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PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: August 19, 2014

Opposition No. 91204861

Red Bull GmbH

v.

Jean Pierre Biane

Opposition No. 91210860

Red Bull GmbH

v.

Andale Energy Drink Co., LLC

**Before Seeherman, Cataldo and Bergsman,
Administrative Trademark Judges.**

By the Board:

This case now comes before the Board for consideration of applicant Andale Energy Drink Co., LLC's (Andale) motion, filed April 15, 2014, for partial judgment on the pleadings. The motion is fully briefed.

Background

By way of background, Andale seeks to register two marks. The following mark is at issue in the motion for judgment on the pleadings (the ‘359 Application):¹



The same opposition proceeding (No. 91210860) also involves the following mark (the ‘316 Application):²



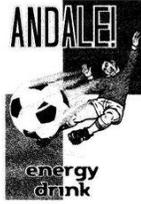
The Board consolidated this case with one in which Jean Pierre Biane seeks to register the following mark (the ‘836 Application),³ in part because of his business relationship with Andale:⁴

¹ Application Serial No. 8546359, filed June 7, 2012 for “Non-alcoholic beverages, namely, energy drinks, energy shots, sports drinks, soft drinks, and bottled water” in Class 32, based on Trademark Act § 1(b).

² Application Serial No. 8546316, filed June 7, 2012 for “Non-alcoholic beverages, namely, energy drinks, energy shots, sports drinks, soft drinks, and bottled water” in Class 32, based on Trademark Act § 1(b).

³ Application Serial No. 85334836, filed June 1, 2011 for “energy drinks” in Class 32, claiming dates of first use and first use in commerce of March 23, 2011.

⁴ In its motion for consolidation, opposer stated in a footnote that Mr. Biane is the owner/managing member of Andale Energy Drink Co., LLC, such that “all three applications are effectively owned by the same party.” (Opp. motion to consolidate (6 TTABVue 3 n. 1).



In both oppositions, opposer claims ownership of the following mark:⁵



The Board previously denied Mr. Biane’s motion for summary judgment in Opposition No. 91204861 on the ground of likelihood of confusion, because the Board found that the evidence submitted by opposer showed there were genuine disputes of material fact regarding how consumers would perceive the design elements of the marks shown in the ‘836 application and opposer’s registration.⁶

Motion for Judgment on the Pleadings

Andale seeks judgment on the pleadings as to the grounds of likelihood of confusion and false suggestion of a connection with regard to the ‘359 application. Andale maintains, and concedes for the purposes of the motion, that even viewing

⁵ Registration No. 2829269, registered April 6, 2004 for, “Non-alcoholic beverages, namely, soft drinks, sports drinks, energy drinks” in Class 32 based on Trademark Act § 44(e). Opposer made this registration of record by filing with its notices of opposition a copy taken from the USPTO’s electronic data base, showing status and title. A Section 8 affidavit as to these goods in Class 32 was accepted, and receipt of a Section 14 affidavit was acknowledged. The registration was cancelled as to Classes 25 and 33, and cancelled as to certain of the goods in Class 32.

⁶ Board’s order of December 19, 2013. The motion for summary judgment had been filed in Opposition No. 91204861 prior to consolidation.

all other *du Pont* factors in opposer's favor, the dissimilarities between the marks are so great that there can be no likelihood of confusion under Trademark Act § 2(d), or false suggestion of a connection under Trademark Act § 2(a). Andale argues that the dominant features of its mark, the word "ANDALE!" across a rectangular flag background and the picture of a soccer player kicking a ball, do not appear in opposer's mark and that the marks are completely different in appearance, sound, meaning and commercial impression. In support of its argument, Andale cites to *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), for the proposition that where the dissimilarities of the marks are so great, the Board may conclude that there can be no likelihood of confusion as a matter of law.

Opposer argues that sufficient allegations remain in the complaint, which allegations are deemed true for purposes of the motion, such that material issues remain.⁷ Opposer contends that, even focusing solely on the first *du Pont* factor of similarity of the marks, genuine disputes of material fact remain as to whether the public would be confused by Andale's use of such a "substantially similar" background design in its mark. Opposer argues that the mark shown in its registration consists of a rectangle with opposing shaded or colored panels, and Andale's mark is also a rectangle with "identical opposing shaded or colored panels" that are so similar the public may be confused as to the source of the

⁷ Opposer also argues Andale's reliance on *Kellogg Co. v. Pack'em Enterprises, Inc.* is misplaced as the *Kellogg* case presents a standard for summary judgment, not one for a motion for judgment on the pleadings. However, the Board has applied such an analysis in the context of a motion for judgment on the pleadings. *See Ava Enter., Inc. v. P.A.C. Trading Group*, 86 USPQ2d 1659, 1661 (TTAB 2008).

goods. Opposer argues that its long-term continuous use of its graphics mark, together with extensive promotion and advertising, have made its mark well-known and famous in the United States for energy drinks and related beverages. Opposer notes that it cannot present evidence regarding the *du Pont* factors on a motion for judgment on the pleadings, but such evidence would support its contention that genuine disputes of material fact remain. Opposer also argues that Andale's motion does not address the Section 2(a) claim.

In reply, Andale argues a claim of false suggestion of a connection "deals with similarities between the marks" and if applicant's mark is not the same or a close approximation of opposer's mark there can be no false suggestion of a connection.

