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

January 31, 2024

Opposition No. 91267937

Alpha Kappa Alpha Sorority

v.

Stroll to the Polls, Inc.

Before Zervas, Goodman and Allard,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Applicant's motions (both filed October 8, 2023) for leave to file an amended answer and for summary judgment on the ground of priority. 61-64 TTABVUE. The motions have been fully briefed.

Background

Applicant seeks to register the standard character mark STROLL TO THE POLLS for "Aprons; Bibs, not of paper; Bodysuits; Dresses; Footwear; Hats; Jackets and socks; Pants; Shirts; Skirts; Swimwear" in International Class 25.[1] In the original notice of opposition, Opposer seeks refusal of registration of Applicant's mark on the

[1] Application Serial No. 90012428, filed June 20, 2020, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging 2018 as the date of first use anywhere and of first use in commerce. The application was filed by Ramona Prioleau and was assigned to Applicant by way of a document that was filed with the USPTO's Assignment Division on December 12, 2020 at Reel/Frame 7176/0268.

grounds of (1) likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its prior use of the mark STROLL TO THE POLLS in connection with its voter engagement and registration efforts; (2) fraud on the USPTO based on Ms. Prioleau's alleged prior knowledge of "Opposer's prior use of and common law rights in and to the mark STROLL TO THE POLLS;" and (3) failure to function as a mark under Trademark Act Sections 1, 2 and 45, 15 U.S.C. §§ 1051, 1052 and 1127, because (a) it is "an informational political message that is not capable of indicating source" and (b) it is merely ornamental. 1 TTABVUE. In a July 16, 2021 order, the Board granted Applicant's (filed April 10, 2021, 4 TTABVUE) motion to dismiss Opposer's fraud claim for failure to state a claim, but otherwise denied that motion. 8 TTABVUE. In an answer to the original notice of opposition, Applicant denied the salient allegations of the notice of opposition and asserted affirmative defenses. 14 TTABVUE.

On March 28, 2022, Opposer filed an amended notice of opposition in which the sole pleaded claim is failure to function as a mark "because it provides an information[al] political message that is not capable of indicating source … [and,] as applied to the apparel products, also is merely ornamental." 23 TTABVUE 4. Applicant, in an answer, denied the salient allegations of the amended notice of opposition and asserted affirmative defenses. 26 TTABVUE.

Motion for summary judgment denied

The Board turns first to the motion for summary judgment. Applicant contends that there is no genuine dispute of material fact as to Applicant's priority of use on

goods in International Class 25 and that it is therefore entitled to entry of judgment as a matter of law. 63 TTABVUE 2. However, a plaintiff alleging failure to function as a mark need not plead or establish priority as an element of that claim. Opposer need only show that it is in a position to use the term at issue in an informational or ornamental manner to establish its entitlement to a cause of action (formerly known as standing) and that actual or prospective purchasers would view the involved alleged mark merely as merely informational or ornamental matter.[2] *See Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1658 (TTAB 2014); *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010); *In re Aerospace Optics, Inc.,* 78 USPQ2d 1861, 1862 (TTAB 2006). The motion for summary judgment is therefore denied.

Motion for leave to file an amended answer denied, defenses stricken

At this stage of the proceeding, Applicant may amend its answer only by written consent of Opposer or by leave of the Board; leave must be freely given when justice so requires. *See* Fed. R. Civ. P. 15(a); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.02 (2023). As a general policy, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *See* TBMP § 507.02. However, where the movant seeks to

[2] Even if we assume that Opposer did not directly sell items depicted in documents AKA0000789-806 (63 TTABVUE 304-21, 64 TTABVUE 283-300), as Applicant argues in its brief, we note that Opposer may rely on use of the mark by a related company that inures to its benefit in support of its claim herein. *See* Trademark Act Section 55, 15 U.S.C. § 1055.

add a new claim or defense that is insufficiently pleaded or would serve no useful purpose, the Board normally will deny the motion for leave to amend. *See id.*

In its original answer to the amended petition to cancel, Applicant set forth defenses of laches, acquiescence, unclean hands, judicial estoppel and "lack of standing." 26 TTABVUE 7. None of these defenses are sufficiently pleaded because Applicant failed to allege any facts that provide fair notice of the basis for any of them, and for additional reasons set forth below. *See Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987); TBMP §§ 311.02(b) and 506.01. Applicant also attempts to reserve the right to add defenses. This paragraph is improper because it does not give Opposer fair notice of such defenses.[3] *See Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, *4 n.6 (TTAB 2021). By its motion, Applicant seeks to amplify its previously pleaded defenses and add defenses that the opposition is barred by the doctrine of ultra vires and that Opposer does not have a bona fide intent to use the mark on goods in International Class 25. However, these defenses are also insufficient.

