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

Proceeding	91221325
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Attachments	RB v Jordi Nogues Jordi Nogues S.L. - Consolidated Proceeding No. 92061202 - Motion for Judgment on the Pleadings.pdf(37408 bytes)

its Answer to Opposer's Notice of Opposition ("Answer")⁶, Appln. No. 86/324,277 is void *ab initio* and, as such, the instant opposition should be sustained. This motion is timely as the pleading period for this consolidated proceeding has closed, and the first testimony period has not yet opened.⁷⁸

Pursuant to 37 C.F.R. Section 2.127(d) and TBMP Section 510.03(a), the instant consolidated proceeding will be suspended to all matters not germane to this Motion for Judgment on the Pleadings⁹, including suspending any and all deadlines relating to discovery, and Red Bull respectfully requests that the Board issue an order to that effect.¹⁰

Introduction

A motion for judgment on the pleadings is a test solely of the undisputed, well-pleaded facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice.¹¹ A judgment on the pleadings may be granted where there is no genuine issue of material fact to be resolved.¹² In determining whether there is no genuine issue of material fact present in the pleadings, the Board considers the *well-pleaded* factual allegations of the non-moving party as true, and the allegations of the moving party which have been denied as false.¹³ However, "[T]he tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal

⁶ See Answer to Notice of Opposition ("Answer"), Opposition No. 91-221,325, Docket No. 5 (April 22, 2015).

⁷ The Board Ordered schedules for Opposition No. 91-221,325 and Cancellation No. 92-061,202 are only one day apart and the pleading period for both proceedings has closed and the first testimony period has not yet opened in either proceeding. Upon consolidation, in accordance with typical Board practice, the later-instituted proceeding, Cancellation No. 92-061,202, will become the *parent* proceeding.

⁸ 37 C.F.R. Section 2.127(e)(1); TBMP Section 504.01.

⁹ See *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434 (TTAB 1995).

¹⁰ Red Bull filed a motion to consolidate on November 11, 2015. Since filing, Nogues has provided its consent to this consolidation, as noted in Red Bull's supplement to motion to consolidate. The request for consolidation is based on the fact that the above-captioned proceedings share common parties, substantially similar and identical witnesses, the same marks asserted by Red Bull, substantially similar marks at issue and substantially similar and identical allegations regarding confusion, false suggestion of a connection, dilution, use in commerce/bona fide intent to use, and false declaration. Good cause for a suspension has been shown where identical and common questions of fact and law will need to be addressed in each proceeding, and allowing both proceedings to continue prior to a Board Order consolidating proceeding and prior to a decision on the instant motion for judgment on the pleadings is not in the best interest of the parties. Suspending the above-captioned consolidated proceeding will save unnecessary time, effort and expense for both parties. Since the Board has not yet formally issued an order suspending proceedings, should the Board decide against suspending both proceedings as consolidated, Red Bull respectfully requests that all deadlines in Cancellation No. 92-061,202, including any and all deadlines relating to discovery, be extended by 60-days.

¹¹ *Kraft Group LLC v. Harpole*, 90 USPQ2d 1837, 1840 (TTAB 2009); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008); TBMP Section 504.02.

¹² TBMP Section 504.02.

¹³ *Id.*

conclusions. Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.”¹⁴

Here, the trademark rules are clear and Applicant’s Answer provides all admissions necessary to support a finding that Appln. No. 86/324,277 was void *ab initio*. As such, this Motion for Judgment on the Pleadings should be granted and registration of Appln. No. 86/324,277 should be denied.

Argument

The trademark rules specify that, while certain errors made as to an applicant’s name in an original trademark application are correctable, an error, such as the one made in the filing of Appln. No. 86/324,277, is a non-correctable error that renders the application void *ab initio*.

While an application can be amended to correct an inadvertent error in the manner in which an applicant’s name is set forth, an application cannot be amended to substitute another entity as the applicant.¹⁵ An application filed in the name of the wrong party is void and cannot be corrected by amendment.¹⁶

The trademark rules distinguish two types of errors, correctable errors and non-correctable errors. Where an error is made and an individual is named in the original application instead of the correct business entity, as is the case with Application No. 86/324,277, this is a non-correctable error and the application is void *ab initio*.¹⁷ “A void application cannot be cured by amendment or assignment.”¹⁸

I. Applicant Filed a Preliminary Amendment, Just Days After Filing Appln. No. 86/324,277, Purporting to Correct a Non-Correctable Error

In the Answer, Applicant expressly admits that the TSDR records accurately reflect a preliminary amendment, filed on July 8, 2014, purporting to change Applicant’s name from Jordi

¹⁴ *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009).

