

ESTTA Tracking number: **ESTTA370430**

Filing date: **09/27/2010**

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

Proceeding	92052684
Party	Plaintiff Natural Supplements and Remedies, Inc., d/b/a Vitanergy
Correspondence Address	OLIVER ALAN RUITZ MALLOY & MALLOY, P.A. 2800 S.W. THIRD AVENUE MIAMI, FL 33129 UNITED STATES oruiz@malloylaw.com, litigation@malloylaw.com
Submission	Motion to Strike
Filer's Name	Francisco J. Ferreiro
Filer's e-mail	fferreiro@malloylaw.com, oruiz@malloylaw.com, litigation@malloylaw.com
Signature	/Francisco J. Ferreiro/
Date	09/27/2010
Attachments	Motion to Strike and Motion to Dismiss.pdf (10 pages)(65406 bytes)

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

In the matter of Registration No. 3,237,960
For the mark "VITAENERGY"

_____)	
NATURAL SUPPLEMENTS AND)	
REMEDIES, INC. d/b/a VITANERGY,)	
a Florida Corporation,)	
)	
Petitioner,)	
)	
vs.)	Cancellation No. 92052684
)	
NUTRISCIENCE CORPORATION,)	
a California Corporation,)	
)	
Registrant.)	
_____)	

PETITIONER’S MOTION TO STRIKE AND MOTION TO DISMISS
REGISTRANT’S THIRD COUNTERCLAIM

COMES NOW Petitioner, Natural Supplements and Remedies, Inc., d/b/a Vitanergy (“Petitioner”) and, pursuant to Fed.R.Civ.P. 12 and TBMP §§ 503 and 506, hereby moves to strike Registrant’s first, second, third, ninth, and eleventh affirmative defenses; certain of Registrant’s immaterial pleadings; and to dismiss Registrant’s Third Counterclaim. In support thereof, Petitioner submits the following:

MEMORANDUM

I. REGISTRANT’S IMPROPER AFFIRMATIVE DEFENSES SHOULD BE STRICKEN.

Initially, Petitioner seeks to strike Registrant’s first, second, third, ninth, and eleventh affirmative defenses from Registrant’s Answer to Petition for Cancellation and Counterclaims for Cancellation of U.S. Reg. No.2440741. Registrant’s first affirmative defense requests dismissal of this action pursuant to 12(b)(6) of the Federal Rules of Civil Procedure and, therefore, should be stricken (a) as Registrant has, by not filing a motion to dismiss concurrently with its answer, waived all Rule 12(b)(6) motions; and (b) because the Petitioner has, indeed, stated a claim upon which relief can be granted. *See, e.g., Hornblower & Weeks, Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

The Registrant's second affirmative defense, which states there is no likelihood of confusion, is but an amplification of a denial and should thus be stricken. In addition, Registrant's third, ninth, and eleventh affirmative defenses –alleging inequitable conduct, abandonment, and fraud – should also be stricken as redundant and duplicative of Registrant's Counterclaims. *See* §TBMP 311.02(b)(noting that defenses raised by way of a counterclaim should not also be plead as affirmative defenses). Thus, as more fully explained below, Petitioner requests that the Board strike Registrant's first, second, third, ninth, and eleventh affirmative defenses.

A. Registrant's First Affirmative Defense – Failure to State a Claim.

A motion to strike is an appropriate procedure for challenging the sufficiency of an affirmative defense based on failure to state a claim on which relief can be granted. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ 2d 1221, 1221-1223 (TTAB 1995), *citing S.C. Johnson & Son, Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973); *accord* TBMP § 506.01, n.98. Here, the Registrant did not serve a Rule 12(b)(6) motion to dismiss concurrently with, or prior to, the service of its Answer; therefore, the Board should deem that Registrant was waived any defense of failure to state a claim. *See Motion Picture Association of America, Inc. v. Respect Sportswear, Inc.*, 83 USPQ 2d 1555 n.5 (TTAB 2007).

Nevertheless, even if properly filed, such a defense should fail as the Petitioner has properly alleged (1) a personal interest in the outcome of the case and (2) facts that, if proven, would demonstrate a likelihood of confusion between the Petitioner's mark and the mark featured in the registration Petitioner seeks to cancel. *See* Registrant's Petition to Cancel ¶¶ 1-12. Thus, the Petitioner has alleged facts capable of establishing Petitioner's standing to maintain the proceeding; and a valid ground for cancellation of the registration. *See Order of Sons*, 36 USPQ 2d at 1221-1223 (articulating the prerequisites to withstanding a motion to dismiss or failure to state a claim.) Consequently, Registrant's first affirmative defense should be stricken as Registrant has waived all Rule 12(b)(6) motions and/or as Petitioner has met the requirements to withstand such a defense.

