ESTTA Tracking number: **ESTTA913418**

Filing date: **08/03/2018**

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

Proceeding	91236715
Party	Plaintiff Robot Wars, LLC
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Date	08/03/2018
Attachments	Opp. 91236715 - Opp. Robot Wars' Reply in Supp. of Renewed Mot. to Strike Aff. Defenses and for Jmt on Pleadings 8.3.2018.pdf(151264 bytes)

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

Application Serial No.:	**87/371,308**
Mark:	**WAR BOT**
International Classes:	**16 & 28**
Applicant:	**Theatricality LLC**
Published in *Official Gazette:*	**July 18, 2017**

ROBOT WARS, LLC	:	
	:	
Opposer,	:	
	:	
v.	:	
	:	**Opposition No. 91236715**
THEATRICALITY LLC,	:	
	:	
Applicant.	:	

OPPOSER ROBOT WARS, LLC'S REPLY IN FURTHER SUPPORT OF ITS RENEWED MOTION TO STRIKE AND FOR JUDGMENT ON THE PLEADINGS

Robot Wars, LLC ("Opposer"), by and through its undersigned counsel of record, submits this reply in further support of its motion to strike certain of applicant Theatricality LLC's ("Applicant") affirmative defenses and denials and for judgment on the pleadings as to the issue of priority (Jun. 29, 2018, TTABVue 15) (the "Motion").

Applicant's Priority Defenses and Denials

In its opposition to the Motion (Jul. 15, 2018, TTABVue No. 16) (the "Opposition"), Applicant further demonstrates its failure to understand the distinction between the issues of priority and likelihood of confusion. Applicant repetitively reasserts its denials and arguments that the parties' respective marks are not confusingly similar. Opposer does not take any issue with such arguments in Applicant's Opposition and its denials and defenses asserted in its operative answer (Jun. 18, 2018, TTABVue No. 14) ("Answer"). Opposer understands and

concedes that those defenses are permissibly amplifying Applicant's denials that there is no likelihood of confusion, which is why Opposer did not seek to strike those defenses.

Notwithstanding Applicant's permissive amplifications of its likelihood of confusion denials, Applicant still confuses the doctrines of priority and likelihood of confusion by improperly trying to incorporate priority into the likelihood of confusion analysis. *See* Opposition at 3–6. It is true that both priority and likelihood of confusion are needed to successfully oppose a trademark application pursuant to Section 2(d), 15 U.S.C. § 1052(d); Lanham Act § 2(d), but it does not mean they are comingled together in the likelihood of confusion analysis – they are instead two elements of a single claim having their own separate and distinct tests that must be analyzed independently.

Applicant also confuses which direction the priority issue is pointing. Applicant states that "Opposer seeks to trick Applicant into admitting that Opposer has the right to use of [sic] Applicant's mark." Opposition at 8. Opposer is not seeking to use Applicant's mark. Opposer is seeking to preclude registration of Applicant's mark. It is as though Applicant is arguing from the position of an opposer before the Board. If Applicant were in fact the opposer here and not in the position of an applicant, Applicant's arguments with respect to priority would be proper. But Applicant is not the opposer and thus, its reversed logic in this matter is improper.

Furthering Applicant's confusion is Applicant's mischaracterization of the Board's limited ruling and its belief that it can properly assert a priority defense against a pleaded, valid registration as an amplification of its denials. Contrary to Applicant's arguments, the Board only ruled that Applicant's prior affirmative defenses asserting priority are amplifications of its denials, not the substantive legal sufficiency of the defenses and underlying denials. *See* Order (Apr. 11, 2018, TTABVue No. 11 [the "Order"]). Because the Board did not address the

substantive legal sufficiency of Applicant's priority defenses and denials in the Order, *i.e.,* that whether the priority defense itself is proper in this opposition, as opposed to being mere amplifications of improper denials, the Board must decide on this Motion whether Applicant's priority defenses (and corresponding denials) are proper, notwithstanding that they are mere amplifications.

