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Filing date: **09/18/2013**

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

|                        |   |
|------------------------|---|
| Proceeding             | 91211839  |
| Party                  | Plaintiff<br>Hickies, Inc.  |
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| Submission             | Motion to Strike  |
| Filer's Name           | Robert B. Golden  |
| Filer's e-mail         | rgolden@LSLLP.com, nsaraco@LSLLP.com  |
| Signature              | /Robert B. Golden/  |
| Date                   | 09/18/2013  |
| Attachments            | Motion to Strike.pdf(179543 bytes )   |

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

**Application Serial Nos.:** 85790385  
**Mark:** Hickies  
**International Class:** 14  
**Applicant:** Scarfware LLC  
**Date of Publication:** April 30, 2013

|                |                                  |
|----------------|----------------------------------|
| -----          | X                                |
| HICKIES, INC., | :                                |
|                | :                                |
| Opposer,       | :                                |
|                | :                                |
| v.             | : <b>Opposition No. 91211839</b> |
|                | :                                |
| SCARFWARE LLC, | :                                |
|                | :                                |
| Applicant.     | :                                |
| -----          | X                                |

**OPPOSER’S MOTION TO STRIKE and  
MEMORANDUM OF LAW IN SUPPORT THEREOF**

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and §506 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Opposer Hickies, Inc. (“Opposer”) hereby submits this Motion to Strike the Affirmative Defenses alleged in the Answer filed by Applicant Scarfware LLC (“Applicant”) in the above-referenced opposition proceeding.

**I. BACKGROUND**

Opposer’s Notice of Opposition asserted that it is the owner of U.S. Registration No. 4200125 (the “Registration”). Without filing a counterclaim for invalidity, Applicant attempted to attack the validity of the Registration. As explained below, such an attack is prohibited and the “Defenses” purporting to attack the Registration must be stricken.

## II. ARGUMENT

### a. **Applicant's Attack on Opposer's Registration by a "Defense" Rather Than a Counterclaim is Impermissible**

TBMP § 311.02(b) clearly provides that “[a]n attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.” 37 CFR § 2.106(b)(2)(ii). Out of ignorance or in an attempt to avoid paying the required \$300 governmental fee associated with filing a counterclaim, Applicant sought to attack the validity of the Registration through an affirmative defense. Applicant has not filed a counterclaim or separate petition for cancellation. Accordingly, pursuant to TBMP § 311.02(b) and 37 CFR § 2.106(b)(2)(ii), Applicant's defenses attacking the validity of the registration must be stricken. In as much as the counterclaim to cancel the Registration was compulsory, because the alleged grounds for such a counterclaim existed at the time of filing the Answer and were known to Applicant (as evidenced by the defenses)(see TBMP § 313.04 and 37 CFR § 2.106(b)(2)(i)), and Applicant did not timely assert such a counterclaim, Applicant must be precluded from now amending its Answer to include such a counterclaim or from filing a separate petition to cancel. *Id*; *S & L Acquisition Company and Seligman & Latz, Inc. v. Helene Arpels, Inc.* 9 U.S.P.Q.2D (BNA) 1221, 1224 (T.T.A.B. 1987) (motion to amend answer to add additional grounds to existing counterclaim denied since such grounds were available at the time of filing the original answer). As TBMP § 313.04 explains, “[i]f the defendant knows the grounds for a counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the answer.”

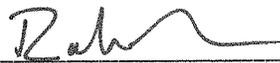
**III. CONCLUSION**

Opposer hereby requests that the Board grants its Motion to Strike and strikes Applicant's Affirmative Defenses attacking the Registration.

Dated: Scarsdale, New York  
September 18, 2013

Respectfully Submitted:

**LACKENBACH SIEGEL LLP**



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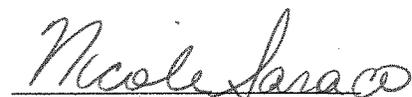
*Attorneys for Opposer*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of the enclosed **OPPOSER'S MOTION TO STRIKE and MEMORANDUM OF LAW IN SUPPORT THEREOF** was served on Applicant on September 18, 2013, via U.S. 1<sup>st</sup> Class Mail, addressed to counsel for Applicant as follows:

Nancy J. Flint, Esq.  
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1844 N. Nob Hill Road # 424  
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Dated: Scarsdale, New York  
September 18, 2013



Nicole Saraco