

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

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Mailed: April 24, 2009

Opposition No. 91187383

EXPRESS FRANCHISE SERVICES,  
L.P. AND EXPRESS SERVICES,  
INC.

v.

FLEXSCAN, INC.

By the Board:

This proceeding is before the Board for consideration of opposers' motion (filed December 29, 2008) to strike certain of applicant's affirmative defenses. The motion is fully briefed.

Express Franchise Services, L.P. and Express Services, Inc. ("opposers") oppose registration of applicant's mark TRIALS EXPRESS (in standard characters, TRIALS disclaimed) for "recruitment advertisement services for pharmaceutical companies, namely, posting of detailed and targeted clinical trial notices, based on medical and lifestyle criteria, for the purpose of recruiting patients for participation in clinical trials for the testing of drugs" in International Class 35,<sup>1</sup> alleging the grounds of priority, likelihood of confusion under Trademark Act Section 2(d), and dilution under Trademark Act Section 43(c). Opposers plead ownership of 23 U.S.

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<sup>1</sup> Application Serial No. 77357346 filed December 20, 2007, based on a bona fide intent to use the mark in commerce under Trademark Act Section 1(b).

registrations, most of which consist of or include the term EXPRESS.

In its answer, applicant denied the salient allegations in the notice of opposition, and asserted the following affirmative defenses:

- 1) Opposer has failed to state a claim upon which relief can be granted.
- 2) Opposer has no standing to assert the claims set forth in the Notice of Opposition.
- 3) Opposer's claims are precluded by the Doctrine of Estoppel.
- 4) Opposer's claims are precluded by the Doctrine of Acquiescence.
- 5) Opposer will not be damaged by registration of Applicant's Mark.
- 6) Opposer is barred, in whole or in part, from relief by the Doctrine of Waiver.
- 7) Opposer is barred, in whole or in part, from relief by the Doctrine of Laches.
- 8) Opposer is barred, in whole or in part, from relief by the Doctrine of Unclean Hands.
- 9) Opposer's claims are barred, in whole or in part, to the extent that there exists no likelihood of confusion between the marks at issue.
- 10) Opposer's claims are barred insofar as Opposer has abandoned its trademark(s).
- 11) Opposer has failed to adequately maintain, police or enforce any trademark or proprietary rights it may once have had in its alleged pleaded mark(s).

Opposers filed a motion to strike, seeking to strike each of these affirmative defenses. See Fed. R. Civ. P. 12(f); see also TBMP Section 506.02 (2d ed. rev. 2004). Opposers assert that each defense is insufficiently pleaded under Fed. R. Civ. P. 8(b). Opposers further move the Board to strike applicant's second affirmative defense ("Opposer has no standing to assert the claims set forth in the Notice of Opposition.") as insufficient as a matter of law, asserting that the defense is precluded by applicant's own admission, in its answer, that opposers are "the listed owner of the term EXPRESS," that

opposer (sic) "has adopted a family of marks," and that opposer (sic) "has various federal trademark registrations with" the USPTO.

In response, applicant states that its affirmative defenses are sufficiently pleaded, comply with Fed. R. Civ. P. 8(c), and adequately put opposers on notice of the nature of the defenses. Applicant argues that opposers have failed to establish that the affirmative defenses are not related to or have no bearing on the issues, and that opposers have not established that they will suffer the prejudice necessary to succeed on their motion.

Motion to Strike: Analysis

The Board may, upon motion or by its own initiative, order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f).<sup>2</sup> See also TBMP Sections 506.01 and 506.02 (2d ed. rev. 2004). The Board also has the authority to strike an impermissible or insufficient claim, or portion of a claim. Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. Since the primary purpose of pleadings is to give fair notice of the claims or defenses asserted, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but

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<sup>2</sup> Fed. R. Civ. P. 12 is applicable to Board proceedings by operation of Trademark Rule 2.116(a).

rather will provide fuller notice of the basis for a claim or defense. See *Ohio State University v. Ohio University*, 51 USPQ2d 1289 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); *FRA S.p.A., et al. v. Surg-O-Flex of America, Inc., et al.*, 194 USPQ 42 (S.D.N.Y. 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Company, Inc.*, 177 USPQ 401 (TTAB 1973).

Applicant's first affirmative defense asserts that opposers have failed to state a claim upon which relief can be granted. As the Board stated in *S.C. Johnson & Son, Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973):

While Rule 12(b)(6) permits a defendant to assert in his answer the "defense" of failure to state a claim upon which relief can be granted, it necessarily follows that the plaintiff may utilize this assertion to test the sufficiency of the plaintiff's pleading in advance of trial by moving under Rule 12(f) ... to strike the "defense" from the defendant's answer.

In order to state a claim upon which relief can be granted, opposers need only allege such facts as would, if proved, establish that (1) they have standing to maintain the proceedings, and (2) a valid ground exists for denying the registration sought. See *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998), and cases cited therein.

Regarding standing, which is a threshold inquiry made by the Board in every inter partes proceeding, see *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1029 (Fed. Cir. 1999),

opposers here have pleaded ownership of U.S. Registration Nos. 1647022, 3283142, 1700779, 1651735, 3521806, 2530726, 3264222, 2771742, 1708586, 1946030, 1718629, 2225130, 2637864, 2124198, 1646233, 3264785, 3170671, 1623976, 1651736, 2857857, 2877119, 3246081, and 3517960, and thus have sufficiently alleged a "real interest" in this proceeding. Furthermore, opposers have sufficiently set forth the grounds of priority and likelihood of confusion under Trademark Act Section 2(d), alleging (1) that applicant's mark, as applied to the goods or services, so resembles opposers' marks as to be likely to cause confusion, mistake or deception, and (2) that opposers have priority of use. See Fed. R. Civ. P. 8; see also *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, given that the notice of opposition sets forth allegations sufficient to state a claim upon which relief can be granted, applicant's defense fails as legally insufficient, and opposers' motion to strike is granted as to the first affirmative defense.

