ESTTA Tracking number: **ESTTA560159**
Filing date: **09/18/2013**

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

Proceeding	91210772
Party	Plaintiff Intercast Europe S.r.l.
Correspondence Address	Ralph H Cathcart Ladas Parry LLP 1040 Avenue of the Americas New York, NY 10018 3738 UNITED STATES rcathcart@ladas.com,rroa@ladas.com,mmercado@ladas.com
Submission	Other Motions/Papers
Filer's Name	Ralph H. Cathcart
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Signature	/Ralph H. Cathcart/
Date	09/18/2013
Attachments	9-18-2013 Letter to Interlocutory Attorney Christen English - T H K Photo Products.pdf(222564 bytes) Corrected Version - Opposer's Motion to Strike Applicant's Affirmative Defenses - THK Photo.pdf(1164555 bytes) Declaration of Ralph H. Cathcart - THK Photo.pdf(2104056 bytes)

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September 18, 2013

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

E-mail: christen.english@uspto.gov

Re: Intercast Europe S.r.l. v. T H K Photo Products, Inc. – Opposition No. 91/210,772 (Our Ref: C13650025)

Dear Ms. English:

We just learned today that there was a typographical error on the first line of the first paragraph of Opposer's Motion to Strike Applicant's Affirmative Defenses. Despite the caption properly identifying Opposer as Intercast Europe S.r.l., in the first paragraph, the typographical error erroneously refers to T H K Photo Products, Inc. as the Opposer. In all other instances, including on the ESTTA cover sheet, the remainder of the legal brief and supporting Declaration of Ralph H. Cathcart, Opposer is appropriately idenfied.

Accordingly, we are simultaneously filing a corrected version today with the Board and have copied Applicant both by e-mail and FEDEX.

We regret any confusion.

Respectfully submitted,

Ralph H. Cathcart

Ralph H. Cathcart
Attorney for Opposer

RHC/rmr
Enclosures

cc: **VIA E-MAIL and FEDEX**
Katherine M. Hoffman, Esq.

E-mail: KHoffman@MckennaLong.com

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **1) LETTER TO INTERLOCUTORY ATTORNEY CHRISTEN M. ENGLISH, ESQ.; 2) CORRECTED OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES; and 3) DECLARATION OF RALPH H. CATHCART, ESQ.** are being electronically transmitted to the United States Patent and Trademark Office on the date indicated below:

Dated: September 18, 2013

Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **1) LETTER TO INTERLOCUTORY ATTORNEY CHRISTEN M. ENGLISH, ESQ.; 2) CORRECTED OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES; and 3) DECLARATION OF RALPH H. CATHCART, ESQ.** were served by FEDEX overnight courier, postage prepaid, to the following person:

Katherine M. Hoffman, Esq.
McKenna Long & Aldridge LLP
600 West Broadway, Suite 2600
San Diego, CA 921101-3372

Tel: (619) 533-7392
E-mail: KHoffman@MckennaLong.com

Dated: September 18, 2013

Reinaldo M. Roa

CORRECTED VERSION

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

INTERCAST EUROPE S.r.l.,		
Opposer,		Opposition No. 91/210,772
v.		Serial No. 85/718,687
T H K PHOTO PRODUCTS, INC.,		
Applicant.		

OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Opposer, Intercast Europe S.r.l. ("Opposer"), moves pursuant to Fed. R. Civ. P. 12(f) to strike Applicant's Affirmative Defenses plead in its Answer ("Answer").

BACKGROUND

On or about May 22, 2013, Opposer timely filed with the Board a Notice of Opposition seeking to oppose Applicant's NXT Application No. 85/718,687. On or about July 7, 2013, Applicant filed its Answer and plead six separate "Affirmative Defenses", as set forth in paragraphs 7 through 12 of Applicant's Answer. Declaration of Ralph H. Cathcart ("Cathcart Dec'l."), Exh. A. Specifically, the relevant portion of Applicant's Answer reads as follows:

AFFIRMATIVE DEFENSES

> 7. Applicant asserts the Opposer has failed to allege grounds sufficient to establish its standing to maintain the present opposition.
>
> 8. Applicant asserts the Opposer as [*sic*] failed to state sufficient grounds for maintaining an opposition and prevent registration of Applicant's mark.
>
> 9. Applicant asserts that Opposer's requested relief should be denied because there is no likelihood of confusion between Opposer's use, if any, and Applicant's proposed use.

