

ESTTA Tracking number: **ESTTA600242**

Filing date: **04/23/2014**

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

Proceeding	91213097
Party	Plaintiff Luxco, Inc.
Correspondence Address	MICHAEL R ANNIS HUSCH BLACKWELL LLP 190 CARONDELET PLAZA, SUITE 600 ST. LOUIS, MO 63105 UNITED STATES mike.annis@huschblackwell.com, alan.nemes@huschblackwell.com, andy.gilfoil@huschblackwell.com
Submission	Opposition/Response to Motion
Filer's Name	Andrew R. Gilfoil
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Signature	/s/ Andrew R. Gilfoil
Date	04/23/2014
Attachments	Opposition.PDF(467379 bytes)

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

LUXCO, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. 91213097
)	
RADILLO, JOSE ADRIAN CORONA,)	Serial No. 77/752453
)	Mark: GENERACION REBELDE
)	
Applicant.)	

**LUXCO’S RESPONSE IN OPPOSITION TO APPLICANT’S MOTION TO
SUSPEND**

Opposer Luxco, Inc. (“Luxco”), by and through its undersigned attorneys and pursuant to 37 C.F.R. §2.127(a), submits the following opposition to Applicant Jose Adrian Corona Radillo (“Radillo” or “Applicant”)’s Motion to Suspend, filed in this matter on April 3, 2014 [Dkt. 11].

INTRODUCTION

Simply stated, the present motion to suspend these proceedings should be soundly rejected. Applicant seeks a stay of all deadlines in this matter pending the ultimate resolution of Cancellation No. 92058411 (the “Cancellation Action”), an unrelated pending action Luxco brought against a third-party seeking cancellation of the Trademark Registration of Opici IP Holdings, LLC for the term “REBELLION.” Applicant cites no pertinent rule or authority supporting its request that the Board do so. At a minimum, the Board’s settled Rules of Practice require Applicant, as the movant, to demonstrate that good cause supports its request to suspend these proceedings. Applicant fails to even make any averment that any such “good cause” purportedly exists here. In so doing

Applicant fails to satisfy its burden in bringing the present Motion. For this reason alone, Applicant's Motion to Suspend should be denied.

As more fully set forth below, Applicant request is an untoward effort to obfuscate Luxco's discovery needs. Luxco has repeatedly attempted to meet and confer with Applicant to resolve deficiencies in its prior discovery responses. Applicant has failed and refused to supplement its responses or even meet and confer with Luxco to discuss these issues. Instead, by employing delay tactics Applicant's Motion here can only be seen as an effort to avoid its well-settled discovery obligations and preclude Luxco from raising these prior discovery deficiencies with the Board by way of appropriate discovery motions. This procedural gamesmanship cannot be rewarded.

FACTUAL BACKGROUND

1. Discovery opened in this matter on December 30, 2013, and is set to close on June 28, 2104. (*See* Scheduling Order [Dkt. 2], p. 2.)

2. On December 30, 2013, Luxco served Applicant with its initial Interrogatories, Requests for Production of Documents and Requests for Admission. Approximately thirty (30) days later, Applicant provided its responses to these requests by, for all intents and purposes, identifying a laundry list of boiler-plate objections and stating that it would subsequently make documents available.

3. Having received no production from Applicant and, in an effort to meet and confer regarding these discovery deficiencies, Luxco wrote Applicant's counsel on March 27, 2014, identified numerous deficiencies and asking that Applicant's counsel contact Luxco's counsel to discuss these issues telephonically. (*See* Mar. 27, 2014, letter from M. Annis to S. Halpern, a copy of which is attached hereto at Ex. A.)

4. On April 4, 2014, having received no response to the March 27, 2014 letter, Luxco sent a follow-up e-mail to Applicant's counsel, again asking that counsel advise "as soon as practical when you are available to discuss." (*See* Apr. 4, 2014, e-mail correspondence from A. Gilfoil to S. Halpern, a copy of which is attached hereto as Ex. B.)

5. That same day, counsel noted that Applicant would "provide you with a substantive response shortly." (*See* Apr. 4, 2014, e-mail correspondence from S. Halpern to M. Annis, a copy of which is attached hereto as Ex. C.)

6. Luxco again followed up with Applicant via e-mail two weeks later, because, despite promising to provide a substantive response, Applicant did not do so. (*See* Apr. 18, 2014, e-mail from A. Gilfoil to S. Halpern, a copy of which is attached hereto as Ex. D, at p. 2.)

7. Instead of providing the promised response, Applicant instead filed the present Motion on April 3, 2014. (*See* Motion [Dkt. 11].)

7. Applicant has not provided any further substantive response or production since that time, although Applicant again professes that it will do so "in the next week." (*See Id.* at p. 1.)

ARGUMENT AND AUTHORITIES

I. APPLICABLE LEGAL STANDARD GOVERNING APPLICANT'S REQUEST

Applicant's Motion states that it is brought pursuant to section 501.03 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"). However, section 501.03 actually deals with Stipulations. *See* TBMP §501.03. Here, Applicant did not even inform Luxco that it intended to file the present motion, let alone request that Luxco

stipulate to its request to suspend this proceeding. As such, Section 501.03 has no application here.

To be sure, Luxco does not stipulate to Applicant's request to suspend this matter. In fact, this matter should proceed on the schedule provided because, as more fully set forth below, Applicant has failed to satisfy its burden to prove to this Board that these proceedings should be suspended.

