

The Trademark Trial and Appeal Board's ("Board") Order of December 14, 2015,⁴ expressly stated that the suspension of the proceeding was as of November 12, 2015, and that proceedings are suspended as to all matters not germane to Red Bull's MJP, *including all discovery*. Since Red Bull's responses to Nogues' Request for Admissions were not yet due as of the effective date of the suspension/filing date of the MJP, the responses to such Requests for Admissions were not late and, indeed, are still not yet due. As such, a substantive response to Nogues' Motion is not believed necessary.

Should the Board disagree and desire a substantive response, Red Bull contingently requests an extension so that it will have an opportunity to provide such a response.

In view of the suspension of proceedings as of November 12, 2015, Red Bull submits that Nogues' Motion is premature and without legal basis. Thus, Red Bull respectfully requests that Nogues' Motion be DENIED.

Dated: December 22, 2015

Respectfully submitted,

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⁴ *Id.*

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **OPPOSER/PETITIONER'S RESPONSE TO APPLICANT/REGISTRANT'S MOTION TO DISMISS OR, IN THE ALTERNATIVE, MOTION FOR SUMMARY JUDGMENT WITH CONTINGENT REQUEST TO EXTEND TIME** is being served on December 22, 2015, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to counsel for Applicant/Registrant at:

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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.⁷

Additionally, Opposer notes that the discovery issues raised in Applicant's Memorandum in Opposition to Red Bull's Motion for Judgment on the Pleadings ("MJP") regarding Opposer's discovery responses need not be addressed herein in light of the Board's Order, stating that the above-captioned consolidated proceeding is suspended with respect to all matters not germane to Opposer's potentially dispositive motion, including any and all discovery, as of the November 12, 2015 filing date of Opposer's MJP.⁸ Similarly, Opposer need not address the exhibits attached to Applicant's Opposition to MJP⁹ in its Reply, but reserves the right to do so later should these motions be renewed after this suspension is lifted.

I. Introduction

As Opposer previously outlined in its MJP, 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.¹⁰ Despite Applicant's attempt to claim otherwise, the file wrappers for each application or registration that is the target of a proceeding are automatically considered part of the record.¹¹ As such, Opposer's MJP relies only on the record and pleadings in supporting its arguments in its MJP and Reply. 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

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

⁸ See Suspension Pending Disposition of Outstanding Motion ("Board Order"), Docket No. 16 (December 14, 2015)

⁹ See Opposition to MSJ. Applicant attached a Motion to Compel and Motion to Dismiss as exhibits to its Opposition to MSJ. These exhibits are improper, premature and will not be considered per the Board's December 14, 2015 order.

¹⁰ *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.

¹¹ 37 C.F.R. Section 2.122(b)(1).

¹² TBMP Section 504.02.

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

Here, Opposer maintains that 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, Opposer supports its position that this MJP should be granted and registration of Appln. No. 86/324,277 should be denied.

II. Argument

Despite Applicant’s attempt to argue otherwise, the mistake in the filing of Application No. 86/324,277 is a clear-cut non-correctable error that renders the application void *ab initio*. Applicant admits in its Opposition to MJP that Application No. 86/324,277 did contain an error at the time of filing.¹⁵ However, Applicant mischaracterizes the error and incorrectly states that the error is correctable. 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.¹⁶ An application filed in the name of the wrong party is void and cannot be corrected by amendment.¹⁷

The trademark rules distinguish two types of errors, correctable errors and non-correctable errors.

The error in Application No. 86/324,277 was a mistake in name and entity (where both the individual and entity existed at the time of filing) and not just a minor inadvertent error in the way the applicant’s name was spelled/written - this is a non-correctable error and the application

¹³ *Id.*

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

¹⁵ See Memorandum in Opposition to Red Bull’s Motion for Judgment on the Pleadings (“Opposition to MJP”), Docket No. 15 (December 2, 2015), p. 7.

¹⁶ See TBMP Section 803.06; 37 C.F.R. Section 2.71.

¹⁷ See TBMP Section 1201.02(c); 37 C.F.R. Section 2.71(d).

is void *ab initio*.¹⁸ “A void application cannot be cured by amendment or assignment.”¹⁹

A. The Error in Application No. 86/324,277 Is Not Simply a “Minor Clerical Error” And Cannot Be Corrected And Application No. 86/324,277 Is Void *Ab Initio*

Applicant mischaracterizes the error in Application No. 86/324,277 as a minor correctable clerical error. Applicant also purposefully cites to an inapplicable rule regarding “correctable” errors, using the example of “an application for ‘ABC, Inc.’ initially filed under the name ‘ABC’”²⁰ in an attempt to make the fatal error in Application No. 86/324,277 appear (at first glance) to be a similar issue. This is not simply a case of *forgetting* to include the correct designation after a company’s name. The way Application No. 86/324,277 was filed, specifically listing the initial applicant, Jordi Nogues, as an individual, makes it clear that “S.L.” was not simply left off the end of the name – the application was filed in the name of a completely different entity and was not just a small clerical error.