10. Applicant asserts that Opposer's requested relief should be denied as to the extent Opposer has ever owned any enforceable rights in and to the NXT mark, because such rights have been abandoned.

11. Applicant asserts that Opposer's requested relief should be denied because Opposer has failed to use the NXT mark in interstate commerce.

12. Applicant asserts that Opposer's requested relief should be denied as claims are barred due to laches and/or acquiescence by Opposer given the unreasonable delay in asserting its rights.

See Answer at Cathcart Dec'l., Exh. A.

During the discovery/settlement conference held by and between the respective parties' counsel on July 31, 2013, Opposer's counsel specifically requested that the aforementioned Affirmative Defenses be withdrawn to narrow the issues, given that they were not well grounded in law. Applicant's counsel declined and the parties agreed to confer with the assigned Interlocutory Attorney on the matter. (Cathcart Dec'l. ¶ 5) By letter dated August 14, 2013, Opposer again requested that Applicant's Affirmative Defenses be voluntarily withdrawn in order to narrow the scope of legitimate issues in dispute. (Cathcart Dec'l. ¶ 6, Exh. B.) The respective Parties' counsel then engaged in a telephone conference with the assigned Interlocutory Attorney, Christen M. English Esq., on September 4, 2013.

As a result of the conference, the Board issued an Order on September 5, 2013 providing Opposer 10 days to either elect to have Opposer's August 14, 2013 letter serve as a Motion to Strike or to file a more formal Motion to Strike with the Board. (Cathcart Dec'l. ¶¶ 8-9, Exh. D) Opposer has elected to file a formal Motion to Strike.

ARGUMENT

I.

The Board should strike all of Applicant's expressly titled and plead "Affirmative Defenses" as they are each either insufficient, redundant, or immaterial.

Fed. R. Civ. P. 12(f) provides in relevant part:

> "**Motion to Strike**. The Court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. The Court may act: 1) on its own; or 2) on motion made by a party" (Emphasis added)

The "Board grants motions to strike in appropriate cases". *See* TBMP § 506.02 [citations omitted]. Groundless Affirmative Defenses are struck where they are insufficient, redundant or immaterial. Further, it is appropriate to strike matter to "remove unnecessary clutter from the case". *See, Heller Financial, Inc. v. Midwhey Powder Co., Inc.*, 883 F.2d 1286, 1294 (7th Cir. 1989).

Thus, as discussed *infra*, Applicant's six "Affirmative Defenses" set forth at ¶¶ 7 through 12 of Applicant's Answer must be stricken.[1] Opposer shall address each of Applicant's "Affirmative Defenses" separately below.

A. Paragraph 7. "Applicant asserts the Opposer has failed to allege grounds sufficient to establish its standing to maintain the present opposition".

Applicant's first "Affirmative Defense" at ¶ 7 of its Answer claims that Opposer has failed to establish its standing in this opposition proceeding. Neither failure to state a claim nor a lack of standing are valid affirmative defenses. *See, e.g., Hornblower & Weeks Inc. v. Hornblower & Weeks Inc., 60 U.S.P.Q.2d 1733, 1738, n. 7 (TTAB 2001)*. Further, Opposer, the

1 Although Opposer is seeking to strike all six Affirmative Defenses, Applicant has already agreed to withdraw its First Affirmative Defense (¶ 7 of its Answer) in a letter copied to Opposer's counsel on September 3, 2013 (Cathcart Dec'l. ¶ 7, Exh. C)

owner of prior common law rights and incontestable registrations for NXT, plainly has a "real interest in the proceedings" and a "reasonable basis for believing it will suffer damage" if Applicant's identical applied-for NXT mark for identical or closely related goods issues to registration. *See, e.g., Ritchie v. Simpson*, 170 F.2d 1092, 1094 (Fed. Cir. 1999). (Opposer must have "a real interest in the proceedings" and "a reasonable basis for believing that it will suffer damage if the mark is registered".)

