

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

Baxley

Mailed: October 6, 2011

Cancellation No. 92054155

Michigan Job Training
Partnership Association

v.

David E Hoffman Jr

By the Trademark Trial and Appeal Board:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on the afternoon of October 5, 2011.¹ Participating in the conference were petitioner's attorneys Leon E. Redman and Elizabeth F. Janda, respondent David E. Hoffman, Jr., and Board interlocutory attorney Andrew P. Baxley.

The Board noted initially that respondent intends to represent himself in this proceeding. While Patent and Trademark Rule 10.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in Board *inter partes* proceedings to secure the services of an attorney who is familiar with

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such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

In addition, respondent is reminded that Trademark Rule 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which respondent may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as *prima facie* proof of service.

In defending the petition to cancel, respondent should review the Trademark Rules of Practice, online at <http://www.uspto.gov/trademarks/law/tmlaw.pdf>, and the Trademark Board Manual of Procedure ("TBMP"), online at <http://www.uspto.gov/trademarks/process/appeal/PrefaceTBMP.jsp>. The Board expects all parties appearing before it, whether or not they are represented by an attorney, to comply with the Trademark Rules of Practice and where applicable, the Federal Rules of Civil Procedure, online at <http://www.law.cornell.edu/rules/frcp/>.

¹ Petitioner requested Board participation by telephone on

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In addition, respondent is advised that, under Trademark Rule 11.18(b),

[b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP Section 527.02.

The parties indicated that they have not previously discussed settlement of this case. The parties further indicated that they were involved in a proceeding with administrators of Facebook.com, which resulted in petitioner's content related to its pleaded marks being removed from that website.

The parties, however, agreed to service of filings by e-mail.² Although respondent sought to restrict discovery to publicly available documents, petitioner would not agree to such a restriction. The Board attorney noted that discovery in Board proceedings is generally not restricted to publicly available documents.

September 28, 2011.

² As a backup, the parties should also make follow-up service by mail.

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The Board reminded the parties of the automatic imposition of the Board's standard protective order in this case. The standard form protective order is online at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>. If the parties wish to add or modify any provisions to the standard protective order, they may negotiate an amended protective agreement, subject to Board approval.

The Board further reminded the parties that, pursuant to the Board's recent rule amendments, neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f).

The parties were advised that the Board will consider at final hearing a printout of an excerpt from an Internet website that is submitted under notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e), where that printout identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL). See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).

The Board then reviewed the pleadings in this case. In the petition to cancel, petitioner has adequately pleaded

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its standing. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). That is, the statements in paragraphs 1-4 and 11-13 of the petition to cancel allege facts which would show a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damages. See *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). In addition, petitioner sets forth a claim of likelihood of confusion with its previously used marks JOBFORCE, THE JOB FORCE BOARD, and MICHIGAN WORKS! THE JOB FORCE BOARD for providing "leadership training and support services to promote quality and excellence for the advancement of the workforce development system and its customers and professionals" under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), in paragraphs 1-10 of the petition to cancel.³

Respondent, in his answer, denied the salient allegations of the petition to cancel and asserts

³ The fact that respondent alleged to administrators of Facebook.com that petitioner's pleaded marks infringe his rights in his registered marks might not operate as a judicial estoppel against respondent's asserting that there is no likelihood of confusion between the marks at issue if there was no judicial proceeding in which petitioner alleged such infringement. See *Interactive Gift Express Inc. v. Compuserve Inc.*, 256 F3d 1323, 59 USPQ2d 1401, 1418 (Fed. Cir. 2001); *Boston Chicken Inc. v. Boston Pizza International Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999). If not, respondent's allegation of infringement would be a fact for the Board to consider in reaching its own conclusion regarding likelihood of confusion between the marks. See *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153-154 (CCPA 1978).

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affirmative defenses⁴ that: (1) petitioner has failed to state a claim; (2) petitioner is not a real party in interest and therefore lacks standing; (3) petitioner failed to oppose registration of respondent's mark during the "normal 'due process of law;'" (4) petitioner lacks standing; and (5) failure to prove a ground for cancellation.

Regarding the "second" defense that petitioner has failed to state a claim, such defense is not a true affirmative defense. Rather, an affirmative defense is an "assertion of facts and arguments that, if true, will defeat [a] plaintiff's ... claim, even if all the allegations in the complaint are true." *Black's Law Dictionary* (9th ed. 2009). Moreover, this "defense" is effectively waived because respondent did not file a motion to dismiss for failure to state a claim concurrently with his answer. See *Motion Picture Ass'n of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555 (TTAB 2007). In any event, a sufficiently pleaded claim requires only allegations of sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. See *Lipton Industries, Inc. v. Ralston*

⁴ Respondent has captioned his responses to the allegations of the petition to cancel as his "first defense." Such responses are not affirmative defenses and should not be captioned as such.

