

Wolfson

THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 16, 2008

Opposition No. 91180462

CALIFORNIA CLOSET COMPANY,
INC.

v.

CHARLES KENWORTHY AND TERRI
KENWORTHY

Before Hairston, Kuhlke and Ritchie de Larena,
Administrative Trademark Judges.

By the Board:

On October 31, 2007, opposer filed an opposition against the marks the WELL-ORGANIZED LIFE and LIFE SIMPLY ORGANIZED for a "kit comprising paper containers and file folders for arranging, compiling and storing important personal documents," alleging prior use and ownership of registrations for the marks WHEN YOU ORGANIZE YOUR HOME YOU SIMPLIFY YOUR LIFE,¹ SIMPLIFY YOUR LIFE² and SIMPLIFYING

¹ Registration No. 3168301 for the mark WHEN YOU ORGANIZE YOUR HOME YOU SIMPLIFY YOUR LIFE for "Custom construction and installation of closets, utility and pantry shelving, garage interiors, cabinets, media units, and shelving, home offices, wall systems, and storage space systems; Design services in the field of customized closets, utility and pantry shelving, garage interiors, cabinets, media units and shelving, home offices, wall systems, and storage space; space management design," registered November 7, 2006.

² Registration No. 1915339 for the mark SIMPLIFY YOUR LIFE for "custom construction and installation of closets and storage space facilities; design services in the field of customized

HOME AND LIFE³ for services related to the design and construction of customized closets and storage space.

Opposer alleges that registration of applicants' mark will cause a likelihood of confusion among relevant purchasers.

Applicants filed an answer to the notice of opposition, denying the salient allegations contained in the complaint and asserting the following affirmative defenses: that the opposition fails to state a claim upon which relief can be granted, that the opposition is barred by the doctrines of laches, acquiescence, estoppel, fraud, mistake, prior judgment or the doctrine of unclean hands, and that opposer's marks are not inherently distinctive, have not acquired secondary meaning and are generic.

Applicants' answer included counterclaims to cancel each of opposer's pleaded registrations. In the counterclaims, applicants assert that opposer has abandoned its marks; that the marks have become generic or are merely descriptive; that the marks are *void ab initio* because opposer "made no bona fide use of the Marks in commerce

closets and storage space and retail store services in the field of closet, storage space, household and travel accessories," registered August 29, 1995, renewed October 24, 2005.

³ Registration No. 2853226 for the mark SIMPLIFYING HOME AND LIFE for "franchising services, namely, rendering technical assistance in the establishment and operation of businesses directed to the custom design, construction, repair and installation of closets and storage spaces; custom construction and installation of closets and storage space facilities; and design services in the field of customized closets and storage space," registered June 5, 2004.

prior to filing their use-based applications;" and that opposer "committed fraud upon the Trademark Office and/or has unclean hands."

In lieu of filing an answer to the counterclaims, opposer filed a motion to dismiss them. Opposer asserts three possible grounds for dismissal. First, opposer argues that fraud has not been pleaded with specificity. Second, opposer argues that "unclean hands" is not legally cognizable as a basis for cancellation. Third, opposer asserts that the claims that the mark of Registration No. 1915339 is merely descriptive or *void ab initio* are barred by Section 14(3) of the Trademark Act, inasmuch as the registration is more than five years old.

In response to opposer's motion, applicants filed a motion for leave to file an amended answer, including amended counterclaims, together with a copy of its proposed amended answer and counterclaims.⁴ By their amended answer, applicants address the deficiencies noted in the motion to dismiss. The fraud claim is pleaded with sufficient particularity, and the amended counterclaims make it clear that applicants do not allege that the mark of Registration No. 1915339 is merely descriptive or *void ab initio*. The reference to "unclean hands" has been removed from the

⁴ Opposer filed a combined response to applicant's motion to amend and a reply brief in support of its motion to dismiss.

counterclaims, although applicants continue to rely upon the doctrine as an affirmative defense. A party may allege unclean hands as an affirmative defense in a Board proceeding. *Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, 1157 (TTAB 2003).

Accordingly, applicants' amended answer and counterclaims are accepted. We therefore consider opposer's motion to dismiss in the context of the amended counterclaims. Inasmuch as the amended counterclaims address the deficiencies noted in the motion to dismiss, the motion to dismiss is denied.

Opposer is allowed until THIRTY DAYS from the mailing date of this order to file an answer to applicants' amended counterclaims. Trial dates, including the close of discovery, are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	January 20, 2009
30-day testimony period for party in position of plaintiff to close:	April 20, 2009
30-day testimony period for party in position of defendant to close:	June 19, 2009
15-day rebuttal testimony period for plaintiff to close:	August 3, 2009

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after

completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>