

ESTTA Tracking number: **ESTTA738472**

Filing date: **04/06/2016**

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

Proceeding	92062783
Party	Plaintiff First Opinion, Inc.
Correspondence Address	THOMAS E ZUTIC DLA PIPER LLP US 500 8TH STREET NW WASHINGTON, DC 20004 UNITED STATES thomas.zutic@dlapiper.com, ashley.joyce@dlapiper.com, alberto.zacapa@dlapiper.com, dctrademarks@dlapiper.com
Submission	Motion to Strike
Filer's Name	Thomas E. Zutic
Filer's e-mail	thomas.zutic@dlapiper.com, john.nading@dlapiper.com, ashley.joyce@dlapiper.com, dctrademarks@dlapiper.com
Signature	/Thomas E. Zutic/
Date	04/06/2016
Attachments	Petitioner's Motion to Strike Affirmative Defenses.pdf(29046 bytes)

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

In the matter of Trademark
Registration No. 1335327
Mark: FIRST OPINION
Filing Date: August 27, 1984
Registered: May 14, 1985

In the matter of Service Mark
Registration No. 1644040
Mark: FIRST OPINION
Filing Date: May 17, 1990
Registered: May 7, 1991

FIRST OPINION, INC.,)	
)	
Petitioner,)	
)	
v.)	Consolidated Cancellation No. 92062783
)	
FIRST OPINION CORPORATION,)	
)	
Registrant.)	

**PETITIONER’S MOTION TO STRIKE
REGISTRANT’S AFFIRMATIVE DEFENSES**

I. INTRODUCTION

Petitioner First Opinion, Inc. (“Petitioner”), by and through its undersigned counsel, files this Motion to Strike First Opinion Corporation’s (“Registrant”) Affirmative Defenses¹ (“Motion”) in the above-captioned proceeding. Petitioner’s Motion should be granted because Registrant’s Affirmative Defenses are insufficient, immaterial, and impertinent, and fail as a

¹ Registrant claims as its “FIRST AFFIRMATIVE DEFENSE” in its Answer the defenses of “waiver, estoppel, laches, and/or acquiescence.” Because there is more than one defense, Petitioner refers to the defenses herein as the “Affirmative Defenses” and not just the “FIRST AFFIRMATIVE DEFENSE.”

matter of law. Specifically, Registrant’s Affirmative Defenses of laches and acquiescence are not available against claims of abandonment or fraud, the very claims alleged in the Petition for Cancellation. Moreover, Registrant failed to allege any facts to support its Affirmative Defenses of “waiver, estoppel, laches, and/or acquiescence,” and thus did not satisfy the notice pleading requirements of Fed. R. Civ. P. 8 and Trademark Trial and Appeal Board Manual of Procedure (“T.B.M.P.”) Section 311.02(b). Accordingly, Petitioner’s Motion should be granted in its entirety and Registrant’s Affirmative Defenses should be stricken without leave to amend.

II. STANDARD

Under Fed. R. Civ. P. 12(f), the Trademark Trial and Appeal Board (“Board”) may strike from a pleading any insufficient defense or any redundant, immaterial, impertinent or scandalous matter. Further, under Fed. R. Civ. P. 8(d)(1), “[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 for the defense.” T.B.M.P. § 311.02(b). Indeed, the primary purpose of pleadings, such as affirmative defenses, “is to give fair notice of the claims or defenses asserted.” *Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1292 (T.T.A.B. 1999); *see also Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1538 (T.T.A.B. 2007) (stating elements of each claim should include enough detail to give fair notice of claim). A party must allege sufficient facts beyond a tender of “‘naked assertion[s]’ devoid of ‘further factual enhancement,’” to support its claims. *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009), *quoting Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 557 (2007).

//

//

//

//

III. ARGUMENT

Registrant's Affirmative Defenses are insufficient, immaterial, and impertinent. Fed. R. Civ. P. 12(f).

A. Laches and Acquiescence

Specifically, Petitioner has alleged that Registrant's FIRST OPINION Registrations, U.S. Trademark Registration Nos. 1335327 and 1644040, should be cancelled because Registrant has abandoned the marks and because Registrant fraudulently renewed Registration No. 1644040. "It is well established that the equitable defenses of laches and acquiescence are not available against claims of genericness, descriptiveness, fraud, and abandonment." *Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys.*, 66 U.S.P.Q.2d 1355, 1359 (T.T.A.B. 2003). Indeed, there is ample Board precedent that the defenses of laches and acquiescence are improper against claims of abandonment or fraud. *See TBC Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d 1311, 1312 (T.T.A.B. 1989) (finding that when the proposed ground for a proceeding is abandonment or fraud, equitable defenses, including laches and acquiescence, are unavailable); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 U.S.P.Q.2d 1572, 1575 & n.3 (T.T.A.B. 2008) (finding that laches is unavailable as an affirmative defense against a claim of fraud); *see also* T.B.M.P. § 311.02(b):

For public policy reasons, the defenses of laches and acquiescence may not be available against claims such as genericness, descriptiveness, fraud, abandonment and functionality, and further, may not apply in a case of likelihood of confusion if it is determined in the case that confusion is inevitable.

