

ESTTA Tracking number: **ESTTA393406**

Filing date: **02/15/2011**

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

Proceeding	92053426
Party	Plaintiff Bachmann Industries, Inc.
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Submission	Motion to Strike
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Date	02/15/2011
Attachments	PRTITIONERS MOTION TO STRIKE 92053426.PDF (7 pages)(272757 bytes)

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

In the matter of Trademark Registration No. 3,567,168
Mark: EZTEC

Bachmann Industries, Inc.

Petitioner,

v.

Cancellation No. 92,053,426

Scientific Toys, Ltd.

Respondent.

**PETITIONER'S MOTION TO STRIKE PARAGRAPHS 30 AND 31 IN
RESPONDENT'S AFFIRMATIVE
DEFENSES FOR LEGAL INSUFFICIENCY**

Pursuant to 37 C.F.R. § 2.127(a) and TBMP § 506.01, Petitioner, Bachmann Industries, Inc., through its counsel, submits this motion to strike Respondent, Scientific Toys, Ltd.'s, *Morehouse* and related laches defenses in Paragraphs 30 and 31 of Respondent's Affirmative Defenses on the grounds of legal insufficiency.

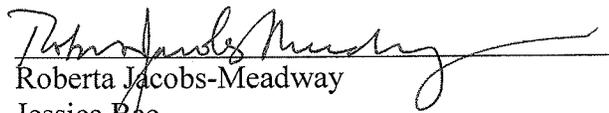
Any insufficient defense may be stricken from a pleading upon either a motion, or *sua sponte* by the Trademark Trial and Appeal Board. FRCP 12(f); TBMP § 506.01. Paragraphs 30 and 31 of Respondent's Answer, Affirmative Defenses and Counterclaim contains the affirmative defense of laches. Respondent claims that "[Petitioner's] claims are barred under the *Morehouse* laches (sic) defense...because [Respondent] already owns a Registration for a similar mark for related goods." This affirmative defense is legally insufficient as Respondent's goods identified in the prior registration are not "identical, substantially the same, or so related as

to represent in law a distinction without a difference” to the goods in the registration at issue. *Mag Instrument, Inc. v. The Brinkmann Corp.*, Opposition No. 91/163,534 (TTAB July 28, 2010).

Accordingly, Petitioner respectfully requests Paragraphs 30 and 31 of Respondent’s affirmative defenses be stricken from the record and otherwise be given no consideration.

Respectfully submitted,

Date: February¹⁵, 2011


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**MEMORANDUM IN SUPPORT OF PETITIONER'S MOTION TO STRIKE
PARAGRAPHS 30 AND 31 OF RESPONDENT'S AFFIRMATIVE
DEFENSE FOR LEGAL INSUFFICIENCY**

Under 37 C.F.R. § 2.127, “upon motion...the Board may order stricken from a pleading any insufficient defense.” *See also* FRCP 12(f). Respondent has alleged in Paragraph 31 in its Affirmative Defenses that Petitioner’s “claims are barred under the *Morehouse* latches (sic) defense...because [Respondent] already owns a Registration for a similar mark for related goods. Respondent’s registration at issue in this proceeding is directed to “toys, namely, remote controlled, radio controlled, and battery operated vehicles, trains, train sets, helicopters, submarines, boats, musical instruments, pinball machines, animals, and insects” in International Class 28. Respondent’s prior registration on which it seeks to rely and which Respondent claims is for similar goods, is directed to “toys, namely, toy typewriters, toy telephones, toy teaching clocks, and toy pre-recorded musical players.” Petitioner submits that the goods in Respondent’s registrations are not sufficiently similar to sustain the *Morehouse* latches defense and such defense should accordingly be stricken pursuant to 37 C.F.R. § 2.127 and FRCP 12(f).

“The prior registration or *Morehouse* defense is an equitable defense, to the effect that if the opposer cannot be further injured because there already exists an injurious registration, the opposer cannot object to an additional registration that does not add to the injury.” *O-M Bread Inc. v. United States Olympic Comm.*, 65 F.3d 933, 938, 36 U.S.P.Q.2d 1041, 1045 (Fed. Cir. 1995).