The standard governing a Motion to Suspend is provided in Trademark Rule 2.117. *See* 37 C.F.R. §2.117(c). As the movant, Applicant bears the burden of showing that good cause supports its request to suspend this matter. *See* 37 CFR §2.117(c). "Good cause" does not exist where the suspension request is filed for purposes of delay rather than advancing resolution of a party's claims. *See Jodi Kristopher Inc. v. Int. Seaway Trading Corp.*, 91 U.S.P.Q.2d 1957, 1959 (TTAB 2009); *Boyd's Collection Ltd. v. Herrington & Co.*, 65 U.S.P.Q.2d 2017, 2018-19 (TTAB 2003). Good cause has also been found lacking where a party seeks to suspend rather than complying with outstanding discovery demands. *See, e.g., Giant Food, Inc. v. Standard Mills, Inc.*, 96 U.S.P.Q.2d 1134, 1136 (TTAB 2010)(finding that filing of meritless motion evidenced effort to further obstruct opposing party's "rights to obtain discovery under the Board's rules"). Finally, it is well settled that an unconsented motion to suspend is not appropriate where, as here, the movant asks that the proceeding be suspended pending the disposition of another matter before the Board. *See* TBMP §510.02(a); *see also New Orleans Louisiana Saints, LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d 1550, 1551 (TTAB 2011)(denying Applicant's motion to suspend case pending disposition of other oppositions where "instant opposers have not consented").

Particularly, with respect to motions to suspend pending resolution of another matter, the Board has stated that it is not appropriate to simply pick “one among multiple oppositions to proceed” and suspend the others, because doing prejudices those parties “who did not consent to suspension.” *Id.* For this reason, in the absence of consent the Board will routinely deny a Motion to Suspend based on a movant’s bare assertion that because the claimant in another “may be successful,” that it may at some later date, purportedly make the instant proceeding “moot.” *Id.*

II. APPLICANT FAILS TO MEET ITS BURDEN OF ESTABLISHING GOOD CAUSE FOR ITS MOTION TO SUSPEND THIS PROCEEDING

First and foremost, Applicant has not identified any “good cause” supporting its request to suspend this matter. (*See* Motion [Dkt. 11].) Applicant offers no averment that “good cause” exists here, nor does it submit any facts that purportedly show Applicant’s good cause in bringing the present Motion.¹ The reason for Applicant’s failure to do so is plain: no good cause exists. As Applicant fails to meet the burden in bringing the present motion, the present request should be denied on this basis alone.

The facts here make equally clear that no “good cause” could exist to support Applicant’s request. First, Applicant’s assertion that the Respondent in the Cancellation Action has moved to cancel all of the registrations upon which Luxco relies here is unfounded. (*See* Motion [Dkt. 11], at p. 1.) To the contrary, Luxco has pled four independent REBEL Marks here, as well as its prior common law rights. (*See* Notice of Opposition [Dkt. 1], at ¶¶3-6.) In the Cancellation Action, the Registrant has filed

¹ To the extent Applicant in reply attempts to do so for the first time, Applicant’s untimely attempt to submit additional arguments or claims should be ignored as improper. *DC Comics Inc. v. Scholastic Magazines, Inc.*, 210 U.S.P.Q. 299, 300 n. 1 (TTAB 198)(giving no consideration to reply brief); *see also In re Caterpillar Inc.*, 43 U.S.P.Q.2d 1335 (TTAB 1997)(new materials submitted in reply untimely and not considered).

counterclaims seeking to cancel only two of these Marks, and has raised no similar counterclaims with respect to Luxco's prior common-law rights or Luxco's ownership of its FOUR REBELS and 4 REBELS Marks. (*See* Answer and Affirmative Defenses to Petition for Cancellation and Counterclaims, attached hereto as Ex. E, at p. 4.) Thus, even if the Registrant in the Cancellation Action were ultimately successful on the merits, it would have no import on the separate and independent federal and common law rights that Luxco has pled here. In short, Applicant has failed to offer any factual support for its assertion that the Cancellation Action will purportedly have significant "impact" on this matter warranting suspension of this matter. (*See* Motion [Dkt. 11], p. 1.)

Moreover, the Registrant's counterclaims in the Cancellation Action are not well founded. For this reason, and because they fail to state any valid claim under the Lanham Act, Luxco has moved to dismiss Registrant's second and third counterclaims. (*See* Luxco's Motion to Dismiss, a copy of which is attached hereto as Ex. F.) If Applicant truly believed that these counterclaims had any validity its proper course of action would have been to file counterclaims in this matter seeking to cancel the referenced U.S. Trademark Registrations. Applicant failed to do so, and has instead answered Luxco's Notice of Opposition and submitted affirmative defenses. (*See* Answer [Dkt. 4].)² As such, Applicant should not now be heard to claim that this case should be suspended for an indeterminate period pending resolution of unfounded claims in an unrelated matter. Having failed to satisfy its burden, the Board should reject Applicant's unsupported assertions that if the Registrant there "may be successful" at some future point in time it

² If Applicant truly believed that the asserted counterclaims had merit it presumably would have asserted the same or substantially similar counterclaims here. Applicant tellingly failed to do so.

would somehow “moot” Luxco’s claims in this matter. *See New Orleans Louisiana Saints, LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d at 1551.

In truth, Applicant’s request in the present motion has not been submitted in good faith and as such cannot possibly constitute “good cause” to suspend these proceedings. As noted above, Applicant has consistently failed and refused to satisfy its discovery obligations in this matter despite having had months now to do so. Luxco has made multiple attempts to obtain supplemental discovery responses and document production, but Applicant has undertaken a pattern of delay and has refused to supplement its responses or even meet and confer with Luxco regarding these deficiencies—despite promising that it would do so. (*See Ex. A-D.*)³ Instead of following through with its prior commitment, Applicant has filed the present request with the Board, presumably in an improper effort to prevent Luxco from seeking resolution of Applicant’s discovery deficiencies by way of a Motion to Compel. The Board should reject Applicant’s unsupported request and gamesmanship as wholly lacking in any “good cause.”

