

ESTTA Tracking number: **ESTTA655309**

Filing date: **02/11/2015**

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

Proceeding	91219077
Party	Defendant Telebrands Corp.
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Date	02/11/2015
Attachments	Memo Opposition Motion to Strike_TristarvTelebrands_FINAL.pdf(163121 bytes)

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

Tristar Products, Inc.)	Opposition No. 91219077
)	
Opposer,)	Application Serial No.
)	86/232781
v.)	
)	
Telebrands Corp.)	
)	
Applicant.)	
)	

**APPLICANT TELEBRANDS CORP.’S MEMORANDUM IN OPPOSITION
TO OPPOSER TRISTAR PRODUCTS, INC.’S
MOTION TO STRIKE ALL AFFIRMATIVE DEFENSES**

Applicant Telebrands Corp. (“Applicant”) hereby submits the following memorandum of law in opposition to Opposer Tristar Products, Inc.’s (“Opposer”) motion to strike the first, second, third, and fourth affirmative defenses set forth in Applicant’s Answer.

I. ARGUMENT

Opposer’s motion to strike is untimely and should be denied. *See* TBMP § 506.02. Even if the Board does not consider Opposer’s motion to be untimely, it should deny the motion on the merits.

It is well-settled that “motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case.” TBMP § 506.01. Accordingly, “the Board, in its discretion 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.” *Id.* Moreover, “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.*

Applicant's first, second, third, and fourth affirmative defenses are sufficient, do not prejudice Opposer, and/or provide fuller notice of the basis for Applicant's defenses. Therefore, Opposer's untimely motion to strike all of Applicant's affirmative defenses should be denied.

A. Opposer's Motion To Strike Is Untimely And Should Be Denied

Section 506.02 of the TBMP sets forth that “[i]f no responsive pleading is required, the motion [to strike] should be filed within 21 days after service upon the moving party of the pleading that is the subject of the motion (26 days, if service of the pleading was made by first-class mail, ‘Express Mail,’ or overnight courier – see 37 CFR § 2.119(c)).” (Emphasis added.) Here, Applicant served its Answer on Opposer's counsel by first-class mail on December 23, 2014. Opposer filed and served its motion to strike on January 23, 2015—31 days after service of Applicant's Answer. Opposer's motion to strike was not filed within 26 days, as required by TBMP § 506.02. Accordingly, Opposer's motion to strike is untimely and should be denied.

B. Applicants First Affirmative Defense Is Proper

Opposer contends that “failure to state a claim upon which relief can be granted is not an affirmative defense.” (Opposer's Motion to Strike at 2.) This is not true. “Fed. R. Civ. P. 12(b)(6) permits [an Applicant] to assert in the answer the ‘defense’ of failure to state a claim upon which relief can be granted.” *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra Ag*, 36 U.S.P.Q. 2d 1221 (TTAB 1995). While Opposer “may utilize this assertion to test the sufficiency of the defense in advance of trial by moving under Fed. R. Civ. P. 12(f) to strike the ‘defense’ from [Applicant's] answer,” the Board may dismiss the Opposer's claim(s) “if it appears certain that the opposer is entitled to no relief under any set of facts which could be proved in support of its claim.” *Id.*

Section 309.3(c) of the TBMP sets forth that “a plaintiff must [] plead a statutory ground or grounds for opposition.” Count II of the Amended Notice of Opposition states that registration of Applicant’s mark should be denied because an “undisclaimed portion of the mark is merely descriptive.” (Amended Notice of Opposition at 5.) This is not a statutory ground for opposition. *See* TBMP § 309.3(c). Opposer only argues that one word (HANDS) should be disclaimed. (Amended Notice of Opposition at 5.) This is not a ground for refusal of registration. *See* TMEP § 1213. Moreover, Opposer’s identification of Section 2(e) of the Trademark Act in its Motion to Strike in connection with this Count does not make the claim sufficient, because these grounds are not pled in the claim. Opposer’s Motion to Strike at 2; *See* TBMP § 309.3(c). Accordingly, Opposer’s motion to strike Applicant’s first affirmative defense should be denied.

C. Applicant’s Second Affirmative Defense Should Not Be Stricken Because It Does Not Prejudice Opposer And Provides Fuller Notice of the Basis for the Defense

Opposer contends that Applicant’s second affirmative defense is duplicative of Applicant’s answer to paragraph 17 in the Amended Notice of Opposition and should be stricken as redundant. This is incorrect. An affirmative defense will not be stricken when it “will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense.” TBMP § 506.01.

