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

Proceeding	91243188
Party	Defendant Monster Energy Company
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Signature	/Jason A. Champion/
Date	03/18/2019
Attachments	2019-03-18 Consented Motion for Leave to File Amended Answer - HAN-BEV.7655M.pdf(776388 bytes ) Appendix A - Applicant_s Amended Answer - HANBEV.7655M.pdf(854185 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTEGRATED SUPPLY NETWORK, LLC,	)	
	)	Opposition No.: 91243188
Opposer,	)	
	)	Serial No.: 87/833591
v.	)	
	)	Mark: MONSTER ENERGY
MONSTER ENERGY COMPANY,	)	
	)	
Applicant.	)	

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**CONSENTED MOTION FOR LEAVE TO FILE AMENDED ANSWER**

Pursuant to Fed. R. Civ. P. 15(a) and Rule 2.107(a) of the Trademark Rules of Practice, Applicant Monster Energy Company (“Applicant”) moves the Board for leave to file an Amended Answer to Notice of Opposition, Affirmative Defenses, and Counterclaim. Opposer’s counsel consented to this motion via email on March 12, 2019, and again by telephone on March 18, 2019.

A copy of the proposed Amended Answer is attached hereto as Appendix A.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 18, 2019

By: /Jason A. Champion/  
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **CONSENTED MOTION FOR LEAVE TO FILE AMENDED ANSWER** has been served on the Opposer's counsel of record on March 18, 2019 via electronic mail to:

Michael T. Hess  
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Signature: 

Name: Doreen P. Buluran

Date: March 18, 2019

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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MONSTER ENERGY COMPANY,	)	
	)	
Applicant.	)	
	)	

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**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION,  
AFFIRMATIVE DEFENSES, AND COUNTERCLAIM**

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Dear Sir or Madam:

Applicant Monster Energy Company (“Monster” or “Applicant”), a Delaware corporation, located and doing business at 1 Monster Way, Corona, California 92879, hereby answers the Notice of Opposition filed by Integrated Supply Network, LLC (“Opposer”) against Application Serial No. 87/833591 as follows:

1. Applicant admits the allegations of Paragraph 1 of the Notice.
2. Applicant admits the allegations of Paragraph 2 of the Notice.
3. Applicant admits that Application Serial No. 85/902,238 claims a date of first use in commerce of December 29, 2010. Applicant denies any remaining allegations of Paragraph 3 of the Notice.

4. Applicant admits that Application Serial No. 85/902,238 registered on May 3, 2016 as U.S. Registration No. 4,951,671. Applicant denies the remaining allegations of Paragraph 4 of the Notice.

5. Applicant admits that ISN has used the MONSTER MOBILE (plus design) mark in U.S. Commerce on at least some of the services recited in the '671 Registration. Applicant denies the remaining allegations of Paragraph 5 of the Notice.

6. Applicant admits that Exhibit A to the Notice appears to be a copy of the '671 Registration and the status pages from the TSDR System for the '671 Registration. Applicant denies any remaining allegations of Paragraph 6 of the Notice.

7. Applicant denies the allegations of Paragraph 7 of the Notice.

8. Applicant admits that ISN sells or has sold tools under the MONSTER MOBILE trademark and under a stylized MONSTER mark in U.S. commerce. Applicant denies all remaining allegations of Paragraph 8 of the Notice.

9. Applicant admits the allegations of Paragraph 9 of the Notice.

10. Applicant admits that it sells beverages, and that it sells energy drinks under the MONSTER ENERGY<sup>®</sup> mark. Applicant denies any remaining allegations of Paragraph 10 of the Notice.

11. Applicant admits that it has been selling energy drinks in U.S. commerce under the MONSTER ENERGY<sup>®</sup> trademark since 2002. Applicant also admits that it sometimes uses the logo depicted in Paragraph 11 of the Notice. Applicant denies any remaining allegations of Paragraph 11 of the Notice.