CONCLUSION

Simply stated, Applicant has failed to satisfy the standard it bears in bringing this motion to provide good cause supporting its request that the Board suspend these proceedings. No good cause is alleged, as none exists. Applicant has repeatedly refused to comply with its discovery obligations in this matter and should not be rewarded for undertaking a procedural ploy to preclude Luxco from bringing Applicant’s discovery

³ As the Board will recall, this is not the first time Applicant has refused to meaningfully undertake its discovery obligations in a timely fashion. As more fully set forth in Luxco’s Response to Applicant’s prior Motion for Discovery Conference, Applicant refused to respond to multiple requests from Luxco to schedule the required Discovery Conference. (*See* Response [Dkt. 6], at p. 2-4 and Exs. A-E attached thereto.) Instead of communicating with Luxco, Applicant instead filed a Motion with the Board asking that the interlocutory attorney participate in the discovery conference.

deficiencies to the Board's attention by way of a Motion to Compel. Accordingly, because Applicant has fundamentally failed to satisfy its burden here, the Board should deny Applicant's Motion to Suspend and order that Applicant meet and confer with Luxco regarding its supplemental discovery responses within fourteen (14) days or else face sanctions for failure to do so.

Respectfully submitted,

Dated: April 23, 2014

By: /s/ Andrew R. Gilfoil

Michael R. Annis

Alan S. Nemes

Andrew R. Gilfoil

HUSCH BLACKWELL LLP

190 Carondelet Plaza, Suite 600

St. Louis, Missouri 63105

Telephone: (314) 480-1500

Fax: (314) 480-1505

Attorneys for Opposer Luxco, Inc.

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that a copy of the foregoing was served via U.S. mail and electronic mail on this 23rd day of April, 2014 upon:

Stacey R. Halpern
Knobbe Martens Olson & Bear LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Stacey.Halpern@knobbe.com

/s/ Andrew R. Gilfoil

HUSCH BLACKWELL

Michael R. Annis
Partner

190 Carondelet Plaza, Suite 600
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mike.annis@huschblackwell.com

March 27, 2014

VIA ELECTRONIC DELIVERY and U.S. MAIL

Stacey R. Halpern
Knobbe, Martens, Olson & Bear, LLP
2014 Main Street
14th Floor
Irvine, CA 92614
stacey.halpern@knobbe.com

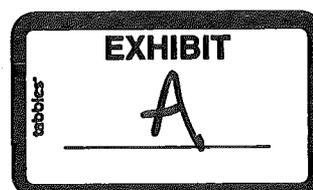
Re: *Luxco, Inc. v. Jose Adrian Corona Radillo*
United States Patent and Trademark Office, Trademark Trial and Appeal Board
Opposition No.: 91213097
Request for Meet and Confer regarding Applicant's Objections and Responses to
Luxco's Initial Discovery Requests

Dear Ms. Halpern:

Please allow this letter to serve as Luxco's request that counsel meet and confer to address Luxco's perceived deficiencies in Applicant's Objections and Responses to Luxco's Initial Interrogatories, Request for Production and Request for Admissions in the above-referenced matter. Frankly, Applicant made little to no effort to respond to the aforementioned discovery requests. As such, our time is likely better served discussing this matter telephonically. However, I will, in an overabundance of caution, outline in very broad strokes some of the issues we will need to discuss. Again, the main purpose of this letter is to ask that you provide us with several dates and times over the next few weeks when we could conduct a meet and confer, as contemplated under the trademark rules of practice. I have general availability the week of March 31st and further have time available on April 7 and 8. To the extent that I am unavailable, I am sure that my associate, Andy Gilfoil, could fill in and conduct a meet and confer in an efficient fashion. Again, I will in broad strokes outline some of the perceived deficiencies below:

I. Applicant's Responses to Luxco's First Set of Admissions

In response to Request Nos. 2 and 3, Applicant objected suggesting that terms used in those requests were "vague and ambiguous." The terms objected to have clear and unequivocal



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meaning, particularly in the context in which they were used. Demand is made that you withdraw the objections and respond to the request as submitted.

In response to Request Nos. 4 – 11, Applicant objects suggesting that the request is premature. It is unclear how this request can be premature in that, pursuant to the schedule entered by the Board, we are in the midst of the discovery process. Further, your client had, at least at one time, filed the application that is the subject of this opposition under the “intent to use” provisions of the Lanham Act. Request Nos. 4, 6, 8 and 10 are all couched as “intended” potential uses of the subject marked in U.S. Commerce. Request Nos. 5, 7, 9 and 11 are generally directed to potential or likely channels of trade for goods bearing the subject mark. Again, this is an issue that is not “premature” or a subject that is otherwise improper for inquiry. Request No. 16 has the same objections and equivocal response to similar request.

As to the same requests (4 - 11), you state, subject to and without waiving the aforementioned objection that Applicant is insufficient to admit or deny these assertions. It is difficult to understand how that would be possible. We obviously need to discuss this putative response.

Request nos. 12-15 seeks an admission that products bearing the mark can be ordered orally, or by voice command, by intended purchasers. I do not think that “requested orally” is vague in any sense and demand is made that you provide full and complete responses to these requests at your earliest opportunity.

