

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: July 6, 2016

Opposition No. 91226463

Intel Corporation

v.

Advanced Charging Technologies, Inc.

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Opposer's May 2, 2016 motion to strike affirmative defenses. The motion is fully briefed.<sup>1</sup>

### **Analysis**

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f); TBMP § 506 (2016); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). Also, the Board has the authority to strike an impermissible or

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<sup>1</sup> Opposer's motion is timely. TBMP § 506.02 (2016),

insufficient claim, or portion of a claim, from a pleading. TBMP § 506.01 (2016). Trademark Rule 2.106(b)(1) provides for the pleading of affirmative defenses in an answer to a notice of opposition. 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. *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d at 1292. The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id.* TBMP §§ 309.03 and 506.01 (2016). 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. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

This proceeding involves Opposer's claims of 1) priority and likelihood of confusion, and 2) dilution by blurring, in opposition to registration of Applicant's application Serial No. 86609735 for the mark TRONIUM INSIDE (standard characters) for "power supplies; electric power converters; power conversion devices" in International Class 9. Opposer pleads ownership of five U.S. registrations for the mark INTEL INSIDE, INTEL INSIDE and design, and THE JOURNEY INSIDE, for goods and services in International Classes 9 and 41. Opposer made the registrations of record by attaching to its pleading the printouts from the Office's electronic database records (TESS, the Trademark Electronic Search System) showing the

current status and title of the registrations.<sup>2</sup> Trademark Rule 2.122(d)(1); TBMP § 309.03(a)(2) (2016). In its answer, Applicant denied the salient allegations, and set forth five matters under the heading of affirmative defenses.<sup>3</sup> Opposer has moved to strike the first four defenses.<sup>4</sup>

The Board has considered the parties' briefs on the contested motion(s), but does not repeat or discuss all of their arguments and submissions, and does not address irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Regarding Applicant's first affirmative defense, in the defense Applicant cites no Board *inter partes* precedent or authority on which it relies in support of the applicability of its defense. Applicant seeks to negate Opposer's claims, but its allegations fail to set forth any conduct, behavior, action or inaction on the part of Opposer or in which Opposer has engaged, which is directly and specifically related to Opposer's pleaded trademarks, which forms the basis for Applicant's defense. On the contrary, the defense merely sets forth conclusory statements and is clearly insufficient to put Opposer on notice of the factual basis for the defense. Thus, although Applicant argues that it has properly asserted trademark misuse as an affirmative defense, the defense is insufficiently pleaded. Similarly, to the extent

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<sup>2</sup> 1 TTABVUE 26-44.

<sup>3</sup> 4 TTABVUE 7.

<sup>4</sup> The fifth matter that Applicant asserts - that it reserves the right to plead additional affirmative defenses as discovery progresses - is not a defense at all, and is unnecessary. As a general matter, amendments to pleadings in Board *inter partes* proceedings are governed by Fed. R. Civ. P. 15. TBMP § 507 (2016).

that Applicant seeks to set forth any other type of defense of unclean hands, it has failed to make out the defense as it is insufficiently pleaded. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653 n.4 (TTAB 2002). Based on these findings, Opposer's motion to strike is granted, and the first affirmative defense is stricken.<sup>5</sup>

Opposer addresses Applicant's second, third and fourth affirmative defenses, arguing that they are not affirmative defenses, that they merely reiterate certain of Applicant's denials, and that they are insufficiently pled. The three defenses, while not technically affirmative defenses, amplify Applicant's denial in its answer of Opposer's allegations in support of its claims, and set forth Applicant's position or theory regarding issues of fact to be determined on the merits. Thus, the matters asserted as defenses may have a bearing on the issues under litigation. Specifically, Applicant's defenses apprise Opposer with greater particularity of the position which Applicant is taking regarding the similarity or dissimilarity between the parties' marks and the strength of Opposer's marks (second affirmative defense), Opposer's continuous use of and rights in certain marks (third affirmative defense), and whether Opposer's mark is famous under the Trademark Act (fourth affirmative defense). Thus, the matters that Applicant asserts amplify and enlarge its denials

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<sup>5</sup> Furthermore, the burden to prove a defense of this nature is particularly high. The Board has noted, in cases where a defense of this nature was asserted, that "[t]here is nothing in the record to suggest that [opposer] has done anything other than seek to protect its rights in its registered marks, and preclude the registration of what it believes to be a confusingly similar mark, a right which every trademark owner possesses under the Lanham Act." *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992). See also *Cook's Pest Control, Inc. v. Sanitas Pest Control Corporation*, 197 USPQ 265, 268 (TTAB 1977).

and provide fuller notice of Applicant's position relative to certain issues of fact. Such assertions, while not affirmative defenses, are allowed. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (motion to strike affirmative defense denied because it was an amplification of a denial, giving fuller notice of the claim); *Textron, Inc. v. The Gillette Company*, 180 USPQ 152 (TTAB 1973). Applicant is allowed to pursue its position by the presentation of its arguments and evidence, as appropriate.

Moreover, the defenses do not violate settled law, and would not be prejudicial to Opposer.

For completeness, the Board notes that to the extent that Applicant seeks, by way of its second, third or fourth affirmative defenses, to challenge the validity of any one or more of Opposer's pleaded registrations, the collateral attack is impermissible and relief in the form of cancelling said registration(s) is not available. Trademark Rule 2.106(b)(2)(ii) strictly provides that any such attack must be brought by the filing of a separate counterclaim or petition to cancel. TBMP § 311.02 (2016).

In view of the above findings, Opposer's motion to strike is denied.

In summary, Opposer's motion to strike the affirmative defenses is granted in part and denied in part.

### **Schedule**

Proceedings are resumed. Conference, initial disclosure, discovery trial dates are reset as follows:

Deadline for Required Discovery Conference	<b>7/20/2016</b>
Discovery Opens	<b>7/20/2016</b>

Initial Disclosures Due	<b>8/19/2016</b>
Expert Disclosures Due	<b>12/17/2016</b>
Discovery Closes	<b>1/16/2017</b>
Plaintiff's Pretrial Disclosures Due	<b>3/2/2017</b>
Plaintiff's 30-day Trial Period Ends	<b>4/16/2017</b>
Defendant's Pretrial Disclosures Due	<b>5/1/2017</b>
Defendant's 30-day Trial Period Ends	<b>6/15/2017</b>
Plaintiff's Rebuttal Disclosures Due	<b>6/30/2017</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>7/30/2017</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 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.