

ESTTA Tracking number: **ESTTA1013153**

Filing date: **11/04/2019**

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

Proceeding	91251140
Party	Defendant The a2 Milk Company Limited
Correspondence Address	GREGORY J. CHINLUND MARSHALL, GERSTEIN & BORUN LLP 233 SOUTH WACKER DRIVE, SUITE 6300 CHICAGO, IL 60606 docket@marshallip.com no phone number provided
Submission	Answer
Filer's Name	Tanja Proehl
Filer's email	tproehl@gbc.law, aziegler@gbc.law, tmdocket@gbc.law
Signature	/Tanja Proehl/
Date	11/04/2019
Attachments	Answer and Affirmative Defenses.pdf(221913 bytes )

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

SOCIÉTÉ DES PRODUITS NESTLÉ S.A.,	:	
	:	
Opposer,	:	Opposition No.: 91251140
	:	Application Serial No. 88/127,337
v.	:	Mark: ATWO
	:	
	:	
THE A2 MILK COMPANY LIMITED,	:	
	:	
Applicant.	:	

**ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION**

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

Dear Sir:

Applicant, The a2 Milk Company Limited, by and through its undersigned counsel hereby answers the Notice of Opposition by addressing each allegation, and submitting affirmative defenses:

**ANSWERS**

1. Opposer and its affiliated companies constitute one of the world’s largest producers of food and beverages.

**RESPONSE:** Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 1 of the Notice of Opposition and, therefore, denies said allegations.

2. Opposer, through its affiliated companies and licensees, produces and sells food for infants and other food and beverage products containing milk products featuring the A2 beta casein protein.

**RESPONSE:** Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 2 of the Notice of Opposition and, therefore, denies said allegations.

3. The terms “A2” and “A2 milk” primarily signify to consumers that the goods contain or feature the A2 beta casein protein, rather than A1 beta casein protein, when the terms are used in connection with goods containing or consisting primarily of milk.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 3 of the Notice of Opposition.

4. Applicant has frequently disclaimed the wording “A2” from its other U.S. trademark applications and registrations covering identical or related goods and services to the goods in the Application or has sought registration on the Supplemental Register, including the following:

Serial or Reg. No.	Trademark	Class and Goods/Services
86945252	TRUE a2	030 - Bakery desserts; Dessert mousse; Dessert puddings; Edible ices; Frozen yoghurt; Ice cream
5311685	TRUE A2	029 - Beverages consisting principally of milk; beverages having a milk base; cows' milk; dairy products excluding ice cream, ice milk and frozen yogurt; milk; powdered milk; all of the aforementioned goods contain A2 beta casein protein in whole or substantial part
5267836		030 - Ice cream; frozen yogurt; edible ices; desserts in the nature of bakery desserts, dessert puddings and ice cream desserts; all of the foregoing containing A2 beta-casein protein
4693969		005 - Food for infants, namely, human breast milk; powdered milk for babies; milk-based infant formula  029 – Milk products excluding ice cream, ice milk and frozen yogurt

4758183		<p>005 - Food for infants consisting in whole or substantial part of dairy cow's milk and dairy cow's milk products containing the A2 milk protein; milk and milk powder for infants containing the A2 milk protein; casein dietary supplements containing the A2 milk protein</p> <p>029 - Milk containing the A2 milk protein; milk products, namely, full cream, milk powder, full cream milk powder, skim milk powder, yogurt, yogurt powder, buttermilk powder all of the foregoing containing the A2 milk protein; whey and whey powder, butter, cheese all containing the A2 milk protein; milk beverages with high milk content containing the A2 milk protein</p>
4720459		<p>029 - Milk; milk products, namely, full cream, milk powder, full cream milk powder, skim milk powder, yogurt, yogurt powder, buttermilk powder; whey and whey powder, butter, cheese; milk beverages, namely, flavored milk</p>
5388849		<p>005 - Food for infants; powdered milk for babies; dietetic beverages adapted for medical use; animal semen; diagnostic preparations for veterinary purposes for detecting genetic predispositions; diagnostic test reagents for veterinary use; all of the foregoing containing A2 beta casein protein</p> <p>29 - Milk powder; milk; butter; cheese; yoghurt; milk beverages, milk predominating; all of the foregoing containing A2 beta casein protein</p> <p>30 - Ice cream, frozen yoghurt; flavoured ices; frozen ice cream desserts; all of the foregoing containing A2 beta casein protein</p> <p>044 - Veterinary services; animal breeding; providing information relating to animal breeding; genetic testing of animals for breeding purposes; breeding and stud services for cattle</p>

