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

Proceeding	91270510
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No.: 90/169,080
Mark: POINT
Filing Date: September 9, 2020
Publication Date: March 23, 2021

WW INTERNATIONAL, INC., Opposer, v. KEY POINT TECHNOLOGIES, INC., Applicant.	Opposition No. 91270510

OPPOSER'S MOTION TO STRIKE APPLICANT'S FIRST, SECOND, TENTH, AND ELEVENTH AFFIRMATIVE DEFENSES AND RESERVATION OF RIGHTS

Pursuant to Federal Rule of Civil Procedure 12(f) and 12(f)(2) and Section 506 of the Trademark Trial and Appeal Board Manual of Procedure (2021) ("TBMP"), Opposer WW International, Inc. ("WW") moves to strike Applicant Key Point Technologies, Inc.'s First, Second, Tenth, and Eleventh Affirmative Defenses as well as language purporting to reserve the right to assert additional, unspecified defenses in future. *See* 4 TTABVUE 4-6; 1 TTABVUE 9-10, 12. As shown below, these defenses are either unavailable to Applicant in this proceeding, unsupported by sufficient factual allegations to fairly place WW on notice of their bases, or both.

I. BACKGROUND

On September 9, 2020, Applicant applied to register the standard-character mark POINT under Section 1(b), 15 U.S.C. § 1051(b), for the following goods and services in Classes 9, 35, 41, 42, and 44:

Class 9: Downloadable software for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine and health metrics; downloadable software, namely, downloadable mobile applications, for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine and health metrics; downloadable software for obtaining, displaying and updating biometric health data from the user and for recommending goods, services, media content, and practices for the user based on the user's biometric health data; downloadable software, namely, downloadable mobile applications, for obtaining, displaying and updating biometric health data from the user and for recommending goods, services, media content, and practices for the user based on the user's biometric health data; downloadable software for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine, health metrics, and location; downloadable software, namely, downloadable mobile applications, for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the individual's routine, health metrics, and location

Class 35: Providing a web site featuring the ratings, reviews, and recommendations on products and services for commercial purposes posted by users of health, fitness, nutrition, mindfulness, and wellness goods, media content, and services provided by others

Class 41: Providing educational information online in the field of physical fitness; educational services, namely, conducting classes in the field of mindfulness and wellness

Class 42: Providing temporary use of non-downloadable online software for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine and health metrics; Providing a website featuring temporary use of non-downloadable online software for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine and health metrics; Providing temporary use of non-downloadable online software for obtaining, displaying and updating biometric health data from the user and for recommending goods, services, media content, and practices for the user based on the user's biometric health data; Providing a website featuring temporary use of non-

> downloadable online software for obtaining, displaying and updating biometric health data from the user and for recommending goods, services, media content, and practices for the user based on the user's biometric health data; Providing temporary use of non-downloadable online software for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine, health metrics, and location; Providing a website featuring temporary use of non-downloadable online software for recommending fitness-related goods and services, health-related goods and services, mindfulness-related goods and services, nutrition-related goods and services, wellness-related goods and services, media content, and practices based on the user's routine, health metrics, and location
>
> Class 44: Providing educational information online in the field of health, nutrition, mindfulness and wellness, nutrition counseling

See 1 TTABVUE 12-13 (¶ 5). The Application was published on March 23, 2021. *Id.* at 1.

On July 15, 2021, WW filed a Notice of Opposition, claiming priority and likely confusion with its POINTS mark and other marks incorporating POINT or POINTS (collectively, the "POINTS Marks") under Section 2(d), 15 U.S.C. § 1052(d). *Id.* at 9-12, 14-15. On August 24, 2021, Applicant filed an Answer asserting 12 "affirmative defenses"[1] and an unnumbered paragraph (at the top of Page 5) purporting to reserve the right to assert additional, unspecified defenses in future. *See* 4 TTABVUE 4-6. For the reasons described below, four of those "defenses" are insufficient, as is Applicant's reservation of rights.

II. ARGUMENT

"The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted." TBMP § 506.01. Thus, an applicant asserting affirmative defenses must support those defenses with factual allegations in sufficient detail to

[1] Many of those "defenses" consist of arguments as to why, in Applicant's view, confusion is unlikely. *See* 4 TTABVUE 5. These are not true affirmative defenses, but serve merely to amplify Applicant's denials. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 U.S.P.Q.2d 1232, 1236 n.11 (T.T.A.B. 2015).

provide the opposer with fair notice of their basis. *See IdeasOne, Inc. v. Nationwide Better Health, Inc.*, 89 U.S.P.Q.2d (BNA) 1952, 1953 (T.T.A.B. 2009); TBMP § 311.02(b)(1) ("[T]he pleading should include enough detail to give the plaintiff fair notice of the basis for the defense."). When an applicant fails to do so, or its defenses have no basis in law, Rule 12(f) empowers the Board to "strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter" either "on its own" or "on motion made by a party . . . within 21 days after being served with the pleading." Fed. R. Civ. P. 12(f), (f)(1), (f)(2). The Board should strike the following defenses here.