Request nos. 17-21 are directed to whether the subject mark, the definition of which includes Application No. 77/752,453, places any of the noted restrictions on ultimate offer and/or sale of products bearing the mark in U.S. Commerce. Again, these requests are straight forward and could not be clearer. Again, demand is made that full and complete responses be provided to these requests at your earliest convenience.

II. Applicant’s Response to Opposer’s Request for Production of Documents

First, it appears that each of Applicant’s responses to the document request responded to in a very similar fashion, if not identically. Applicant makes broad unsubstantiated objections and then states that it will, subject to and without waiving those objections make documents available. Unfortunately, no documents were provided with the request. Please advise when you will produce all responsive documents to these requests. Thank you in advance for your courtesies in this regard. In that you provided the written responses on February 3, 2014, more than a month ago, I would hope that, by now, you have obtained all of the requested materials from your client and will be producing before April 4, 2014. That would give you over six (6) weeks from the date the responses were provided.

In response to Request 5, you object suggesting that the requested information is irrelevant to these proceedings, even though Applicant relies on foreign registrations as the basis for the pending application. You must immediately withdraw this objection and provide the requested information. Similarly, Request No. 6 ask Applicant to provide documents showing any ownership interest in businesses that own marks using the term “REBEL” and/or “REBELDE.” There can be no legitimate question that this information is relevant to this

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proceeding. For the same reasons, Applicant's irrelevance objections to Request No. 10 are unfounded and must be withdrawn.

Request No. 8 seeks to production of any trademark searches conducted by Applicant or any agents on its behalf with respect to the subject mark. Applicant objects suggesting that the same is irrelevant, over broad, unduly burdensome and oppressive. It is unclear whether Applicant is hiding behind these objections by its failure to produce the requested information. As you know, searches are extremely relevant to key issues in this matter such as whether Applicant was aware of Luxco's rights in the term "REBEL" with respect to alcoholic beverages before the subject application was filed. Please provide the requested information at your earliest opportunity.

Request Nos. 31-33 are generally directed to Applicant's purported intent to use the subject mark in U.S. Commerce and any activities that would objectively support any alleged intent. The grounds under which the present application was filed, §§ 1(b) and 44(e), both require Applicant's to provide a declaration including an averment that the Applicant has a bona-fide intention to use the subject mark in U.S. Commerce. Without question each and every one of these requests is relevant to that matter, particularly where Luxco contends that Applicant lacked that bona-fide intent with respect to the subject application. Please withdraw your objections and produce the requested information at your earliest opportunity.

The fact that I have skipped over several requests is not indicative that Applicant's objections, if any, to those requests are well taken. To the contrary, Applicant's objections are not well founded and must be withdrawn. Again, we can discuss these matters further at our required meet and confer on the matter.

III. Applicant's Response to Opposer's First Set of Interrogatories

In general objection 2, Applicant objects to providing a privilege log for this matter. First, Applicant failed to provide a required verification for its punitive answers to Luxco's interrogatories. Applicant just had more than six (6) weeks to supplement its response with the required verification. Please provide the same immediately. Your prompt attention to this request is appreciated. Is it truly Applicant's contention that a privilege log is not required for documents withheld by Applicant based upon an assertive privilege?

Many, if not all, of Applicant's responses to Luxco's Interrogatories provide that Applicant will respond pursuant to Rule 33(d). As you are well aware, that rule requires that with the actual response Applicant actually provide copies of the documents purporting to respond to the subject interrogatory and further that Applicant's specifically identify each and every document that purports to provide Applicant's response to a particular interrogatory. Applicant has failed to do this. If Applicant truly intends to rely on Rule 33(d), Applicant must update the following interrogatories once:

Interrogatory No. 1-9, 14, 16-18, 20-21, 25-26, and 29.

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Interrogatory No. 30, which seeks identification of foreign trademark registrations, was objected to as being irrelevant, overly broad and unduly burdensome and seeking information protected by privilege. No privilege log was provided and, as noted above, the fact that the application is based upon a foreign registration shows relevance and narrowness of the interrogatory. Your failure to identify the "undue burden" renders the objection meritless.

Again, I do not think it is productive to go through each and every interrogatory to address the noted objections. I think our time is better spent discussing these matters by phone and determining what, if anything, that Applicant is prepared to do to withdraw unsupported objections and supplement its responses.

We look forward to hearing from you in regards to the above and addressing Applicant's objections and responses as provided in the trademark rules of practice.

Very truly yours,

/s/ Michael R. Annis

Michael R. Annis

MRA/kb

cc: Andy Gilfoil, Esq.

Gilfoil, Andy

From: Gilfoil, Andy
Sent: Friday, April 04, 2014 3:41 PM
To: 'stacey.halpern@knobbe.com'
Cc: Annis, Michael; Gilfoil, Andy
Subject: RE: Luxco, Inc. v. Jose Adrian Corona Radillo

Ms. Halpern,

This is in further response to prior correspondence from Mike Annis dated March 27 regarding deficiencies in Applicant's discovery responses. We have received no response regarding these issues nor any dates when you are available to discuss these issues. Please let me know as soon as practical when you are available to discuss.

As you know, discovery is well underway in this proceeding and is set to close on June 28. Accordingly, if we are unable to receive any meaningful response from Applicant regarding these discovery deficiencies by next Wednesday, April 9, we will need to proceed with filing appropriate motions with the Board to compel satisfactory responses and production.

I look forward to hearing from you as soon as practical regarding these issues.

