Goodman

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

Mailed: September 21, 2011

Opposition No. **91195262**
Cancellation No**. 92053083**

Sensible Foods LLC

v.

World Gourmet Marketing LLC
and Hain Gourmet, Inc.[1]

By the Board:

This case now comes up on opposer/petitioner's, Sensible Foods LLC's (hereinafter Sensible Foods) motion, filed January 21, 2011, to strike certain of applicant/respondent's, World Gourmet Marketing LLC's and Hain Gourmet Inc.'s (hereinafter Hain Gourmet) affirmative defenses.

Sensible Foods seeks to strike Hain Gourmet's affirmative defenses one through eight.

Hain Gourmet argues that the motion to strike is untimely filed as it was not filed by Sensible Foods within

[1] Hain Gourmet is joined as a party defendant in view of the assignment recorded at Reel/Frame 4290/0117 of the Office's Assignment Branch. See TBMP Section 512.01 (3d ed. 2011) (when assignment is recorded in the Assignment Services Division of the USPTO, the assignee will be joined rather than substituted to facilitate discovery unless the assignment occurred prior to the commencement of the proceeding, the assignor is no longer in existence, or the plaintiff raises no objection to substitution, or the discovery and testimony periods have closed).

21 days after being served with Hain Gourmet's answer as required by Fed. R. Civ. P. 12(f), and therefore should be denied.

However, the Board, in its discretion, may consider untimely motions to strike and grant them if doing so seems proper. 5C C. Wright, A. Miller & E. Cooper, Federal Practice and Procedure Civil 3d § 1380 (2009). "[T]he time limitations set out in Rule 12(f) should not be applied strictly when the motion to strike seems to have merit." *Id*. Accordingly, although Sensible Foods' motion to strike is untimely under Fed. R. 12(f), the Board, in its discretion, shall consider the motion.

In considering the motion, the Board will not recount the parties' arguments, but will presume their familiarity therewith.[2] Additionally, for the sake of completeness, the Board will consider the sufficiency of affirmative defenses nos. 9 and 10.

Under Fed. R. Civ. P. 12(f), the Board may strike from a pleading "any insufficient defense or any redundant, immaterial, impertinent or scandalous matter."

First Affirmative Defense – Failure to State a Claim

We turn to Hain Gourmet's first affirmative defense, failure to state a claim upon which relief can be granted.

[2] Arguments by the parties relating to the merits of the defense rather than the sufficiency of the defense are premature and have not been considered.

A plaintiff may use a motion to strike this defense to test the sufficiency of the complaint in advance of trial. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36, USPQ2d 1221, 1222 (TTAB 1995). If the pleading is legally sufficient in stating a claim, the Board will strike this defense. *S. C. Johnson & Son, Inc. v. GAF Corporation*, 177 U.S.P.Q. 720 (TTAB 1973).

The claims asserted by Sensible Foods in the combined notice of opposition and petition to cancel are

- Priority and likelihood of Confusion - Section 2(d)
- False suggestion of a connection - Section 2(a)
- Examining Attorney Should Have Rejected Registration
- Nonuse with all of the goods listed in the registration as of the claimed date of first use

Standing

Sensible Foods has sufficiently alleged a real interest in this proceeding by its allegations of ownership of multiple registrations.

Count I Likelihood of Confusion
Count II False Suggestion of a Connection

With respect to the claim of priority of use and likelihood of confusion, and the claim of false suggestion of a connection, the Board finds that the combined notice of opposition and petition to cancel allege sufficient

facts which, if proved, would entitle Sensible Foods to the relief it seeks.

Count III Examining Attorney Should Have Rejected Registration

Sensible Foods allegations include the assertion that "the examining attorney should have rejected Application No. 77/596,051 that gave rise to Registration No. 3,195,083 for the same reasons and under the same authorities cited in the September 21, 2007 Office Action to deny registration of Applicant's Application No. 77/210120."

Sensible Foods is attempting to base its claim on an examination error, i.e., the failure of the examining attorney to assert Registration Nos. 3024683 and 2861273 against application Serial No. 78596051 which matured into involved Registration No. 3195083. However, such a claim is an ex parte examination issue and not a ground for cancellation. *Cf. Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (failure of examining attorney to enforce requirement that applicant submit a copy of the foreign registration upon which its U.S. application is based is an examination error, not a ground for opposition). Therefore, this claim is insufficient on its face.

