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

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Mailed: March 13, 2013

Opposition No. 91204861

Red Bull GmbH

v.

Jean Pierre Biane

By the Board:

This proceeding is before the Board for consideration of opposer's motion (filed October 10, 2012) to strike paragraphs 28-30 of applicant's September 27, 2012 first amended answer to opposer's first amended notice of opposition. The motion has been fully briefed.

The Board summarized the parties' pleadings and properties in its July 17, 2012 order; familiarity with the particulars is presumed. Of note, opposer pleads ownership of Registration No. 2829269, which is incontestable under Trademark Act Section 15, for a design mark (shown below) for "non-alcoholic beverages, namely, soft drinks, sports drinks, energy drinks" in International Class 32.[1]

[1] Registration No. 2829269, registered on the Principal Register April 6, 2004 based on Trademark Act § 44(e); partial § 8 affidavit accepted, and Section 15 affidavit acknowledged, April 8, 2010.

In paragraphs 28-30 of its amended answer to opposer's first amended notice of opposition, applicant set forth matters under the heading "Affirmative Defenses," including the following:

> 28. As a seventh and separate affirmative defense, Applicant is informed and believes, and on this basis asserts that Opposer's claim is barred from recovery because Opposer's mark is merely ornamental and does not function as a source identifier for Opposer's goods, or receives a severely reduced scope of protection.
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> 29. As an eighth and separate affirmative defense, Applicant is informed and believes, and on this basis asserts that Opposer's claim is barred from recovery because Opposer's mark is purely ornamental and does not function as a source identifier for Opposer's goods, or receives a severely reduced scope of protection.
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> 30. As a ninth and separate affirmative defense, Applicant is informed and believes, and on the basis asserts that Opposer's claim is barred from recovery because Opposer's mark is not inherently distinctive and has not acquired distinctiveness or secondary meaning, and thus does not function as a source identifier for Opposer's goods, or receives a severely reduced scope of protection.

Applicant did not file a counterclaim or a separate petition to cancel opposer's pleaded registration.

Opposer moved to strike each of these paragraphs on the basis that they set forth matters that are collateral attacks on opposer's pleaded registration which are permissible only as a compulsory counterclaim. Opposer maintains that applicant

should not be granted leave to amend inasmuch as the defenses he seeks to assert are legally untenable.

In response, applicant argues that paragraphs 28-30 set forth "permissible allegations that Opposer's mark is so weak and lacking in distinctiveness that the Board should severely restrict the scope of protection afforded to the mark at trial" (applicant's brief, p. 2). He maintains that the paragraphs are arguments "relevant to the strength of the mark, without amounting to a collateral attack on the validity of the mark" (applicant's brief, p. 2).

Analysis

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See* Fed. R. Civ. P. 12(f); TBMP § 506; *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973). The Board has the authority to strike an impermissible or insufficient claim or portion of a claim from a pleading. TBMP § 506.01. A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *Id.*

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 Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d

1289, 1292 (TTAB 1999) (citations omitted). The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id.* *See also* TBMP §§ 309.03 and 506.01. Thus, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See Harsco Corp. v. Electrical Sciences Inc.,* 9 USPQ2d 1570 (TTAB 1988).

Pursuant to Trademark Rule 2.106(b)(2)(ii),

> An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

Thus, the Board will not entertain an attack upon the validity of a registration pleaded by an opposer unless the applicant timely files a counterclaim or a separate petition to cancel the registration. *See also* TBMP § 506.01.

Opposer's pleaded registration is entitled to the presumption of validity as provided in Trademark Act Section 7(b), 15 U.S.C. § 1057(b), including the presumption that the mark has overcome any inherent nondistinctiveness. *In re H & H Products*, 228 USPQ 771, 773 (TTAB 1986); *see also* TBMP § 704.03(b)(1)(A). Moreover, opposer's registration has become incontestable pursuant to Trademark Act Section 15, and is conclusive evidence of the validity of the mark and its registration, of opposer's ownership thereof, and of

opposer's exclusive right to use the mark in commerce on or in connection with the identified goods and services, subject to limited defenses and exceptions. Trademark Act Section 7(b).

