

THIS ORDER IS NOT A  
PRECEDENT OF THE  
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

MW

October 24, 2018

Opposition No. 91236715

*Robot Wars, LLC*

*v.*

*Theatricality LLC*

**By the Trademark Trial and Appeal Board:**

This case now comes before the Board on Opposer's second combined motion to strike Applicant's affirmative defenses and motion for judgment on the pleadings as to the issue of priority. The combined motion is fully briefed.

**I. Background**

By way of background, on December 21, 2017, Opposer filed its first combined motion to strike certain of Applicant's affirmative defenses and denials and motion for judgment on the pleadings as to the issue of priority. By its motion, Opposer requested that the Board strike Applicant's denials of Opposer's allegations of priority in the answer and in Defenses A and K. Opposer also requested that the Board strike Affirmative Defense B, C, E, F, G, H, I and M.

In an order dated April 11, 2017, the Board denied Opposer's first motion to strike Affirmative Defenses A, B, F, G, H, K, and L because the defenses are merely

amplifications of Applicant's denials and serve to provide Opposer a more complete notice of Applicant's position.<sup>1</sup> The Board granted the motion to strike with respect to Affirmative Defenses C (unclean hands), D (laches), and E (acquiescence) as insufficiently pleaded. In addition, the Board granted the motion to strike with respect to Defenses I and J because allegations of abandonment are an impermissible collateral attack on Opposer's pleaded registration absent a counterclaim to cancel the registration. The Board also reviewed the notice of opposition and found that Opposer's claims of false suggestion of a connection, dilution by blurring and dilution by tarnishment were insufficiently pleaded. Accordingly, the Board *sua sponte* struck the insufficient claims and allowed Opposer time in which to file an amended pleading.<sup>2</sup> Because Opposer was allowed time to file an amended pleading, the Board found the motion for judgment on the pleadings moot.

On May 18, 2018, Opposer filed an amended notice of opposition claiming (1) likelihood of confusion; (2) false suggestion of a connection; (3) dilution by blurring; and (4) dilution by tarnishment. On June 18, 2018, Applicant filed its answer to the amended pleading denying the salient allegations (including priority) in the complaint and asserting the following "Affirmative and Equitable Defenses": (A) priority; (B) no likelihood of confusion; (C) concurrent use; (D) no damage due to prior registration and concurrent use; (E) no damage due to failure to enforce rights; and (F) no dilution due to lack of fame.

---

<sup>1</sup> See 11 TTABVUE 2-3.

<sup>2</sup> *Id.* at 6-8.

## II. Renewed Motions

By its renewed motion to strike, Opposer seeks an order striking Defenses A, D, E and F in addition to Applicant's denials of Opposer's allegations of priority in paragraphs 21 and 22 of the answer. Opposer also moves for partial judgment on the pleadings on the issue of priority. In its response to the motions, Applicant notes that Defenses A, D, E, and F in its answer to the amended notice of opposition are identical to Defenses A, G, H, and K asserted in Applicant's original answer.

Because the Board denied Opposer's first motion to strike the identical defenses and denials in the April 11, 2018 order, Opposer's renewed motion to strike is construed as a request for reconsideration of the Board's order denying the first motion to strike these defenses and denials. Opposer's assertion that because the Board did not address its arguments regarding the legal sufficiency of the defenses and denials, the Board must decide them on this motion to strike is incorrect. *See* 18 TTABVUE 4.<sup>3</sup> While the Board carefully considers all arguments made by the parties in connection with a motion, there is no requirement that the Board's order repeat or discuss all arguments, in particular, arguments that are irrelevant to the decision in the order. *Guess? IP Holder L.P. v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

Regarding Opposer's motion for judgment on the pleadings, the Board finds Opposer's motion under Fed. R. Civ. P. 12(c) solely on the nondispositive issue of

---

<sup>3</sup> The Board noted that it considered the parties' submissions but did not recount them in the order. 11 TTABVUE 1 n.1.

