

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: May 2, 2011

Cancellation No. 92053773

Jeffrey Kaplan

v.

Del Monte Corporation

By the Trademark Trial and Appeal Board:

On April 27, 2011, respondent filed its answer. On April 28, 2011, petitioner filed a motion to strike the affirmative defenses from that answer. In the interest of resolving the motion to strike without further delay, the Board determined that a telephone conference was warranted. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a) (2d ed. rev. 2004). On April 29, 2011, such conference was held between petitioner Jeffrey Kaplan, respondent's attorneys Beth M. Goldman and Chelsea E.L. Bush, and Board attorney Andrew P. Baxley.

Petitioner's arguments in support of his motion are set forth in his brief and will not be summarized in this order. In response, respondent contends that its affirmative defenses are adequately pleaded and that the Board denied a motion to strike essentially the same affirmative defenses

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from an answer to another petition to cancel that petitioner filed.

The Board may strike any insufficient defense from a defendant's answer. See Fed. R. Civ. P. 12(f); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (insufficient affirmative defenses stricken); *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973) (affirmative defense of failure to state a claim upon which relief can be granted stricken since complaint did state such a claim); TBMP Section 506.01.

As respondent's first affirmative defense, respondent alleges that petitioner has failed to state a claim. An affirmative defense of failure to state a claim is an attack on the sufficiency of a complaint. See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221 (TTAB 1995); *S.C. Johnson & Son Inc. v. GAF Corp.*, *supra*. To overcome such an attack, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for cancelling the registration(s) at issue. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Petitioner has adequately pleaded his standing in paragraphs 5-7 of the petition to cancel by alleging that he intends to use and register an identical mark for identical goods, by virtue of

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his pending application Serial No. 85269420, which was filed on the same day as the petition to cancel. See *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990); TBMP Section 309.03(b) (2d ed. rev. 2004). In addition, petitioner has adequately pleaded an abandonment claim in paragraph 4 of the petition to cancel based on discontinuation of use of the registered mark for three years or more with no intent to resume use. See *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007). Accordingly, petitioner, in the petition to cancel, has alleged facts sufficient to overcome an affirmative defense of failure to state a claim.¹ Respondent's first affirmative defense is therefore stricken.

As respondent's fourth affirmative defense, respondent alleges that the petition to cancel is barred by unclean hands. However, the equitable defense of unclean hands is unavailable against an abandonment claim. See *American Vitamin Products Inc. v. DowBrands Inc.*, *supra*; *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989). Respondent's fourth affirmative defense is therefore stricken.

As respondent's second and third affirmative defenses, respondent alleges that petitioner does not have standing to bring the petition to cancel because: (1) he does not have a bona fide intent to use his pleaded mark; and (2) because

¹ Whether or not petitioner can ultimately prevail herein is a matter for resolution on the merits. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

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he did not have a bona fide intent to use his pleaded mark when he filed his pleaded application. Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark "'in the ordinary course of trade, ... and not ... merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. Section 1127, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988). That is, an applicant must possess an ability and willingness to use the mark as a source indicator for its identified goods at the time of the filing of the application. See *Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1664 (TTAB 2009).

Although petitioner has sufficiently pleaded his standing, respondent may raise an affirmative defense challenging petitioner's assertion in his pleaded application that he has a bona fide intent to use his pleaded mark in commerce. See *Salacuse v. Ginger Spirits*

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Inc., 44 USPQ2d 1415 (TTAB 1997). Because petitioner bears the ultimate burden of proof on the standing issue, petitioner may be required to go beyond the mere pendency of his application and establish his entitlement to file the application upon which his standing claim is based. See *id.* The second and third affirmative defenses provide notice that respondent intends to require that petitioner establish his entitlement to file his pleaded application.

However, to the extent that respondent alleges in the third affirmative defense that petitioner has committed fraud upon the USPTO because he lacked a bona fide intent to use his pleaded mark when he filed his pleaded application, the fraud allegation is insufficient. In particular, respondent has not alleged that petitioner falsely averred in his pleaded application that he has a bona fide intent to use his pleaded mark in commerce with the intent of obtaining or maintaining a registration to which he is otherwise not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Accordingly, the motion to strike is granted with regard to the first sentence of respondent's third affirmative defense, but is denied with regard to the second affirmative defense and the remainder of the third affirmative defense.

Regarding respondent's assertion that the Board denied a motion to strike essentially the same affirmative defenses

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was denied in another proceeding in which petitioner is plaintiff,² such denial is not a citable precedent and is not binding upon the Board. *Citation of Opinions to the Trademark Trial and Appeal Board*, Official Gazette, January 23, 2007, online at

www.uspto.gov/web/offices/com/sol/og/2007/week04/patcita.htm.

While non-precedential decisions may be cited for whatever persuasive value they might have, the Board cannot err by failing to follow a non-precedential decision, except under circumstances not at issue here.³ See *id.*; TBMP Section 101.03.

In view thereof, petitioner's motion to strike is granted with regard to respondent's first and fourth affirmative defenses and the first sentence of respondent's third affirmative defense, but is denied with regard to the second affirmative defense and the remainder of the third affirmative defense.⁴

² Respondent is apparently referring to a January 12, 2011 order that was issued in Cancellation No. 92052991, styled *Kaplan v. Johnson & Johnson*.

³ In addition, the Board notes that, in Cancellation No. 92052482, styled *Kaplan v. Brady*, the Board stated in a November 15, 2010 order that the equitable defense of unclean hands was unavailable against the pleaded abandonment claim.

⁴ Petitioner, who is representing himself herein and who is a party to numerous other Board proceedings, is reminded that he is expected to comply with all applicable rules and Board practices during the remainder of this case.

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Dates remain as set in the Board notice instituting this proceeding.