

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

Pologeorgis

Mailed: December 31, 2008

Opposition No. 91178512

Anheuser-Busch, Incorporated

v.

Pabst Brewing Company

By the Trademark Trial and Appeal Board:

This proceedings now comes up for consideration of opposer's motion to redesignate applicant's affirmative defense of priority as a counterclaim and to strike applicant's affirmative defenses of laches, estoppel, waiver, unclean hands, and acquiescence. The motion is fully briefed.

The Board, in its discretion, suggested that the issues raised in the aforementioned motion should be resolved by telephonic conference as permitted by TBMP § 502.06 (2nd ed. rev. 2004). The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold a telephone conference at 3:00 p.m., Eastern Time on Friday, December 19, 2008. The conference was held as scheduled among Douglas N. Masters,

as counsel for Anheuser-Busch, Incorporated, Brett Lovejoy and Stephen F. Kampmeier, as counsel for Pabst Brewing Company, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in this case.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding the above matters. During the telephone conference, the Board made the following findings and determinations:

Opposer's Motion to Strike Applicant's Affirmative Defenses of Laches, Estoppel, Waiver, Unclean hands, and Acquiescence

Opposer's motion to strike is granted to the extent that applicant's affirmative defenses of laches, estoppel, waiver, unclean hands, and acquiescence are hereby stricken.¹

¹The Board notes that the affirmative defenses of laches and acquiescence, as well as estoppel and/or waiver by laches or acquiescence, are generally not available in opposition proceedings. See *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). The Board further notes that applicant has not pleaded sufficient factual allegations to substantiate its asserted affirmative defense of unclean hands.

**Opposer's Motion to Redesignate Applicant's Affirmative
Defense of Priority as a Counterclaim**

Preliminarily, we note that priority technically remains an issue in this case to the extent that opposer has yet to make of record proper status and title copies of its pleaded registrations. If opposer properly makes its pleaded registrations of record during its assigned testimony period and such registrations are properly maintained during the course of this proceeding, priority would then not be an issue in this case in the absence of counterclaim asserted by applicant.² See *King Candy v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

In view thereof, opposer's motion to redesignate is granted to the extent that applicant's affirmative defense of priority is stricken conditioned upon opposer's submission of appropriate status and title copies of its pleaded registrations during its assigned testimony period and proper maintenance thereof.

As a final matter, the stipulated protective agreement filed on June 12, 2008 is noted and its use in this proceeding is approved. The parties are referred, as

²The Board notes that copies of registrations retrieved from the Trademark Application and Registration Retrieval database ("TARR") do not constitute proper status and title copies for proceedings commenced prior to August 31, 2008, as is the case here.

appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Proceedings herein are resumed. Discovery is closed. Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE:	CLOSED
Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	2/27/2009
Testimony period for party in position of defendant to close:(opening thirty days prior thereto)	4/28/2009
Rebuttal testimony period to close: (opening fifteen days prior thereto)	6/12/2009

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 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>