Accordingly, Opposer respectfully requests that the Board strikes Applicant's First Affirmative Defense set forth at ¶ 7 of its Answer for the reasons set forth above.

B. Paragraph 8. "Applicant asserts the Opposer as [*sic*] failed to state sufficient grounds for maintaining an opposition and prevent registration of Applicant's mark".

For the reasons set forth at ¶ A above, Opposer likewise respectfully requests that the Board strike Applicant's Second Affirmative Defense at ¶ 8 of its Answer.

Alternatively, the Board may also strike Applicant's Second Affirmative Defense (¶ 8 of its Answer) since the Board may treat Opposer's Rule 12(f) motion as testing the sufficiency of Applicant's purported affirmative defense prior to trial. *See, e.g., Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995).

In order to withstand a Motion to Dismiss for failure to state a claim upon which relief can be granted, an Opposer need only allege such facts as would, if proved, establish that 1) the Opposer has standing to maintain the proceeding and 2) a valid ground exists for opposing registration. *See, Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 104, 213 U.S.P.Q. 185 (CCPA 1982). Moreover,

> "for purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Opposer's well-pleaded allegations must be accepted as true, and the notice of opposition must be construed in the light most

> favorable to opposer . . . dismissal for insufficiency is appropriate only if it appears certain that the Opposer is entitled to no relief under any set of facts which could be proved or supported as claimed." [citations omitted] (Emphasis added)

Id. at Order Sons of Italy in America, 36 U.S.P.Q.2d at 1222-1223. Thus, Applicant's Second Affirmative Defense (¶ 8 of its Answer) must be stricken as insufficient and/or redundant.

C. Paragraph 9. "Applicant asserts that Opposer's requested relief should be denied because there is no likelihood of confusion between Opposer's use, if any, and Applicant's proposed use."

Applicant's Third Affirmative Defense (¶ 9 of its Answer) that "there is no likelihood of confusion" is not an Affirmative Defense at all, and must be stricken.

Indeed, an affirmative defense assumes the allegations in the Notice of Opposition are true, but nevertheless constitutes a viable defense to the Notice of Opposition. Thus, an affirmative defense does not negate the elements of the cause of action; rather, it is an explanation that otherwise bars the claim. *See, e.g., Gwin v. Curry*, 161 F.R.D. 70, 71 (N.D. Ill. 1995) ("basic notion that an [affirmative defense] should accept rather than contradict well-pleaded allegations of the complaint remains valid.") Here, Applicant's Third Affirmative Defense (¶ 9 of its Answer) impermissibly seeks to contradict Opposer's well-pleaded likelihood of confusion claims in the Notice of Opposition by alleging there is no "likelihood of confusion" between the parties' respective NXT marks.

Further, Applicant's Third Affirmative Defense (¶ 9 of its Answer) must likewise be stricken because it is redundant. Applicant already "Denied" Opposer's claims of likelihood of confusion earlier in its Answer at ¶¶ 4-6 thereof. (Cathcart Dec'l., Exh. A). *See, e.g., Order Sons of Italy in America,* 36 U.S.P.Q.2d at 1223. (Since applicant denied earlier in its answer opposer's allegation of disparagement, Board struck applicant's affirmative defense that merely

restated that denial as redundant.) Accordingly, Applicant's Third Affirmative Defense (¶ 9 of its Answer) must be stricken as insufficient and redundant.

D. Paragraph 10. "Applicant asserts that Opposer's requested relief should be denied as to the extent Opposer has ever owned any enforceable rights in and to the NXT marks, because such rights have been abandoned".

