

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: August 15, 2014

Opposition Nos. **91208003 (parent)**
91214448

Red Bull GmbH

v.

Michael F. Ball

By the Board:

This matter comes up on applicant's motion (filed February 21, 2014) to dismiss Opposition No. 91214448 and opposer's cross-motion (filed March 7, 2014) to dismiss applicant's counterclaim based on mere descriptiveness under Section 2(e)(1) and to strike applicant's first affirmative defense. The motions are fully briefed.¹

As a preliminary matter, it is noted that Opposition Nos. 91208003 and 91214448 were consolidated by order of the Board on February 20, 2014. Pursuant to that order, the parties were instructed to "no longer file separate papers in connection with each proceeding, but [to] file only a single copy of each paper in the parent case." Although the order goes on to note that the

¹ Applicant's change of correspondence (filed May 14, 2014) is noted. The Board's records have been accordingly updated.

proceedings are being consolidated prior to joinder of issue in each proceeding, and instructs the parties to file separate answers, that does not preclude the parties from filing a paper in the parent for the child proceeding. Accordingly, neither party will be heard to complain that a paper is untimely because it was filed in the parent proceeding as opposed to the child proceeding.

Applicant's Motion to Dismiss Opposition No. 91214448

Applicant seeks to dismiss the child proceeding based on its assertion that opposer failed to successfully file the actual notice of opposition with the Board at the time opposer attempted to commence the opposition proceeding through ESTTA, the Board's electronic filing system. The basis of applicant's claim is that only the ESTTA cover sheet to the notice of opposition was visible on TTABVUE prior to January 23, 2014, the last day of the period for opposing application Serial No. 85400948.

A review of the TTABVUE record for Opposition No. 91214448 currently shows both the ESTTA cover sheet and the originally filed notice of opposition. Although applicant suggests that the January 13, 2014 filing is now complete due to a subsequent transmittal of the notice of opposition to the Board, this is mere supposition by applicant without a basis in fact.

Contrary to applicant's contention that the "ESTTA-created electronic cover sheets ... do not form part of any complaint," *Applicant's Motion to Dismiss*, p. 2, the Board views the ESTTA cover sheet and any attachments

thereto “as comprising a single document or paper being filed with the Board.” *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005). As pointed out by opposer, the ESTTA cover sheet reflects that a .pdf attachment consisting of 124499 bytes was submitted with the original ESTTA filing. Since it is not the practice of the Board to “match up” a later-filed paper with an earlier filing, that the notice of opposition is now available for viewing on TTABVUE merely reflects that the technical error that prevented the document from being viewed was internally remedied by the Board’s information technology personnel. It is of no consequence that the technical issues associated with the proceeding were remedied after the close of the opposition period since the timing of the Board’s technical fix has no bearing on when opposer filed its notice of opposition. As such, the Board finds no basis for applicant’s claim and hereby **DENIES** applicant’s motion to dismiss.

Opposer’s Motion to Dismiss Counterclaim in Opposition No. 91208003
Opposer’s Motion to Strike Affirmative Defense

Opposer has cross-moved under Fed. R. Civ. P. 12(b)(6) to dismiss applicant’s counterclaim of mere descriptiveness against opposer’s pleaded Registration No. 3939863.² In support of its motion, opposer contends that applicant’s counterclaim is insufficient as it is based wholly on facts

² For RED in typed form for “energy drinks and soft drinks” in Class 32. Registered on the Principal Register on April 5, 2011, under Section 44.

concerning one of opposer's applications³ that is unrelated to opposer's pleaded registration and currently not under the Board's jurisdiction. Opposer's contention is not well taken.

As part of its counterclaim, applicant has pleaded that it "believes that it is and/or will be damaged by United States Trademark Registration No. 3,939,863, owned by Opposer/Respondent ... for RED which ... covers 'energy drinks and soft drinks' in Int'l Class 32 (the 'Registration')" [¶ 25 of Answer], that applicant is the owner of application Serial Nos. 85400933, 85400941, 85400955, and 85406652 and that opposer "has opposed these applications on the grounds of a likelihood of confusion, in part, with U.S. Registration No. 3,939,863" [¶ 26], that "[u]pon 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" [¶ 36], that opposer's drinks that are so labeled "are advertised as including 'the taste of cranberry'" [¶ 37] and "are actually a red colored liquid" [¶ 38], and that opposer'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's] alleged RED mark identifies and/or describes an ingredient, quality, characteristic, function, feature, purpose, of [opposer's] red colored

³ Application Serial No. 85438268 for RED in standard characters for "energy drinks; soft drinks; hypertonic drinks" in International Class 32, filed October 3, 2011 under Section 1(a).

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and cranberry flavored ‘energy drinks and soft drinks” [¶ 39]. These allegations, taken as true as they must on a motion to dismiss, are sufficient for applicant to plead its standing as a counterclaimant, *see Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1930 n.12 (TTAB 1993), and its claim of mere descriptiveness under Section 2(e)(1) of the Trademark Act, independent of those factual allegations relating to opposer’s pending application Serial No. 85438268. In view thereof, opposer’s motion to dismiss applicant’s counterclaim is hereby **DENIED**.

As to opposer’s motion to strike applicant’s first “affirmative defense,” i.e., ¶ 22 of the answer, the motion is **GRANTED** as applicant has consented to striking the paragraph from the answer. Accordingly, ¶ 22 of the answer is hereby **STRICKEN**.

Proceedings herein are **RESUMED** in accordance with the following schedule:

Answer in Opposition No. 91214448 and Answer to Counterclaim in Opposition No. 91208003 Due	9/12/2014
Deadline for Discovery Conference	10/12/2014
Discovery Opens	10/12/2014
Initial Disclosures Due	11/11/2014
Expert Disclosures Due	3/11/2015
Discovery Closes	4/10/2015
Plaintiff’s Pretrial Disclosures	5/25/2015

30-day testimony period for plaintiff's testimony to close	7/9/2015
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	7/24/2015
30-day testimony period for defendant and plaintiff in the counterclaim to close	9/7/2015
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	9/22/2015
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	11/6/2015
Counterclaim Plaintiff's Rebuttal Disclosures Due	11/21/2015
15-day rebuttal period for plaintiff in the counterclaim to close	12/21/2015
Brief for plaintiff due	2/19/2016
Brief for defendant and plaintiff in the counterclaim due	3/20/2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	4/19/2016
Reply brief, if any, for plaintiff in the counterclaim due	5/4/2016

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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