

ESTTA Tracking number: **ESTTA591255**

Filing date: **03/07/2014**

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, AMR@TechMark.com, LZH@TechMark.com, DMP@TechMark.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Leah Z. Halpert
Filer's e-mail	MRG@TechMark.com, LZH@TechMark.com, AMR@TechMark.com, DMP@TechMark.com
Signature	/Leah Z. Halpert/
Date	03/07/2014
Attachments	Michael Ball RED Applns-91208003-Mtn to Dismiss Counterclaim.pdf(40413 bytes)

**CERTIFICATE OF ELECTRONIC FILING AND
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I hereby certify that the following Motion is being filed with the TTAB via ESTTA on the date set forth below.
Date: March 7, 2014

/Leah Z. Halpert/
Leah Z. Halpert

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

		Opposition No.:	91-208,003 (Parent)
RED BULL GMBH,			91-214,448 (Child)
Opposer/Counterclaim Registrant		Serial Nos.:	85/400,933, 85/400,941, 85/400,955
v.			85/406,652, and 85/400,948
		Trademarks:	
MICHAEL F. BALL,		+RED DETOX ELIXIR	(#85/400,933)
		+RED DREAM ELIXIR	(#85/400,941)
Applicant/Counterclaim Petitioner		+RED SUN REPAIR ELIXIR	(#85/400,955)
		+RED RESCUE ELIXIR	(#85/406,652)
		+RED POWER ELIXIR	(#85/400,948)

**OPPOSER’S MOTION TO DISMISS THE GROUND OF MERE DESCRIPTIVENESS
IN APPLICANT’S COUNTERCLAIM, AND STRIKE APPLICANT’S FIRST
AFFIRMATIVE DEFENSE IN APPLICANT’S ANSWER**

Pursuant to the Federal Rules of Civil Procedure (“FRCP”) Rule 12(b)(6) and TBMP § 503, Opposer/Counterclaim Registrant, Red Bull GmbH (“Red Bull”), moves the Trademark Trial and Appeal Board (“Board”) to dismiss Applicant/Counterclaim Petitioner’s (“Applicant”) claim of mere descriptiveness found in ¶¶ 31-39, 41 of its Answer and Affirmative Defenses to Amended Notice of Opposition and Counterclaim for Cancellation of U.S. Reg. No. 3,939,863¹. As discussed in detail below, ¶¶ 31-38 of Applicant’s Counterclaim are irrelevant and highly prejudicial, and should be stricken. Without these paragraphs, Applicant’s ground of mere descriptiveness is legally insufficient and should be dismissed in its entirety.²

¹ Hereinafter, “Applicant’s Answer” refers to ¶¶ 1-23 and “Applicant’s Counterclaim” refers to ¶¶ 24-42 of the Answer and Affirmative Defenses to Amended Notice of Opposition and Counterclaim for Cancellation of U.S. Reg. No. 3-939,863.

² Although Red Bull is not moving to dismiss the claim of abandonment, this is not to be taken as conceding this false claim. Red Bull maintains its emphatic disagreement with the claim of abandonment – a matter which will properly be taken up during discovery and trial.

Further, Red Bull moves to strike Applicant's first affirmative defense found in ¶ 22 of the Applicant's Answer, as it is an impermissible collateral attack on the validity of Red Bull's registration.

ARGUMENT

“A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint.” *Petróleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403 (TTAB 2010); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); TBMP §503.02. Under the Trademark Rules and precedent, a complaint must include a short and plain statement of a claim, the elements of the claim, and enough factual support to show that the pleader is entitled to relief and to give the defendant fair notice. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007); *Fair Indigo LLC*, 85 USPQ2d at 1538 (elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985) (petitioner's Trademark Act § 2(a), 15 U.S.C. § 1052(a) allegations were merely conclusory and unsupported by factual averments); *Ashcroft v. Iqbal*, 556 U.S. 662, (2009), quoting *Twombly*, 550 U.S. at 570; 37 C.F.R. §2.104(a); TBMP §309.03(a)(2); Fed. R. Civ. P. 8(a)(2). To survive a motion to dismiss, a complaint must state more than bare conclusory allegations, such that the facts in the complaint are sufficient enough to make any claim within it plausible on its face. *Twombly*, 550 U.S. at 570; TBMP §503.02. Each and every allegation must be supported by at least a modicum of details. *Id.* Such details are necessary not only to give the defendant fair notice of the basis of each claim, but also to show the Board that a right to relief exists assuming all such facts and allegations are taken to be true. *See Fair Indigo LLC*, 85 USPQ2d at 1538; TBMP §309.03(a)(2) (“A pleading should include enough detail to give the defendant fair notice of the basis for each claim”).

