

ESTTA Tracking number: **ESTTA672558**

Filing date: **05/15/2015**

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

Proceeding	91221004
Party	Plaintiff International IP Holdings, LLC
Correspondence Address	CHRISTOPHER W SCHNEIDER OAKLAND LAW GROUP PLLC 38955 HILLS TECH DRIVE FARMINGTON HILLS, MI 48331 UNITED STATES cschneider@oaklandlawgroup.com, trademarks@oaklandlawgroup.com
Submission	Motion to Strike
Filer's Name	Christopher W Schneider
Filer's e-mail	cschneider@oaklandlawgroup.com, trademarks@oaklandlawgroup.com
Signature	/cwschneider/
Date	05/15/2015
Attachments	Motion To Strike RE and Design -12 may15.pdf(148683 bytes )

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

International IP Holdings, LLC,

Opposer,

v.

Tom Miles,

Applicant.

Mark: REAL and Design



Serial No.: 86/138,010

Opposition No.: 91221004

**International IP Holdings' Motion to Strike Applicant's Affirmative  
Defenses in Opposition No. 91221004**

Opposer, International IP Holdings, LLC ("IIPH"), through its counsel Oakland Law Group, PLLC, hereby moves the Board to strike Applicant, Tom Miles ("Applicant") affirmative defenses as legally insufficient, immaterial, insufficiently pleaded, and constituting an impermissible broadening.

**Preliminary Statement**

Applicant's Answer in the 91221004 proceeding (Dkt. No. 4) asserts nine affirmative defenses. One seeks to retract the colors claimed as part of the mark. One defense claims the Dietary Supplement Health and Education Act of 1994 preempts the possibility of a likelihood of confusion. Five defenses seek to narrow Applicant's goods, packaging, or channels-of-trade in an attempt to avoid consumer confusion with IIPH's marks. However, IIPH's registrations have no such restrictions so IIPH's registrations encompass Applicant's proposed restrictions. The remaining affirmative defenses are not true affirmative defenses or avoidances.

Applicant's affirmative defenses are futile, immaterial, and have no bearing on the case. The Board should strike the affirmative defenses to avoid unnecessary delays and expenses to the Parties.

### **Argument**

#### **1. Affirmative Defense Number 7 constitutes a material alteration in the form of an impermissible broadening of rights.**

Applicant's Affirmative Defense number seven states: "Applicant is at least entitled to a registration...excluding use of orange, yellow and the tri-color fade." (Dkt. No. 4, pg. 4). Application 86/138,010 ("Application '010"), expressly claims the colors red and orange. Applicant now seeks registration for all colors except "orange, yellow and the tri-color fade" (red, orange, and yellow). Aside from the fact that Application '010 clearly contains the colors red and orange as originally claimed, the proposed material alteration is an impermissible broadening of rights. Applicant cannot revise his application to exceed the scope of the original application. 37 CFR §2.173; *Aries Systems Corp. v. World Book Inc.*, 26 U.S.P.Q.2d 1926, 1931 (TTAB 1993)("applicant's suggestion that its goods be revised... impermissibly broadens its application..[w]e consequently cannot adopt the foregoing changes.").

#### **2. Affirmative Defenses Numbers 1-4 are not valid Affirmative Defenses or Avoidances under FRCP 8.**

The first affirmative defense claims that under the Dietary Supplement Health and Education Act of 1994 ("DSHEA") "Opposer is regulated against being

confused as real food” (Dkt. 4, pg. 2-3). DSHEA has no bearing upon the issues in this case. Applicant argues federal regulation creates an absolute bar to a likelihood of consumer confusion between marks used on goods defined as dietary supplements under DSHEA and marks used on a non-dietary supplement food. Moreover, many of the goods in Application ‘010 may also be dietary supplements including, but not limited to, chia, hemp seeds, herbs, whey-based beverages, and energy drinks.

The Board should strike Defenses 2-4 as nothing more than merely reiterated denials of a likelihood of confusion without adding anything of substance. *Textron, Inc. v. Gillette Co.*, 180 USPQ 152 (TTAB 1973).

**3. Applicant inadequately pleads Affirmative Defenses Numbers 5-9 by not setting forth the proposed restrictions in detail.**

An affirmative defense may include a pleading that applicant is at least entitled to a registration with a particular restriction. TBMP §311.02(b). However, Applicant does not set forth the proposed restrictions with specificity as to how he seeks to restrict the identification of goods as required by TBMP §311.02(b). For example, Applicant fails to identify which of the proposed restrictions applies to which goods or classes.

**4. Affirmative Defenses 5-9 are immaterial as IIPH’s registrations wholly encompass the proposed restrictions to Application ‘010.**

The identifications of goods in IIPH’s pleaded registrations are without restriction as to packaging, size, purchasers or channels-of-trade. Applicant’s

proposed restrictions would not affect the likelihood of confusion analysis in any meaningful manner and are therefore immaterial.

To the extent the channels-of-trade and purchasers overlap, they are identical in part. “It is not significant, either in law or fact, that the channels of trade for opposer's [goods] may actually be broader than applicant's channels of trade.” *Tea Board of India v. The Republic of Tea, Inc.*, 80 USPQ2d 1881, 1898 (TTAB 2006) (“In any event, the question of likelihood of confusion is based on the goods as identified in the application and registrations regardless of what the record may show as to the actual channels of trade or purchasers for the goods.”).

Applicant’s Affirmative Defenses are nothing more than vague and improper attacks on IIPH’s registrations. Applicant seeks registration of the entire marketplace save a carve-out for presumptions made about the marketplace conditions under which IIPH’s sells its goods. Marketplace conditions are irrelevant when considering the likelihood of confusion between a registered mark and an applied-for-mark. The second *du Pont* factor mandates consideration of the similarity or dissimilarity of the goods “as described in an application or registration.” *In re E. I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). IIPH’s registrations do not have any restrictions. Any restriction to the opposed application is futile and immaterial as IIPH’s registrations are broader than, and therefore encompass, the proposed restrictions.

**Conclusion**

Applicant's Affirmative Defenses are immaterial and have no bearing to the issues of the instant proceeding. One defense argues DSHEA preempts the possibility of a likelihood of confusion between marks. One seeks impermissible alteration of the mark by retracting the color claim. Five defenses seek restrictions to Application '010 that IIPH's registrations would nevertheless encompass. Additionally, Applicant fails to plead its proposed restrictions in detail.

WHEREFORE, for the reasons stated above, Opposer, International IP Holdings, LLC respectfully requests the Board to strike Applicant's nine affirmative defenses in Proceeding 91221004 as factually and legally immaterial and for such further relief as this Honorable Board deems appropriate.

Respectfully submitted,  
OAKLAND LAW GROUP, PLLC  
*Attorneys for Opposer,*  
*International IP Holdings, LLC*



---

Christopher W. Schneider  
Robert A. Bondra  
Paul Hoffer  
38955 Hills Tech Drive  
Farmington Hills, Michigan 48331  
Tel. (248) 536-0795  
Fax (248) 536-1848

Date: May 15, 2015

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 15<sup>th</sup> day of May, 2015, a true copy of the foregoing **Motion to Strike** is being served on Applicant via First Class Mail at:

Wendy Peterson  
Not Just Patents LLC  
PO BOX 18716  
Minneapolis, MN 55418

OAKLAND LAW GROUP, PLLC



---

Christopher W. Schneider  
38955 Hills Tech Drive  
Farmington Hills, Michigan 48331  
Tel. (248) 536-0795  
Fax (248) 536-1848

*Attorneys for Opposer, International IP Holdings, LLC*