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

Proceeding	91177828
Party	Defendant Todd Meagher
Correspondence Address	TODD MEAGHER 2101 LEGACY CT KELLER, TX 76248-8449 UNITED STATES toddme@gher.com
Submission	Opposition/Response to Motion
Filer's Name	Erik M. Pelton
Filer's e-mail	emp@tm4smallbiz.com
Signature	/ErikMPelton/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SNOCAP, INC.,)
Opposer,) Opposition No. 91177828
v.) Application. Serial No. 78853866
Todd Meagher.) Mark: MYSTORE.COM
Applicant.)

RESPONSE TO OPPOSER’S MOTION TO STRIKE
PORTIONS OF APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES

Opposer has filed a Motion to Strike paragraphs 14, 15, 18, 19, 20, 22, and 23 (the “Contested Paragraphs”) of the Answer to Notice of Opposition (“Answer”).

While pursuant to TBMP § 506.01, the Board may strike “any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter,” Opposer has failed to allege facts or reasons sufficient to justify striking paragraphs from Applicant’s Answer or affirmative defenses. Under Fed. R. Civ. P. 12(f), a court may order stricken from any pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. Opposer has failed to demonstrate that any defense pled by Applicant is insufficient or that any of the Contested Paragraphs are redundant, immaterial, impertinent, or scandalous.

Pursuant to 37 CFR § 2.106(b)(1) and TBMP § 311.02, “An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense.”

In general, “Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case.” TBMP § 506.01. 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. *Id.* Here, the Contested Paragraphs provide fuller notice of the Applicant's defense to the notice of opposition and affirmative defenses. The inclusion of the Contested Paragraphs does not prejudice Opposer in any way.

Paragraphs 14 and 15

Paragraphs 14 and 15 of the Answer contain public record evidence from the records of the U.S. Patent and Trademark Office. Furthermore, this evidence is directly relevant to Opposer's claim of descriptiveness. The evidence shows that numerous other trademarks containing all of the words in Applicant's mark have previously been allowed registration, and is thus an element of one of Applicant's affirmative defenses. "An answer may also include a short and plain statement of any defenses, including affirmative defenses that the defendant may have to the claim or claims asserted by the plaintiff." TBMP § 311.02(b).

The Notice of Opposition in this case is based on allegations of descriptiveness and genericness, not a likelihood of confusion or prior use. Although expired, the Registrations in paragraph 15 of the Answer are useful to show the present and previous policy of the U.S. Patent and Trademark Office in handling certain marks with characteristics relevant to the current proceeding.

In *Aquion Partners L.P. v. Envirogard Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1991), the board held that a laches defense in an opposition can be based on Opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods. Here, paragraphs 14 and 15 in Applicant's Answer contain facts from the public record used by Applicant to demonstrate or allege that Opposer failed to object to earlier registrations of similar

marks. Furthermore, Applicant has not merely listed evidentiary material in its Answer, put has described the material and explained its relevance to Applicant's defenses.

Paragraphs 18-20

Paragraphs 18 to 20 of Applicant's Answer contain claims of the affirmative defenses of the Doctrine of Laches, the Doctrine of Estoppel, and the Doctrine of Acquiescence.

In support of its arguments, Opposer cites a decision in *E.I. DuPont de Nemours and Company v. duPont Publishing* (TTAB 2001, Lexis 740), which is (a) a non-precedential decision; (b) a case based upon a likelihood of confusion under Trademark Act § 2(d); and (c) a Board decision following the parties' full briefing of the issues after discovery, testimony and depositions, not a Motion to Strike.

This Opposition is not based upon an allegation of likelihood of confusion, but rather an allegation of descriptiveness. As a result, the traditional analysis of whether the affirmative defenses of laches, estoppel and acquiescence apply is not appropriate. There is not issue in the present case regarding priority of use. In *Aquion Partners L.P. v. Envirogard Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1991), the board held that a laches defense in an opposition can be based on Opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods. Here, paragraphs 18 to 20 in Applicant's Answer raise the affirmative defenses of laches, estoppel and acquiescence regarding an Opposition proceeding based on a claim of descriptiveness or genericness.

