

Goodman

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

Mailed: February 1, 2013

Opposition No. 91206026

Victualic Company

v.

Shurjoint Piping Products,
Inc.

Before Cataldo, Bergsman and Wolfson, Administrative
Trademark Judges.

By the Board:

As background, opposer filed a three-paragraph notice
of opposition to applicant's mark



for Class 6: "Elbows of metal for pipes, metal junctions for
pipes, metal pipe clips, metal pipe collars, metal pipe
connectors, metal pipe couplings and joints, metal pipe
fittings for compressed air pipes, metal pipe fittings for
rigid pipes, metal pipes and metal fittings therefor, pipe
fittings of metal" based on priority and likelihood of
confusion. In its answer, applicant effectively denied
paragraphs 1 and 2 of the notice of opposition and expressly
denied paragraph 3 of the notice of opposition. In

addition, applicant alleged the affirmative defenses of laches, acquiescence, estoppel and unclean hands.

This case now comes up on applicant's motion, filed October 16, 2012, for judgment on the pleadings. Applicant argues that judgment on the pleadings should be granted based on its laches defense as the parties have co-existed for 40 years with no actual confusion. Applicant points to its incontestable Registration No. 1996123 for the mark

 **SHURJOINT** for "pipe fittings of metal"

which it submits is virtually identical to the involved mark. Applicant contends that an "established exception to the general rule [for laches] dictates that the laches period runs from the publication date of a substantially similar prior registration based on the opposing party's failure to object to the applicant's earlier registration."

In response¹, opposer argues that material facts are in dispute so that judgment on the pleadings cannot be granted, pointing, in particular, to applicant's denial of likelihood of confusion in the answer. Opposer also argues that laches is not an appropriate basis for a motion for judgment on the pleadings, and applicant's service of discovery concurrently

¹ The Board notes that opposer's response and its request for clarification filed November 7, 2012, are single spaced. In accordance with Trademark Rules 2.126(a)(1) and 2.126(b), all

with its motion for judgment is a "tacit admission" that material facts remain for discovery.²

In reply, applicant argues that there are no material facts in dispute and that only legal questions remain ripe for adjudication. In particular, applicant submits that "[t]he only question is whether the Board as a matter of law finds them [the marks and goods covered by the prior incontestable registration and the opposed application] substantially similar such that laches runs from the publication date of the incontestable registration."

A motion for judgment on the pleadings provides a means of disposition of cases when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings. See Fed. R. Civ. P. 12(c). A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice.³ *Ava Enterprises Inc. v. P.A.C. Trading*

submissions should be double-spaced. The Board expects opposer to comply with this requirement in the future.

² The motion for judgment on the pleadings was filed prior to the deadline for service of initial disclosures. It is unclear if applicant served its initial disclosures prior to or concurrently with its formal discovery which is a requirement under the discovery rules. Trademark Rule 2.120(a)(3).

³ The Board does not take judicial notice of registrations that reside in the USPTO. *Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987). Accordingly, no judicial notice can be taken of applicant's incontestable registration for purposes of the motion.

Group Inc., 86 USPQ2d 1659, 1660 (TTAB 2008). For purposes of the motion, all well-pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted, e.g., affirmative defenses) are deemed false. *Id.*

Applicant's Fed. R. Civ. P. 12(c) motion provides no basis for judgment as a matter of law. Applicant's express and effective denials of the allegations in the notice of opposition as well as applicant's assertion of affirmative defenses in its answer are sufficient to place all material facts in this case in dispute and, therefore, serve as a bar to applicant's motion for judgment on the pleadings. See *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303, 1307 (TTAB 2002) (denying motion for judgment on the pleadings finding material issues of fact raised by express conflict between the parties' pleadings as well as the pleading of affirmative defenses by applicant in its answer). See also *Aquion Partners L.P. v. Envirogard Products Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1997) ("The defense of laches usually requires factual development beyond the content of the pleadings. The facts evidencing unreasonableness of the delay and material prejudice to the

defendant cannot be decided against the plaintiff based solely on presumptions").

Accordingly, the motion for judgment on the pleadings is denied.

Proceedings are resumed.

In the event that applicant did not serve its initial disclosures prior to or concurrently with its formal discovery requests, then applicant should reserve the discovery requests concurrently with its initial disclosures. Trademark Rule 2.120(a)(3). In such a case, opposer is allowed until thirty days from the service date (plus five days for mailing, if appropriate) to serve its responses thereto. In the event that initial disclosures had been served or were served concurrently with formal discovery, opposer is allowed until thirty days from mailing date of this order to serve responses to applicant's outstanding discovery requests. In the event that applicant has been served with discovery requests and initial disclosures by opposer, applicant is allowed until thirty days from the mailing date of this order to serve responses to those outstanding discovery requests.

Dates are reset as follows:

Initial Disclosures Due	3/2/2013
Expert Disclosures Due	6/30/2013
Discovery Closes	7/30/2013
Plaintiff's Pretrial Disclosures Due	9/13/2013
Plaintiff's 30-day Trial Period Ends	10/28/2013
Defendant's Pretrial Disclosures Due	11/12/2013

Opposition No. 91206026

Defendant's 30-day Trial Period Ends	12/27/2013
Plaintiff's Rebuttal Disclosures Due	1/11/2014
Plaintiff's 15-day Rebuttal Period Ends	2/10/2014

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.