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

Proceeding	91210367
Party	Plaintiff Roche Diagnostics GmbH, Roche Diagnostics Operations, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Roche Diagnostics GmbH, and Roche Diagnostics Operations, Inc.  Opposers,  v.  Arriva Medical, LLC,  Applicant.	In the Matter of Trademark Serial No.: 85/339,161  Applicant's Mark: ARRIVA MEDICAL  <b>Opposition No.: 91210367</b>
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**REPLY BRIEF IN SUPPORT OF OPPOSER'S  
MOTION TO STRIKE**

Opposers, Roche Diagnostics GmbH, and Roche Diagnostics Operations, Inc. ("Roche") respectfully submit the following reply brief on Opposer's Motion to Strike under TBMP 506 and Fed.R.Civ.P. 12(f).

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## I. INTRODUCTION

Opposers, Roche Diagnostics GmbH, and Roche Diagnostics Operations, Inc. (“Roche”) respectfully submit the following brief in reply to Arriva Medical, LLC’s (“Applicant”) responsive brief in opposition to Opposer’s Motion to Strike. Based on the allegations as pled by Applicant, the affirmative defenses of estoppel by laches, estoppel by acquiescence, estoppel, and waiver must be struck from Applicant’s Answer.

The Board has declined to consider Roche’s motion for summary judgment at this time. Upon the Board’s resolution of the pending motion to strike, and absent the Board taking judicial notice of the fact that laches cannot be asserted in this opposition proceeding, Roche will file its initial disclosures concurrently with a motion for summary judgment including the following citation, “**the affirmative defense of laches is inapplicable in opposition proceedings.**” *Nike, Inc. v. Gregory A. Bordes*, Opposition No. 91178960, Dkt. No. 35, at 16 (T.T.A.B. September 30, 2009)(emphasis added).<sup>1</sup>

## II. ARGUMENT

### A. Acquiescence

In Applicant’s responsive brief (Dkt. No. 8), Applicant failed to refute that the affirmative defense of acquiescence must be struck from its answer (Dkt. No.4). In fact, Applicant declined to substantively address the issue at all. Applicant’s sole comment regarding why acquiescence should not be struck from Applicant’s Answer is the conclusory statement that Roche has “offered inadequate arguments for striking the affirmative defense of acquiescence.”

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<sup>1</sup> See e.g. *National Cable Television Ass’n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *James Burrough, Ltd. v. La Joie*, 462 F.2d 570, 174 USPQ 329 (C.C.P.A. 1972); *DAK Ind. Inc. v. Daiichi Kosho Co. Ltd.*, 25 U.S.P.Q.2d 1622, 1624 (T.T.A.B. Sept. 30, 1992); *Guide to T.T.A.B. Practice*, Handelman, Jeffery, 2003, Section 11.03[I].

(Dkt. No. 8, p.5).

In the context of a T.T.A.B. opposition, acquiescence is tied to a mark's registration, not its use. *Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904 (T.T.A.B. 2005). In this case, all of the alleged facts pled by Applicant in its Answer relate to *use* rather than *registration* of the ARRIVA MEDICAL mark. Allegations related to acquiescence as to *use* are inapplicable to a T.T.A.B. dispute which involves whether acquiescence to *register* a mark with the U.S.P.T.O. existed. Applicant has made no allegations related to any purported permission given by Roche to register the ARRIVA MEDICAL mark.<sup>2</sup> Because Applicant has not substantively opposed Roche's motion to strike the affirmative defense of acquiescence and has failed to allege any facts that are applicable to an acquiescence defense in this proceeding, the affirmative defense of acquiescence must be struck from Applicant's Answer.

**B. Estoppel is duplicative of Laches or Acquiescence**

In the context of this TTAB proceeding, Applicant's affirmative defense of "estoppel" is duplicative of laches or acquiescence. Applicant cannot deny that the affirmative defense of laches cannot be asserted in this opposition proceeding (Dkt. No. 5, p.6-7) and that estoppel by acquiescence must be struck. Because laches cannot be raised in an opposition and acquiescence must be struck, the alleged affirmative defense of "estoppel", which is duplicative of laches or acquiescence, must likewise be struck.

As an initial matter, Applicant has failed to provide any support for the proposition that the affirmative defense of "estoppel," as pled, is in any way different from estoppel by laches or estoppel by acquiescence. In applicant's words "[e]stoppel requires that a party rely on the actions of another." (Dkt. No 8, p 3.) Applicant does not explain, and Roche cannot grasp, how

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<sup>2</sup> Roche disputes and denies that any permission was given Applicant to use or register the term ARRIVA MEDICAL as a trademark.

such a definition is not duplicative of either laches or acquiescence where laches is defined as “(1) an unreasonable delay in assertion of one’s rights against another; and (2) material prejudice to another attributable to that delay” and acquiescence is defined as “a type of estoppel predicated upon conduct of a plaintiff that, expressly or by clear implication, assents to, encourages, or furthers the activity on the part of the defendant, which is now objected to.” *Guide to T.T.A.B. Practice*, Handelman, Jeffery, 2003, Section 11.03[A], 11.04[A]; *Hitachi Metals Int., Ltd. V. Yamakyu Chain Kabushiki Kaisha*, 209 USPQ1057, 1067 (T.T.A.B. 1981). Because Applicant has otherwise pled these affirmative defenses, and Applicant has failed to substantively define how the defense of “estoppel” differs from estoppel by laches or estoppel by acquiescence, Roche remains at a loss as to how the defense is not impermissibly duplicative.

