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

Proceeding no.	92086350
Party	Defendant Advanced, LLC
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Submission	Opposition/Response to Motion
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Date	04/10/2025
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U.S. Trademark Registration No. 6,094,433

Advanced Bionutritionals, L.L.C., Petitioner, -against- Advanced, LLC, Registrant.	Cancellation No.: 92086350 Date Filed: April 10, 2025

OPPOSITION TO COUNTERCLAIM REGISTRANT'S MOTION TO DISMISS COUNTERCLAIM PETITIONER'S COUNTERCLAIM

Registrant and Counterclaim Petitioner Advanced, LLC ("Advanced" or "Registrant"), by and through its attorneys, Austin LLP, responds in opposition to Petitioner and Counterclaim Registrant Advanced Bionutritionals, L.L.C. ("Counterclaim Registrant") as follows:

RELEVANT BACKGROUND

On December 24, 2024, Advanced filed its Answer with Counterclaims in response to Counterclaim Registrant's Petition for Cancellation. On March 21, 2025, Counterclaim Registrant filed its motion to dismiss Advanced's counterclaim for cancellation for being merely descriptive.

REQUEST FOR LEAVE TO AMEND ANSWER

Herein, in opposition to Counterclaim Registrant's motion to dismiss, Advanced hereby requests the Trademark Trial and Appeal Board (the "Board') grant Advanced leave to file an amended answer with additional counterclaims pursuant to 15 U.S.C § 1064(3).

Specifically, Advanced requests the Board grant it leave to amend the answer to assert counterclaims that the mark has become generic and/or is functional pursuant to 15 U.S.C § 1064(3). As the statute states, "[a] petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed . . . (3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered." 15 U.S.C § 1064(3) (excerpted).

LEGAL STANDARD

The issue presently before the Board is whether an answer may be amended to add an omitted counterclaim, where the counterclaim may be alleged to have been compulsorily filed with the answer.

A defense attacking the validity of a registration pleaded in an opposition is a compulsory counterclaim if grounds for the counterclaim exist at the time when the answer is filed or are learned during the course of the opposition proceeding. *See* Trademark Rule 2.106(b)(3)(i), 37 C.F.R. § 2.106(b)(3)(i).

However, in a precedential decision, the Board held that neither the wording of the compulsory counterclaim rules, nor the purposes behind their adoption dictate a finding that a compulsory counterclaim is barred absolutely unless raised in the original answer. *Jive Software, Inc. v. Jive Commc'ns, Inc.*, 125 USPQ2d 1175 (TTAB 2017). The Board stated, "

> Trademark Rule 2.106(b)(3)(i) provides that "[i]f grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned."

Jive Software, at *5.

The Board also held that if grounds for a compulsory counterclaim are learned after an answer is filed, the defendant must promptly move to file a motion for leave to amend to add the counterclaim. *Id*.

The Board has also held that a defendant that fails to timely file a compulsory counterclaim may be precluded from asserting the counterclaim. *Freki Corp. N.V. v. Pinnacle Entm't, Inc.*, 126 USPQ2d 1697, 1701 (TTAB 2018).

ADVANCED SHOULD BE GRANTED LEAVE TO AMEND ITS ANSWER

As this filing is made well before the discovery conference, Counterclaim Registrants will not be prejudiced by granting Advanced leave to amend. Secondly, in the interests of justice and for the purposes of determining this issue on the merits, Advanced should be granted leave to amend.

In short, the Board has discretion to grant Advanced leave to amend its answer with counterclaims and for the reasons presented herein, Advanced respectfully requests such leave.

WHEREFORE, Registrant Advanced, LLC respectfully requests the Trademark Trial and Appeal Board Grant Petitioner's request for leave to amend its answer with counterclaims and award such other and further relief as is deemed just and equitable.

Dated: April 10, 2025
New York, NY

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposition to Counterclaim Registrant's Motion to Dismiss Counterclaim Petitioner's Counterclaim has been served on JULIAN GONZALEZ GOLDSTEIN PATENT LAW by forwarding said copy on April 10, 2025 via email to:

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Dated: April 10, 2025
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