Best,

Andy

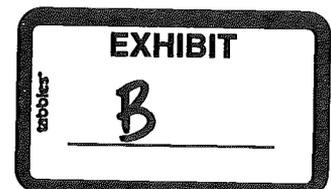
Andrew R. Gilfoil
Attorney
Direct: 314.480.1812
Andy.Gilfoil@huschblackwell.com

From: Smith, Celeste
Sent: Thursday, March 27, 2014 11:16 AM
To: 'stacey.halpern@knobbe.com'
Cc: Annis, Michael; Gilfoil, Andy
Subject: Luxco, Inc. v. Jose Adrian Corona Radillo

This correspondence is being sent to you on behalf of Michael R. Annis, Esq. regarding the above-styled case.

Celeste M. Smith
Legal Administrative Specialist

HUSCH BLACKWELL LLP
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Gilfoil, Andy

From: Lori.Gillette <Lori.Gillette@knobbe.com>
Sent: Friday, April 04, 2014 3:48 PM
To: Annis, Michael
Cc: 2srh; grupo.004m.kmob@iwcs.kmob.com; Lisa.Helmle; Smith, Celeste; Gilfoil, Andy
Subject: FW: Luxco, Inc. v. Jose Adrian Corona Radillo

Sent on behalf of Stacey Halpern:

Michael,

I am in receipt of your correspondence. We are reviewing this matter and we will provide you with a substantive response shortly.

Stacey

Stacey Halpern

Partner
Stacey.Halpern@knobbe.com
949-721-6301 Direct

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INTELLECTUAL PROPERTY LAW

five decades. one focus.

2040 Main Street, 14th Floor
Irvine, CA 92614

From: Smith, Celeste [<mailto:Celeste.Smith@huschblackwell.com>]
Sent: Thursday, March 27, 2014 9:16 AM
To: Stacey.Halpern
Cc: Annis, Michael; Gilfoil, Andy
Subject: Luxco, Inc. v. Jose Adrian Corona Radillo

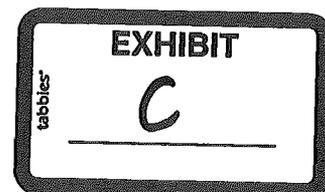
This correspondence is being sent to you on behalf of Michael R. Annis, Esq. regarding the above-styled case.

Celeste M. Smith
Legal Administrative Specialist

HUSCH BLACKWELL LLP
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St. Louis, MO 63105-3433
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intended recipient, please contact the sender by reply email and destroy all copies of the original message.

Gilfoil, Andy

From: Gilfoil, Andy
Sent: Tuesday, April 22, 2014 11:29 AM
To: 'Lori.Gillette'
Cc: 2srh; Lisa.Helmle; grupo.004m.kmob@iwcs.kmob.com; Annis, Michael; Gilfoil, Andy
Subject: RE: Luxco, Inc. v. Jose Adrian Corona Radillo

Stacey,

Luxco does not share your view regarding what constitutes a "reasonable" delay. Applicant's prior responses to Luxco's production requests stated that Applicant would make documents available to the extent any responsive documents existed. In addition, the vast majority of Applicant's responses to Luxco's Interrogatories simply responded pursuant to Rule 33(d) and indicated that copies of documents would be made available. Luxco assumed that Applicant, as a foreign entity, was in the process of gathering these documents and that it would be making a forthcoming production. Applicant has presumably had ample time by now to gather responsive documents.

Your email fails to note that it was Applicant--not Luxco--who stated on Apr. 4 that it would be providing a substantive response "soon." Applicant failed to provide any supplemental response, nor did we receive any follow-up call or e-mail from you regarding these issues. Instead, with no notice to Luxco, Applicant filed a motion asking the Board to suspend all deadlines in this matter. Despite your prior commitment on April 4 to provide same, no substantive response has been received from Applicant as of this writing. In any event, I look forward to your renewed commitment to provide supplemental responses on or before next Monday.

Andy

Andrew R. Gilfoil
Attorney
Direct: 314.480.1812
Andy.Gilfoil@huschblackwell.com

From: Lori.Gillette [mailto:Lori.Gillette@knobbe.com]
Sent: Monday, April 21, 2014 11:14 AM
To: Gilfoil, Andy
Cc: 2srh; Lisa.Helmle; grupo.004m.kmob@iwcs.kmob.com
Subject: FW: Luxco, Inc. v. Jose Adrian Corona Radillo

Sent on behalf of Stacey Halpern:

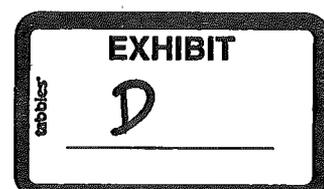
RULE 408 - FOR SETTLEMENT PURPOSES ONLY

Andy,

We note that it took over seven weeks from the date the responses were served for you to contact us to advise us that, in your opinion, our client's responses were not satisfactory. As such, we assume that you consider a delay of almost two months to be a reasonable time period. Therefore, the two weeks we have been reviewing your letter and discussing it with our client would clearly seem to be a reasonable time frame in which to respond. In any event, our client will provide supplemental responses in the next week.

Stacey

Stacey Halpern
Partner
Stacey.Halpern@knobbe.com
949-721-6301 Direct



Knobbe Martens

INTELLECTUAL PROPERTY LAW

five decades. one focus.

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Irvine, CA 92614

From: Gilfoil, Andy [<mailto:Andy.Gilfoil@huschblackwell.com>]
Sent: Friday, April 18, 2014 1:27 PM
To: Stacey.Halpern
Cc: Annis, Michael; Nemes, Alan; Gilfoil, Andy
Subject: RE: Luxco, Inc. v. Jose Adrian Corona Radillo

Stacey,

I am following up on your April 4 email below where you indicate that you will provide a substantive response to Luxco's prior golden-rule letter "shortly." Unfortunately two weeks later we have received no further response regarding these issues, nor have you provided any availability as to when you can discuss these discovery issues. Please advise as soon as practical when you will be able to meaningfully respond to Luxco's discovery concerns. Absent a meaningful attempt by Applicant to meet and confer regarding these issues we will have no other option than to make an appropriate request from the Board regarding Applicant's discovery deficiencies.

