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

Proceeding	91212445
Party	Plaintiff Red Bull GmbH
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Attachments	RB v. Bullstone - 91212445 - Resp to App's Oppo to Resp to Status Inquiry and XMtn for Term - Final.pdf(132838 bytes )



Additionally, proceedings were suspended at the time Applicant filed its combined Opposition to Board-Ordered Suspension and Cross Motion for Termination, rendering Applicant's motion out of order.

On March 7, 2016, Applicant filed its Opposition to Board-Ordered Suspension, taking issue with the rules and Board procedure, arguing that the above-captioned opposition should no longer be suspended for the completion of the deposition on written questions procedure. Applicant's Opposition to Board-Ordered Suspension is not an *opposition* at all where Opposer did not file any motion in the first place, but rather Applicant's expression of its distaste for the rules and Board practice.<sup>3</sup> Opposer is not guilty of avoidance or delay and is simply following the necessary procedure for taking a deposition on written questions in Austria. In this Opposition to Board-Ordered Suspension, Applicant offered no evidence that the continued suspension of proceedings and the taking of the deposition on written questions of Jorge Casals will be prejudicial to Applicant in any way. Applicant's Opposition to Board-Ordered Suspension is simply another pointless, argumentative motion, similar to previous motions filed by Applicant in this proceeding.<sup>4</sup> The above-captioned proceeding should remain suspended pending the completion of the deposition on written questions of Jorge Casals, a procedure known to be very involved, and requiring various levels of government and diplomatic approval.

## **II. Opposer Has Followed Proper Procedure for Taking Testimony and Proceedings Should Remain Suspended, In Accordance With The Rules and Board Practice**

Opposer has followed proper procedure, from serving timely and proper pretrial disclosures<sup>5</sup>, to serving its Notice of Taking Testimony Deposition of Jorge Casals on Written Questions<sup>6</sup>, to exchanging rounds of

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<sup>3</sup> Applicant's filing amounts to a motion to disregard the rules, captioned as an "opposition" in an attempt to somehow improperly shift the burden onto Opposer to *support* the rules surrounding the current suspension.

<sup>4</sup> Similar to previous motions filed by Applicant in this proceeding, this is yet another "unfortunate and unnecessary" motion and an example of a motion that will result in "needless motion practice, increased costs to the parties, [and] unnecessary utilization of Board resources and delay." *See* Proceedings Resumed, Docket No. 13 (May 7, 2015).

<sup>5</sup> Applicant states that Opposer's "[p]re-[t]rial disclosures list seven potential witnesses and listed no specific documents," in an attempt to make it sound as if Opposer has somehow fallen short of the requirements. This statement is one of many examples of Applicant's failure to be forthright. The Trademark Trial and Appeal Board Manual of Procedure ("TBMP") specifically states that "the Board does not require the pretrial disclosure of each document or other exhibit that a party plans to introduce at trial." *See* TBMP Section 702.01.

<sup>6</sup> Opposer's Notice of Taking Testimony Deposition of Jorge Casals on Written Questions ("Notice") was timely served within ten days of the opening of its testimony period and complied with all requirements sent out in the rules and TBMP. *See* 37 C.F.R. Section 2.124 and TBMP Section 703.03. Additionally, Opposer, in its Notice, explicitly stated that it also has

questions with Applicant and serving a finalized set of testimony deposition questions on Applicant<sup>7</sup>, to complying with all necessary domestic and foreign regulations for taking the deposition on written questions of an individual living outside of the United States. Indeed, the individual providing testimony in this case is in a country that does not subscribe to the Hague Evidence Convention<sup>8</sup>. As a result, the process is more complex, necessarily involving local counsel to address not only legal issues but local customs and procedure for cooperation with U.S. authorities.<sup>9</sup> Opposer is simply following the necessary steps to comply not only with U.S. law, but also foreign law.<sup>10</sup>

