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

Proceeding	91236715
Party	Defendant Theatricality LLC
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Submission	Motion to Strike
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Date	07/15/2018
Attachments	Applicant response to Motion to Strike opp no. 91236715 07152018.pdf(127873 bytes)

which is why the opposition procedure before the TTAB is available to all parties, not just one party, namely, Opposer. This is also why an opposition procedure should be allowed to proceed so that the parties may discover facts if need be and the Board may then determine the outcome of the case. It is up to the Board to determine the merits of a case, not a single party proceeding in its self-interest.

In Opposer's "Facts" section it failed to remind the Board that the Board had already ruled on the Affirmative Defenses included in Applicant's Answer to the Amended Complaint. The Board ruled in Applicant's favor. Opposer now terms the affirmative defenses granted in the prior ruling as "improper affirmative defenses" and that the decision allowed the "facial and fatal deficiencies of the denials and the affirmative defenses." We will leave it up to the Board on how they wish to handle those assertions by Opposer.

Opposer claims it seeks protection from "burdensome, immaterial, and prejudicial discovery and defending against meritless theories in this matter." Applicant submits that it is Opposer that set forth the claims in its Complaints and apparently now does not wish to defend them. An opposer must be ready to follow through in a matter it started. Instead, this Opposer seeks to bully, vex and annoy Applicant with yet another motion.

II. BACKGROUND

Applicant has once again set forth valid and compelling defenses in its Answer to the First Amended Complaint and Affirmative Defenses. Opposer is once again seeking to circumvent and deny Applicant its right to defend its mark and application. This is not a case of avoiding unnecessary discovery, but it is a case of a bully trying to steamroll over a defendant. The Board should also note that these motions have all been filed before the Discovery Conference has been held, Initial Disclosures shared, or the Discovery Period has even started.

"The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. See TBMP Section 309.03 and TBMP Section 311.02. Thus,

the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits.” TBMP Section 506.01.

Most of Opposer’s allegations in this case are contested by defendant. The case should move forward to the next phases and all of Applicant’s affirmative defenses in its answer to the first amended complaint should remain.

III. ARGUMENTS

Opposer once again tries to take a bite at the apple and put defendant and the Board through another round on issues in a “renewed” motion that was already decided in its prior motion. A decision was already rendered on most of these issues, for example, Applicant’s affirmative defenses. One could say these questions were “asked and answered” already – in April. The decision stated:

“Applicant’s affirmative defenses marked A-B, F-H, and K-L go to the merits of Opposer’s likelihood of confusion and/or dilution claim(s). The defendant in a Board proceeding should not argue the merits of the allegations in a complaint but rather should state as to each of the allegations contained in the complaint that the allegation is either admitted or denied. . . . Notwithstanding the foregoing, inasmuch as Applicant’s allegations give Opposer a more complete notice of its position, the Board treats Applicant’s allegations as amplifications of its denials. . . . In view thereof, Opposer’s motion to strike the affirmative defenses A-B, F-H and K-L is **denied.**” See Decision of the TTAB in Opposition No. 91236715, Robot Wars, LLC v. Theatricality LLC, dated April 11, 2018.

The definition of amplifying denials is set forth in the TBMP as follows:

“311.02(d) Other Affirmative Pleadings - Amplifying Denials

An answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant’s denial of one

or more of the allegations in the complaint. These amplifications of denials, whether referred to as "affirmative defenses," "avoidances," "affirmative pleadings," or "arguments," are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration. [Note 1.]

NOTES:

1. See *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 (TTAB 2009) (applicant's "affirmative defenses" for the most part amplified its denials of opposer's allegations regarding likelihood of confusion); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (motion to strike third affirmative defense denied because it was an amplification of a denial, giving fuller notice of the claim); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such); *Maytag Co. v. Lusk's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986) (same); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (denying motion to strike paragraph in answer which amplified applicant's denial and provided opposer with fuller notice of applicant's defense); *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959) (allegation that registered mark is weak does not constitute a collateral attack on validity of opposer's registrations). Cf. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1572 (TTAB 1988)."

