

ESTTA Tracking number: **ESTTA1063891**

Filing date: **06/24/2020**

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

Proceeding	91254899
Party	Plaintiff Total Safety U.S., Inc.
Correspondence Address	JOHN M CONE FERGUSON BRASWELL FRASER KUBASTA PC 2500 DALLAS PARKWAY, SUITE 600 PLANO, TX 75093 UNITED STATES jmcdoCKET@fbfk.law, jcone@fbfk.law 972-826-4436
Submission	Reply in Support of Motion
Filer's Name	John M. Cone
Filer's email	jcone@fbfk.law, jmcdoCKET@fbfk.law
Signature	/s/ John M. Cone
Date	06/24/2020
Attachments	200624 Reply supporting Motion to Strike.pdf(156460 bytes)

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

In the Matter of Application Serial No. 88/361770 DNA of Safety

<hr/> TOTAL SAFETY U.S., INC.,	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91254899
	§	
K.A. SCHMERSAL HOLDING	§	
GMBH & CO. KG,	§	
<hr/> Applicant.	§	

TO THE HONORABLE TRADEMARK TRIAL AND APPEAL BOARD

**OPPOSER’S REPLY BRIEF IN SUPPORT OF ITS MOTION UNDER FED. R. CIV. P.
12 TO STRIKE OR TO REQUIRE AMENDMENT OF AFFIRMATIVE DEFENSES**

Opposer, Total Safety U.S., Inc. (“Total Safety”), files this reply to Applicant’s Opposition (7 TTABVUE) to the Motion to Strike Applicant’s Affirmative Defenses (5 TTABVUE).

Opposer’s Motion asks the Board to cancel the two affirmative defenses in Applicant’s Answer because they contain no factual allegations and fail to meet current requirements for the degree of disclosure required in pleadings.

The affirmative defenses in question read as follows:

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim)

The Notice of Opposition, and each claim alleged therein, fails to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

(No Likelihood of Confusion)

The Notice of Opposition, and each claim alleged therein, is barred by the absence of likelihood of confusion.

As to the First Affirmative Defense, Applicant now discloses that its claim that the Notice fails to state a claim is a challenge to Opposer's pleading of standing. However, the First Affirmative Defense as pleaded makes no mention of this. Opposer is entitled to notice that this, and not some other possible deficiency is the basis of the defense and the First Affirmative Defense is therefore insufficiently pleaded.

As to the merits of this defense, the Notice of Opposition expressly identifies earlier trademark registrations owned by the Opponent and alleges that Applicant's use of the mark applied for in connection with the goods and services of the application will be likely to cause confusion. This pleading is sufficient to allege facts showing that Opposer has a "real interest" in the proceedings and a "reasonable" basis for its belief of damage. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 111USPQ2d 1058,1062 (Fed. Cir. 2014); *John W. Carson Found. V. Toilets.com, Inc.*, 94 USPQ2d 1942,1945 (TTAB 2010). Ownership of the trademarks relied on in a 2(d) claim that the mark applied for is likely to cause confusion with those trademarks is sufficient to establish standing.

Applicant ignores the facts pleaded in sections 2 through 9 of the Notice and contends that a clerical error in section 11 of the Notice (in which the Opposer is incorrectly referred to as "Gruma") somehow results in the Notice failing to plead standing. Again, this contention is not mentioned in the First Affirmative Defense

Amended and appears to be an attack on the sufficiency of the Notice, not an argument supporting the sufficiency of the pleading of the First Affirmative Defense.

Applicant admits that the so called Second Affirmative Defense is not an affirmative defense, but merely a denial of Opposer's allegation of likelihood of confusion.

Opposer respectfully requests that its Motion be granted and that the Affirmative Defenses be struck as insufficiently pleaded.

Dated: June 24, 2020

Respectfully submitted,

/s/ John M. Cone

John M. Cone

Ferguson Braswell Fraser Kubasta PC

2500 Dallas Parkway, Suite 600

Plano, Texas 75093

(972) 826-4436 Telephone

(972) 378-9115 Facsimile

jccone@fbfk.law

ATTORNEY FOR OPPOSER

TOTAL SAFETY CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing document has been served on Applicant by forwarding said copy on June 24, 2020 via email to:

Marlene J. Williams

mwilliams@nixonpeabody.com

sftrademarks@nixonpeabody.com

Attorney for Applicant K.A. Schmearsal Holding GmbH & Co. KG

/s/ John M. Cone

John M. Cone