

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

Mailed: March 6, 2015

Opposition No. 91218523

Oakhurst Industries, Inc.
DBA Freund Baking Co.

v.

13th Ave Fish Market Inc.
DBA Freund's Fish

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of opposer's December 1, 2014 motion to strike affirmative defenses, and applicant's December 29, 2014 motion for leave to file an amended answer. The motions are fully briefed.

Analysis

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See* Fed. R. Civ. P. 12(f); TBMP § 506 (2014); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973). Also, the Board has the authority to strike an impermissible or insufficient claim, or portion of a claim, from a pleading. *See* TBMP § 506.01 (2014). A defense will not be stricken as

insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *Id.* Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (citations omitted). The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id.* *See also* TBMP §§ 309.03 and 506.01 (2014). Thus, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

Opposer's motion to strike is timely. Fed. R. Civ. P. 12(f); TBMP § 506.02 (2014). Opposer moved to strike each of applicant's affirmative defenses.

Applicant opposed the motion on the merits, and concurrently submitted a proposed amended answer and requested leave to file the amended answer. In the amended answer, applicant deletes the original first and seventh affirmative defenses, and amends the eighth (now sixth) affirmative defense. In the interest of achieving efficiency, minimizing further pleading motions practice, and advancing this proceeding, the Board grants applicant leave to file the amended answer; it is now applicant's operative pleading.

Accordingly, the Board has given consideration to opposer's motion to strike, and reply brief thereon, with respect to applicant's amended answer.

First Through Fifth Affirmative Defenses

The matters asserted in these paragraphs do not constitute affirmative defenses, but rather are statements and assertions that amplify applicant's denials of certain salient allegations in the notice of opposition. As such, applicant's "defenses" cannot operate to negate opposer's claims. Rather, they merely provide opposer with fuller notice of applicant's positions or theories with respect to certain elements of opposer's claims, and may be relevant to various issues of fact that are ultimately to be determined on the merits. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). Inasmuch as applicant is allowed to put forth its positions or theories with respect to the elements of opposer's claims, opposer's motion to strike is denied, and applicant is left to present its proofs at trial on the matters asserted.

Sixth Affirmative Defense

The matters set forth constitute an attack on the validity of opposer's pleaded Registration No. 4500792. Trademark Rule 2.106(b)(2)(i) provides:

A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such 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.

An impermissible collateral attack on a pleaded registration cannot be considered in the absence of a counterclaim for cancellation of the registration. *See* TBMP §§ 311.02, 313.01 (2014). Applicant did not file a counterclaim. Opposer's motion to strike is granted. The sixth affirmative defense is stricken.

Review of Notice of Opposition

Inasmuch as the notice of opposition is before the Board, the Board has sua sponte reviewed it for sufficiency. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, supra.*

Inasmuch as opposer sets forth a claim of likelihood of confusion that is not wholly without merit, based on ownership of two registrations, it sufficiently sets forth allegations which, if proven, would establish its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 648 (Fed. Cir. 1983); *Lipton Industries Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Turning to the grounds, opposer sufficiently pleads a claim of priority and likelihood of confusion pursuant to Trademark Act Section 2(d). *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). Opposer also sufficiently pleads a claim of dilution pursuant to Trademark Act Section 43(c). *See National Pork Board and National Pork Producers Council v. Supreme Lobster and Seafood Co.*, 96

USPQ2d 1479 (TTAB 2010); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1172-1173 (TTAB 2001). Lastly, opposer sufficiently pleads, with respect to application Serial No. 85139577, a claim that the mark is merely descriptive pursuant to Trademark Act Section 2(e)(1). *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1251, 103 USPQ2d 1753, 1755 (Fed. Cir. 2012).

Regarding opposer's fourth ground, opposer does not sufficiently plead a claim of fraud on the USPTO. Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration, or a registrant in a declaration of use or a renewal application, knowingly makes a false, material representation of fact in connection with an application to register, or in a post-registration filing, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Claims of fraud on the USPTO must be pleaded with the heightened level of specificity required by Fed. R. Civ. P. 9(b). *See Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1565 (Fed. Cir. 2009).¹

Opposer does not clearly or sufficiently state the alleged material misrepresentation upon which opposer bases its claim. Furthermore, opposer does not allege that applicant made a material misrepresentation with the intent to deceive the USPTO; opposer's mere mention that applicant

“willfully” took certain actions does not constitute the required allegation. Consequently, opposer fails to put applicant on fair notice of the basis for the fraud claim.

Opposer’s allegations regarding a “New Drawing” (paragraphs 50 and 51) are unclear and specious. An applicant for registration is not required to demonstrate use of a drawing, whether original or new. To the extent that opposer seeks to allege something with respect to use (or nonuse) of the mark, its allegations are unclear and lack the required factual specificity. To the extent that opposer seeks to allege that applicant submitted a drawing of the mark, and specimens of use of the mark, with the ® federal registration symbol, and/or that applicant sold or sells goods with the ® symbol, none of these submissions or uses constitutes a material misrepresentation to the USPTO in an application to register a mark. To the extent that opposer seeks to allege that applicant misused the federal registration symbol, it does not sufficiently allege the elements of the claim. *See Copelands’ Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991). To the extent that opposer seeks to allege that applicant failed to allege correct dates of first use of the mark and/or first use of the mark in commerce, this does not constitute a material misrepresentation to the USPTO in an application; it is well-established that a claimed date of first use, even if false, does not constitute fraud because the date is not material to the Office’s

¹ At trial or on summary judgment, all claims of fraud on the USPTO must be proven “to the hilt” with clear and convincing evidence. *See Alcatraz Media Inc. v.*

decision to approve a mark for publication. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009). Finally, the notice of opposition is unclear as to whether the attempted fraud claim pertains to just one or both of the opposed applications.

In view of these findings, opposer's fraud claim is stricken as insufficient. *See* TBMP § 506.01 (2014).

Discovery and Settlement Conference

In its November 29, 2014 order, the Board reset the deadline for the parties' required conference to January 7, 2015. Prior to the reset deadline, opposer filed its motion to strike, and the Board suspended this proceeding. In the instant order the Board resumes proceedings and resets dates again. Although applicant's request, with its brief on the motion to strike, for the Board's participation in the parties' required discovery and settlement conference is procedurally inappropriate and premature, the Board exercises its discretion to grant the request.

The attorneys of record are directed to confer and determine two potential dates and times on which they are both available to conference, in view of the reset deadline set forth below. Applicant's counsel is directed to contact the Board attorney by telephone (571-272-9183, Monday through Friday) in advance with such dates, so that the conference may be scheduled. At that time the Board will update the docket entries to reflect applicant's request for the Board's participation.

Chesapeake Marine Tours Inc., 107 USPQ2d 1750, 1767 (TTAB 2013).

Schedule

Proceedings are resumed. Conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for Required Discovery Conference	4/10/2015
Discovery Opens	4/10/2015
Initial Disclosures Due	5/10/2015
Expert Disclosures Due	9/7/2015
Discovery Closes	10/7/2015
Plaintiff's Pretrial Disclosures	11/21/2015
Plaintiff's 30-day Trial Period Ends	1/5/2016
Defendant's Pretrial Disclosures	1/20/2016
Defendant's 30-day Trial Period Ends	3/5/2016
Plaintiff's Rebuttal Disclosures	3/20/2016
Plaintiff's 15-day Rebuttal Period Ends	4/19/2016

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.