The rationale is that it is within the public interest to have certain registrations, such as those that have been abandoned or fraudulently obtained or maintained, "stricken from the register and that this interest or concern cannot be waived by the inaction of any single person or concern, no matter how long the delay persists." *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg.*

Co., 146 U.S.P.Q. 313, 316 (T.T.A.B. 1965); *see also TBC Corp.*, 12 U.S.P.Q.2d at 1311 (finding it in the public interest to remove abandoned or fraudulent registrations from the register). “The rationale, itself, embodies equitable concerns, that is, to remove from the register matter that should be available to all, marks no longer in use, or marks that were registered by means of fraud on the Office.” *Saint-Gobain Abrasives, Inc.*, 66 U.S.P.Q.2d at 1359. Accordingly, Registrant’s defenses of laches and acquiescence are insufficient, immaterial, and impertinent against Petitioner’s claims of abandonment and fraud and must be stricken.

B. Waiver, Estoppel, Laches, and Acquiescence

Further, Registrant provided absolutely no facts regarding the grounds for its Affirmative Defenses of “waiver, estoppel, laches, and/or acquiescence,” contrary to the spirit of Fed. R. Civ. P. 8 and T.B.M.P. Section 311.02(b), which require sufficient detail to provide the other side with fair notice of the defenses. *Ohio State Univ.*, 51 U.S.P.Q.2d at 1292; *Fair Indigo LLC*, 85 U.S.P.Q.2d at 1538. Thus, Petitioner is left to guess the basis for Registrant’s insufficient and seemingly impertinent defenses. For example, “the doctrine of estoppel may be invoked only by one who has been prejudiced by the conduct relied upon to create the estoppel” *Textron, Inc. v. The Gillette Co.*, 180 U.S.P.Q. 152, 154 (T.T.A.B. 1973) (internal citations omitted). Similarly, “[a]cquiescence is a type of estoppel that is based upon the plaintiff’s conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant, that is not objected to.” *Christian Broad. Network Inc. v. ABS-CBN Int’l*, 84 U.S.P.Q.2d 1560, 1574 (T.T.A.B. 2007). Here, it would be nonsensical to allege that Petitioner induced Registrant to abandon its marks or fraudulently renew its registration, or that Petitioner otherwise encouraged Registrant’s conduct. Registrant is in need of facts to explain its defenses.

Moreover, “[t]o prevail on its affirmative defense of laches, [Registrant] [is] required to establish that there was undue or unreasonable delay by [Petitioner] in asserting its rights, and

prejudice to [Registrant] result[ed] from the delay.” *Bridgestone/Firestone Research Inc. v. Automobile Club de l’Ouest de la France*, 245 F.3d 1359, 1361, 58 U.S.P.Q.2d 1460, 1462-63 (Fed. Cir. 2001). Once more, Registrant has stated no facts to show how Petitioner delayed in bringing this proceeding. Nor has Registrant alleged facts to support its bald assertion of waiver. *McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45, 47 (T.T.A.B. 1985) (finding bald allegations do not provide fair notice of the basis of the party’s claims). Petitioner is again left to speculate what Registrant’s defenses mean or how they are relevant or pertinent to this proceeding. Accordingly, Registrant’s Affirmative Defenses do not satisfy the requirements of Fed. R. Civ. P. 8 and T.B.M.P. § 311.02(b) and must be stricken.

Finally, here, where the Affirmative Defenses are not even legally cognizable, the Board need not allow Registrant leave to amend where any such amendment would be futile. *Institut National des Appellations d’Origine v. Brown-Forman Corp.*, 47 U.S.P.Q.2d 1875, 1896 (T.T.A.B. 1998) (finding that amendment would be futile because the parties cannot prevail on their claim as a matter of law).

//
//
//
//
//
//
//
//
//
//

IV. CONCLUSION

For the foregoing reasons, the Board should grant Petitioner's Motion to Strike Registrant's Affirmative Defenses without leave to amend.

Dated: April 6, 2016

Respectfully submitted,

DLA PIPER LLP (US)

/s/ Thomas E. Zutic

By: Thomas E. Zutic
John M. Nading
Ashley H. Joyce
500 8th Street, NW
Washington, DC 20004
Tel. (202) 799-4140
Fax (202) 799-5140
Attorneys for Petitioner
First Opinion, Inc.

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **PETITIONER'S MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES** was served via U.S. First Class mail, postage prepaid, and properly addressed to counsel of record:

Jeffrey L. Van Hoosear
2040 Main Street, 14th Floor
Irvine, CA 92614

this 6th day of April, 2016.

/s/ Thomas E. Zutic

Thomas E. Zutic
Attorney for Petitioner