

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

CME

Mailed: January 4, 2016

Cancellation No. 92061456

Graphic Armor, LLC

v.

Church & Dwight Co., Inc.

Christen M. English, Interlocutory Attorney:

On December 17, 2015, the Board convened a telephone conference to address Petitioner's motion "for judgment on the pleadings," filed September 17, 2015, and to conduct the parties' telephonic discovery conference mandated under Fed. R. Civ. P. 26(f) and Trademark Rule 2.120(a)(1) and (a)(2).¹ Mark Johnson appeared on behalf of Petitioner, Brooks Bruneau appeared on behalf of Respondent, and the assigned interlocutory attorney participated on behalf of the Board.

The Board first addressed Petitioner's motion. Although the motion is captioned as a "motion for judgment on the pleadings," Petitioner's motion is actually a motion to strike because Petitioner's arguments concern the sufficiency and materiality of Respondent's affirmative defenses. Accordingly, as the Board explained during the

¹ Petitioner filed a request for Board participation in the discovery conference on August 20, 2015.

teleconference, Petitioner's motion is given no consideration as a motion for judgment on the pleadings and is considered only as a motion to strike.²

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See* Fed. R. Civ. P. 12(f); *Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); TBMP § 506.01 (2015). Motions to strike are not favored, and as such, 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* TBMP § 506.01. Moreover, the primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *See id.*; *see also* TBMP §§ 309.03 and 311.02. Thus, the Board, in its discretion, 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 Harsco Corp. v. Elec. Scis. Inc.*, 9 USPQ2d 1570 (TTAB 1988).

Respondent asserts in paragraphs 13-16 of its answer an affirmative defense that Petitioner's second claim for relief – failure to function as a mark – fails to state a claim upon which relief can be granted. A defendant is permitted to assert failure to state a claim as an affirmative defense, but a plaintiff is allowed to test the sufficiency of such a defense before trial by filing a motion to strike. *See Order of*

² Petitioner filed its motion more than 26 days after Respondent served its answer via first-class mail, but the Board exercises its discretion to consider Petitioner's motion to strike. *See* TBMP § 506.02 (2015).

Sons of Italy in Am. v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1222 (TTAB 1995).

For the reasons discussed during the teleconference, Petitioner's second count fails to state a claim upon which relief can be granted.³ Accordingly, Petitioner's motion to strike paragraphs 13-16 of Respondent's answer is **DENIED**. The Board, however, finds it appropriate to allow Petitioner an opportunity to replead, and Petitioner indicated during the teleconference that it will in fact file a second amended pleading. Accordingly, Petitioner is allowed until **January 18, 2016** to file an amended petition that includes an adequately pleaded claim for failure to function as a mark. Respondent is allowed until **February 8, 2016**, to file an answer to Petitioner's amended pleading. Because the parties will be repleading, the remainder of Petitioner's motion to strike is moot, but the Board makes the following observations regarding Respondent's remaining affirmative defenses.

The affirmative defenses set forth in paragraphs 1-3 of Respondent's answer concern purported deficiencies in Petitioner's pleaded application. In its response to the motion, Respondent indicated that it would voluntarily withdraw these paragraphs if Petitioner agrees to rely on its pleaded application for purposes of standing only and not priority. As the Board explained during the teleconference, Petitioner may not rely on its pleaded application to establish priority because: (1) the filing date of the pleaded application is *after* the filing date of the applications underlying Respondent's involved registrations; and (2) the allegations of use set

³ As noted during the teleconference, however, Petitioner has adequately pleaded its standing and a claim for priority and likelihood of confusion.

forth in the pleaded application are not evidence of use. *See* Trademark Rule 2.122(b)(2). Accordingly, in filing an answer to any amended petition, it will be unnecessary for Respondent to reassert the allegations in paragraphs 1-3 of its answer.

The affirmative defenses asserted in paragraphs 4-6 and 10 of Respondent's answer concern Petitioner's purported unlawful use of its pleaded mark. As discussed during the teleconference, the factual basis for Respondent's affirmative defense of unlawful use is not entirely clear. Accordingly, to the extent Respondent asserts such an affirmative defense in its answer to any amended petition, Respondent should "connect the dots" between its allegations.

Lastly, paragraphs 7-9 and 11-12 of Respondent's answer⁴ challenge Petitioner's claim of priority on the ground that Petitioner has not made prior common law use of its pleaded mark in connection with condoms and contract manufacturing in the field of condoms. Such allegations are amplifications of Respondent's denials, and therefore, such allegations will not be stricken.