12. Applicant admits that it has filed and obtained U.S. trademark registrations for its MONSTER ENERGY<sup>®</sup> trademark and its M MONSTER ENERGY logo for goods that

encompass energy drinks. Applicant denies any remaining allegations of Paragraph 12 of the Notice.

13. Applicant admits that third party companies have used trademarks that include the term “monster.” Applicant denies any remaining allegations of Paragraph 13 of the Notice.

14. Applicant admits that third party companies have used trademarks that include the term “monster.” Applicant denies any remaining allegations of Paragraph 14 of the Notice.

15. Applicant admits that third party companies have used trademarks that include the term “monster.” Applicant denies any remaining allegations of Paragraph 15 of the Notice.

16. Applicant admits that third party companies have used trademarks that include the term “monster.” Applicant denies any remaining allegations of Paragraph 16 of the Notice.

17. Applicant admits the allegations of Paragraph 17 of the Notice.

18. Applicant admits that it has entered into a coexistence agreement with Odwalla, Inc., and that, at the time of the agreement, Odwalla had been using the marks C MONSTER and B MONSTER in commerce in the United States in conjunction with certain beverages. Applicant denies the remaining allegations of Paragraph 18 of the Notice.

19. Applicant admits the allegations of Paragraph 19 of the Notice.

20. Applicant denies the allegations of Paragraph 20 of the Notice.

21. Applicant denies the allegations of Paragraph 21 of the Notice.

22. Applicant denies the allegations of Paragraph 22 of the Notice.

23. Applicant denies the allegations of Paragraph 23 of the Notice.

24. Applicant denies the allegations of Paragraph 24 of the Notice.

25. Applicant admits the allegations of Paragraph 25 of the Notice.

26. Applicant admits that it has filed a complaint against ISN in the United States District Court for the Central District of California (Case No. 5:17-cv-00548-CBM-RAO), alleging trademark and trade dress infringement by ISN. Applicant denies any remaining allegations of Paragraph 26 of the Notice.

27. Applicant admits the allegations of Paragraph 27 of the Notice.

28. Applicant admits the allegations of Paragraph 28 of the Notice.

29. Applicant admits the allegations of Paragraph 29 of the Notice.

30. Applicant admits the allegations of Paragraph 30 of the Notice.

31. Applicant admits the allegations of Paragraph 31 of the Notice.

32. Applicant admits the allegations of Paragraph 32 of the Notice.

33. Applicant admits the allegations of Paragraph 33 of the Notice.

34. Applicant admits the allegations of Paragraph 34 of the Notice.

35. Paragraph 35 of the Notice constitutes an admission by ISN as to its beliefs. No response by Applicant as to ISN's statement of its beliefs is necessary or appropriate.

36. Paragraph 36 of the Notice constitutes an admission by ISN as to its beliefs. No response by Applicant as to ISN's statement of its beliefs is necessary or appropriate.

37. Applicant denies the allegations of Paragraph 37 of the Notice.

38. Applicant admits the allegations of Paragraph 38 of the Notice.

39. Applicant admits the allegations of Paragraph 39 of the Notice, but denies any implication that it had not used the MONSTER ENERGY® mark in connection with the listed services at the time it filed its application.

