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

Proceeding	91226317
Party	Plaintiff mMetrocom LLC
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Signature	/Ralph H. Cathcart/
Date	05/09/2016
Attachments	Opposers Reply in Further Support of Motion to Strike - YOLOTech.pdf(2126753 bytes) Reply Declaration of Ralph H. Cathcart - YOLOTech.pdf(1359946 bytes)

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

mMETRO.COM LLC,		
	Opposer,	Opposition No. 91/226,317
	v.	Serial No. 86/504,326
YOLOTech, LLC,		
	Applicant.	

OPPOSER'S REPLY IN FURTHER SUPPORT OF MOTION
TO STRIKE APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES

Opposer, mMetro.com LLC ("Opposer"), through its attorneys Ladas & Parry LLP, submits this Reply Brief and Reply Declaration of Ralph H. Cathcart, Esq. in further support of its Motion to Strike pursuant to Fed. R. Civ. P. 12(f) and Fed. R. Civ. P. 8.

As the Board well knows, a motion to strike is appropriate in certain circumstances. *See, e.g., American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 U.S.P.Q.2d 1313, 1314 (TTAB 1992) (insufficient affirmative defenses stricken); *Harsco Corp. v. Electrical Servicing Inc.*, 9 U.S.P.Q.2d 1570, 1571-1572 (TTAB 1988) (immaterial allegation stricken); *W.R. Grace & Co. v. Arizona Feeds*, 195 U.S.P.Q 670, 671 (Conm'r. 1972) (affirmative defenses stricken as redundant).

Here, Applicant's putative "Brief in Support of Applicant's Response in Opposition to Opposer's Motion to Strike Applicant's Answer and Affirmative Defenses" (Applicant's "Opposition Brief") fails to establish credible grounds to preclude the Board from granting Opposer's Motion to Strike. In fact, the lengthy and circuitous Opposition Brief and hybrid

supporting declaration, like Applicant's Answer, further underscores why the Motion to Strike should be granted. Declaration of Ralph H. Cathcart ("Cathcart Decl.") Cathcart Decl. ¶¶ 3-4.

Opposer shall not endeavor to address each and every infirmity contained in Applicant's lengthy Opposition Brief, as Opposer's Moving Brief adequately sets forth Opposer's legal entitlement to the simple, straightforward relief sought herein.

Nevertheless, Opposer will address some of Applicant's more glaring misstatements and misapprehensions of the law, as succinctly as possible.

I.

APPLICANT'S CONTENTION THAT A DEMAND FOR DISCOVERY IS PROPER IN AN ANSWER MUST FAIL

Opposer notes the folly in Applicant's contention that a demand for discovery is proper in an Answer. Simply put, such a demand is improper, immaterial, impertinent and a distraction. Discovery demands must be made during the relevant discovery period in accordance with Fed. R. Civ. P. and the Trademark Trial and Appeal Board Rules pertaining to discovery practice and devices. Further, to the extent Applicant attacks the validity of Opposer's THRILLIST Registrations in the relevant statement – "[i]t is denied that Opposer ever used, currently uses, or has any intention to use the THRILLLIST Mark for all of the goods and services recited in the Opposition or any other registration, and proof of same is demanded" such allegations should be struck for the reasons already set forth in Opposer's Moving Brief as improperly attacking the validity of Opposer's pleaded registrations.

Applicant seemingly suggests that Fed. R. Civ. P. 8) ("Denials – Responding to the Substance. A demand must fairly respond to the substance of the allegation") somehow opens the flood gate to permissive responsive pleadings. In fact, Fed. R. Civ. P. 8(2) merely means that one must actually respond to the allegation and not respond in an evasive or non-definitive

manner. See e.g., Lipton Industries, Inc. v. Ralston Purina co., 670 F.2d 1024 (Fed. Cir. 1982) ("The third sentence of subdivision (b) (Rule 8) epitomizes the objective: 'Denials shall fairly meet the substance of the averments denied'. It follows that **denials must not be evasive.**) (emphasis added).

