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

Proceeding	91268316
Party	Plaintiff Red Bull GmbH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re* Application Serial Nos.: 90/081,580 and 90/081,586

Mark:  **BISON**

Filing Date: July 29, 2020

Publication Date: December 22, 2020

RED BULL GMBH,

Opposer,

v.


BISON PRODUCTS, LLC,

Applicant.

Opposition No. 91268316

**OPPOSER’S MOTION TO DISMISS APPLICANT’S COUNTERCLAIMS  
AND TO STRIKE APPLICANT’S EQUITABLE DEFENSES**

Pursuant to Federal Rules of Civil Procedure 12(b)(6) and 12(f) and TBMP §§ 503 and 506, Opposer Red Bull GmbH (“Red Bull”) moves to dismiss the counterclaims for cancellation asserted by Applicant Bison Products, LLC (“Applicant”), *see* 14 TTABVUE 10-29, and moves to strike Applicant’s affirmative defenses of unclean hands and equitable estoppel. *See id.* at 6-9.

As demonstrated in detail below, Applicant’s counterclaims are fatally defective because Applicant has not alleged any facts from which the Board could infer that Red Bull fraudulently procured its Registration No. 3,838,170 (the “170 Registration”) or Registration No. 3,092,197 (the “197 Registration”) or that Red Bull abandoned its  and RED BULL marks. In addition, Applicant’s affirmative defenses of unclean hands and equitable estoppel do not contain facts identifying any act on Red Bull’s part that “rightfully can be said to transgress equitable

standards of conduct,” *see VIP Foods, Inc. v. V.I.P. Food Prods.*, 200 U.S.P.Q. (BNA) 105, 113 (T.T.A.B. 1978), nor does Applicant allege any facts supporting its conclusory claims of reasonable reliance or material prejudice. Applicant’s equitable defenses therefore are insufficient as a matter of law.

## **I. BACKGROUND**

On July 29, 2020, Applicant applied to register the mark shown below under Section 1(b), 15 U.S.C. § 1051(b), for “Nutritional supplements” in Class 5 (the “580 Application”) and “Mixed fruit juices” in Class 32 (the “586 Application”).



*See* 12 TTABVUE 8 (¶ 3). Each application was published on December 22, 2020. 1 TTABVUE 2.

On March 23, 2021, Red Bull opposed both applications, pleading its prior rights in “various United States trademark registrations and common law rights” in the word and design marks set forth in the notice of opposition. 1 TTABVUE 9 (¶ 6). After Applicant moved to dismiss Red Bull’s notice of opposition under Rule 12(b) claiming that Red Bull failed to assert priority, 4 TTABVUE, Red Bull filed an amended notice on May 3, 2021, this time specifically pleading several of its registrations as well as its common-law rights. 6 TTABVUE 4-6 (¶¶ 6-10). On July 26, 2021, Red Bull sought leave to further amend the notice to withdraw its claims as to Applicant’s applications to register the BISON word mark. 12 TTABVUE 2. Applicant did not oppose that motion. 13 TTABVUE.

On August 3, 2021, Applicant filed its Answer, Affirmative Defenses, and Counterclaims for Cancellation. 14 TTABVUE. Applicant's counterclaims seek cancellation of Red Bull's '170 Registration and '197 Registration on the grounds of fraud and abandonment. *Id.* at 10-29. Applicant also asserts unclean hands and equitable estoppel as affirmative defenses.<sup>1</sup> *Id.* at 6-9. As shown below, Applicant's counterclaims fail to state plausible claims for relief, meriting their dismissal. Applicant's equitable defenses are insufficient and should be stricken.

## II. ARGUMENT

Applicant's counterclaims fail to state a claim under Rule 12(b)(6) because they do not "contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). "A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Id.* In drawing those inferences, however, a court is not required to accept "conclusory statements" made by the counterclaimant as true, nor do "legal conclusion[s] couched as . . . factual allegation[s]" merit such deference. *Id.*

The purpose of a 12(b)(6) motion is to challenge "the legal theory of the complaint, . . . [and] to eliminate actions that are fatally flawed in their legal premise and destined to fail." *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157 (Fed. Cir. 1993). This is an apt description of Applicant's fraud and abandonment claims. Accordingly, the Board should dismiss each of Applicant's claims in their entirety.