In order for the *Morehouse* defense to apply, the registrations must be “identical, substantially the same, or so related so as to represent in law a distinction without a difference.”

Mag Instrument, Inc. v. The Brinkmann Corporation, Opp. No. 91/164,169 (TTAB July 28, 2010) quoting *Aquion Partners Limited Partnership v. Envirogard Products Limited*, 43 U.S.P.Q.2d 1371, 1373 (TTAB 1971).

Respondent necessarily contends in raising the *Morehouse* defense that “toy typewriters, toy telephones, toy teaching clocks, and toy pre-recorded musical players” are substantially identical to “remote controlled, radio controlled, and battery operated vehicles, trains, train sets, helicopters, submarines, boats”, such that no additional harm would come to Petitioner by virtue of the second registration. While the goods identified in such registration may broadly be described as toys, that is legally insufficient as a predicate for a *Morehouse* defense. It is not enough that the goods “in the application and registrations may fall under the same broad umbrella.” *Citigroup v. Capital City Bank Group*, Opp. No. 91/177,415 (TTAB February 16, 2010). The registrations must be for goods that are essentially the same. *See id.*

In *Citigroup*, the Board held that “electronic processing and transmission of bill payment data; brokerage and administration services in the field of securities...” though all classified as financial services, were not essentially identical to a prior registration for “banking services.” The Board, in *The Mag Instrument Inc. v. The Brinkman Corp.*, held that flashlights and hand-held spotlights were “two separate categories of hand-held lighting products” and therefore, the Applicant could not rely on the *Morehouse* laches defense.

In this case, that goods identified in the prior registration are substantially different than the goods which are identified in the registration which is the subject of this proceeding and which are the basis for the petition: in particular, toy trains and train sets. Respondent’s first registration does not identify any category of toy vehicle. There is no overlap in identified goods

between Respondent's two registrations other than musical instruments, and even those are not the same.

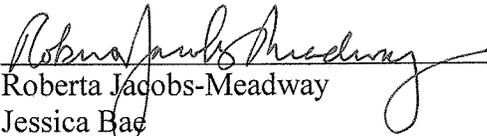
Respondent's prior registration raised no conflict with Petitioner's rights because it did not include toy trains and train sets and such related goods as toy vehicles. However, the registration in issue does include toy trains and train sets, which directly conflict with Petitioner's goods, which are described as "toy train sets; toy trains; accessories for toy trains, namely toy train tracks and couplers for toy railway carriages." *See* Petition for Cancellation, Paragraphs 3-9, 16.

The goods identified in Respondent's prior registration such as toy telephones and typewriters and those identified in the current registration which is the subject of this proceeding are clearly not "identical" or "substantially the same" and they are not related except to the extent that they are broadly categorized as toys. The *Morehouse* defense is inapplicable. Flashlights and hand-held spotlights were not considered similar enough to sustain a *Morehouse* defense. Toy trains and teaching clocks are even less related, and a prior registration for teaching clocks cannot be the basis for invoking a laches defense against a proceeding directed to a registration for toy trains.

As Respondent's prior registration and registration in issue are not sufficiently similar to warrant consideration of the affirmative defense of laches, Petitioner respectfully requests that this Board strike the affirmative defenses in Paragraphs 30 and 31 of Respondent's Affirmative Defenses.

Respectfully submitted,

Date: February 15, 2011

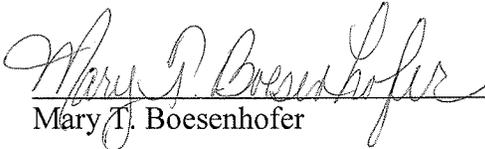

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Attorney for Petitioner – Bachmann Industries, Inc.

CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing Petitioner's Motion to Strike Respondent's Affirmative Defense was served on counsel for the Respondent on the date listed below via electronic mail and Federal Express Overnight Delivery:

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Date: 2-15-11