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

Proceeding	91208003
Party	Defendant Michael F. Ball
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RED BULL GMBH,	)	
	)	
Opposer/Respondent,	)	
	)	
v.	)	Opposition No. 91208003
	)	
MICHAEL F. BALL,	)	
	)	
Applicant/Petitioner.	)	

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**APPLICANT/PETITIONER’S RESPONSE IN OPPOSITION  
TO OPPOSER/RESPONDENT’S RENEWED MOTION TO SUSPEND**

Michael F. Ball (“Applicant/Petitioner”) hereby opposes Red Bull GmbH’s (“Opposer/Respondent”) July 26, 2013 Renewed Motion to Suspend Opposition No. 91208003 (the “July 26, 2013 Motion”).

As set forth in more detail below, the July 26, 2013 Motion should be denied because (1) it is untimely in light of the Board’s June 28, 2013 Order, (2) it is moot in light of the Board’s June 20, 2013 Order in *ex parte* appeals for U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334, and (3) judicial economy favors the disposition of this proceeding and Applicant’s counterclaim petition to cancel Opposer/Petitioner’s Reg. No. 3,939,863 – RED.

**I. The July 26, 2013 Motion Is Untimely Per The Board’s June 28, 2013 Order**

On June 28, 2013, the Board issued an order ruling on Opposer/Respondent’s January 18, 2013 Motion to Strike. The Board ordered Opposer/Respondent “to replead its notice of opposition to specifically identify the registrations upon which it bases its claim of priority and likelihood of confusion, failing which any references to its “Federal registrations” will be stricken.” Board’s June 28, 2013 Order, TTABVUE No. 10 at 3.

The Board’s June 28, 2013 Order noted that:

*Opposer’s motion (filed June 19, 2013) to suspend this proceeding pending disposition of applicant’s ex parte appeals is noted but has been given no consideration as it*

*contravenes the suspension order of February 27, 2013. Further, the Board will not consider a renewed motion to suspend prior to opposer's amendment, if any, to its notice of opposition in accordance with this order and applicant's response thereto.*

Board's June 28, 2013 Order at P. 4, Note 1.

On July 15, 2013, Opposer/Respondent filed an Amended Notice of Opposition, which for the first time, identified its U.S. Reg. No. 3,939,863 – RED. Applicant/Petitioner timely filed its Answer, Affirmative Defenses and Counterclaim Petition to Cancel U.S. Reg. No. 3,939,863 on August 14, 2013 in compliance with the Board's June 28, 2013 Order.

Because Opposer/Respondent's July 26, 2013 Motion was filed before Applicant/Petitioner's August 14, 2013 Answer, Affirmative Defenses and Counterclaim, it is untimely in light of the Board's June 28, 2013 Order and should therefore be denied.

**II. The July 26, 2013 Motion Moot Is In Light Of The Board's June 20, 2013 Order**

On June 20, 2013, the Board suspended the *ex parte* appeals in U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334. One of the issues in these appeals is the question of likelihood of confusion with U.S. Reg. No. 3,939,863.

Opposer/Respondent indicates that the question of likelihood of confusion between Applicant/Petitioner's +RED marks and Opposer/Respondent's prior-registered marks in Class 32 is central to both the *ex parte* appeals and this opposition. Opp'r/Resp't Mot. TTAB No. 12 at 2. Opposer/Respondent further indicates that if likelihood of confusion is found in one situation then likelihood of confusion will necessarily be found in the other. *Id.*

This is not the case, as Opposer/Respondent ignores the fact or mistakenly contends that

- (1) Applicant/Petitioner's here opposed U.S. Trademark Applications Serial Nos. 85/400,933, 85/400,941, 85/400,955 and 85/406,652 were not refused registration by the Office — none of Opposer/Respondent's pleaded registration were cited against these applications;
- (2) though Opposer/Respondent quite mistakenly identifies Applicant/Petitioner's "six +RED formative marks" as "+RED and various descriptive terms," Opp'r/Resp't Mot. TTAB

No. 12 at 1, the Office has not held any of the words of the composite +RED marks as descriptive except for the word RED<sup>1</sup>;

(3) only Opposer/Respondent's U.S. Reg. No. 3,939,863 was cited against

Applicant/Petitioner's U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334

— none of Opposer/Respondent's other pleaded registrations were raised in the *ex parte* appeals<sup>2</sup>; and

(4) Applicant/Petitioner is entitled to challenge the validity of Opposer/Respondent's U.S. Reg. No. U.S. Reg. No. 3,939,863 and has done so in its August 14, 2013 counterclaim Petition for Cancellation<sup>3</sup>.

The Board has previously recognized the merit of suspending the *ex parte* appeal pending disposition of the instant proceeding in its June 20, 2013 Order. Since Opposer/Respondent only properly identified its pleaded U.S. Registrations (including U.S. Reg. No. 3,939,863) as a basis for opposition in its July 15, 2013 Amended Notice of Opposition, Applicant/Petitioner has now taken its first legitimate opportunity to petition to cancel U.S. Reg. No. 3,939,863 through its mandatory counterclaim.

The foresight of the June 20, 2013 Orders should be recognized and the July 26, 2013 Motion should be denied as moot.

### **III. Judicial Economy Favors The Disposition Of This Proceeding**

Opposer/Respondent urges the Board to lift the suspension of the appeals, and instead grant its motion to suspend the instant opposition pending the disposition of the appeals for reasons of judicial economy. Applicant/Opposer questions the spirit of judicial economy where Opposer/Respondent has already filed three motions, two of which would have required two Board orders reinstating *ex parte*

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<sup>1</sup> Applicant/Petitioner's August 14, 2013 counterclaim seeks cancellation of U.S. Reg. no. petitioned to cancel U.S. Reg. No. 3,939,863, in part, on grounds of mere descriptiveness.

<sup>2</sup> It seems logical that Opposer/Respondent would challenge these applications if the appeals are successful and the Board would find the parties before it again *inter partes*.

<sup>3</sup> Because the appeals are *ex parte*, they do not afford Applicant/Opposer the option to challenge the cited registration. Instead, this *inter partes* proceeding is the proper forum for disposition of such a challenge.

appeals where one of, if not the seminal issue before the Board, is the viability of U.S. Reg. No. 3,939,863.

Applicant/Petitioner further questions the spirit of judicial economy behind the July 26, 2013 Motion in that this proceeding has not yet made it to the mandatory discovery/settlement conference. At such conference the parties will be required to discuss settlement and the possibility of Accelerated Case Review (ACR), which has the very certain potential to truncate proceedings that Opposer/Respondent suggests will “inevitably likely take years.” Opp’r/Resp’t Mot. TTAB No. 12 at 2.

It is Applicant’s counterclaim for cancellation of Opposer/Respondent’s U.S. Reg. No. U.S. Reg. No. 3,939,863 that has the potential to be dispositive of both these proceedings and the suspended *ex parte* appeals. As such, judicial economy favors disposition of these proceedings and the July 26, 2013 Motion should be denied as moot.

**IV. Conclusion**

In view of the foregoing, Applicant/Petitioner requests that the July 26, 2013 Motion be denied.

Respectfully submitted,

MICHAEL F. BALL



Date: August 15, 2013

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing APPLICANT/PETITIONER'S RESPONSE IN OPPOSITION TO OPPOSER/RESPONDENT'S RENEWED MOTION TO SUSPEND has been served by first-class mail, postage prepaid, on counsel for Opposer/Respondent, as follows, this 15th day of August 2013 as follows:

Martin R. Greenstein  
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