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<sup>1</sup> Applicant also asserts "No Likelihood of Confusion" as a defense. 14 TTABVUE 9. This is not a true affirmative defense, but merely amplifies Applicant's denials. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 U.S.P.Q.2d 1232, 1236 n.11 (T.T.A.B. 2015).

**A. Applicant’s Fraud Claims Seek Relief That Is Either Legally Unavailable or Fail to State a Claim Upon Which Relief Can Be Granted.**

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009) (citation omitted). As the Federal Circuit famously emphasized in *Bose*,


A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.”

*Id.* (quoting *Smith Int’l, Inc. v. Olin Corp.*, 209 U.S.P.Q. 1033, 1044 (T.T.A.B. 1981)).

In addition, at the pleading stage, Federal Rule of Civil Procedure 9(b) requires parties alleging fraudulent procurement to “state with particularity the circumstances constituting fraud.” Fed. R. Civ. P. 9(b). Thus, while “[m]alice, intent, knowledge, and other conditions of a person’s mind may be alleged generally,” *id.*, the law requires a counterclaimant alleging fraudulent procurement to allege the *particular facts* supporting a reasonable inference that the registrant acted fraudulently. “The pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud.” *Asian & W. Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, 1478 (T.T.A.B. 2009) (quoting *King Auto., Inc. v. Speedy Muffler King, Inc.*, 212 U.S.P.Q. 801, 803, 667 F.2d 1008, 1010 (C.C.P.A. 1981)). Conclusory statements like the ones in Applicant’s counterclaims “do not suffice.” *See Iqbal*, 556 U.S. at 678; *see Twombly*, 550 U.S. at 555.

**1. Applicant Cannot Cancel Red Bull’s ‘170 Registration and ‘197 Registration in Their Entirety Based on Allegations of Fraud Related to Class 33 Only.**

Applicant advances equally deficient theories in support of its claim that the registrations at issue should be cancelled in their entirety. With respect to the ‘170 Registration, Applicant

alleges that Red Bull submitted knowingly false declarations of its *bona fide* intent to use the  mark in commerce in connection with Class 33 good. 14 TTABVUE 17 (¶¶ 27, 29, 30). Similarly, with respect to the ‘197 Registration, Applicant alleges that Red Bull knowingly misrepresented to the USPTO that it had used the RED BULL mark in connection with vodka at the time it filed its use-based application. Even if the facts alleged by Applicant were true—they are not—its remedy would be to cancel Class 33 only, not any other active Class in the registrations at issue as requested by Applicant. *See G&W Lab’ys, Inc. v. G W Pharma Ltd.*, 89 U.S.P.Q.2d 1571, 1574 (T.T.A.B. 2009) (dismissing a fraud claim against a multi-class registration where a judgment of fraud was found only as to one Class in the registration).

The Board’s decision in *G&W* is both instructive and binding precedent. In that case, the petitioner sought to cancel a registration covering Classes 35 and 5, but only asserted fraud as to Class 35. *Id.* Finding that the petitioner failed to “state a valid basis for cancellation,” the Board granted the defendant’s motion to dismiss the counterclaim as to Class 5 reasoning that

each class of goods or services in a multiple class registration must be considered separately when reviewing the issue of fraud, and judgment on the ground of fraud as to one class does not in itself require cancellation of all classes in a registration.

*Id.* at 1574.

Like the petitioner in the *G&W* case, Applicant’s allegations of fraud related to Class 33 is not a valid basis to cancel any other Class in the ‘170 Registration or the ‘197 Registration. Accordingly, Applicant’s request to cancel Classes 25 and 32 of the ‘170 Registration and Class 32 of the ‘197 Registration based on allegations of fraud related to Class 33 should be dismissed.

## **2. Applicant’s Allegations of Fraud As to Class 33 Are Moot.**


As explained above, Applicant’s allegations of fraud related to Class 33, if proven, could only result in the cancellation of Class 33 of the ‘170 Registration and the ‘197 Registration.

Setting aside the absurdity that Applicant’s allegations of fraud are based on the fact that Red Bull filed extensions of time to file a Statement of Use<sup>2</sup>, and its counsel’s inability to find *internet* evidence of Red Bull’s bona fide intent to use its mark with Class 33 goods<sup>3</sup> and documentation of a licensing arrangement<sup>4</sup>, neither of the registrations at issue even covered Class 33 at the time Applicant filed its counterclaims for fraud.