Also under Section 7(b), a registration affords prima facie rights in a mark *as a whole.* In contrast, a showing of descriptiveness or genericness of part of a mark does not constitute an attack on the registration. *See Sweats Fashions Inc. v. Pannill Knitting Co. Inc.,* 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987; *Tea Board of India v. Republic of Tea Inc.,* 80 USPQ2d 1881, 1884 n.5 and n.12 (TTAB 2006). Here, the allegations in paragraphs 28-30 are directed to opposer's pleaded registration *as a whole.* None of the allegations specify or identify only a part or portion of opposer's registered mark. The allegations in each of the paragraphs at issue assert that opposer's mark - due to being "merely ornamental" or "purely ornamental" or "not inherently distinctive" without acquired distinctiveness - does not function as a source identifier. Moreover, it is apparent from the record that opposer's mark consists of one composite design mark. Thus, the allegations amount to assertions that the mark, as a whole, is invalid. *See, e.g., Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007) (applicant's contentions in its brief that opposer's marks

are functional, non-distinctive, and lack source-indicating significance constitute an impermissible collateral attack on opposer's pleaded registrations, and cannot be considered absent a counterclaim for cancellation).[2] Accordingly, the allegations are impermissible, as an attack on opposer's registration.

Applicant expresses concern that he "should be permitted to allege and prove that Opposer's mark is merely or purely ornamental and almost completely lacking in distinctiveness, which is relevant to the strength factor in the likelihood of confusion analysis" (applicant's brief, p. 4). Indeed, the determination of likelihood of confusion under Trademark Act Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors ("*du Pont* factors") bearing on the issue which are set forth in *In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973)*. *See also, In re Majestic Distilling Co., Inc.,* 315 F.3d 1311, 65 UPSQ2d 1201, 1203 (Fed. Cir. 2003). Furthermore, whether a mark is or is not weak, and the wide or narrow scope of protection to which it is entitled, are relevant inquiries under this analysis. *See King Candy Co. v. Eunice King's Kitchen,*

[2] Moreover, certain attacks on a Principal Register registration that is over five years old are time-barred. To the extent that applicant seeks to assert that opposer's registered mark is invalid because it is merely descriptive or ornamental and lacks

Inc., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). To the extent that applicant seeks to pursue a position of the general nature that opposer's mark is weak and is deserving of a limited scope of protection in the context of likelihood of confusion, applicant, through the paragraphs at issue, has placed opposer on early notice of his position, and is permitted to set forth his position, as well as any probative and properly introduced evidence in support thereof, at trial or on summary judgment. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007) (defendant's argument that plaintiff's registered marks are descriptive can only be considered in a timely counterclaim or separate petition to cancel, but to the extent that applicant's position goes to the strength of opposer's marks the Board will consider such argument and evidence).

Applicant's request, in the alternative, for leave to file an amended answer excluding in each paragraph at issue the language "does not function as a source identifier for Opposer's goods" is noted. Under the proposed amendments, the core allegations remain the same, and are likewise directed to opposer's registered mark as a whole. The proposed amendments would not give rise to assertions that do not constitute a collateral attack on the validity of opposer's registration;

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inherent or acquired distinctiveness, such assertion is time

hence, they would not overcome the directive of Trademark Rule 2.106(b)(2)(ii).[3]

In summary, the matters set forth in paragraphs 28-30 of applicant's first amended answer to opposer's first amended notice of opposition constitute a collateral attack on the validity of opposer's pleaded registration, which must be brought by way of a counterclaim. Trademark Rule 2.106(b)(2)(ii). Accordingly, opposer's motion to strike the paragraphs is granted.

Schedule

Proceedings are hereby resumed. Conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for Required Discovery Conference	**4/12/2013**
Discovery Opens	4/12/2013
Initial Disclosures Due	5/12/2013
Expert Disclosures Due	9/9/2013
Discovery Closes	10/9/2013
Plaintiff's Pretrial Disclosures due	11/23/2013
Plaintiff's 30-day Trial Period Ends	1/7/2014
Defendant's Pretrial Disclosures due	1/22/2014
Defendant's 30-day Trial Period Ends	3/8/2014
Plaintiff's Rebuttal Disclosures due	3/23/2014
Plaintiff's 15-day Rebuttal Period Ends	4/22/2014

barred. Trademark Act Section 14.

[3] It is noted that inasmuch as opposer included with its pleading a copy of Registration No. 2829269 generated from the TSDR database, opposer is not required to prove acquired distinctiveness of its mark. *See* Trademark Rule 2.122(d)(1); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d at 1626.

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 the taking of testimony. Trademark Rule 2.l25.

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.l29.