

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: March 3, 2016

Opposition No. 91217941
Opposition No. 91217992
Opposition No. 91218267

Robert Kirkman, LLC

v.

Phillip Theodorou and Anna Theodorou

By the Trademark Trial and Appeal Board:

This case comes up for consideration of (1) Applicants' motion (filed November 25, 2015) to dismiss Opposition No. 91217941 on the ground of unclean hands, and (2) Opposer's motion (filed December 7, 2015) to suspend pending final determination of a civil action between the parties. *See* Trademark Rule 2.117(a). Opposer has filed a brief in opposition to Applicants' motion. Opposer's motion is unopposed.

Turning first to Applicants' motion to dismiss, such motion is identified in the electronic cover sheet thereof as one to dismiss under Trademark Rule 2.132. To the extent that Applicants seek dismissal under Rule 2.132, their motion was filed during the discovery period, i.e., prior to the close of Opposer's testimony period, and is therefore premature. *See* TBMP § 534 (2015).

A review of the text of Applicants' motion indicates that Applicants are essentially attempting to argue the merits of the case, rather than seeking

dismissal based on an assertion of failure to state a claim (*see* Fed. R. Civ. P. 12(b)(6); TBMP § 503)¹ or entry of judgment on the pleadings (*see* Fed. R. Civ. P. 12(c); TBMP § 504).² As such, the Board will treat Applicants' motion as one seeking entry of summary judgment on the ground of unclean hands.³ *See* Fed. R. Civ. P. 56; TBMP § 528.

An assertion of unclean hands is an affirmative defense. *See* Trademark Rules 2.106(b)(1) and 2.114(b)(1). Affirmative defenses must be pleaded in a defendant's answer. *See* Fed. R. Civ. P. 8(c). A party cannot obtain judgment based on an

¹ A motion to dismiss for failure to state a claim was due by the filing of Applicants' answer. *See* Fed. R. Civ. P. 12(b); TBMP § 503.01. To withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding).

² A motion for judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period. *See* TBMP § 504.01. A judgment on the pleadings is granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy as a matter of law. *See* TBMP § 504.02.

³ Except on the grounds of lack of Board jurisdiction or claim or issue preclusion, a motion for summary judgment may be filed after the movant's initial disclosures and prior to the opening of the first testimony period. *See* Trademark Rule 2.127(e)(1). Summary judgment is a method of disposing of cases in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). Applicants, as the parties moving for summary judgment, have the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that they are entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987). In considering the propriety of summary judgment, all evidence must be viewed in a light most favorable to Opposer, as the nonmovant, and all justifiable inferences are to be drawn in Opposer's favor as the nonmovant. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. *See* *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Opposition Nos. 91217941, 91217992 and 91218267

unpleaded defense. *See* TBMP §§ 314 and 528.07(a) and cases cited therein. Applicants did not plead an affirmative defense of unclean hands, or any other affirmative defenses, in their answer in Opposition No. 91217941. Moreover, Applicants did not submit any evidence in support of their motion (*see* TBMP § 528.05) and therefore fall well short of meeting their initial burden of making a *prima facie* case that there is no genuine dispute as to any material fact herein and that they are entitled to entry of judgment as a matter of law. Based on the foregoing, Applicant's motion to dismiss is denied.

The Board notes in addition that Applicant's unclean hands allegations are based on Applicant's conduct in connection with Opposer's application Serial No. 86145914 for the mark THE WALKING DEAD for goods in International Classes 16, 20, 25, and 28. However, Opposer is not relying upon that application in support of Opposition No. 91217941.⁴

An unclean hands defense must be based on conduct related to Opposer's claims herein; misconduct unrelated to the claim in which it is asserted as a defense does not constitute unclean hands.⁵ *See Tony Lama Co., Inc. v. Di Stefano*, 206 USPQ

⁴ In the notices of opposition in Opposition Nos. 91217941 and 91217992, Opposer relied upon its Registration Nos. 4007681, 4314918, 4429084, and 4443715 in support of its claims. Opposer relied upon the aforementioned registrations and application Serial No. 86145914 in support of its claims in Opposition No. 91218267. However, Applicants in their motion sought dismissal of Opposition No. 91217941 only based on conduct in connection with application Serial No. 86145914.

⁵ Applicants allege that Opposer is improperly using the trademark registration symbol in selling goods under the THE WALKING DEAD mark for goods identified in application Serial No. 86145914. The improper use of a registration notice in connection with an unregistered mark with intent to deceive the purchasing public or others in the trade into believing that the mark is registered may be a basis for a fraud claim. *See Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991);

Opposition Nos. 91217941, 91217992 and 91218267

176, 179 (TTAB 1980). As such, Opposer's conduct with regard to application Serial No. 86145914 would not appear to be a basis for an unclean hands defense in Opposition No. 91219741.