In fact, the ‘170 Registration **never** covered Class 33. 14 TTABVUE 10 (¶ 12) Instead, when Red Bull filed its Statement of Use to obtain the registration in 2010, it did so only for

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<sup>2</sup> *Spin Master, Ltd. v. Zobmondo Ent. LLC*, 778 F. Supp. 2d 1052, 1066 (C.D. Cal. 2011) (“[A]bsent a subjective intent to deceive the PTO . . . , there is nothing wrong with [the plaintiffs] requesting (and being granted) all of the available statutory extensions. Congress created the intent-to-use system and the Court will not treat compliance with statutory procedures as evidence of fraud.”) Moreover, Applicant can have no knowledge of why Red Bull sought extensions, and Applicant has not alleged a single fact supporting its claim that Red Bull misrepresented its reasons for doing so. This type of unfounded accusation does not even rise to the level of “speculation, inference, or surmise” and is improper. *See* Fed. R. Civ. P. 11(b)(3) (“By presenting to the court a pleading, written motion, or other paper . . . an attorney . . . certifies that to the best of the person’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, . . . the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery”).

<sup>3</sup> As trademark owners are not in the habit of uploading their *bona fide* intentions to the internet, it is not surprising that Applicant’s counsel did not find any evidence through internet searches. In any event, Applicant’s internet evidence is incompetent to establish Red Bull’s intentions for its  mark one way or the other, leaving nothing but “speculation, inference, or surmise”<sup>3</sup> *See Bose*, 580 F.3d at 1243.

<sup>4</sup> “[T]o satisfy Rule 9(b), any allegations based on ‘information and belief’ must be accompanied by a statement of facts upon which the belief is founded.” *Asian & W. Classics*, 92 U.S.P.Q.2d at 1479; *accord NSM Res. Corp. v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 1034 (T.T.A.B. 2014) (“Pleadings of fraud ‘based on information and belief’ without allegations of specific facts upon which the belief is reasonably based are insufficient.”). Several of Applicant’s allegations are based on “information and belief,” *see* 14 TTABVUE 26, 27 (¶¶ 68, 69, 79), for which Applicant fails to provide any legitimate basis. Specifically, Applicant does not identify *any* support for its allegation that Red Bull “knew that any [vodka manufacturer’s] use in commerce . . . did not inure to the benefit of Opposer” when Red Bull “filed its application under Section 1(a) and its declaration of use” in Class 33, *id.* at 27-28 (¶ 79), and as Applicant must know, Internet searches alone are unlikely to reveal whether a manufacturer is operating under a trademark license. *See* 14 TTABVUE 26 (¶¶ 68, 69).


Classes 25 and 32. Similarly, when Red Bull renewed the ‘197 Registration in 2012, it deleted Class 33 in its entirety. *See* 6 TTABVUE Ex. A-1, 1. In sum, prior to any challenge by Applicant, Red Bull voluntarily deleted Class 33 from the application before it matured into the ‘170 Registration and from the ‘197 Registration upon renewal. Accordingly, even if Applicant could prove its fraud claims related to Class 33, there is nothing to cancel. Any attempt by Applicant to cancel Class 33 of the registrations is, therefore, moot.

**3. Applicant Fails to State a Claim for Fraud as to Class 32 of the ‘170 Registration.**

Another theory Applicant advances in support of its fraud claims is that Red Bull filed a knowingly false declaration in its Statement of Use for the ‘170 Registration for Class 32. *Id.* at 18-20 (¶¶ 37-42, 46). In support of this claim, Applicant relies on Red Bull’s submission of its July 1, 2010 specimen of use, which Applicant alleges “depict[s] an image of two charging bulls,” not Red Bull’s  mark. *Id.* at 18 (¶ 37). Essentially, Applicant takes issue with the Examiner’s acceptance of Red Bull’s specimen of use demonstrating one example of how Red Bull used the  mark at the time it filed its Statement of Use. Red Bull’s specimen, however, cannot form the basis of a fraud claim for two reasons. First, the adequacy of specimen submitted during prosecution is solely a matter of *ex parte* examination and does not constitute grounds for challenging the resulting registration in an opposition or cancellation. *See Century 21 Real Est. Corp. v. Century Life of Am.*, 10 U.S.P.Q.2d 2034, 2035 (T.T.A.B. 1989) (“reaffirm[ing] [the Board’s] prior decision that unacceptable specimens are not a proper ground for opposition”). Second, the specimen itself demonstrates that Red Bull did not make a false representation or omission of fact that would support a fraud claim.