I note that Applicant has now filed with the Board a Motion to suspend this proceeding. Applicant's request is without merit and Luxco will file its opposition to same. As you are no doubt aware, the Board's Rules make plain that a party's outstanding discovery obligations are not stayed by a subsequent suspension order from the Board. *See Super Bakery Inc. v. Benedict*, 96 U.S.P.Q.2d 1134, 1136 (TTAB 2010). Accordingly, we view Applicant's motion and continued refusal to engage in meaningful dialogue regarding Luxco's discovery concerns as improper efforts to preclude Luxco from obtaining critical discovery to which it is entitled in this matter.

I look forward to hearing from you as soon as practical regarding these issues.

Best,

Andy

Andrew R. Gilfoil
Attorney
Direct: 314.480.1812
Andy.Gilfoil@huschblackwell.com

From: Lori.Gillette [<mailto:Lori.Gillette@knobbe.com>]
Sent: Friday, April 04, 2014 3:48 PM
To: Annis, Michael
Cc: 2srh; grupo.004m.kmob@iwcs.kmob.com; Lisa.Helmle; Smith, Celeste; Gilfoil, Andy
Subject: FW: Luxco, Inc. v. Jose Adrian Corona Radillo

Sent on behalf of Stacey Halpern:

Michael,

I am in receipt of your correspondence. We are reviewing this matter and we will provide you with a substantive response shortly.

Stacey

Stacey Halpern

Partner
Stacey.Halpern@knobbe.com
949-721-6301 Direct

Knobbe Martens

INTELLECTUAL PROPERTY LAW
five decades. one focus.
2040 Main Street, 14th Floor
Irvine, CA 92614

From: Smith, Celeste [<mailto:Celeste.Smith@huschblackwell.com>]
Sent: Thursday, March 27, 2014 9:16 AM
To: Stacey.Halpern
Cc: Annis, Michael; Gilfoil, Andy
Subject: Luxco, Inc. v. Jose Adrian Corona Radillo

This correspondence is being sent to you on behalf of Michael R. Annis, Esq. regarding the above-styled case.

Celeste M. Smith
Legal Administrative Specialist

HUSCH BLACKWELL LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63105-3433
Direct: 314.345.6120
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ESTTA Tracking number: **ESTTA584230**

Filing date: **01/28/2014**

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

Proceeding	92058411
Party	Defendant Opici IP Holdings, LLC
Correspondence Address	OPICI IP HOLDINGS, LCC 25 DEBOER DRIVE GLEN ROCK, NJ 07430 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Stephen L. Baker
Filer's e-mail	officeactions@br-tmlaw.com,s.baker@br-tmlaw.com,p.chang@br-tmlaw.com,k.hnasko@br-tmlaw.com,s.cesaro@br-tmlaw.com,k.Drogowski@br-tmlaw.com
Signature	/Stephen L Baker/
Date	01/28/2014
Attachments	SCANS-2-Baker-Rannells140128153917.pdf(55560 bytes)

Registrations Subject to the filing

Registration No	3632812	Registration date	06/02/2009
Registrant	Luxco, Inc. 1000 Clark Avenue St. Louis, MO 63102 MACAU		

Goods/Services Subject to the filing

Class 033. First Use: 2008/09/29 First Use In Commerce: 2008/09/29 All goods and services in the class are requested, namely: liquors and distilled spirits
--

Registration No	727786	Registration date	02/20/1962
Registrant	LUXCO, INC. 5050 KEMPER AVENUE ST. LOUIS, MO 63139 MACAU		
Grounds for filing	The registered mark has been abandoned.		

Goods/Services Subject to the filing

Class 033. First Use: 1937/08/00 First Use In Commerce: 1937/08/00 All goods and services in the class are requested, namely: Straight Bourbon Whiskey



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

In re United States Registration No. 4407601
Filing Date: October 11, 2011
Mark: REBELLION

Luxco, Inc.,)
)
 Petitioner,)
)
 v.) Cancellation No. 92058411
)
 Opici IP Holdings LLC,)
)
 Registrant.)

**ANSWER AND AFFIRMATIVE DEFENSES
TO PETITION FOR CANCELLATION AND COUNTERCLAIMS**

Registrant, Opici IP Holdings, LLC, (“Registrant”), by and through its attorneys Baker and Rannels, PA, for its Answer, Affirmative Defenses and Counterclaim to the Petition for Cancellation filed by Petitioner, Luxco, Inc. (“Petitioner”), alleges on knowledge as to its own acts and otherwise upon information and belief as follows:

ANSWER

1. Admitted
2. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 2 of the Petition for Cancellation except that it admits the issuance of Registrations for Nos. 727,786 and 3,632,812.

3. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 3 of the Petition for Cancellation and therefore denies the same.
4. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 4 of the Petition for Cancellation and therefore denies the same.
5. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 5 of the Petition for Cancellation and therefore denies the same.
6. The allegations contained in Paragraph 6 of the Petition for Cancellation do not call for a response.
7. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 7 of the Petition for Cancellation and therefore denies the same.
8. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 8 of the Petition for Cancellation and therefore denies the same.
9. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 9 of the Petition for Cancellation and therefore denies the same.
10. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 10 of the Petition for Cancellation and therefore denies the same.

11. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 11 of the Petition for Cancellation and therefore denies the same.
12. Registrant has insufficient knowledge or information upon which to form a belief concerning the allegations contained in Paragraph 12 of the Petition for Cancellation and therefore denies the same.
13. Admitted except that it denies Petitioner's prior rights.
14. Denied.
15. Denied.
16. Denied.
17. Denied.
18. Denied

AFFIRMATIVE DEFENSES

19. Registrant repeats and re-alleges the allegations of paragraphs 1-18 hereof as if set forth fully herein.
20. As and for a first defense, the Petition for Cancellation fails to state a claim upon which relief can be granted
21. As and for a second defense, the Petition for Cancellation is barred by the acquiescence and laches in that the respective marks of the parties coexisted with the knowledge of and without prior legal action from Petitioner.
22. As and for a third defense, the Petition for Cancellation is barred by the doctrine of waiver and estoppel.

23. As and for a forth defense, the Petition for Cancellation is barred by Petitioner's failure to challenge the use of Rebel and/or Rebellion marks on related goods and services by unrelated third parties.

COUNTERCLAIMS FOR CANCELLATION OF

REG. NOS. 0727786 and 3632812

24. Registrant repeats and re-alleges the allegations of paragraphs 1 - 23 hereof as if set forth fully herein.

25. Petitioner is relying in part of on REG. NOS. 0727786 and 3632812 ("Petitioner's Alleged Mark") as the basis of the within cancellation.

26. As and for a first counterclaim, the Petitioner has abandoned its use of Petitioner's Alleged Mark in the United States by engaging in naked licensing of REBEL and/or REBELLION marks used by other parties.

27. As and for a second counterclaim, the Petitioner and/or its alleged predecessor-in-interest have failed to police the use Petitioner's Alleged Mark by unrelated third parties.

28. As and for a third counterclaim, the Petitioner and/or its alleged predecessor-in-interest have failed to police the use REBELLION by unrelated third parties.

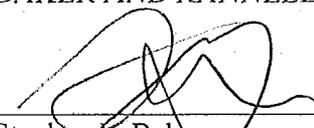
29. The continued existence of REG. NOS. 0727786 and 3632812 for Petitioner's Alleged Mark also creates a serious cloud on Registrant's continued right to use the mark sought to be cancelled, alone or in combination, for the goods set forth in its Reg. No. 4407601, which registration is the subject of these proceedings.

30. Registrant believes that it is and will be damaged by the continued registration of
Petitioner's Alleged Mark to Registrant.

WHEREFORE, Petitioner requests that the petition to cancel Registration No. 4407601
be denied and that REG. NOS. 0727786 and 3632812 be canceled

Dated: January 28, 2014

BAKER AND RANNELLS, PA

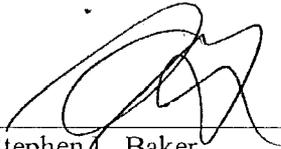
By: 

Stephen L. Baker
Attorney for Registrant
575 Route 28, Suite 102
Raritan, New Jersey 08869
(908) 722-5640

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION AND COUNTERCLAIMS has been served on Petitioner by first class mail this 28th day of January 2014:

Michael R. Annis
HUSCH BLACKWELL LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63108



Stephen L. Baker

ESTTA Tracking number: **ESTTA595406**

Filing date: **03/28/2014**

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

Proceeding	92058411
Party	Plaintiff Luxco, Inc.
Correspondence Address	MICHAEL R ANNIS HUSCH BLACKWELL LLP 190 CARONDELET PLAZA, STE 600 ST LOUIS, MO 63105 UNITED STATES mike.annis@huschblackwell.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Michael R. Annis
Filer's e-mail	andy.gilfoil@huschblackwell.com, mike.annis@huschblackwell.com, alan.nemes@huschblackwell.com
Signature	/s/ Michael R. Annis
Date	03/28/2014
Attachments	motion to dismiss.PDF(65098 bytes)



CERTIFICATE OF MAILING VIA ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals on March 28, 2014.

/s/ Andrew Gilfoil

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

LUXCO, INC.,)	
)	
Petitioner/Counter Registrant,)	
)	
v.)	Cancellation No. 92/058,411
)	
OPICI IP HOLDINGS, LLC)	
)	
Registrant/Counter Petitioner.)	

**LUXCO'S MOTION TO DISMISS REGISTRANT/COUNTERCLAIM PETITIONER'S
SECOND AND THIRD COUNTERCLAIMS FOR CANCELLATION OF U.S.
REGISTRATION NOS. 0727786 & 3632812 AND MEMORANDUM IN SUPPORT**

Petitioner/Counter Registrant Luxco, Inc. ("Luxco"), by and through its undersigned attorneys, in support of its Motion to Dismiss Registrant/Counterclaim Petitioner's Second and Third Counterclaims for Cancellation of U.S. Registration Nos. 0727786 & 3632812, states as follows:

INTRODUCTION

In its Answer, Affirmative Defenses and Counterclaims, Registrant/Counter Petitioner Opici IP Holding's LLC ("Opici") purports to plead three separate and distinct "counterclaims" (See Answer, Affirmative Defenses and Counterclaims [Dkt. 3], ¶¶ 26-28, at p. 4.) Specifically, Opici purports to seek cancellation certain of Luxco's pleaded registrations, particularly, U.S. Registration Nos. 0727786 for REBEL YELL (the "786 Registration") and 3,632,812 for

REBEL RESERVE (the “‘812 Registration”).¹ Although far from the picture of clarity, Opici’s second and third counterclaims are as follows:

Second counterclaim, as set forth in paragraph 27, that Luxco “and/or its alleged predecessor-in-interest have *failed to police and use* [Luxco’s trademarks in the ‘786 and ‘812 Registrations] by unrelated parties;” and

Third counterclaim, as set forth in paragraph 28, that Luxco “and/or its alleged predecessor-in-interest have *failed to police the use* (sic) *REBELLION* by unrelated third parties.”

