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

Proceeding	91226647
Party	Defendant Food Dudes Delivery, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Dude IP, LLC, Opposer, v. Food Dudes Delivery, LLC, Applicant.	Opposition No.: 91226647 Application No.: 86/577,684 Mark: FOOD DUDES

APPLICANT FOOD DUDES DELIVERY, LLC'S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE

Applicant Food Dudes Delivery, LLC ("Applicant"), hereby submits its memorandum of law in opposition to Opposer Dude IP, LLC's ("Opposer") motion to strike, in accordance with TBMP §§ 502.02 & 517. Opposer's motion to strike is without basis as it offers no authority for striking a timely filed, ten page reply brief. In contrast, Opposer's unfounded motion to strike brought under Fed. R. Civ. P. 12(f) and TBMP § 506 is untimely under those rules and should be denied on that basis alone.

Alternatively, Opposer's motion should be denied under TBMP § 517. What Opposer seeks to avoid by filing this motion to strike is the Board's consideration of Applicant's rebuttal to the arguments raised in Opposer's brief in opposition to Applicant's motion for leave to amend and the evidence presented in support of that rebuttal. Applicant's motion and its reply directly relate to statements made by Opposer in its Opposition. Where Opposer relies on its alleged rights under U.S. Reg. No. 4101367 ("'367 Reg.") in support of its Opposition, Applicant responds with evidence that Opposer lacks viable rights in the '367 Reg. Where Opposer relies on statements made to the USPTO and the Board to support its claimed rights in U.S. Reg. No.

4702834 ("'834 Reg."), Applicant responds with evidence that these statements are false and that Opposer repeatedly made them knowing they were false. Lastly, where Opposer relies on its claim to priority as a basis for refusing Applicant's application, Applicant responds with evidence that Opposer's assignor abandoned its trademark rights prior to assigning it to Opposer and, therefore, Opposer obtained no trademark rights from assignor Veneziano, including any enforceable rights under the '367 Reg. Contrary to Opposer's claim, all of these issues are germane to the pending Opposition, and were made as of right under TBMP § 517. For these reasons, the Board should deny Opposer's motion to strike, and consider the evidence presented in Applicant's reply when ruling on Applicant's motion for leave to amend.

BACKGROUND

Applicant filed its motion for leave to amend its answer and counterclaims on January 3, 2017 after receiving Opposer's discovery responses in late-December 2016. (9 TTABVUE 4.) In its first set of discovery requests—served immediately after settlement discussions broke down in November 2016—Applicant explicitly requested information and documents related to Opposer's rights in the DELIVERY DUDES mark dating back to its claimed first use in October 2005.[1] (12 TTABVUE, Exs. 1-2.) Applicant's discovery requests also sought information and documents related to the assignment of the '367 Reg. by Mark Veneziano, as well as Veneziano's use of the DELIVERY DUDES mark, and all communications that transpired between Opposer and Veneziano in relation to the assignment. (*Id.*) On December 15, 2016, Opposer served its responses to Applicant's discovery requests in which Opposer repeatedly refused to supply any information or documents supporting its claimed first use date, Veneziano's use of the DELIVERY DUDES mark, and its assignment. (*Id.*) Specifically,

[1] October 7, 2005 is the claimed date of first use in both the '367 Reg. and the '834 Reg. (9 TTABVUE 3-4.)

Opposer could not produce any information or documents showing that Veneziano was actively using the mark in commerce when he applied for the '367 Reg. or on September 12, 2012—the date the '367 Reg. was assigned to Opposer. (*Id.*) Finally, Opposer could produce no evidence that it had received any assets or ongoing business with the assignment of the registration. Instead, Opposer's lack of responsive discovery demonstrated that the assignment of the '367 Reg. was, in fact, naked. (*Id.*) The parties' counsel held a meet-and-confer conference on December 22, 2016, in which it became apparent that Opposer would continue to resist this discovery.

Upon initiating its own investigation, Applicant discovered that at the time Veneziano applied for the DELIVERY DUDES registration on March 17, 2011, he had not used the mark in commerce for at least three years. (11 TTABVUE 6-7, Exs. 9, 11-13.) Despite this, Veneziano claimed to have ongoing use of the mark in commerce. (*Id.*) The '367 Reg. issued on this basis. However, based on Internet archive records of the Veneziano's online-order delivery website, the mark had not been in use for at nearly four years. (*Id.*) As a result, Veneziano had no rights in the abandoned '367 application that he could lawfully transfer to Opposer in 2012.