Interestingly, Applicant relies on the specimen Red Bull filed with and that was approved by the USPTO Examiner as evidence that Red Bull made a material false statement to the Board




regarding its use of the  mark when it filed its Statement of Use. But the specimen itself belies this allegation. How could Red Bull intentionally misrepresent its use of the mark when it presented the USPTO Examiner with a specimen depicting one way in which the mark was used in commerce with goods in Class 32?


Applicant does not allege that the specimen itself is fraudulent nor does it allege that the Class 32 goods shown in the specimen were not in use in commerce at the time Red Bull filed its Statement of Use. Rather, Applicant simply disagrees with the USPTO Examiner's decision that use of the mark as depicted in the specimen was sufficient to demonstrate use of the mark in commerce. Applicant's disagreement, however, does not transform Red Bull's specimen and accompanying Statement of Use into a false misrepresentation or omission. *See Belstone Capital, LLC v. Bellstone Partners, LLC*, No. 2:16-cv-01124-KJM-GGH, 2017 WL 1153111, at \*4 (E.D. Cal. Mar. 27, 2017) (holding that defendant provided the USPTO with evidence of how it used the mark in commerce and although plaintiff may disagree with the USPTO's decision to register the mark at issue based on a specimen that depicted the mark along with other elements, that disagreement does not make out a claim of fraud."). Without a false misrepresentation, Applicant's fraud claim as to Class 32 is fatally flawed and must be dismissed.

**B. Applicant's Abandonment Claims Are Factually and Legally Insufficient.**

A mark is deemed abandoned "[w]hen its use has been discontinued with intent not to resume such use," with three consecutive years of nonuse serving as "prima facie evidence of abandonment." 15 U.S.C. § 1127. Thus, to plausibly plead abandonment, Applicant must "must recite facts which, if proven, would establish at least three consecutive years of nonuse, or alternatively, a period of nonuse less than three years coupled with proof of intent not to resume use." *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1930 (T.T.A.B. 2014) (citation

omitted). These facts must be sufficient to provide the registrant with “fair notice” of the counterclaimant’s abandonment theory. *Id.*

Applicant’s abandonment claims do not recite any facts from which the Board could reasonably infer Red Bull’s nonuse, much less for three consecutive years. Applicant’s entire basis for claiming abandonment of Red Bull’s ‘170 Registration is its counsel’s July 24, 2021, Google internet search for Red Bull’s  mark between the “registration date of August 24, 2010 up to August 25, 2013 in connection with energy drinks, soft drinks, and sport drinks.” 14 TTABVUE 21 (¶ 53). Based on the results of this search, Applicant concludes that Red Bull was not using the mark in commerce “in connection with all of the identified goods in Class 32” during that period, *id.* at 22 (¶ 56), and seeks cancellation of Red Bull’s “entire” registration. *Id.* at 22 (¶ 58). Applicant’s abandonment allegations for the ‘197 Registration are even more conclusory, if possible; and as with the ‘170 Registration, Applicant alleges nonuse as to a single class (Class 33), yet seeks cancellation of the “entire ‘197 Registration.” *Id.* at 28-29 (¶¶ 85-89).

The results of Applicant’s internet searches—all conducted within the last two months—are not competent evidence to infer that Red Bull failed to use its  and RED BULL marks in Classes 32 and 33, respectively, for three consecutive years. *See Equinix, Inc. v. OnePacket LLC*, Cancellation No. 92069714, slip op., 13 TTABVUE 18 (T.T.A.B. July 2, 2021) (nonprecedential) (unavailability of “advertising or promotional materials, or press coverage” about respondent’s services on “the Google, Bing and Yahoo internet search engines (on September 11, 2019) . . . does not establish Respondent’s lack of use of its mark for a three-year period”); *Toufigh v. Persona Parfum, Inc.*, 95 U.S.P.Q.2d 1872, 1875 (T.T.A.B. 2010) (no *prima facie* case of abandonment where “Petitioner did testify to having checked respondent’s website ‘on more than one occasion’” over a period “spanning merely a few weeks,” but there was “no

evidence that he checked over a period of at least three years”); *cf. Buchan v. Livingood*, No. 92043742, 2005 WL 2747604, at \*4 (T.T.A.B. Oct. 19, 2005) (nonprecedential) (on motion for summary judgment, holding that “[t]he mere absence of petitioner’s mark on the Internet in no way satisfies the strict standard necessary to prove abandonment”).

