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

Proceeding	91204861
Party	Plaintiff Red Bull GmbH
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**CERTIFICATE OF ELECTRONIC FILING AND  
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I hereby certify that Opposer's Reply in Support of its Request for Discovery to Respond to Applicant's Motion for Summary Judgment is being filed with the TTAB via ESTTA on the date set forth below.

Date: September 9, 2013

/Leah Z. Halpert/  
Leah Z. Halpert

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

RED BULL GMBH,	)	
	)	
Opposer,	)	Opposition No.: 91-204,861
	)	
v.	)	Mark: ANDALE! ENERGY DRINK
	)	& Design
JEAN PIERRE BIANE	)	Serial No.: 85/334,836
	)	
Applicant.	)	

**OPPOSER'S REPLY IN SUPPORT OF ITS REQUEST FOR DISCOVERY NECESSARY  
TO RESPOND TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

Opposer, RED BULL GMBH ("Opposer"), submits this reply brief in support of its Request for Discovery Necessary to Respond to Applicant, JEAN PIERRE BIANE's ("Applicant") Motion for Summary Judgment ("Discovery Request"). As Applicant's arguments in its Brief in Response to the Discovery Request ("Applicant's Response") are flawed, incorrect, or bolster Opposer's position, Opposer respectfully requests that the Board grant Opposer's Discovery Request so that Opposer can proceed with effectively responding to Applicant's Motion for Summary Judgment ("MSJ").

**A. Opposer's Discovery Request Does Not Argue Its Opposition to the MSJ but Rather Explains Why Discovery is Necessary.**

Applicant's Response focuses on a misplaced assumption that Opposer has fully and effectively argued its opposition to the MSJ within the Discovery Request. However, the Discovery Request only pertains to the limited scope of necessary discovery Opposer is seeking – specifically focusing on the first *Du Pont* factor alone – and specifically details the necessary facts needed and why the requested deposition of Mr. Biane is warranted (as required by the

Trademark Rules). While anyone could potentially develop an argument against a MSJ without discovery or evidence, doing so would be highly ineffective as any such arguments would amount to merely disagreeing on facts rather than presenting adequate support for a countering position. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) (motion for summary judgment granted and upheld when the opposition thereto was merely a disagreement with the facts presented rather than presenting contradictory facts). Here, without the necessary discovery, Opposer is left without the ability to obtain countering evidence to rebut the evidence presented by Applicant (as without the requested discovery, Opposer is entirely unaware of the facts upon which the Declaration of Jean Pierre Biane relies) and is, thus left with only unsupported disagreements to the MSJ.

What Applicant incorrectly assumes to be Opposer's argument to the MSJ is actually an explanation of why the requested discovery is needed. According to Trademark Law, a party moving for summary judgment has the burden to demonstrate the absence of any genuine dispute of material fact. *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998); TBMP § 528.01. In order to meet this burden, the moving party must support its motion with affidavits or other evidence which, if unopposed, would establish right to judgment. TBMP § 528.01. Therefore, in order to adequately oppose the MSJ, Opposer necessarily will need to oppose the evidence provided to support the motion (rather than simply disagreeing with any factual assertions within the MSJ), and proffer countering evidence to show that there is a genuine factual dispute for trial. Fed. R. Civ. P. 56(c)(1); *Octocom Systems, Inc.*, 16 USPQ2d at 1786. As such, Opposer's discussion in the Discovery Request that the Declaration of Jean Pierre Biane is the only evidence provided to support Applicant's MSJ does not go to the adequacy of the declaration, but rather narrows the focus of the discovery sought to the statements made in the declaration (again, as required by Trademark Law).

Further, as Applicant explains in Applicant's Response, the assertions and opinions of Applicant in the Declaration of Jean Pierre Biane are "legal conclusions and the ultimate facts of

this case,” Applicant’s Response at 5, without any actual underlying facts or evidence to support such “conclusions”<sup>1</sup>. Without deposing Mr. Biane and first understanding the evidence Applicant is attempting to present – something that only Mr. Biane would know as he is the source of these “legal conclusions”<sup>2</sup> – Opposer is unable to effectively provide countering evidence in order to meet its burden. At this point, Opposer can only counter the MSJ with conclusory statements that merely disagree with the “facts” within the MSJ; an ineffective response as such mere disagreements do not rise to the level of persuasive evidence by simply being put in the opposition to the MSJ or placed in an affidavit. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987).

Applicant would like the Board to believe that the MSJ and Opposer’s forthcoming opposition thereto, should only be based on the attorney’s arguments alone, without any supporting evidence. However, as stated above, neither party can meet their respective burdens without providing evidence to support their arguments. Unlike the arguments in Applicant’s Response, Opposer did not make its opposition to the MSJ in the Discovery Request, but rather explained the reasons behind the need to depose Mr. Biane as well as accepted Applicant’s limitation of the issue at hand to the first *Du Pont* factor in an effort to limit the scope of the discovery needed.

