, 295, 304, 313, 323, and 331, should be stricken.

It is important to strike these allegations now in order to ensure that this case will proceed on the narrow issues that are relevant to the opposition and the counterclaims. If Alibaba’s allegations remain intact, likely it will seek wide-ranging discovery on these irrelevant subjects, which will waste fees and probably will produce more motion practice for this Board.

### **III. CONCLUSION**

Alibaba’s counterclaim is not a “short and plain statement” showing the grounds for the relief requested. Rather, it is 44 pages long, consisting primarily of immaterial allegations. Those allegations, set forth in paragraphs 2-44, 54-196, 201, 211, 221, 231, 240, 249, 258, 268, 287, 295, 304, 313, 323, and 331, should be stricken.

Accordingly, EMI respectfully requests that the Board grant this motion and strike the offending paragraphs.

Respectfully submitted on July 24, 2012

By: /s/ Mark A. Finkelstein

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document entitled ENTREPRENEUR MEDIA, INC.'S MOTION TO STRIKE IMMATERIAL AND IMPERTINENT MATTERS FROM COUNTERCLAIMS has been served on Applicant, by placing a true copy thereof enclosed in sealed envelopes with postage thereon fully pre-paid, the United States mail at Irvine, 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 in Irvine, California, this 24<sup>th</sup> day of July, 2012.

/s/ Mark A. Finkelstein \_\_\_\_\_  
Attorney for Registrant