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

Proceeding	92061456
Party	Defendant Church & Dwight Co., Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<hr/>		<b>Cancellation No. 92061456</b>
GRAPHIC ARMOR, LLC,	:	
	:	Registration No. 4081154
Petitioner,	:	for the mark ARMOR
	:	Date of Registration: January 3, 2012
v.	:	
	:	Registration No. 4133033
CHURCH & DWIGHT CO., INC.	:	for the mark ARMOR & Design
	:	Date of Registration: April 24, 2012
Respondent.	:	
	:	Registration No. 4147686
	:	For the mark ARMOR
	:	Date of Registration: May 22, 2012
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**RESPONDENT’S RESPONSE TO PETITIONER’S**  
**MOTION FOR JUDGMENT ON THE PLEADINGS**

Church & Dwight Co., Inc. hereby responds to Petitioner’s Motion for Judgment on the Pleadings.

**Summary of Argument**

Petitioner has filed a motion for judgment on the pleadings rather than a motion to strike affirmative defenses in an attempt to prevent discovery and trial on the issues associated with its original claim of priority, and its subsequent claim of non-trademark use of ARMOR by Respondent. In its motion, Petitioner provides partial quotes, purposefully ignores prior and/or subsequent paragraphs that comprise an affirmative defense, and even asserts the Board should utilize a burden of proof reserved for trial, all to obscure the Board’s review of its motion. Accordingly, Respondent asks the Board to scrutinize Petitioner’s motion carefully, especially Petitioner’s interpretation of the paragraphs in the Affirmative Defenses. Despite the contrived conclusions by Petitioner’s counsel, there are

disputed material facts, and issues needing discovery and trial in defense of the grounds asserted in the Petition.

### **Legal Argument**

The First Amended Petition to Cancel states two grounds for cancellation:

- Ground I - Likelihood of Confusion and priority citing a US trademark application
- Ground II – Failure of Respondent to use its marks as a trademark source indicator

The Affirmative Defenses proffered by Respondent are directed to those grounds as pleaded by the Petitioner in its listed General Allegations [paragraphs 1-8] and the two separately listed grounds [paragraphs 9-17].

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings. For purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party, which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b) (6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. ***Kraft Group LLC v. Harpole***, 90 USPQ2d 1837, 1840 (TTAB 2009); ***Baroid Drilling Fluids Inc. v. SunDrilling Products***, 24 USPQ2d 1048 (TTAB 1992)

A judgment on the pleadings may only be granted where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law. A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment. ***Kraft Group LLC v. Harpole***, 90 USPQ2d 1837, 1840 (TTAB 2009); ***Baroid Drilling Fluids Inc. v. SunDrilling Products***, 24 USPQ2d 1048 (TTAB 1992)

The above is the appropriate standard of review for this motion. Nonetheless, it is important to note that Petitioner chose not to file a motion to strike the affirmative defenses in an attempt to avoid discovery on defenses to its claims of priority and its claim of non – trademark use by Respondent. (But at some points in its motion Petitioner’s counsel cites law and makes references to defenses being stricken, rather than obtaining judgment). So, Respondent asks the Board to keep in mind that Affirmative Defenses also function to give fair notice of the claims or defenses asserted, and the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. See, e.g. **Order of Sons of Italy in America v. Profumi Fratelli Nostra AG**, 36 USPQ2d 1221, 1223 (TTAB 1995). Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. See **Wright & Miller**, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008); **Ohio State University v. Ohio University**, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings “is to give fair notice of the claims or defenses asserted”)<sup>1</sup>.

Respondent hereinafter addresses Petitioner’s arguments, but in order of the paragraphs contained in Respondent’s Affirmative Defenses so as not to perpetuate Petitioner’s counsel’s selective dissection of the content in those paragraphs.

### **Paragraphs 1, 2 & 3 to the Affirmative Defenses**

In paragraphs 1-3 of the Frist Amended Petition to Cancel (hereinafter “Amended Petition”), Petitioner identified and asserted its U.S. Trademark Application Serial No. 86383755 as part of its priority claim, and presumably as a grounds for standing in filing its Petition to Cancel. By example, paragraph number 3 of the Amended Petition states “Petitioner’s application to register GRAPHIC

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<sup>1</sup> In a September 17, 2015 phone conference to discuss the motion, Respondent’s counsel advised Petitioner’s counsel, that Affirmative Defenses were equally about notice as well as being affirmative defenses. Mr. Johnson simply laughed and indicated he did not need such notice.