Priority is not an issue in an opposition proceeding if a valid registration has been pleaded. *See* Motion at 5–6 (citing to the T.B.M.P. and other cases therein). Opposer has pled a valid registration in this opposition. Applicant is not entitled, as a matter of law, to assert that it has priority over Opposer in this proceeding. Any of Applicant's arguments to the contrary are meritless and inapplicable.

Even if priority were an issue in this proceeding, priority is determined by the party who first uses a mark, not who first uses a mark on specific goods. *See* Motion at 5. Opposer's registration, Applicant's application, and the parties' respective pleadings are all part of the factual record in this proceeding. Accordingly, and without more, Applicant cannot and does not set forth facts sufficient to support its claims of priority over Opposer. Applicant's statements – that it used Applicant's mark on different goods before Opposer used Opposer's mark on those goods – may be true, but are insufficient to establish any claim of priority in this case. In light of the facts in the record, and the applicable law of priority, Applicant's denials (Answer ¶¶21–22) and affirmative defenses (*id.* 4 at A, 5 at F) are patently false and legally deficient, and must be stricken as a matter of law.

Applicant's Other Defenses

To the extent Applicant's other affirmative defenses are mere amplifications of Applicant's denials that there is no likelihood of confusion, Opposer concedes that those

defenses are permissive. To the extent Applicant's other, attacked affirmative defenses go beyond and do not amplify Applicant's denials of a likelihood of confusion (such as a *Morehouse* defense, that Opposer lacks standing, and/or laches or acquiescence), those defenses should be stricken, or limited to the sole purpose of amplifying the likelihood of confusion denials.

Judgment on the Pleadings

Judgment on the Pleadings is appropriate in this matter. Applicant's statement that judgment on the pleadings is premature is incorrect. *See* Opposition at 8. Judgment on the pleadings can only be made when the pleadings are closed. T.B.M.P. § 504.01; Fed. R. Civ. P. 12(c). Here, the pleadings are closed and the issue of priority is ripe for determination.

Consistent with the arguments made in the Motion and *supra* herein, Applicant improperly relies upon its misunderstanding of priority. The plain reading of the law and the parties' respective pleadings, together with Opposer's registration and Applicant's application made of record as a matter of law, *see* 37 C.F.R. § 2.122(b)(1); 15 U.S.C. § 1115(a), Lanham Act § 15(a), or at the very minimum judicially noticeable as requested by Opposer, *see* 37 C.F.R. § 2.122(a); Fed. R. Evid. 201, make clear that Opposer has priority over Applicant in this matter.

In its Answer, Applicant admits Applicant commenced using its mark after Opposer obtained is pleaded registration. *See* Answer 2 at ¶19. Applicant also admits that "[t]his is a likelihood of confusion case." Opposition at 8. Applicant, by its own admission and argument, is conceding there is no issue of priority before the Board. Notwithstanding these concessions, Applicant persistently asserts that is has priority over Opposer and relies upon its application and prior, expired registration for its priority dates. *See* Answer 4 at A, 5 at D–F; Opposition at 3–6. Applicant's claimed priority dates set forth in the operative pleadings, and the record, are simply

not prior to Opposer's pleaded first use date and/or Opposer's pleaded, valid registration. Accordingly, the pleadings, as written, demonstrate that Opposer has priority over Applicant in this matter and that the Board must grant judgment on the pleadings to Opposer on the issue of priority.

CONCLUSION

Applicant's denials in paragraphs 21 and 22 and affirmative defenses A, D, E, and F should be stricken from Applicant's Answer, and Opposer should be granted judgment on the pleadings on the issue of priority.

Dated: Scarsdale, New York
August 3, 2018

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing documents was served on Applicant via email, addressed to Applicant's counsel of record, as follows:

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Dated: Scarsdale, New York
August 3, 2018

/s/ Eric A. Menist
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