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

Proceeding	91247832
Party	Defendant Lonza Ltd.
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Date	07/12/2019
Attachments	Objection to Motion to Strike.pdf(258218 bytes)

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

In the matter of Trademark Application

Serial No.: 87471939
Filed: Jun. 01, 2017
By: Lonza Ltd.
Published: Oct. 30, 2018
For the Trademark: IBEX- THE AGILE ADVANTAGE
International Class: 042

PolarityTE, Inc., Opposer, v. Lonza Ltd. Applicant	Opposition No. 91247832

APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO STRIKE MATTER FROM APPLICANT'S ANSWER

Box TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Applicant, Lonza Ltd., by and through its undersigned counsel, hereby submits the following response in opposition to Opposer's Motion to Strike Matter from Applicant's Answer. [9 TTABVUE].

I. INTRODUCTION

Opposer's Motion to Strike Matter from Applicant's Answer to the Amended Notice of Opposition should be denied. Opposer's motion, if awarded, violates settled law and would unreasonably burden and prejudice Lonza Ltd.

II. FACTUAL BACKGROUND

On 04/29/2019 Opposer filed the instant Notice of Opposition [1 TTABVUE], and the undersigned counsel entered a Notice of Appearance on 05/14/2019 [4 TTABVUE]. On 05/30/2019 Opposer filed an Amended Notice of Opposition [6 TTABVUE]. On 06/03/2019 Applicant filed an Answer to the Amended Notice of Opposition ("Answer") [8 TTABVUE]. On 06/24/2019 Opposer filed a Motion to Strike Matter from Applicant's Answer to the Amended Notice of Opposition ("Motion to Strike") on the ground that they are legally insufficient as a matter of law [9 TTABVUE].

In particular, Opposer requests under Section II.B of its Motion to Strike that portions of Applicant's statements and claims in Paragraph 3, 12, 13, 14 and 16 of the Answer should be stricken because they are allegedly non-responsive, irrelevant, improper and potentially prejudicial to Opposer. Opposer also requests under Section II.C. of its Motion to Strike that Applicant's First Affirmative Defense should be stricken on the ground that it is allegedly legally insufficient.

Applicant respectfully disagrees and will address these issues as follows.

III. ANALYSIS

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. However, matter will not be stricken unless such matter clearly has no bearing upon the issues in the case. See *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co.*, 177 USPQ 401 (TTAB 1973); 2A Moore's Federal Practice P12.21[2] (2d ed. 1985); and Wright & Miller, Federal Practice and Procedure: Civil 2d § 1380 (1990).

In the instant case, Applicant's statements in its Answer to the Notice of Opposition in Paragraphs 3, 12, 13, 14 and 16 and Applicant's First Affirmative Defense are relevant and have a bearing upon the issues in the case. Each request to be stricken will be addressed separately for Paragraphs 3, 12, 13, 14 and 16 and the First Affirmative Defense as follows:

Paragraph 3 of the Notice of Opposition and its Answer:

3. Ibex is a biomedical technology company focused on preclinical biomedical research and biomedical product development throughout the United States and the world. For the sake of simplicity, PolarityTE and Ibex are collectively referred to herein as "Opposer."

RESPONSE:

Applicant lacks knowledge or information sufficient to form a belief about the truth of the averments of this paragraph and therefore denies same. However, it appears from the website at https://www.ibexresearch.com/introduction that the IBEX services relate specifically to animal testing, a distinct subcomponent of the pharmaceutical design and development process. See **Exhibit 1** which is a true and correct printout of this website. Further, Applicant objects to the inclusion and reference of Ibex as the Opposer. Ibex is not listed as the Opposer in this proceeding, and the reference to Ibex as an Opposer is incorrect and misleading. Any subsequent reference to "Opposer" will be interpreted as PolarityTE, the actual Opposer in this proceeding.

