ESTTA Tracking number: **ESTTA563893**
Filing date: **10/08/2013**

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

Proceeding	91210772
Party	Defendant T H K Photo Products, Inc.
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Date	10/08/2013
Attachments	Applicant's Response to Opposer's Motion to Strike Affirmative Defenses.pdf(991436 bytes)

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INTERCAST EUROPE S.r.l.,	)	Opposition No. 91210772
	)	
Opposer,	)	
	)	
v.	)	
	)	
THK PHOTO PRODUCTS, INC.,	)	
	)	
Applicant.	)	
	)	

APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE ITS AFFIRMATIVE DEFENSES

Applicant Kenko Tokina USA, Inc. ("Applicant") submits the following response to Opposer Intercast Europe S.r.l.'s ("Opposer") motion to strike Applicant's affirmative defenses plead in its Answer ("Answer").

I. INTRODUCTION

On July 30, 2013 during the discovery conference, Opposer objected to Applicant's affirmative defenses. Two weeks later, Opposer sent a demand letter seeking withdrawal of said defenses. After Applicant refused to withdraw its defenses, Opposer sent the Board a copy of its August 14 letter and requested a conference with the Interlocutory Attorney assigned to this case to strike said defenses.

On September 4, 2013, the Interlocutory Attorney advised Opposer that the time to request the Interlocutory Attorney's assistance with this issue should have occurred no later than ten (10)

days prior to the discovery conference. Since the discovery conference in this matter had taken place on July 30, 2013, Opposer's request was late. Accordingly, the Interlocutory Attorney would not allow Opposer to proceed in moving to strike Applicant's defenses without bringing a formal motion to strike.

On September 12, 2013, Opposer filed a formal motion to strike Applicant's defenses. On September 18, 2013, Opposer filed an amended motion to strike Applicant's defenses. On September 19, 2013, the Board issued an Order stating that Applicant's response to Opposer's motion is due by October 8, 2013.

II.
ARGUMENT

Clearly, in this case, Opposer's motion is a dilatory tactic, intended to prejudice Applicant by: (1) improperly restricting the scope of discovery, (2) increasing Applicant's legal expenses, and (3) delaying the proceeding in order to obfuscate the meritless allegations in this opposition.

Motions to strike are not favored, and matter should not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999). The Fourth Circuit Court of Appeals has noted that such motions are disfavored, "because striking of a pleading is a drastic remedy and because it is often sought by the movant simply as a dilatory tactic." *See Waste Mgmt. Holdings, Inc. v. Gilmore*, 252 F.3d 316, 347 (4th Cir. 2001). Not surprisingly, then, Rule 12(f) motions to strike are "often not granted unless there is a showing of prejudice to the moving party." *See Wright & Miller*, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008). To strike defendant's affirmative defenses would only encourage the bringing of more motions to strike, which is entirely counter to the well-established standard that such motions are strongly disfavored.

Further, a defense should not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See, generally, Wright & Miller*, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008). The Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g.*, *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

Opposer's attempt to strike Applicant's affirmative defenses before any discovery has been conducted is inappropriate and premature. Applicant must plead certain defenses or lose the right to assert them later in the proceeding. Although Opposer might believe that certain defenses have no merit, Applicant is unable to make that determination prior to any discovery.

Rule 8(c) of the Federal Rules of Civil Procedure, which rules govern the practice and procedure in the Patent and Trademark Office with respect to applications for the registration and other proceedings with respect to trademarks, states, "An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense." Applicant should be afforded an opportunity to test all the allegations made by Opposer in its Opposition, and thus Opposer's motion should be denied.

A. <u>Applicant Withdraws Lack of Standing as an Affirmative Defense</u>

As a show of good faith, Applicant conducted further research and, in an effort to compromise, Applicant has agreed to withdraw the affirmative defense asserted in paragraph 7.

B. <u>Applicant Maintains Failure to State a Claim as an Affirmative Defense</u>

In order to withstand the assertion that a pleading fails to state a claim, a plaintiff need allege such facts that would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing the mark. The pleading must be examined in

its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and TBMP § 503.02 (3d. ed. rev. 2012).

C. <u>Applicant Maintains Likelihood of Confusion as an Affirmative Defense</u>

Opposer recited the wrong standard in its pleading of likelihood of confusion, and included some limiting language in its Notice of Opposition, ¶¶ 4-6. For example, Opposer refers to the likelihood of confusion to the "average" consumer in its Notice. But Applicant does not agree that Opposer has properly pled the standard and that likelihood of confusion should be based on the "reasonably prudent" consumer. *Dreamwerks Prod. Group, Inc. v. SKG Studio,* 142 F.3d 1127, 1129 (9th Cir.1998) ("Under Ninth Circuit law, the core element of trademark infringement is whether the reasonably prudent consumer is likely to be confused as to the origin of the good or service bearing one of the marks.").