priority inappropriate. The purpose of a motion for judgment under Fed. R. Civ. P. 12(c) is “to provide a means for disposing of cases when the material facts are not in dispute and a judgment on the merits can be achieved by focusing on the content of the pleadings and any facts of which the court will take judicial notice.” *Scranton Times L.P. v. Wilkes-Barre Pub. Co.*, 2009 WL 3100963. \*2 (M.D. Pa. 2009) (citing Charles Alan Wright and Arthur R. Miller, 5C Federal Practice ad Procedure § 1367). Here, Opposer does not seek disposition of the case or any of the claims by its motion for *judgment* on the pleadings. Indeed, granting Opposer’s motion on the issue of priority would not dispose of the likelihood of confusion claim in this case.<sup>4</sup> Opposer merely seeks to remove Applicant’s priority defense from the action in order to “limit the permissible scope of discovery and limit the scope of the proceeding.” 15 TTABVue 3. Thus, the appropriate motion is one to strike the insufficient or implausible defense under Fed. R. Civ. P. 12(f).<sup>5</sup> Accordingly, the Board has treated Opposer’s combined motion as a single request for reconsideration of the Board’s order denying Opposer’s motion to strike Applicant’s defenses and denials under Rule 12(f). *See, e.g., Ciminelli v. Cablevision et al.*, 583 F. Supp. 158, 161 (E.D.N.Y. 1984) (motion for an order granting summary judgment dismissing affirmative defenses of

---

<sup>4</sup> *See, e.g., United States v. Real Property and Improvements Located at 2366 San Pablo Ave., Berkeley Cal.*, 2013 WL 6774082, \*1 (N.D. Cal. 2013) (“Though courts have often entertained motions for partial judgment on the pleadings with respect to a particular cause of action or affirmative defense, the Court is aware of no case in which a court has granted partial judgment on the pleadings with respect to less than a full cause of action.”).

<sup>5</sup> “If a plaintiff seeks to dispute the legal sufficiency of fewer than all of the defenses raised in defendant’s pleading, he should proceed under Rule 12(f) rather than under Rule 12(c) because the latter leads to entry of judgment.” Charles A. Wright, et al., 5C Fed. Pract. & Proc. § 1369 (3d ed. 2018).

business justification and unclean hands based on the rule providing for judgment on the pleadings [Rule 12(c)] treated as one to strike the insufficient defense under Rule 12(f).

### **III. Request for Reconsideration**

The basis for a request for reconsideration under Trademark Rule 2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. It is not to be used as a reargument of the points presented in the original motion. TBMP § 518 (June 2018).

In the April 11, 2018 order, the Board stated that motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. 11 TTABVUE 1. Rule 12(f) of the Federal Rules of Civil Procedure gives the Board discretion to decline to strike even objectionable pleadings where their inclusion would not prejudice the adverse party, but rather provide fuller notice of the basis of the defense. *See Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (applicant's affirmative defense amplifies denial of likelihood of confusion).

#### **A. Priority –Defenses A & F and Denials**

In support of its construed request for reconsideration of the Board's order denying to strike Applicant's assertion of priority in its original answer (current Defenses A and F and paragraphs 21 and 22), Opposer argues that Applicant's claim of priority is insufficient because priority is not an issue inasmuch as Opposer's priority is established by its pleaded registration. 15 TTABVUE 8. In addition, Opposer argues that the priority claims are barred by Section 14 of the Trademark Act because they

are an impermissible collateral attack on Opposer's registration. *Id.* at 8-9. Opposer further argues that Applicant's reliance on its prior expired registration is "impermissible" because the former registration "does not grant Applicant any rights and Applicant cannot rely upon it to claim any date of priority, which is still after any date claimed by Opposer." *Id.* at 10. Opposer also argues that Applicant's priority claims are "patently incorrect" because Opposer's first use and registration dates are long before Applicant's admitted first use date of 2008.

Here, Opposer's construed request for reconsideration of the issue of priority is essentially a reargument of the points presented in its original motion. *See* 7 TTABVUE 6-8. In addition, Opposer's argument that the Board did not address the legal sufficiency of the defenses is without merit. In the April 11, 2018 order, the Board found that Defenses A and K, among others, "go to the merits of Opposer's likelihood of confusion claims." 11 TTABVUE 2. Thus, the order addressed the legal sufficiency of the defenses and the Board finds no error in its earlier decision to deny Opposer's motion to strike Applicant's defenses and denials based on priority.

