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

Proceeding	91208855
Party	Defendant The Wine Group LLC
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Date	04/23/2013
Attachments	Reply.pdf ( 3 pages )(45341 bytes )

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

3 Application Serial No. 85/736,374

4 Mark: (B)URBAN

5 Class: 33

6	_____ )	
7	<b>GREATER LOUISVILLE</b> )	Opposition No: 91208855
8	<b>CONVENTION &amp; VISITORS</b> )	
9	<b>BUREAU,</b> )	<b>APPLICANT/COUNTERCLAIMANT’S</b>
10	Opposer/Respondent )	<b>REPLY ON</b>
11	v. )	<b>OPPOSITION TO MOTION TO AMEND</b>
12	<b>THE WINE GROUP, LLC.,</b> )	<b>OR, IN THE ALTERNATIVE, MOTION</b>
	Applicant/Counterclaimant. )	<b>TO STRIKE AFFIRMATIVE DEFENSES</b>
	_____ )	

13                   The Wine Group (TWG) submits this reply to Opposer/Respondent’s (GLCVB)  
14 Opposition Memorandum of April 19, 2013.

15               1.       GLCVB’s opposition memorandum never addresses the substance of TWG’s  
16 motion, namely, that the newly-pleaded defenses should not be permitted because they are futile.  
17 Never. Instead, it makes two arguments. First, it argues that the motion raises no new issues and  
18 has already been mad denied as moot (Opp. Mem. at 1, 4). This is wrong: GLCVB’s motion to  
19 amend and amended answer was filed **in response** to TWG’s initial motion so TWG’s motion  
20 did not and could not have addressed it.

21               Second, GLCVB argues that the defenses should be permitted as long as they “bear upon  
22 the issues in the case” and there are factual issues for trial. (*Id.* at 3-4). This is also wrong. The  
23 issue for the Board is whether, **assuming the pleaded facts to be true**, the two affirmative  
24

1 defenses **state a plausible theory** on which relief could be granted. Here they do not and,  
2 therefore, pursuing them is futile. As a matter of law the laches defense fails because TWG did  
3 not have a cause of action until GLCVB opposed the application, and TWG filed its  
4 counterclaim within the time allowed by the Board’s rules. (TWG Mem. at 3:18-6:7). The  
5 unclean hands defense fails because the claim does not arise from TWG’s conduct in acquiring  
6 the rights being asserted; “pressuring” GLCVB to settle or intentionally infringing its marks do  
7 not, even if proven, establish an unclean hands defense. (*Id.* at 6:0-8:22). And in the case of the  
8 former, litigation tactics are privileged and settlement discussions are inadmissible.

9 2. At bottom, GLCVB wants the Board to find that because the affirmative  
10 defenses are already in the case GLCVB is entitled to discovery and trial on them. That is not  
11 the way the Rules work. The Board erred by deciding the motion before the time period for  
12 responding to it had expired. More importantly, the whole point of a Rule 12 (b)(6) motion is "to  
13 allow the [Board] to eliminate actions that are fatally flawed in their legal premises and destined  
14 to fail, and thus spare litigants the burdens of unnecessary pretrial and trial activity." *Advanced*  
15 *Cardiovascular Systems, Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993).  
16 The Board should do so here by striking the affirmative defenses.

17 Respectfully submitted,

18 By: /s/ Paul W. Reidl

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Dated: April 23, 2013

*Attorney for Applicant,  
The Wine Group*

1 **PROOF OF SERVICE**

2 On April 23, 2013, I caused to be served the following document:

3 **REPLY ON OPPOSITION TO MOTION TO AMEND OR,**  
4 **IN THE ALTERNATIVE, MOTION TO STRIKE**

5 on Opposer by placing a true copy thereof in the United States mail enclosed in an envelope,  
6 postage prepaid, addressed as follows to their counsel of record at his present business address:

7 John A. Galbreath  
8 Galbreath Law Offices  
9 2516 Chestnut Woods Ct.  
Reiseterstown, MD 21136-5523

10 Executed on April 23, 2013 at Half Moon Bay, California.

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