40. Applicant admits the allegations of Paragraph 40 of the Notice.

41. Applicant denies the allegations of Paragraph 41 of the Notice.

42. Applicant denies the allegations of Paragraph 42 of the Notice.
43. Applicant denies the allegations of Paragraph 43 of the Notice.
44. Applicant admits the allegations of Paragraph 44 of the Notice.
45. Applicant denies the allegations of Paragraph 45 of the Notice.
46. Applicant admits that, among other things, it has alleged that there is a likelihood of confusion between the MONSTER ENERGY<sup>®</sup> trademark and ISN's MONSTER MOBILE trademark and stylized MONSTER mark on various goods sold in commerce. Applicant admits that one or more of these allegations have been made in the California civil suit, the Suspended Oppositions, and the Cancellation Action. Applicant denies any remaining allegations of Paragraph 46 of the Notice.
47. Applicant lacks sufficient information to determine the truth or falsity of ISN's assertion as to its own alleged subjective belief and, on that basis, denies the allegations of Paragraph 47 of the Notice.
48. Applicant lacks sufficient information to determine the truth or falsity of ISN's assertion as to its own alleged subjective belief and, on that basis, denies the allegations of Paragraph 48 of the Notice.
49. Applicant admits there has been no final decision on the merits as to Applicant's allegations of a likelihood of confusion in the California civil suit, the Suspended Oppositions, or the Cancellation Action. Applicant denies any remaining allegations of Paragraph 49 of the Notice.
50. Applicant denies that ISN will be injured if the '591 Application is permitted to register and denies any remaining allegations of Paragraph 50 of the Notice.
51. Applicant denies the allegations of Paragraph 51 of the Notice.



## **AFFIRMATIVE DEFENSES**


1. The Notice fails to state a claim upon which relief can be granted.
2. ISN lacks standing to bring the present Opposition Proceeding.
3. ISN's claims are barred by unclean hands because ISN's MONSTER and MONSTER MOBILE marks infringe Applicant's trademark and trade dress rights.

WHEREFORE, Applicant prays that this Opposition be denied in its entirety, for lack of standing and on the merits, and that the '591 Application be permitted to register.

## **COUNTERCLAIM FOR CANCELLATION**

Applicant and Counterclaimant Monster Energy Company ("Monster" or "Applicant"), a Delaware corporation, located and doing business at 1 Monster Way, Corona, California 92879, believes that it has been and will continue to be damaged by the continued registration of U.S.



Registration No. 4,951,671 for the mark  ("the '671 Registration") in International Class 35 and relied upon by Opposer Integrated Supply Network ("ISN" or "Opposer") in its opposition. As grounds for cancelling the '671 Registration, Applicant alleges as follows:

### **A. Likelihood of Confusion and Priority**

1. Applicant previously filed a petition to cancel the '671 Registration on March 6, 2017 (TTAB Proceeding No. 92065591).
2. Applicant's March 6, 2017 petition to cancel alleges that Applicant has priority over the '671 Registration, and that the '671 Registration and ISN's use of the




mark in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment” in International Class 35 is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

3. Monster hereby incorporates by reference all of its allegations as set forth in the March 6, 2017 petition to cancel in TTAB Proceeding No. 92065591.

**B. Fraudulent Allegation of Use**

4. Monster repeats and realleges Paragraphs 1-3 of the Counterclaim as if set forth fully herein.



5. ISN purports to own the '671 Registration for the mark  in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment” in International Class 35.

6. ISN relies on the '671 Registration as grounds for this Opposition against Monster's U.S. Trademark Application Serial No. 87/833,591 for the MONSTER ENERGY mark.

7. The '671 Registration resulted from U.S. Trademark Application Serial No. 85/902,238 (“the '238 Application”).

8. ISN filed the '238 Application on April 12, 2013.

9. On February 11, 2016, ISN filed a Statement of Use in connection with the '238



Application for the mark in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment.”

10. The February 11, 2016 Statement of Use filed in connection with the '238 Application contains the statement “[t]he mark was first used by the applicant, or the applicant’s related company, licensee, or predecessor in interest at least as early as 12/29/2010, and first used in commerce at least as early as 12/29/2010 and is now in use in such commerce.” The February 11, 2016 Statement of Use also contains a standard declaration as to the truth of ISN’s statements contained therein.



11. Upon information and belief, ISN did not use the mark in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment” on or prior to December 29, 2010.



12. Upon information and belief, ISN did not create the mark until January 2013.

13. Upon information and belief, the December 29, 2010 date of first use and date of first use in commerce identified by ISN in the February 11, 2016 Statement of Use are based on



ISN’s sale of three (3) utility knives that do not bear the mark. Additionally, the

services identified by ISN in the '238 Application do not include utility knives.

14. Upon information and belief, ISN knew at the time it filed its February 11, 2016



Statement of Use that it had not used the mark in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment” as early as December 29, 2010.