The initial application for Application No. 86/324,277 clearly listed Jordi Nogues as an individual, which Applicant’s counsel later attempted to change by preliminary amendment to Jordi Nogues, S.L., a limited liability company organized under the laws of Spain.²¹ These are two completely different entities. As Applicant eventually points out, “[m]inor clerical errors such as the mistaken addition or omission of ‘The’ or ‘Inc.’ in the applicant’s name may be corrected by amendment, as long as this does not result in a change of entity.”²² A completely new entity cannot be simply *substituted* for a incorrectly listed party, as Applicant attempted to

¹⁸ 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.*

¹⁹ TBMP Section 803.06.

²⁰ See Applicant’s Opposition to MJP, p. 7.

²¹ 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.

²² See 37 CFR Section 2.17(d), TBMP Section 1201.02(c)(3) (emphasis added).

do here. This is clearly an issue of a non-correctable error and Application No. 86/324,277 is void *ab initio*.

Applicant incorrectly argues that the file wrapper for Application No. 86/324,277 is not part of the record and cannot be referenced for the purposes of a motion for judgment on the pleadings. It is clearly set out in the rules that the file wrappers for each application or registration that is the target of a proceeding are automatically considered part of the record.²³ As part of the file wrapper for Application No. 86/324,277, opposed herein, both the initial application, containing the incorrect applicant, and the preliminary amendment referenced herein, purporting to *correct* this clearly non-correctable error, are automatically part of the record for this consolidated proceeding.

Further, Applicant expressly admits in its Answer that the TSDR records accurately reflect a preliminary amendment, filed on July 8, 2014, purporting to change Applicant's name from Jordi Nogues, the individual, to Jordi Nogues, S.L., the limited liability company. 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, 2014.²⁴

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.²⁵

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,

²³ 37 C.F.R. Section 2.122(b)(1).

²⁴ See Notice of Opposition ("Notice"), Docket No. 1 (April 1, 2015), ¶ 7.

²⁵ See Answer to Notice of Opposition ("Answer"), Docket No. 5 (April 22, 2015), ¶ 7.

- S.L., a corporation organized under the laws of Spain.²⁶
- 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.²⁷
- 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*.²⁸
- 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.²⁹

Clearly stated in the application, 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 limited liability company organized under the laws of Spain and a completely different entity. 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 law³⁰, this is very clearly a *non-correctable* error.

It is uncontested that there was an error in the name in which Application No. 86/324,277 was filed. The parties, however, disagree as to the severity of this uncontested error. The correct applicant, and the entity that allegedly possessed the bona fide intent to use the mark of Appln.

²⁶ See Notice, ¶ 8.

²⁷ See Answer, ¶ 8

²⁸ See Notice, ¶ 9.

²⁹ 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.

³⁰ See *Tracie Martyn, Inc. v. Tracy Artman*, Opposition No. 91-173,009 (May 1, 2008) [not precedential].

No. 86/324,277, was the limited liability company, Jordi Nogues, S.L., as reflected by Applicant's preliminary amendment. As Applicant pointed out in its Opposition to MJP, another entity cannot be substituted for the wrong party³¹ – the purposefully stated entity information in the application and preliminary amendment highlights the fact that this is not simply a spelling mistake or other minor clerical error. 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*.

B. Jordi Nogues, S.L., the Limited Liability Company, Was In Existence As Of The Filing Date Of Application No. 86/324,277 – This Was Not Simply A Minor Clerical Spelling Error And Cannot Be Corrected

Filing Appln. No. 86/324,277 in the name of Jordi Nogues, the individual, rather than Jordi Nogues, S.L., the limited liability company – two completely different entities - where this company was already in existence was clearly a non-correctable error. Not only was Registration No. 4,471,520, the registration that is one of the targets of the above-captioned consolidated proceeding³², filed in 2012 in the name of the entity Jordi Nogues, S.L., as evidenced by the file wrapper automatically made of record, but Applicant's website, of which Applicant claims ownership and confirms validity in its Answer, notes that 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. While the fact that Registration No. 4,471,520 was filed in 2012 in the name of this already-existing entity is sufficient to establish the existence of this entity prior to the filing of Application No. 86/324,277 in 2014, this fact is further established by the admissions contained in Applicant's Answer (in relevant part):

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 ...³³

³¹ See Opposition to MJP, p. 7.

³² Per the rules, the file wrapper for Registration No. 4,471,520, as the target registration of Consolidated Proceeding No. 91-221,325, is automatically part of the record for this consolidated proceeding.

³³ See Notice, ¶11.

Answer: 11. Applicant admits the allegations contained in paragraph 11 of the Opposition.³⁴

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.

As Opposer established in its MJP and again above, Jordi Nogues, S.L., the limited liability company, was clearly in existence when Appln. No. 86/324,277 was filed in 2014. However, through an uncontested error, 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.

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

³⁴ See Answer, ¶11.

on Applicant's lack of bona fide intent to use at the time of filing and false declaration.

III. 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: December 22, 2015

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **RED BULL'S REPLY IN SUPPORT OF MOTION FOR JUDGMENT ON THE PLEADINGS** is being served on December 22, 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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