Count IV - Nonuse with all of the goods as of claimed date of first use

The grounds in Count IV are unclear. Sensible Foods has made one allegation relating to the involved application Serial No. 77833401, namely, that the "Date of First Use of July 1, 2003" "is prior to March 28, 2005, the date Respondent provided in its Application No. 78/596,051 . . . ." However, this allegation alone is insufficient to assert a claim with regard to involved application Serial No. 77833401.[3]

The remainder of the allegations relate to Hain Gourmet's intent to use application Serial No. 78596051 which matured into Registration No. 3195083, the subject of the petition to cancel.[4] These allegations assert that Hain Gourmet had not used the mark in connection with the goods "anywhere and/or in U.S. interstate commerce as of either the filing date [of the intent to use application], March 23, 2005, or the subsequently provided date of first use, July 7, 2003."

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[3] It is noted that the combined notice of opposition and petition to cancel identifies application Serial Nos. 77833386 and 77833401 as subject to opposition. However, the ESTTA cover sheet dated June 12, 2010, shows that Sensible Foods identified only 77833401 as subject to opposition. Current office records show that although an extension of time to oppose was filed against application Serial No. 77833386; however, no opposition was filed against this application. Application Serial No. 77833386 proceeded to issuance of notice of allowance, and presently, a second extension has been granted for filing the statement of use.

[4] There is a typographical error with respect to Hain Gourmet's involved registration number in Count IV of the combined pleading.

Hain Gourmet's application Serial No. 78596051 was an intent to use application so there was no requirement that the mark be in use in commerce either prior to or on the filing date.[5] *Consolidated Cigar Corp. v. Rodriguez*, 65 USPQ2d 1153, 1155 (TTAB 2002) ("the applicant need not make actual use prior to the issuance of the registration, in an intent-to-use based application, the applicant need not make use until it files its statement of use, which is required for the registration to issue"). With regard to a use based application, a misstatement of a date of first use in commerce is not fraudulent nor is it otherwise fatal to the securing of a valid registration provided that there has been use of the mark in commerce prior to the filing date of the registrant's application. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986). Similarly, a misstatement of a date of first use or a date of first use in commerce in a statement of use is not fatal to securing a valid registration as long as the mark was in use on the date the statement of use was filed.

[5] The constructive use date for Hain Gourmet's application is the March 23, 2005 filing date. It is also unclear from the wording of the allegations whether Sensible Foods' claim of nonuse is based on nonuse of some, rather than all, of the goods identified in the registration. In this regard, absent a claim of fraud, nonuse of the mark on some of the goods does not result in a void application. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696 (TTAB 2006).

Accordingly, the Board finds that Count IV is insufficient.

Inasmuch as Sensible Foods' first affirmative defense is valid with respect to Count III and Count IV of the combined notice of opposition and petition to cancel, Sensible Foods' motion to strike Hain Gourmet's first affirmative defense is denied.

Second Affirmative Defenses: Laches, Waiver and Estoppel
Third Affirmative Defense, Unclean Hands
Fourth Affirmative Defense: Accord and Satisfaction

The Board turns to the second, third and fourth affirmative defenses. An affirmative defense must be pleaded with minimal specificity so as to give fair notice to plaintiff of the defense. *Advanced Cardiovascular Systems Inc. v. Medtronic Inc.*, 41 USPQ2d 1770 (N.D. Cal. 1996). Defenses that are conclusory or include no specific allegations, are insufficient to state a defense and may be stricken. *See e.g.*, *Heller Fin., Inc. v. Midwhey Powder Co., Inc.*, 883 F.2d at 1294, 1295 (7th Cir. 1989) (striking conclusory defenses); *Telectronics Proprietary Ltd. v. Medtronic Inc.*, 7 USPQ2d 1777, 1784 (S.D.N.Y 1988) ("the word 'estoppel' without more is not a sufficient statement of a defense."); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.* 5 USPQ2d 1067, 1069 (TTAB 1987) (conclusory, unclear, non-specific allegations are insufficient to state a defense of unclean hands).

