

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

In re: LABCAST
Application Serial No.: 75/813380
Current Applicant: Varian, Inc. (Prior Applicant: VanKel Technology Group)

Opposition No. 91150161

Innovative Programming Associates, Inc.

Opposer

v.

Varian, Inc.

Applicant



01-22-2002

U.S. Patent & TMO/tm Mail Rcpt Dt. #11

**OPPOSER'S OPPOSITION TO
APPLICANT'S MOTION TO STRIKE OPPOSER'S AFFIRMATIVE DEFENSES**

Opposer, Innovative Programming Associates, Inc. ("IPA") hereby opposes Applicant's Motion to Strike Opposer's Affirmative Defenses. It is well established that motions to strike are not favored by the Trademark Trial and Appeals Board. As stated in Harsco Corp v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988):

"Fed.R.Civ.P. 12(f) provides, in relevant part, for striking from a pleading, any redundant, immaterial, impertinent or scandalous matter, Motions to strike are not favored and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See FRA S.p.A v. Surg-O-Flex of America, Inc., 194 USPQ 42, 46 (S.D.N.Y. 1976); Leon Shaffer Golnick Advertising, Inc. v. William G Pendil Marketing Co., Inc., 177 USPQ 401, 402 (TTAB 1977); and cases cited therein."

Moore's Federal Practice, Section 12.21 [2] (2nd ed. 1985) further states:

"Even if the allegations are redundant or immaterial, they need not be stricken if their presence in the pleading cannot prejudice the adverse party."

Grounds for not striking Opposer's First Affirmative Defense:

Applicant's counterclaim is to restrict Opposer's registered mark (Registration No. 1284179 for LABCAT) by reducing the scope of the description of services in Opposer's registered mark LABCAT.

As its first affirmative defense against this counterclaim, Opposer asserts its ownership rights under the Lanham Act in the LABCAT Trademark. Clearly, this defense is not immaterial or redundant and at the very least the presence of the defense in the pleadings cannot prejudice Applicant.

Grounds for not striking Opposer's Second Affirmative Defense:

Opposer's second affirmative defense to Applicant's counterclaim to restrict Opposer's Registration is that Applicant fails to state a claim on which relief may be granted. Opposer owns registration No. 1284179 for LABCAT. This registration has been registered since July 1983 and the first use in commerce was in December of 1982. Opposer has been using the mark in connection with the listed goods and has built up considerable goodwill in the mark over many years of use. Opposer has filed the Section 8 and Section 15 declarations under 37 CFR Secs. 2.161-2.166 and 2.167 and 2.168 for this registration. (See Exhibits A and B) Thus this registration is prima facie evidence that Opposer is the owner of this Trademark. Applicant in its Counterclaim seeks to restrict Opposer's registration. In Paragraph 5 of Applicant's Counterclaim, Applicant states that Opposer's description of goods is overly broad and does not do equity and does not fairly or accurately reflect the true nature of Opposer's

goods. In as much as Opposer has filed the required Section 8 and 15 declarations, Applicant's ownership rights in the mark are uncontestable. 15 U.S.C. Sec.1065.

§15 (15 U.S.C. §1065). Incontestability of right to use mark

“Except on a ground for which application to cancel may be filed at anytime under paragraphs (3) and (5) of section 14 of this Act, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this Act of such registered mark, the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable”

Since Opposer's right to use the mark is uncontestable, any claim to alter Opposer's ownership rights cannot be brought at this time and therefore Applicant's counterclaim to restrict Opposer's ownership rights fails to state a claim on which relief may be granted. Thus Opposer's Second Affirmative Defense must not be stricken.

Grounds for not striking Opposer's Third Affirmative Defense:

Finally, as for Opposer's Third Affirmative Defense, Section 35 of the Lanham Act provides:

§35 (15 U.S.C. §1117). Recovery of profits, damages, and costs

“(a) When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 43(a), (c), or (d) or a willful violation under section 43(c), shall have been established in any civil action arising under this Act, the plaintiff shall be entitled, subject to the provisions of sections 29 and 32 and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action.”

Even if the TTAB does not have the authority to grant such relief, Opposer has included this defense so as to preserve it if needed in subsequent actions. At the least, inclusion of this defense in no way prejudices Applicant's defense of its application, and under the standards set forth above this defense must not be stricken.