Applicant's Fourth Affirmative Defense at ¶ 10 of its Answer must be stricken as an impermissible attack on Opposer's pleaded incontestable NXT Registrations. *See* generally, TBMP § 313. *See* also, 37 C.F.R. § 2.106, which provides in relevant part:

> "When a defense attacks the validity of a registration pleaded in an opposition, ¶ b(2) of this section shall govern.
>
> * * *
>
> (2)(i)
>
> A defense attacking the validity of any one of more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for counterclaim exist at the time when the Answer is filed. If grounds for a counterclaim are known to the Applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer.
>
> * * *

See also, *Continental Gummi-Werke AG v. Continental Steel Corp.*, 222 U.S.P.Q. 822, 825 (TTAB 1984) (affirmative defense was "in effect, a collateral attack on the validity of the registrations" and therefor struck.)

Here, Applicant has affirmatively attacked the validity of Opposer's pleaded NXT registrations with its Fourth "Affirmative Defense" (¶ 10 of its Answer) by affirmatively alleging abandonment of Opposer's pleaded NXT Marks.

Thus, Applicant has alleged, in a pleading filed with the Board and certified by counsel as true, that Applicant is aware of circumstances that show that Opposer has abandoned its NXT

Marks. Applicant does not make its abandonment claim "upon information and belief" but rather, alleges abandonment of Opposer's NXT Marks unequivocally.

Now, in an effort to justify its improper "Affirmative Defenses", Applicant misconstrues the difference between having the initial right to take discovery concerning the nature of the use of Opposer's marks in order to find evidence of some viable defense and the mandatory requirement that Applicant file a compulsory counterclaim where it claims to be aware of circumstances that justify attacking the validity of Opposer's pleaded registrations. *See* Cathcart Dec'l., Exh. C.

Indeed, in *Neville Chemical Company v. The Lucasoil Corp.*, 183 U.S.P.Q. 183, 187, the Board instructively stated "an improper attack upon an Opposer's pleaded registration exists only when the Applicant asserts affirmatively that Opposer's registration is invalid for certain specified reasons, but fails to couple such assertion with a counterclaim for cancellation thereof". (Emphasis added.) *Id.*

In *Lucasoil Corp.*, the Board was making the point that taking discovery that may lead to admissible evidence "concerning matters constituting grounds, such as abandonment, for a counterclaim for cancellation of opposer's pleaded registrations" would not in and of itself be construed as "an attack upon any registration". *Id.* Conversely, this is not the case here, where Applicant has already affirmatively pleaded abandonment as an Affirmative Defense in its Answer. *Cf., Johnson & Johnson v. Rexall Drug Co.*, 186 U.S.P.Q. 167, 171, where the Board instructively stated

> "[m]oreover, the mere taking of discovery on matters concerning the validity of an opposer's registration does not constitute a defense "otherwise raised" in a proceeding within the meaning of Trademark Rule 2.106(c). Rather, a defense is

raised when it is actually affirmatively asserted, as for example in a party's pleading".[2]

Thus, Applicant's Fourth Affirmative Defense (¶ 10 of its Answer) must be stricken as insufficient and immaterial.

E. Paragraph 11. "Applicant asserts that Opposer's requested relief should be denied because Opposer has failed to use the NXT Mark in interstate commerce".

Applicant's Fifth Affirmative Defense at ¶ 11 of its Answer must likewise be stricken since it again involves an affirmative attack on the validity of Opposer's NXT Marks. Further, since Opposer's incontestable NXT Registrations were obtained by filing Statements of Use and subsequent Affidavits establishing continuous and uninterrupted use in commerce, Applicant's illogical putative Affirmative Defense calling into question Opposer's use of its NXT Mark in "interstate" commerce provides no cognizable Affirmative Defense to Opposer's Notice of Opposition and must be struck as insufficient and immaterial.

F. Paragraph 12. "Applicant asserts that Opposer's requested relief should be denied as [*sic*] claims are barred due to laches and/or acquiescence by Opposer given the unreasonable delay in asserting its rights".