Opposer requests that the red highlighted portion be stricken from the Answer. Applicant respectfully disagrees and considers the above red highlighted statement to be an important part of its response to the claim made in Paragraph 3 of the Notice of Opposition. In Paragraph 3, Opposer introduces a new company to the Amended Notice of Opposition which was not mentioned in the initial Notice of Opposition. In Paragraph 3, Opposer defines "Opposer" as "PolarityTE and Ibex". In its response, Applicant had to address this definition of the Opposer, and outline that the party to this opposition is PolarityTE, and not Ibex. It is a material fact to the priority claim made by PolarityTE, and certainly has a bearing upon the issues in the case. Further, Applicant had to clarify that in its responses Applicant only considered PolarityTE as the Opposer.

In addition, it is well established that if evidentiary facts are pleaded, and they aid in giving a full understanding of the complaint as a whole they need not be stricken." 2A Moore's Federal Practice, Section 12.21[2] (2nd ed. 1985). This is the case here.

If *arguendo* this statement would be considered to be objectionable, the Board, in its discretion, may still 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. See *Harsco Corp. v. Electrical Sciences Inc., supra.* Applicant's statements in its response to Paragraph 3 were intended to provide fuller notice of Applicant's defense, e.g. that PolarityTE cannot claim prior rights to the services identified in Applicant's application, and that PolarityTE therefore failed to state a proper claim.

Paragraph 12 of the Notice of Opposition and its Answer:

12. Opposer's Mark has priority through its use in commerce at least 14 years prior to Applicant's filing date of June 01, 2017.

RESPONSE:

Applicant denies the allegations of paragraph 12. In fact, Opposer's Mark was filed based on an intent-to use for a broad list of services with a later filing date than Applicant's Mark. Opposer's allegation that Opposer's Mark has been in use in commerce at least 14 years prior to Applicant's filing date of June 01, 2017 is misleading as it implies that Opposer's Mark has been in use for well over 14 years in connection with *all* of the listed services in Opposer's Application, which is clearly not true, and hereby denied.

Opposer requests that the red highlighted portion be stricken from the Answer. Applicant respectfully disagrees and considers the above red highlighted statement to be crucial to provide fuller notice of the basis for Applicant's defense. In its response, Applicant denies that Opposer's Mark has priority through its use in commerce at least 14 years prior to Applicant's filing date of June 01, 2017, and clarifies its statement by providing publicly available facts that Applicant's opposed mark has an earlier filing date than Opposer's Mark, which is based on an intent-to use.

Therefore, Applicant's statement is by no means non-responsive, irrelevant or argumentative. To the contrary, it is relevant to Applicant's defense that Opposer cannot claim priority, which is a fundamental issue in this case. It is well established that motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See FRA S.p.A. v. Surg-O-Flex of America, Inc., 194 USPQ 42, 46 (S.D.N.Y. 1976); Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc. 177 USPQ 401, 402 (TTAB 1977). Applicant's above statements fail to meet the criteria that would warrant the statement to be stricken.

Paragraph 13 of the Notice of Opposition and its Answer:

13. Applicant's services are substantially related to Opposer's services, if not near identical to Opposer's services. Applicant markets itself as a contract development and manufacturing organization ("CDMO"). CDMOs offer a wide variety of services to companies in the pharmaceutical, medical device, and biotech industries (collectively "BioPharma"), from preclinical development, testing, and production all the way through commercial

production. *See* Ex. 1 for further information on CDMOs *(available at* https://bioprocessintl.com/manufacturing/manufacturing-contract-services/from-cmo-to-cdmo-opportunities-for-specializing-and-innovation/). In addition, Applicant also offers many services that are traditionally offered by contract research organizations ("CROs"). This is a growing trend in the BioPharma outsourcing market, as is evidenced by third party analysts. "Many CDMOs, such as Patheon, Lonza and Catalent, are aiming to extend their service offerings to areas adjacent to their core capabilities." *See* Ex. 2 at 11 *(available at* https://www.ey.com/Publication/vwLUAssets/ey-study-opportunities-in-the-consolidating-cdmo-industry/$File/ey-study-opportunities-in-the-consolidating-cdmo-industry.pdf). *See also* Ex. 3 *(available at* https://www.outsourcing-pharma.com/Article/2012/07/05/Join-CDMOs-and-CROs-to-drive-clinicalresearch-Quotient).

