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September 3, 2013

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VIA E-MAIL

Christen M. English, Esq.
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

Re: Intercast Europe S.r.l. v. T H K Photo Products, Inc. - Opposition No. 91/210,772
Client-Matter No.: 129004.00004

Dear Ms. English:

We represent the Applicant in the present Opposition. On July 30, 2013, Applicant and Opposer met by phone to participate in the discovery conference required by TBMP 401.01. Applicant believed the conference ended on a positive note, including a discussion of possible limitations on use and/or registration to avoid the likelihood of consumer confusion, and Applicant was optimistic that a settlement could be reached.

During the conference call, counsel for Opposer had demanded that Applicant withdraw numerous affirmative defenses, and I explained that Applicant prefers to reserve these defenses until thorough discovery has been conducted to determine their appropriateness. Our position seems prudent in that once Applicant withdraws an affirmative defense, the right to assert that defense later in the proceeding would be lost.

Despite our reasonable position, on August 14, 2013, Opposer wrote to Applicant and once again demanded withdrawal of nearly all affirmative defenses asserted in this proceeding. Unfortunately, Opposer's letter did not include any discussion of settlement. Thereafter, Opposer initiated this conference.



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As a preliminary matter, 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.”

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

However, the defense of abandonment asserted in Paragraph 10 of Applicant’s Answer is an appropriate affirmative defense. 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. Opposer’s letter states, “Plainly, this “Affirmative Defense is improper...” but 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.

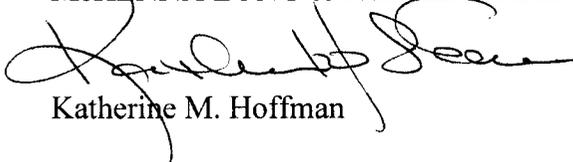
The same is true of Opposer’s demand that Applicant not question whether Opposer has used its marks in interstate commerce, which is the subject of Paragraph 11. Applicant believes it is entitled to discover evidence of whether and to what extent Opposer has abandoned its rights and has used its marks in commerce – in order to determine whether Opposer in fact has the rights it asserts.

Regarding laches, Opposer states that “laches and acquiescence are not available in opposition proceedings,” while Opposer cites a case that states laches, acquiescence or estoppel are *generally* not available in opposition proceedings. However, laches, estoppel, acquiescence are listed affirmative defenses in Rule 8(c) of the Federal Rules of Civil Procedure. Once again, Applicant, should be provided the opportunity to discover when Opposer received notice of Applicant’s mark, and any related evidence that provide Opposer’s 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.

Sincerely,

McKENNA LONG & ALDRIDGE LLP



Katherine M. Hoffman

KMH/JCD

cc: Ralph H. Cathcart, Esq.