Opposer's continued argument that priority is not at issue in this proceeding is legally incorrect. In its amended notice of opposition, Opposer asserts use of its mark on or in connection with merchandise related to its entertainment services "such as, without limitation, clothing and drinking mugs."<sup>6</sup> Opposer alleges that it has prior rights through its date of first use, that Applicant's goods are related to "Opposer's

---

<sup>6</sup> Amended Notice of Opp. at ¶ 6, 15 TTABVUE 3.

Goods and Services,”<sup>7</sup> and that Applicant’s goods travel through the same channels of trade as “Opposer’s Goods and Services.”<sup>8</sup> Thus, while priority is not at issue with respect to Opposer’s claim of likelihood of confusion based on ownership of a pleaded registration for services in International Class 41, *see King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974), because Opposer also alleges likelihood of confusion based on common law use of its mark on goods (i.e., clothing and drinking mugs) not included in the pleaded registration, Opposer must prove priority of use with respect to those goods. *See Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1195 (TTAB 2012) (failure to prove priority at common law for goods not covered by pleaded registrations of record).<sup>9</sup>

In addition, the Board did not err in declining to strike Applicant’s assertion in Defense K of the original answer that it “has continuously used its mark for the goods listed in its prior registration and in its application since at least as early as 2008” and that such use “is prior to Opposer’s use of a different mark.”<sup>10</sup> The assertion that the parties’ marks are different and have coexisted for many years is not objectionable

---

<sup>7</sup> *Id.* at ¶ 23, 15 TTABVUE 5.

<sup>8</sup> *Id.* at ¶ 24.

<sup>9</sup> The Board notes, however, that Applicant’s argument that it has priority for its own mark for its own goods, 16 TTABVUE 7, is irrelevant to the proceeding and appears to indicate a misunderstanding of the issue. If the Board finds that there is a likelihood of confusion between Opposer’s common law mark as used in connection with Opposer’s goods and the subject application, Opposer must only prove prior use in connection with its goods. Applicant’s date of first use on toys is not relevant to the claim of likelihood of confusion with Opposer’s registration.

<sup>10</sup> Defense F in Answer to Amended Notice of Opposition, 14 TTABVUE 6.

and, as stated in the April 11 order, provides Opposer notice of the basis of Applicant's defense.<sup>11</sup> See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (in testing for likelihood of confusion, court may consider the length of time and conditions of concurrent use without evidence of actual confusion).<sup>12</sup>

Because the Board did not err in denying Opposer's first motion to strike Defenses A and K and Applicant's denials in the April 11, 2018 order, Opposer's construed request for reconsideration requesting that the Board strike the identical Defenses (A and F) and denials in the answer to the amended notice of opposition is **DENIED**.

### **B. Defenses D and E**

Defenses D and E in Applicant's answer to the amended notice of opposition are identical to Defenses G and H in Applicant's original answer. As noted above, the Board denied the motion to strike these defenses in the original answer because the allegations therein are treated as amplifications of Applicant's denials of the merits of Opposer's likelihood of confusion claims. Again, the Board finds no error in its April 11, 2018 decision to deny Opposer's first motion to strike these defenses and Opposer has not pointed to any error.

---

<sup>11</sup> The Board further notes that, contrary to Applicant's arguments, Applicant cannot rely on any prior rights in a registration that is no longer in existence. See *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969). The relevant issue under the *duPont* analysis is the nature and length of concurrent use which must be established by evidence.

<sup>12</sup> Further, even if Opposer had not pleaded a Section 2(d) claim based on common law use on goods, Opposer's argument that Applicant's claim of priority is an impermissible collateral attack on Opposer's registration would be incorrect inasmuch as Applicant denies that there is any likelihood of confusion between the marks.