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Purina Co., supra. As noted *supra*, petitioner has adequately pleaded its standing and a Section 2(d) claim.⁵

⁵ A mark may be refused registration under Trademark Act Section 2(d) where it

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, **or a mark or trade name previously used in the United States by another and not abandoned**, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

(emphasis added). In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the Court of Customs and Patent Appeals, our reviewing court's predecessor, discussed the factors relevant to a determination of likelihood of confusion:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere 'consent' to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.

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Accordingly, the Board *sua sponte* strikes respondent's "second" defense. See Fed. R. Civ. P. 12(f); TMBP Section 506.01.

Regarding respondent's "third" defense that petitioner lacks standing because it is not a real party in interest, "an action must be prosecuted in the name of the real party in interest." Fed. R. Civ. P. 17(a)(1). That is, a "person entitled by law to enforce a substantive right should be the one under whose name the action is prosecuted." *Black's Law Dictionary* (9th ed. 2009). Whether or not petitioner can establish its entitlement to seek cancellation of respondent's mark goes to whether petitioner can establish its standing, which is a matter for resolution on the merits. Likewise, respondent's "fifth" and "sixth" defenses that petitioner lacks standing and that petitioner has not proven a ground for cancellation of the involved registration are matters for resolution on the merits.

(13) Any other established fact probative of the effect of use.

The goods or services at issue do not have to be identical or even competitive in order to determine that there is a likelihood of confusion. The issue is not whether the goods will be confused with each other, but rather whether the public will be confused about their source. See *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975). It is sufficient that the goods or services at issue are so related that the circumstances surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that would give rise to the mistaken belief that they originate from the same source. See *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

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However, regarding respondent's "fourth" defense that, notwithstanding that petitioner has long known of both respondent's claim of ownership of the involved mark in the United States and of respondent's involved registration, respondent failed to opposer such claim of ownership, petitioner is allowed until five years from the March 31, 2009 date of registration to seek cancellation thereof under Trademark Act Section 2(d). See Trademark Act Section 14, 15 U.S.C. Section 1064. To the extent that respondent intends to plead an affirmative defense of laches, the elements of laches are (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the latter attributable to the delay. See *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992). Laches runs from January 13, 2009, the date that the application for respondent's involved registration was published for opposition. See *Nat'l Cable Television Ass'n Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1431-32 (Fed. Cir. 1991). Moreover,

Such defense is insufficiently pleaded because respondent has not alleged any specific conduct regarding how petitioner became aware of the involved registration or the underlying application therefor and any prejudice resulting from any delay in seeking cancellation of the

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registration at issue.⁶ See *Heisch v. Katy Bishop Productions Inc.*, 45 USPQ2d 1219 (N.D. Ill. 1997); Wright & Miller, *Federal Practice and Procedure: Civil 2d*, Section 1274 (1990 & Supp. 2001). Accordingly, the Board *sua sponte* strikes respondent's "fourth" defense. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

The parties indicated that they are not interested in pursuing ACR at that time. The parties are directed to review the Board's website regarding ACR at http://www.uspto.gov/web/offices/com/sol/notices/acrognotice_rule.pdf. If the parties later agree to pursue ACR after some disclosures and discovery, they should notify the above-signed interlocutory attorney by not later than two months from the opening of the discovery period.

Respondent indicated that he had owned a state registration for his involved mark. However, "such registration has ... little or no bearing on the respective rights of the parties" in this proceeding. *State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25, 26 fn.2 (TTAB 1976).

⁶ In any event, the Board is unaware of a defendant in a Board proceeding prevailing on a defense of laches based on failure to take action against a registration less than two and a half years after the application for that mark was published for opposition. See, however, *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203 (TTAB 2006).

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In view of the claims herein, the parties are urged to focus their discovery on priority of use, the relatedness of the services at issue, and the extent of third party use of similar marks in connection with related goods and services,

If the parties appear to be uncooperative in discovery, the Board may require a telephone conference prior to the filing of motions to compel discovery. See TBMP Section 408.01.

If either party files an unconsented motion to extend or suspend in this case, the moving party must contact the Board interlocutory attorney assigned to the case by telephone upon filing so that such motion can be resolved promptly by telephone conference.

Regarding discovery depositions, pursuant to Fed. R. Civ. P. 30(b)(4), the parties may take and appear for such depositions by telephone. The parties may also appear in person for such depositions.

All dates herein remain as last reset in the Board's July 26, 2011 order. The next significant due date herein is November 2, 2011, when the parties initial disclosures are due. See Fed. R. Civ. P. 26(a)(1)(A)(i) and (ii) regarding required initial disclosures.

The Board thanks the parties for their participation.