Similarly, opposers' motion is granted with respect to applicant's second affirmative defense, namely, that opposers lack standing. As stated, opposers plead ownership of 23 registrations, 22 of which consist of or include the term EXPRESS, and thus have established a "real interest" and "direct and personal stake" in the outcome of the proceeding and in the determination of registrability of applicant's

TRIALS EXPRESS mark. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Moreover, applicant, in its answer, admitted opposers' listed ownership of the term EXPRESS, opposers' adoption of a family of marks, and opposers' ownership of various federal trademark registrations. Thus, in summary, opposers have established their standing to bring this proceeding.

Turning to applicant's third, sixth and eighth affirmative defenses, alleging that the opposition is barred by the doctrines of estoppel, waiver and unclean hands, respectively, opposers' motion to strike is granted. These defenses contain no specific allegations of conduct on the part of opposers which, if proved, would prevent opposers from prevailing on their claims. Rather, the defenses are unclear, non-specific, or merely conclusory in nature, and thus insufficiently pleaded, failing to give fair notice as to the basis for the defenses. See, e.g., *Heisch v. Katy Bishop Productions Inc.*, 45 USPQ2d 1219 (N.D. Ill. 1997); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987); Wright & Miller, *Federal Practice and Procedure: Civil 2d*, Section 1274 (1990 & Supp. 2001).

Regarding applicant's fourth and seventh affirmative defenses of preclusion by the doctrines of acquiescence and

laches, respectively, opposers' motion is granted inasmuch as these defenses are unavailable and inapplicable. *Krause v. Krause Publications Inc.*, 76 USPQ2d 1904 (TTAB 2005) (equitable defense of acquiescence in opposition or cancellation proceeding does not begin to run until mark is published for opposition). *See also National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991) (laches runs from the time from which action could be taken against the trademark rights inhering from registration). Furthermore, these equitable defenses are insufficiently pleaded inasmuch as they are conclusory allegations that do not give opposers fair notice as to the bases for the defenses, and thus are inconsistent with the notice-pleading standard of Fed. R. Civ. P. 8(a). *See Heisch v. Katy Bishop Productions Inc.*, *supra* at 1221.

Turning to applicant's fifth affirmative defense, that opposers will not be damaged by registration of applicant's mark, and ninth affirmative defense, that there exists no likelihood of confusion between the marks at issue, these assertions, rather than being affirmative defenses, set forth allegations in the nature of arguments in support of applicant's denials of opposers' claims, and thus amplify such denials. Such amplifications of denials are permitted because they serve to give opposers fuller notice of the position

applicant plans to take in defense of its right to registration. See *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987); *The Maytag Co. v. Luskins, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986). Moreover, the Board finds no prejudice to opposer in allowing these assertions. Accordingly, with respect to these defenses, opposers' motion to strike is denied.

Regarding applicant's tenth and eleventh affirmative defenses, alleging respectively that opposers have abandoned the trademark(s), and that opposers have failed to adequately maintain, police or enforce their pleaded trademark(s), opposers' motion to strike is granted. The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration. See Trademark Rules 2.106(b)(1) and (b)(2); TBMP § 311.02(b)(2d ed. rev. 2004). See also *Gould Inc. v. Sanyo Electric Co.*, 179 USPQ 313 (TTAB 1973).

In summary, opposers' motion to strike is granted with respect to applicant's first, second, third, fourth, sixth, seventh, eighth, tenth and eleventh affirmative defenses, and is denied with respect to applicant's fifth and ninth affirmative defenses. Applicant's first, second, third, fourth, sixth, seventh, eighth, tenth and eleventh affirmative defenses are hereby stricken from its answer.

Revocation of power of attorney

The Board acknowledges applicant's revocation of power of attorney filed March 17, 2009, and change of correspondence address. The Board has updated its records accordingly. The firm of Stetina, Brunda, Garred and Brucker no longer represents applicant in this proceeding, and a copy of this order has been sent to all persons listed below.

cc:

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Motion for extension

The Board notes applicant's motion (filed March 18, 2009) for a 30-day extension to respond to discovery and extension of remaining deadlines.

It is general Board practice to suspend proceedings to accommodate a pro se party's need to secure legal counsel. Furthermore, opposers did not file a brief in opposition to applicant's request for an extension, and applicant's request indicates its intent to appoint new counsel and to advance this

proceeding. Accordingly, for good cause shown, applicant's motion is granted to the extent that (1) applicant's responses to outstanding discovery shall be due thirty (30) days from the mailing date of this order; and (2) remaining disclosure, discovery and trial dates are reset as follows:

Initial Disclosures Due	5/25/2009
Expert Disclosures Due	9/22/2009
Discovery Closes	10/22/2009
Plaintiff's Pretrial Disclosures	12/6/2009
Plaintiff's 30-day Trial Period Ends	1/20/2010
Defendant's Pretrial Disclosures	2/4/2010
Defendant's 30-day Trial Period Ends	3/21/2010
Plaintiff's Rebuttal Disclosures	4/5/2010
Plaintiff's 15-day Rebuttal Period Ends	5/5/2010

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.

**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](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>