It is well settled that the defense of laches and/or acquiescence is not viable in TTAB proceedings. *See, e.g., National Cable Television Association v. American Cinema Editors, Inc.*, 937 F2d. 1572, 19 U.S.P.Q.2d 1424, 1432 (Fed. Cir. 1991); *Bausch & Lomb, Inc. v. Carlstars GmbH & Co. Kg.*, 87 U.S.P.Q.2d 1526, 1531 (TTAB 2008); and *Barbara's Bakery, Inc. v. Lindeman*, 82 U.S.P.Q.2d 1283, 1292, n. 14 (TTAB 2007) ("Defenses of laches, acquiescence or estoppel are not available in opposition proceedings".)

---

2 Applicant cannot have it both ways and unequivocally plead improper affirmative defenses and then argue it needs to take discovery to see if its own affirmative defenses are even viable.

Plainly, Applicant cannot establish a claim of laches or acquiescence in this Opposition proceeding since Opposer timely opposed Applicant's applied-for NXT mark once it was published in the Gazette. (Cathcart Dec'l., ¶ 11, Exh. E.) Accordingly, Opposer respectfully requests that Applicant's Sixth putative Affirmative Defense at ¶ 12 of its Answer be stricken as insufficient and immaterial.

II

STAY OF DISCOVERY

As discussed in the conference with the assigned Interlocutory Attorney and Applicant's counsel, Opposer respectfully requests a stay of discovery in this case until such time as a decision is rendered by the Board. This is because the decision by the Board will directly affect the scope and nature of each party's discovery. (Cathcart Dec'l., ¶ 8.) Opposer certainly would not engage in robust discovery aimed at refuting Applicant's Affirmative Defenses if they were properly stricken. *Id.* Thus, a stay of discovery would avoid duplicative and unnecessary discovery and motion practice before the Board, would serve the interest of judicial economy and reduce legal fees. There can be no legitimate claim of prejudice, since as of this date, neither party has taken any discovery (Cathcart Dec'l. ¶ 10.) and proceedings are in its infancy.

For all of the above reasons, Opposer respectfully requests that the Board strike Applicant's six "Affirmative Defenses" and stay discovery and suspend proceedings, pending a decision by the Board.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Opposer

Dated: September 12, 2013

By: Ralph H. Cathcart

Ralph H. Cathcart
1040 Avenue of the Americas
New York, NY 10018
(212) 708-1920
(Our Ref: C13650025)

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S 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: September 12, 2013

Reinaldo M. Roa

CERTIFICATE OF SERVICE

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

Katherine M. Hoffman, Esq.
McKenna Long & Aldridge LLP
600 West Broadway, Suite 2600
San Diego, CA 921101-3372

Tel: (619) 533-7392
E-mail: KHoffman@MckennaLong.com

Dated: September 12, 2013

Reinaldo M. Roa

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

INTERCAST EUROPE S.r.l.,	:	
Opposer,	:	Opposition No. 91/210,772
v.	:	Serial No. 85/718,687
T H K PHOTO PRODUCTS, INC.,	:	
Applicant.	:	

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 support of Opposer's Motion to Strike Applicant's Affirmative Defenses and a stay of discovery and suspension of proceedings.

2. Opposer timely filed its Notice of Opposition against Applicant's NXT Application No. 85/718,687 on May 22, 2013.

3. On or about July 2, 2013, Applicant filed its Answer, which included six separate defenses, denominated "Affirmative Defenses". A copy of Applicant's Answer is attached hereto as Exhibit A.

4. On July 31, 2013 counsel for the respective parties held the mandatory discovery/settlement conference and discussed numerous settlement and discovery related issues.

5. During the discovery/settlement conference, Opposer's counsel specifically requested that Applicant withdraw its Affirmative Defenses as they were not well grounded in

law. Since Applicant's counsel refused, Opposer's counsel proposed that we refer the matter to the assigned Interlocutory Attorney to narrow the issues and Applicant's counsel agreed.

6. By letter dated August 14, 2013 (a copy is attached as Exhibit B), Opposer's counsel made one last attempt to persuade Applicant to voluntarily withdraw its Affirmative Defenses. When no reply was forthcoming, Opposing counsel filed a letter with the Board, addressed to the assigned Interlocutory Attorney seeking a conference to resolve these issues.