Opposer's construed request for reconsideration consists of significant reargument of its first motion to strike the defenses based on lack of damage. *See* 7 TTABVue 11-12. The Board notes that actual damage need not be pleaded or proven by Opposer and Applicant should avoid arguing such irrelevant issues. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011). However, the Board finds no error in its decision in the April 11 order to construe the entirety of the allegations in the defenses, including allegations of lack of damage, as assertions of a lack of likelihood of confusion. In addition, Opposer is not prejudiced by the assertions. Again, the decision to strike matter under Fed. R. Civ. P. 12(f) is discretionary. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); *cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (reasonable latitude permitted in statement of claims).

Opposer also argues that the allegations in Defense E (formerly H) assert laches and acquiescence. The Board disagrees. The Board struck Applicant's laches and acquiescence defenses from the original answer and Applicant did not attempt to reassert the defenses by adding allegations to its answer to the amended pleading.<sup>13</sup>

In view of the foregoing, Opposer's construed request for reconsideration is **DENIED** with respect to Defenses D and E in Applicant's answer to the amended notice of opposition.

---

<sup>13</sup> In addition, other than alleging that Opposer failed to assert rights if Opposer thought it had any, Applicant does not allege any of the elements of laches or acquiescence.

#### **IV. Opposer's Amended Claims**

For purposes of efficiency and judicial economy, the Board has also reviewed the previously dismissed claims in the amended notice of opposition to determine if Opposer has pleaded legally sufficient claims upon which relief may be granted.

##### **A. False Suggestion of a Connection**

Upon careful review of the amended pleading, the Board finds that Opposer has, again, failed to plead a legally sufficient claim of false suggestion of a connection. To properly assert a ground of false suggestion of a connection under Section 2(a) of the Trademark Act, opposer must plead that (1) applicant's mark is the same or a close approximation of opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to opposer; (3) that opposer is not connected with the goods sold by applicant under the mark; and (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods, a connection with opposer would be presumed. *Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 USPQ2d 1025, 1031-32 (TTAB 2015); *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). Section 2(a) is intended to protect the unauthorized use of the persona of a person or institution which is not a trademark or trade name upon which a Section 2(d) claim can be made. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508-09 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982).

In its amended pleading, Opposer continues to assert that Applicant's mark is similar to Opposer's *trademark* (§ 34) and that Opposer's *trademark* is famous (§§ 32, 34). Opposer has failed to allege that Applicant's involved mark points uniquely and unmistakably to Opposer's persona and/or identity (not merely Opposer or its mark). Further, Opposer has failed to allege that its identity or persona (not its mark) is famous or of sufficient fame or reputation that when Applicant's mark is used on its goods, a connection with Opposer would be presumed. Moreover, Opposer has failed to allege any facts that would support an allegation that its persona is famous apart from the use of its name as a trademark or service mark. The purpose of Section 2(a) is to protect one's "identity." *Id.* Section 2(a) "is not about likelihood of confusion with trademarks." *In re Wielinski*, 49 USPQ2d 1754, 1757 (TTAB 1998). In addition, the fame of Opposer's trademark is not at issue under Section 2(a). *Id.* "A party acquires a protectable interest in a name (or its equivalent) under Section 2(a) where the name claimed to be approached points uniquely and unmistakably to that party's personality or 'persona.' A party's interest in such a name or designation does not depend for its existence on the adoption and use of a technical trademark." *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

In view of the foregoing, the claim of false suggestion of a connection is **dismissed**. Because Opposer has twice failed to plead a legally sufficient claim under Section 2(a) and because it appears Opposer is unable to allege sufficient facts to support the claim, the Board finds that allowing Opposer leave to cure the defective 2(a) claim would serve no useful purpose. Accordingly, the Section 2(a) claim is dismissed with

prejudice. *See Sun Hee Jung v. Magic Snow, LLC*, 124 USPQ2d 1041, 1044 (TTAB 2017) (Board did not grant leave to replead opposer’s Trademark Act § 2(d) claim due to futility where opposer twice failed to plead prior use); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1590-91 (TTAB 2009) (because petitioner twice failed to properly allege prior use, petitioner’s Trademark Act § 2(d) claim was dismissed with prejudice).<sup>14</sup>

