

THIS DISPOSITION
IS NOT A PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

WINTER

Mailed: August 26, 2008

Opposition No. 91177827
Opposition No. 91177828

SNOCAP, Inc.

v.

Todd Meagher

Before Grendel, Kuhlke and Walsh,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of opposer's motion (filed August 15, 2007) to strike certain affirmative defenses set forth in applicant's answer, applicant's motion (filed October 16, 2007) for summary judgment on the ground that its proposed marks¹ are neither merely descriptive or generic (and alternative motion to compel combined therewith), and opposer's cross-motion (filed November 20, 2007) for summary judgment on the ground that applicant's marks are either merely descriptive or generic.² The

¹ See application Serial Nos. 78853866 and 78853849, respectively, for the marks MYSTORE and MYSTORE.COM, both filed April 4, 2006, based on applicant's alleged *bona fide* intent to use the mark in commerce.

² The Board notes that opposer's cross-motion for summary judgment did not raise its allegation in ¶11 of the notice of opposition, viz. that applicant "did not have at the time of filing a bona fide intent to use the alleged mark mystore (stylized) on or in

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parties have fully briefed³ the motion to strike and the motions for summary judgment.⁴ Opposer did not file a separate brief in opposition to the motion to compel, but rather objects to the motion to compel as a "preliminary matter" in its cross-motion for summary judgment.

Preliminary Matter

We note applicant's motion (filed July 23, 2007) to consolidate these proceedings on the grounds that they involve virtually identical marks and common questions of law and fact, and the parties are the same and are represented by the same counsel. In opposer's cross-motion for summary judgment, opposer does "not object or oppose consolidation."

The Board has reviewed each case and agrees that consolidation is appropriate. In view thereof, applicant's motion to consolidate is granted as well taken. See Fed. R. Civ. P. 42(a); and TBMP § 511 (2d ed. rev. 2004). Accordingly, Opposition Nos. 91177827 and 91177828 may be presented on the same records and briefs. The record will be maintained in Opposition No. **91177827** as the "parent"

connection with some or all of the goods and services" recited in the subject applications.

³ Opposer requests that the Board consider its cross-motion for summary judgment to be its responsive brief to applicant's motion for summary judgment (cross-motion, p. 3).

⁴ The delay in acting upon these matters is regretted.

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case, but all papers filed in these cases should include both proceeding numbers in ascending order.

Motion to Strike⁵

Opposer requests that the Board strike seven of applicant's ten affirmative defenses, viz. those set forth in paragraphs 14, 15, 18, 19, 20, 22 and 23 of the answer. In said paragraphs, applicant alleges that certain trademark registrations on the Principal Register exist (or formerly existed) which contain the terms "MY" and "STORE" without any disclaimer or claim of acquired distinctiveness (§§ 14 & 15); that opposer's claims are barred by the doctrines of laches (§18), estoppel (§19) and acquiescence (§20); that opposer does not have standing to bring this opposition (§22); and that the notice of opposition fails to state a claim upon which relief may be granted (§23).

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. See also Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP 506 (2d ed. rev. 2004). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. See, e.g., *Ohio State University v. Ohio University*,

⁵ The Board presumes the parties' familiarity with the pleadings and the arguments submitted with respect to the subject motion.

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51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, 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) (amplification of applicant's denial of opposer's claims not stricken). Nonetheless, the Board grants motions to strike in appropriate instances.

In regard to applicant's statements related to the alleged trademark registrations for marks comprising the terms "MY" and "STORE", the Board finds that these paragraphs function to amplify applicant's general denial of the grounds for opposition and, thus, provide opposer with notice of applicant's position. Cf. *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of argument in support of denial of claim of likelihood of confusion rather than true affirmative defenses and were treated as such); and *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986). Further,

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the allegations do not prejudice opposer. In view thereof, opposer's motion to strike is denied as to paragraphs 14 and 15 of the answer.

As to paragraphs 18, 19, and 20, which set forth applicant's equitable defenses, opposer's motion to strike is granted. It is well established that the defenses of laches, acquiescence and estoppel cannot be asserted against a claim that a mark is descriptive or generic. See, e.g., *Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (defenses of laches and acquiescence not available against claim of genericness), citing *Yankee, Inc. v. Geiger*, 216 USPQ 996, 1001 (TTAB 1982); and *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002) ("the equitable defenses of laches, estoppel, and acquiescence cannot be asserted against a claim of descriptiveness").

Regarding applicant's defense that opposer does not have standing, we find that the notice of opposition is legally sufficient and that it clearly contains allegations which, if proven, would establish opposer's standing. In particular, the Board finds that opposer has pleaded facts in paragraphs 1, 2 and 13 of the notice of opposition which, if later proved, would establish that it has a real interest in the outcome of the proceeding, that is, a personal interest in the outcome of the case beyond that of the

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general public. See *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Nonetheless, whether these allegations are true is a question of fact to be determined at trial. Accordingly, opposer's motion to strike applicant's affirmative defense set forth in paragraph 22 is denied.

Inasmuch as we have determined that the notice of opposition is legally sufficient, we also find that opposer has set forth therein at least one valid ground for the relief which it seeks. In view thereof, applicant's affirmative defense in paragraph 23, viz. that the notice of opposition fails to state a claim upon which relief may be granted, is unsupported and opposer's motion to strike that affirmative defense is granted.

Accordingly, in view of the foregoing, opposer's motion to strike is granted to the extent that the affirmative defenses in paragraphs 18, 19, 20, and 23 of applicant's answer are hereby stricken.