B. Registrant's Second Affirmative Defense – No Likelihood of Confusion.

The Registrant's Second Affirmative Defense, which denies that there is a likelihood of confusion, is nothing more than an improper amplification of a denial contained in its answer, and should thus be stricken. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ 2d 1221, 1223 (TTAB 1995); and *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973).

C. Registrant's Third, Ninth, and Eleventh Affirmative Defenses

In addition, Registrant's third, ninth, and eleventh affirmative defenses, which are based on inequitable conduct, abandonment, and fraud, should be stricken as repetitious and unnecessary. *See* §TBMP 311.02(b)(stating that defenses raised by way of a counterclaim should not also be plead as affirmative defenses); *see also Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (motion to strike affirmative defense predicated on same facts alleged in counterclaim granted as representing, in effect, a collateral attack on registration); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (motion to strike affirmative defense which allegations formed basis for counterclaim granted as the affirmative defense was repetitious and unnecessary).

Specifically, Registrant's ninth affirmative defense for abandonment based on non-use raises the identical claim plead in Registrant's First Counterclaim which alleges abandonment of Petitioner's Registration due to non-use. Similarly, Registrant's Second and Third Counterclaims, which allege that Petitioner's engaged in fraud and fraudulent filed renewal declarations, are (1) identical to the claims presented in Registrant's eleventh affirmative defense; and (2) are prefaced on the same allegations that form the basis Registrant's third affirmative defense. Given the foregoing, Registrant's third, ninth, and eleventh affirmative defenses should be stricken as redundant and unnecessary. *See* §TBMP 311.02(b).

II. DISMISSAL OF REGISTRANT'S THIRD COUNTERCLAIM IS WARRANTED.

Petitioner also requests dismissal of Registrant's Third Counterclaim as the facts alleged therein, even if proven, would not provide valid grounds for the cancellation of Petitioner's registration. *See, e.g., William &*

& Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1870 (TTAB 1994)(setting forth the basis for a motion to dismiss for failure to state a claim upon which relief can be granted.)

Registrant's Third Counterclaim seeks to cancel Petitioner's registration based on an allegedly fraudulent Section 8 & 9 Renewal Declaration filed on April 21, 2010. The foregoing claim is prefaced on two factual allegations, namely, (1) that Attorney Oliver A. Ruiz was not properly authorized to sign and file Petitioner's Renewal Declaration; and (2) that the specimens submitted in connection with the April 21, 2010 Renewal Declaration were inadequate. As noted below, however, neither of these allegations – even if proven – would provide a valid ground for the cancellation of Petitioner's registration.

A. Attorney Ruiz Was Authorized to Sign and File Petitioner's Renewal Declaration.

There are several circumstances under which a power of attorney submitted in connection with an application or registration is deemed to have lapsed. A power of attorney filed with in connection with a pending application, for example, is deemed to lapse once the application proceeds to registration. TMEP §604.02; 37 C.F.R. §2.17(g)(1). Similarly, a power of attorney filed in connection with a renewal application ends upon the Examining Attorney's acceptance or a final rejection of the filing. *See* TMEP §604.02; 37 C.F.R. §2.17(g)(2). As the Registrant has noted, Petitioner filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 of the Lanham Act through Attorney James F. Gossett with the United States Patent & Trademark Office ("USPTO") on June 8, 2007. *See* Exhibit D to Registrant's Answer. As reflected in the USPTO's records, this Declaration of Use and Incontestability was accepted on July 12, 2007. Thus, under the applicable rules, therefore, the power of attorney granted to Attorney James F. Gossett was terminated upon acceptance of this Declaration on July 12, 2007. *See* TMEP §604.02; 37 C.F.R. §2.17(g)(2). Thus, Petitioner was properly viewed as *pro se* by the USPTO prior to Attorney Oliver Ruiz's April 21, 2010 filing.

There is a presumption that a signatory has authority to represent a registrant provided that the "[p]erson signing for a previously *pro se* applicant or registrant identifies him/herself as an attorney in good standing of the bar of the highest court of any state in the United States who is practicing abroad." TMEP

§611.04 As discussed above, Petitioner was rendered *pro se* following the USPTO's acceptance of the Declaration of Use and Incontestability on July 12, 2007. Therefore, Attorney Ruiz -- an attorney in good standing of the Florida Bar -- was correctly presumed to possess authority to represent the previously *pro se* Petitioner. See TMEP §611.04 Moreover, because a renewal application may be signed by a registrant's representative, Attorney Ruiz had full authority to file the renewal application and would properly assume power of attorney upon submitting the filing. See 37 C.F.R. §2.183(a); see also TMEP §1612 (providing that the USPTO's electronic record will be automatically updated to indicate the name of the practitioner filing a document.)¹

The foregoing presumption regarding a signatory's authority will not be questioned by the USPTO unless the record indicates an inconsistency regarding the signatory's authority to sign on behalf of the registrant. TMEP §1606.07. Here, Registrant has not alleged the existence of any inconsistency -- and, in fact, the record contains no inconsistency -- regarding Attorney Ruiz's authority to sign on behalf of registrant. See TMEP §1606.07. Thus, Registrant has failed to make any factual allegations which-- if true -- provide valid grounds for the cancellation of Petitioner's registration based on fraud.