In this case, Applicant had previously presented its "affirmative defenses," "avoidances," "affirmative pleadings," or "arguments," ("affirmative defenses") as affirmative defenses marked A through L in its Answer to the First Complaint ("Answer 1"). The decision on Opposer's prior motion specifically stated that Applicant's prior affirmative defenses A-B, F-H and K-L were allowed and would not be stricken. Applicant placed those same affirmative defenses in its Answer to Opposer's Amended

Complaint (“Answer 2”). For ease of reference, below is a chart showing the prior lettered affirmative defenses contained in Answer 1 and the new lettered affirmative defenses contained in Answer 2.

Answer 1 letter	Title	Answer 2 letter	Title
A	Priority	A	Priority
B	There is No Likelihood of Confusion	B	There is No likelihood of Confusion
F	Concurrent Use	C	Concurrent Use
G	Prior Registration and Concurrent Use Prove that Opposer Has Not Suffered Damage	D	Prior Registration and Concurrent Use Prove that Opposer Has Not Suffered Damage
H	Opposer Was Never Damaged by Applicant’s Prior Identical Mark and Registration	E	Opposer Was Never Damaged by Applicant’s Prior Identical Mark and Registration
K	Applicant’s Use of the Mark for Its Goods has been Continuous since 2008 and Applicant is the Senior User of the Mark for Its Goods	F	Applicant’s Use of the Mark for Its Goods has been Continuous since 2008 and Applicant is the Senior User of the Mark for Its Goods
L	Opposer’s Mark is not Well-Known or Famous and There can be No Dilution Claim	G	Opposer’s Mark is not Well-Known or Famous and There can be No Dilution Claim

Applicant admits that it copied the exact Affirmative Defenses from Answer 1 into Answer 2 because the Board had ruled in its favor and affirmed that Applicant already had a right to assert those affirmative defenses. We understand that Opposer is not happy that it failed in its attempts to bully Applicant into giving up its rights and Opposer is now trying for a “do-over” or mulligan. We don’t allow mulligans in tournaments and they should not be allowed in this matter either.

Even so, Applicant must now respond to Opposer's Issues in its attempt to deny Applicant its rights.

1. First and Sixth Affirmative Defenses (A and F) and Paragraphs 21 and 22

Applicant correctly set forth denials in paragraphs 21 and 22. That is all that Applicant is required to do at this stage. Affirmative Defenses A and F were sufficient the time before, and Applicant sets forth that they are still sufficient.

a. Applicant still contends that it has priority for its own mark for its own goods. This is apparently a bone of contention with Opposer as it feels this must be tried and investigated further. Opposer has pleaded a case with a registration that does not contain a description of Applicant's goods AND is furthermore contested as being confusingly similar. Opposer's registration is for services, not for goods, and Opposer's rights are based on the precise descriptions listed in its registration. The right to use the registration as a bludgeon has some limitations. Applicant does not contest that Opposer owns its registration, but it does contest that Opposer has prior rights for toys and it also contests that there is likelihood of confusion.

Opposer further cites to a decision in TTAB Opp. No. 91222745 that is not even Precedential or published by claiming that it is "very similar" and that the Board should follow its lead. This is presented simply because it would give Opposer an unfair advantage. The facts of that case are different, the marks are different, that case had a counterclaim and this one does not, etc. The one similarity we see is that Opposer's counsel is in the habit of routinely filing motion after motion in a case.

b. Applicant's Priority Claim Should Stand

Applicant's mark is different, is used for different goods, and Applicant should be allowed to defend its own application. Applicant used its mark "first" because Opposer hasn't used Applicant's mark as far as Applicant knows. Applicant didn't file a cancellation action under Section 14. Applicant finds Opposer's statements rather confusing and obfuscating.

c. Applicant's reliance upon Its Prior Registration should stand

Likelihood of confusion is analyzed using several different facts. Under the thirteen specified E.I. Dupont factors as set forth in In re E.I. du Pont deNemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), Applicant clearly has at least a couple of factors to be considered on its behalf. While all factors should be considered, following are some of the more relevant factors:

1. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression.
2. The similarity or dissimilarity and nature of the goods . . . described in an application or registration or in connection with which a prior mark is in use.
7. The nature and extent of any actual confusion.
8. The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion. [emphasis added.]
9. The variety of goods on which a mark is or is not used.
12. The extent of potential confusion.
13. Any other established fact probative of the effect of use.

