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

Proceeding	91210772
Party	Plaintiff Intercast Europe S.r.l.
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Submission	Reply in Support of Motion
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Signature	/Ralph H. Cathcart/
Date	10/23/2013
Attachments	Opposer's Reply in Support of Motion to Strike - THK Photo.pdf(752299 bytes) Cathcart Reply Declaration - THK Photo.pdf(287390 bytes)

Thus, Applicant's ill-conceived plan to conduct a fishing expedition will be futile and entirely misses the point.

Further, Applicant's contention that Opposer is somehow engaging in dilatory tactics (Cathcart Reply Dec'l. ¶¶ 2 - 9) is unsupported, much like Applicant's assertion of a menu of skeletal "garden variety" Affirmative Defenses. Opposer respectfully submits that it is this very type of scatter-shot pleading that wastes time, clogs the Board's docket and causes hardship to Opposer, who must incur needless expense in motion practice and discovery and suffer delay and uncertainty as to which claims/defenses are even properly at issue.

Notwithstanding Applicant's assertions to the contrary, Motions to Strike serve an important function and should be granted in this case.¹

II.

For the Board's ease of reference, Opposer shall address each of Applicant's responses (denominated IIA - F in Applicant's response papers) sequentially below:

A. Applicant Withdraws Lack of Standing as an Affirmative Defense

This is now moot, as Applicant has agreed to withdraw its lack of standing Affirmative Defense at paragraph 7 of its Answer.

B. Applicant Maintains Failure to State a Claim as an Affirmative Defense

Opposer is unable to glean the argument being proffered by Applicant at paragraph II B of its response to Opposer's Motion to Strike. To the extent Applicant concurs that the Board may treat the instant Rule 12(f) Motion as a motion testing the sufficiency of Applicant's purported Affirmative Defense prior to trial, Applicant has already conceded Opposer's

¹ As of this date, Opposer never received any discovery requests from Applicant's counsel, so counsel must assume that Applicant's protestations of delay are self-serving. Similarly, it bears noting that Opposer made numerous attempts to persuade Applicant to voluntarily withdraw its meritless/redundant Affirmative Defenses, without having to resort to motion practice. *See* Cathcart Reply Dec'l. ¶¶ 1 - 9.

“standing” and plainly Opposer has plead valid grounds, namely: Opposer has priority, Applicant’s applied-for NXT mark is identical to Opposer’s NXT Marks and covers identical and/or closely related goods. Moreover, to the extent any of the goods differ, consumers might believe Opposer has bridged the gap.

A mark may be refused registration under Section 2(d) of the Lanham Act where it:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

See 15 U.S.C. § 1052(d).

To allege a valid ground for opposition under Section 2(d), Opposer need only allege it has priority of use and that Applicant’s mark so resembles Opposer’s mark as to be likely to cause confusion. *See*, Lanham Act § 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

Inasmuch as Opposer has alleged, at paragraphs 1 and 2 of its Notice of Opposition, prior rights in its pleaded NXT Registration Nos. 2,819,525, 3,056,740 and 3,335,620 and that Applicant’s identical applied-for NXT mark so resembles Opposer’s NXT Mark, when used on or in connection with the goods of Applicant, that Applicant’s NXT mark “is likely to be confused” with Opposer’s NXT Marks (paragraphs 4 and 5 of Opposer’s Notice of Opposition), Opposer has adequately set forth a claim of likelihood of confusion with its registered NXT Marks. *See also*, *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108 (CCPA 1974). *See, e.g.*, *Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995). Thus, Applicant’s Affirmative Defense at paragraph 8 of its Answer is immaterial and must be stricken.

C. Applicant Maintains Likelihood of Confusion as an Affirmative Defense

Contrary to its arguments, Applicant's Affirmative Defense at paragraph 9 of its Answer is unfounded.

To begin with, its reliance on *Dreamwerks Prod. Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998) is unsupported, as that case concerned a trademark infringement and unfair competition case (rather than a Board proceeding dealing with the registerability of Applicant's applied-for mark and Section 2(d)). Further, *Dreamwerks* contains no express holding to support the validity of a skeletal "Affirmative Defense" that merely states there is no "likelihood of confusion", when Applicant has already denied likelihood of confusion in its Answer. Nor does *Dreamwerks* overrule the general rule that affirmative defenses do not negate elements of the cause of action. *Gwin v. Curry*, 161 F.R.D. 70, 71 (N.D. Ill. 1985).

Applicant's position is also contrary to the well-established principle that pleadings are to be construed liberally and that pursuant to Fed. R. Civ. P. 8, a pleading should contain simple and concise terms to merely give notice of Opposer's claims.

Plainly, Opposer's claims rooted in Section 2(d) of the Lanham Act provide notice of its grounds for Opposition and Applicant has already unequivocally denied such claims in its Answer.

Thus, as stated in Opposer's moving papers, Applicant's Affirmative Defense is not a cognizable defense at all and further, is redundant, as it merely restates Applicant's denials alleged earlier in its Answer, without any additional information that would provide better notice of its defense.

D. Applicant Maintains Abandonment as an Affirmative Defense

Not surprisingly, Applicant sets forth no precedential authority to refute Opposer's

Motion to Strike based upon Applicant's impermissible attack on Opposer's pleaded registrations. Rather, Applicant curiously cites *Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 1579 (Fed Cir. 1984) for the proposition that abandonment is a question of fact.

