UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Baxley

December 15, 2020

Opposition No. 91263623

Marvel Characters, Inc.

v.

John Mills, LLC

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of Applicant's motion (filed August 21, 2020) to strike paragraphs 1-3 from the notice of opposition, 6 TTABVUE. The motion has been fully briefed.

Applicant seeks to register the mark NUFFSAID in standard characters for "Wearable garments and clothing, namely, shirts" in International Class 25.[1] Opposer opposes registration of Applicant's mark, alleging likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its previously used mark NUFF SAID, which it contends began as a catchphrase, for comic books, shirts, sweatshirts, bags and mugs.

In the paragraphs at issue, Opposer alleges as follows.

> 1. Opposer, by and through its predecessors-in-interest, related companies, and licensees (collectively, "Marvel" or "Opposer"), is one of

[1] Application Serial No. 87857951, filed March 30, 2018, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and reciting January 2016 as the date of first use anywhere and February 2016 as the date of first use in commerce.

> the world's leading entertainment companies, with a library of more than 8,000 characters featured in numerous entertainment franchises and properties and in a variety of media for more than seventy years.
>
> 2. In addition to Marvel's own commercialization of its entertainment franchises and properties, Marvel has for many years engaged in a vast licensing program under which it licenses others to use its trademarks, including names, images, and catchphrases, in connection with a wide variety of products and services including, but not limited to, entertainment services, television programs, motion picture films, apparel, footwear, toys, dolls, food, theme parks and attractions, online games, computer games, video games, music, and mobile applications.
>
> 3. There are many popular catchphrase trademarks associated with Marvel and/or the Marvel universe of entertainment franchises and properties associated with Marvel, including "With great power comes great responsibility" from the Spider-Man franchise, "It's clobberin' time!" from the Fantastic Four franchise, and "Hulk smash!" from the Hulk franchise, just to name a few.

1 TTABVUE 3-4.

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted; a plaintiff is allowed "reasonable latitude in its statement of its claims." *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01 (2020).

Motions to strike are not favored, and matter usually will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). Thus, the Board, in its discretion, may 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*., 9 USPQ2d at 1571.

Applicant seeks to strike these paragraphs on the grounds that they are immaterial and prejudicial. The Board, however, finds that the paragraphs at issue set forth background information which has a bearing upon the nature of Opposer's business, which relates to its interest in this proceeding and belief of damage, and therefore to its entitlement to a statutory cause of action.[2] Those paragraphs also allege relevant information regarding Opposer's identity and how Opposer uses, or authorizes use of, its marks in commerce.[3] Opposer is not relying upon any registration in support of its claim and therefore must establish prior use of its pleaded mark by evidence. *See* Trademark Act Section 2(d); *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). As such, the paragraphs at issue help provide a fuller statement of the basis for Opposer's Section 2(d) claim.

[2] Board decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063 and 1064, in terms of "standing." Mindful of the Supreme Court's direction in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), the Board now refers to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable. That is, to establish entitlement to a statutory cause of action under Trademark Act Sections 13 or 14, 15 U.S.C. §§ 1063 or 1064, a plaintiff must demonstrate a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020).

[3] Opposer is not relying upon any registration in support of its claim and therefore must establish prior use of its pleaded mark by evidence. *See* Trademark Act Section 2(d); *Hydro-Dynamics Inc. v. George Putnam & Co. Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

In addition, the Board is not persuaded that the allegations in the paragraphs at issue are prejudicial.[4] Applicant's implication that the paragraphs may lead to unwanted inferences, 6 TTABVUE 3, is not well-taken. The Board routinely decides cases from entities alleging to be highly successful. Notwithstanding such allegations, the Board decides each case on its own merits based on an evaluation of the **evidence** of record.[5] *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 152 (CCPA 1978). Whether Opposer can prevail herein is a matter for resolution after introduction of evidence. *See Prosper Bus. Dev. Corp. v. Int'l Bus. Machs., Corp*., 113 USPQ2d 1148, 1152 (TTAB 2014). Bearing in mind that the Board allows reasonable latitude in the stating of claims, Applicant's motion to strike is denied.

Proceedings are resumed with the parties placed where they stood when the motion to strike was filed. Applicant's answer, 7 TTABVUE, is accepted. Dates are reset as follows.

Deadline for Discovery Conference	1/14/2021
Discovery Opens	1/14/2021
Initial Disclosures Due	2/13/2021
Expert Disclosures Due	6/13/2021
Discovery Closes	7/13/2021
Plaintiff's Pretrial Disclosures Due	8/27/2021

[4] Applicant's assertion that "Opposer seems to be implying that because it is a 'leading entertainment company' with more than '8,000 characters' it must be right," 6 TTABVUE 5, is not well-taken.

[5] Applicant can take discovery proportional to the needs of the case regarding allegations in the notice of opposition. *See* Fed. R. Civ. P. 26(b)(1); Trademark Rule 2.120(a)(1); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 181 USPQ 286, 287 (TTAB 1974); TBMP § 402.01 (2020).

Plaintiff's 30-day Trial Period Ends	10/11/2021
Defendant's Pretrial Disclosures Due	10/26/2021
Defendant's 30-day Trial Period Ends	12/10/2021
Plaintiff's Rebuttal Disclosures Due	12/25/2021
Plaintiff's 15-day Rebuttal Period Ends	1/24/2022
Plaintiff's Opening Brief Due	3/25/2022
Defendant's Brief Due	4/24/2022
Plaintiff's Reply Brief Due	5/9/2022
Request for Oral Hearing (optional) Due	5/19/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).