The “detail” provided by Applicant in relation to its claim of mere descriptiveness – found in ¶¶ 31-38 of Applicant’s Counterclaim – is entirely insufficient, irrelevant and prejudicial references to one of Red Bull’s pending applications not in issue in this proceeding; as such it is matter that should be stricken. Without this “detail”, Applicant’s claim of mere descriptiveness does not meet the minimal pleading standards, but rather constitutes, at best, merely a formulaic recitation of the cause of actions’ elements. As the courts have held,

While a complaint attacked by a Rule 12(b)(6) motion to dismiss does not need detailed factual allegations, a plaintiff’s obligations to provide the “grounds” of his “entitle[ment] to relief” require more than labels and conclusion, and a formulaic recitation of a cause of action’s elements will not do. *Factual allegations* must be enough to raise a right to relief above the speculative level on the assumption that all the complaint’s allegations are true.

Twombly, 550 U.S. at 545 (emphasis added). Here, without the highly irrelevant material in ¶¶ 31-38, Applicant’s Counterclaim provides no relevant details or facts whatsoever upon which the ground of mere descriptiveness is based. Because Applicant has failed to plead a factual basis for its claim of descriptiveness in the counterclaim, this ground is legally insufficient to raise a right to relief, and should be dismissed.

Further, Red Bull moves to strike Applicant’s first affirmative defense in Applicant’s Answer, as it is an improper collateral attack on Red Bull’s RED Registration³ that is more properly dealt with in a counterclaim.

A. Applicant’s Claim of Mere Descriptiveness in the Counterclaim is Based Entirely on Irrelevant “Facts” and Therefore Does Not State a Claim Upon Which Relief Can be Granted.

Under § 2(e) of the Trademark Act, 15 U.S.C. § 1052(e), a party can claim that a defendant’s mark, when used on or in connection with the goods or services of the defendant, is

³ Applicant’s first affirmative defense merely mentions Red Bull’s “alleged RED mark” and does not indicate to which specific mark Applicant is referring. Red Bull assumes, however, that Applicant is referring to the RED Registration, as Red Bull defined, in the Amended Notice of Opposition, its U.S. registrations and common law rights collectively as the RED and RED BULL Marks. Since Applicant does not clarify or refer to the collective marks, Red Bull can only assume that Applicant is referring to the only RED mark that was listed singly – the RED Registration.

merely descriptive and therefore not entitled to registration. TBMP § 309.03(c). As stated above, however, bald allegations without sufficient facts to establish the elements necessary for recovery do not provide sufficient notice to the defendant and are impermissible, as they fail to state a claim upon which relief can be granted. *McDonnell Douglas Corp.*, 228 USPQ at 47. Here, Applicant attempts to include facts to support its claim of mere descriptiveness, however, each and every one of Applicant’s “facts” is entirely irrelevant to the matter at hand – referring solely to a separate, pending application not involved in this proceeding – and should be stricken as such. Without these “facts”, Applicant’s claim of mere descriptiveness is legally insufficient, fails to state a claim upon which relief can be granted, and should be dismissed.

Applicant’s mere descriptiveness claim, found in ¶¶ 31-39 of Applicant’s Counterclaim, and referred to again in passing in ¶ 41, is as follows:

Upon information and belief, Opposer/Respondent is also the owner of U.S. Trademark Application No. 85/438,268 – RED, filed on October 3, 2011, based on use since August 29, 2011, for “energy drinks; soft drinks; hypertonic drinks.” Applicant’s Answer/Counterclaim ¶ 31.