(Emphasis added)

With its motion, Luxco seeks an order of the Board dismissing the nominated “second counterclaim” and “third counterclaim” in that the same fail to state a claim upon which relief may be granted. *See* Fed.R.Civ. P. 12(b)(6). “Failure to police use” of a party’s registered trademarks or related terms by unrelated third parties is not, in and of itself, a ground for cancellation of an existing trademark registration. In the alternative, Luxco requests that the Board require Opici to plead its second and third “counterclaims” with sufficient specificity and clarity to allow Luxco to fully and completely respond to the same.

ARGUMENT AND AUTHORITIES

I. Legal Standard.

A motion to dismiss a counterclaim for failure to state a claim upon which relief can be granted is simply a test of the legal sufficiency of pleaded counterclaim. *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir.1993). In order to withstand such a motion, the counterclaim must allege such facts that would, if proved, establish that the petitioner is entitled to the relief sought –

¹Luxco has filed, contemporaneously herewith, its Answer and Affirmative Defenses to Opici’s first counterclaim, set forth in paragraph 26 of its Answer, Affirmative Defenses and

cancellation of the noted US Trademark Registrations. In short, to survive a motion to dismiss, the counterclaim must “state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. vs. Twombly*, 550 USPQ 554,570 (2007); *Ashcroft vs. Iqbal*, 556 US 662, 129 S. Ct. 1937 (2009); *Doyle vs. Al Johnson’s Swedish Restaurant & Butik Inc.*, 101 USPQ 2d 1780, 1782 (TTAB 2012).

Here, Opici’s counterclaims must include specific averments that (1) Opici has standing to maintain the proceeding, and (2) a valid ground for cancelling the registration exists. *Young vs. AGB Corp*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1989). Simply stated, Opici has failed to state a valid ground for cancelling the cited Luxco registrations. As such, Opici’s second and third counterclaims do not state claims to relief that are plausible on their face and must be dismissed.

II. Opici’s Second and Third Counterclaims Must be Dismissed Because They Fail to State Cognizable Claims Under the Lanham Act

As stated above, in its “second counterclaim” and “third counterclaim” Registrant avers allegations that Luxco’s subject registrations should be cancelled based on Luxco’s alleged “failure to police.” “Failure to police use” of a party’s registered trademarks or related terms by unrelated third parties is not, in and of itself, a ground for cancellation of an existing trademark registration. Registrant’s second and third counterclaims should thus be dismissed for failure to state a valid ground for cancelling these registrations. *Young vs. AGB Corp*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1989). In the alternative, at a minimum Luxco requests that the Board require Opici to plead its second and third “counterclaims” with sufficient specificity and clarity to allow Luxco to fully and completely respond to the same, including under what valid Lanham Act grounds Opici’s “failure to police” counterclaims are brought.

Counterclaims [Dkt.4].

III. Opici's Second and Third Counterclaims Must Be Dismissed as to the '786 Registration Because it is Incontestable.

In Board proceedings, there are certain facts not subject to proof—such as the issue date of registrations that are subject to a cancellation petition—that the Board may consider when a party has filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6). *Compagnie Gervais Danone vs. Precision Formulations LLC*, 89 U.S.P.Q.2d 1251, 1258 (TTAB 2009). The '786 Registration issued in 1962, well over five years before Opici's filed its counterclaims. Moreover, the '786 Registration has achieved incontestable status. Even if the Board finds that Opici's second and third counterclaims state valid grounds for cancellation, the Board must nonetheless dismiss those counterclaims as to the '786 registration.

It is a "well settled" rule that the grounds on which a cancellation action may be brought "are limited for a registration that has been in existence for five years." *Otto Intl. Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1862-63 (TTAB 2007). Congress expressly provided in §§ 33(b) and 15 of the Lanham Act that an incontestable mark could be challenged only on very specific grounds. *Park and Fly Inc. vs. Dollar Park & Fly, Inc.*, 469 US 189, 194-195 (1985). Those grounds include: (1) the mark has become generic, (2) the mark has been abandoned, (3) the mark was procured by fraud, or (4) the mark if it is being used to misrepresent the source of the goods or services in connection with which it is used. *Id.* At 195. It is unclear how to characterize "failure to police," but it certainly is not one of the enumerated grounds for cancellation of registration with incontestable status.

CONCLUSION

For the reasons set forth above, Counter-Petitioner has failed to state a claim with respect to its second and third counterclaims against Luxco's '786 and '812 registrations. The Board must accordingly dismiss those counterclaims.

DATED: March 28, 2014.

Respectfully Submitted,

By: /Michael Annis/
Michael R. Annis
Andrew R. Gilfoil
HUSCH BLACKWELL LLP
190 Carondelet Plaza, Suite 600
St. Louis, MO 63108
Telephone: (314) 480-1500
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mike.annis@huschblackwell.com
andy.gilfoil@huschblackwell.com

Attorneys for Luxco, Inc.

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that a copy of the foregoing was served by First Class Mail, postage prepaid on this 28th day of March, 2014, upon:

Stephen L. Baker
Baker & Rannells P.A.
575 Route 28, Ste. 102
Raritan, New Jersey 08869-1354

/Andrew Gilfoil/