**B. Opposer is Not Requesting “Discovery for Discovery’s Sake”**

Applicant’s Response further misunderstands the Discovery Request by overbroadening

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<sup>1</sup> Throughout Applicant’s Response, Applicant’s attorney attempts to incorporate underlying facts and circumstances upon which he claims the statements in Jean Pierre Biane’s Declaration were based – an action that ultimately concedes that such necessary information was lacking initially, and bolsters Opposer’s position that discovery to uncover such evidence is necessary in this case. See Applicant’s Response at 6 (“it is clear that the opinions set forth in Applicant’s Declaration are *wholly* based on Applicant’s visual comparison of the marks side-by-side”); See also Applicant’s Response at 7 (“Applicant submits herewith *Exhibit A* copies of dictionary definitions of “trapezoid”, “rectangle” and “circle”). However, these are simply claims of the attorney, and without deposing Mr. Biane, Opposer cannot actually ascertain the evidence upon which Mr. Biane’s opinions, “legal conclusions and ultimate facts” are based.

<sup>2</sup> Applicant’s Response is completely nonsensical when asserting that the basis of Applicant’s opinions in the Declaration of Jean Pierre Biane are outside of Applicant’s control – after all, it is directly within Applicant’s control to form the opinions and conclusions therein. The Requested Discovery is narrowly focused to determine what Applicant, himself, used as the basis of his own opinions and conclusions. If this is not within his control, then there are more serious issues with the Declaration than the fact that Opposer needs some additional discovery to effectively respond to the MSJ.

and mischaracterizing it as impermissible “discovery for discovery’s sake”. Applicant’s Response at 3, 5. All of Applicant’s support for this notion is irrelevant to the matter at hand, as in each of those cases the discovery sought was general, broad and related to the issue overall, rather than being narrowly tailored as Opposer’s Discovery Request is here. As explained above and in the Discovery Request, Opposer is not requesting to depose Mr. Biane on all aspects of likelihood of confusion, or on anything beyond the scope of what is necessary. Rather, Opposer conceded that the MSJ relates only to the first *Du Pont* factor, and as such the required deposition will focus only on this factor as well. Further, Opposer explains that the deposition, limited to Mr. Biane’s assertions in his Declaration, necessarily will uncover the actual facts upon which his opinions were based. Only by doing so can Opposer then provide countering evidence (rather than simply disagreeing statements) that would lead to a different conclusion to the one presented in the MSJ, thus creating a genuine issue of material fact. It is clear that the information sought through the requested deposition of Mr. Biane (again, as Mr. Biane is the only person in control of the facts and evidence he used to support the conclusions he asserted in his Declaration) is the only manner through which Opposer can obtain the necessary evidence that could reasonably create a genuine issue of material fact.

**C. Applicant’s Reliance on the *Nutri Leche* Case is Entirely Misplaced**

Finally, Applicant’s reliance on the case, *Cytosport, Inc. v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 2011 TTAB LEXIS 325 (non-precedential) (hereinafter “*Nutri Leche*”) is misplaced. In fact, upon even a cursory reading of the cited decision or a brief look at the case history on TTABView, it is clear that the instant Discovery Request is highly distinguishable from the *Nutri Leche* case.

In *Nutri Leche*, the applicant responded to a motion for summary judgment by simultaneously filing both an extensive opposition to the motion (complete with its countering evidence), as well as a separate Rule 56(d) request for necessary discovery. Here, as explained previously, Opposer has not submitted any opposition to the MSJ as of yet, as it simply cannot

effectively respond without the deposition as discussed in the Discovery Request. As such, it is clear by the arguments above and those in the Discovery Request, that unlike *Nutri Leche*, Opposer cannot substantively oppose the MSJ without first obtaining the necessary discovery.

Further, the applicant in *Nutri Leche* attempted to use its Rule 56(d) motion to obtain responses to all outstanding discovery requests served including requests surrounding elements of likelihood of confusion that were not at issue in the summary judgment motion – the definition of “discovery for discovery’s sake”. In this case, however, as discussed above and in the Discovery Request, the discovery sought is narrowly tailored to the sole deposition of Mr. Biane to inquire about the facts and circumstances surrounding the “legal conclusions” made in his declaration. The responses obtained from this deposition will allow Opposer to understand the actual evidence at issue (rather than just the unsupported conclusions) and obtain countering evidence, thus presenting a genuine issue of material fact in its opposition to the MSJ. As the surrounding circumstances for the *Nutri Leche* case and the instant Discovery Request are so drastically different, Applicant’s reliance on the *Nutri Leche* case is entirely misplaced.

#### **D. Conclusion**

For the reasons stated above, in addition to those presented in the Discovery Request, Opposer respectfully requests that the Board grant Opposer’s Request for Discovery to Respond to Applicant’s Motion for Summary Judgment, or alternatively, deny Applicant’s Motion for Summary Judgment.

Date: September 9, 2013

Respectfully submitted,  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF ITS REQUEST FOR DISCOVERY NECESSARY TO RESPOND TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT** is being served on September \_\_, 2013, by first class mail, postage prepaid on Applicant's Correspondent of Record at the Correspondent's address of record below, with courtesy copy via email to [Paulo@patelalmeida.com](mailto:Paulo@patelalmeida.com) and [Alex@patelalmeida.com](mailto:Alex@patelalmeida.com):

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