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

Proceeding	92060016
Party	Plaintiff Mecum Auction Inc.
Correspondence Address	DANIEL E KATTMAN REINHART BOERNER VAN DEUREN SC 1000 NORTH WATER STREET , SUITE 1900 MILWAUKEE, WI 53202-3186 UNITED STATES tmadmin@reinhardt.com
Submission	Motion to Strike
Filer's Name	Daniel E. Kattman
Filer's e-mail	tmadmin@reinhardt.com
Signature	/dek/
Date	12/23/2014
Attachments	Dealmaker Motion to Strike Aff Defenses.pdf(97182 bytes )

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

Mecum Auction Inc.	:	
	:	Cancellation No. 92060016
Plaintiff,	:	Trademark Registration No. 2600589
	:	For the mark: DEALMAKER
	:	Registered on July 30, 2002
	:	
v.	:	
	:	
Dealmaker, LLC	:	
	:	
Registrant.	:	

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PLAINTIFF'S MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES IN  
REGISTRANT'S ANSWER AND TO SUSPEND PROCEEDINGS

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Mecum Auction Inc. ("Plaintiff") hereby moves pursuant to Fed. R. Civ. P. 12(f) and TBMP § 503 to strike Defendant's affirmative defenses set forth in the Answer of Dealmaker, LLC ("Registrant") as immaterial, irrelevant or insufficient claims.

Additionally, as the Board's determination of Plaintiff's motion will affect the scope of discovery in this proceeding, Plaintiff moves that the proceeding be suspended pending consideration of its motion to strike and that, after the Board decides the motion, the deadlines for the initial discovery conference, discovery and trial be reset.

**MEMORANDUM IN SUPPORT OF MOTIONS**

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." (3d ed. rev. 2011); *see also* Fed. R. Civ. P. 12(f).

Accordingly, Plaintiff moves that Defendant's affirmative defenses be stricken for the reasons set forth below:

**First Affirmative Defense (Failure to State a Claim)**

Plaintiff moves that the First Affirmative Defense (Failure to State a Claim) be stricken as inadequately pled, as it consists of a conclusory statement without the factual allegations required for such a defense.

While nonuse of Registrant's mark for three consecutive years constitutes prima facie evidence of abandonment under 15 U.S.C. Section 1127, this section also states that abandonment may occur when Registrant intends not to resume use of its mark and where intent not to resume may be inferred from circumstances. Therefore, evidence of abandonment is not limited solely to nonuse for three consecutive years.

Therefore, failure to plead nonuse for three consecutive years is not required when arguing that Registrant has abandoned its mark under 15 U.S.C. Section 1127. Applicant merely needs to plead that Registrant has intended to abandon its trademark or that the trademark has been abandoned due to inferred circumstances.

**Second Affirmative Defense (Laches, Estoppel, Acquiescence, Unclean Hands and/or Waiver)**

Plaintiff moves that the Second Affirmative Defense be stricken because Registrant's renewal of its Registration on July 24, 2012 is irrelevant in relation to defenses of Laches, Estoppel, Acquiescence, Unclean Hands and/or Waiver.

**Third Affirmative Defense (Laches, Estoppel, Acquiescence and/or Waiver)**

Plaintiff moves that the Third Affirmative Defense be stricken because the existence of third party uses on or in connection with a wide variety of goods and services is irrelevant in a cancellation related to whether Registrant has abandoned its trademark.

**Fourth Affirmative Defense (No Damage)**

Plaintiff moves that the Fourth Affirmative Defense be stricken because damage to Applicant is irrelevant in a cancellation related to whether Registrant has abandoned its trademark. Additionally, Registrant's registration has been cited against Applicant's applications such that Applicant is likely to be damaged by the existence of Registrant's registration.

**Fifth Affirmative Defense (Lack of Standing)**

Registrant argues that Applicant's use of the mark THE DEALMAKER is not use of a term as a trademark and is therefore ineligible for protection under common law or 15 U.S.C. Section 1051.

Plaintiff moves that the Fifth Affirmative Defense of Lack of Standing should be stricken because this cancellation proceeding does not address the registerability of Applicant's mark or Applicant's use of its mark. Such attacks on the registerability of Applicant's application must be conveyed in a counterclaim filed concurrently with Registrant's Answer to the Cancellation Proceeding.

**Sixth Affirmative Defense (Lack of Standing)**

Plaintiff moves that the Sixth Affirmative Defense based on a claim that Applicant's application is descriptive or generic and therefore ineligible for protection under common law and/or the Lanham Act should be stricken because this cancellation proceeding does not address the registerability of Applicant's mark or Applicant's use of its mark. The strength or weakness

of Applicant's mark is irrelevant in a cancellation based on whether the Registrant has abandoned its trademark.

### **Second - Fifth Affirmative Defenses Generally**

Plaintiff moves that the Second through Fifth Affirmative Defenses of Laches, Estoppel, Acquiescence, Unclean Hands and/or Waiver and Lack of Standing should be stricken because, as pled, these defenses are merely conclusory and fail to state facts that would give adequate notice of the basis for such defense.

TBMP § 300 requires that “[t]he elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis of the defense.” Where a defense contains mere conclusory allegations that do not give an Plaintiff fair notice as to the specific conduct which provides the basis for the defense, the defense will be stricken by the Board. *See e.g., Veles Int’l Inc. v. Ringing Cedars Press LLC*, Consolidated Opp. Nos. 91182303 and 91182304 (T.T.A.B. June 2, 2008) (Board struck, *sua sponte*, applicant’s affirmative defenses of waiver, estoppel, and unclean hands, finding affirmative defenses legally insufficient where applicant provided no specific allegations of conduct in support of its affirmative defenses that would, if proven, prevent Plaintiff from prevailing on its claims), *citing Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 U.S.P.Q.2d 1701 (Fed. Cir. 1992) and *Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 U.S.P.Q.2d 1067 (T.T.A.B. 1987); *Activision Publ’g, Inc. v. Oberon Media, Inc.*, Opp. No. 91195500, at 3-4 (T.T.A.B. September 10, 2010) (dismissing affirmative defense of unclean hands where applicant failed to allege specific conduct providing basis for defense).



