UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

Mailed: December 2, 2014

Opposition No. 91215049

Alliance Powersports Inc.

v.

Hammer Brand LLC d/b/a Wolf Brand Scooters

Andrew P. Baxley, Interlocutory Attorney:

In this proceeding, Alliance Powersports, Inc. ("Opposer") opposes registration of Hammer Brand LLC d/b/a Wolf Brand Scooters' ("Applicant") application to register the mark WOLF in standard character form for "Motor scooters; Motorized scooters; Motorized scooters and structural parts therefor" in International Class 12[1] on the ground of likelihood of confusion with Opposer's previously used mark WOLF for "scooters" under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Applicant, in its answer, denies the salient allegations of the notice of opposition and provides bases for its intended defense in the affirmative defenses section of the answer.

This case now comes up for consideration of Applicant's motion (filed October 2, 2014) to compel Opposer's Fed. R. 30(b)(6) to appear for a

[1] Application Serial No. 86037963, filed August 14, 2013, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and

discovery deposition and to produce all documents requested in the notice of that deposition and to extend the discovery period for Applicant only. The motion has been fully briefed.

In preparing this order, the Board reviewed the operative pleadings in this case and notes the following. In addition to the aforementioned Section 2(d) claim, Opposer pleads a fraud claim based on the allegation that "[u]pon information and belief, Applicant did not use Applicant's Mark in commerce ... during the filing of the Application." However, the fraud claim is insufficient because it is made upon information and belief with no allegation of any specific facts upon which the belief is based. *See Asian and Western Classics B.V. v. Selkow,* 92 USPQ2d 1478 (TTAB 2009). *See also In re Bose Corp.,* 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); Fed. R. Civ. P. 9(b). The Board *sua sponte* strikes paragraphs 14 through 19 from the notice of opposition.[2] *See* Fed. R. Civ. P. 12(f); TBMP § 506.01 (2014).

In paragraph 1 of Applicant's affirmative defenses, Applicant alleges that the notice of opposition fails to state "sufficient grounds upon which relief can be granted." In paragraph 11 of the Applicant's affirmative defenses, Applicant alleges that the "opposition is groundless." However, Applicant did not timely file a motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to

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alleging April 1, 2013 as the date of first use anywhere and date of first use in commerce.

[2] If Opposer wants to re-plead its intended fraud claim, it may file a motion for leave to file an amended notice of opposition. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02.

state a claim upon which relief can be granted.[3] *See Motion Picture Ass'n of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1557 n.5 (TTAB 2007). In any event, Opposer has adequately pleaded its standing in paragraphs 1 and 2 and its Section 2(d) claim in paragraphs 1 through 13 of the notice of opposition. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Accordingly, the Board *sua sponte* strikes paragraphs 1 and 11 of Applicant's affirmative defenses. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01 (2014).

In paragraph 2 of Applicant's affirmative defenses, Applicant asserts that "[t]here is no likelihood of confusion, mistake or deceit." However, this assertion is redundant of the denials of paragraphs 9 through 13 of the notice of opposition that is set forth in Applicant's answer. Accordingly, the Board *sua sponte* strikes paragraph 2 from Applicant's affirmative defenses. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01.

In paragraph 5 of Applicant's affirmative defenses, Applicant alleges that to the extent that Opposer has used the pleaded WOLF mark, "such use is not extensive." However, Opposer need not establish "extensive" use to prevail on its pleaded Section 2(d) claim. Rather, "'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made

[3] If Applicant genuinely believed that Opposer had failed to state a claim upon which relief can be granted, it should have filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6) prior to, or concurrently with, its answer. *See* TBMP § 503.

merely to reserve a right in a mark." Trademark Act Section 45, 15 U.S.C. § 1127. "An opposer claiming priority under Section 2(d) may rely on use that is strictly intrastate." *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 77 USPQ2d 1334, 1341 n.15 (TTAB 2005). Accordingly, the Board *sua sponte* strikes paragraph 5 from Applicant's affirmative defenses. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01.