7. On or about September 3, 2013, Applicant's counsel copied Opposer's counsel with a letter (not filed with the Board) declining to withdraw 3 of Applicant's Affirmative Defenses (¶¶ 10, 11 and 12 of Applicant's Answer), but agreeing to withdraw Applicant's First Affirmative Defense (¶ 7 of its Answer) attacking Opposer's standing. A copy is attached hereto as Exhibit C.

8. During the conference with the assigned Interlocutory Attorney on September 4, 2013, Opposer's counsel requested that the Board strike the unfounded Affirmative Defenses so as to narrow the issues, so both parties could focus on legitimate issues relevant to this Opposition proceeding, thereby minimizing unnecessary discovery, motion practice, judicial intervention by the Board, incursion of attorney's fees and burden on potential witnesses. Opposing counsel also requested a stay of discovery pending the decision by the Board since the decision would bear directly on the scope of discovery to be pursued by the parties.

9. The assigned Interlocutory Attorney stated that (i) Opposer's August 14, 2013 letter could be deemed Opposer's Motion to Strike or, (ii) Opposer could file a more formal motion, and (iii) Opposer should put its request for a stay of discovery in the motion. A copy of the Board's Order dated September 5, 2014 is annexed hereto as Exhibit D.

10. Although each party has served Initial Disclosures, Opposer has not served any discovery upon Applicant and to this date Opposer has received no discovery requests from Applicant.

11. Opposer's counsel and Opposer only learned of Applicant's applied-for NXT mark when it was published for opposition in the Gazette. See Nathan Troxell Declaration at Exhibit E.

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

Executed on September 12, 2013 in New York, New York.

Ralph H. Cathcart

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: September 12, 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:

Katherine M. Hoffman, Esq.
McKenna Long & Aldridge LLP
600 West Broadway, Suite 2600
San Diego, CA 921101-3372

Tel: (619) 533-7392
E-mail: KHoffman@MckennaLong.com

Dated: September 12, 2013

Reinaldo M. Roa

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re:

Applicant's Mark:	NXT
Serial No.:	85/718,687
Filed:	August 31, 2012
Published:	In the Official Gazette on February 5, 2013

INTERCAST EUROPE S.r.l.,	)	Opposition No. 91210772
	)	
Opposer,	)	**ANSWER TO NOTICE OF OPPOSITION**
	)	
v.	)	
	)	
THK PHOTO PRODUCTS, INC.,	)	
	)	
Applicant.	)	
	)	

Applicant Kenko Tokina USA, Inc., formerly THK Photo Products, Inc. ("Applicant"), hereby answers the Notice of Opposition filed by Intercast Europe S.r.l. ("Opposer") as follows, wherein numbered paragraphs correspond to the like numbered paragraphs in the Notice of Opposition.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of paragraph 1 averments, and therefore denies same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of paragraph 2 averments, and therefore denies same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of paragraph 3 averments, and therefore denies same.

4. Denied.

5. Denied.

6. Denied.

AFFIRMATIVE DEFENSES

7. Applicant asserts the Opposer has failed to allege grounds sufficient to establish its standing to maintain the present opposition.

8. Applicant asserts the Opposer as failed to state sufficient grounds for maintaining an opposition and prevent registration of Applicant's mark.

9. Applicant asserts that Opposer's requested relief should be denied because there is no likelihood of confusion between Opposer's use, if any, and Applicant's proposed use.

10. Applicant asserts that Opposer's requested relief should be denied as to the extent Opposer has ever owned any enforceable rights in and to the NXT mark, because such rights have been abandoned.

11. Applicant asserts that Opposer's requested relief should be denied because Opposer has failed to use the NXT mark in interstate commerce.

12. Applicant asserts that Opposer's requested relief should be denied as claims are barred due to laches and/or acquiescence by Opposer given the unreasonable delay in asserting its rights.