Applicant will prove in this matter that there is not any likelihood of confusion, and must therefore preserve this defense to the fullest extent possible. Accordingly, Applicant does not wish to be limited by Opposer's pleading in any manner in presenting this defense.

D. <u>Applicant Maintains Abandonment as an Affirmative Defense</u>

Abandonment is a question of fact. *See Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 1579 (Fed.Cir. 1984). Opposer rejects that it has any burden to demonstrate it has not abandoned its mark because it possesses an incontestable registration. This is not the case.

Opposer fails to recognize the validity of its registration and the current use of its mark are not one and the same. By asserting a defense of abandonment, Applicant, through discovery, will require that Opposer meet its burden of demonstrating the continuous use of its mark. Applicant has

the right to question the strength of Opposer *marks* in a defensive position, without taking the offensive stance of petitioning to cancel Opposer's registrations. Further, because Applicant will prevail in showing that there is no likelihood of confusion between Applicant's mark and Opposer's mark, Applicant has no reason to seek cancellation of Opposer's mark in a counterclaim. And Applicant has the right to conduct discovery and determine the extent of Opposer's rights to its own satisfaction, rather than take Opposer's assertions at face value.

E. Applicant Maintains Lack of Use in Interstate Commerce as an Affirmative Defense

For the reasons stated above concerning the defense of abandonment, the same basis holds true for the defense that Opposer has failed to use its mark interstate commerce, which is the subject of Paragraph 11. Applicant believes it is entitled to discover evidence of whether and to what extent Opposer has abandoned its rights and used its mark in commerce.

Since Opposer is not a United States entity, it is particularly important that Applicant has the opportunity to examine whether Opposer uses its marks in interstate commerce. Without discovery on this issue, Applicant cannot determine whether Opposer in fact has the rights it asserts.

F. Applicant Maintains Laches as an Affirmative Defense

Opposer states that "laches and acquiescence are not available in opposition proceedings." (See Motion at page 8). This is a misstatement of the law. Although laches, acquiescence or estoppel are *generally* not available in opposition proceedings, these defenses are allowed under certain circumstances. *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n. 39 (TTAB 1994); *see also Leatherwood Scopes International, Inc. v. James M. Leatherwood, Opposition No. 122,064, (TTAB 2002).*

Once again, Applicant, should be provided the opportunity to discover when Opposer received notice of Applicant's mark, and any related evidence that provides Opposer with its basis

for opposition. Thus, Applicant's affirmative defense of laches is appropriate under these circumstances.

Applicant respectfully requests the opportunity to conduct reasonable discovery to determine the facts upon which Opposer premises this Opposition, and hopes that this proceeding may continue without any further attempts at delay.

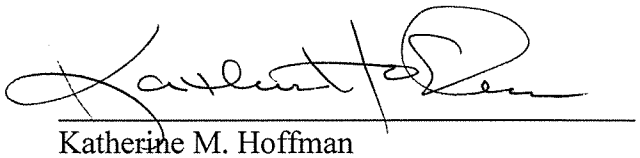
III.
CONCLUSION

Applicant respectfully requests that Opposer's Motion be denied in its entirety.

In the event that the Board grants any part of Opposer's Motion to Strike, Applicant respectfully requests that the Board allow leave to amend its answer and make the factual allegations necessary to support the stricken defense.

Applicant further requests that the Discovery Period NOT be stayed, and the present Opposition proceed without further unnecessary delay.

Dated: October 8, 2013



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CERTIFICATE OF SERVICE

I am employed in San Diego County. My business address is 4435 Eastgate Mall, Suite 400, San Diego, California 92121, where this mailing occurred. I am over the age of 18 years and am not a party to this cause. I am "readily familiar" with the practices of McKenna Long & Aldridge LLP for collection and processing of correspondence for mailing with the United States Postal Service. Such correspondence is deposited with the United States Postal Service the same day in the ordinary course of business.

On October 8, 2013, I served the foregoing document(s) described as:

APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE ITS AFFIRMATIVE DEFENSES

By placing true copies thereof enclosed in sealed envelope(s) addressed as follows:

Ralph H. Cathcart
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[X] **BY MAIL.** I deposited such envelope in the mail at San Diego, California. The envelope was mailed with postage thereon fully prepaid.

I am "readily familiar" with the business' practice of collection and processing of correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at San Diego, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing an affidavit.

[ ] **BY PERSONAL SERVICE.** I delivered such envelope by hand to the offices of the party(ies) listed above. [by delivering a copy to CalExpress Messenger Service] on this date for personal service on each party listed above.

I declare under penalty of perjury under the laws of the United States of America that I am employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on October 8, 2013, at San Diego, California.

California C. Lopez

California C. Lopez