RESPONSE:

Applicant objects to this allegation as unclear because "Opposer's services" are not defined. To the extent that this allegation is intelligible, Applicant denies the averments in paragraph 13.

Opposer requests that the red highlighted portion be stricken from the Answer. Applicant respectfully disagrees and considers the above red highlighted statement to be relevant because parts of Opposer's claim are unclear and cannot be fully considered and answered unless Opposer includes a definition of "Opposer's services". Further, Applicant respectfully submits that Opposer has deliberately presented a vague definition of its services because those services for which it may claim priority are distinct from those provided by Applicant, in contrast to the broader services recited in Opposer's junior application.

Paragraph 14 of the Notice of Opposition and its Answer:

14. Ibex is a contract research organization ("CRO") specifically offering preclinical research services ranging from single-dose pharmacokinetic studies to complex projects requiring surgical instrumentation, as well as assistance in study design and protocol preparation. *See* Ex. 4 *(available at* https://www.ibexresearch.com/services), BioPharma companies contract with Ibex to perform various research functions in connection with development of therapeutics.

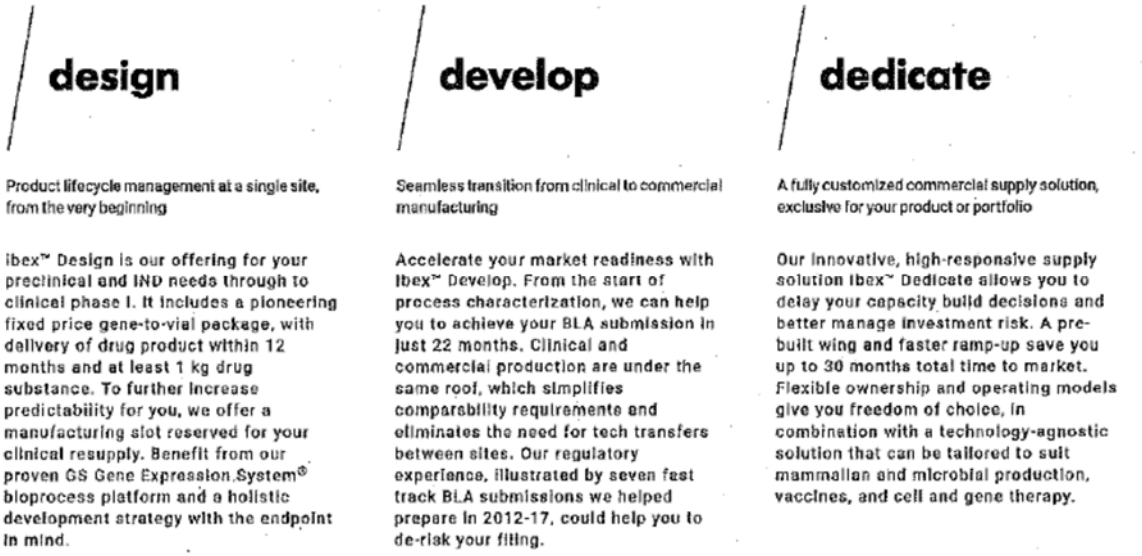
RESPONSE:

Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations of this paragraph and therefore denies same. Further, Applicant states that Ibex is not the Opposer in this proceeding and any information about Ibex is irrelevant.

Opposer requests that the red highlighted portion be stricken from the Answer. Applicant respectfully disagrees and considers the above red highlighted statement to be an important clarification that Ibex is not the Opposer, which provides information about Applicant's defense and has a bearing on the case.

Paragraph 16 of the Notice of Opposition and its Answer:

16. Applicant's own website demonstrates that research and development of biomedical products, specifically including preclinical activities, are offered alongside and in addition to design and development services for bio



/ design

Product lifecycle management at a single site, from the very beginning

ibex™ Design is our offering for your preclinical and IND needs through to clinical phase I. It includes a pioneering fixed price gene-to-vial package, with delivery of drug product within 12 months and at least 1 kg drug substance. To further increase predictability for you, we offer a manufacturing slot reserved for your clinical resupply. Benefit from our proven GS Gene Expression System® bioprocess platform and a holistic development strategy with the endpoint in mind.