Applicant promptly filed its motion for leave to amend on January 3, 2017. Opposer filed its response on January 13, 2017, objecting to Applicant's ability to amend its answer and assert a counterclaim on the grounds that Applicant's motion was untimely, that Applicant needed to prove the merits of its amendment "to the hilt" before being given the ability to amend, that Applicant was engaging in an "impermissible collateral attack," and that Applicant's amendment was futile. (10 TTABVUE *et seq.*) Applicant timely filed its reply brief on January 30, 2017 rebutting each issue Opposer raised to Applicant's motion. Opposer filed this motion to strike on February 8, 2017.

I. Opposer's Motion to Strike Under Fed. R. Civ. P. 12(f) is Untimely

Opposer's asserts that its motion is brought under Fed. R. Civ. P. 12(f) and TBMP § 506, but under those rules the motion is untimely. Federal Rule of Civil Procedure 12(f) states that a court may strike a pleading on motion "made by a party either before responding to the pleading or, if a response is not allowed, within 21 days after being served with the pleading." Fed. R. Civ. P. 12(f). TBMP § 506 states the same. *See also Am. Vitamin Prods. v. Dowbrands, Inc.*, 22 U.S.P.Q.2d 1313 (TTAB 1992) ("A motion to strike must be filed within 20 days after service of an answer upon a party."). Applicant served its amended answer upon Opposer on January 3, 2017, thus, any 12(f) motion to strike it was due by January 24, 2017. Opposer filed this motion to strike on February 8, 2017. It appears Opposer confuses an answer with a reply brief in bringing its motion under Rule 12(f) and TBMP § 506. Regardless, Applicant's motion is untimely and should be denied.

II. Applicant's Amended Answer and Counterclaims are Directly Related to the Outcome of this Opposition.

If the Board does not deny Opposer's 12(f) motion to strike Applicant's proposed amended pleadings as untimely, it should still deny the motion because Applicant's proposed amended pleadings are directly related to Opposer's opposition. TBMP § 506.01 makes clear that "[m]otions to strike are not favored." TBMP § 506.01. As such, a "matter will not be stricken unless it clearly has no bearing upon the issues in the case." *Id.* (emphasis added); *see also Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, at *3 (TTAB 1999) (declining to strike counterclaims supplying the necessary factual basis for applicant's claim of fraud).

The central issue in this Opposition is whether Applicant's mark FOOD DUDES is confusingly similar to the DELIVERY DUDES trademark. (1 TTABVUE ¶ 9.) In addition to proving a likelihood of confusion between these two marks, Opposer must show that it has

priority in the mark DELIVERY DUDES over Applicant's rights in FOOD DUDES. TBMP § 309.03(c) ("A plaintiff must plead (and later prove) priority of use."). Thus, Applicant's amended counterclaims alleging that neither the '367 Reg. or '834 Reg. can be used to establish priority of use is directly related to the outcome of this Opposition. If Applicant's counterclaims are proven, Opposer's claim to priority disappears. (12 TTABVUE 2, 9.) Therefore, Opposer's motion to strike should be denied.

III. Applicant's Reply Brief Responds Directly to Opposer's Response Brief as Allowed Under the Rules

Opposer's motion to strike should also be denied under TBMP § 517 because Applicant's reply brief was not merely a recitation of its original brief, but a direct response to the arguments set forth in Opposer's response brief to Applicant's motion to amend. Under TBMP § 517, it is within a movant's rights to submit a reply brief in support of its motion. TBMP § 517 ("[A] party is entitled to offer in its brief any argument it feels will be to its advantage."). Because of that right, "when . . . a reply brief on a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party that simply objects to the contents thereof." *Id.* (emphasis added); *See also Kidsart, Inc. v. Kidzart Texas, LLC*, Opp. No. 91166639, 2006 WL 2007542, at *1 (TTAB July 13, 2006) (denying motion to strike reply brief); *True Colors Int'l v. Information Transport Solutions, Inc.*, Opp. No. 91209905, 2014 WL 11032970 (TTAB Mar. 10, 2014) (denying motion to strike brief in response to motion for summary judgment). The basis for Opposer's motion to strike is merely an objection to the contents of Applicant's reply brief. (13 TTABVUE 2-3.) That is not a basis to grant Opposer's motion to strike and Opposer can cite to no cases in which a reply brief was stricken solely for its content.

