Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA239338**

Filing date: **09/26/2008**

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

Proceeding	91186018
Party	Plaintiff In-N-Out Burgers
Correspondence Address	Edward O. Ansell Law Office of Edward O. Ansell 427 N. Yale Avenue, Suite 204 Claremont, CA 91711 UNITED STATES anselaw@verizon.net
Submission	Other Motions/Papers
Filer's Name	Edward O. Ansell
Filer's e-mail	anselaw@verizon.net
Signature	/Edward O. Ansell/
Date	09/26/2008
Attachments	Quagliagame.strikemotion.pdf (5 pages)(185879 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF APPLICATION SERIAL NO. 76/687,302
FOR THE MARK "IN & OUT"
PUBLISHED IN THE OFFICIAL GAZETTE OF July 22, 2008

In-N-Out Burgers Opposer	)	
v.	)	OPPOSITION NO. 91186018
Brian Quaglia Applicant	)	

PETITIONER'S OPPOSITION TO RESPONDENT/APPLICANT'S MOTION TO DISMISS FILED WITH ITS ANSWER AND MOTION TO STRIKE CERTAIN OF RESPONDENT/APPLICANT'S AFFIRMATIVE DEFENSES

To the TTAB:

The undersigned Petitioner/Opposer hereby moves the TTAB for an order striking Respondent/Applicant's Motion to Dismiss for failure to state a claim upon which relief can be granted, filed as part of its Answer, together with an order striking certain of Applicant's affirmative defenses filed together with its Answer filed with the Board on September 19, 2008. Petitioner supports these motions with the herein memorandum

Respectfully submitted,

Edward O. Ansell
Attorney for Petitioner/Opposer

MEMORANDUM

Motion In Opposition To Motion To Dismiss

In affirmative defense No. 17, "Applicant asserts that Opposer has failed to state a claim upon which relief can be granted." In his prayer, following paragraph 23, Applicant states:

> "WHEREFORE, it is respectfully requested that the opposition be dismissed and that this application proceed to registration."

The quoted language could be construed as a Motion to Dismiss for Failure to State a Claim pursuant to Rule 12 (b)(6) of the Federal Rules of Civil Procedure (F.R.C.P.). Because failure to respond in a timely manner could be construed as acquiescence, Opposer finds it necessary to file the instant response.

A Motion to Dismiss for Failure to State a Claim should not be granted unless it is certain beyond any doubt that the respondent to the Motion cannot, under any circumstances, prevail under the present allegation. See *Cardinal Engineering Corp. v. Champion Mfg. Co.* 133 U.S.P.Q. 197 (CCPA 1962); See also TBMP §503,

To survive such a Motion Opposer need only to have alleged such facts as would, if proven, show it has standing and a statutory ground preventing registration exists. See *Western Worldwide Enterprises Group, Inc. v. Qinqdao Brewery* 17 U.S.P.Q.2d 1137 (TTAB 1990); *Order of Sons of Italy in America v. Profumi Fratelli Nostra, A.G.* 36 U.S.P.Q.2d 1221 (TTAB 1995).

Whenever the sufficiency of any Notice of Opposition has been challenged by a Motion to Dismiss, it is the duty of the Board to examine the Notice of Opposition in its entirety, construing the allegations therein liberally, as required by F.R.C.P. 8(e) to determine whether it contains **any** allegations which if proved, would entitle Opposer to the relief it seeks. See

Cineplex Odeon Corp v. Fred Wehrenberg Circuit of Theatres 56 U.S.P.Q.2d 1538 (TTAB 2000); see also TBMP § 503.02.

Motion To Strike Certain Affirmative Defenses

Applicant/Respondent's Answer asserted the following Affirmative Defenses which Opposer moves the Board to strike:

> "16. If the registration of applicant is not granted, applicant will suffer great 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 trademark "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 trademark, 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."

Upon Motion, the Board may order stricken from a pleading any insufficient defense or any redundant matter. See TMBP §506.01. The Board grants motions to strike in appropriate cases. See for example *Textron, Inc. v. Gillette Co.* 180 USPQ 152 (TTAB 1973), wherein allegations in the Answer merely reiterating the denial of likelihood of confusion without adding anything of substance were stricken as redundant. None of the pleaded Affirmative Defenses specifically listed by Opposer are among those listed in FRCP 8(c), and they do not flow logically from Opposer's Notice of Opposition.

Applicant's Affirmative defense pleaded in Paragraph 16, of "great immediate harm" if the registration of Applicant is not granted, should be stricken as being impertinent and immaterial matter having no bearing on this case. Irreparable harm or damage are not equitable defenses in TTAB *inter partes* proceedings, and the TTAB lacks jurisdiction to grant either injunctive relief or monetary damages. The only ultimate issue before the TTAB is the entitlement of Applicant to the registration sought. See 15 U.S.C. 1067; also see TBMP § 102.

The Affirmative defense pleaded in Applicant's Paragraphs 20 and 21 should be stricken as the numerical classification of marks clearly has no bearing on the issue of registerability. See *Jean Patou Inc. v. Theon Inc.* 29 U.S.P.Q.2d 1771 (CAFC 1993). Section 1050(d) of the Lanham Act makes no reference to classification. The system of dividing goods and services into classes is purely a matter of convenience. See *INB National Bank v. Metrohost, Inc.* 22 U.S.P.Q. 2d 1585 (TTAB 1992).

The "first separate and special" defense pleaded in Paragraph 22 should be stricken because no defense of estoppel against an Opposer exists merely because Opposer never sought federal registration of its mark. Federal registration is permissive, not mandatory. Opposer has no duty to register its mark. Failure to register is no bar to Opposer objecting to someone else's

registration of the mark. See *General Motors Corp. v. Pacific Tire & Rubber Co.* 132 U.S.P.Q. 562 (TTAB 1962).

Applicant's Affirmative defense pleaded in Paragraph 23 should be stricken as irrelevant, having no bearing on the issues in this case. *Inter partes* cases are heard in the first instance by the TTAB sitting as a fact-finding decision maker. The TTAB reviews with a clear slate and is not bound or restricted in any sense by the actions of an Examining Attorney. See *McDonald's Corp. v. McLain,* 37 U.S.P.Q.2d 1274 (TTAB 1995).

NOW THEREFORE, Petitioner/Opposer hereby moves the TTAB for an order dismissing Applicant's Motion to Dismiss and striking the cited Affirmative Defenses contained in Applicant/Respondent's Answer, served September 11, 2008.

Respectfully submitted

/Edward O. Ansell/

Edward O. Ansell
Attorney for Petitioner/Opposer
In-N-Out Burgers

Date: September 26, 2008

427 N. Yale Avenue
Suite 204
Claremont, CA 91711
Tel: (909) 621-1985
Fax: (909) 624-1664
Email: anselaw@verizon.net

PROOF OF SERVICE: I hereby certify that on September 26, 2008, a copy of the foregoing document was deposited with the U.S. Postal Service, first class mail postage prepaid, to the Applicant, Brian Quaglia, 151 Airport Rd., Warwick, RI 02886.

/Edward O. Ansell/
Edward O. Ansell