Even if Applicant had pleaded sufficient facts to support its abandonment theories—it did not—it would still not be entitled to cancellation of the ’170 Registration and the ’197 Registration in their entirety. “To cancel an entire registration, the party must prove its adversary has abandoned the mark of the registration for all goods or services in each of the classes of goods and services identified therein.” *Sky Int’l AG v. Sky Cinemas LLC*, No. 91223952, 2020 WL 6887759, at \*6 (T.T.A.B. Nov. 19, 2020). Because Applicant’s allegations of non-use do not relate to Class 25 of the ’170 Registration or Class 32 of the ’197 Registration, Applicant’s claims to cancel these classes are fatally flawed as a matter of law and must be dismissed. Moreover, even if Applicant’s allegations are true with respect to Class 33 of the ’197 Registration, that registration no longer contains goods in Class 33 and, like its fraud claim, any abandonment claim related to Class 33 is now moot.

Applicant has failed to state plausible claims for abandonment and these claims should be dismissed.

**C. Applicant’s Affirmative Defenses of Unclean Hands and Equitable Estoppel Are Insufficient as a Matter of Law.**

In addition to its counterclaims, Applicant asserts the affirmative defenses of unclean hands and equitable estoppel<sup>5</sup>, both of which are based on Applicant’s alleged reliance on explicit

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<sup>5</sup> The Board “may strike from a pleading an insufficient defense,” Fed. R. Civ. P. 12(f). A motion to strike “may be joined with any other motion allowed” under Rule 12, including a motion to dismiss. Fed. R. Civ. P. 12(g)(1); *see also* TBMP § 506.02 (timing of motion).

representations by Red Bull that it would not assert its registrations in an opposition against Applicant's marks. Applicant's equitable affirmative defenses are factually and legally untenable.

Applicant's own allegations and the pleadings of record are at odds with any inference that Red Bull represented to Applicant that it would not rely on its common law rights:

- In the email Applicant relies on, Red Bull's counsel never represents that Red Bull would not assert its registrations. Instead, she informed Applicant that Red Bull's rights are rooted in common law after which she identified two of the registrations Red Bull ultimately asserted in its amended Notice of Opposition:

For the purposes of any potential opposition, our client would be relying on its common law rights in its RED BULL family of marks, which include, but are not limited to, the two logo marks shown below. *These marks, and other marks within the family of marks, are registered under multiple trademark registrations for various goods and services, including but not limited to soft drinks and energy drinks.* Red Bull need not rely on any particular registration for the purposes of its objection to, or opposition of, your client's trademark applications. However, ***two examples of Red Bull's registrations are Reg. Nos. 3838170 and 3197810.***

14 TTABVUE 7 (emphasis added).

- Red Bull's original notice of opposition asserted that it is "also the owner of various United States trademark registrations and common law rights in and to the trademarks [set forth in the opposition]." 1 TTABVUE 9 (¶ 6).
- After Applicant moved to dismiss the original notice of opposition, 4 TTABVUE, Red Bull amended its notice to specifically plead Registration Nos. 2,946,045, 3,092,197, 3,197,810, and 3,838,170 in addition to its common-law rights. 6 TTABVUE 3-6 (¶¶ 5-10).
- Red Bull's amended notice included registrations of the same marks it identified in its original notice. *Id.*

These facts do not support a reasonable inference that Red Bull misled Applicant about its reliance on its trademark registrations. *See Iqbal*, 556 U.S. at 678 (defining plausibility as “allow[ing] the court to draw the reasonable inference that the defendant is liable for the misconduct alleged”).

Applicant’s equitable defenses also are legally unsupported. Specifically, it is well settled that “[t]he allegedly unfair or improper filing of a trademark infringement lawsuit cannot itself constitute a basis for an unclean hands defense to that lawsuit.” *See* 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31:51 (5th ed. 2021) (“*McCarthy*”). Instead, “[u]nclean hands must relate to the *getting or using* of the alleged trademark rights”—not the enforcement of those rights.<sup>6</sup> *Id.* (emphasis added). That being the case, Red Bull’s amendment to plead specific registrations *of which its counsel previously put Applicant on notice* cannot support Applicant’s unclean hands defense.