/ develop

Seamless transition from clinical to commercial manufacturing

Accelerate your market readiness with ibex™ Develop. From the start of process characterization, we can help you to achieve your BLA submission in just 22 months. Clinical and commercial production are under the same roof, which simplifies comparability requirements and eliminates the need for tech transfers between sites. Our regulatory experience, illustrated by seven fast track BLA submissions we helped prepare in 2012-17, could help you to de-risk your filing.

/ dedicate

A fully customized commercial supply solution, exclusive for your product or portfolio

Our innovative, high-responsive supply solution ibex™ Dedicate allows you to delay your capacity build decisions and better manage investment risk. A pre-built wing and faster ramp-up save you up to 30 months total time to market. Flexible ownership and operating models give you freedom of choice, in combination with a technology-agnostic solution that can be tailored to suit mammalian and microbial production, vaccines, and cell and gene therapy.

RESPONSE:

To the extent that this allegation is intelligible, among other things "preclinical activities" is so broad in the context of this industry as to be meaningless, Applicant denies the averments in paragraph 16.

Opposer requests that the red highlighted portion be stricken from the Answer. Applicant respectfully disagrees, and considers the above red highlighted statement to be an important clarification to its denial by explaining that the term "preclinical activities" is too broad to be meaningful in a likelihood of confusion analysis.

First Affirmative Defense of the Answer to the Amended Notice of Opposition

First Affirmative Defense

As the First Affirmative Defense to the Notice of Opposition, Applicant alleges that the Notice of Opposition does not state facts sufficient to constitute grounds for opposition against the registration of the mark IBEX- THE AGILE ADVANTAGE for its covered services, e.g. "*Design and development services for the creation of bioprocessing and biomanufacturing facilities for the life sciences industry*." Applicant understands that PolarityTE filed an application for the mark IBEX on May 14, 2018 covering "*Research and development of new biomedical products, namely, research and development in the field of biomedical and biotechnology research; biomedical research services; biotechnology research; scientific research for medical purposes in the field of pre-clinical research; providing assistance in pre-clinical study design and clinical trial preparation*" in International Class 42 based on an intent-to-use. Applicant has priority over this application. PolarityTE then claims to have prior rights based on use of the mark. However, PolarityTE fails to state for which services PolarityTE has prior use in connection with the mark.

Opposer requests that the first affirmative defense in its entirety be stricken on the ground that it is legally insufficient. Applicant respectfully disagrees. 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. 6. 5C C. WRIGHT & A. MILLER, FEDERAL PRACTICE AND PROCEDURE CIVIL § 1381 (3d ed. 2018). In the instant case, Opposer, PolarityTE, defined Opposer's Mark in its Amended Notice of Opposition as the application filed under Serial No. 87/919,745 which was filed based on an intent to use and has a later filing date than Applicant's opposed application. Therefore, Opposer cannot claim priority based on Opposer's Mark.

PolarityTE further is unclear in its Notice of Opposition if a party to the instant opposition can claim prior use of the mark IBEX. In its Paragraph 3 of the Notice of Opposition, PolarityTE states that "PolarityTE and Ibex are collectively referred to herein as "Opposer"" which requires further clarification to determine if PolarityTE can in fact claim priority.

In view of the above, Applicant respectfully requests that the Board not strike portions of Applicant's Answer and Affirmative Defenses, and denies the Motion to Strike in its entirety.

Respectfully submitted,

By____/Tanja Proehl/_____

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CERTIFICATE OF SERVICE

I hereby certify that true and complete copy of the foregoing APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO STRIKE MATTER FROM APPLICANT'S ANSWER was served upon Applicant' counsel of record, via email, to the following address of record:

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Respectfully submitted,

Dated: July 12, 2019
Chicago, Illinois

/Tanja Proehl/
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