Opposer relies on *Order of Sons of Italy in America v. Marofa S.A.* 38 USPQ2d 1602 (TTAB 1996). This case can be distinguished in two ways. The first issue to be noted is that this case is marked as unpublished in the heading and there is an Editor's note on page 1603 stating that this is not binding precedent on the TTAB.

Second in *Sons of Italy*, Applicant denied the allegations set forth in the opposition and as an affirmative defense asserted that Opposer failed to state a cause of action. Opposer filed a motion to strike the affirmative defenses as insufficient contending that the allegations in its notice are sufficient to establish its personal interest in the opposition proceeding. The opposition in this proceeding was an organization of Italian-American citizens who were opposing the registration under section 2(a) of the Lanham Act, of the trademark COSA NOSTRA on the grounds that it was disparaging to them as an ethnic group. Opposer's motion to strike Applicant's affirmative defenses was only granted upon a showing that Opposer has standing to bring the proceeding and support the allegations in the pleading.

In the present case, the roles are reversed. Opposer as owner of the mark has standing to bring this proceeding. However, Applicant in its counterclaim seeks to restrict Opposer's uncontestable registration. The burden is on Applicant to make a showing that Applicant has standing to bring such a claim.

Conclusion:

Each of the Affirmative Defenses presented in Opposer's Answer to Applicant's Counterclaims should not be stricken for the foregoing reasons.

Respectfully Submitted,

Charles Manero

Charles Manero
Attorney for Opposer
Innovative Programming
Associates, Inc.

Charles Manero

Woodbridge & Associates, P.C.
P.O. Box 592
Princeton, NJ 08542

(609) 924-3773

CERTIFICATE OF MAILING

I certify that this document is being deposited with the United States Postal Service, First Class Postage prepaid, addressed to Commissioner of Trademarks, Attn: TTAB, 2900 Crystal Drive, Arlington, VA 22201-3513 on January 17, 2002

Dated: 1/17/02

Charles Manero

CERTIFICATE OF SERVICE

I certify that a copy of this document has been sent to counsel for Varian Inc. via United States Postal Service, First Class postage pre-paid, addressed as follows: Roy S. Gordet Esq., 530 Bush Street, Suite 601, San Francisco, CA 94108

Dated: 1/17/02

Charles Manero



UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

REGISTRATION NO. 1284179

SERIAL NO. 73/433988

PAPER NO.

MAILING DATE: 06/11/90

MARK: LABCAT

REGISTRANT: Innovative Programming Associates, Inc.

CORRESPONDENCE ADDRESS:

CHRISTOPHER A. SIDOTI
ROBERT G. SHEPHERD
MATHEWS, WOODBRIDGE & COLLINS
100 THANET, SUITE 306
PRINCETON, NJ 08540-3662

Please furnish the following
in all correspondence:

1. Your phone number and zip code.
2. Mailing date of this action.
3. Affidavit-Renewal Examiner's name.
4. The address of all correspondence not containing fees should include the words "Box 5".
5. Registration No.

RECEIPT IS ACKNOWLEDGED OF THE SUBMITTED REQUEST UNDER:

SECTION 8 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.161-2.166.

SECTION 15 OF THE TRADEMARK STATUTE AND 37 CFR SECS. 2.167-2.168.

YOUR REQUEST FULFILLS THE STATUTORY REQUIREMENTS AND HAS BEEN ACCEPTED.

PATRICIA ANN EVERETT
AFFIDAVIT-RENEWAL EXAMINER
TRADEMARK EXAMINING OPERATION
(703) 557-1988

Exhibit "A"

MATHEWS, WOODBRIDGE & COLLINS, P.A.