Opposer is not guilty of avoidance or undue delay, but is diligently moving through the required process. Applicant has not shown any prejudice by Opposer's actions – Applicant has simply expressed a distaste for Board practice and has failed to meet the extremely high burden of showing why the rules and Board procedure should be disregarded in this instance. In fact, the instant opposition proceeding has progressed with relatively few delays or interruptions and is simply suspended in accordance with the rules and Board practice.<sup>11</sup> Despite Applicant's statements in its Opposition to Board-Ordered suspension, made in an attempt to make the current Board-Ordered suspension seem unnecessary, Opposer has never once stated, or given the impression, that Opposer is "unable to obtain discovery"<sup>12</sup> from Mr. Casals. Opposer has not sought to obtain any discovery from Mr. Casals – the discovery period in this case has closed and Opposer is now in its testimony period. Opposer is simply following the necessary procedure to take the testimony deposition of Jorge Casals on written questions in compliance with all U.S. and foreign laws. Additionally, Opposer has never stated that "it is not possible to take

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domestic depositions to be taken, following the procedure for the deposition on written questions of Jorge Casals.

<sup>7</sup> See 37 C.F.R. Section 2.124(b)(1) and TBMP Section 703.03(g).

<sup>8</sup> Applicant, again being less than forthright, flip flops between saying Austria is a member of the Hague Convention and then saying Austria is not a member of the Hague Convention, stating at one point that Austria IS a member of portions of the Hague Convention and has been since 1955. Austria is not a member to the relevant Hague Convention here (i.e. the Hague Evidence Convention), but is a signatory to some parts of the Hague Convention, such as the Hague Child Abduction Convention, developed by the Hague Conference on Private and International Law. This clearly has no relevance here.

<sup>9</sup> As Applicant notes, obtaining the necessary permission in Austria can be challenging, but is certainly not impossible, which is exactly why Opposer has taken great care in preparing its request.

<sup>10</sup> Contrary to Applicant's assertions, the fact that Mr. Casals is an employee of Red Bull GmbH, a willing witness and a lawyer does not allow Opposer to ignore domestic and foreign rules and laws.

<sup>11</sup> There have been extensions earlier in this proceeding, one fully briefed and granted by the Board and others with consent (two largely for Applicant's benefit and one at the request of Opposer).

<sup>12</sup> See Opposition to Board-Ordered Suspension, p. 5.

the deposition of Mr. Casals in Austria by any of the proposed procedures.”<sup>13</sup> Opposer is diligently following the deposition on written questions procedure, as proscribed by the rules and Board Practice, to take Mr. Casals testimony deposition on written questions. The current suspension is of no *benefit* to either party, but rather a suspension by operation of the rules of complete the deposition of a necessary witness living outside of the U.S. This is not an unnecessary delay. As shown above, Opposer has been diligent in following the proper procedure for its testimony period and its deposition on written questions. In accordance with the rules and Board practice, the above-captioned proceeding should remain suspended until the pending deposition on written questions of Jorge Casals is complete.

#### **IV. Applicant’s Cross Motion to Terminate/Motion to Dismiss<sup>14</sup> is Untimely and Should Not Be Considered**

Applicant filed its Opposition to Board-Ordered Suspension and Cross Motion for Termination on March 7, 2016. During this time, proceedings were (and still are) suspended per the Board’s July 6, 2015 order, suspending proceedings pending completion of the testimony deposition of Jorge Casals on written questions. As Applicant’s Cross Motion to Terminate/Motion to Dismiss is not germane to the testimony deposition on Jorge Casals, this motion should not be considered at this time. Opposer does not want to perpetuate this violation of the Board’s suspension by addressing outside issues. Should the Board decide it would like Opposer to provide its arguments against Applicant’s Cross Motion to Terminate/Motion to Dismiss, Opposer requests that the Board issue an order requesting such a response and Opposer will be happy to provide its arguments against Applicant’s motion.

#### **V. Conclusion**

In view of the foregoing, Opposer submits that Opposition No. 91-212,445 should remain suspended pending the completion of the deposition on written questions of Jorge Casals, in accordance with the rules and Board practice.

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<sup>13</sup> See Opposition to Board-Ordered Suspension, p. 6.

<sup>14</sup> *Id.* at 8.

Dated: March 28, 2016

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that a true and correct copy of the foregoing **RESPONSE TO APPLICANT'S OPPOSITION TO RESPONSE TO STATUS INQUIRY AND CROSS MOTION FOR TERMINATION OF OPPOSITION** is being served on March 28, 2016, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Applicant at:

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