The affirmative defenses in the proposed amended answer begin in paragraphs 15-18 with Applicant's repleading of its defenses of waiver, estoppel, laches and acquiescence, now based on Opposer's alleged failure to assert its right against Applicant prior to the commencement of this proceeding.[4] 61 TTABVUE 18. The

[3] Rather, pleadings must be amended in accordance with Fed. R. Civ. P. 15. *See* TBMP § 507.
[4] A waiver defense is based on an assertion of "an intentional relinquishment or abandonment of a known right or privilege." *Johnson v. Zerbst*, 304 U.S. 458, 464 (1938). An equitable estoppel defense is based on assertions of (1) misleading conduct, which may include not only statements and action but silence and inaction, that leads another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this

defenses of laches and acquiescence are generally not available in opposition proceedings because time to act against an application runs from the date on which the applied-for mark is published for opposition, in this case, from November 3, 2020, and not from when Opposer first became aware of Applicant's alleged use of the alleged mark. *See Nat'l Cable Television Ass'n, Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007). Opposer timely filed its notice of opposition 120 days later on March 2, 2021. Applicant has not alleged that Opposer made any representations that it would not oppose the registration that Applicant seeks or that Applicant already owns a registration for substantially the same mark for substantially the same goods. *See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969). Applicant has otherwise alleged no conduct that would give rise to any of these defenses. *See Lincoln Logs Ltd.,* 23 USPQ2d at 1703; *Midwest Plastic Fabricators*, 5 USPQ2d at 1069. Accordingly, these defenses are insufficient.

In paragraph 19 of the proposed amended answer, Applicant alleges that the opposition is barred in whole or in part by the doctrine of unclean hands. "To the

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reliance, material prejudice if the delayed assertion of such rights is permitted. *See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). A laches defense is based on assertions of: (1) unreasonable delay in asserting one's rights against another; and (2) material prejudice to the latter attributable to that delay. *See id.* An acquiescence defense is based on assertions of (1) a plaintiff's affirmative representation that it would not assert a right or a claim; (2) inexcusable delay between that representation and assertion of the right or claim; and (3) undue prejudice resulting from the delay. *See Coach House Rest. Inc. v. Coach and Six Rests., Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991).

extent Opposer has delayed to asserts [sic] its alleged rights to [the involved mark], Opposer has failed to assert its purported rights to [the involved mark] against third parties to this proceeding." 61 TTABVUE 18. A defense of unclean hands must be supported by specific allegations of misconduct by a plaintiff related to its claim that, if proven, would prevent the plaintiff from prevailing on its claim. *See Midwest Plastic Fabricators*, 5 USPQ2d at 1069; *Tony Lama Co. v. Di Stefano*, 206 USPQ 176, 179 (TTAB 1980). In addition, Applicant merely alleges failure to act against third parties and does not allege any conduct by Opposer that could be found egregiousness or unconscionable, as is necessary for the Board to find unclean hands. *See Patsy's Italian Rest., Inc. v. Banas*, 575 F. Supp. 2d 427, 461 (E.D.N.Y. 2008), *aff"d*, 658 F.3d 254, 100 USPQ2d 1001 (2d Cir. 2011) ("[C]ourts typically only bar recovery under a theory of unclean hands when a plaintiff's conduct was 'egregious,' ... or 'clear, unequivocal and convincing.'").

In any event, this proceeding is between Opposer and Applicant and not between Opposer and any third party who may be using the term STROLL TO THE POLLS, as an alleged mark or as an informational phrase. Opposer need only establish its claim with regard to Applicant. *See BAF Indus. v. Pro-Specialties, Inc.*, 206 USPQ 166, 174 (TTAB 1980). Further, Opposer is not asserting proprietary rights in the term STROLL TO THE POLLS and instead asserts that it uses the term "in an effort to get people to the polls to vote" and that other members of the Divine Nine, a group of African-American fraternities and sororities, "have used the [term STROLL TO

THE POLLS] in connection with voter engagement and registration."[5] 23 TTABVUE 3. Accordingly, this defense is insufficient.

In paragraph 20 of the proposed amended answer, Applicant alleges judicial estoppel, asserting that, "[i]n prior proceedings in federal courts of the United States, Opposer has relied on court interpretations that uphold its actions when Opposer follows its constitution and by-laws. … Yet in the instant proceeding, Opposer asserts that Opposer's constitution[] and by-laws are not relevant." 61 TTABVUE 19. "[J]udicial estoppel [i]s an equitable principle that holds a party to a position on which it prevailed, as against later litigation arising from the same facts."[6] *Boston Chicken Inc. v. Boston Pizza Int'l Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999) (citing *Data General Corp. v. GSA*, 78 F.3d 1556, 1565 (Fed. Cir. 1996). The only case that Applicant mentions in pleading this defense is *Jolevare v. Alpha Kappa Sorority, Inc*., Case No 1:05-cv-01982, filed in the United States District Court for the District of Columbia. That case arises from entirely different facts from this proceeding and thus does not provide a basis for a judicial estoppel defense.[7] Because Applicant has

