

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

Faint

Mailed: March 23, 2011

Opposition No. 91194379

Cornfields, Inc.

v.

Adeena Weiss d/b/a Skinny
Munch Corp.

**Before Seeherman, Holtzman and Cataldo,
Administrative Trademark Judges.**

By the Board:

Applicant/counterclaim petitioner (hereinafter "applicant") has applied to register the mark SKINNY MUNCH in standard character form for "grain-based snack foods."¹ Opposer/counterclaim respondent (hereinafter "opposer") opposes the application on the ground of likelihood of confusion with its registered mark for SKINNY in typed form for "food products-namely, snack chips of a corn meal nature," Registration No. 911254.² With her answer, applicant counterclaimed to cancel the pleaded registration on the ground of genericness.

This case now comes up on the following motions:

¹ Application Serial No. 77780921, filed July 14, 2009, based on applicant's allegation of its bona fide intent to use the mark in commerce pursuant to Trademark Act § 1(b).

² The registration issued April 13, 1971 on the principal register, and has been renewed twice.

- 1.) opposer's motion for judgment on the pleadings pursuant to Fed. R. Civ. P. 12(c) on the ground of likelihood of confusion; and
- 2.) applicant's motion to strike opposer's affirmative defenses in opposer's answer to the counterclaim.

The motions are contested.

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion, all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied, or which are taken as denied pursuant to Fed. R. Civ. P. 8(b)(6), are deemed false.³ Conclusions of law are not taken as admitted. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ2d 1048 (TTAB 1992). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Id.* A party may not obtain judgment on the pleadings if the nonmoving party's pleading, the allegations of which are accepted as true, raises an issue of fact that, if proved, would establish the nonmoving party is entitled to judgment. *Id.*

Priority and Likelihood of Confusion

³ We note that applicant submitted a list of third-party registrations with her response brief. It is within the Board's discretion whether to accept extra-pleading matter, in which case the motion is treated as one for summary judgment. See Fed. R. Civ. P. 12(d); see also *Sellers v. M.C. Floor Crafters, Inc.*, 842 F.2d 639 (2nd Cir. 1988). In this case, we have made our determination of opposer's motion for judgment on the pleadings, in regard to opposer's Section 2(d) claim, without considering applicant's list of third-party registrations.

Opposer argues that judgment on the pleadings is appropriate here because there are no genuine issues of material fact as to priority of use and likelihood of confusion, inasmuch as applicant admits opposer is the owner of the mark SKINNY for snack foods, and opposer's pleaded registration registered thirty-eight years prior to applicant's filing date for its intent to use application. Applicant argues that opposer has no standing and that applicant's mark and goods are not similar to those of opposer.

Judgment on the pleadings is not appropriate in this case. With respect to priority, the usual rule, that priority is not in issue where opposer pleads a registration, does not apply when there is a counterclaim to cancel the registration. *Cf. King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The counterclaim puts the burden on opposer to prove its priority. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) (prior use need not be shown by plaintiff relying on registered mark unless defendant counterclaims for cancellation). Furthermore, the counterclaim in this case, which is based on genericness, at a minimum, raises genuine issues of material fact as to opposer's proprietary rights in the mark. If the mark is ultimately found to be generic, opposer likely cannot establish proprietary rights and the likelihood of confusion claim would fail as a matter

of law. *See, e.g., NASA v. Bully Hill Vineyards, Inc.*, 3 USPQ2d 1671, 1676 (TTAB 1987) (generic term SPACE SHUTTLE cannot serve as basis for plaintiff's likelihood of confusion claim).

We note that opposer places considerable reliance upon the asserted admissions in the following paragraphs of applicant's answer (which repeat the allegations of the notice of opposition):

1. Opposer owns the following U.S. trademark registrations and pending applications (hereinafter collectively the SKINNY Marks):

Mark	Reg. No. / App. No.	Reg. Date	Goods
SKINNY	911,254	4/13/71	Food products, namely snack chips of a corn meal nature, onion dip mixes, and candy
SKINNY STICKS	77/826,529	n/a	Potato-based snack foods; Vegetable-based snack foods
SKINNY MINIS	77/826,841	n/a	Potato-based snack foods; Vegetable-based snack foods

ANSWER: Applicant admits Opposer owns the mark ?SKINNY? [sic]. Further answering, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 1 of the Notice of Opposition, and accordingly denies the same.

8. Notwithstanding Opposer's prior rights in and to its SKINNY Marks, Applicant filed an application, U.S. Serial No. 77/780,921, for registration of the mark SKINNY MUNCH, which Applicant intends to use in connection with "grain-based snack foods" in International Class 30. This application was published in the December 1, 2009 issue of the *Official Gazette* (Trademarks) of the United States Patent and Trademark Office, and Opposer was granted a time extension until March 31, 2010 to oppose.

ANSWER: Applicant admits she filed an application for the mark ?SKINNY MUNCH?[sic], which is in part, comprised of multiple grains, not including corn. Further answering, Applicant admits that the application was published in the *Official Gazette*. Applicant admits Opposer requested an

extension of time to file their opposition and was granted same. Applicant admits the remaining allegations.

However, reading the answer in its entirety, including the counterclaim, and drawing all reasonable inferences as we must in favor of applicant, we find that the statements in applicant's answer fall far short of an admission that opposer has priority or even that opposer has proprietary rights in SKINNY as a mark.

