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

Proceeding	92051170
Party	Plaintiff O2Micro International Limited
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Submission	Motion to Strike
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In Re Trademark Reg. No. 2231093)

Dated: March 9, 1999)

Mark: O2)

Class: INT. 9)

O2Micro International Limited)
Petitioner) Cancellation No. 92051170
)
v.)
)
O2 Holdings Limited)
Respondent)
*

PETITIONER'S MOTION TO STRIKE
AFFIRMATIVE DEFENSES OF RESPONDENT

Petitioner O2Micro International Ltd. (Petitioner) hereby moves to strike the second, third, fifth and sixth Affirmative Defenses as set forth in the Answer to Petition to Cancel Registration filed by Respondent O2 Holdings Limited on September 8, 2009. Petitioner submits that the alleged defenses do not provide Respondent with legally sufficient or legally supportable defenses to the Petition for Cancellation. As such, the defenses are insufficient and/or immaterial and should be stricken

Fed. R. Civ. P. 12(f) provides, in relevant part, for striking from a pleading any redundant, immaterial, impertinent or scandalous matter. The Board also has the authority to strike an impermissible or insufficient claim (or portion of a claim) from a pleading. See, *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289 (TTAB 1999). Petitioner submits that the identified affirmative defenses are immaterial and/or insufficient and thus makes this motion

for the purpose of narrowing and limiting the issues in this proceeding. As stated in Moore's Manual: Federal Practice and Procedure, at 12.03[2]:

Although courts are reluctant to grant motions to strike, where a defense is legally insufficient, the motion should be granted in order to save the parties unnecessary expenditure in time and money in preparing for trial.

Petitioner's grounds for this motion are set forth as follows:

Respondent's Second Affirmative Defense Should be Stricken

Petitioner submits Respondent's Second Affirmative Defense should be stricken. The Second Affirmative Defense reads as follows:

2. As and for a second defense, the Petition to Cancel is barred by the doctrines of laches and waiver in that the Petitioner's marks have coexisted with Registrant's Mark since at least 2001 without prior objection from Petitioner.

As an initial matter, Petitioner has not pleaded a prior trademark as grounds for the Petition for Cancellation¹, but has identified its trademarks and registrations as they relate to Petitioner's standing and potential damage. The only ground for cancellation raised by Petitioner is fraud. Thus, the Second Affirmative Defense is unrelated to Petitioner's claim and whether or not the parties' respective marks have coexisted is not relevant. Even if the allegations in this Affirmative Defense were proven to be true, they would not form a defense to the allegation of fraud.

Furthermore, laches may not be maintained as a defense to fraud. *TBC Corp. v. Grand Prix, Ltd.*, 12 U.S.P.Q.2d 1311, 1313 (T.T.A.B. 1989) (in a proceeding based on descriptiveness or fraud, the equitable defenses of laches, acquiescence or estoppel are not applicable; the public

¹ Registration No. 2231093 is dated March 9, 1999, more than five years ago. Thus, a Petition to Cancel based on Section 2(d) grounds would be barred Lanham Act §14(3), 15 U.S.C.S. §1064(3). Respondent's not having raised this as an affirmative defense contradicts Respondent's attempts to give relevance to Petitioner's trademarks and registrations in its affirmative defenses.

interest to preclude registration of merely descriptive designations or a registration procured by fraud dominates); *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289 (TTAB 1999).

Based on the foregoing, Respondent's second Affirmative defense is insufficient and should be stricken.

Respondent's Third Affirmative Defense Should be Stricken

Petitioner submits Respondent's Third Affirmative Defense should be stricken. The Third Affirmative Defense reads as follows:

3. As and for a third defense, the Petition to Cancel is barred by the doctrine of estoppel in that the United States Patent and Trademark Office ("USPTO") issued an office action with regard to one of Petitioner's applications in which the Examining Attorney cited Registrant's Mark in a 2(d) refusal to register. Teresa Tucker, the attorney who filed the instant Petition to Cancel, successfully responded that Registrant's Mark and Petitioner's Mark were so dissimilar in name and with respect to the goods on which each party used its Mark that no likelihood of confusion was likely to occur. The Examining Attorney at the USPTO relied on the statements of Ms. Tucker, removed the 2(d) citation and allowed Petitioner's Mark to register.

Petitioner has not pleaded a prior trademark and likelihood of confusion as grounds for the Petition for Cancellation, but has identified its trademarks and registrations as they relate to Petitioner's standing and potential damage. The only ground for cancellation raised by Petitioner is fraud. Thus, whether or not the Petitioner, in an unrelated matter, argued that there is no likelihood of confusion, is not relevant. Even if the Examining Attorney's finding in prosecution of one of Petitioner's trademark applications was found to be precedential, it would not form a defense to the allegation of fraud.

Based on the foregoing, Respondent's third Affirmative defense is unrelated to Petitioner's claim, is insufficient and should be stricken.