[5] We take judicial notice of the following dictionary definition of "proprietary:" "one that possesses, owns, or holds exclusive right to something." https://www.merriam-webster.com/dictionary/proprietary (accessed on January 25, 2024). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

[6] In determining whether judicial estoppel will lie the Board considers the following factors: (1) judicial acceptance of the previously asserted inconsistent position; (2) risk of inconsistent results; (3) effect of the pleading party's actions on the integrity of the judicial process; (4) perception that the tribunal has been misled; (5) reliance by the opposing party; and (6) prejudice to the opposing party's case as a result of the inconsistent position. *See Boston Chicken Inc.*, 53 USPQ2d at 1055.

[7] The papers from *Joulvare* that Applicant submitted, 62 TTABVUE 358-411, indicate that that case arose out of a violation of Opposer's anti-hazing guidelines.

otherwise failed to set forth a factual basis for this defense, the judicial estoppel defense is insufficient.

In paragraph 21 of the proposed amended answer, Applicant asserts Opposer's "lack of standing or entitlement" to a cause of action. 61 TTABVUE 19. Lack of entitlement to a cause of action, formerly known as "standing," is not an affirmative defense; rather, Opposer must plead and later establish its entitlement to a cause of action as an essential element of its case. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 188 (CCPA 1982). Accordingly, this defense serves no useful purpose.

In paragraph 22 of the proposed amended answer, Applicant asserts that the opposition is barred by the doctrine of ultra vires. 61 TTABVUE 19. An action is ultra vires when it is "beyond the scope or in excess of legal power or authority." https://www.merriam-webster.com/dictionary/ultra%20vires. In the only mention of the term in a precedential Board decision available in online databases, the Board stated in 1976 that "there is a serious question as to the Board's jurisdiction to determine whether a particular act of a corporation is ultra vires in nature." *State Hist. Soc. of Wis. v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25, 29 (TTAB 1976). In any event, because Applicant has not cited to any specific provision in Opposer's corporate by-laws, 62 TTABVUE 376-411, or other organizational documents that provide a factual basis for a defense that Opposer's bringing the above-captioned opposition proceeding is ultra vires, Applicant has failed to plead a legally sufficient ultra vires defense.

In paragraph 23 of the amended answer, Applicant asserts that the opposition is barred because Opposer lacks a bona fide intent to use or lack of use in commerce the alleged mark of STROLL TO THE POLLS for any goods in International Class 25. 61 TTABVUE 19-21. However, Opposer does not allege and need not establish use or a bona fide intent to use the involved mark on goods in International Class 25 to prevail herein. Opposer need only show that it is in a position to use the term at issue in an informational or ornamental manner to establish its entitlement to a cause of action *See Nature's Way Prods. Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077, 2080 (TTAB 1989) (entitlement established where petitioner "is in a position to use the designation sought to be cancelled in a descriptive manner"). Accordingly, this proposed defense is insufficient.

In paragraph 24 of the amended answer, Applicant attempts to reserve the right to add defenses. This paragraph is improper because it does not give Opposer fair notice of such defenses. *See Philanthropist.com, Inc.,* 2021 USPQ2d 643, at *4 n.6.

In view of the insufficiency of the defenses set forth in the proposed amended answer, Applicant's motion for leave to file an amended answer is denied. Applicant's original answer to the amended notice of opposition remains the operative responsive pleading herein. 26 TTABVUE. In view of the insufficiency of the affirmative defenses set forth in the original answer, those defenses are sua sponte stricken. See Fed. R. Civ. P. 12(f); TBMP § 506.01.

Proceedings are resumed. **The Board will not entertain any further motions for summary judgment from Applicant. The parties are directed to move this case forward to trial without further delay.**

Remaining dates are reset as follows.

Plaintiff's Pretrial Disclosures Due	3/1/2024
Plaintiff's 30-day Trial Period Ends	4/15/2024
Defendant's Pretrial Disclosures Due	4/30/2024
Defendant's 30-day Trial Period Ends	6/14/2024
Plaintiff's Rebuttal Disclosures Due	6/29/2024
Plaintiff's 15-day Rebuttal Period Ends	7/29/2024
Plaintiff's Opening Brief Due	9/27/2024
Defendant's Brief Due	10/27/2024
Plaintiff's Reply Brief Due	11/11/2024
Request for Oral Hearing (optional) Due	11/21/2024

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). Such briefs should utilize citations to the TTABVUE record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. 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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing.

Note: Parties are strongly encouraged to check the entire document before filing.[8] The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the ESTTA help webpage.

[8] To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.