

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

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Mailed: September 2, 2016

Opposition Nos. **91226317 (parent)**  
**91226808**

*MMetro.com LLC*

*v.*

*YOLOTech, LLC*

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

These opposition proceedings come up on Opposer's motions (filed April 8 and April 11, 2016) to strike portions of Applicant's answer, including affirmative defenses.<sup>1</sup> The motions are fully briefed.<sup>2</sup>

As a preliminary matter, it is noted that Opposer's motions were filed twenty-one days after service of the answer in each proceeding. The motions are therefore timely. *See* Fed. R. Civ. P. 12(f).

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a) and TBMP § 506.01

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<sup>1</sup> Applicant's motion to consolidate the proceedings (filed April 9, 2016) is noted. Opposer did not file a response thereto.

<sup>2</sup> As the pleadings, the motions to strike and the issues raised therein are largely identical, they have been addressed in a single order. For the sake of efficiency and readability, references to the record will be based on Opposition No. 91226317 unless stated otherwise.

(2016). Motions to strike, however, are not favored and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999). Thus, even an objectionable pleading may not be stricken if its inclusion will not prejudice the adverse party but instead will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims).

By its motions, Opposer has objected to the form of Applicant's answers as well as various allegations and defenses asserted by Applicant. They are addressed *infra*.

*Affirmative Defenses*

Turning first to Applicant's "affirmative defenses," the motion to strike is **DENIED** as to the second and third defenses. Although they are not true affirmative defenses, their inclusion can hardly be deemed prejudicial as they serve merely to amplify Applicant's denial of the likelihood of confusion claim.

As to the first and fourth defenses,<sup>3</sup> Applicant has requested, as part of its response to the motions, their withdrawal without prejudice. The Board sees

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<sup>3</sup> The first and fourth affirmative defenses are, respectively, "Opposer fails to state a claim upon which relief can be granted" and "Opposer's rights in and to the portion of its alleged THRILLIST trademark are generic or, in the alternative, merely descriptive of the goods and/or services allegedly offered under the mark. Opposer's alleged mark is therefore inherently unprotectable absent acquired distinctiveness, which the alleged THRILLIST Mark lacks."

little value in potentially deferring consideration of the issues presented. Applicant's request is therefore denied and Opposer's motion to strike these defenses is considered on the merits.

Concerning the first defense, failure to state a claim upon which relief can be granted is not an affirmative defense. *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828, 1830 (TTAB 1994). Nevertheless, since Applicant is permitted under Fed. R. Civ. P. 12(b)(6) to assert "failure to state a claim" as a defense, Opposer may test the sufficiency of its pleading prior to trial by moving under Fed. R. Civ. P. 12(f) to strike the defense from the answer. *See Order of Sons of Italy in America*, 36 USPQ2d at 1222.

In order to withstand the assertion that Opposer has failed to state a claim for relief, Opposer need only allege such facts as would, if proved, establish (1) that it has standing to maintain the proceeding, and (2) that a valid ground exists for opposing the mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

On the question of standing, a plaintiff need only demonstrate that it has a "real interest," i.e., a personal stake, in the outcome of the proceeding and a reasonable basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A belief in likely damage can be shown by establishing a direct commercial interest. *See International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984). The purpose of the standing requirement is to avoid

litigation where there is no real controversy between the parties, i.e., to weed out intermeddlers. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

In these oppositions, Opposer has pleaded Registration Nos. 3264673<sup>4</sup> and 4636005<sup>5</sup>. The pleading of these registrations is sufficient to allege Opposer's direct commercial interest in these proceedings and, therefore, its standing. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844.

The Board further finds that Opposer has sufficiently pleaded its claim of priority and likelihood of confusion under Section 2(d). Opposer has alleged a prior proprietary right, vis-à-vis Applicant, and that Applicant's use of its mark in connection with Applicant's goods and services is likely to cause confusion with Opposer's mark. *See Notice of Opposition*, 1 TTABVUE 6-8.

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<sup>4</sup> For THRILLIST and design. Registered July 17, 2007, on the Principal Register for "publication services, namely, online publications in the nature of newsletters in the fields of entertainment and lifestyles" in International Class 41.

<sup>5</sup> For THRILLIST and design. Registered November 11, 2014, on the Principal Register for "electronic commerce services, namely, providing information about products and services for advertising and sale purposes via computer, computer networks, the Internet, mobile devices, or electronic mail; advertising services; promoting the goods and services of others via the Internet; arranging and conducting marketing promotional events for others; advertising, marketing and promotion services; online retail store services featuring clothing, footwear, headphones, sunglasses, hats, speakers, and watches; promoting the goods and services of others by providing a website featuring discounted sales of local services; Organization of events and exhibitions for commercial, promotional and advertising purposes; Providing information and reviews of venues, products and events relating to automobiles for sale" in International Class 35 and "publication services, namely, online publications in the nature of newsletters in the fields of products, services, entertainment, popular culture, and lifestyles; providing information relating to celebrities, entertainment, and popular culture and providing reviews of venues, products and events in connection therewith; providing online newsletters in the field of entertainment, consumer product information, consumer information about the services of others, popular culture and lifestyles via e-mail" in International Class 41.