¹⁵ See TBMP Section 803.06; 37 C.F.R. Section 2.71.

¹⁶ See TBMP Section 1201.02(c); 37 C.F.R. Section 2.71(d).

¹⁷ An example of a non-correctable error is if, for example, “the president of a corporation is identified as the owner of the mark when in fact the corporation owns the mark, and there is no inconsistency in the original application between the owner name and the entity type (such as a reference to a corporation in the entity section of the application), the application is void as filed because the applicant is not the owner of the mark.” *Id.*

¹⁸ TBMP Section 803.06.

Nogues, the individual, to Jordi Nogues, S.L., the limited liability company.¹⁹ The portions of Applicant's Answer that admit and confirm that the TSDR records are an accurate reflection of the preliminary amendment filed read as follows (in relevant part):

Notice: 7. The original Applicant, Jordi Nogues ("Applicant"), an individual whose address is listed as Bruc 114, pral 2^a, Barcelona, Spain 08009, filed Application No. 86/324,277 on June 30, 2014, claiming a bona fide intent-to-use the [mark of Application No. 86/324,277] in U.S. commerce on or in connection with "beer," in Int'l Class 32. Application No. 86/324,277 was published on December 2, 2014.²⁰

Answer: 7. As to the information contained in paragraph 7 of the Opposition, Applicant states that the records of the U.S. Patent and Trademark Office shall speak for themselves.²¹

Notice: 8. On July 8, 2014, Nicholas Wells, attorney of record listed on Application No. 86/324,277, signed and filed a preliminary amendment, without explanation, declaration, assignment or support, purporting to change the listed owner of Application No. 86/324,277 from Jordi Nogues, the individual, to Jordi Nogues, S.L., a corporation organized under the laws of Spain.²²

Answer: 8. As to the information contained in paragraph 8 of the Opposition, Applicant states that the records of the U.S. Patent and Trademark Office shall speak for themselves.²³

Notice: 9. According to the Trademark Manual of Examining Procedure ("TMEP") Section 803.06 and 1201.02(c), when an application filed in the name of the wrong party – for example, in the name of the president of a corporation as an individual when the corporation owns the mark – this is a non-correctable error and the application is void *ab initio*. As such, Application No. 86/324,277 is void *ab initio*.²⁴

Answer: 9. As to the information contained in paragraph [9] of the Opposition, Applicant states that the [rules] of the U.S. Patent and Trademark Office shall speak for themselves.²⁵

¹⁹ For clarity, Jordi Nogues, S.L. is a Spanish entity equivalent to a limited liability company in the United States, not a corporation. The preliminary amendment, filed July 8, 2014, incorrectly lists Jordi Nogues, S.L. as a corporation organized under the laws of Spain. This is later corrected by an Examiner's Amendment, entered on October 28, 2014, to correctly reflect the fact that S.L., a Spanish entity, is legally equivalent to a limited liability company in the United States. The Jordi Nogues, S.L. listed in the record for Application No. 86/324,277 is the same as the listed registrant of Registration No. 4,471,520, which is the subject of related Cancellation No. 92-061,202.

²⁰ See Notice of Opposition ("Notice"), Docket No. 1 (April 1, 2015), ¶ 7.

²¹ See Answer to Notice of Opposition ("Answer"), Docket No. 5 (April 22, 2015), ¶ 7.

²² See Notice, ¶ 8.

²³ See Answer, ¶ 8.

²⁴ See Notice, ¶ 9.

²⁵ See Answer, ¶ 9. Note that Applicant's Answer mistakenly references paragraph 7 in its response to paragraph 9, but it is clear that Applicant intends to provide a response to paragraph 9 and that it is acknowledging the accuracy and validity of the USPTO rules, not the USPTO records.

Intent-to-use Appln. No. 86/324,277 was filed in the name of Jordi Nogues, an individual living in Spain. Just eight days after this application was filed, Applicant's experienced counsel who is presumably well-acquainted with the rules, filed a preliminary amendment, without explanation, declaration, assignment or support, purporting to change the listed owner of Application No. 86/324,277 from Jordi Nogues to Jordi Nogues, S.L., a corporation organized under the laws of Spain. This preliminary amendment attempts to *fix* the purported error of listing Jordi Nogues, individually, as the owner of the mark and the one possessing the bona fide intent to use the mark of Appln. No. 86/324,277, instead of the correct applicant, Jordi Nogues, S.L., the limited liability company. Based on the well-settled rules and case law²⁶, this is very clearly a non-correctable error.

