TTAB

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

Butler

Mailed: March 13, 2009

Opposition No. 91186018

IN-N-OUT BURGERS 76/687,302

v.

BRIAN QUAGLIA

Before Walters, Zervas and Mermelstein, Administrative Trademark Judges.

By the Board:

Applicant seeks to register the mark IN & OUT for a "game, namely a dice game."[1] As grounds for the opposition, opposer alleges that applicant's mark, when used on the identified goods, so resembles opposer's previously used and registered marks IN-N-OUT and IN-N-OUT BURGERS for, *inter alia*, restaurant services, retail and mail order merchandising services, clothing items, and novelty items as to be likely to cause confusion, mistake or to deceive.[2] In addition, opposer alleges prior use of the mark IN-N-OUT OPOLY for "a game, namely a board game including dice."[3] Opposer also asserts a dilution claim.

In his answer, applicant denies the essential allegations of the notice of opposition and asserts affirmative defenses.

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[1] Application Serial No. 76687302, filed on March 3, 2008
[2] Opposer specifically pleads ownership of nine U.S. registrations.
[3] *See* paragraph No. 2 of the notice of opposition.

04-13-2009

U.S. Patent & TMOfc/TM Mail Rcpt Dt #32

This case now comes up on the following motions and matters:

1) opposer's response, filed September 26, 2008, to applicant's affirmative defense "that opposer has failed to state a claim upon which relief can be granted," which opposer characterizes as a motion to dismiss;[4]
2) opposer's motion to strike, also filed September 26, 2008, applicant's affirmative defenses at paragraph Nos. 16 and 20-23 of applicant's answer;[5] and
3) the sufficiency of opposer's dilution claim.

Applicant has not filed a reply with respect to opposer's treatment of the affirmative defense at paragraph No. 17 of the answer as a motion to dismiss. Applicant has not filed a response to opposer's motion to strike the other affirmative defenses.

Applicant's "motion to dismiss"

Applicant simply affirmatively asserts "that opposer has failed to state a claim upon which relief may be granted."

Opposer filed a response arguing that the language "could be construed" as a motion to dismiss and failure to file a response "could be construed as acquiescence." Opposer also argues that the Board has a duty to examine the notice of opposition in its entirety to determine whether it contains any allegations which if proved would entitle opposer to the relief it seeks.

With respect to applicant's first affirmative defense, the Board stated in *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973):

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[4] *See* paragraph No. 17 of the answer.
[5] The affirmative defenses asserted at these paragraphs are discussed in more detail later in this order.

> While Rule 12(b)(6) permits a defendant to assert in his answer the "defense" of failure to state a claim upon which relief can be granted, it necessarily follows that the plaintiff may utilize this assertion to test the sufficiency of the plaintiff's pleading in advance of trial by moving under Rule 12(f) of the Federal Rules of Civil Procedure to strike the "defense" from the defendant's answer.

See also Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1222 (TTAB 1995). Thus, the striking of the defense that a complaint fails to state a claim upon which relief could be granted may be appropriate when the legal sufficiency of the plaintiff's pleading is readily apparent. *See* Wright & Miller, 5C Fed. Prac. & Pro. Civ.3d §1381 (2004).

In order to state a claim upon which relief can be granted, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the registration sought. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998), and cases cited therein.

After a review of the notice of opposition, the Board finds that opposer has adequately pleaded facts which, if proven at trial, would establish its standing. Specifically, opposer has adequately pleaded ownership of its registrations. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 (CCPA 1982); Section 13 of the Trademark Act; and TBMP §303.03 (2d ed. rev. 2004). Opposer has also adequately pleaded at least one

available ground for opposing registration of applicant's mark, namely, priority of use of its marks and likelihood of confusion.[6] *See* Trademark Act §2(d).

Inasmuch as the allegations in the notice of opposition are sufficient to state a claim upon which relief can be granted, to the extent applicant's affirmative defense at paragraph No. 17 may be construed as a motion to dismiss, the motion is denied and paragraph No 17 of applicant's answer is hereby stricken.

Opposer's motion to strike other "affirmative defenses"

Opposer seeks to strike the following averments in applicant's answer:

16. If the registration of applicant is not granted, applicant will suffer immediate harm from having to withdraw its existing inventories of dice games from the market.
20. In any event, opposer, before or as of the date of applicant's filing had not filed a trademark application to protect any trademark within international class 028 nor is it clear to applicant that opposer ever intended to do so.
21. As stated in the Notice opposer's marks are registered in classes other than applicant's mark and therefore there cannot be any confusion with applicant's mark.
22. In and for a first separate and special defense, applicant alleges that at the time applicant adopted its trademark, a search was made in the United States Patent and Trademark Office and the search disclosed, as of the date of adoption of the mark "IN N OUT" by applicant, that there was no existing United States federal registration for a dice game including "IN N OUT."
23. Applicant also alleges that at the time applicant adopted its mark, a diligent search was made by the United States Patent and Trademark Office and the search disclosed that there was no existing United States federal registration for a dice game including "IN N OUT" in international class 028.