Respondent's Fifth Affirmative Defense Should be Stricken

Petitioner submits Respondent's Fifth Affirmative Defense should be stricken. The Fifth Affirmative Defense reads as follows:

3. As and for a fifth defense, the Petitioner may have committed fraud on the USPTO for failure to use one of its Marks in association with its goods by not either directly applying its Mark on its goods or on its point of sale material, or the like; Applicant reserves the right to file an Amended Answer with Counterclaims after discovery commences and discoverable evidence is produced of said fraud.

If an opposer relies upon a prior registration as grounds for opposition, the validity of that registration cannot be challenged unless the applicant counterclaims by a petition to cancel opposer's registration. *Cosmetically Yours, Inc. v. Clairol, Inc.*, 424 F.2d 1385, 165 U.S.P.Q. 515 (C.C.P.A. 1970); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 U.S.P.Q. 46 (C.C.P.A. 1969). Petitioner recognizes an important exception is the *Duffy-Mott* defense, under which an applicant can, by way of an affirmative defense in its answer to opposition, raise the issue of fraud in obtaining and maintaining opposer's registration. *Duffy-Mott Co. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 U.S.P.Q. 422 (C.C.P.A. 1970).

In this case Petitioner has not pleaded a prior registration. Thus, neither a counterclaim nor a *Duffy-Mott* defense is available to the Respondent.

Furthermore, the hypothetical basis for fraud proposed by Respondent, that is, that "Petitioner failed to use its mark by applying it directly to goods or to point of sales displays" does not provide any basis for the Board to find fraud. A Trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false. *See Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 U.S.P.Q.2d 1483 (Fed. Cir. 1986) ("Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application."). The manner in which Petitioner uses its trademark in commerce would

not form the basis of an allegation of fraud, and does not form a defense to the allegation of fraud raised by Petitioner as grounds for cancellation.

Furthermore, and as stated previously, Petitioner has not pleaded a prior trademark and likelihood of confusion as grounds for the Petition for Cancellation, but has identified its trademarks and registrations as they relate to Petitioner's standing and potential damage. Thus, there is no pleaded registration against which Respondent could bring a counterclaim even if Respondent had alleged facts sufficient to form a claim of fraud.

Based on the foregoing, Respondent's fifth Affirmative defense is immaterial and insufficient and should be stricken.

Respondent's Sixth Affirmative Defense Should be Stricken

Petitioner submits Respondent's Sixth Affirmative Defense should be stricken. The Sixth Affirmative Defense reads as follows:

6. As for a sixth defense, Registrant denies the allegations in paragraphs six (6) through thirteen (13) of the Petition to Cancel, but affirmatively states that a substitute/additional specimen has been submitted showing Registrant's goods bearing Registrant's Mark on its goods that was in use in commerce within one year before the end of the ten-year period after the date of registration pursuant to TMEP § 1604.12(c)(2).

Respondent's sixth Affirmative defense is redundant, immaterial and insufficient.

In its Answer, Respondent denied the allegations in paragraphs six through thirteen. Said paragraphs set forth Petitioner's allegations of the actions of Respondent as alleged to constitute the basis of a finding of fraud. Accordingly, at minimum, the first sentence of Respondent's sixth Affirmative defense should be stricken.

More significantly, however, the Respondent has filed with the USPTO Trademark Renewal Unit, on September 8, 2009, the day after filing its Answer, a Declaration, an amendment to the identification of goods, and a "substitute specimen." These were filed after

commencement of the Cancellation proceeding but without submission in the form of a Motion to the Board. A registration which is the subject of a Board inter partes proceeding may not be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion. *See* 15 U.S.C. § 1057(e) and 37 CFR § 2.173. As of this date the Trademark Office does not appear to have acted on the September 8, 2009 filing by Respondent. Petitioner submits that the filing is exclusively within the Board's jurisdiction.

With respect to the substitute/additional specimen submitted by Respondent, Petitioner notes that it comprises a "smart card" that is indicated for use in the United Kingdom. Petitioner reserves the right to amend its pleadings in order to address the timeliness, substance and relevance of the September 8, 2009 filing whether or not the matter is transferred to the Board's jurisdiction.

Regardless of the timeliness or jurisdiction of the additional filing by Respondent, Petitioner submits that even if it were deemed acceptable it does not provide a sufficient defense as it does not alter the facts alleged in paragraphs six through thirteen of the Petition to Cancel with respect to Petitioner's ground for cancellation.

WHEREFORE, Petitioner respectfully moves that its Motion to Strike the second, third, fifth and sixth Affirmative Defenses of Respondent's Answer be granted in all respects.

O2Micro International Limited

Dated: 9.28.2008

By: 
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CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the subject Petitioner's Motion to Strike Affirmative Defenses was served upon the Respondent via First Class mail, postage prepaid, this 28th day of September, 2009 to the following address:

Linda Kurth
Baker & Rannells PA
575 Route 28, Suite 102
Raritan NJ 08869

By: 
Teresa C. Tucker