ARMOR was filed on an actual use in commerce basis of January 1, 2010.” Accordingly, Petitioner is relying upon its Application Serial No. 86383755 as at least one basis for its asserted date of first use. To the extent Application Serial No. 86383755 will be a basis to its claim of priority and date of first use, Respondent has a right to pursue the validity of that application based upon non-use in U.S. Commerce of the submitted class 10 specimen of use, which is not an attack on Trademark Office’s review of the specimen.

Now, as touched on above, Petitioner is twisting this notice of a claim of non-use in US commerce asserted in paragraphs 1 and 2 of the Affirmative Defenses as an ex parte challenge to the specimens of use. This is not true. Paragraphs 1 and 2 indicate that Petitioner did not have use in U.S. commerce at the time it filed its application based upon its specimen of use presented. If there was no use in U.S. commerce at the time Petitioner filed its application and the application is being relied upon as evidence of Petitioner’s priority, the application’s invalidity acts as credible evidence for a defense to the Amended Petition, but one that must be made of record. Again, the affirmative defense presented in paragraphs 1 and 2 of the Affirmative Defenses is not an attack on the specimen of use, but rather describes, so as to give notice, the factual basis for why the GRAPHIC ARMOR Application Serial No. 86383755 cannot support a claim of priority.<sup>2</sup>

If Petitioner is going to rely upon its Application Serial No. 86383755 in any way to substantiate its claim of priority, then Respondent has a right to a defense that looks into the whether the application has a valid basis of in use in US commerce [not if the specimen of use was correctly reviewed by the Trademark Office]. This includes deposing the person who asserted the mark was in use in U.S. commerce, which is current counsel of record. Accordingly, that compelled the notification and defense that Petitioner’s counsel could be a material witness as presented in paragraph No. 3 to the

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<sup>2</sup> On September 17, 2015 Respondent’s counsel explained in a phone conference how this Affirmative Defense was not an ex parte attack on the specimen of use, but a challenge to the validity of a claimed use in U.S. commerce and therefore the application’s claimed date of first use. Mr. Johnson indicated he would proceed with his interpretation and file his motion by 5:00 p.m.

Affirmative Defenses. The disputed material facts are whether there was use of the GRAPHIC ARMOR mark in U.S. commerce at the time Petitioner filed its trademark application and if the example of use provided was in fact legitimate as declared by counsel of record for Petitioner.

If Petitioner's counsel only intends to rely upon Application Serial No. 86383755 to show it received a likelihood of confusion refusal from the U.S. Trademark Office in support of its standing [and no aspect of priority], and that purpose is made of record by Order of the Board or by a stipulation of record from Petitioner, Respondent's counsel will voluntarily withdraw paragraphs 1-3 in its Affirmative Defenses.<sup>3</sup>

#### **Paragraphs 4-6 to the Affirmative Defenses**

The affirmative defense presented in paragraphs 4-6 notifies Petitioner that Respondent will challenge any actual common law use, to support its priority claim, so as to determine if it was legal and therefor valid use in U.S. commerce and capable of being relied upon by Petitioner. This addresses the alleged common law use and not the use asserted in the application. This affirmative defense jeopardizes Petitioner's claim of priority, and it wants to avoid discovery and trial on the issue.

The defense addresses the issue of non-legal sales in U.S. commerce of the condom goods [addressed in paragraph No. 4] and the contract manufacturing services [addressed in paragraph No. 5] in response to the facts pleaded by Petitioner in paragraphs 1-3 to the Amended Petition. Then paragraph No. 6 indicates the overall affirmative defense is to show Petitioner's non-regulatory compliance is a per se violation of United States Food and Drug Administration ("FDA") regulations. There are material issues of fact, such as looking into Petitioner's FDA regulatory compliance for its

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<sup>3</sup> This could have been accomplished before any such motion, but on September 17, 2015 Petitioner's counsel engaged in an odd form of strategy where he sent a copy of its motion at approximately 10:00 a.m. and informed Respondent's counsel, in an email and phone call, he would be filing by 5:00 p.m. unless Respondent agreed to withdraw all or some of the Affirmative Defenses offering little time to review the matter or seek a resolution.

claimed date of first use, and/or the years it made sales of condoms, in US commerce, all going toward its Ground I in the Amended Petition.

