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

Proceeding	91208003
Party	Plaintiff Red Bull GmbH
Correspondence Address	Martin R. Greenstein TechMark a Law Corporation 4820 Harwood Road, 2nd Floor San Jose, CA 95124 UNITED STATES MRG@TechMark.com, LZH@TechMark.com, MPV@TechMark.com, AMR@TechMark.com
Submission	Reply in Support of Motion
Filer's Name	Leah Z Halpert
Filer's e-mail	MRG@TechMark.com, LZH@TechMark.com, AMR@TechMark.com
Signature	/Leah Z Halpert/
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Attachments	Michael Ball RED Applns-91208003-Reply in Support of Renewed Mtn to Suspend.pdf(26219 bytes )



*accordance with this order and applicant's response thereto.*" Opposer amended its Notice of Opposition on July 15, 2013, and Opposer's Renewed Motion was filed on July 26, 2013. While it is true that Applicant's amended answer and counterclaim were filed on August 14, 2013, the Board does not "consider" a motion until it is fully briefed (or until after passage of a sufficient time for filing and receipt of a responsive brief by the Board). TBMP § 502.04. As such, the Board's consideration of the Renewed Motion at this point (and after both of the required prior filings) is timely and should be considered.

Even if the Board deems the Renewed Motion untimely, Applicant has provided its full response, such that it can be properly ruled upon at this time. Denying the Renewed Motion and requiring the parties to resubmit the same arguments and papers – as requested by Applicant – would be a meaningless exercise resulting in the further unnecessary spending of even more time and resources by both the Board and the Parties, especially in light of the fact that it has already been fully briefed.

In light of the above, Applicant's contention that the Renewed Motion is untimely is incorrect and the Board should issue a decision on the merits.

**B. The Renewed Motion is Not Moot.**

Applicant is also incorrect in its assertion that the Renewed Motion is moot. Applicant argues that simply because the Board previously suspended the *ex parte* appeals pending the disposition of the *inter partes* opposition, Applicant's Opposition at 2-3, the suspensions were clearly appropriate and should be maintained. However, at the time the appeals were suspended (by "automatic" order) the Board had not had the opportunity to review the instant Renewed Motion to determine which proceeding would be most judicially economical to continue. At the time Applicant moved to suspend the appeals (June 17, 2013), the instant opposition was already

under suspension pending resolution on a motion to strike (suspended February 27, 2013 and resumed on June 28, 2013). In an effort to notify the Board of the suspension requests for the appeals and indicate that judicial economy would be better served by suspending this proceeding instead, Opposer filed its initial motion to suspend the opposition. However, as the Board noted in its June 28 Order, per the Trademark Rules the initial motion to suspend could not be taken under consideration, but a renewed one would at the proper time – which is now.

As the Board did not have all the necessary facts to determine whether it would be better to suspend the appeals or the instant opposition until this time, the Renewed Motion is not moot – it merely gives the Board the opportunity to determine how judicial economy will best be served in this situation.

**C. Applicant has had Ample Opportunity to Challenge Opposer’s Reg. No. 3,939,863 Before Filing the Counterclaim and Opted not to.**

The central argument in Applicant’s Opposition is that although Opposer’s Reg. No. 3,939,863 is the cited registration barring registration of the Appealed Applications, Applicant did not have any opportunity to challenge the validity of Reg. No. 3,939,863 until it was recently pleaded in the Amended Notice of Opposition, and for that reason, the opposition should proceed rather than the appeals. Applicant argues “because the appeals are *ex parte*, they do not afford Applicant/Opposer [sic] the option to challenge the cited registration. Instead this *inter partes* proceeding is the proper forum for disposition of such a challenge.” Applicant’s Opposition at 3, fn. 3. However, there was absolutely nothing preventing Applicant from petitioning to cancel Reg. No. 3,939,863 once it was cited against the Appealed Applications, as Applicant had both standing<sup>1</sup> and grounds<sup>2</sup> – Applicant simply chose not to.

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<sup>1</sup> See *Saddlesprings, Inc. v. Mad Croc Brands, Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012); *Kallamni v. Kahn*, 101 USPQ2d 1864, 1865 (TTAB 2012).

Applicant is simply incorrect in stating that the recently filed counterclaim has been its only opportunity to challenge Opposer's Reg. No. 3,939,683 – Applicant simply chose to not take any action prior to this point. It would be prejudicial to Opposer to require the parties to engage in a much lengthier and more costly proceeding (the opposition) that could be resolved quickly and easily through the appeals, simply because Applicant opted to not petition to cancel the registration earlier.

Continuing the instant opposition purely because Applicant made a conscious decision not to challenge Reg. No. 3,939,683 when it was cited against its applications and has now decided to challenge it because it was pleaded in the Amended Notice of Opposition would be illogical and prejudicial to Opposer.