79205493	THANK YOU a2	<p>005 - Food for infants; powdered milk for infants; dietetic foods and beverages, namely, milk and milk-based food and beverages adapted for medical use</p> <p>009 - Downloadable electronic publications in the nature of books, magazines in the field of nutrition; electronic downloadable publications provided online from databases or the Internet in the nature of books, magazines in the field of nutrition; downloadable computer software applications for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data; computer software for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data</p> <p>016 - Printed materials, namely, written articles in the field of nutrition; printed publications in the nature of books, magazines, brochures, booklets, leaflets and informational materials in the field of nutrition; photographs</p> <p>029 - Milk powder; milk; butter; cheese; yoghurt; milk beverages, milk predominating</p> <p>038 - Audio, visual and multimedia transmission services; providing access to electronic and online databases</p> <p>41 - Providing non-downloadable electronic publications in the nature of books, magazines in the field of nutrition; publication of journals, pamphlets, newspapers; publication of magazines; on-line publication of journals, diaries, blogs and forums</p> <p>42 - Providing online non-downloadable software for mobile phones, portable media players, handheld computers, namely, software for use in database management, use in electronic storage of data; design and development of software; hosting computer websites; hosting of databases for others</p>
----------	--------------	---

5211249	a2 PLATINUM	<p>005 - Powdered milk foods for infants; powdered milk for babies; all of the foregoing containing A2 beta-casein protein</p> <p>029 - Milk powder; milk; butter; cheese; yoghurt; milk beverages, milk predominating; all of the foregoing containing A2 beta-casein protein</p>
---------	-------------	--

Printouts from the TSDR database showing the status of these applications and registrations are annexed as **Exhibit 1**.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 4 of the Notice of Opposition.

5. Several of Applicant’s other applications for marks consisting of or containing the wording “A2” covering goods and services identical or related to the goods in the Application have been abandoned after receiving a final refusal from the Office: (a) under Section 2(e)(1), including a final disclaimer requirement for the entire literal element of a composite mark, or (b) on the ground that the mark is generic, including the following:

Serial No.	Trademark	Class and Goods/Services
87087474		<p>005 - Food for infants; powdered milk for babies; dietetic beverages adapted for medical use; Milk for infants; dietetic foods adapted for medical use; all of the forgoing containing A2 beta casein protein</p> <p>029 - Milk powder; milk; butter; cheese; yoghurt; milk beverages, milk predominating; Cream; all of the forgoing containing A2 beta casein protein</p>
86235571	THE a2 MILK COMPANY	<p>005 - Infant foods; milk and milk powder for infants; dietetic foods and beverages, namely, milk and milk-based food and beverages adapted for medical use; all containing A2 beta casein protein</p> <p>029 - Milk and milk products excluding ice cream, ice milk and frozen yogurt; goods including milk and milk products as ingredients, namely, yogurt, yogurt drinks, cream, and thickened cream; all containing A2 beta casein protein</p>

86959820		<p>005 - Infant food containing A2 beta-casein protein; milk and milk powder for infants containing A2 beta-casein protein; dietetic food, namely, milk and milk products adapted for medical use containing A2 beta-casein protein, and dietetic beverages, namely, nutritionally fortified beverages containing A2 beta-casein protein</p> <p>029 - Milk and milk products, namely, milk, flavored milk, full cream, milk powder, skim milk powder, yoghurt, yoghurt powder, buttermilk powder, casein, all of the foregoing containing A2 beta-casein protein; products with milk or milk products as ingredients, namely, whey and whey powder, butter, and cheese, all of the foregoing containing A2 beta-casein protein</p>
86811806		030 - Baked desserts, namely, pies, cookies, brownies and cakes, ice cream, frozen yogurt, edible ices; all of the foregoing containing A2 beta-casein protein
86815137	THE a2 MILK COMPANY	030 - Baked desserts, namely, pies, cookies, brownies and cakes, ice cream, frozen yogurt, edible ices; all of the foregoing containing A2 beta-casein protein
86786413	a2 ICE CREAM	030 – Ice cream; frozen yogurt; edible ices; desserts
86504450		<p>005 - A1 beta-casein protein free food for infants; A1 beta-casein protein free powdered milk for babies; A1 beta-casein protein free dietetic beverages adapted for medical use</p> <p>029 - A1 beta-casein protein free milk powder; A1 beta-casein protein free milk; A1 beta-casein protein free butter; A1 beta-casein protein free cheese; A1 beta-casein protein free yoghurt; milk beverages, A1 beta-casein protein free milk predominating</p>

Printouts from the TSDR database showing the status of these applications are annexed

as **Exhibit 2**.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 5 of the Notice of Opposition.