Motions for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving

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for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). That is, the moving party in each of the pending motions has the burden as to its motion. Additionally, the evidence must be viewed in a light favorable to the non-movant in each party's pending motion, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993). The mere fact that cross-motions for summary judgment on an issue have been filed does not necessarily mean that there are no genuine issues of material fact, and that trial is unnecessary. See 10A Fed. Prac. & Proc. Civ.3d § 2720 (2007).

Based on our review of the arguments and supporting papers of the parties, and drawing all inferences in favor of the non-movant in each motion, we find that neither party has met its burden of showing that it is entitled to disposition of this matter by summary judgment. Specifically, at a minimum, there exist genuine issues of material fact as to whether the terms MYSTORE and MYSTORE.COM are merely descriptive or generic when used in connection with services described in the respective involved applications.⁶ In view thereof, applicant's motion

⁶ The fact that we have identified two genuine issues of material fact as sufficient bases for denying the motion and cross-motion

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for summary judgment and opposer's cross-motion for summary judgment are denied.⁷

Applicant's Alternative Motion to Compel

Applicant requests that the Board consider his motion to compel opposer's responses to applicant's discovery requests (served on opposer on July 23, 2007) if the Board denies applicant's motion for summary judgment. Opposer objects to the consideration of the motion to compel on procedural grounds, and argues that the motion should be denied without prejudice or that opposer should be allowed leave to file a substantive response to applicant's motion after the Board considers the motions for summary judgment. While opposer did not file a brief in opposition to the motion to compel, opposer clearly contests the motion; therefore, we do not treat it as conceded under Trademark Rule 2.127(a).

Applicant's motion to compel is an "alternative" to the motion for summary judgment. As such, we find that applicant's motion for summary judgment is his primary

for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

⁷ The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period (under a notice of reliance, or by properly introducing it as part of a testimony deposition). See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1993); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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motion before the Board and that the motion to compel is not germane thereto. When any party files a motion for summary judgment, no party should file any paper which is not germane to the motion except as otherwise specified in the Board's suspension order. See Trademark Rule 2.127(d). In view thereof, the motion to compel must be considered to be untimely. Accordingly, applicant's motion to compel is denied without prejudice.⁸

⁸ While the Board does not issue advisory opinions, we, nonetheless, feel compelled to comment on the nature of the discovery propounded by applicant and the apparent lack of cooperation between the parties in regard to discovery. In general, to the extent that applicant's interrogatories request opposer to "identify each and every" type of information sought, or to provide all documents relating to a defined subject matter, which contain no temporal or other reasonable limitation, such requests appear overly broad and unduly burdensome. Such discovery requests are not in conformance with the parties' obligation to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the proceeding. See TBMP § 402.01 (2d ed. rev. 2004).

Furthermore, in view of the reasonable number of interrogatories and requests for production of documents propounded by applicant, opposer's refusal to respond to any of applicant's interrogatories or production requests is not well taken. Opposer is reminded that where complete compliance with a particular request would be unduly burdensome, a representative sampling may be provided. See TBMP § 414(2) (2d ed. rev. 2004). In addition, an explanation must be made describing why the request is unduly burdensome. (For example, the responding party has tens of thousands of documents spanning decades.) Additionally, a production of "representative" documents must truly be a representative sampling, and not merely a self-serving selection of favorable documents. See, e.g., *The Procter & Gamble Company v. Keystone Automotive Warehouse, Inc.*, 191 USPQ 468 (TTAB 1976). An evasive or incomplete response is the equivalent of a failure to disclose. Fed. R. Civ. P. 26(g) and 37(a)(3).

Moreover, the Board's standard protective order was effectively made applicable to these proceedings on August 31, 2007 (see the USPTO Notice of Final Rulemaking at 72 Federal Register 42242). See Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g). In view thereof, where opposer has objected on the basis that the interrogatories and document requests seek information that is protected from disclosure, opposer should provide information

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Summary; Proceedings Resumed; Dates Reset

Opposition Nos. 91177827 and 91177828 are hereby consolidated and may be presented on the same records and briefs. The record will be maintained in Opposition No. **91177827** as the "parent" case.

Opposer's motion to strike is granted, as discussed, to the extent that the affirmative defenses in paragraphs 18, 19, 20, and 23 of applicant's answer are hereby stricken.

The parties' respective motions for summary judgment are denied. Applicant's alternative motion to compel is denied without prejudice.

Proceedings herein are resumed, and discovery and trial dates are reset as indicated below:

and/or documents that may need the protection of the standard protective order but are not privileged, as well as a privilege log setting forth the type of information and/or documents that will not be produced and which specific privilege is applicable thereto.

Finally, both parties are reminded that, if a party provides an incomplete response to a discovery request, that party may be precluded from relying at trial on information from its records which was properly sought in the discovery request, but which was not included in the response thereto, unless the response is supplemented in a timely fashion pursuant to Fed. R. Civ. P. 26(e). See *Bison Corp. v. Perfecta Chemie B.V.*, 4 USPQ2d 1718 (TTAB 1987); and TBMP § 408.02 (2d ed. rev. 2004).

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DISCOVERY PERIOD TO CLOSE:	November 26, 2008
Thirty-day testimony period for party in position of plaintiff to close:	February 24, 2009
Thirty-day testimony period for party in position of defendant to close:	April 25, 2009
Fifteen-day rebuttal testimony period to close:	June 9, 2009

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. See Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.125(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB

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inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>