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

Proceeding	91246063
Party	Plaintiff Novatel Inc.
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Submission	Motion to Strike
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NovAtel Inc.	§	Opposition No.: 91246063
	§	
Opposer	§	
	§	
v.	§	
	§	
NOVARES GROUP	§	
	§	Mark: NOVARES
Applicant	§	Application No.: 79217670
	§	

OPPOSER NOVATEL INC.’S MOTION TO STRIKE

Pursuant to TBMP § 506.01, Opposer NovAtel Inc. (“NovAtel”) moves the Trademark Trial and Appeal Board (the “Board”) to strike the first Affirmative Defense pleaded in the Answer of Applicant Novares Group (“Novares”). The resolution of this motion will define and potentially narrow the issues for discovery and trial in this cancellation proceeding. In support, NovAtel states the following:

BACKGROUND

On January 9, 2019, NovAtel filed its notice of opposition (“Notice of Opposition”) against Novares’s application for the NOVARES mark (the “NOVARES mark”) in Class 009. In its Notice of Opposition, NovAtel asserts a likelihood of confusion between the NOVARES mark and NovAtel’s pre-existing and incontestable rights in its NOVATEL federal registrations. *See* Notice of Opposition, Dkt. No. 1.

On March 6, 2019, Applicant filed its answer (the “Answer”) to the Notice of Opposition in which Novares alleges four purported “Affirmative Defenses” (*see* Answer, Dkt. No. 4, p. 3). At least the first Affirmative Defense pleaded in paragraph 6 of the Answer (“First Affirmative

Defense”) is invalid in this case and should be stricken. Specifically, Novares’s First Affirmative Defense is not cognizable under the facts alleged in NovAtel’s Notice of Opposition.

ARGUMENTS

I. Novares’s First Affirmative Defense Challenging the Sufficiency of NovAtel’s Pleadings is Not a Valid Affirmative Defense.

Under Fed. R. Civ. P. 12(f), the Board may strike from a pleading any insufficient defenses or redundant, immaterial, impertinent, or scandalous matter. See TBMP § 506.01 and 506.02; *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 U.S.P.Q.2d 1313, 1314 (TTAB 1992) (insufficient affirmative defenses stricken). The Board may grant a motion to strike or, on its own initiative, strike from a pleading any insufficient defense and any matter that clearly has no bearing on the issues in the case. *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289, 1292 (TTAB 1999).

Novares’s First Affirmative Defenses asserts that NovAtel’s Notice of Opposition “failed to state a claim upon which relief can be granted.” See the Answer, Affirmative Defenses, ¶ 6. It is well-established that failure to state a claim is not a cognizable affirmative defense. *Blackhorse v. Pro Football, Inc.*, 98 U.S.P.Q.2d 1633, 1637 (TTAB 2011). In *Blackhorse*, the Board held that failure to state a claim upon which relief can be granted is not an affirmative defense.

In all events, on the face of the Notice of Opposition, NovAtel properly alleges a claim for likelihood of confusion. In order to state a claim, the facts alleged must, if proven, establish that (1) NovAtel has standing to maintain the proceeding and (2) a valid ground exists for opposing the registration. *Order of Sons of Ital. in Am. v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222 (TTAB 1995). It is well-settled that for purposes of ruling on the

defense, all well-pleaded allegations in the opposition must be accepted as true, and the notice of opposition must be construed in the light most favorable to NovAtel. *Id.*

Under this governing standard, NovAtel has pled sufficient facts to state a claim for likelihood of confusion. The allegations in the Notice of Opposition allege NovAtel's prior use of the NOVATEL mark and prior rights in the NOVATEL federal registration (Notice of Opposition, ¶ 1), and a likelihood of confusion (*Id.* at ¶ 5). TBMP § 309.03(c). These allegations, if accepted as true, establish that NovAtel has a real interest in the outcome of the proceeding — that is NovAtel has a particular interest in the outcome of the case beyond the general public (i.e., standing) — as well as viable grounds for opposing the Application. Therefore, on the face of the Notice of Opposition, NovAtel has alleged sufficient facts to both establish standing and grounds for opposing the Application based on a likelihood of confusion.

CONCLUSION

NovAtel respectfully requests that the Board strike the Applicant's First Affirmative Defense so that the issues for discovery and trial can be appropriately limited, and this proceeding may focus on the issue properly before the Board: whether the federally registered mark owned and used by NovAtel is confusingly similar to the NOVARES mark applied for by Novares.

Dated: March 27, 2019

Respectfully Submitted,

/s/ Gregory W. Carr

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CERTIFICATE OF SERVICE

I hereby declare under penalty of perjury that **on March 27, 2019** a true copy of the foregoing **OPPOSER NOVATEL INC.'S MOTION TO STRIKE** was served **via email** on **Mary Margaret L. O'Donnell** at BLUE FILAMENT LAW PLLC, 700 E Maple Road, Suite 450, Birmingham, MI 48009, attorney of record for Applicant, sent to the e-mail addresses noted below:

tmdocketing@bluefilamentlaw.com

/s/ Gregory W. Carr
Gregory W. Carr
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