Paragraphs 22 and 23

Paragraph 22 of the Answer alleges that Opposer does not have standing. Paragraph 23 alleges that the Opposition fails to state a claim upon which relief may be granted. Such an

affirmative defense is not only limited to the issue of “standing,” and is appropriate for Applicant to Allege so that, after discovery it is not barred from making such a defense if the facts discovered support the defense.

Opposer has not alleged or shown that Opposer has a competitive need or equal right to use Applicant’s mark in a descriptive manner. In fact, Opposer’s own use of Applicant’s MYSTORE appears to be an attempt to distinguish the services of Opposer from those of its competitor. Opposer repeatedly uses the phrase “SNOCAP MyStore” on its website at <http://www.snocap.com> with capital letters “M” and “S” and the phrase in a font of a different size, boldness, thickness, and style in comparison to Opposer’s general content. Opposer’s own use of “SNOCAP MyStore” as described in Paragraph 2 of the Notice of Opposition, is not descriptive and is attempting to establish trademark usage. An attempt to use the wording in Applicant’s mark in a descriptive manner would appear as “my store.” As a result, Opposer’s standing and ability to claim relief are subject to challenge and discovery.

In support of its arguments regarding Paragraphs 22 and 23, Opposer cites the decision in *James River Petroleum Inc. v. Petro Stopping Centers, L.P.*, 57 U.S.P.Q.2d 1249 (TTAB 2000), which is (a) a non-precedential decision; (b) a case based in part upon an allegation of likelihood of confusion under Trademark Act § 2(d); and (c) a Board decision following cross Motions for Summary Judgment, not a Motion to Strike.

In support of its arguments regarding Paragraphs 22 and 23, Opposer cites a decision in the *Interpayment Services Limited v. Docters & Thiede* (TTAB 2002, Opp. No. 91119852) which does not involve a motion to strike or the sufficiency of any affirmative defenses. Opposer’s claims regarding its standing in this proceeding are irrelevant to the instant Motion to Strike.

Conclusion

The Contested Paragraphs in Applicant's Answer do not prejudice Opposer. The Contested Paragraphs expound upon the defenses and affirmative defenses which are permissible for Applicant to raise in an Opposition based upon descriptiveness and/or genericness. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. TBMP § 311.02.

The purpose of a Motion to Strike is not to test the sufficiency or strength of the defenses alleged by Applicant in the Answer. Rather, it is merely to determine whether the Contested Paragraphs are redundant, immaterial, impertinent, or scandalous matter. Fed. R. Civ. P. 12(f), TBMP § 506.01. Opposer has failed to make a demonstration that the Contested Paragraphs should be stricken from the Answer, and instead argues that Opposer has standing in this matter.

In addition, the majority of authorities cited by Opposer in support of its arguments are cases in which a likelihood of confusion cases and/or priority of use are at issue. The claims and affirmative defenses available in the current proceeding, based on allegations of descriptiveness or genericness, are different from those of a case based on a claim of likelihood of confusion. As a result, Opposer's alleged authorities, including the *Interpayment Services Limited* decision attached to Opposer's motion, are of limited or no value.

As a result of Opposer's own evidence of its use of the MYSTORE name, Opposer has demonstrated that it may *not* have a competitive need or equal right to use the term MYSTORE in a descriptive manner. And thus Opposer may not have standing, may have failed to state a

claim upon which relief may be granted, and may be barred from asserting its claims based on the equitable principles of laches, estoppel and acquiescence.

Applicant hereby requests that the Motion to Strike Portions of Applicant's Answer and Affirmative Defenses be denied, and that the Board grant any other relief it deems appropriate.

Respectfully Submitted,
Todd Meagher (Applicant)

By: /ErikMPelton/
Erik M. Pelton, Esq.

Erik M. Pelton & Associates, PLLC
PO Box 100637
Arlington, Virginia 22210
TEL: (703) 525-8009
FAX: (703) 525-8089

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Response to Motion to Strike Portions of Applicant's Answer and Affirmative Defenses was deposited as First Class mail with the United States Postal Service on August 29, 2007, to Counsel for Opposer at the following address:

Martin R. Greenstein
TechMark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose, CA 95124-5273

By: /ErikMPelton/
Erik M. Pelton, Esq.