Turning to the discovery conference portion of the teleconference, the parties stated that they are not aware of any related proceedings between them or disputes with third parties regarding the marks at issue here. If this changes, the parties should advise the Board.

The parties have engaged in settlement discussions, but have reached an impasse. During the teleconference, counsel for the parties agreed to revisit the

⁴ The Board notes that paragraphs 9 and 11 of Respondent's answer were not subject to Petitioner's motion to strike.

possibility of settlement with their clients. The Board strongly encourages the parties to work together to amicably resolve this matter, if possible.

The Board next discussed ways to streamline the case by using Accelerated Case Resolution (“ACR”). As discussed during the discovery conference, ACR can take almost any form that the parties agree to and that will move this proceeding forward in an efficient and expeditious manner. The simplest form of ACR would be similar to summary judgment whereby the parties would submit briefs with attached evidence, but would agree to allow the Board to resolve any genuine disputes of material fact raised by the parties’ filings or the record. Alternatively, the parties may wish to consider ACR-like efficiencies such as stipulating to some or all of the facts, foregoing discovery in favor of greater reciprocal disclosures than required by Fed. R. Civ. P. 26(a)(1), limiting discovery in time and scope (i.e. 60-day discovery period with each party limited to 10 interrogatories, document requests and requests for admission and 1 deposition), and/or taking testimony by declaration, subject to the right of either party to cross examine, if desired.

As discussed during the teleconference, ACR may not be appropriate for this proceeding given the nature of the issues that have been raised. Petitioner, however, proposed the possibility of bifurcating and utilizing ACR with respect to Respondent’s affirmative defense of unlawful use. Respondent’s counsel expressed skepticism about the efficiency of such an approach, but agreed to discuss the possibility with his client.

If the parties are interested, they may find additional information regarding ACR at the following links:

1. General description of ACR:

http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf;

2. FAQs on ACR:

[http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_\(ACR\)_FAQ_updates_12_22_11.doc](http://www.uspto.gov/trademarks/process/appeal/Accelerated_Case_Resolution_(ACR)_FAQ_updates_12_22_11.doc);

3. List of cases employing ACR-like efficiencies:

[http://www.uspto.gov/trademarks/process/appeal/ACR_Case_List_\(10-23-12\).doc](http://www.uspto.gov/trademarks/process/appeal/ACR_Case_List_(10-23-12).doc);

4. Potential ACR schedules:

http://www.uspto.gov/trademarks/process/appeal/TTAB_ACR_Options.jsp;

and

5. Sections 528.05(a)(2), 702.04 and 705 of the TBMP (2015).

The Board's standard protective order is applicable in this proceeding by operation of Trademark Rule 2.116(g) and available here:

<http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>

During the teleconference, Respondent proposed amending the Board's standard protective order to allow in-house counsel to view documents designated as "trade secret/commercially sensitive" as long as the in-house attorney executes a declaration indicating that he/she is not involved in the company's day-to-day

business operations. Counsel for Petitioner agreed to consider such a request, but noted that it is unlikely to have many “trade secret/commercially sensitive” documents that in-house counsel would be precluded from accessing under the Board’s standard protective order.

If the parties agree to amend the Board’s standard protective order, they should file a copy of the stipulation with the Board. *See* TBMP § 412.02(a). If the parties do not agree to amend the standard protective order, they are encouraged to acknowledge their obligations under the standard protective order in writing, and may utilize the following form:

<http://www.uspto.gov/trademarks/process/appeal/guidelines/ackagrmnt.jsp>

As a reminder, a party may not serve discovery requests or file a motion for summary judgment until after the party has served initial disclosures. In addition, the Board is available for future telephone conferences to resolve contested matters, address scheduling issues, and to address other issues, as necessary, to move this case forward efficiently.

Dates are reset as follows:⁵

Time to File an Amended Pleading	1/18/2016
Time to Answer an Amended Pleading	2/8/2016
Discovery Opens	2/18/2016
Initial Disclosures Due	3/19/2016
Expert Disclosures Due	7/17/2016
Discovery Closes	8/16/2016
Plaintiff’s Pretrial Disclosures Due	9/30/2016
Plaintiff’s 30-day Trial Period Ends	11/14/2016

⁵ The mailing of this order has been delayed due to a major power outage that shut down the USPTO’s IT system. For this reason, the dates for repleading as well as all subsequent deadlines in this proceeding, have been modified from the dates discussed during the teleconference.

Defendant's Pretrial Disclosures Due	11/29/2016
Defendant's 30-day Trial Period Ends	1/13/2017
Plaintiff's Rebuttal Disclosures Due	1/28/2017
Plaintiff's 15-day Rebuttal Period Ends	2/27/2017

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