6. The mark ATWO is identical to the term A2 in pronunciation and meaning and indistinguishable from and interchangeable with the term A2 to U.S. consumers.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 6 of the Notice of Opposition.

7. The term ATWO is therefore generic to the relevant U.S. purchasing public when used in connection with the goods in the Application.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 7 of the Notice of Opposition.

8. Alternatively, the term ATWO merely describes an ingredient, quality, characteristic, or feature of the goods in the Application when used in connection with the goods in the Application.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 8 of the Notice of Opposition.

**COUNT I**  
**The ATWO Mark Is Merely Descriptive**  
**(15 U.S.C. § 1052(e)(1))**

9. Opposer realleges and incorporates by reference the preceding allegations of this Notice of Opposition.

**RESPONSE:** Applicant hereby realleges and incorporates by reference the preceding responses to the Notice of Opposition.

10. The term ATWO is a term that the relevant purchasing public in the U.S. would understand to merely describe milk products that contain only A2 beta casein protein, as opposed to A1 beta casein protein or any mixture of the two proteins.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 10 of the Notice of Opposition.

11. The term ATWO is merely descriptive because it would be understood by the relevant purchasing public in the U.S. to describe an ingredient, quality, characteristic, and/or feature of the goods in the Application.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 11 of the Notice of Opposition.

12. The term ATWO is merely descriptive because it immediately conveys knowledge of a quality, feature, or characteristics of the goods in the Application to the relevant purchasing public in the U.S.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 12 of the Notice of Opposition.

13. The Application therefore should be refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 13 of the Notice of Opposition and further submits that Opposer's request to refuse registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1) should be denied.

**COUNT II**  
**The ATWO Mark Is Generic**  
**(15 U.S.C. § 1052(e)(1))**

14. Opposer realleges and incorporates by reference the preceding allegations of this Notice of Opposition.

**RESPONSE:** Applicant hereby realleges and incorporates by reference the preceding responses to the Notice of Opposition.

15. The term ATWO is a term that the relevant purchasing public in the U.S. would understand primarily as the common or class name for the goods in the Application.

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 15 of the Notice of Opposition.

16. Because a generic term is “the ultimate in descriptiveness” under Section 2(e)(1) (TMEP § 1209.01(c)), the mark is incapable of functioning as a trademark, and the Application therefore should be refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1).

**RESPONSE:** Applicant denies the allegations set forth in Paragraph 16 of the Notice of Opposition and further submits that Opposer’s request to refuse registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1) should be denied.

### **AFFIRMATIVE DEFENSES**

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. Applicant reserves the right to assert additional affirmative defenses which may emerge up to and including the time of trial.

WHEREFORE, Applicant prays that the subject Notice of Opposition be dismissed.

Respectfully submitted,

By           /Tanja Proehl/            
Amy C. Ziegler  
Tanja Proehl  
Attorneys for APPLICANT

GREER, BURNS & CRAIN, LTD.  
300 South Wacker Drive  
Suite 2500  
Chicago, Illinois  
Telephone: (312) 360-0080  
Facsimile: (312) 360-9315

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer and Affirmative Defenses to Notice of Opposition was served upon Opposer's counsel of record, via email, to the following address of record:

CATHERINE C. MILLER  
ANDREA ANDERSON  
NADYA DAVIS  
HOLLAND & HART LLP  
PO BOX 8749 Attn: Trademark Docketing  
DENVER, CO 80201  
[docket@hollandhart.com](mailto:docket@hollandhart.com)  
[aanderson@hollandhart.com](mailto:aanderson@hollandhart.com)  
[ccmiller@hollandhart.com](mailto:ccmiller@hollandhart.com)  
[ncdavis@hollandhart.com](mailto:ncdavis@hollandhart.com)  
[mamoore@hollandhart.com](mailto:mamoore@hollandhart.com)

Respectfully submitted,

Dated: November 4, 2019  
Chicago, Illinois

/Tanja Proehl/  
Tanja Proehl  
One of the Attorneys for Applicant

GREER, BURNS & CRAIN, LTD.  
300 South Wacker Drive  
Suite 2500  
Chicago, Illinois  
Telephone: (312) 360-0080  
Facsimile: (312) 360-9315