

ESTTA Tracking number: **ESTTA533304**

Filing date: **04/19/2013**

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

Proceeding	91208855
Party	Plaintiff Greater Louisville Convention & Visitors Bureau
Correspondence Address	JOHN A GALBREATH GALBREATH LAW OFFICES PC 2516 CHESTNUT WOODS CT REISTERSTOWN, MD 21136 UNITED STATES jgalbreath@galbreath-law.com
Submission	Opposition/Response to Motion
Filer's Name	John A. Galbreath
Filer's e-mail	jgalbreath@galbreath-law.com
Signature	/John A. Galbreath/
Date	04/19/2013
Attachments	91208855-Opposition to Recons. Request & 2nd Strike Motion.pdf (5 pages) (140769 bytes)

Greater Louisville Convention and Visitor's Bureau)	IN THE UNITED STATES
)	PATENT AND TRADEMARK OFFICE
)	
Opposer)	
)	TRADEMARK TRIAL AND APPEAL BOARD
v.)	
)	
The Wine Group LLC)	APPL. NO. 85/736,374
)	
Applicant)	OPPOSITION NO. 91208855
_____)	

**OPPOSER'S OPPOSITION TO APPLICANT'S RECONSIDERATION
REQUEST; REPLY IN MOTION TO AMEND; & OPPOSITION TO
APPLICANT'S SECOND MOTION TO STRIKE**

Greater Louisville Convention and Visitor's Bureau ("Louisville", "Opposer", or "Plaintiff"), by and through its below-identified attorneys, hereby opposes The Wine Group LLC's ("Wine Group", "Applicant", or "Defendant") request for reconsideration; submits a reply in its motion to amend its counterclaim answer; and opposes applicant's second motion to strike, and states as follows:

I. Opposition to Applicant's Request for Reconsideration.

The Board correctly decided Wine Group's first motion to strike, because the motion was rendered moot by Louisville's amending of its counterclaim answer to give Wine Group fair notice of the bases for Louisville's affirmative defenses. The Board also properly granted Louisville's motion to amend its counterclaim answer, as further discussed below.

Wine Group's motion to strike was fully briefed, including a reply by Wine Group filed on April 2, 2013. Wine Group's request for reconsideration raises no new issues that have not already been considered by the Board, and is unpersuasive.

II. Reply in Motion to Amend Counterclaim Answer.

The Board has already correctly granted Louisville's motion to amend its counterclaim answer. Wine Group's subsequently filing of an opposition to this granted motion is thus moot. However, in an abundance of caution, Louisville submits this reply.

It is a long-standing principle, embodied both in the Federal Rules of Civil Procedure and in the Trademark Trial and Appeal Board Manual of Procedure, that pleadings may be amended by leave of court, and that "such leave shall be freely given". Fed. R. Civ. P. 15(a), TBMP § 507.01(2). The Trademark Rules of Practice place no restrictions on amending the pleadings in a cancellation action, and state that "such pleadings may be amended in the same manner and to the same extent as in a civil action in a United States district court". 37 C.F.R. § 2.115. Indeed, amended pleadings serve an important purpose because they allow parties to clarify their claims and defenses, and ensure that the other party has fair notice of what those claims and defenses are.

Leave should be particularly given in the absence of any showing of prejudice. *Foman v. Davis*, 371 U.S. 178, 182 (1962); *Smith v. Angelone*, 111 F.3d 1126, 1134 (4th Cir. 1997); *Davis v. Piper Aircraft Corp.*, 615 F.2d 606, 613 (4th Cir. 1980). As discussed in Louisville's motion to amend, Wine Group is not prejudiced in any way by Louisville's amended counterclaim answer. The situation is instead quite the contrary. In its motion to strike, Wine Group complained that Louisville's originally-stated affirmative defenses were not sufficient for it to understand the bases for those defenses. Louisville's amended answer addressed that complaint by providing fair notice of the bases for its affirmative defenses. In sum, Louisville did not

amend its counterclaim answer *sua sponte* – rather, it did so in response to Wine Group’s complaint, in order to address that complaint.

III. Opposition to Wine Group’s Second Motion to Strike.

As discussed in Louisville’s opposition to Wine Group’s first motion to strike, the Board does not favor motions to strike, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. TBMP § 506.01; *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401, 402 (TTAB 1973); C. Wright & A. Miller, Federal Practice and Procedure Civil 3d § 1380 (2011). Here, Louisville’s amended affirmative defenses clearly bear on issues in the case, and thus should not be stricken.

Moreover, a pleading needs only to give fair notice of the claims or defenses asserted. TBMP 506.01; *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB 1985). Here, the amended affirmative defenses clearly set forth the bases for the defenses, and as set forth in the Board’s April 5, 2013 Order, are sufficient to give Wine Group fair notice.

Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. TBMP 506.01; C. Wright & A. Miller, Federal Practice and Procedure Civil 3d § 1381 (2011). Here, the amended affirmative defenses raise factual issues concerning Wine Group’s prior knowledge of the use

and registration of Louisville's marks as well as factual issues concerning Wine Group's motivation in this matter. These factual issues should be determined on the merits.

Wine Group's second motion to strike makes essentially the same arguments as its first motion to strike, which was properly denied as moot. In its motion, Wine Group argues the merits of Louisville's affirmative defenses, and this not the place for that. Wine Group will have ample opportunity to argue the merits of the affirmative defenses during the trial phase. Indeed, the fact that Wine Group is arguing the merits proves the point that the affirmative defenses bear upon the issues in the case, and raise factual issues that should be determined at trial.

CONCLUSION

For all the above reasons, Wine Group's reconsideration request and second motion to strike should be denied. The granting of Louisville's motion to amend was proper and should stand.

Respectfully submitted,

/John A. Galbreath/

John A. Galbreath
Galbreath Law Offices
2516 Chestnut Woods Ct.
Reisterstown, MD 21136-5523
TEL: 410-628-7770
FAX: 410-666-7274
EMAIL: jgalbreath@galbreath-law.com

Attorneys for Opposer

Certificate of Service: I certify that on the date below, the foregoing Opposition to Reconsideration Request, Reply in Motion to Amend, and Opposition to Second Motion to Strike and referenced attachments, if any, were sent by first-class mail to:

PAUL W. REIDL
LAW OFFICE OF PAUL W. REIDL
241 EAGLE TRACE DRIVE, SECOND FLOOR
HALF MOON BAY, CA 94019

19 April 2013

/John A. Galbreath/
John A. Galbreath