

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

Mailed: April 15, 2016

Cancellation No. 92063032

Boston Juicery, LLC

v.

Squeeze Juice Works, LLC

**Robert H. Coggins,
Interlocutory Attorney:**

Now before the Board are Petitioner's motion (filed March 25, 2016) to strike portions of the Answer, and Respondent's First Amended Answer (filed April 15, 2016).

Motion to Strike - Granted as Conceded

Petitioner moves to strike paragraphs 17-47 from the Answer. Specifically, Petitioner seeks to strike extraneous paragraphs 17-26 which are not separately included under an affirmative defense header, the first affirmative defense of "failure to state a claim" (paragraphs 27-30), the second affirmative defense of "lack of standing - no prior use" (paragraphs 31-34), the third affirmative defense of "lack of standing – false advertising" (paragraphs 35-37), the fourth affirmative defense "lack of standing – unfair competition" (paragraphs 38-40), the fifth affirmative defense "lack of standing – deceptive trade practice" (paragraphs 41-43), the sixth affirmative defense "lack of standing – fraud" (paragraphs 44-50), the seventh affirmative defense

“unclean hands” (paragraphs 51-56), and the eighth affirmative defense “abandonment” (paragraphs 57-62).

The motion to strike was filed March 25, 2016, and included a certificate of service dated that same day indicating service upon Respondent by first class mail. In view thereof, any response to the motion was due on or before April 14, 2016. *See* Trademark Rules 2.119(c) and 2.127(a). No timely response was filed to the motion to strike. In view thereof, the motion to strike is **granted** as conceded, and paragraphs 17-47 are **stricken** from the Answer. Trademark Rule 2.127(a). Moreover, the motion is otherwise well-taken.

First Amended Answer - No Consideration

Respondent filed a First Amended Answer on April 15, 2016, but failed to include therewith a motion to amend the answer. Inasmuch as the First Amended Answer was filed more than twenty-one days after the original Answer was served, and an answer is not a pleading to which a responsive pleading is required, Respondent may not amend its answer as a matter of course. *See* Fed. R. Civ. P. 15(a)(1). Accordingly, Respondent may amend its answer only with Petitioner’s written consent or the Board’s leave. Fed. R. Civ. P. 15(a)(2). However, because Respondent did not provide Petitioner’s consent, and no motion accompanied the First Amended Answer, Respondent has not demonstrated any of the elements required for amending its pleading. In view thereof, the First Amended Answer will be given **no consideration**. The original Answer, as stricken, is currently Respondent’s operative pleading.

Should Respondent consider filing an appropriate motion to amend its pleading, Respondent should not re-file the same First Amended Answer concurrently therewith. Although the First Amended Answer will not be given any consideration, the Board nonetheless notes that the First Amended Answer contains insufficient defenses and redundant matter. For example, extraneous paragraphs 17-26, as well as the first, second, third, fourth, and fifth affirmative defenses clearly would be ripe for striking under Fed. R. Civ. P. 12(f)(1).

Affirmative defenses six and seven appear more appropriate for combination under the single defense of “unclean hands” based on an alleged misuse of the federal registration symbol. *See Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007) (allegation that opposer has misused federal registration symbol construed “as a species of the equitable affirmative defense of unclean hands”); *Penn Dairies, Inc. v. Penn. Agricultural Coop. Mktg. Ass’n*, 200 USPQ 462, 464 (TTAB 1978). In order to establish the affirmative defense of unclean hands based on Petitioner’s misuse of the federal registration symbol, Respondent must allege and prove that the use of the federal registration symbol “was undertaken with fraudulent intent.” *Barbara’s Bakery, Inc.*, 82 USPQ2d at 1292; *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 342 (TTAB 1980) (“[T]o show that such use constitutes ‘unclean hands’ so as to bar the registration of applicant’s mark, it is incumbent upon opposer to show an intent to mislead or deceive in fact.”). This defense should be appropriately and fully pleaded under a single header, with all relevant allegations enumerated thereunder.

Affirmative defense eight is technically deficient. To the extent relevant here, a mark is deemed abandoned

[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.

Trademark Act § 45. Therefore, a properly pleaded defense of abandonment requires an allegation of facts supporting either (1) at least three consecutive years of nonuse, or (2) less than three years of nonuse coupled with an intent not to resume use. *See Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). *See also Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (complaint “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007))). Note that an “intent not to resume” use of the mark, which is required for a defense of abandonment as Respondent attempted to allege, is not necessarily the same as the lack of a current intention to resume use (which might otherwise be relevant). Respondent’s allegation that “Petitioner did not intend to resume use” (para. 60) falls short of alleging that Petitioner has an “intent not to resume.” The difference might be subtle, but the parties should be aware of the requirement for pleading and proof.¹

¹ In order to establish priority, a plaintiff is only required to show prior use, not continuous use of its mark, unless the defendant has asserted the affirmative defense of abandonment. *See West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). Here, Respondent’s prospective defense that Petitioner abandoned use of the SQUEEZE JUICE BAR mark is presented as an appropriate (although insufficiently pleaded) affirmative defense such that Petitioner might have to prove its claimed continuous common law use of the SQUEEZE JUICE BAR mark should Respondent properly allege the defense in a prospective amended pleading. Of course, should Respondent allege this defense

Schedule

Dates are **reset** on the following schedule, which puts the parties back in the same position as of the filing date of the motion to strike and effectively grants the suspension requested in that motion:

Deadline for Discovery Conference	4/27/2016
Discovery Opens	4/27/2016
Initial Disclosures Due	5/27/2016
Expert Disclosures Due	9/24/2016
Discovery Closes	10/24/2016
Plaintiff's Pretrial Disclosures	12/8/2016
Plaintiff's 30-day Trial Period Ends	1/22/2017
Defendant's Pretrial Disclosures	2/6/2017
Defendant's 30-day Trial Period Ends	3/23/2017
Plaintiff's Rebuttal Disclosures	4/7/2017
Plaintiff's 15-day Rebuttal Period Ends	5/7/2017

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.

in the manner it attempted with the First Amended Answer, it would be Respondent's burden to show non-use with intent not to resume.