**D. Applicant Concedes that the Opposition will Take Far Longer to Resolve than the Appeals.**

Throughout Applicant's Opposition, Applicant concedes that the instant opposition will take far longer to resolve than the appeal – bolstering Opposer's argument that judicial economy will be best served by suspending the opposition (and now counterclaim) pending the disposition of the appeals. Applicant acknowledges that the opposition has yet to hold the mandatory discovery conference, Applicant's Opposition at 4, which will now be even further delayed due to the filing of the counterclaim.<sup>3</sup> Applicant suggests that this conference could result in settlement or moving into ACR, but overlooks the fact that such discussions could have occurred long prior to any mandatory conference. In fact, Applicant has never made any attempt to

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<sup>2</sup> Opposer assumes that Applicant had the same grounds that it put forth in the counterclaim. Opposer does not concede that the grounds put forth in the counterclaim are legally sufficient or state a claim upon which relief can be granted, and will make such an argument in a proper motion in response to the counterclaim.

<sup>3</sup> Upon the filing of the counterclaim (and appropriate fees and proof of service), the Board prepares and issues an order acknowledging its receipt and resetting the deadlines in the matter to incorporate time for the other party to file its answer to the counterclaim. TBMP § 313.06. To date, the order resetting the dates has yet to be issued and the parties cannot have a meaningful discovery conference until after the counterclaim is duly answered. As such, the discovery conference deadline and opening of the discovery period for the opposition will be delayed even further due to Applicant's filing of the counterclaim.

contact Opposer or begin any potential negotiations. Additionally, while ACR is a quicker proceeding than a traditional opposition, Applicant's inclusion of a counterclaim makes this particular matter much more complex and not well suited for ACR. Ultimately, as Opposer argued in the Renewed Motion, judicial economy favors suspending the opposition and counterclaim pending the disposition of the appeals, as the denial of the appeals (since most appeals are, in fact, denied) will be dispositive of the issues presented in the opposition and a decision will be reached at a much lower cost of time and resources to both the Board and parties.

**E. Even with the Counterclaim, Judicial Economy Favors Proceeding with the Appeals.**

Judicial economy is best served by resolving this issue through the much quicker *ex parte* appeal process, which avoids extensive discovery and trial periods (or even a limited discovery process through ACR), and moves directly to briefing.

The addition of the new counterclaim does not change this fact. All the counterclaim does is make discovery much more complex and time consuming should the opposition proceed at this point. Additionally, the Board's ultimate decision in this matter will be much more involved as well, due to the more extensive trial record and evidence that is necessarily going to be involved. Instead, resolving the central issue of the opposition through the appeals will also drastically limit the scope of the instant proceeding. By resolving the issue of the opposition entirely in the *ex parte* proceeding (without any need for any discovery process or trial), the continuing cancellation aspect can be much more focused on the exact issues presented therein – with more narrowed discovery and evidence to be presented at trial.

Ultimately, the counterclaim does not alter the fact that judicial economy favors proceeding with the appeals rather than the opposition.

## **CONCLUSION**

As discussed in the Renewed Motion, judicial economy favors pursuing an *ex parte* proceeding to resolve this matter as it does not include the necessary discovery and trial phases involved with an opposition (and now counterclaim). Additionally, given the fact that, as Applicant concedes, the opposition has yet to even hold the mandatory discovery conference, which will be significantly delayed due to the filing of the counterclaim, the appeals will clearly be able to resolve much more quickly, while drastically reducing the burden on the Board's time and resources.

Accordingly, for the foregoing reasons and those stated in the Renewed Motion, Opposer respectfully urges that the *ex parte* appeals of Appln. No. 85/351,186 and 85/346,334 be resumed and the subject opposition be suspended pending the disposition of the Appealed Applications.

RED BULL GMBH  
By: /Martin R. Greenstein/  
Martin R. Greenstein  
Leah Z. Halpert  
Angelique M. Riordan  
TechMark a Law Corporation  
4820 Harwood Road, 2nd Floor  
San Jose, CA 95124-5273  
Tel: 408- 266-4700 Fax: 408-850-1955  
E-Mail: MRG@TechMark.com  
Attorneys for Opposer Red Bull GmbH

Dated: August 30, 2013

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF THE RENEWED MOTION TO SUSPEND OPPOSITION NO. 91-200,803** is being served on August 30, 2013, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to Applicant's Counsel at their Correspondent address given on the TARR website, with a courtesy copy via email to [cwcdocketing@roylance.com](mailto:cwcdocketing@roylance.com).

Casimir W. Cook II  
Roylance, Abrams, Berdo & Goodman LLP  
1300 19<sup>th</sup> Street NW, Suite 600  
Washington, D.C. 20036

/Leah Z. Halpert/  
Leah Z. Halpert