Applicant has failed to define “estoppel” other than as identical to estoppel by laches which cannot be brought in an opposition proceeding<sup>3</sup> or estoppel by acquiescence which must be struck. If this defense is not struck, Roche will be prejudiced by having to respond and conduct discovery on an affirmative defense that is inapplicable in this proceeding. Consequently, Applicant’s duplicative and impermissible “estoppel” affirmative defense must be struck from the Applicant’s Answer.

**C. Waiver is duplicative of laches or acquiescence**

Applicant’s affirmative defense of waiver is duplicative of estoppel by laches or estoppel by acquiescence. The only factual allegations that Applicant has raised to support this defense relate to certain letters in which Applicant claims Roche grants it permission to use the mark as a business name.<sup>4</sup> (Dkt. No. 4.) From these alleged facts alone, Applicant has raised the defense of “waiver.” *See Id.* Under the facts as pled, either Applicants’ waiver claim relates to some

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<sup>3</sup> *Nike, Inc. v. Gregory A. Bordes*, Opposition No. 91178960, Dkt. No. 35, at 16 (T.T.A.B. September 30, 2009).

<sup>4</sup> Roche denies this allegation.

purported inaction by Roche prior to the issuance of the instant notice of publication, which is a laches defense and therefore barred in opposition proceedings, or Applicant believes that evidence that allegedly allows use is relevant in a proceeding where the only possible issue is the presence or absence of permission to *register*, a theory that is identical to the estoppel by acquiescence theory that, as discussed *supra*, must be struck. This is consistent with Applicant's brief statements in its responsive brief that "acquiescence requires an affirmative act, while laches can be based on silence and inaction. Estoppel requires that a party rely on the actions of another, while waiver can be found independent of such reliance." (Dkt. No. 8, p.3).

Given Applicant's arguments and alleged facts, there is no plausible interpretation of the affirmative defense of waiver that is not duplicative of estoppel by laches or estoppel by acquiescence. If this defense is not struck, Roche will be prejudiced by having to respond and conduct discovery on an affirmative defense that is inapplicable in this proceeding. Consequently, because estoppel by laches and estoppel by acquiescence must be struck from Applicant's Answer, the affirmative defense of acquiescence must likewise be struck from Applicant's Answer as duplicative of a defense that must be struck.

**D. Applicant's affirmative defenses should be struck.**

Applicant's affirmative defenses should be struck as wholly duplicative or impermissibly unsupported. Were the affirmative defenses of estoppel and waiver merely duplicative of other permissible affirmative defenses then there would be little harm allowing them to remain. However, in this case the defenses are duplicative of affirmative defenses that must be struck.

Applicant has incorrectly characterized the *Order of Sons of Italy* case's application to this proceeding. (Dkt. No. 8, p.4) *citing Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). In that case the Board declined to strike an

affirmative defense which, “instead of restating, amplified a denial within the body of the Answer.” *Id.* Unlike *Order of Sons of Italy*, Applicant’s asserted affirmative defenses of waiver and estoppel are not enhanced versions of its affirmative defenses of laches and acquiescence, or *vice versa*. Rather, these defenses are merely restatements of other asserted affirmative defenses. Based on the facts alleged in this proceeding, Applicant’s asserted affirmative defenses of waiver and estoppel must be struck because they are either impermissibly duplicative of either estoppel by laches or estoppel by acquiescence.

**E. Roche will be prejudiced if this motion is not granted.**

If the Board sees fit to grant Roche’s Motion, the only issue remaining will be that of likelihood of confusion. However, if the Board declines to strike these affirmative defenses at this time, Roche will be required to respond to expensive, burdensome, and unnecessary discovery relating to affirmative defenses that are inapplicable to the final determination in this case.

Roche recognizes that expense is to be expected in litigation. However, where affirmative defenses such as laches and acquiescence are so clearly inappropriate, it would be highly prejudicial to permit unnecessary discovery on them. This prejudice stems from the great cost in both time and money that would be required to respond to discovery requests regarding defenses that must be struck. Therefore, in order to avoid Roche being unduly prejudiced, Roche urges the Board to both grant its motion to strike and take judicial notice that laches cannot be raised as a defense in an opposition proceeding.

**III. Conclusion**

Applicant’s affirmative defenses must either be struck as unsupported, impermissible, or duplicative. Laches cannot be raised in an opposition proceeding and any defense duplicative of

laches must likewise be struck on the same grounds. Applicant has failed to substantively oppose Roche's motion to strike Applicant's affirmative defense of acquiescence. Further, Applicant has failed to plausibly establish why "estoppel" or "waiver" as pled should not be struck as duplicative of either estoppel by laches or estoppel by acquiescence. Based on the foregoing, Roche Diagnostics GmbH and Roche Diagnostics Operations, Inc.'s motion to strike should be granted with respect to Applicant's affirmative defenses of acquiescence, estoppel, and waiver. Moreover, Roche respectfully requests the Board take notice that the affirmative defense of laches cannot be asserted in a timely filed opposition proceeding as well as any further action the Board deems appropriate.

Dated: August 5, 2013

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on August 5, 2013, a true and correct copy of the foregoing was sent to the following parties by First Class U.S. Mail in a sealed, postage prepaid, envelope which was deposited with the United States Postal Service.

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