In this case, the application was filed in error in the name of an individual, who is the founder of Jordi Nogues, S.L. The correct applicant, and the entity that allegedly possessed the bona fide intent to use the mark of Appln. No. 86/324,277, was the limited liability company, Jordi Nogues, S.L., as reflected by Applicant's preliminary amendment. As the rules clearly state, errors cannot be *cured* by filing an amendment or assignment – moreover, this mistake falls under the category of non-correctable error, rendering Appln. No. 86/324,277 void *ab initio*.

III. Based on Applicant's Admissions in its Answer, It is Clear that Jordi Nogues, S.L., the Limited liability company, Was In Existence As Of The Filing Date Of Application No. 86/324,277

Filing Appln. No. 86/324,277 in the name of Jordi Nogues, the individual, rather than Jordi Nogues, S.L., the limited liability company, where this company was already in existence was clearly a non-correctable error. Not only was Registration No. 4,471,520, the subject of the related cancellation action, filed in 2012 in the name of Jordi Nogues, S.L, but Applicant's website, of which Applicant claims ownership and confirms validity in its Answer, notes that

²⁶ See *Tracie Martyn, Inc. v. Tracy Artman*, Opposition No. 91-173,009 (May 1, 2008) [not precedential].

Jordi Nogues, S.L. has been in existence since at least as early as 2012. Application No. 86/324,277 was not filed until 2014. The portions of Applicant's Answer that confirm the existence of Jordi Nogues, S.L. at the time Appln. No. 86/324,277 was filed read, in relevant part, as follows:

Notice: 11. Applicant's [mark of Appln. No. 86/324,277] is used on Applicant's websites, badtoro.es and badtorostore.com, in connection with the wording "BadToro" in the colored red and black ...²⁷

Answer: 11. Applicant admits the allegations contained in paragraph 11 of the Opposition.²⁸

Through its admission in paragraph 11 of its Answer, Applicant acknowledges and confirms its familiarity, ownership and control of the websites badtoro.es and badtorostore.com. Both badtoro.es and badtorostore.com, websites Applicant admits to owning and running, have an "About Us" section that states Jordi Nogues, the company (i.e. Jordi Nogues, S.L.), was founded and organized in 1996, long prior to the filing of Appln. No. 86/324,277. Further, Registration No. 4,471,520 for the mark BADTORO & Bull Logo, which is the subject of related Cancellation No. 92-061,202²⁹, was filed in the name of Jordi Nogues, S.L. two years prior to the filing of Appln. No. 86/324,277.

Clearly, Jordi Nogues, S.L., the limited liability company, was in existence when Appln. No. 86/324,277 was filed in 2014. However, by mistake, Appln. No. 86/324,277 was filed in the name of Jordi Nogues, the individual, constituting a non-correctable error and rendering Appln. No. 86/324,277 void *ab initio*. Further, not being the intended applicant, Jordi Nogues, the individual, could not have possessed the requisite bona fide intent to use the mark of Appln. No. 86/324,277 at the time of filing the intent-to-use application – the bona fide intent to use this mark, if any, was that of Jordi Nogues, S.L., the intended applicant.

IV. At The Time Of Filing Intent-To-Use Application No. 86/324,277, The Original

²⁷ See Notice, ¶11.

²⁸ See Answer, ¶11.

²⁹ See Petition to Cancel ("Cancellation"), Cancellation No. 92-061,202 (April 1, 2015). Opposition No. 91-221,325 is explicitly listed as a related opposition on the USPTO-generated cover sheet for this Cancellation.

Applicant, Jordi Nogues, Did Not Have a Bona Fide Intent To Use the Mark of Application No. 86/324,277 on the Relevant Goods.

At the time of filing Appln. No. 86/324,277, the original applicant listed on the application, Jordi Nogues, submitted a declaration, attesting to his bona fide intent to use the mark of Appln. No. 86/324,277. At the time of filing that declaration, Jordi Nogues did not have a bona fide intent to use the mark of Appln. No. 86/324,277 on the relevant goods. As Jordi Nogues, the unintentional applicant, did not have a bona fide intent to use the mark of Appln. No. 86/324,277 at the time of filing, the declaration submitted simultaneously with the application constitutes a false declaration. Not only does the non-correctable error laid out above render Appln. No. 86/324,277 void *ab initio*, but, further, Appln. No. 86/324,277 is void based on Applicant's lack of bona fide intent to use at the time of filing and false declaration.

Conclusion

For the foregoing reasons, Opposer respectfully requests that the Board grant the Motion for Judgment on the Pleadings, sustaining the instant opposition and denying registration on Appln. No. 86/324,277.

Dated: November 12, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **RED BULL'S MOTION FOR JUDGMENT ON THE PLEADINGS** is being served on November 12, 2015, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Applicant/Registrant Jordi Nogues/Jordi Nogues, S.L. at:

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