

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 2, 2015

Opposition No. 91219077

Tristar Products, Inc.

v.

Telebrands Corp.

Robert H. Coggins,
Interlocutory Attorney:

Telephone Conference

On February 26, 2015, at approximately 2:00 p.m. EST, the Board conducted a telephone conference to resolve the outstanding motion to strike. Participating in the conference were Robert Maldonado and Elana Araj, counsel for applicant; Daniel Holmander, counsel for opposer; and the above-signed Board attorney responsible for resolving interlocutory matters in this case.

Inasmuch as the conference was conducted prior to the time in which opposer might otherwise file a written reply brief, opposer was allowed the opportunity to present an oral reply. The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the

parties' arguments or comments raised in the motion or brief. Instead, this order lists the decisions made by the Board.

Motion to Strike

Inasmuch as the answer was served upon opposer on December 23, 2014, the motion to strike was due January 20, 2015. *See* Fed. R. Civ. P. 12(f)(2) and Trademark Rules 2.119(c) and 2.196. In view thereof, opposer's motion, filed January 23, 2015, is untimely. However, Fed. R. Civ. P. 12(f)(1) permits the Board to act on its own; and, the Board exercised its discretion to review applicant's affirmative defenses. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995).

Affirmative Defenses

The Board noted that applicant's first sentence under its affirmative defense header was merely an advisory statement that applicant "reserves the right" to amend its answer at some future date to add additional affirmative defenses after conducting discovery in this case. While applicant cannot reserve unidentified defenses, since doing so would not provide opposer fair notice of such defenses, it is possible that applicant may, in the future, file a motion to amend the answer to add an affirmative defense. Any such motion would require Board determination. Inasmuch as opposer will not be prejudiced by the inclusion of this sentence in the answer, the Board did not strike this unnumbered allegation. Notwithstanding this treatment,

applicant was informed that the statement would be given no further consideration by the Board.

First affirmative defense

Because Fed. R. Civ. P. 12(b)(6) permits applicant to assert in its answer the “defense” of failure to state a claim upon which relief can be granted, the Board utilized the assertion to test the sufficiency of the notice of opposition. *Id.*, citing *S.C. Johnson & Son Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973). To withstand the pleaded first defense, opposer need only allege such facts as would, if proved, establish that it has standing to maintain the proceeding and a valid ground exists for opposing registration. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

The Board determined that the first amended notice of opposition sufficiently alleges opposer’s standing and the ground of priority and likelihood of confusion; however, the Board determined that the second ground (i.e., the undisclaimed portion of the mark is merely descriptive) failed to state a claim upon which relief could be granted.

By “count II,” registration of the subject mark is opposed on the ground that HANDS is a merely descriptive term and the mark is not registrable absent a disclaimer of the descriptive wording HANDS . While registration of an application may be opposed on the ground that an undisclaimed portion of the mark is merely descriptive of the identified goods and that the mark

should not be registered without a disclaimer of that portion (*see Kellogg Co. v. Pack'Em Enters., Inc.*, 14 USPQ2d 1545 (TTAB 1990); *see also, The Procter & Gamble Co. v. Colgate-Palmolive Co.*, 2011 WL 1576730, *5 (TTAB, April 12, 2011) (defendant's applications for the marks COLGATE ALL IN ONE and ULTRA BRITE ALL IN ONE were refused registration absent a disclaimer of the phrase ALL IN ONE which was shown by the opposer to be merely descriptive of the applicant's goods)), an entire mark may not be disclaimed. TMEP § 1213.06 (Jan. 2015). Inasmuch as the subject mark is COPPER HANDS in standard characters, and COPPER has already been disclaimed, HANDS, as the sole remaining word in the mark, may not also be disclaimed.

In view thereof, paragraphs 18-20 were stricken from the first amended notice of opposition, and opposer was allowed until March 13, 2015, in which to file a second amended notice of opposition, should opposer wish, failing which this proceeding will continue under the first amended notice of opposition as stricken (i.e., under the sole ground of priority and likelihood of confusion).¹ Applicant was allowed until March 30, 2015, in which to file an answer to the second amended notice of opposition, if filed.

¹ The Board noted that opposer's pleaded application appears to have registered; however, the registration was not in evidence. The Board stated that because opposer pleaded a pending application in the first amended notice of opposition, opposer may make the resulting registration of record at trial without having to amend its pleading to assert reliance on the registration. *See UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009).

Second affirmative defense

Applicant's second defense was stricken. It is merely a restatement of the denial of likelihood of confusion which does not anything to the denial. *See Answer, para. 15. See also Sons of Italy, 36 USPQ2d at 1223.*

Third and fourth affirmative defenses

As to applicant's third and fourth affirmative defenses, the Board did not strike these defenses because they are amplifications of applicant's denial of opposer's claim of likelihood of confusion. In so acting, the Board noted that in usual circumstances matter will not be stricken unless it clearly has no bearing upon the issues of the case. *See Ohio State Univ. v. Ohio Univ., 51 USPQ2d 1289, 1292 (TTAB 1999).* Since the primary purpose of pleadings is to give fair notice of the claims or defenses asserted, 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 a fuller notice of the basis for a claim or defense. *See TBMP § 506.01 (2014).* The amplifications inform opposer of the way that applicant may defend against the opposition under the factors set forth in *In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)*, and serve to apprise opposer with greater particularity of at least some of the positions which applicant is taking in the defense of its right of registration. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1223 (TTAB 1995); and Textron, Inc. v. The Gillette Company, 180 USPQ2d 152, 153 (TTAB*

1973). It was determined that opposer would not be prejudiced by the inclusion of the amplifications in the answer.

Schedule

Dates were reset on the following schedule.

Second Amended Complaint Due, if Filed	3/13/2015
Answer to Second Amended Complaint Due	3/30/2015
Deadline for Discovery Conference ²	4/15/2015
Discovery Opens	4/15/2015
Initial Disclosures Due	5/15/2015
Expert Disclosures Due	9/12/2015
Discovery Closes	10/12/2015
Plaintiff's Pretrial Disclosures	11/26/2015
Plaintiff's 30-day Trial Period Ends	1/10/2016
Defendant's Pretrial Disclosures	1/25/2016
Defendant's 30-day Trial Period Ends	3/10/2016
Plaintiff's Rebuttal Disclosures	3/25/2016
Plaintiff's 15-day Rebuttal Period Ends	4/24/2016

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.

² The Board inquired about settlement, and each party stated that it was open to the possibility of settlement. While the Board is liberal in granting suspensions or extensions of time to answer when requested to accommodate settlement, the Board is not liberal in granting suspensions or extensions of time for settlement after the answer is filed but prior to the parties' discovery conference. See "Miscellaneous Changes to Trademark Trial and Appeal Board Rules," 72 Fed. Reg. 42242, 42245 (August 1, 2007).