On October 3, 2011, Opposer/Respondent submitted as a specimen of use supporting U.S. Trademark Application No. 85/438,268 the image in Figure 1 below:



Figure 1

Id. at ¶ 32.

On December 23, 2011, the USPTO issued a non-final office action (1) indicating that the specimen was unacceptable as it did not support use of the alleged RED mark; (2) seeking information on the significance of the term RED; and (3) indicating a potential suspension based on Applicant/Petitioner’s U.S. Trademark Application Serial Nos. 85/351,186 and 85/346,334. *Id.* at ¶ 33.

On June 20, 2012, Opposer/Respondent submitted arguments in favor of its specimen from Figure 1, providing limited information to the USPTO on the significance of the term RED, and arguing against suspension. *Id.* at ¶ 34.

On July 13, 2012, the USPTO issued a Notice of Suspension (1) suspending Opposer/Respondent's U.S. Trademark Application No. 85/438,268 – RED pending the disposition of Applicant/Petitioner's prior pending U.S. Trademark Application Serial Nos. 85/351,186 and 85/146,334; (2) maintaining and continuing the refusal of the specimen in Figure 1 as representing THE RED EDITION mark and not the alleged RED mark; and (3) indicating that the response to the significance inquiry (which did not identify the product in Figure 1 as artificially cranberry flavored or containing red colored liquid) was satisfactory. *Id.* at ¶ 35.

Upon information and belief, apart from use as an element of the composite mark RED BULL, Opposer/Respondent's only other use of the literal element RED in commerce in connection with beverages is as an element of the composite designation THE RED EDITION. *Id.* at ¶ 36.

Upon information and belief, Opposer/Respondent's THE RED EDITION energy drinks and soft drinks are advertised as including “the taste of cranberry.” *Id.* at ¶ 37.

Upon information and belief, Opposer/Respondent's THE RED EDITION energy drinks are actually a red colored liquid. *Id.* at ¶ 38.

Opposer/Respondent's alleged RED mark, subject of the Registration, is merely descriptive under Section 2(e) of the Trademark Act, 15 U.S.C. § 1052(e), in that Opposer/Respondent's alleged RED mark identifies and/or describes an ingredient, quality, characteristic, function, feature, purpose, of Opposer/Respondent's red colored and cranberry flavored “energy drinks and soft drinks.” *Id.* at ¶ 39.

Applicant's entire claim is based on its own assertion that Red Bull's unrelated, currently pending Application No. 85/438,268 (“Red Bull's Pending Application”) is merely descriptive, *See* Applicant's Counterclaim ¶¶ 31-38, and therefore the RED Registration at issue in the counterclaim is also merely descriptive. *Id.* at ¶ 39. Not only does Applicant's conclusion incorrectly assume that Red Bull's Pending Application is somehow related to its RED Registration, but the “facts” presented are entirely irrelevant and outside the scope of the Board's jurisdiction. The Board has jurisdiction over four types of inter partes proceedings – oppositions, cancellations, interferences, and concurrent use proceedings – as well as ex parte appeals made

after an examining attorney’s final refusal to register a mark in an application. TBMP § 102.02. Nothing within the statute or rules allows for a party to do what Applicant is attempting with its counterclaim – to surreptitiously broaden the Board’s jurisdiction in order to get a ruling on the registrability of a pending application that is not involved in the instant Board proceedings and, in fact, is still under examination by the PTO. According to Applicant’s Counterclaim, Applicant purports to imply that Red Bull’s Pending Application is merely descriptive and not entitled to registration. Red Bull will be highly prejudiced if Applicant is allowed to rely on the above-discussed irrelevant “facts” in its counterclaim as it will ultimately force the Board to go beyond its jurisdiction and make a ruling on Red Bull’s Pending Application. Even if these “facts” are allowed and proven by Applicant, they are still irrelevant to the matter at hand as they do not indicate one way or another whether the wholly separate and unrelated RED Registration – the issue in Applicant’s Counterclaim – is merely descriptive. Each and every reference to Red Bull’s Pending Application, therefore, is highly irrelevant, cannot be considered by the Board, and must be stricken.