The Board finds that these defenses are insufficient inasmuch as they are vague, conclusory and lack specificity.

Accordingly, Sensible Foods' motion is granted and Hain Gourmet's second, third and fourth affirmative defenses are hereby stricken, with leave to amend with requisite particularity, if appropriate.

Fifth Affirmative Defense – Prior Use[6]

To the extent that Hain Gourmet is asserting this defense in the opposition, such a defense is an improper collateral attack on Sensible Foods' pleaded registrations in the absence of a counterclaim. *SCOA Industries Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411 (TTAB 1975).

On the other hand, in the cancellation proceeding, such a defense may be asserted, as priority of use (not priority or registration) must be established by petitioner when both parties own registrations.[7] *SCOA Industries Inc.* 188 USPQ at 411.

Because it is unclear if the fifth affirmative defense is being asserted in both the opposition and the

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[6] This defense appears to be directed to the priority and likelihood of confusion claim.

[7] Sensible Foods has alleged that its pleaded Registration No. 2861273 is incontestable. Unless the incontestable registration is subject to one of the defenses enumerated in 15 U.S.C. 1115(b), full weight must be given to the registration's incontestable status regardless of the question of prior use in the cancellation. However, consideration of respondent's priority of use, as an equitable factor bearing on likelihood of confusion, is not precluded if the issue is reasonably debatable. *The Ansul Company v. Malter International Corporation*, 199 USPQ 596, 600 (TTAB 1978).

cancellation, and because it would be improper to assert such a defense in the opposition in the absence of a counterclaim, the motion to strike is granted, with leave to amend (with respect to the cancellation) if appropriate.

Six, Seventh and Eighth Affirmative Defenses

These defenses are amplifications of Hain Gourmet's denials of likelihood of confusion, are not prejudicial to Sensible Foods, and give Sensible Foods more complete notice of the basis for Hain Gourmet's denials. In view thereof, the motion to strike is denied with regard to affirmative defenses six, seven and eight. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

Ninth Affirmative Defense - Merely Descriptive[8]

The assertion that Sensible Foods' marks are merely descriptive is an improper collateral attack on Sensible Foods' pleaded registrations which cannot be entertained in the absence of a counterclaim. *Exxon Corporation v. U.S. Industries, Inc.*, 213 USPQ 393 (TTAB 1982). In view thereof, the Board sua sponte strikes this defense.

Tenth Affirmative Defense – Reserves the right . . . to assert any additional defenses

The Board sua sponte strikes this defense as an improper affirmative defense as well as mere surplusage.

[8] This defense appears to be directed to the priority and likelihood of confusion claim.

In summary, the motion to strike is denied with respect to affirmative defense nos. 1, 6, 7 and 8 and granted with respect to affirmative defense nos. 2, 3, 4, 5. The Board sua sponte strikes affirmative defenses 9 and 10. Applicant is allowed until October 20, 2011 to file an amended answer, if appropriate, to properly assert *some* of the affirmative defenses that have been stricken as set forth supra. In view of the insufficiency of Counts III and Count IV of the combined notice of opposition and petition to cancel, these claims are stricken. Additionally, references to application Serial No. 77833386 in the complaint are stricken as the only opposed application is Serial No. 77833401. This proceeding will go forward on the priority and likelihood of confusion and false suggestion of a connection claims only.

Proceedings are resumed.

Dates are reset as follows:

Deadline for Discovery Conference	**11/19/11**
Discovery Opens	**11/19/11**
Initial Disclosures Due	**12/19/11**
Expert Disclosures Due	**4/17/12**
Discovery Closes	**5/17/12**
Plaintiff's Pretrial Disclosures	**7/1/12**
Plaintiff's 30-day Trial Period Ends	**8/15/12**
Defendant's Pretrial Disclosures	**8/30/12**
Defendant's 30-day Trial Period Ends	**10/14/12**
Plaintiff's Rebuttal Disclosures	**10/29/12**
Plaintiff's 15-day Rebuttal Period Ends	**11/28/12**

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.