Lastly, Applicant incorrectly suggests that *E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) excuses Applicant's assertion of immaterial and impertinent statements and insertions of evidence in a responsive pleading that is supposed to admit or deny allegations in plain, concise terms (Opposition Brief, p.8 (Dkt. 7) *DuPont* merely states that in an *inter partes* trial where certain extraneous evidence is properly made a part of the record (unlike the present case), such evidence may possibly be considered and appropriately weighted on a case-by-case basis. *Id.* Applicant also mistakenly relies on 37 C.F.R. § 2.122(c) to excuse its insertion of extraneous immaterial and impertinent material in the body of the pleading. The latter provision relates to "Exhibits" and <u>not</u> the body of the actual responsive pleading itself.

II.

THE EXTRANEOUS IMMATERIAL AND IMPERTINENT MATTER IN THE ANSWER MUST BE STRUCK

A. Applicant fails to demonstrate why the extraneous, lengthy, single-spaced quotations are not immaterial, impertinent, or prejudicial, nor has Applicant refuted that they add unnecessary clutter to the pleadings. Cathcart Decl. ¶¶ 2-5. Applicant seemingly misapprehends the difference between discoverable evidence that might support or controvert a claim and the mandates of Fed. R. Civ. P. 8 and 12 for responsive pleadings. As stated in the Moving Brief, in determining likelihood of confusion, the Board has long recognized that the two most important factors are a comparison of the competing marks as a whole and the respective recited goods or services. (Dkt. 5) Unlike an action for unfair competition where marketplace evidence may be at

issue and properly introduced into evidence, that is not the case here. Nor is Applicant's lengthy discourse about the burden of proof being on Opposer to prove its case remotely relevant. The jurisdiction of the Board is limited to the issue of registerability of Applicant's applied-for mark. At this stage of the proceedings, Applicant's improper use of extraneous, misleading single-spaced quotations of statements in the body of its Answer is immaterial, impertinent, prejudicial and merely adds clutter to the pleadings.

B. Applicant's position that its Answer does not resemble an argumentative brief is unavailing and cannot be taken seriously. In fact, much of Applicant's "Answer" prematurely and improperly contains Applicant's arguments concerning Section 2(d) likelihood of confusion, rather than simple admissions or denials in response to Opposer's Notice of Opposition. Applicant's habit of treating pleadings and briefs interchangeably also extends to Applicant's Declaration submitted in support of its Opposition Brief. Cathcart Decl. ¶ 3. Curiously, Applicant's Declaration includes numbered "denials", *i.e.*, "denied" or "Admitted in part and denied in part" that should be used in a responsive Answer. Opposer is not clear as to what allegations Applicant seeks to deny in its Declaration. *Id.*

III.

APPLICANT'S ANSWER CONTAINS IMPERTINENT AND SCANDALOUS ALLEGATIONS

Applicant surprisingly devotes substantial time fabricating an argument that its use of "guttural" in its Answer in describing Opposer's THRILLIST Marks was not impertinent, immaterial or scandalous. Applicant's contention is less than candid. Even a cursory review of Applicant's pleading shows that Applicant states that Opposer's "THRILLIST Mark is "more pedestrian, guttural, and conjures imagery of list of items and things". Plainly, in this context and given alternative definitions of "guttural", Applicant's disparaging remarks have nothing to

do with a physiological description of sounds that are made "near the back of the oral cavity". Applicant's Opposition Brief at pg. 13. If so, Applicant would have said that the THRILLIST Marks "sounded" as such. Instead, Applicant characterized THRILLIST in a disparaging way. Indeed, definitions of "guttural" include "being marked by utterance that is strange, unpleasant or disagreeable" (Merriam-Webster Dictionary) - Cathcart Decl. ¶ 7, Exhibit A; and synonyms therefor (*i.e.*, inarticulate, rough, gruff, grating). *Id.*, Exhibit B. Likewise, the word "pedestrian" which precedes Applicant's use of "guttural" and also has alternative definitions, means "undistinguished, ordinary" (or walking by foot). Cathcart Decl. Exhibit C. This places Applicant's intended use of "guttural" as it pertains to Opposer's THILLIST marks in proper perspective. Finally, it cannot be seriously argued that the word THRILLIST sounds like it is made in the back of someone's throat. Cathcart Decl. ¶ 6. Of course, Applicant is being coy now, toying with Opposer and the Board in a less than forthcoming manner. Accordingly, the disparaging/scandalous word should be struck and deserves no further treatment in this Reply Brief.