ATTORNEYS AT LAW

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March 6, 1990

PATENT AGENT
JEREMIAH G. MURRAY

TELECOPIER: (609) 924-3036
TELEX: 291601

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Exhibit "B"

RE: Section 8 & 15 Affidavit for the
mark, "LABCAT" in Class 9
Our File No. IPA-001

Sir:

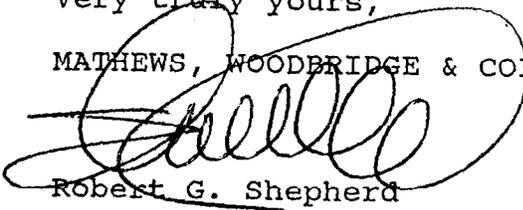
Enclosed please find the following:

1. Combined Declaration under Section 8 & 15 relative to the above-captioned trademark.
2. Power of Attorney, executed by Morton S. Cohen, C.E.O., Innovative Programming Associates, Inc.
3. Three (3) specimens of labels showing the current use of the mark "LABCAT".
4. Our check in the amount of \$200.00 to cover the Section 8 & 15 filing fees; and,
5. A stamped, self-addressed acknowledgement post card.

Please process the enclosed document and return the acknowledgement post card at your earliest convenience. Should there be any questions at all regarding this affidavit, please do not hesitate to contact us by telephone.

Very truly yours,

MATHEWS, WOODBRIDGE & COLLINS


Robert G. Shepherd

Honorable Commissioner

-2-

March 6, 1990

RGS:emc

Encs.

1. Combined Section 8 & 15.
2. Three specimens of labels.
3. Our check for \$200.00.
4. Stamped self-addressed post card.

IPA-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Innovative Programming Associates, Inc.
Mark: LABCAT
Serial No.: 433,988
Filed: July 11, 1983
Registration No.: 1,284,179
Class: Int. Class 9

TO THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS

COMBINED DECLARATION UNDER SECTION 8 AND 15

Morton S. Cohen, C.E.O., declares that:

Innovative Programming Associates, Inc., a corporation of the State of New Jersey, having its business address at 303 Wall Street, Princeton, New Jersey 08540, owns Registration No. 1,284,179 issued on July 3, 1984, as shown in the records of the U.S. Patent Office.

That the Trademark shown therein is still in use as evidenced by the attached specimens showing the mark as currently used.

That the service mark shown therein has been in continuous use in interstate commerce for five consecutive years from July 3, 1984 to the present for Computer Programs Recorded on Magnetic Discs in Class 9.

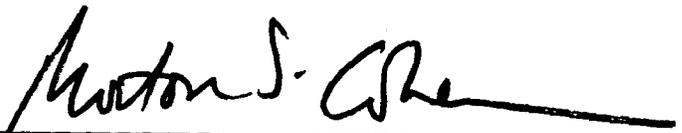
That said Trademark is still in use in interstate commerce; that there has been no final decision adverse to Registrant's claim of ownership of said mark, to the right to register the same or maintain it on the register, and that there is no proceeding involving any of the said rights pending and not disposed of either in the Patent Office or in the Courts.

That the fee for filing the Declaration of Use is attached.

That all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of this Document or the registration to which it is directed.

Applicant hereby appoints Christopher A. Sidoti, Esq., and Robert G. Shepherd, Esq., of the firm of MATHEWS, WOODBRIDGE & COLLINS, P.A., 100 Thanet Circle, Suite 306, Princeton, New Jersey, 08540-3662, (609) 924-3773, to prosecute this Declaration of Use, to transact all business in the Patent Office in connection therewith, and to receive the Certificate.

INNOVATIVE PROGRAMMING ASSOCIATES, INC.


Morton S. Cohen, C.E.O.

Dated: Feb. 28, 1990

- Encs. 1. Specimens: 3 each labels used on magnetic discs.
2. Our Check for \$200.00 (Filing Fee - 1 Class)
3. Acknowledgement Post Card

TTAB



01-22-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

WOODBIDGE & ASSOCIATES, P. C.

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January 17, 2002

VIA FIRST CLASS MAIL

Attn: Commissioner of Trademarks
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Innovative Programming Associates, Inc. v. Varian, Inc.
Opposition No. 91150161

Dear Madam/Sir:

Enclosed for filing is Opposer's Opposition to Applicant's Motion to Strike Opposer's Affirmative Defenses regarding the above-referenced matter. Also, enclosed is an Acknowledgement Postcard. Upon receipt of our Motion, please forward back to us the Acknowledgement Postcard.

Thank you for your courtesy in this matter.

Respectfully Submitted,

Charles Manero
Charles Manero, Esq.

CM:bs
Enclosures
Cc: Roy S. Gordet, Esq. (w/encls)