In addition, Applicant's unclean hands assertion is based in part on Opposer's filing of an amendment to allege use in application Serial No. 86145914, wherein it set forth dates of use that preceded Opposer's intent-to-use filing date of that application. However, an intent-to-use applicant may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use. *See* TMEP § 903 (October 2015). Accordingly, even if Applicants could base an unclean hands defense on Opposer's conduct in the prosecution of application Serial No. 86145914, the dates of use set forth in the amendment to allege use in that application would not appear to be a proper basis for an unclean hands defense.

Applicant's unclean hands assertion is also based in part on Opposer's alleged enforcement of its "trademark rights beyond a reasonable interpretation of the scope of the rights granted." However, every trademark owner possesses a right under the Lanham Act to seek to protect its rights in its registered marks and preclude the registration of what it believes to be a confusingly similar mark. *See Avia Group Int'l Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992); *Cook's Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265 (TTAB 1977). Accordingly,

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 1101, 192 USPQ 24, 27 (CCPA 1976). However, such claim must be raised in a timely manner in an appropriate proceeding, e.g., by commencing an opposition proceeding against that application after publication or cancellation proceeding after registration. *See* Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063 and 1064; Trademark Rule 2.101 *et seq.*

Opposition Nos. 91217941, 91217992 and 91218267

Opposer's efforts to enforce its rights in the WALKING DEAD mark may not provide a basis for an unclean hands defense.

With regard to Opposer's motion to suspend, Applicants did not file a brief in response thereto. However, the Board, in its discretion, elects to decide that motion on the merits and declines to grant the motion to suspend as conceded. *See* Trademark Rule 2.127(a).

By the motion to suspend, Opposer seeks suspension of these consolidated proceedings pending final determination of Case No. 3:15-cv-08474-MAS-DEA, styled *Robert Kirkman, LLC v. Theodorou*, filed in the United States District Court for the District of New Jersey (hereinafter sometimes referred to as "the civil action").⁶ Under Trademark Rule 2.117(a), "[w]henver it shall come to the attention of the ... Board that a party or parties to a pending case are engaged in a civil action ... which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding." *See also* TBMP § 510.02(a). To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board. *See, e.g., Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

In the civil action, Opposer alleges, among other things, that Applicants' THE WALKING DEAD mark infringes Opposer's THE WALKING DEAD mark under

⁶ Applicant Phillip Theodorou is a party defendant and joint applicant in Opposition Nos. 91222005 and 91222719, which the Board suspended in a January 15, 2016 Board order pending final determination of Case No. 3:15-cv-08474-MAS-DEA.

Opposition Nos. 91217941, 91217992 and 91218267

Trademark Act Section 32, 15 U.S.C. § 1114, and that Applicants' THE WALKING DEAD mark is likely to cause dilution of Opposer's THE WALKING DEAD mark under Trademark Act Section 43(c), 15 U.S.C. § 1125(c). In the above-captioned proceedings, Opposer alleges that Applicants' THE WALKING DEAD mark is likely to cause confusion with Opposer's THE WALKING DEAD mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and likely to cause dilution under Trademark Act Section 43(c). Admittedly, infringement and likelihood of confusion claims rely on somewhat different transactional facts. *See Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1857-58 (Fed. Cir. 2000). In addition, because Applicant's involved mark is the subject of pending applications and not registrations, the district court may lack jurisdiction to entertain a claim by opposer to refuse registration of applicant's involved mark. *See Trademark Act Section 37*, 15 U.S.C. § 1119; *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249, 1253 n.6 (TTAB 2011).

However, to the extent that the civil action involves issues in common with those in these consolidated proceedings, the district court's findings in the civil action, most notably with regard to the dilution claim, would be binding on the Board herein. Further, in the civil action, Opposer asks, among other things, that Applicants be permanently enjoined from using the involved THE WALKING DEAD mark. Any such injunction would have a bearing upon Applicants' assertion in its involved applications that they have a bona fide intent to use the WALKING DEAD mark in commerce and therefore may have a bearing upon this proceeding.

Opposition Nos. 91217941, 91217992 and 91218267

Accordingly, the Board finds that suspension of this proceeding pending final determination of the civil action is warranted.

Based on the foregoing, the motion to suspend is hereby granted. Proceedings herein are suspended pending final determination, including any appeals or remands, of Case No. 3:15-cv-08474-MAS-DEA. The Board will make annual inquiry as to the status of the civil action. Within twenty days of the final determination of the civil action, Opposer should notify the Board so that this proceeding can be called up for appropriate action. While these consolidated proceedings are suspended, the parties shall keep their correspondence addresses current.