Analysis

A motion for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c) is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion, all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied, or which are taken as denied, are deemed false. Conclusions of law are not taken as admitted. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ2d 1048 (TTAB 1992). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.* A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine dispute

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of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Id.*

As noted, opposer attached a copy of an electronic TSDR report from the USPTO website for its Registration No. 2829269 to its notice of opposition; thus, priority is not at issue in this case. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Moreover, for purposes of this motion, Andale does not dispute opposer's priority.

The similarity or dissimilarity of the marks must be analyzed by comparing the marks in their entireties, as to appearance, sound, connotation and commercial impression. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Whether letters or designs will dominate in a composite mark comprised of words and designs such as that shown in Andale's application will depend on the marks and circumstances of the case. *See National Steel Constr. Co. v. Matsushita Elec. Indus. Co.*, 158 USPQ 464, 467 (TTAB 1968) (when comparing composite marks dominance of words or design elements may be controlling in the likelihood of confusion analysis), *aff'd* 442 F.2d 1383, 170 USPQ 98, 100 (CCPA 1971). Further, no element of a mark can be ignored when analyzing the likelihood of confusion issue. *In re Electrolyte Labs., Inc.*, 929 F.2d 645, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990), *citing Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974).

In comparing the two marks here, we note the description in the application record for Andale's mark states, "[t]he mark consists of a rectangular flag consisting of shaded streaks with one un-shaded streak crossing the flag diagonally from the top left corner to the bottom right corner of the flag; a soccer player appears kicking a soccer ball in the center of the flag, with the word "ANDALE!" appearing above the soccer player in shaded letters with un-shaded outlining." Opposer's registration is for a design mark of shaded rectangles, with no words and no figures. Andale's mark, on the other hand, features the word ANDALE! and the figure of a soccer player kicking a ball. If Andale's mark were to be seen as an overall rectangular flag, as stated in the description, the marks convey very different commercial impressions, as opposer's mark would not in any circumstances be viewed as a rectangular flag. Further, to the extent that Andale's mark is viewed as having separate color blocks, thereby making it more similar to opposer's mark, there are still significant differences. Unlike opposer's mark, the color blocks are not symmetrical and they have jagged edges, suggesting paint carelessly applied by a paint brush. Moreover, they serve to bookend the word and soccer figure, so that the eye is drawn to the word ANDALE! and the figure of a soccer player. We find that, while both marks consist at least in part of opposing color blocks, the overall impression is of dissimilar marks. Even if opposer were to show that its mark is famous, and even if all the other *du Pont* factors were to be considered in opposer's favor, including the similarity of the goods, channels of trade and classes of consumers, the marks

in this case are simply too dissimilar to support a finding of likelihood of confusion. *See Kellogg*, 14 USPQ2d at 1550 (dissimilarity of marks outweighed all other *du Pont* factors, even if opposer were to offer evidence of mark's fame).

In order to prove a § 2(a) claim for false suggestion of a connection, the opposer must show the following:

- 1) applicant's mark is the same as or a close approximation of opposer's previously used name or identity;
- 2) applicant's mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to opposer;
- 3) opposer is not connected with the goods that will be sold by applicant under its mark; and
- 4) opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on applicant's goods, a connection with opposer would be presumed.

See In re Pedersen, 109 USPQ2d 1185, 1188 (TTAB 2013); *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012). *See also University of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983); *Board of Trs. of Univ. of Ala. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013).

As the marks are too dissimilar to find a likelihood of confusion, opposer cannot prove the first element of the false suggestion of a connection claim, and the ground of false suggestion of a connection also fails. *See Boston Red Sox v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008)(where dissimilarity of marks is dispositive in likelihood of confusion analysis, mark fails stricter first element of false suggestion test).

In view thereof, Andale's motion for judgment on the pleadings is **granted**.
Opposition No. 91210860 is dismissed as to Application No. 85646359.

Schedule

During the time this case was suspended for consideration of the motion decided herein, Andale submitted on April 25, 2014, a motion for judgment on the pleadings as to its '316 application and Mr. Biane's '836 application.⁸ Consideration of the motion was deferred by the Board's order of May 5, 2014, as the motion was filed while this proceeding was suspended. In that order, the Board allowed applicants Andale and Biane to file a renewed motion after proceedings were resumed.

The Board notes, however, that a genuine dispute of material fact was already found to exist as to Mr. Biane's '836 application, specifically on the issue of the similarity of the marks.

Proceedings are resumed. Bearing in mind the Board's prior decision regarding the '836 application, and the requirements of Fed. R. Civ. P. 11(b) and USPTO Rule 11.18(b), Andale may refile its motion if grounds for renewal of the motion still exist.

Dates are otherwise reset as set out below.

Plaintiff's Pretrial Disclosures Due	9/18/2014
Plaintiff's 30-day Trial Period Ends	11/2/2014

⁸ The filing was made via the Board's ESTTA system in the parent case. The ESTTA cover sheet indicates Biane as the filer, while the opening sentence of the motion indicates it is filed by Andale. The motion seeks judgment on the pleadings as to Mr. Biane's '836 application and Andale's '316 application. The motion is signed by the attorney representing both applicants.

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Defendant's Pretrial Disclosures Due	11/17/2014
Defendant's 30-day Trial Period Ends	1/1/2015
Plaintiff's Rebuttal Disclosures Due	1/16/2015
Plaintiff's 15-day Rebuttal Period Ends	2/15/2015

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 2.125.

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.