Without the irrelevant “facts” in ¶¶ 31-38 of Applicant’s Counterclaim, the ground of mere descriptiveness is simply a legally insufficient, bald allegation that does not provide sufficient notice to Red Bull. Therefore, Applicant’s ground of mere descriptiveness in ¶¶ 31-39 of Applicant’s Counterclaim (as well as the reference to it in ¶ 41⁴), should be dismissed for failure to state a claim upon which relief can be granted.

B. Motion to Strike Applicant’s First Affirmative Defense as an Improper Collateral Attack.

⁴ ¶ 41 of Applicant’s Counterclaim reads as follows (with the portion to be stricken in italics):

41. In view of the foregoing, U.S. Registration No. 3,939,863 is subject to cancellation and Applicant/Petitioner asks that it be cancelled pursuant to Sections 14(1) and 14(3) of the U.S. Trademark Act, 15 U.S.C. § 1064(1) and (3) on the grounds of abandonment under Section 45 of the U.S. Trademark Act, 15 U.S.C. § 1127 and under Section 2(e) of the U.S. Trademark Act, 15 U.S.C. § 1052(e), on the grounds of mere descriptiveness.

Red Bull further moves to strike Applicant's first affirmative defense, as seen in ¶ 22 of Applicant's Answer, as an impermissible collateral attack on the validity of Red Bull's RED Registration. ¶ 22 of Applicant's Answer reads as follows:

Opposer/Respondent's alleged RED mark lacks secondary meaning and is not a protectable trademark because Opposer/Respondent cannot show that the primary significance in the minds of the consuming public of the term "RED" when used in connection with "energy drinks and soft drinks" is not descriptive of an ingredient, quality, characteristic, function, feature, purpose, or use of the specified goods, but rather the source itself; therefore, Applicant/Petitioner is free to use and register the alleged trademark "RED" in commerce as a literal element of +RED DETOX ELIXIR, +RED DREAM ELIXIR, +RED SUN REPAIR ELIXIR, and +RED RESCUE ELIXIR.

The above defense directly attacks the validity of Red Bull's RED Registration by alleging that it is descriptive and does not function as a source identifier – a defense that can only be properly raised in a counterclaim or separate petition to cancel. 37 C.F.R. § 2.114(b)(2)(ii). As discussed above, Applicant attempted to raise this defense in the counterclaim, however the claim must be dismissed for legal insufficiency and failure to state a claim upon which relief has been granted. Therefore, as Applicant has not filed a proper counterclaim or separate petition to cancel Red Bull's RED Registration, the attack on its validity as seen in ¶ 22 of Applicant's Answer is impermissible, should not be given any consideration, and should be stricken.

Even if the Board determines that Applicant has adequately pleaded the ground of mere descriptiveness in the counterclaim (despite striking the highly irrelevant and prejudicial references to Red Bull's Application), Applicant's first affirmative defense should still be stricken as redundant of the bald allegations made in the counterclaim – the more appropriate place to deal with such a defense.

CONCLUSION

For the foregoing reasons, Red Bull respectfully requests that ¶¶ 31-38 of Applicant's Counterclaim be stricken as highly prejudicial and irrelevant, and Applicant's ground of mere

descriptiveness, as seen in ¶¶ 31-39, and referenced in ¶ 41 of Applicant's Counterclaim be dismissed as legally insufficient. Further, Red Bull respectfully requests that ¶ 22 of Applicant's Answer also be stricken as an improper collateral attack on the validity of Red Bull's RED Registration, or, in the alternative, as redundant of the counterclaim.

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: March 7, 2014

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S MOTION TO DISMISS THE GROUND OF MERE DESCRIPTIVENESS IN APPLICANT'S COUNTERCLAIM, AND STRIKE APPLICANT'S FIRST AFFIRMATIVE DEFENSE IN APPLICANT'S ANSWER** is being served on March 7, 2014, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to Applicant's Counsel at its Correspondent of Record's address, with a courtesy copy via email to docketing@roylance.com, sstraub@roylance.com:

Stephen A. Straub
Roylance, Abrams, Berdo & Goodman LLP
1300 19th Street NW, Suite 600
Washington, D.C. 20036-1649

/Leah Z. Halpert/
Leah Z. Halpert