

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

CME

Mailed: December 17, 2013

Opposition No. 91210772

Intercast Europe S.r.l.

v.

T H K Photo Products, Inc.

By the Trademark Trial and Appeal Board:

This case now comes up on opposer's amended motion, filed September 18, 2013, to strike applicant's affirmative defenses and to suspend this proceeding pending the Board's decision on the motion to strike.¹ The amended motion is fully briefed.

By way of background, applicant seeks registration of the mark NXT, in standard characters, for "Portable photography equipment, namely optical glass filters, UV filters, protector filters and circular polarizer filters."² In the notice of opposition, opposer alleges that applicant's involved mark is likely to cause confusion with opposer's prior used and registered marks NXT and NXT

¹ Applicant's change of correspondence address, filed September 26, 2013, is noted and the Board's records have been updated accordingly.

² Application Serial No. 85718687, filed on August 31, 2012, based on applicant's allegation of a *bona fide* intention to use

(stylized) for optical goods, including lenses for eyeglasses and sunglasses.³ In its answer, applicant denies the salient allegations of the notice of opposition and asserts six affirmative defenses, namely that: (1) opposer has failed to sufficiently allege its standing, see Answer, ¶ 7; (2) opposer has failed to state a claim upon which relief can be granted, see *id.* at ¶ 8; (3) confusion is not likely between the parties' marks, see *id.* at ¶ 9; (4) opposer has abandoned its pleaded marks, see *id.* at ¶ 10; (5) opposer has failed to use the pleaded marks in interstate commerce, see *id.* at ¶ 11; and (6) opposer's claims are barred by "laches and/or acquiescence." *Id.* at ¶ 10.

Opposer moves to strike applicant's affirmative defenses on the grounds that: (i) it has adequately alleged its standing and a valid ground for opposition of the involved marks, Amended Motion, pp. 3-5; (ii) affirmative defense 3 "is not an affirmative defense at all," "impermissibly seeks to contradict [o]pposer's well-pleaded likelihood of confusion claims," and is "redundant" of applicant's denials set forth in its answer, *id.* at p. 5; (iii) affirmative defenses 4-5 are impermissible collateral

the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

³ Registration Nos. 2819525, 3056740 and 3335620.

attacks on opposer's pleaded registrations, *see id.* at pp. 6-8; and (iv) laches and acquiescence are "not viable [defenses] in TTAB proceedings." *Id.* at p. 8.

In response, respondent withdraws Affirmative Defense 1. With respect to the remaining affirmative defenses, applicant argues that motions to strike are not favored and that opposer's motion is merely an attempt to "improperly restrict the scope of discovery." Response, pp. 2. Applicant further contends that it "has the right to question the strength of [o]pposer's marks in a defensive position, without taking the offensive stance of petitioning to cancel [o]pposer's registrations," and "[a]pplicant should be provided the opportunity to discover when [o]pposer received notice of [a]pplicant's mark, and any related evidence that provides [o]pposer with its basis for opposition." *Id.* at 5-6 (emphasis in original).

As an initial matter, opposer's motion to strike is untimely as it was filed more than twenty-one days after the service of applicant's answer. Fed. R. Civ. P. 12(f). "Nevertheless, inasmuch as Fed.R. Civ. P. 12(f) provides that the Board may, upon its own initiative, at any time strike from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter, we will consider the arguments raised in [opposer's] motion to

strike on the merits." *Western Worldwide Enterprises Group Inc. v. Qindingdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990).

Affirmative Defense 1 (Answer, ¶ 7)

Applicant has withdrawn Affirmative Defense 1, and therefore, it is hereby **STRICKEN**.

Affirmative Defense 2 (Answer, ¶ 8)

A defendant is permitted to assert failure to state a claim upon which relief can be granted as an affirmative defense, but a plaintiff is allowed to test the sufficiency of such a defense before trial by filing a motion to strike. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d, 1221, 1222 (TTAB 1995). To survive a motion to dismiss, a claimant need only allege sufficient factual matter as would, if proved, establish that 1) it has standing to maintain the claim, and 2) a valid ground exists for opposing the mark. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, a complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory

statements," to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).

Here, opposer has sufficiently alleged both its standing and a valid ground for opposition by pleading its prior use and registration of the NXT and NXT stylized marks and a non-frivolous likelihood of confusion claim. See *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007); see also TBMP § 309.03(b) (3d ed. rev.2 2013) and cases cited therein. Accordingly, opposer's motion is **GRANTED** with respect to Affirmative Defense 2, which is hereby **STRICKEN**.

Affirmative Defense 3 (Answer, ¶ 9)

"Affirmative defense" 3 merely amplifies applicant's denials and provides fuller notice of how applicant intends to defend this opposition proceeding. See *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999). Accordingly, although it is not a proper affirmative defense, the Board need not strike it.