WHEREFORE, Applicant requests that the present opposition be dismissed with prejudice so that Applicant's application can proceed to mature into a registration.

Dated: July 1, 2013

Respectfully submitted,

Katherine M. Hoffman
McKenna Long & Aldridge LLP
4435 Eastgate Mall, Suite 400
San Diego, California 92121
Tel: (619) 533-7392
Email: khoffman@mckennalong.com

Attorney for Applicant
Kenko Tokina USA, Inc.
(formerly THK Photo Products, Inc.).

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 July 1, 2013, I served the foregoing document(s) described as:

ANSWER TO NOTICE OF OPPOSITION

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

Ralph H. Cathcart
Ladas & Parry LLP
1040 Avenue of the Americas
New York, NY 10018
Tel. No. (212) 708-1920
Email: rcathcart@ladas.com
Attorneys for Opposer
Intercast Europe S.r.l.

[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 July 1, 2013, at San Diego, California.

California C. Lopez

California C. Lopez

ESTTA Tracking number: **ESTTA546118**

Filing date: **07/01/2013**

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.
Correspondence Address	KATHERINE M. HOFFMAN MCKENNA LONG & ALDRIDGE LLP 600 W BROADWAY STE 2600 SAN DIEGO, CA 92101-3372 khoffman@mckennalong.com;mlaip@mckennal
Submission	Answer
Filer's Name	Katherine M. Hoffman
Filer's e-mail	khoffman@mckennalong.com, clopez@mckennalong.com, mlaip@mckennalong.com
Signature	/kmh/
Date	07/01/2013
Attachments	NXT Answer img-701121247-0001.pdf(145370 bytes)

EXHIBIT B

LADAS & PARRY LLP
INTELLECTUAL PROPERTY LAW

Ralph H. Cathcart rcathcart@ladas.com
212.708.1920

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August 14, 2013

VIA E-MAIL
Katherine M. Hoffman, Esq. E-mail: KHoffman@MckennaLong.com
McKenna Long & Aldridge LLP
600 West Broadway, Suite 2600
San Diego, CA 921101-3372

Re: Intercast Europe S.r.l. v. T H K Photo Products, Inc.- 91/210,772 (Our Ref: C13650025)

Dear Ms. Hoffman:

As per our discussion on July 31, 2013 during the Discovery/Settlement Conference mandated by the Board's Institution Order, we are following up on the open issue relating to our joint stated willingness to confer with the assigned Interlocutory Attorney regarding the propriety of your client's Affirmative Defenses in order to narrow the issues.

Kindly let us know whether your client will voluntarily withdraw its Affirmative Defenses for the reasons discussed or if we should conclude the Discovery/Settlement Conference by scheduling a telephonic conference with the assigned Interlocutory Attorney.

To avoid any doubt, following are our comments regarding Applicant's unnumbered "Affirmative Defenses":

Applicant's Affirmative Defenses

Paragraph 7: Applicant claims that Opposer has failed to sufficiently state a claim upon which relief can be granted and to establish its standing in the present opposition. Failure to sate a claim and lack of standing is not an affirmative defense. *See, e.g., Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1738, n. 7 (TTAB 2001). Further, Opposer is the owner of prior common law rights and incontestable registrations for NXT and your client seeks registration for the identical NXT mark for closely related products. Thus, Opposer has 1) "a real interest in the proceeding and 2) a reasonable basis for believing that it will suffer damage if the mark is registered. *Ritchie v. Simpson*, 170 F.2d 1092, 1094 (Fed. Cir. 1999). Kindly confirm that your client will withdraw this alleged affirmative defense.

Paragraph 8: Applicant asserts as an affirmative defense that "Opposer as [*sic*] failed to state sufficient grounds for maintaining an opposition and prevent registration of Applicant's mark". *See* response to affirmative defense at paragraph 7. This again implicates Opposer's standing.

Paragraph 10: Applicant alleges as an affirmative defense that Opposer has never owned any enforceable rights in NXT marks, because such rights have been abandoned. Plainly, this Affirmative Defense is improper and Opposer's registrations cannot be attacked by way of Affirmative Defense. Please confirm that your client will withdraw this affirmative defense. *See* also TBMP § 313.