As for equitable estoppel, that defense is generally unavailable in opposition proceedings because the estoppel runs from the publication date—here, December 22, 2020. An estoppel period lasting a few months (as opposed to years) makes it difficult, if not impossible, to establish material prejudice from any resulting “delay.” *Nat’l Cable Tel. Ass’n v. Am. Cinema Eds. Inc.*, 19 U.S.P.Q.2d 1424, 1432, 937 F.2d 1572, 1580 (Fed. Cir. 1991). Applicant seeks to avoid this settled

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<sup>6</sup> *See Novadaq Techs., Inc. v. Karl Storz GmbH & Co. K.G.*, 143 F. Supp. 3d 947, 956 (N.D. Cal. 2015) (holding an erroneous date in a pleading and continued prosecution of the case “cannot underlie an unclean hands defense because they relate to the current litigation, not to how Novadaq allegedly obtained the asserted trademark rights”); *Gucci Am., Inc. v. Guess?, Inc.*, 868 F. Supp. 2d 207, 256 (S.D.N.Y. 2012) (rejecting unclean hands defense because Gucci’s delay in pursuing infringement and dilution claims against defendants was “a tactical choice rather than an ‘unconscionable act’”); *Yurman Design, Inc. v. Golden Treasure Imps., Inc.*, 275 F. Supp. 2d 506, 518 (S.D.N.Y. 2003) (holding “[t]he fact that a party has brought a lawsuit in which the party seeks protection for a trademark or trade dress, allegedly in bad faith, cannot be the basis of a defense of unclean hands, because the ‘[u]nclean hands must relate to the getting or using the alleged trademark rights’” (citing, *inter alia*, 5 *McCarthy* § 31:51)).

Board rule by locating its alleged “misrepresentation” in the February 3, 2021 email from Red Bull’s counsel. 14 TTABVUE 9. As shown above, however, counsel’s email does not contain *any* representation (much less an “explicit” one) about whether Red Bull might ultimately plead specific registrations in addition to “relying on its common law rights.” *See id.* at 7. Rather, the email clearly identifies two of the registration Red Bull recited in its amended notice.

Further, the prejudice Applicant alleges as a result of the February 3, 2021 email—*i.e.*, “having to defend against Opposer’s claims with respect to its federal registrations”—also fails as a matter of law. Trademark rights are obtained through use, not registration. Here, Red Bull has relied on its prior and continuous common law use of its marks in support of its pleading of likelihood of confusion and damage resulting therefrom. The registrations asserted by Red Bull cover the same trademarks and goods for which Red Bull asserted common law rights. Thus, Applicant would be required to defend this opposition against Red Bulls rights in the same marks whether or not Red Bull asserted its registrations. There is simply no prejudice to Applicant, particularly when Applicant was put on notice at the pleading stage of the proceedings.

Applicant’s affirmative defenses should be stricken in their entirety.

### **III. CONCLUSION**

For the foregoing reasons, Applicant has failed to state plausible counterclaims for cancellation based on its fraud and abandonment theories, and Applicant’s equitable defenses are likewise insufficient. Red Bull therefore respectfully asks the Board to dismiss Applicant’s counterclaims with prejudice and strike Applicant’s affirmative defenses of unclean hands and equitable estoppel from Applicant’s Answer.

This 13<sup>th</sup> day of September, 2021.

Respectfully submitted,

/Tywanda Harris Lord/  
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**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION TO DISMISS APPLICANT'S COUNTERCLAIMS AND TO STRIKE APPLICANT'S EQUITABLE DEFENSES is being filed electronically with the Trademark Trial and Appeal Board via ESTTA on this, 13<sup>th</sup> day of September, 2021.

/Louie W. Crumbley/  
Kilpatrick Townsend & Stockton LLP



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RED BULL GMBH,

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**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing OPPOSER'S MOTION TO DISMISS APPLICANT'S COUNTERCLAIMS AND TO STRIKE APPLICANT'S EQUITABLE DEFENSES has been served on Applicant's counsel, Sam Sokhansanj, Esquire, Law Office of Sam Sokhansanj PLLC, 2101 Cedar Springs Road, Suite 1050, Dallas, Texas 75201, by electronic mail to the following email address:

*sam@attorneysam.com*

This 13<sup>th</sup> day of September, 2021.

*/Louie W. Crumbley/*  
Kilpatrick Townsend & Stockton LLP