

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

Mailed: July 23, 2010

Opposition No. 91194973

Navigon AG

v.

Daymen Photo Marketing LP

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on opposer's motion (filed July 14, 2010) to strike paragraphs 2 and 3 of applicant's affirmative defenses. On July 21, 2010, at approximately 3:00 p.m. Eastern time, the Board exercised its discretion to conduct a telephone conference to determine the outstanding motion. Participating in the conference were Gregory P. Goonan, counsel for applicant; Janet F. Satterthwaite, counsel for opposer; and the above-signed Board attorney responsible for resolving interlocutory matters in this case.

During the conference, the Board considered applicant's oral brief in opposition, opposer's oral brief in reply, as well as the supporting motion and record of this case. The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the motion, briefs, or during the

telephone conference. Instead, this order summarizes the comments and decisions of the Board.

Motion to Strike

Motions to strike 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). 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.

With regard to affirmative defense No. 2, the Board noted that this paragraph was not construed as a motion to dismiss under Fed. R. Civ. P. 12(b)(6). No motion to dismiss was filed by applicant, and applicant did not brief this defense as such. The Board noted that inasmuch as standing and a valid ground for opposing registration of the involved mark must be proved at trial by opposer, opposer will not be prejudiced by the inclusion of this defense in the answer. Accordingly, the motion to strike was denied as to affirmative defense No. 2.

With regard to affirmative defense No. 3, the Board noted that this paragraph is an allegation by applicant that opposer did not have a bona fide intent to use the mark in

the pleaded registrations in commerce as of the filing date of the underlying applications. Such an assertion is an impermissible collateral attack on the validity of pleaded Registration Nos. 3286593 and 3712226, which will not be heard in the absence of a counterclaim. See Trademark Rule 2.106(b)(2)(ii), and TBMP §§ 311.02(b) and 313.01 (2d ed. rev. 2004). Accordingly, the motion to strike was granted as to affirmative defense No. 3.

Motion to Amend Answer

Applicant's arguments with regard to affirmative defense No. 3 were construed by the Board as a motion to amend the answer to properly assert as a counterclaim against Registration Nos. 3286593 and 3712226 that opposer did not have a bona fide intent to use the mark in the pleaded registrations in commerce as of the filing date of the underlying applications. Applicant confirmed its intent to make such a motion. Opposer consented to, and the Board granted, the oral motion for leave to amend. Accordingly, applicant was allowed twenty days from the date of the conference in which to file an amended answer with counterclaims, failing which the current answer, as stricken, will serve as applicant's operative pleading.

Appearance of Associate Counsel

The Board noted the appearance of associate counsel filed July 20, 2010; however, the Board also noted that (1)

the filing fails to include proof of service as required by Trademark Rule 2.119(a) and TBMP § 113.02 (2d ed. rev. 2004), and (2) the Board will not correspond with more than one representative of applicant. See Trademark Rule 2.18(a)(7) and TBMP § 117.02. Applicant offered to re-file the appearance with a proper proof of service, but inasmuch as opposer had been made aware of the filing (in a procedural email from applicant relating to the conference and also during the conference when the Board addressed the issue), the Board indicated that no corrected filing was necessary.

Settlement and Discovery Conference

The parties indicated their intent, pursuant to Trademark Rule 2.120(a)(2), to stay on the line after the Board hung up to conduct the mandatory settlement and discovery conference for the involved application Serial No. 77842702.

Schedule

Dates were reset on the following schedule.¹

Amended Answer and Counterclaim Due	8/10/2010
Deadline for Discovery Conference	9/9/2010
Discovery Opens	9/9/2010

¹ Opposer inquired as to the scheduling effect of the motion to amend. The Board noted that the new schedule, based on the Board's standard schedule form, would include a new deadline for the discovery conference; and, if applicant files a counterclaim, a second amended schedule will necessarily be issued allowing opposer time in which to answer the counterclaim and in which a new deadline for an additional discovery conference (to include issues newly raised by the counterclaim) will be set.

Initial Disclosures Due	10/9/2010
Expert Disclosures Due	2/6/2011
Discovery Closes	3/8/2011
Plaintiff's Pretrial Disclosures	4/22/2011
Plaintiff's 30-day Trial Period Ends	6/6/2011
Defendant's Pretrial Disclosures	6/21/2011
Defendant's 30-day Trial Period Ends	8/5/2011
Plaintiff's Rebuttal Disclosures	8/20/2011
Plaintiff's 15-day Rebuttal Period Ends	9/19/2011

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.