[6] The insufficiency of opposer's dilution claim is discussed later in this order.

In support of its motion, opposer argues that the defense at paragraph No. 16 should be stricken as being impertinent and immaterial matter which has no bearing on this case; the defenses at paragraph Nos. 20 and 21 should be stricken because the numerical classification has no bearing on the issue of registrability; the defense at paragraph No. 22 should be stricken because a defense of estoppel on the basis that opposer has not sought to register its mark for "dice games" does not exist; and the defense at paragraph No. 23 should be stricken as irrelevant.

Although applicant has not filed a response, the motion will not be granted as conceded. Instead, the Board will consider the motion on its merits.

The Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See* Fed. R. Civ. P. 12(f). Motions to strike, however, are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues of the case. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); and Wright & Miller, 5C Fed. Prac. & Pro. Civ.3d §1381 (2008). Since the primary purpose of pleadings is to give fair notice of the claims or defenses asserted, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but

rather will provide a fuller notice of the basis for a claim or defense.

In this case, the averment of damage at paragraph No. 16 causes no prejudice to opposer. The averments at paragraph Nos. 20-23 amplify applicant's denials of opposer's claims and further provide opposer with some aspects of how applicant intends to defend himself. In addition, the averments at paragraph Nos. 22-23 are relevant to a likelihood of confusion claim at least with respect to applicant's intent in the adoption of his mark.

In view thereof, opposer's motion to strike paragraph Nos. 16 and 20-23 of applicant's answer is denied.

Opposer's dilution claim is deficient

As requested by opposer, the Board has reviewed the notice of opposition in its entirety. We find opposer's claim of dilution to be deficient because opposer does not plead when its mark became famous, which must be at least before the filing date of applicant's application. *See Toro Co. v. ToroHead, Inc.*, 61 USPQ22 1164 (TTAB 2001); and *Polaris Industries Inc. v. DC Comics,* 59 USPQ2d 1798 (TTAB 2000).

In view thereof, opposer's dilution claim is stricken and no further consideration is given thereto.

Opposer is reminded that "[f]ame for dilution purposes is difficult to prove. … The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *Toro, supra*. In other words, the requirement for proving "fame"

for dilution purposes under Trademark Act § 43(c) is considerably more stringent than the proof of "fame" in a likelihood of confusion analysis.[7]

Reset Schedule

Operative dates are reset as follows:

Deadline for Discovery Conference	**4/11/2009**
Discovery Opens	**4/11/2009**
Initial Disclosures Due	**5/11/2009**
Expert Disclosures Due	**9/8/2009**
Discovery Closes	**10/8/2009**
Plaintiff's Pretrial Disclosures	**11/22/2009**
Plaintiff's 30-day Trial Period Ends	**1/6/2010**
Defendant's Pretrial Disclosures	**1/21/2010**
Defendant's 30-day Trial Period Ends	**3/7/2010**
Plaintiff's Rebuttal Disclosures	**3/22/2010**
Plaintiff's 15-day Rebuttal Period Ends	**4/21/2010**

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

[7] The Board notes in passing that, less than one year ago, the Board found opposer's evidence of fame insufficient. *See In-N-Out Burgers v. Peak Harvest Foods LLC*, Opposition No. 91161044 (TTAB September 29, 2008).

Information about Board proceedings

The Board notes that applicant is representing himself and provides the following information about Board proceedings.

NATURE OF BOARD PROCEEDINGS

Applicant is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

REQUIREMENT FOR SERVICE OF PAPERS

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such

service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding, including applicant's answer to the notice of opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

> The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. *See also* TBMP §113 (2d ed. rev. 2004).

OPTION OF E-MAIL SERVICE

The parties may agree to the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic

transmission when mutually agreed upon by the parties.").[8] Should the parties decide to continue using traditional service options, the parties may consider agreeing at least to courtesy email notification when any paper is served.

THE BOARD'S STANDARDIZED PROTECTIVE ORDER IS IN PLACE

The Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties may substitute a stipulated protective agreement (signed by both parties). However, the Board will not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order.

REPRESENTATION

Applicant may represent himself. However, it should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board

[8] The additional five days available under Trademark Rule 2.119(c) for traditional service modes (*e.g.*, First Class Mail) is not available for email service.

may not provide legal advice, though may provide information as to procedure.

ELECTRONIC RESOURCES

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, *www.uspto.gov*. The TTAB homepage provides electronic access to the Board's standardized protective order, a chart of the new rules and the text of the new rules (effective August 31, 2007 and November 1, 2007), and answers to frequently asked questions. Other useful databases include the ESTTA filing system[9] for Board filings and TTABVUE for status and prosecution history.

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[9] Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received.

A party may also use first class mail. Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

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P.O. Box 1451
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The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.
The certificate of mailing must be signed and dated.

The Board's records are public records. Thus, applicant may use the TTABVUE database to view other cases to get an idea of the course of Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

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