IV.

APPLICANT'S AFFIRMATIVE DEFENSES MUST BE STRICKEN

Lastly, Opposer shall not substantially reply to Applicant's Opposition Brief concerning the propriety of striking Applicant's groundless Affirmative Defenses, since Applicant apparently now substantially concedes the merit of Opposer's motion.

Tellingly, Applicant now seeks to withdraw "without prejudice" its First and Fourth Affirmative Defenses. Applicant's Opposition Brief at pgs. 13 - 14. Opposer specifically objects to Applicant's "offer" as it is untimely, procedurally defective and prejudicial to Opposer. Applicant has not timely counterclaimed or moved to amend its pleading pursuant to

Fed. R. Civ. P. 15. Rather, in recognition of the futility of pressing forward with its groundless, tardy and improper affirmative defenses, Applicant seeks to reserve another bite of the proverbial apple, contrary to the controlling statutory and precedential authorities.

Concerning Applicant's First Affirmative Defense, namely that "Opposer has failed to state a claim upon which relief can be granted", Applicant knows that it is specious as set forth in Opposer's Moving Brief (Dkt. 5). Thus, under the guise of doing the Board a favor for expediency sake, Applicant "offers" to withdraw the affirmative defense "without prejudice". However, Opposer seeks repose and does not want to leave open the issue or revisit such defense later, when the issue is squarely before the Board now. Also, if the Board were not to rule and consider the issue moot, as Applicant proposes, the doctrine of the "law of the case" might be invoked later, potentially militating that the Board not reopen the issue (*i.e.*, the Board's election to treat an issue as moot) decided in earlier stages of the same litigation. *See e.g., Cabot Company v. Combat Watch Company*, 2013 WL 6040029 (Trademark Trial and Appeal Board 2013).

Likewise, Applicant's groundless attack on the validity of Opposer's THRILLIST Marks (Fourth Affirmative Defense) as being generic or merely descriptive, is improper, tardy, and time barred. Any such attack would have had to have been made in the context of a compulsory counterclaim and therefore Applicant cannot unilaterally disregard statutory mandates and pervert the Federal Rules of Civil Procedure to reopen an expired time or obtain an extension of time, if you will, to make such compulsory counterclaim, by merely offering to withdraw the Affirmative Defense "without prejudice". Thus, Opposer objects to Applicant simply withdrawing the Fourth Affirmative Defense "without prejudice".

Accordingly, for all of the above reasons, Applicant has failed to demonstrate why Opposer's Motion to Strike should not be granted. Accordingly, Opposer requests that its Motion To Strike be granted in its entirety and that the Board stay discovery pending it decision and thereafter reset discovery and trial deadlines accordingly.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Opposer

Dated: May 9, 2015

By: _____

Ralph H. Cathcart
Jennifer Kwon
1040 Avenue of the Americas
New York, NY 10018
(212) 708-1920
(Our Ref: C15672442)

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S REPLY IN FURTHER SUPPORT OF OPPOSER'S MOTION TO STRIKE APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated below:

Dated: May 9, 2015

Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **OPPOSER'S REPLY IN FURTHER SUPPORT OF OPPOSER'S MOTION TO STRIKE APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES** was served by first-class mail, postage prepaid, to the following persons:

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mhoffma1@alumni.law.upenn.edu
Phone: 267-398-7470

Dated: May 9, 2015

Reinaldo M. Roa

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

mMETRO.COM LLC,		
	Opposer,	Opposition No. 91/226,317
	v.	Serial No. 86/504,326
YOLOTech, LLC,		
	Applicant.	