B. Issues Regarding the Adequacy of Petitioner's Specimens Do Not Give Rise to Fraud.

Registrant also alleges that Petitioner's registration should be cancelled based on the inadequacy of the specimens submitted in connection with Petitioner's April 21, 2010 Renewal Declaration. However, a review of pertinent case law indicates that "an allegation of the sufficiency of what was submitted in an application is a technical question which is within the province of the examining attorney to determine and cannot form the basis of a proceeding before the Board." *FCH Enters. v. Douvris*, 2008 TTAB LEXIS 533, 10-11 (TTAB 2008)(citing *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989)(stating that "fairness dictates that the ex parte question of the sufficiency of the specimen not be the basis for [a proceeding]).") Thus, Registrant's Third Counterclaim -- as well as those portions of Registrant's Second Counterclaim discussed below, prefaced on the adequacy of materials submitted to and inspected by an

¹ For this reason, Attorney Ruiz was not required to file a separate power of attorney document and, therefore, Registrant's allegations regarding an Attorney Ruiz's authority to execute a Power of Attorney, see Registrant's

inspected by an examining attorney – constitutes an improper request for the Board to “substitute its judgment for that of the examiner.” See *Granny's Submarine Sandwiches v. Granny's Kitchen Inc.*, 199 USPQ 564, 567 (TTAB 1978) (the Board will not substitute its judgment for that of the examiner); *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 642 (TTAB 1977) (it is not the Board's function to review or supervise the work of the examiner).

Nevertheless, even if the Board decides that it may properly review of the adequacy of Petitioner’s specimens, the factual allegations in Registrant’s Counterclaim would not give rise to a cancellation claim based on “fraudulent renewal.” Fraud “implies some intentional deceitful practice or act designed to obtain something to which the person practicing such deceit would not otherwise be entitled” and “involves a willful withholding from the Patent and Trademark Office by an applicant or registrant of material information which, if disclosed to the Office, would have resulted in disallowance of the registration sought or to be maintained.” *In-Flight Phone Corporation v. J. Anselmo, Inc.*, 1998 TTAB LEXIS 55, 10-13 (TTAB 1998). As the intent to deceive must be “willful”, fraud will not be found if it can be shown that the statement was a “false misrepresentation” occasioned by an “honest misunderstanding, inadvertence, negligent omission or the like rather than one made with a willful intent to deceive.” *Id.*; *Torres v. Cantine Torresella S.r.L.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) (noting that fraud occurs “when an applicant knowingly makes false, material representations of fact in connection with his application.”) Here, neither of Registrant’s allegations indicate that fraud has occurred.

Initially, Registrant alleges that the Petitioner’s specimens were improper as they contain a reference to Petitioner’s fictitious name rather than its corporate name. However, “[t]he USPTO does not inquire about the relationship between the applicant and other parties named on the specimen or elsewhere in the record, except when the reference to another party clearly contradicts the applicant’s verified statement that it is the owner of the mark or entitled to use the mark.” TMEP §1201.04. A review of Petitioner’s registration records demonstrates that Petitioner had previously provided the USPTO with its fictitious name, namely, Vitanergy. See Exhibit A to Registrant’s Answer (describing “the owner” of the Registration as “Natural Supplements and

Answer at ¶¶31-32, are irrelevant and would not affect the validity of Petitioner’s Renewal.

and Remedies, Inc. d/b/a Vitanergy.) Thus, as the presence of Petitioner's fictitious name on a specimen did not contradict the applicant's verified statement regarding ownership, the examining attorney correctly deemed that they could be properly accepted without the need for additional information.

Registrant also alleges that Petitioner's specimens are inadequate because a date -- June 18, 2000-- appears on a specimen. However, the mark displayed in the specimen, "is essentially the same as the mark that appears in the registration." TMEP §1604.13 (describing acceptable specimens.) Moreover, the Petitioner's specimens included the address to Petitioner's website. *See* Exhibit M to Registrant's Answer. A review of this information would have made it "plainly evident" to the examining attorney "whether specimen supported an application to register the mark for the listed goods." *See This Little Piggy Wears Cotton v. Piggy Toes*, 2004 TTAB LEXIS 447, 13-14 (TTAB 2004) (observing that "the question whether the specimen showed use of the applied-for mark for the goods listed in the involved application was a matter to be determined by the Examining Attorney, and it would have been plainly evident whether the specimen supported an application to register the mark for the listed goods.")

