

ESTTA Tracking number: **ESTTA1122846**

Filing date: **03/25/2021**

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

Proceeding	91265455
Party	Defendant James Michael Morris
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Attachments	Response MTS.pdf(126942 bytes)

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

In Re Application No. 88829427
Filed: March 11, 2020
Mark: FIRST CHOICE APPLIANCE REPAIR
Published in the Official Gazette: August 18, 2020

FIRST CHOICE APPLIANCE, LLC,)
)
 Opposer,)
)
v.)
)
JAMES MICHAEL MORRIS)
)
 Applicant.)

OPPOSITION NO. 91265455

**APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO STRIKE APPLICANT’S
AFFIRMATIVE DEFENSES**

Applicant, James Michael Morris (“Applicant”) files this response in opposition to Opposer’s Motion to Strike Applicant’s Affirmative Defenses. For the reasons set forth herein, Applicant requests that Opposer’s motion be denied relative to the non-withdrawn affirmative defenses.

I. Withdrawn Affirmative Defenses

To expedite the proceedings, Applicant hereby withdraws his first, second, third, fourth seventh and eighth Affirmative Defenses as set forth in his filed Answer.

II. Legal Standard

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. Fed. R. Civ. P. 12(f); TBMP § 506.01. 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. *Ohio State University v. Ohio*

University, 51 USPQ2d 1289, 1292 (TTAB 1999). The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (emphasis added). “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.” TBMP § 506.01.

“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.” *Id.* Furthermore, an “answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant’s denial of one or more of the allegations in the complaint.” TBMP § 311.02(d). Such “amplifications” are permitted because “they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.” *Id.*

III. Applicant’s Fifth Affirmative Defense is Appropriate

As noted in the Board’s Order of December 23, 2020, Applicant’s fifth affirmative defense is appropriate as an “amplification” of Applicant’s denial of one or more of the allegations set forth in Opposer’s opposition as permissible under TBMP § 311.02(d). Opposer’s argument that intent is not relevant to a determination of likelihood of confusion is misplaced. If the junior user adopted the mark in bad faith, confusion is more likely. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961.)

Accordingly, Applicant’s fifth affirmative defense is appropriate because it raises factual issues that should be determined on the merits.

IV. Applicant’s Sixth Affirmative Defense is Appropriate

As noted in the Board’s Order of December 23, 2020, Applicant’s sixth affirmative defense is appropriate as an “amplification” of Applicant’s denial of one or more of the allegations set forth in Opposer’s opposition as permissible under TBMP § 311.02(d). Again, Opposer’s argument that the subject marks are virtually identical is misplaced. The sixth affirmative defense relates to the strength of the Opposer’s mark not that of the applicant’s mark. The stronger or more distinctive the senior user’s mark, the more likely the confusion. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961).)

V. Conclusion

For the reasons set forth herein, Opposer’s Motion to Strike Applicant’s Affirmative Defenses should be denied relative to Applicant’s fifth and sixth affirmative defenses. Applicant’s fifth and sixth affirmative defenses amplify Applicant’s denials of Opposer’s claims. Furthermore, Applicant’s fifth and sixth affirmative defenses raise factual issues which should be determined on the merits.

March 25, 2021

Respectfully Submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on the 25th day of March 2021, a true and correct copy of the **APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** was served electronically as follows:

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