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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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Opposer notes that Applicant did not actually submit an opposition to Opposer's Motion for Summary Judgment, but simply "incorporates, in its entirety, including all exhibits, its prior Memorandum in Opposition to Red Bull's Motion for Judgment on the Pleadings,"<sup>5</sup> which opposes an entirely different motion with different standards, evidence and support. Additionally, Applicant has included its prior-filed Motion to Dismiss Or, In the Alternative, Motion for Summary Judgment, which, as before, need not be addressed herein in light of the Board's August 29, 2016 Order<sup>6</sup>, tolling the time to respond to any outstanding discovery requests.<sup>7</sup> Similarly, Opposer need not address the exhibits attached to Applicant's Opposition to Opposer's Motion for Summary Judgment ("Opposition to MSJ")<sup>8</sup> in its Reply, but reserves the right to do so later should these motions be renewed after this suspension is lifted. Further, Applicant does not contest Opposer's standing.<sup>9</sup>

## **I. Introduction**

Despite Applicant's contention in its Opposition to MSJ that "the sustenance [*sic*] of Red Bull's Motion is identical to Red Bull's prior Motion for Judgment on the Pleadings,"<sup>10</sup> Opposer's MSJ involves completely different legal standard and includes additional evidence and support. Different from a motion for judgment on the pleadings, a motion for summary judgment is appropriate where there is "no genuine issue as to any material fact and the movant is entitled to judgment as a matter of law."<sup>11</sup> A motion for summary judgment is not restricted to the pleadings, as is a motion for judgment on the pleadings, and allows the movant to include additional evidence outside the pleadings, such as discovery responses.

Opposer maintains that summary judgment is proper where there is no genuine issue of

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<sup>5</sup> See Defendant's Opposition/Response to Motion ("Opposition to MSJ"), Docket No. 34 (September 7, 2016).

<sup>6</sup> See Board Order, Docket No. 16 (December 14, 2015).

<sup>7</sup> See Suspension Pending Disposition of Outstanding Motion ("Board Order"), Docket No. 33 (August 29, 2016)

<sup>8</sup> 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 August 29, 2016 order.

<sup>9</sup> Per the Board's August 29, 2016 Order, all matters, including outstanding discovery, are suspended. In its Opposition to MSJ, Applicant bases its argument that Opposer lacks standing based on the outstanding requests for admission, a response to which is not yet due. Applicant does not contest Opposer's standing on any other grounds.

<sup>10</sup> See Opposition to MSJ, p. 2.

<sup>11</sup> See FRCP Rule 56 and TBMP Section 528.01.

material fact – the trademark rules are clear and Applicant’s answer and discovery responses provide all admissions necessary to support a finding that that, at the time of filing Appln. No. 86/324,277, the initial applicant did not have the requisite bona fide intent to use the applied-for mark and Appln. No. 86/324,277 is void *ab initio*.

## **II. Argument**

It is undisputed that, where an applicant files a trademark application based on bona fide intent to use (which necessarily includes a verified statement, attesting to the applicant’s bona fide intent to use), but does not, at the time of filing, actually possess the requisite bona fide intent to use the applied-for mark in connection with the applied-for goods and services, the resulting application or registration is subject to opposition or cancellation. In its discovery responses, Applicant expressly admits that the limited liability company, Jordi Nogues, S.L. was already in existence at the time of filing Appln. No. 86/324,277 and, further, admits that the mark of Appln. No. 86/324,277 was “created and designed” prior to filing this application specifically to be used by Jordi Nogues, S.L., the limited liability company, and not Jordi Nogues, the individual. Additionally, it is undisputed that Application No. 86/324,277 contained an error at the time of filing,<sup>12</sup> but Applicant mischaracterizes this 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*. 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 is void *ab initio*.<sup>13</sup> “A void application cannot be cured by amendment or assignment.”<sup>14</sup>

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<sup>12</sup> See Opposition to MSJ, p. 7.

<sup>13</sup> An example of a non-correctable error is if, for example, “the president of a corporation is identified as the owner”<sup>3</sup>

**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***

It is uncontested that there was an error in the name in which Appln. No. 86/324,277 was filed. The parties, however, disagree as to the severity of this uncontested error. 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’”<sup>15</sup> 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 applicant did not possess the requisite bona fide intent to use the applied-for mark at the time of filing.