Thus, Opposer's motion to strike the first defense is **GRANTED** and the defense is hereby **STRICKEN**.<sup>6</sup>

On the other hand, Opposer's basis for striking the fourth defense is not well taken. Opposer's pleaded marks are composite marks consisting of a literal element, i.e., THRILLIST, and a design element. Applicant's claim of mere descriptiveness or genericness is directed to a "portion" of the mark rather than to the mark as a whole. As such, the defense does not constitute an improper collateral attack on the pleaded registrations as Opposer contends. *See Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987) ("The registration affords *prima facie* rights in the marks *as a whole*, not in any component. Thus, a showing of descriptiveness or genericness of *part* of a mark does not constitute an attack on the registration.") *quoting In re Nat'l Data Corp.*, 753 F.2d 1056, 1059-60, 224 USPQ 749, 752 (Fed. Cir. 1985) (emphasis in original). Rather, like the second and third defenses, this defense merely amplifies Applicant's denial of the likelihood of confusion claim. In view thereof, Opposer's motion to strike the fourth defense is hereby **DENIED**.

*Form of Answer and Allegations and Statements Therein*

Applicant's answer in each of the oppositions is comprised of responses consistent with Rule 8(b) of the Federal Rules of Civil Procedure as well as arguments in further support of those responses. While such arguments are

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<sup>6</sup> Of course, the striking of this defense is limited to the likelihood of confusion claim as pleaded herein and without prejudice to Applicant to raise the defense as against a newly asserted claim or an amended likelihood of confusion claim.

more appropriate for final briefing, the Board does not find their inclusion so prejudicial as to warrant striking them, particularly where they serve to provide further notice of Applicant's position. The same holds true for Applicant's demands for proof.

Moreover, the Board finds Opposer's concerns of "unauthenticated hearsay evidence" or the "self-serving and unsavory" nature of certain of Applicant's allegations overstated. Statements made in pleadings are not considered as evidence on behalf of the party making them but rather must be established by competent evidence during the time for taking testimony. *See Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010) (assertions in answer not evidence unless supported by evidence introduced at trial or except as admission against interest). Furthermore, the Board generally finds the striking of putatively derogatory or inflammatory statements as unnecessary as the Board is capable of discerning improper arguments and accordingly excluding them from consideration in rendering a decision. *Cf. Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1579 (TTAB 2015) (the Board "need not exclude evidence for danger of unfair prejudice [because Fed. R. Evid. 403] 'assumes a trial judge is able to discern and weigh the improper inferences ... from certain evidence, and then balance those improprieties against probative value and necessity ... [and] exclude those improper inferences from his mind in reaching a decision'")

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*quoting Gulf States Utils. Co. v. Ecodyne Corp.*, 635 F.2d 517, 519 (5<sup>th</sup> Cir. 1981).

To be clear, with the exception of the first “affirmative defense,” which is deemed stricken from each of the answers of record, Opposer’s motions to strike are otherwise **DENIED**.

*Applicant’s Motion to Consolidate*

The Board may consolidate pending cases that involve common questions of law or fact. *See* Fed. R. Civ. P. 42(a); *see also Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). Consolidation in appropriate cases will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays. In view of the identity of the parties and the common questions of law and fact presented by the proceedings, the Board finds consolidation appropriate. Thus, **Opposition Nos. 91226317 and 91226808 are hereby consolidated** and may be presented on the same record and briefs. The record will be maintained in **Opposition No. 91226317 as the “parent” case**. The parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order, and the parent case should be designated as such in the case caption.

The parties are reminded that consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. *See* 9A Wright, Miller, Kane, Marcus, Spencer & Steinman, Fed. Prac. & Proc. Civ. § 2382 (3d ed.).

The parties are instructed to promptly inform the Board of any other related cases within the meaning of Fed. R. Civ. P. 42.

These consolidated oppositions will proceed under the following schedule, as reset:

Deadline for Discovery Conference	<b>9/30/2016</b>
Discovery Opens	<b>9/30/2016</b>
Initial Disclosures Due	<b>10/30/2016</b>
Expert Disclosures Due	<b>2/27/2017</b>
Discovery Closes	<b>3/29/2017</b>
Plaintiff's Pretrial Disclosures Due	<b>5/13/2017</b>
Plaintiff's 30-day Trial Period Ends	<b>6/27/2017</b>
Defendant's Pretrial Disclosures Due	<b>7/12/2017</b>
Defendant's 30-day Trial Period Ends	<b>8/26/2017</b>
Plaintiff's Rebuttal Disclosures Due	<b>9/10/2017</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>10/10/2017</b>

**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 taking of testimony. Trademark Rule 2.125.

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Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b).  
An oral hearing will be set only upon request filed as provided by Trademark  
Rule 2.129.

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