

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

Mailed: October 30, 2013

Opposition No. 91210367

Roche Diagnostics GmbH, Roche
Diagnostics Operations, Inc.

v.

Arriva Medical, LLC

Cheryl S. Goodman, Interlocutory Attorney:

This case now comes up on opposer's motion, filed July 1, 2013, to strike.¹

Opposer seeks to strike applicant's affirmative defenses of estoppel, laches, acquiescence and or waiver as precluded, defective and/or inapplicable as a matter of law.

In response, applicant argues that the affirmative defenses amplify its denial of likelihood of confusion and should not be stricken. Applicant also argues that its acquiescence and laches defenses have merit. As to the defenses of estoppel and waiver, applicant argues that it has provided "considerable factual detail" and there is no

¹ Opposer also had moved for partial summary judgment. However, the Board gave no consideration to that portion of the motion as initial disclosures had not been served, and the arguments made related to neither issue nor claim preclusion.

basis for striking these defenses as duplicative of acquiescence and laches. Applicant argues that the facts alleged were pled as one coherent narrative but not all of the facts necessarily apply to each defense.

In reply, opposer reiterates its arguments and submits that it will be prejudiced by having to respond and conduct discovery as to an inapplicable affirmative defense. Opposer argues that applicant has failed to substantively define how the defense of "estoppel" differs from estoppel by laches or estoppel by acquiescence.

Rule 12(f) provides that "the court may order stricken from any pleading any insufficient defense. . . ."

Laches and Acquiescence

A prima facie defense of laches requires a showing of (1) unreasonable delay in asserting one's rights against another, and (2) material prejudice to the latter as a result of the delay. *Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

Acquiescence is a doctrine which is very similar to laches. The difference between acquiescence and laches is that laches denotes passive consent and acquiescence denotes active consent. The defense of acquiescence requires proof of three elements: (1) That the other party

actively represented that it would not assert a right or a claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused undue prejudice. *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 19 USPQ2d 1401, 1409 (11th Cir. 1991)

In the context of a trademark opposition or cancellation proceeding, the defenses of laches and acquiescence must be tied to a party's registration of a mark rather than to its use of the mark. *National Cable Television Assoc., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1432 (Fed.Cir. 1991). Therefore, in an opposition where the objection is to the issuance of a registration of mark and the plaintiff had prior knowledge of applicant's use, laches or acquiescence starts to run when the mark is published for opposition. *Id.* (laches); *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904, 1914 (TTAB 2005) (acquiescence). If a timely opposition has been filed, there can be no undue delay by opposer or prejudice caused by opposer's delay. *Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d 1789, 1797 (TTAB 2009). Therefore, the defenses of laches and acquiescence are inapplicable in an opposition proceeding. *National Cable National Cable Television*

Association Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 (TTAB 2007) (laches and acquiescence generally not available in opposition proceeding).

Accordingly, the motion to strike is granted with respect to applicant's laches and acquiescence affirmative defenses, without leave to replead.

Equitable estoppel

Just as with acquiescence and laches, in an opposition proceeding, the equitable estoppel defense must be tied to the registration of applicant's marks, not applicant's use of its marks. *Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d at 1798.

The elements of equitable estoppel are (1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

The allegations as pleaded relate only to opposer's actions with respect to applicant's use of the mark ARRIVA MEDICAL and not with respect to registration of its mark. There are no allegations that opposer agreed that it would not object to registration of ARRIVA MEDICAL or misled applicant into believing that opposer would not object to registration of ARRIVA MEDICAL. Therefore, the affirmative defense of equitable estoppel as presently pleaded is insufficient. *See Panda Travel Inc. v. Resort Option Enterprises Inc.*, 94 USPQ2d at 1798 (finding no basis for equitable estoppel defense in part because opposer made no representation to applicant that it would not oppose applicant's marks). Accordingly, opposer's motion to strike the defense of equitable estoppel is granted, with leave to replead.

Waiver

The defense of waiver is "an intentional relinquishment or abandonment of a known right or privilege." *Johnson v. Zerbst*, 304 U.S. 458, 464, (1938); *see Seaboard Lumber Co. v. United States*, 903 F.2d 1560, 1563 (Fed.Cir. 1990) ("Waiver requires only that the party waiving such right do so 'voluntarily' and 'knowingly' based on the facts of the case)" (citations omitted)). A waiver need not be express, but may be inferred from a

pattern of conduct. *Seaboard Lumber*, 903 F.2d at 1563, 1588 ("Waiver can be either express or implied." (citations omitted)).

Just as with laches, acquiescence and equitable estoppel defenses, the defense of waiver must be tied to registration of applicant's mark.

Applicant's allegations as to opposer's conduct relate to use of ARRIVA MEDICAL and not to registration. Therefore, these allegations lack any facts that opposer knowingly and voluntarily relinquished its claims to oppose ARRIVA MEDICAL or engaged in a pattern of conduct that led applicant to believe that opposer had knowingly and voluntarily abandoned its right to oppose registration of applicant's ARRIVA MEDICAL mark. In view thereof, the Board finds the allegations of waiver insufficient.

Accordingly, opposer's motion to strike the waiver defense is granted with leave to replead.

It is the policy of the Board to allow parties to amend insufficient pleadings. *See, e.g., Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997); and TBMP § 503.03 (3d ed. rev. 2013).

Accordingly, applicant is allowed until TWENTY DAYS from the mailing date of this order to submit an amended

answer, asserting sufficient allegations with regard to equitable estoppel and waiver, failing which these defenses will stand as stricken.

Proceedings are resumed.

Dates are reset as follows:

Deadline for Discovery Conference	11/22/2013
Discovery Opens	11/20/2013
Initial Disclosures Due	12/20/2013
Expert Disclosures Due	4/19/2014
Discovery Closes	5/19/2014
Plaintiff's Pretrial Disclosures	7/3/2014
Plaintiff's 30-day Trial Period Ends	8/17/2014
Defendant's Pretrial Disclosures	9/1/2014
Defendant's 30-day Trial Period Ends	10/16/2014
Plaintiff's Rebuttal Disclosures	10/31/2014
Plaintiff's 15-day Rebuttal Period Ends	11/30/2014

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.