15. Upon information and belief, ISN knew at the time it filed its February 11, 2016



Statement of Use that it had never used the mark in commerce in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment.”

16. As a result of ISN’s false statements in its February 11, 2016 Statement of Use, the USPTO issued the '671 Registration.

17. Upon information and belief, ISN made the false statements in the February 11, 2016 Statement of Use with knowledge that the statements were false, with the intent to deceive the USPTO and with the intent to induce the USPTO to issue the '671 Registration. Further, the false statements are material. But for the false statements, ISN would not have received the benefit of the '671 Registration.

18. By knowingly submitting false statements to the USPTO in connection with the '238 Application, ISN committed fraud on the USPTO, and ISN’s '671 Registration should be cancelled.

C. **Fraudulent Specimen of Use**

19. Monster repeats and realleges Paragraphs 1-18 of the Counterclaim as if set forth fully herein.

20. ISN did not file a specimen of use with the '238 Application on April 12, 2013.

21. ISN submitted an alleged specimen of use in connection with its February 11, 2016 Statement of Use.

22. ISN's February 11, 2016 Statement of Use describes the alleged specimen of use as a "digital image showing the mark as used on signage promoting the services."

23. Upon information and belief, when submitting its alleged specimen of use, ISN represented to the USPTO that the digital image attached to its February 11, 2016 Statement of Use showed "the mark as used in commerce on or in connection with any item in the class."

24. Upon information and belief, as of February 11, 2016, when ISN filed the



Statement of Use for the '238 Application, ISN had not used the mark in

connection with "mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment."

25. Upon information and belief, the alleged specimen of use submitted by ISN on February 11, 2016 was a computer generated mock-up, and not a depiction of the



mark used in commerce.

26. Upon information and belief, ISN created a computer generated digital image of a



truck bearing the mark for the sole purpose of submitting a specimen that matched the drawing in the '238 Application to obtain the '671 Registration.

27. Upon information and belief, ISN knew at the time it submitted the fraudulent



specimen that it had not used the mark in connection with “mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and

equipment,” and that its alleged specimen of use did not show use of the mark in commerce.



28. As a result of ISN’s false statements and fraudulent specimen submitted in connection with its February 11, 2016 Statement of Use, the USPTO issued the '671 Registration.

29. Upon information and belief, ISN made false statements and submitted a fraudulent specimen with the intent to deceive the USPTO and induce the USPTO to issue the '671 Registration. Further, ISN’s submission of false statements and a fraudulent specimen was material. But for the false statements and fraudulent specimen, ISN would not have received the benefit of the '671 Registration.

30. By knowingly submitting false statements and a fraudulent specimen to the USPTO in connection with the '238 Application, ISN committed fraud on the USPTO, and ISN’s '671 Registration should be cancelled.

**D. Abandonment**

31. Monster repeats and realleges Paragraphs 1-30 of the Counterclaim as if set forth fully herein.



32. Upon information and belief, ISN has abandoned the mark shown in the '671 Registration by discontinuing use of said mark in the United States with intent



not to initiate or resume such use. Accordingly, the mark shown in the '671 Registration has been abandoned and the '671 Registration should be cancelled.



33. In view of ISN's non-use of the mark for "mobile retail store and wholesale distributorship services featuring automotive and industrial tools, supplies and equipment," ISN is not entitled to registration of the mark pursuant to Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3), and as such, said registration should be cancelled.

WHEREFORE, Applicant respectfully requests that U.S. Registration No. 4,951,671 be cancelled and that Applicant's Counter Petition to Cancel be sustained in its entirety in favor of Applicant.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 18, 2019

By: /Jason A. Champion/

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MONSTER ENERGY COMPANY



CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S AMENDED ANSWER TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES, AND COUNTERCLAIM has been served on Opposer's counsel of record on March 18, 2019 via electronic mail to:

Michael T. Hess  
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Signature: 

Name: Doreen P. Buluran

Date: March 18, 2019

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