In order for any date of first use by the Petitioner of GRAPHIC ARMOR in connection with condoms to be valid use in U.S. commerce, the Petitioner must have complied with the United States Food and Drug Administration Regulatory Rules or there was no lawful use of GRAPHIC ARMOR in U.S. commerce. The Board accepts such challenges, and the law on the matter is as follows:

Determining whether the use of a mark is lawful under one or more of the myriad of regulatory acts involves two questions: (1) whether a court or government agency having competent jurisdiction under the statute involved has previously determined that party is not in compliance with the relevant statute; or (2) whether there is a *per se* violation of a statute regulating the sale of a party's goods. *General Mills Inc. v. Healthy Valley Foods*, 24 USPQ2d 1270, 1273 (TTAB 1992).

Moreover, the case of *Automedix, Inc. v. Artivent Corp.*, 95 USPQ 2d 1976 confirms that a litigant can show there was a *per se* violation of any law or FDA regulation which did not amount to lawful use in U.S. commerce. Respondent does not have to cite the rule violation as part of notice pleading, and the case cited by Petitioner to suggest the rule or regulation should be cited speaks to the burden at time of trial (see *infra*). If Petitioner was in FDA compliance it could have included proof in its amended pleading, when it knew, per discussions with Respondent's counsel, that was an issue as it related to the claimed priority. Moreover, if Respondent did not assert this in the Affirmative Defenses, Petitioner would then argue at time of trial it was not put on notice, and would likely object to any discovery on the topic. Again, there are clearly issues of material fact: Were the sales of its condoms or the rendering of its condom manufacturing services, as of the date of first use claimed for such sales or services, compliant with applicable FDA rules and regulations? If not, then such sales and services cannot be considered lawful use in commerce.

Now, Petitioner goes on to change the standard of review for this matter. It cites case law starting at the bottom of page 5 of its motion alleging the defense must be presented with clear and

convincing evidence, which is the burden of proof at time of trial. Petitioner does not want the issue to be investigated in discovery or tried, and it goes so far as to cite inapplicable case law.

Next, Petitioner attempts to either confuse or trick the Board by providing a snippet quote from paragraph No. 5 to the Affirmative Defenses, where Respondent is challenging FDA compliance in connection with the Petitioner's pleaded services of "contract manufacturing in the field of condoms", stated only 2015 compliance as a re-packager could be located. Investigation of Petitioner's possible FDA compliance [compelled by FRCP 11] showed only FDA registration as a re-packager or re-labeler of condoms, not a contract manufacturer of condoms. Accordingly this fact was identified in the challenge to legal use, in U.S. commerce, of Petitioner's mark with its pleaded services. The defense is based upon non-compliance with FDA regulations for a manufacturer of condoms, not a re-packager. [The misrepresentation of fact to the Board should be noted.]

#### **Paragraphs 7, 8 and 12 to the Affirmative Defenses**

Petitioner persists in cherry picking the paragraphs in the Affirmative Defenses and coupling them with other paragraphs in order to try and obtain judgment without discovery that will look into its burden of proof for its priority claim. The defense that is presented in paragraph no. 12<sup>4</sup> is not related to the defenses presented in paragraphs 7 and 8, which themselves are directed to the pleaded goods and services of Petitioner. It is important to see the Affirmative Defenses in their entirety, rather than snippets that have been provided by Petitioner. It is also important to notice the leap in paragraphs made by Petitioner's counsel to couple paragraph No. 12 to its arguments, and then effectively ignore it in its discussion in hopes it may be included in any ruling on paragraphs 7 & 8:

7. Graphic Armor, LLC, and any alleged predecessor in interest, was not using the "GRAPHIC ARMOR" trademark in connection

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<sup>4</sup> Respondent is taking paragraph No. 12 out of order because it is clearer to present the conduct of Petitioner by addressing its coupling with paragraphs 7 & 8 by Petitioner.

with condoms in U.S. commerce, on January 1, 2010 as alleged in its Application Serial No. 86383755 and its Petition.

8. Graphic Armor, LLC, and any alleged predecessor in interest, was not offering contract manufacturing in the field of condoms in connection with the "GRAPHIC ARMOR" trademark on January 1, 2010 as alleged in its Application Serial No. 86383755 and its Petition.

