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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
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Attachments	Michael Ball RED Applns-91208003-Reply in Support of Mtn to Dismiss Counterclaim.pdf(25428 bytes)

Applicant's Response to Opposer's Motion to Dismiss ("Applicant's Response") begins by conceding that a complaint (or, as here, a counterclaim) without facts to support it is legally insufficient as it lacks the necessary detail to justify the claim for relief. Applicant's Response at 2. Applicant then argues that the relevancy of this factual support is an evidentiary standard, *Id.* at 3, incorrectly implying that facts pleaded in support of a claim need not be relevant². Opposer agrees that a pleading need contain "only enough facts to state a claim to relief that is plausible on its face", *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 & 570 (2007); however, Applicant is incorrect that this long-held ruling somehow makes irrelevant facts proper. Applicant conveniently omits that *Bell Atlantic* clearly holds a claim must provide enough factual matter that, *when taken as true*, (1) states a plausible claim to relief, *Id.* at 556, **and** (2) shows entitlement to the relief sought. *Id.* at 558 (allegations in a complaint, however true³, that cannot rise to a claim of entitlement to relief must be stricken prior to the parties and court expending time and money on exploring them). As conceded by Applicant, the "facts" presented by Applicant in ¶¶ 31-39⁴ are either all directly taken from Opposer's pending Application No. 85/438,268 – an application not at issue in the case here, and completely irrelevant to the matter at hand – or directly developed from statements made during the prosecution of Opposer's pending Application No. 85/438,268⁵. Therefore, even assuming Applicant's "facts" in ¶¶ 31-39 are true (which Opposer does not concede and vigorously denies), Applicant is still not entitled

² In making this argument, Applicant actually implicitly concedes that its "facts" in ¶¶ 31-39, 41 are entirely irrelevant to the matter at hand, and included solely in a far-fetched effort to develop a claim that is plausible on its face.

³ Opposer is not, in any way, conceding that the allegations in ¶¶ 31-39, 41 of the counterclaim are true, and in fact, vigorously denies them.

⁴ Opposer also moved to dismiss the references to Applicant's claim of mere descriptiveness in ¶ 41 of the counterclaim. Applicant did not dispute the motion in regard to this paragraph, and therefore has conceded to this portion.

⁵ Applicant concedes that ¶ 31 discusses the irrelevant application and ¶¶ 32-35 directly discuss statements made during the prosecution of this irrelevant application. Further the "further factual allegations" that Applicant claims are made in ¶¶ 36-39 are not distinct from the previous paragraphs, as Applicant contends, but rather, clearly based entirely on those paragraphs (and the irrelevant application).

to the relief sought in the counterclaim – the cancellation of Opposer’s registration (wholly unrelated to the pending Application No. 85/438,268 Applicant discusses and any statements made during the prosecution of said application). The “factual” support for Applicant’s claim of mere descriptiveness, therefore, should be stricken as irrelevant. As conceded by Applicant, without any factual support, its claim of mere descriptiveness in the counterclaim is legally insufficient as it lacks the necessary support to justify the cancellation of Opposer’s registration, and should be stricken.

B. Applicant’s Reliance on *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607 (TTAB 1981) is Entirely Misplaced.

In order to support its inclusion of irrelevant “facts” from the prosecution of an unrelated and irrelevant application, Applicant asserts that “statements made by a party in prosecution of its application for registration may be used by an adverse party as evidence against the applicant in the nature of an admission against interest.” Applicant’s Response at 3. While under certain circumstances there is some validity to this statement (but certainly not to the extent that Applicant implies), the limits of what can be used as an admission against interest are actually quite narrow. There is no need at this juncture to delve into the very narrow limits of prosecution estoppel and the differences between factual statements and argument (which Applicant has attempted blur), since the entirety of “statements” Applicant attempts to rely upon as “admissions against interest” come from an unrelated and irrelevant application, and should be stricken as such.

Even if the irrelevant Application No. 85/438,268 were somehow related to the registration at issue in the counterclaim (which is clearly is not), the “statements” Applicant relies upon from the prosecution of Application No. 85/438,268 are not of the type that are allowable as “admissions against interest” under *Eikonix Corp. v. CGR Medical Corp.*, 209

USPQ 607 (TTAB 1981), and still should be stricken as impermissible. Statements made during the prosecution of an application are generally not admissions against interest (and cannot be used as such), as they are often in the nature of inconsistent pleadings and not genuine facts. *Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza Holding Co., Inc.*, 95 USPQ2d 1271 (TTAB 2009); *Meier's Wine Cellers, Inc. v. Meyer Intellectual Properties Ltd.*, Cancellation No. 92044883 (March 4, 2008). Because of this, the doctrine of “file wrapper estoppel” does not apply in trademark cases. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 963 (TTAB 1986). Under *Eikonix Corp.*, the only portion of a relevant *registration* that may constitute an “admission against interest” are actual genuine facts (rather than argument); facts such as finalized disclaimers, dates of first use, and claims of distinctiveness. *See Bass Pro Trademarks, LLC v. Sportsmans's Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008); *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n. 5 and n. 11 (TTAB 1985).

As discussed above, Applicant's claim of mere descriptiveness in the counterclaim is based entirely on, and derived from Opposer's submission in connection with an unrelated and irrelevant application – one which is still under review by the USPTO. With Opposer still arguing the submission, it clearly cannot be considered a “fact” that rises to the level of an “admission against interest”. Therefore, even if pending Application No. 85/438,268 were somehow relevant to the case at hand, under the long-standing case law, including *Eikonix Corp.*, ¶¶ 31-39, 41 of the counterclaim must be stricken.

With the irrelevant matter removed, Applicant's bald claim of mere descriptiveness does not meet pleading standards and should be stricken as legally insufficient.

CONCLUSION

For the foregoing reasons and those stated in the Motion to Dismiss, Opposer respectfully requests that Applicant's claim of mere descriptiveness in its counterclaim, and Applicant's first affirmative defense in its answer be dismissed.

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Dated: April 7, 2014

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER'S REPLY IN SUPPORT OF THE 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 April 7, 2014, 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 sstraub@roylance.com and docketing@roylance.com:

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