REPLY DECLARATION OF RALPH H. CATHCART, ESQ.

I, Ralph H. Cathcart, declare that the following is true and correct pursuant to 28 U.S.C. § 1746:

1. I am a partner at the law firm of Ladas & Parry LLP, attorneys for Opposer mMetro.com LLC ("Opposer") and respectfully submit this declaration in further support of Opposer's well-founded Motion to Strike Applicant's putative "Answer to the Notice of Opposition and Affirmative Defenses" ("Answer").

2. Applicant has provided no law or facts to negate the propriety of Opposer's Motion to Strike.

3. Applicant inexplicably submitted a Declaration in Support of its putative Opposition to Opposer's Motion to Strike that resembles a pleading, with numbered denials, *i.e.*, "denied" and "Admitted in part and denied in part". (Dkt. 7)

4. Applicant's lengthy and circuitous Opposition Brief provides no legal basis to support a denial of Opposer's Motion to Strike and is filled with groundless reasoning, immaterial, impertinent and misleading statements and *ad hominin* attacks.

5. Applicant's explanation for its use of "guttural" (page 13 of Applicant's Brief in Opposition (Docket 7) defies credulity.

6. Given the context of Applicant's use of the pejorative description of Opposer's Mark, namely that THRILLIST is "pedestrian and guttural", Applicant's proffered explanation that Applicant really meant to refer to the physiological pronunciation of the word THRILLIST as involving the back of one's throat, is not credible, particularly given 1) the context of the statement and 2) the pronunciation of THRILLIST.

7. Definitions for guttural include "being or marked by utterance that is strange, unpleasant or disagreeable" (See Exhibit A attached) and synonyms include "inarticulate", "rough", "harsh", "growling" and "gruff". (See Exhibit B). Definitions for "pedestrian" including "undistinguished" or "not interesting" are attached as Exhibit C.

8. Applicant is time barred from asserting compulsory counterclaims, calling into question the validity of Opposer's THRILLIST registered marks, and cannot simply withdraw same "without prejudice".

9. Applicant's request to withdraw its frivolous First and Fourth Affirmative Defenses merely seeks to maintain a cloud over available defenses, the scope of discoverable issues and seeks to reserve a second chance at asserting defenses or counterclaims Applicant is not legally entitled to assert or which must be dismissed on the merits in this motion.

10. Opposer has acted in good faith and has not undertaken any conduct for the purpose of delay and Applicant's claims to the contrary are unsupported and false.

11. For all of the foregoing reasons, Opposer's Motion to Strike should be granted in its entirety, discovery stayed until the Board issues its decision and discovery and trial deadlines thereafter reset.

I declare that the foregoing is true and correct under penalties of perjury.

Executed on May 9, 2016 in New York, New York.

Ralph H. Cathcart

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **REPLY DECLARATION OF RALPH H. CATHCART, ESQ.** is being electronically transmitted to the United States Patent and Trademark Office on the date indicated:

Dated: May 9, 2016

Reinaldo M. Roa

CERTIFICATE OF SERVICE

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **REPLY DECLARATION OF RALPH H. CATHCART, ESQ.** was served on the persons listed below by First-Class Mail, postage prepaid, on the date indicated below:

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Dated: May 9, 2016

Reinaldo M. Roa

EXHIBIT A

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guttural

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guttural

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adjective gut·tur·al \ˈgə-tə-rəl, ˈgə-trəl\
Popularity: Bottom 50% of words

Simple Definition of *guttural*

- : formed or pronounced in the throat

Source: Merriam-Webster's Learner's Dictionary
Editor's note: Did You Know?