9. [...text not reproduced for this section of the brief]

10. [...text not reproduced for this section of the brief]

11. [...text not reproduced for this section of the brief]

12. Any use of "GRAPHIC ARMOR" by Petitioner in connection with condoms and contract manufacturing in the field of condoms prior to Respondent's use of its ARMOR mark was in different channels of trade, separate from sales of Respondent's goods, such that there have been no instances of actual confusion and Respondent has priority in use of its ARMOR marks within its retail channels of trade.

Based upon paragraph No. 10 in the Amended Petition, Respondent has put Petitioner on notice that it intends to prove there was no use of the GRAPHIC ARMOR trademark as of the alleged dates of first use proffered by Petitioner. This is separate and apart from whether the use was legal use in U.S. commerce. It simply goes to whether there was use at all of the mark with the cited goods and services.

Paragraph 7 refers to Petitioner's pleaded goods and paragraph No. 8 separately refers to the pleaded services asserted by Petitioner. They are appropriate defenses to the Amended Petition, and Petitioner should not be due judgment on those issues since the material issue of fact in dispute is whether Petitioner had the common law use of the goods and services it plead in paragraph No. 10 to the Amended Petition. Petitioner merely arguing that it reads the defenses as redundant does not meet Petitioner's burden of proof for judgment when priority is a primary fact issue in Ground I to the Amended Petition. Proof of use of the mark, with the asserted goods and services, is not in the Pleadings, it is a disputed material fact, and therefore judgment is not warranted.

With regard to paragraph no. 12 in the Affirmative Defense, there is no discussion by Plaintiff's counsel that addresses the affirmative defense the respective goods and services of the parties travel in different channels of trade. There is no pleaded claim in the Amended Petition the parties goods and/or services do travel in the same channels of trade, so the defense cannot be a redundant denial. The defense addresses the Ground I – Likelihood of Confusion claim, and as Petitioner's counsel should know, channels of trade are a factor considered by the Board in its DuPont factors. **In Re: E.I. DuPont De Nemours & Co., 177 U.S.P.Q. 563 (CCPA 1973)**. Accordingly, there is a material issue of fact, namely, what are the parties' respective channels of trade and corresponding dates of first use and judgment on the pleadings must be denied.

#### **Paragraph 10 to the Affirmative Defenses**

Petitioner is making a convoluted argument with regard to paragraph number 10 to the Affirmative Defenses and tried to justify its arguments by tacking them onto arguments addressing paragraph number 6. Again, Petitioner is in a game of selective interpretation and quotes in an effort to avoid discovery and trial on the issue of its claim of priority. The affirmative defense in paragraph No. 10 addresses the possibility of Petitioner relying upon its application as its basis of priority if the underlying common law use basis for that application is shown to be non-legal use in U.S. commerce.

In the Amended Petition to Cancel, Petitioner states in paragraph no. 10 as follows:

Petitioner possesses common-law rights in its mark based on its continued use in commerce, with respect to the goods/services listed in Application Serial No. 86/383,755, before Registrant's use, and therefore has priority of use over the marks in Registrant's registrations pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d).

In paragraph no. 10, Petitioner is asserting and/or referencing its Application Serial No. 86383755. The affirmative defense in paragraph No. 10 goes directly towards whether Petitioner may attempt to rely upon a change to its claimed date of first use in its cited application, and/or rely upon its filing date.

For this affirmative defense the material issues of fact are whether Petitioner's use of the goods/services cited in the pleaded application was legal use in U.S. commerce and if reliance upon the pleaded application will make a valid claim for constructive use to support, in any way, its basis for claimed priority.

### **Paragraphs 13-16 to the Affirmative Defenses**

The last affirmative defense is articulated in paragraph nos. 13 -16, and it goes directly towards Ground II in the amended Petition and its Trademark Act Section 45 (hereinafter "Section 45") claim of non-trademark use. Petitioner's counsel is choosing to ignore the defense as pleaded by Respondent, and tries to recast it. In doing so, Petitioner is again engaged in snippet quoting, all in an attempt to avoid discovery and trial on the issues it pleaded in Ground II. Accordingly, Respondent would like to accurately present the affirmative defense detailed in paragraphs 13-16 which reads:

13. Petitioner has alleged that "at all times material hereto" Respondent has not utilized its ARMOR and ARMOR & Design trademarks under Registrations 4081154 and 4133033 as a source indicator for the goods "as required under Section 45 of the Trademark Act".