"[T]his is not a case in which the applicant withheld information or material from the Examining Attorney which would have been necessary for the Examining Attorney to determine whether the specimen was sufficient; nor is it a case in which applicant is alleged to have outfoxed the Examining Attorney by fabricating a specimen. In short, any deficiency in the specimen would have been readily apparent to the Examining Attorney and could not have led to unwarranted approval of the mark for publication." *Id.* at *13-14 (emphasis added). Here, a review of the website advertised on Petitioner's specimens would have verified that Petitioner was actively using the same mark displayed in the specimen. As such, Registrant has not provided any facts indicating that Petitioner was "not using the mark as registered and that the label attached to the registration [wa]s not currently in use." *Torres.*, 808 F.2d. at 46 (describing the intent behind a fraudulent renewal.); *compare Morehouse Mfg. Co. v. J. Strickland and Co.*, 407 F.2d 881, 56 C.C.P.A. 946, 160 USPQ 715, 720 (CCPA 1969)(noting that nothing is to be gained from and no public purpose is served by cancelling the registration of a technically good trademark because of a minor technical defect in an affidavit.)

affidavit.)

Consequently, Registrant's counterclaim is prefaced on an issue, namely, "the adequacy of the specimen to demonstrate use of the registered mark . . . that does not go to the issue of fraud." *See Paris Glove of Can. v. SBC/Sporto Corp.*, 2007 TTAB LEXIS 84, 22-25 (TTAB 2007). Registrant's Third Counterclaim fails to provide any valid grounds for the cancellation of Petitioner's registration and should be dismissed.

III. MOTION TO STRIKE ¶¶ 15 AND 24 OF REGISTRANT'S SECOND COUNTERCLAIM

Lastly, certain portions of Registrant's Second Counterclaim – which is also prefaced on fraud -- contain immaterial allegations that should be stricken. Specifically, Paragraphs 15 and 24 of Registrant's Second Counterclaim are predicated on allegations regarding the inadequacy of Petitioner's specimens which, for the reasons stated in Section II.B. and incorporated by reference herein, are immaterial and should, therefore, be stricken.

IV. CONCLUSION.

As noted above, Registrant's first affirmative defense should be stricken as (1) Registrant has waived all Rule 12(b)(6) motions and (2) Petitioner has met the requirements to withstand a motion to dismiss for failure to state a claim. In addition, the Board should strike Registrant's second affirmative defense as an improper amplification of a denial; and, the Board should strike Registrant's third, ninth, and eleventh affirmative defenses as they merely duplicate and repeat Registrant's counterclaims. The Board should also strike Paragraphs 15 and 24 of the Registrant's Second Counterclaim, as these portions of the counterclaim are predicated on immaterial allegations that do not give rise to a claim for fraud and, moreover, cannot form the basis for a cancellation proceeding.

Finally, Petitioner requests dismissal of Registrant's Third Counterclaim as neither the Registrant's allegation regarding the adequacy of Petitioner's specimens, nor the Registrant's allegation regarding Attorney Ruiz's authority to sign and file Petitioner's Renewal Declaration, provides a valid ground for cancellation of the registration based on fraudulent renewal.

WHEREFORE, Petitioner requests that the Board grant the instant motion and dismiss Registrant's Third Counterclaim and strike the Registrant's first, second, third, ninth, and eleventh affirmative defenses, as well as, Paragraphs 15 and 24 of Registrant's Second Counterclaim.

Respectfully submitted,

Dated: September 27, 2010

By: /Francisco J. Ferreiro/
John Cyril Malloy, III
Florida Bar No. 964,220
Oliver Alan Ruiz
Florida Bar No. 524,786
Francisco J. Ferreiro
Florida Bar No. 37,464
MALLOY & MALLOY, P.A.
Attorneys for Petitioner
2800 S.W. Third Avenue
Miami, Florida 33129
Telephone: (305) 858-8000
Facsimile: (305) 858-0008
Email: oruiz@malloylaw.com,
fferreiro@malloylaw.com

CERTIFICATE OF FILING

I HEREBY CERTIFY that the foregoing Motion to Strike Affirmative Defenses and Motion to Dismiss Third Counterclaim was filed electronically via the ESTTA, at the United States Patent and Trademark Office, Trademark Trial and Appeal Board's ESTTA electronic filing system, on September 27, 2010.

By: /Francisco J. Ferreiro/
Francisco J. Ferreiro
Florida Bar No. 37,464

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on September 27, 2010, a true and complete copy of the foregoing Motion to Strike Affirmative Defenses and Motion to Dismiss Third Counterclaim was served by U.S. Mail on the following:

Kurt Koenig, Esq.
Koenig & Associates
920 Garden Street, Suite A
Santa Barbara, CA 93101

Respectfully submitted,

By: Francisco J. Ferreiro
Francisco J. Ferreiro
Florida Bar No. 37,464