In paragraph 6 of Applicant's affirmative defenses, Applicant alleges that Opposer's pleaded mark is not famous within the definition of Trademark Act Section 43(c), 15 U.S.C. § 1125(c). However, Opposer has not pleaded a Section 43(c) dilution claim in this case, and fame for Section 2(d) purposes and fame for Section 43(c) purposes are distinct concepts. *See Weider Publ'ns, LLC v. D&D Beauty Care Co.,* 109 USPQ2d 1347, 1353-54 (TTAB 2014). To the extent that Applicant asserting that Opposer's pleaded mark is not famous for Section 2(d) purposes, that assertion is redundant of the denial of paragraph 6 of the notice of opposition that is set forth in Applicant's answer. Accordingly, the Board *sua sponte* strikes paragraph 6 from the affirmative defenses of Applicant's answer. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01.

In paragraph 7 of Applicant's affirmative defenses, Applicant alleges that Opposer lacks standing to bring this proceeding. However, "[l]ack of standing is not an affirmative defense. Standing is an element of [Opposer's] claim. [Opposer] must prove standing as part of [its] case." *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011). Accordingly, the Board

sua sponte strikes paragraph 7 from the affirmative defenses of Applicant's answer.

In paragraphs 8 and 10 of Applicant's affirmative defenses, Applicant alleges that the opposition is barred by the doctrines of estoppel, waiver, laches, and/or unclean hands. However, these defenses are insufficient because Applicant has alleged no specific conduct upon which these defenses are based. *See Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987). Accordingly, the Board *sua sponte* strikes paragraphs 8 and 10 from the affirmative defenses of Applicant's answer. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01.

In paragraph 9 of Applicant's affirmative defenses, Applicant alleges that Opposer's pleaded mark has not acquired distinctiveness or secondary meaning. To prevail on a Section 2(d) claim, a plaintiff must establish "proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source, whether by ownership of a registration, prior use of a technical 'trademark,' prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity."[4] *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). Moreover, acquired distinctiveness (also known as secondary meaning)

[4] Opposer's pleaded mark and Applicant's involved mark are identical, and the marks are alleged to be used on legally overlapping goods.

becomes an issue only where the mark at issue is not inherently distinctive. *See* Trademark Act Sections 2(e)(1), 2(e)(2), 2(e)(4), and 2(f), 15 U.S.C. § 1052(e)(1), 1052(e)(2), 1052(e)(4), and 1052(f); *Two Pesos Inc. v. Taco Cabana Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992); *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *In re Slokevage*, 441 F.3d 957, 78 USPQ2d 1395 (Fed. Cir. 2006); *In re Chippendales USA Inc.*, 90 USPQ2d 1535 (TTAB 2009). Because establishing proprietary rights in the pleaded WOLF mark is part of Opposer's Section 2(d) claim (*cf. Blackhorse v. Pro Football Inc., supra*) and Applicant has not alleged that the pleaded mark is not inherently distinctive, the Board *sua sponte* strikes paragraph 9 from the affirmative defenses of Applicant's answer.

The remaining allegations in the affirmative defense section of Applicant's answer provide a fuller basis for Applicant's intended defense herein. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995). Accordingly, the Board will allow those allegations to remain in Applicant's answer.

Turning to the motion to compel, Applicant seeks to compel: (1) Opposer's appearance for a discovery deposition under Fed. R. Civ. P. 12(b)(6), and (2) Opposer's production of documents requested in the notice of the Rule 30(b)(6) deposition. The Board finds initially that, in view of Applicant's extensive efforts to schedule such deposition, that Applicant made a sufficient good faith effort to resolve the parties' discovery dispute prior to

seeking Board intervention as required by Trademark Rule 2.120(e)(1). *See HighBeam Marketing LLC v. Highbeam Research LLC*, 85 USPQ2d 1902, 1907 (TTAB 2008).