- -
- -
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-

Full Definition of *guttural*

1. *1* : articulated in the throat *guttural sounds*
2. *2* : velar
3. *3* : being or marked by utterance that is strange, unpleasant, or disagreeable

guttural *noun*
gutturalism play \ˈgə-tə-rə-ˌli-zəm, ˈgə-trə-\ *noun*

See guttural defined for English-language learners

EXHIBIT B

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guttural

see definition of guttural show all

adj **deep in sound**

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gratin

15 Synonyms found for guttural

Relevance A-Z Complexity Length

Synonyms for guttural

Common Informal

adj deep in sound

grating	low	thick	gruff
growling	rasping	glottal	harsh
husky	rough	gravelly	hoarse
inarticulate			
sepulchral			
throaty			

Antonyms for guttural

thin

dulcet

Word Origin & History

guttural 1594, from M.Fr. guttural, from L. guttur "throat."

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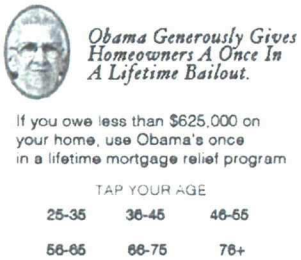
More words related to **guttural**

gruff
adj. rasping in sound

cracked	grating	hoarse	rough
croaking	guttural	husky	throaty
croaky	harsh	low	



harsh
adj. rough, crude (to the senses)

acrid	creaking	guttural	out-of-tune
asperous	croaking	hard	rasping
astringent	disagreeing	hoarse	raucous
bitter	discordant	incompatible	rigid
bleak	dissonant	jagged	rugged
cacophonous	disturbing	jangling	rusty
caterwauling	earsplitting	jarring	screeching
clashing	flat	noisy	severe
coarse	glaring	not smooth	sharp
	grating	off-key	sour

Example Sentences for guttural

"They have quite an eye for dramatic effect," he said in his **guttural** voice, and very contemptuously.

It sometimes gives a **guttural**, short, and rapidly-repeated bark.

Lem's jaw dropped, and he uttered a throat sound, **guttural** and rough.

EXHIBIT C

Pedestrian - definition of pedestrian by The Free Dictionary

http://www.thefreedictionary.com/pedestrian

pedestrian

Also found in: **Thesaurus**, **Legal**, **Acronyms**, **Wikipedia**.

pe·des·tri·an (pə-dĕs'trē-ən)

n.

A person traveling on foot; a walker.

adj.

1. Of, relating to, or made for pedestrians: *a pedestrian bridge.*

2. Going or performed on foot: *a pedestrian journey.*

3. Undistinguished; ordinary: *pedestrian prose.* See Synonyms at **dull**.

[From Latin `pedester, pedestr-`, *going on foot*, from `pedes`, *a pedestrian*, from `pēs, ped-`, *foot*; see **ped-** in **Indo-European roots**.]

pe·des'tri·an·ism *n.*

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pedestrian (pɪˈdɛstrɪən)

n

a. a person travelling on foot; walker

b. (*as modifier*): *a pedestrian precinct.*

adj

dull; commonplace: *a pedestrian style of writing.*

[C18: from Latin *pedester,* from *pēs* foot]

Collins English Dictionary – Complete and Unabridged, 12th Edition 2014 © HarperCollins Publishers 1991, 1994, 1998, 2000, 2003, 2006, 2007, 2009, 2011, 2014

pe•des•tri•an (pəˈdɛs tri ən)

n.

1. a person who goes or travels on foot.

adj.

2. going or performed on foot.

3. of or for walking.

4. lacking in vitality, imagination, or distinction; prosaic.

[1710–20; < Latin *pedestri-* (s. of *pedester* on foot, derivative of *pēs* (s. *ped-*); see **pedi-**) + **-an**[1]]

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pedestrian

play
adjective pe·des·tri·an \pə-ˈdes-trē-ən\
Popularity: Top 30% of words

Simple Definition of *pedestrian*

- : not interesting or unusual
- : relating to or designed for people who are walking

Source: Merriam-Webster's Learner's Dictionary
Examples: *pedestrian* in a sentence

- -
- -
- -
- -
-

Full Definition of *pedestrian*

1. *1* : commonplace, unimaginative
2. *2 a* : going or performed on foot*b* : of, relating to, or designed for walking <*a pedestrian mall*>

See pedestrian defined for English-language learners

See pedestrian defined for kids