14. This claim under Section 45 cannot be brought before the Board. The adequacy of specimens of use is solely a matter of ex parte examination. *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ 2d 2035 (TTAB 1989); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ 2d 1925, see footnote 12, (TTAB 2014).

15. Respondent's specimens of use for its application serial numbers 85166387 and 85284939, which matured into Registration Nos. 4081154 and 4133033, were accepted by the U.S. Trademark Office for the listed goods in the underlying applications. Accordingly, the specimens of use cannot be challenged as not functioning as a trademark for the goods under Section 45, and such a claim must be dismissed.

16. Accordingly, Petitioner's claim under Section 45 fails to state a claim upon which relief can be granted under F.R.Civ.P. 12(b) (6), and Respondent reserves the right to file the appropriate motion to dismiss if the Board does not dismiss the claim sua sponte.

Respondent is presenting an affirmative defense based upon allegations of paragraphs 13-14 to the Amended Petition:

13. At all times material hereto, the word ARMOR is and was not used by Registrant as a source indicator for the good, condoms.

14. At all times material hereto, the word ARMOR is and was not used by Registrant to distinguish and/or identify condoms from the same or similar goods made, manufactured, or sold by others.

As articulated in paragraphs 13-16 in the Affirmative Defenses, when Petitioner claims that “at all times material hereto” Respondent had not been using its ARMOR mark as a source indicator and couples that with a claim under Section 45, that automatically includes the examples of use that were submitted and accepted by the Trademark Office for the ARMOR registrations. Accordingly, Petitioner is challenging specimens of use submitted to the Trademark Office, and the affirmative defense addresses the claim as pleaded in Ground II to the Amended Petition. Petitioner conveniently ignores this fact, and claims this affirmative defense just reiterates the denial of the allegations, but a denial of such a claim does not notify Petitioner of the defense as articulated.<sup>5</sup>

Accordingly, the minimum material facts in dispute are: Did the U.S. Trademark office accept examples of use of Respondent’s ARMOR marks complained of by Petitioner in Ground II to its Amended Petition?, and can it be shown current use by Respondent is the same or nearly the same as the examples accepted by the U.S. Trademark Office?

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<sup>5</sup> It puts Petitioner on notice that Ground II claim can be dismissed by dispositive motion as being equal to an ex parte attack on the examination of the underlying application. After all, a party may not obtain summary judgment on an issue that has not been pleaded. (TBMP Section 528.07(a)). Accordingly, if Respondent did not put Petitioner on notice that its pleaded allegation is an ex parte examination challenge in disguise or a de facto ex parte examination challenge, more likely than not, Petitioner would raise that defense to any summary judgment motion.

## CONCLUSION

Petitioner has sought judgment on the pleadings, rather than an attempt to strike the affirmative defenses, so as to avoid the defenses from being the subject of discovery.<sup>6</sup> In order to persuade the Board to do so, Petitioner has engaged in selective quoting and made arguments that assert the burden of proof for trial. Affirmative Defenses are meant to put the Petitioner on notice. Apparently the notification scared the Petitioner as to what discovery will be taken causing it to make an unnecessary motion, and delay the Discovery Conference at the last minute. It is somewhat rare that a plaintiff is trying to avoid entering into discovery and trial.

Finally, to the extent the Board feels the affirmative defenses set forth are not adequately presented to properly put Petitioner on notice or are somehow insufficient to be affirmative defenses, Respondent respectfully asks for leave to amend its Answer to address any concerns of the Board, but this should not be necessary given a defense will not be stricken as insufficient [or judgment granted] if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See, generally, Wright & Miller*, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008).

Respectfully submitted:

**Church & Dwight Co., Inc.**  
**Respondent**

Date: September 30, 2015

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<sup>6</sup> A motion to strike would not block discovery topics, but judgment on the pleadings could block such discovery.

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that Respondent's Response to Petitioner's Motion for Judgment on the Pleadings was electronically filed with the Trademark Trial and Appeal Board this 30th day of September, 2015.

/Brooks R. Bruneau/

(Signature)

September 30, 2015

(Date of Signature)

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of Respondent's Response to Petitioner's Motion for Judgment on the Pleadings was served upon Petitioner's counsel via email, pursuant to stipulation by the parties, on this 30<sup>th</sup> day of September 2015, addressed as follows:

MARK C. JOHNSON  
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**CHURCH & DWIGHT CO., INC.**  
**Respondent**

Date: September 30, 2015

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