In its Answer, Applicant denies the allegations contained in paragraph 17 of the Amended Notice of Opposition. Paragraph 17 sets forth that “Applicant’s mark, COPPER HANDS, is likely to cause confusion with *Opposer’s trademark COPPER WEAR based upon a federal registration and/or common law rights.*” (Emphasis added.) Applicant’s second affirmative defense recites, “There is no likelihood of confusion between *Opposer’s design mark, COPPER WEAR & Design, that is the subject of U.S. Trademark Application Serial No. 85/826741*, and Applicant’s mark, COPPER HANDS, that is the subject of U.S. Trademark Application Serial No. 86/232781.”

(Emphasis added.) Indeed, Applicant's second affirmative defense is not redundant. Rather, it specifically states there is no likelihood of confusion with respect to the design mark in Opposer's federal trademark application, which is specifically identified. Paragraph 17 of the Amended Notice of Opposition does not include such specificity. Accordingly, Applicant's second affirmative defense does not prejudice Opposer, but rather provides fuller notice of the basis for Applicant's no likelihood of confusion defense. Therefore, Opposer's motion to strike Applicant's second affirmative defense should be denied.

D. Applicant's Third Affirmative Defense Should Not Be Stricken Because The Allegations Particularly Set Forth The Position Applicant Is Taking

Opposer contends that "the third defense is plainly duplicative of the Applicant's answer and therefore, should be stricken." (Opposer's Motion to Strike at 4.) This is simply not true.

It is well-settled that an affirmative defense will not be stricken when "Applicant's allegations, in fact, serve to apprise opposer with greater particularity of the position which applicant is taking in the defense of its right of registration." *Textron, Inc. v. the Gillette Co.*, 180 U.S.P.Q. 152 (TTAB 1973). In Paragraph 17 of the Amended Notice of Opposition, which Applicant denies in its Answer, Opposer generally states that Applicant's mark, COPPER HANDS, is likely to cause confusion with Opposer's mark, COPPER WEAR, based upon a federal registration. In that registration, all words are disclaimed and only design elements are protected. Applicant's third affirmative defense specifically identifies Opposer's mark that is the subject of the federal registration and describes, with particularity, the design features of the mark and Opposer's rights with respect to that mark. Applicant asserts there can be no likelihood of confusion because Applicant's mark does not use any of the design features of Opposer's mark. Indeed, the statements in Applicant's third affirmative defense "serve to apprise Opposer with greater particularity" of Applicant's position and "amplify[y] the denial of likelihood of confusion

previously set forth by Applicant in its answer.” *See Id.* Accordingly, Opposer’s motion to strike Applicant’s third affirmative defense should be denied.

E. Applicant’s Fourth Affirmative Defense Should Not Be Stricken Because It Is Material To Applicant’s No Likelihood of Confusion Defense

Contrary to Opposer’s contentions, Applicant’s fourth affirmative defense is not “no trademark infringement or unfair competition.” (Opposer’s Motion to Strike at 4.) Rather, Applicant’s fourth affirmative defense sets forth that there is no likelihood of confusion with Opposer’s alleged common law word mark, COPPER WEAR. In Paragraph 17 of the Amended Notice of Opposition, Opposer pled likelihood of confusion with its alleged common law mark, COPPER WEAR. In defense, Applicant asserts that Opposer owns no common law rights to the mark, COPPER WEAR, because it is descriptive and not distinctive, so there can be no likelihood of confusion. Indeed, these allegations “serve to apprise Opposer with greater particularity of the position which Applicant is taking in the defense of its right of registration.” *Textron*, at 180 U.S.P.Q. 152. Accordingly, Opposer’s motion to strike Applicant’s fourth affirmative defense should be denied.

II. CONCLUSION

For the reasons set forth above, Opposer’s untimely motion to strike Applicant’s first, second, third, and fourth affirmative defenses should be denied.

Respectfully submitted,

Telebrands Corp.

Dated: February 11, 2015

/Robert T. Maldonado/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **MEMORANDUM IN OPPOSITION TO OPPOSER TRISTAR PRODUCTS, INC.'S MOTION TO STRIKE ALL AFFIRMATIVE DEFENSES** has been served on Opposer's counsel, at the following address of record, by First Class Mail, postage prepaid, this 11th day of February 2015.

Cheryl A. Clarkin, Esq.
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101 Dyer Street, 5th Floor
Providence, Rhode Island 02903-3908

Dated: February 11, 2015

*/Robert T. Maldonado/*_____

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