In this case, the marks at issue peacefully co-existed since at least as early as 2008. Applicant's registration was for the identical mark it is and has been using, and the listing of goods at issue are exactly those listed in the prior registration. As of this date, there was no actual confusion between Opposer's mark and Applicant's mark. The fact that Applicant's U.S. registered trademark co-existed with Opposer's registered trademark for many years is relevant with regard to the factor of actual and/or potential confusion, is probative of the effect of use, is probative of concurrent use without confusion, and goes directly to the fact that there is no likelihood of confusion. These are important factors that must be considered in this case.

3. Affirmative Defense E Should Remain

This Affirmative Defense actually goes to the fact that Opposer did not consider Applicant's mark as confusingly similar and had no evidence of actual confusion. There was concurrent use and no consumer confusion. These factors go against a finding of likelihood of confusion. Applicant already deleted Affirmative Defenses C – Unclean Hands, D – Laches, and E – Acquiescence. Affirmative Defense E should remain standing.

a. Affirmative Defense E does not state the same thing as Acquiescence and Laches. The Board already noted this distinction. This defense goes to the merits of Opposer's likelihood of confusion and/or dilution claims, as do Affirmative Defenses in the prior Answer and in the Answer to the Amended Complaint. ". . . inasmuch as Applicant's allegations give Opposer a more complete notice of its position, the Board treats Applicant's allegations as **amplifications of its denials.** Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1223 (TTAB 1995); Harsco Corp. v. Electrical Sciences, Inc., 9 USPQ2d 1570 (TTAB 1988). See TTAB decision in opposition no. 91236715 dated April 11, 2018.

b. There is no Current Acquiescence Defense. However, because Opposer is so intent on fighting it, and doth protest so much, Applicant reserves its right to amend and add this defense, if it believes it is relevant, at a later time. Applicant also reserves its right to add more affirmative defenses if the facts of the matter in the case support such defenses.

c. There is no Current Laches Defense. Please see above.

B. Judgment on the Pleadings that Opposer has Priority should be DENIED.

Judgment on the Pleadings at this time is not appropriate. It is premature. It would not be based in truth or the facts. This is a likelihood of confusion case. Applicant was the first to use its mark for its goods. Opposer seeks to trick Applicant into admitting that Opposer has the right to use of Applicant's mark. Applicant refuses to set forth such an untruth.

Opposer sets forth generalities that are untrue. Applicant stated that it has priority over its use of its mark for its goods. Now Opposer seeks to state that Applicant said otherwise. The facts set forth by Applicant are based on its prior registration and also contained in its current application. Applicant does not believe that the marks are confusingly similar, and because of this “fact” and claim, Applicant thus has priority over its mark for toys.

CONCLUSION

Applicant requests that the Board not be persuaded by Opposer’s obfuscation of the issues and twisting of the facts. Applicant is defending its mark and its application and should be allowed to maintain its affirmative defenses and any and all other defenses allowed it under federal law, case law and the TBMP.

All of Opposer’s requests in its Renewed Motion to Strike and for Judgment on the Pleadings should be DENIED.

Dated: July 15, 2018

Respectfully submitted,

/Kathryn A. Tyler/

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CERTIFICATE OF SERVICE

STATE OF CALIFORNIA)
) ss
COUNTY OF LOS ANGELES)

I am employed in the County of Los Angeles, State of California. I am over the age of 18 years and not a party to the within action. My business address is 2062 Roaring Camp Drive, Rancho Cordova, CA 95670.

On July 15, 2018, I timely filed and served via e-mail a copy of the APPLICANT THEATRICALITY LLC's RESPONSE TO OPPOSER'S RENEWED MOTION TO STRIKE AND FOR JUDGMENT ON THE PLEADINGS

via e-mail on the following party:

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I caused the attached document to be transmitted via e-mail to the addressees as listed above.

I declare that I am a member of the California and federal bar and licensed to practice before the USPTO and the TTAB.

/Kathryn A. Tyler/
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