### **B. Trademark Dilution**

With respect to Opposer’s amended dilution claims, the Board finds that Opposer has alleged sufficient facts in its amended notice of opposition to plead a legally sufficient claim of dilution by blurring under Trademark Act Section 43(c), 15 U.S.C. § 1125(c). However, the allegations in the amended notice of opposition are vague and insufficient to support a claim of dilution by tarnishment under this Section. Opposer alleges that “*any* faults or imperfections in Applicant’s Goods will reflect adversely on Opposer”<sup>15</sup> and that “dilution by tarnishment will *likely* occur.”<sup>16</sup> The allegations are insufficient because the claim is conditioned on whether there are any actual faults or imperfections in Applicant’s goods. The pleading does not include factual allegations about any inappropriate use of Applicant’s mark or some negative quality

---

<sup>14</sup> *See also Pure Gold v. Sytnex (U.S.A.) Inc.*, 221 USPQ 151, 154 (TTAB 1983) (“In order to prevail under Section 2(a), opposer must establish the same likelihood of confusion as is required under Section 2(d).”) *citing The Univ. of Notre Dame v. J. C. Foods Imports*, 213 USPQ 594 (TTAB 1983) *aff’d*, 217 USPQ 505 (Fed. Cir. 1983); *see also* 3 McCarthy on Trademarks and Unfair Competition § 19:76 (4<sup>th</sup> ed. 2017) (“The terminology ‘falsely suggests and connection with’ in Lanham Act § 2(a) is equivalent in effect to the words ‘to be likely ... to cause confusion’ in § 2(d).”

<sup>15</sup> Amended Notice of Opp. at ¶¶ 46 (emphasis added), 12 TTABVUE 9.

<sup>16</sup> *Id.* at ¶ 47 (emphasis added).

of Applicant's goods. *See Coach Services, Inc. v. Triumph Learning LLC*; 96 USPQ2d 1600, 1615 (TTAB 2010). The notice of opposition must be based on a viable claim, not a likely or potential threat. *See McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 USPQ 45, 47 (TTAB 1985). Because the allegations in the complaint fail to set forth sufficient facts to give Applicant fair notice or establish the elements necessary for recovery, Opposer's dilution by tarnishment claim is **dismissed** with prejudice.

The Board also notes that Opposer's Section 2(d) claim based on common law use on goods is limited to those goods specifically identified in paragraph 6 of the amended pleading, namely, clothing and mugs.<sup>17</sup> Thus, to the extent that Opposer intends to claim likelihood of confusion based on common law use of its mark on other goods, the Board finds the wording "such as, without limitation" vague and insufficient to give Applicant fair notice of basis of the claim. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice). Accordingly, the Board *sua sponte* **strikes** the wording "such as, without limitation" from paragraph 6 of the amended notice of opposition.

## V. Summary

In summary, Opposer's construed request for reconsideration of the April 11, 2018 Board order is **denied**. Opposer's claims of false suggestion of a connection and dilution by tarnishment are **dismissed** from the amended notice of opposition. In

---

<sup>17</sup> *Id.* at ¶ 6.

addition, the Board *sua sponte* **strikes** the wording “such as, without limitation” from paragraph 6 of the amended complaint.

Proceedings herein are resumed. Conferencing, discovery and trial dates are reset as follows:

Deadline for Discovery Conference	11/12/2018
Discovery Opens	11/12/2018
Initial Disclosures Due	12/12/2018
Expert Disclosures Due	4/11/2019
Discovery Closes	5/11/2019
Plaintiff's Pretrial Disclosures Due	6/25/2019
Plaintiff's 30-day Trial Period Ends	8/9/2019
Defendant's Pretrial Disclosures Due	8/24/2019
Defendant's 30-day Trial Period Ends	10/8/2019
Plaintiff's Rebuttal Disclosures Due	10/23/2019
Plaintiff's 15-day Rebuttal Period Ends	11/22/2019
Plaintiff's Opening Brief Due	1/21/2020
Defendant's Brief Due	2/20/2020
Plaintiff's Reply Brief Due	3/6/2020
Request for Oral Hearing (optional) Due	3/16/2020

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.