Nonetheless, Applicant served its notice of Opposer's Rule 30(b)(6) deposition on September 22, 2014 and filed its motion to compel on October 2, 2014, only ten days later. The parties could have, and should have, been more cooperative in seeking to resolve their disagreement regarding the scheduling of the discovery deposition of Opposer's Rule 30(b)(6) witness, including briefly extending the discovery period as Opposer's attorney proposed in a September 24, 2014 e-mail to Applicant's attorney, and/or allowing Opposer's Rule 30(b)(6) to appear remotely under Fed. R. Civ. P. 30(b)(4), as Opposer's attorney proposed in an October 15, 2014 letter to Applicant's attorney.

Opposer is located in Mira Loma, California, and its intended Rule 30(b)(6) witness works and resides in California. Under Trademark Rule 2.120(b), the deposition should have been noticed to take place "in the Federal judicial district where the [deponent] resides or is regularly employed or at any place on which the parties agree by stipulation." As such, Applicant's notice of Opposer's Rule 30(b)(6) deposition for Applicant's attorneys' offices in Cleveland, Ohio "or other location mutually agreed upon by the parties" is improper. *See* Trademark Rule 2.120(b). The Board will not compel Opposer's Rule 30(b)(6) witness to appear for his discovery deposition in a manner that contravenes Rule 2.120(b). Although the better practice

would have been for Opposer to have objected to the notice of deposition based on the proposed location of the deposition at issue immediately upon receipt of that notice, the Board finds that Opposer objected to the location of the Rule 30(b)(6) deposition in a sufficiently prompt manner in its brief in response to the motion to compel and that Opposer therefore did not waive that objection.

In addition, Applicant noticed Opposer's Rule 30(b)(6) deposition for October 20, 2014, twenty-eight days after the service of that notice by mail, and requested document production at that deposition. When requesting documents as part of a notice of discovery deposition, the deposing party must allow at least thirty days between the date of the request and the deposition (or thirty-five days if served by first-class mail or overnight courier) to comply with Fed. R. Civ. P. 34.[5] *See* TBMP § 404.05.

Finally, in the motion to compel, Applicant asks that it be awarded attorney's fees and costs in connection with that motion. So awarding would

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[5] To the extent that Opposer has withheld production of documents until a protective order is entered herein, Opposer filed a copy of a fully executed protective agreement on June 13, 2014, which the Board accepted in a June 19, 2014 order. Prior to such filing, the Board's standard protective order was operative herein. *See* Trademark Rule 2.116(g). Therefore, confidential documents should have been disclosed under whatever protective order was operative at the time of such disclosure.

Opposer is reminded that, as the plaintiff herein, it has the burden of establishing priority and likelihood of confusion by a preponderance of the evidence. *See L'Oreal S.A. v. Marcon,* 102 USPQ2d 1434, 1436 (TTAB 2012). In addition, the parties are reminded that each has a duty to correct or supplement its discovery responses as necessary and that failure to disclose properly requested information during discovery may, upon timely objection at trial, result in the exclusion of that information as trial evidence. *See* Fed. R. Civ. P. 26(e) and 37(c)(1).

be in contravention of Trademark Rule 2.127(f). Based on the foregoing, the motion to compel is denied in full.

To the extent that Applicant requests that the discovery period be extended for itself only, the Board finds that, under the circumstances herein, an extension of the discovery period for both parties is warranted.[6] *See* Fed. R. Civ. P. 6(b)(1)(A); TBMP § 509.01(a).

Proceedings herein are resumed. Remaining dates are reset as follows.

Expert Disclosures Due	**12/31/2014**
Discovery Closes	**1/30/2015**
Plaintiff's Pretrial Disclosures Due	**3/16/2015**
Plaintiff's 30-day Trial Period Ends	**4/30/2015**
Defendant's Pretrial Disclosures Due	**5/15/2015**
Defendant's 30-day Trial Period Ends	**6/29/2015**
Plaintiff's Rebuttal Disclosures Due	**7/14/2015**
Plaintiff's 15-day Rebuttal Period Ends	**8/13/2015**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, 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. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.

[6] Opposer's Rule 30(b)(6) witness may appear for any subsequently noticed discovery deposition by remote means. *See* Fed. R. Civ. P. 30(b)(4).