Applicant cannot affirmatively plead matters as "defenses" that must of necessity be plead as a counterclaim. Applicant has unequivocally attacked Opposer's pleaded NXT registrations and certified that Applicant's pleading was true, by signing Applicant's Answer within the meaning of 37 CFR § 11.18. With respect to signed submissions, such as Applicant's Answer, 37 CFR §11.18 requires in relevant part:

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true . . .

Thus, Applicant's improper abandonment Affirmative Defense was presumably made with actual knowledge of abandonment. Therefore, such claim must lie as a mandatory counterclaim to Petition to Cancel. Tellingly, as stated in Opposer's moving papers, Applicant did not assert its improper abandonment Affirmative Defenses "upon information and belief". Applicant's purported claim to need to take discovery to see if its defective Affirmative Defenses are viable seeks to pervert the Rules of Civil Procedure and Trademark Rules and is a red herring that has no bearing on the instant Motion to Strike.

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

See response to paragraph II D of Applicant's response to Opposer's Motion to Strike above. Again, Applicant confuses the right to take discovery with the obligation to make truthful statements and timely assert claims of abandonment by counterclaim.

F. Applicant Maintains Laches as an Affirmative Defense

Applicant provides no legal authority for its contention that Applicant's laches and

acquiescence defense should not be stricken.

Here, Applicant's reliance on *University Book Store v. University of Wisconsin Board of Regents*, 33 U.S.P.Q.2d 1385, 1401 N. 39 (TTAB 1994) and *Leatherwood Scopes International, Inc. v. James M. Leatherwood*, Opposition No. 122,064 (TTAB 2002) is misplaced, as both cases merely held that laches/acquiescence could not serve as grounds for an Opposition. Here, in an opposition proceeding, laches is determined from the date of publication of the applied-for mark.

Further underscoring the immaterial nature of Applicant's laches Affirmative Defense is the fact that its applied-for NXT mark was filed under Section 1(b) as an intent-to-use application.

Thus, Applicant's alleged laches Affirmative Defense begs the question how Opposer could be guilty of laches when Opposer timely filed its opposition and the applied-for mark was not even in use at the time the application was filed.

In sum, Applicant seeks to deflect attention from the fact that its Affirmative Defenses are immaterial, redundant, improper and ill-conceived.

For all of the above reasons, Opposer's Motion to Strike should be granted in its entirety, and discovery and trial deadlines reset.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Opposer

Dated: October 23, 2013

By: 
Ralph H. Cathcart
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(Our Ref: C13650025)

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S REPLY IN FURTHER SUPPORT OF ITS MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated below:

Dated: October 23, 2013


Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S REPLY IN FURTHER SUPPORT OF ITS MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** was served by first-class mail, postage prepaid, to the following persons:

Katherine M. Hoffman, Esq.
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4435 Eastgate Mall, Suite 400
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E-mail: KHoffman@MckennaLong.com

Dated: October 23, 2013


Reinaldo M. Roa

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

-----X
INTERCAST EUROPE S.r.l.,
Opposer,
v.
T H K PHOTO PRODUCTS, INC.,
Applicant.
-----X

Opposition No. 91/210,772
Serial No. 85/718,687

DECLARATION OF RALPH H. CATHCART, ESQ.

I, Ralph H. Cathcart, declare that the following is true and correct pursuant to 28 U.S.C. § 1746:

1. I am a partner at the law firm of Ladas & Parry LLP, attorneys for Opposer Intercast Europe S.r.l. and respectfully submit this declaration in further support of Opposer's Motion to Strike Applicant's Affirmative Defenses and a stay of discovery pending the Board's decision.
2. On or about July 31, 2013, Declarant conducted a telephonic conference call with Applicant's counsel in order to conduct the mandatory Settlement/Discovery conference mandated by the Board's Institution Order.
3. During such conversation, Declarant explained to Applicant's counsel that its Affirmative Defenses were infirm and requested that Applicant voluntarily withdraw same.
4. After Applicant's counsel declined to voluntarily withdraw the Affirmative Defenses, both counsel agreed to conclude the Discovery/Settlement Conference by requesting that the assigned Interlocutory Attorney decide the matter.

5. On or about August 14, 2013, Declarant wrote to Applicant's counsel again setting forth the basis of the infirmities of Applicant's putative Affirmative Defenses and again requested that Applicant voluntarily withdraw same or that Opposer would seek the involvement of the assigned Interlocutory Attorney.

6. On September 4, 2013, the respective Parties' counsel and the assigned Interlocutory Attorney, Christen M. English, conferred on this and other matters related to the striking of the Affirmative Defenses.

7. During that telephonic conference, Declarant recalls Applicant's counsel stating that counsel had served discovery requests upon Opposer and did not want Opposer to sit on such discovery "for two months" until the Board rendered its decision.

8. Declarant then requested a stay of discovery pending the determination by the Board of the Motion to Strike.

9. As of this date, Applicant has not served any discovery upon Opposer.

I declare that the foregoing is true and correct under penalties of perjury.

Executed on October 23, 2013 in New York, New York.



Ralph H. Cathcart

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **DECLARATION OF RALPH H. CATHCART, ESQ.** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated:

Dated: October 23, 2013



Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **DECLARATION OF RALPH H. CATHCART, ESQ.** was served on the persons listed below by First-Class Mail, postage prepaid, on the date indicated below:

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Dated: October 23, 2013



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