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

Proceeding	91213743
Party	Defendant Al-Jazeera Satellite Channel
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Signature	/Gary D. Krugman/
Date	10/29/2014
Attachments	H00191 Applicant's Reply Brief in Support of Its Motion for Leave to Amend Answer (October 29, 2014) As Filed.PDF(138402 bytes )

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

In re U.S. Application Serial No. 85/639,289  
Mark: BEIN SPORT

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BE SPORT, INC.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91213743
	:	
AL-JAZEERA SATELLITE CHANNEL,	:	
	:	
Applicant.	:	

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**APPLICANT'S REPLY BRIEF IN SUPPORT OF ITS  
MOTION FOR LEAVE TO AMEND ANSWER**

Applicant, by its attorneys, hereby file this reply brief in support of its motion for leave to amend its answer to affirmatively plead the defense of *res judicata*, based on the judgment against Opposer and in favor of Applicant in connection with Opposition No. 91212091.

At the outset, Opposer's argument that the motion to amend Applicant's answer should be denied because allowing such an amendment "... at this late stage of the proceedings and with discovery closed" would somehow prejudice Opposer, is baseless.

First, the judgment against Opposer and in favor of Applicant in Opposition No. 91212091 only recently issued on September 2, 2014. Applicant filed its motion for leave to amend its answer only several weeks after the Board's September 2, 2014 decision in the related case. That motion was filed prior to the opening of the trial period and Opposer's insinuation that the discovery period being closed in this case somehow prejudices Opposer is nonsensical since the proposed affirmative defense of *res judicata* requires no discovery.

Given the foregoing, Applicant's motion for leave to amend its answer was timely and in no way prejudices Applicant.

Applicant's main argument, in opposition to Applicant's motion for leave to amend its answer is that the proposed affirmative defense, as a matter of law, must fail as it is assertedly futile. In support of its position, Opposer relies on Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp., 94 U.S.P.Q.2d 1294 (TTAB 2010). That case, however, is inapposite as it involved a proposed affirmative defense of "non-commercial use" which, the Board concluded, was not as a matter of law available as a defense to a dilution claim. The instant proceeding, by contrast, properly asserts a *res judicata* affirmative defense to a likelihood of confusion based opposition based on the Board's dismissal with prejudice of Opposer's identical likelihood of confusion claims against Applicant's BEIN mark.

Opposer further relies on the case of Institute Nat'l Des Appellations D'Origine v. Brown-Forman Corp., 47 U.S.P.Q.2d 1875 (TTAB 1998). That case found the mark MIST AND COGNAC to be a mark with a different commercial impression compared to the mark CANADIAN MIST AND COGNAC and denied a motion to assert a *res judicata* claim as futile. That case is also inapposite to the facts in the instant case where the only difference in Applicant's two marks in the two oppositions is the inclusion in this case of the descriptive, non-distinctive and disclaimed term SPORT in Applicant's mark, a term with no trademark significance as it relates to Applicant's activities relating to sports.

Opposer also relies on the case of Metromedia Steakhouses, Inc. v. Pondecò II, 28 U.S.P.Q.2d 1205 (TTAB 1993). However, the Board, in that case, granted the motion to amend to raise the issue of *res judicata*. The Board correctly noted that the issue presented by the motion was not whether the moving party should prevail on the ground sought to be asserted by the amendment, but whether the moving party should be allowed to assert such ground.<sup>1</sup>

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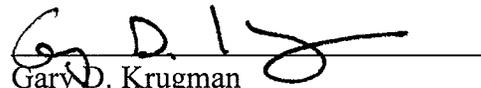
<sup>1</sup> The Board went on to deny the motion for summary judgment on the *res judicata* ground, finding that a judgment in an earlier case against the mark RANCH STEAK & SEAFOOD in typed form did not preclude Applicant from filing a subsequent application to register the mark RANCH STEAK &

Given the foregoing, and since it is clear, and acknowledged by Opposer, that leave to amend should be liberally granted, Applicant maintains that such leave to amend should be granted herein; that Applicant's motion be granted and that Opposer should be directed to substantively respond to the summary judgment motion.

Respectfully submitted,

Al-Jazeera Satellite Channel

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Date: October 29, 2014

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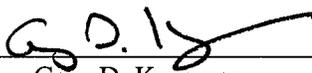
SEAFOOD together with several design elements, including the stylized script in which the word "RANCH" is depicted, the black rectangular design on which the words "STEAK & SEAFOOD" appear, the designs of a cactus, sun, and wavy line which appears to be earth appearing in the foreground of the pictorial scene. This western landscaping depiction, combined with the other design elements, created for the second mark a commercial impression arguably different from that created from that which the words alone created for the first mark.

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing APPLICANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR LEAVE TO AMEND ANSWER has been mailed this 29<sup>th</sup> day of October 2014, by first-class mail, postage prepaid to:

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