Paragraph 11: Applicant's alleges as an affirmative defense that "Opposer's requested relief should be denied because Opposer has failed to use the NXT mark in interstate commerce". This Affirmative Defense must be stricken as Opposer is the owner of several NXT trademarks, including incontestable NXT trademarks, and has filed affidavits of use in support thereof.

Paragraph 12: Applicant asserts a "laches and/or acquiescence" affirmative defense. The Affirmative Defense of laches and acquiescence are not available in opposition proceedings. *See, e.g.*, *National Cable Television Association v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 U.S.P.Q.2d 1424, 1432 (Fed. Cir. 1991); *Bausch & Lomb, Inc. v. Karl Starz GmbH & Co. KG*, 87 U.S.P.Q.2d 1526, 1531 (TTAB 2008); and *Barbara's Bakery Inc. v. Lindeman*, 82 U.S.P.Q.2d 1283, 1292, n.14 (TTAB 2007) (Defenses of laches, acquiescence or estoppel generally not available in opposition proceeding).

Your prompt response is required failing which we will contact the Interlocutory Attorney to schedule a conference.

Very truly yours,

Ralph H. Cathcart

RHC/rmr

EXHIBIT C

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KATHERINE M. HOFFMAN

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September 3, 2013

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.

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 it 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 it 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.

EXHIBIT D

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

CME

Mailed: September 5, 2013

Opposition No. 91210772

Intercast Europe S.r.l.

v.

T H K Photo Products, Inc.

Christen M. English, Interlocutory Attorney:

On August 20, 2013, opposer filed a letter indicating that the parties held the required discovery conference on July 31, 2013, but that they were unable to complete the conference due to disagreements concerning the propriety of applicant's affirmative defenses. On September 4, 2013, the Board held a telephone conference to address opposer's August 20, 2013 filing. Ralph Cathcart appeared on behalf of opposer, Katherine Hoffman and Jamie Danaher appeared on behalf of the Board, and the interlocutory attorney assigned to the case conducted the conference.

The Board informed the parties that it construes opposer's August 20, 2013 filing not as a request for Board participation in the required discovery conference, but as a request that the Board hear an oral motion to strike certain of applicant's affirmative defenses. The Board explained that because of the nature of applicant's affirmative

defenses, the Board will not decide a motion to strike on the telephone. Accordingly, opposer is allowed **until TEN DAYS from the mailing date of this order** to file a more standard motion to strike or to file a paper stating that it wishes the Board to treat its August 20, 2013 filing as a motion to strike. Applicant's deadline to respond to any motion to strike will run from the date that opposer files a response to this order. *See* Trademark Rule 2.127(a). If opposer fails to respond to this order, its August 20, 2013 filing will be given no further consideration.

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EXHIBIT E

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

INTERCAST EUROPE S.r.l., Opposer,	:	Opposition No. 91/210,772
v.	:	Serial No. 85/718,687
T H K PHOTO PRODUCTS, INC., Applicant.	:	

DECLARATION OF NATHAN TROXELL

I, Nathan Troxell, declare that the following is true and correct pursuant to 28 U.S.C. §1746.

1. I am the Global Marketing Manager, Optical Materials, PPG Industries, Inc. Intercast Europe S.r.l., the Opposer in this Opposition Proceeding, is a wholly-owned affiliate of PPG Industries, Inc.

2. I am personally familiar with, knowledgeable and responsible for the NXT Mark in the United States.

3. On or about February 5, 2013, Applicant's NXT Application No. 85/718,687 was published for Opposition in the Gazette. Until such date, neither Intercast nor PPG Industries had any knowledge of Applicant's intention to file an intent-to-use application for NXT.

4. Opposer timely filed a Notice of Opposition against the applied-for NXT Mark once Opposer learned that it was published for Opposition.

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

Executed on September 11th, 2013 in Pittsburgh, Pennsylvania, UNITED STATES

Nathan Troxell