Affirmative Defenses 4 and 5 (Answer, ¶¶ 10-11)

Applicant's fourth affirmative defense alleges that opposer has abandoned its rights in the pleaded marks. See Answer, ¶ 10. In its fifth affirmative defense, applicant alleges that "[o]pposer has failed to use [the pleaded marks] in interstate commerce," Answer, ¶ 11, which can be

interpreted either as a restatement of applicant's assertion of abandonment or an assertion that the pleaded registrations are *void ab initio* based on opposer's alleged lack of use of the marks necessary to support registration.

Abandonment is a statutory ground for cancellation of a trademark registration under § 14(3) of the Trademark Act, 15 U.S.C. § 1064(3); *see also* Trademark Act § 45, 15 U.S.C. § 1127. As such, applicant's allegation of abandonment is an attack on the validity of opposer's registrations, and therefore, it is not a proper affirmative defense, but an impermissible collateral attack on opposer's registrations. To the extent that applicant may be asserting that the pleaded registrations are *void ab initio* based on lack of *bona fide* use to support the original registrations, this too is an impermissible collateral attack.

The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration. *See* Trademark Rules 2.106(b)(2)(ii) and 2.114(b); *Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (defense attacking validity of pleaded registration must be raised by way of cancellation of registration). Applicant's argument that such "affirmative defenses" are proper because it has a "right to conduct discovery and determine the extent of

[o]pposer's rights" in the pleaded marks is without merit as the scope of discovery is not limited to the claims and defenses raised in the parties' pleadings. Indeed, a party may take discovery "as to any matter which might serve as the basis for an additional claim, defense or counterclaim." TBMP § 402.01; *see also Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 171 (TTAB 1975) (the mere taking of discovery on matters concerning the validity of a pleaded registration cannot be construed as a collateral attack on the registration); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) ("[A]pplicant is entitled to take discovery not only as to the matters specifically raised in the pleadings but also as to any matters which might serve as the basis for an affirmative defense or for a counterclaim.").

In view of the foregoing, opposer's motion is **GRANTED** with respect to Affirmative Defenses 4 and 5, which are hereby **STRICKEN**.

Affirmative Defense 6 (Answer, ¶ 12)

As its sixth affirmative defense, applicant alleges "laches and/or acquiescence." Answer, ¶ 12. Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the petitioner on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health*

Inc., 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State University*, 51 USPQ2d at 1292 (noting that the primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); see also TBMP § 311.02(b) and the cases cited therein. Here, applicant's defenses of laches and acquiescence are conclusory in nature and are not supported by any facts.⁴ Accordingly, opposer's motion is **GRANTED** with respect to Affirmative Defense 6, which is hereby **STRICKEN**.

In sum, applicant has withdrawn Affirmative Defense 1 (Answer, ¶ 7) and opposer's motion is **GRANTED** with respect to affirmative defenses 2 and 4-6 (Answer, ¶¶ 8 and 10-12). Accordingly, affirmative defenses 1-2 and 4-6 are hereby STRICKEN from applicant's answer. Applicant is allowed until **TWENTY DAYS** from the date of this order to replead, with particularity, the affirmative defenses of laches and acquiescence; however, as noted in footnote 4, such affirmative defenses may be futile.⁵ If applicant wishes to

⁴ Moreover, the defenses of laches and acquiescence start to run from the time the involved application is published for opposition, and therefore, these defenses are severely limited in opposition proceedings. See TBMP § 311.02(b); see also *National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Barbara's Bakery*, 82 USPQ2d at 1292 n.14 (noting that amendment of applicant's answer to assert defenses of laches, acquiescence or estoppel would be futile as such defenses generally are not available opposition proceedings).

⁵ If applicant is not aware of any facts to support an affirmative defense of laches or acquiescence, it may move to

plead abandonment, it must seek leave of the Board to file an amended answer setting forth appropriate counterclaims supported by well-pleaded factual matter. Counterclaims that the pleaded registrations are *void ab initio* based on a lack of *bona fide* use are not available because these registrations were more than five years old as of the date that this proceeding was commenced. See 15 U.S.C. § 1064(3); see also TBMP § 307.02.

With respect to opposer's motion to suspend, the Board considers the motion to strike as having tolled the deadlines in this proceeding. Accordingly, opposer's motion to suspend is moot.

Disclosure, discovery, trial and other dates are reset as follows:

Expert Disclosures Due	4/4/2014
Discovery Closes	5/4/2014
Plaintiff's Pretrial Disclosures	6/18/2014
Plaintiff's 30-day Trial Period Ends	8/2/2014
Defendant's Pretrial Disclosures	8/17/2014
Defendant's 30-day Trial Period Ends	10/1/2014
Plaintiff's Rebuttal Disclosures	10/16/2014
Plaintiff's 15-day Rebuttal Period Ends	11/15/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits,

amend its answer promptly after such facts, if any, become known through discovery. See TBMP § 313.04.

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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.