The initial application for Application No. 86/324,277 expressly listed Jordi Nogues as an individual, which Applicant’s experienced counsel, who is presumably well-acquainted with the rules, later attempted to change by preliminary amendment<sup>16</sup>, without explanation, declaration, assignment or support, to Jordi Nogues, S.L., a limited liability company organized under the laws of Spain.<sup>17</sup> These are two completely different entities. The entity that possessed the bona

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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.*

<sup>14</sup> TBMP Section 803.06.

<sup>15</sup> See Applicant’s Opposition to MSJ, p. 7.

<sup>16</sup> Applicant incorrectly argues that the file wrapper for Application No. 86/324,277 is not part of the record. 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. 37 C.F.R. Section 2.122(b)(1). 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.

<sup>17</sup> 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, 4

bona fide intent to use the mark of Appln. No. 86/324,277, and the correct applicant, was the limited liability company, Jordi Nogues, S.L. 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.”<sup>18</sup> As Applicant pointed out in its Opposition to MSJ, another entity cannot be substituted for the wrong party<sup>19</sup> – 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. This preliminary amendment invalidly 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 law<sup>20</sup>, this is very clearly a *non-correctable* error.

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:

- Notice: 7.** The original Applicant, Jordi Nogues (“Applicant”), an individual whose address is listed as Bruc 114, pral 2<sup>a</sup>, 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.<sup>21</sup>
- 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.<sup>22</sup>
- 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.<sup>23</sup>
- 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.<sup>24</sup>

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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.

<sup>18</sup> See 37 CFR Section 2.17(d), TBMP Section 1201.02(c)(3) (emphasis added).

<sup>19</sup> See Opposition to MSJ, p. 7.

<sup>20</sup> See *Tracie Martyn, Inc. v. Tracy Artman*, Opposition No. 91-173,009 (May 1, 2008) [not precedential].

<sup>21</sup> See Notice of Opposition (“Notice”), Docket No. 1 (April 1, 2015), ¶ 7.

<sup>22</sup> See Answer to Notice of Opposition (“Answer”), Docket No. 5 (April 22, 2015), ¶ 7.

<sup>23</sup> See Notice, ¶ 8.

<sup>24</sup> See Answer, ¶ 8

- 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*.<sup>25</sup>
- 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.<sup>26</sup>

Intent-to-use Appln. No. 86/324,277 was expressly filed in the name of Jordi Nogues, an individual living in Spain. This mistake falls under the category of non-correctable error, which cannot be *cured* by filing an amendment or assignment, rendering Appln. No. 86/324,277 void *ab initio*. The initial applicant obviously did not possess the requisite bona fide intent to use the applied-for mark at the time of filing Application No. 86/324,277.

**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***

Applicant admits that Jordi Nogues, S.L. was in existence prior to 2014, when Appln. No. 86/324,277 was filed. Not only was Registration No. 4,471,520, the registration that is one of the targets of the above-captioned consolidated proceeding<sup>27</sup>, 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 discovery responses admit that Jordi Nogues, S.L. “was founded in 1995 ...”<sup>28</sup> 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 - was clearly a non-correctable error and renders Appln. No. 86/324,277 void *ab initio*. As the unintentional 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 Appln. No. 86/324,277.

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<sup>25</sup> See Notice, ¶ 9.

<sup>26</sup> 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.

<sup>27</sup> 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.

<sup>28</sup> See Opposer’s Motion for Summary Judgment (“MSJ”), Docket No. 31, Exhibit B (August 9, 2016).

**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, 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. Applicant admits in its discovery responses that the mark of Appln. No. 86/324,277 “was created and designed ... in 2006 ... for [Jordi Nogues, S.L.]”<sup>29</sup> Where Jordi Nogues, S.L. was the intended user, Jordi Nogues, the individual and unintentional application, could not have possessed the requisite bona fide intent to use the mark of Appln. No. 86/324,277 at the time of filing. As such, Jordi Nogues’ declaration submitted simultaneously with the application constitutes a false declaration and Appln. No. 86/324,277 is void *ab initio*.

**III. Conclusion**

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

Dated: September 27, 2016

Respectfully submitted,

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<sup>29</sup> *Id.*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing **RED BULL'S REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT** is being served on September 27, 2016, 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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