In fact, the Board has declined to grant a motion to strike a reply brief where the brief responded directly to statements made in the opposing brief. *See e.g.*, *Hawaiian Moon, Inc. v. Rodney Doo*, Opp. No. 91165327, 2006 WL 1258942, at *5, n.4 (TTAB Apr. 27, 2006); *Grupo Marti, S.A. v. Marti's S.A.*, Cancellation No. 92044602, 2006 WL 896920, at *2, n.3 (TTAB Apr. 4, 2006). In *Hawaiian Moon*, the Board held that it would not strike the reply brief where the "additional evidence submitted [in the reply was] directed to the statements made by [the non-movant] in its responsive brief." 2006 WL 896920, at *5, n. 4. Ultimately, the Board ruled that it would consider the reply brief and supporting documentation when deciding on the original motion. *Id.* Similarly, Applicant's reply brief differs from its original motion and responds to Opposer's opposition brief by:

- Rebutting Opposer's claim of untimeliness. (*Compare* 11 TTABVUE 15-19 *with* 12 TTABVUE 2-4.)
- Rebutting Opposer's claimed standard of proof to amend. (*Compare* 11 TTABVUE 4-6 *with* 12 TTABVUE 4-5.)
- Rebutting Opposer's claims that Applicant's amended answer and counterclaim are "legally insufficient" and "futile" by providing additional factual evidence and legal authority to support claims of fraud, assignment-in-gross, and abandonment that by the time Veneziano applied for the '367 Reg. on March 17, 2011, he had not used the mark DELIVERY DUDES for approximately four years. (*Compare* 11 TTABVUE 5-14 *with* 12 TTABVUE 5-9.)
- Rebutting Opposer's claim that Applicant's motion should be denied with prejudice. *Compare* 11 TTABVUE 19 *with* 12 TTABVUE 10.)

Thus, the Board should decline to strike Applicant's reply brief, and instead, rely on it for the same reason articulated in *Hawaiian Moon*.

In addition to mischaracterizing the contents of the reply, Opposer asserts that the Board must first "accept" a reply. (13 TTABVUE 2). There is no authority for this assertion. Applicant timely filed a 10-page reply. Applicant's reply is properly before the Board and the

Board should consider Applicant's rebuttal of Opposer's arguments against granting Applicant's leave to amend.

Finally, Opposer's motion should be denied because it is nothing more than a surreply. The TBMP and Board opinions are clear that the Board will give "no consideration" to surreply briefs. TBMP § 517; *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 U.S.P.Q.2d 1464, at *8 (TTAB 1993). In *Levi Strauss & Co.*, the Board denied the applicant's motion to strike on the grounds that "[a]pplicant's motion to strike . . . [was] essentially an attempt to reply to opposer's reply brief." *Id.* Here, Opposer's motion to strike Applicant's reply brief rests on nothing other than criticisms of the content of the Applicant's reply. As such, Opposer's motion to strike should be denied as an impermissible surreply disguised as a motion to strike.

CONCLUSION

Applicant respectfully requests that the Board deny Opposer's motion to strike.

Dated: February 27, 2017

Respectfully submitted,

GRAY, PLANT, MOOTY, MOOTY & BENNETT, P.A.

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CERTIFICATE OF SERVICE

I hereby certify that this MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE is being emailed to the below counsel for Opposer pursuant to TBMP 502.02(a):

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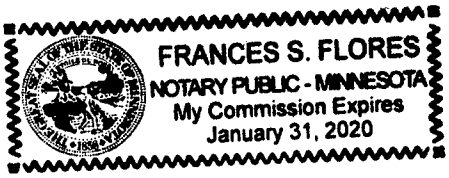
Dated: February 27, 2017

/s/ Molly R. Littman
Molly R. Littman

Subscribed and sworn to before me
this 27th day of February, 2017

s/ Frances S. Flores
NOTARY PUBLIC - MINNESOTA
My Commission Expires
January 31, 2020



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