In view thereof, we find there exist genuine issues of material fact, and opposer is not entitled to judgment. Accordingly, opposer's motion for judgment on the pleadings is denied.

Motion to Strike

We turn next to applicant's motion to strike opposer's affirmative defenses from its answer. As noted, the counterclaim was brought on the ground of genericness, alleging opposer's registered mark SKINNY lacks evidence of secondary meaning, opposer has failed to protect its rights, or object to or prevent misuse of the mark by others, and that there has been third-party use of the mark as a common noun. Opposer denied all the salient allegations in the counterclaim, and asserted the following affirmative defenses:

1. Applicant's claim fails to state a claim upon which relief can be granted.
2. Applicant's recovery is barred by the doctrine of unclean hands.
3. Applicant's claim is barred in whole or in part by the doctrine of waiver.
4. Applicant's claim is barred by the doctrine of estoppel.

5. Applicant's claim is barred in whole or in part because it [sic] has not been damaged by any act or omission on the part of opposer.

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense. However, motions to strike are not favored, and matter will not be stricken unless such matter clearly has no bearing upon the issues in the case. See *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1570 (TTAB 1988); and *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401, 402 (TTAB 1973). Turning to opposer's first affirmative defense to the counterclaim, while Fed. R. Civ. P. 12(b)(6) allows a defendant to raise a defense of failure to state a claim by motion, it does not prevent the pleading as an affirmative defense. See Fed. R. Civ. P. 12(b). As a consequence, it follows that a plaintiff may move to test the sufficiency of this assertion in advance of trial by moving to strike the defense from the answer under Fed. R. Civ. P. 12(f). *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995). As such, a motion to strike the defense of failure to state a claim upon which relief can be granted is a test of the sufficiency of the pleading, and all of applicant's well-pleaded allegations in the counterclaim must be accepted as true, and construed in the light most favorable to applicant in her position as counterclaim plaintiff.

The counterclaim is sufficiently pleaded if it alleges such facts that would, if proven, establish that

- 1) counterclaimant has standing to challenge the

registration and 2) there exists a statutory ground for cancelling the subject registration. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982).

Applicant's standing to assert the counterclaim arises from her position as a defendant in the opposition initiated by opposer. See *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (opposer's assertion of its registration to prevent registration of applicant's mark sufficient to prove applicant's standing to bring counterclaim). Given her standing, all applicant need do for notice pleading of genericness is to state a claim for that ground for cancellation. See Fed. R. Civ. P. 8(d); see also, *General Mills Inc. v. Nature's Way Products, Inc.*, 202 USPQ 840, 841 (TTAB 1979) (applicant need only properly allege elements of fraud to counterclaim to cancel on those grounds). In this case, we find that applicant has adequately pled genericness. Accordingly, applicant's motion to strike opposer's first affirmative defense is granted.

Next we turn to opposer's affirmative defenses of unclean hands, waiver and estoppel. Where the ground for cancellation is genericness, equitable defenses such as unclean hands, waiver and estoppel are not available in light of the overriding public interest in removing registrations of generic terms from the register. *Loglan Institute, Inc. v. Logical Language Group, Inc.*, 22 USPQ2d

1531, 1534 (Fed. Cir. 1992) (affirming equitable defenses not available where mark is generic). In view thereof, opposer's affirmative defenses numbered 2, 3 and 4 are stricken.

Opposer's fifth affirmative defense asserts that applicant has not been damaged by an act on the part of opposer. As discussed above, applicant's belief in damage, and her standing, arise from her position as defendant in the opposition. *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987). That is, opposer's act in bringing the opposition, and asserting its registration against applicant, has given rise to applicant's reasonable belief in damage from the registration. Accordingly, applicant's motion to strike opposer's fifth affirmative defense is granted.

Summary

In summary, opposer's motion for judgment on the pleadings is denied. In view of applicant's counterclaim to cancel opposer's Registration No. 911254, this registration is of record and, in the event that the counterclaim for cancellation is not granted, may be relied upon by opposer in support of its likelihood of confusion claim. Applicant has proven her standing to bring the counterclaim.

Applicant's motion to strike opposer's affirmative defenses to the counterclaim is granted. In view thereof,

opposer's affirmative defenses 1, 2, 3, 4 and 5 are stricken from the answer to the counterclaim.

Dates Reset

Conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for Discovery Conference	March 31, 2011
Discovery Opens	April 30, 2011
Initial Disclosures Due	May 30, 2011
Expert Disclosures Due	September 27, 2011
Discovery Closes	October 27, 2011
Plaintiff's Pretrial Disclosures	December 11, 2011
30-day testimony period for plaintiff's testimony to close	January 25, 2012
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	February 9, 2012
30-day testimony period for defendant and plaintiff in the counterclaim to close	March 25, 2012
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 9, 2012
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	May 24, 2012
Counterclaim Plaintiff's Rebuttal Disclosures Due	June 8, 2012
15-day rebuttal period for plaintiff in the counterclaim to close	July 8, 2012
Brief for plaintiff due	September 6, 2012
Brief for defendant and plaintiff in the counterclaim due	October 6, 2012
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	November 5, 2012
Reply brief, if any, for plaintiff in the counterclaim due	November 20, 2012

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.

☼☼☼