A. Applicant's Defense of Failure to State a Claim Should Be Stricken as Nakedly Pleaded and Factually Unsupported.

Applicant's First Affirmative Defense asserts that WW's "opposition fails to state a claim for which relief can be granted." 4 TTABVUE 4. "[F]ailure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim." *John W. Carson Found. v. Toilets.com, Inc.*, 94 U.S.P.Q.2d 1942, 1949 (T.T.A.B. 2010). Regardless, WW has sufficiently alleged valid statutory grounds for opposition and its entitlement to assert those grounds, *see* 1 TTABVUE, and Applicant has neither moved to dismiss nor alleged any supporting facts for its First Affirmative Defense. Thus, that "defense" is insufficient as nakedly pleaded,[2] and the Board should strike it from the Answer. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 U.S.P.Q.2d 1733, 1738 n.7 (T.T.A.B. 2001); *Lodestar Anstalt v. Bacardi & Co.*, No. 91216163, 2017 WL 513974, at *3 (T.T.A.B. Feb. 2, 2017) (striking defense of failure to state a claim because

[2] As the Supreme Court instructed in *Ashcroft v. Iqbal*, 556 U.S. 662 (2009), factual allegations must be more than "naked assertion[s]" devoid of "further factual enhancement." *Id.* at 678 (alteration in original) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 557 (2007)). "[A] formulaic recitation of the elements of a [defense] will not do." *Twombly*, 550 U.S. at 555.

"Bacardi has not filed a motion to dismiss or otherwise indicated any basis for its allegation that Lodestar's complaint fails to state a claim upon which relief may be granted, and we see none") (nonprecedential).

B. Applicant's Defenses of Estoppel and Acquiescence Should Be Stricken as Either Unavailable on these Facts, Nakedly Pleaded, or Both.

Applicant's Second Affirmative Defense asserts that WW's "opposition is barred by the equitable doctrines of estoppel and/or acquiescence." 4 TTABVUE 5. The equitable defenses of estoppel and acquiescence generally are not applicable in opposition proceedings because they run from the publication date, not from the date on which the opposer learns of the use (if any). *Nat'l Cable Tel. Ass'n v. Am. Cinema Eds., Inc.*, 19 U.S.P.Q.2d 1424, 1432, 937 F.2d 1572, 1580 (Fed. Cir. 1991); *see also Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 23 U.S.P.Q.2d 1701, 1703, 971 F.2d 732, 734 (Fed. Cir. 1992) ("As applied in trademark opposition or cancellation proceedings, these defenses [of laches and estoppel] must be tied to a party's registration of a mark, not to a party's use of the mark."); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 U.S.P.Q.2d 1526, 1531 (T.T.A.B. 2008) ("Conduct which occurs prior to the publication of the application for opposition generally cannot support a finding of equitable estoppel."); *Barbara's Bakery, Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1292 n.14 (T.T.A.B. 2007) (holding amendment to assert laches, acquiescence, and estoppel would be futile); *Krause v. Krause Publ'ns, Inc.*, 76 U.S.P.Q.2d 1904, 1914 (T.T.A.B. 2005) ("[T]he equitable defense of acquiescence in an opposition or cancellation proceeding does not begin to run until the mark is published for opposition."); TBMP § 311.02(b)(1).

Here, Applicant has not supported its estoppel and acquiescence defenses by alleging *any* relevant facts arising during the four months separating its publication date (March 23, 2021) and the opposition date (July 15, 2021), nor could it do so. In short, Applicant "has done no more than

list these defenses by name, and has provided no further facts upon which they might plausibly be based." *See Lodestar Anstalt*, 2017 WL 513974, at *3. The Board should strike Applicant's Second Affirmative Defense.

C. Applicant's Defenses Relating to Ex Parte Examination of the Application Should Be Stricken as Immaterial.

Applicant also asserts the following as affirmative defenses:

> 10. The USPTO Examining Attorney examining Applicant's Application did not cite any of Opposer's pleaded registrations or applications as a bar to registration of the Application under Section 2(d) of the Lanham Act, finding no likelihood of confusion between Applicant's applied-for mark and Opposers' [sic] asserted marks.
>
> 11. The USPTO Examining Attorney's position in the examination and publication of this Application is consistent with Applicant's position that there is no likelihood of confusion with respect to its applied-for mark and the pleaded registrations or applications asserted by Opposers [sic].

4 TTABVUE 5. Yet, the Board has held that "it is not dispositive or even relevant that applicant was able to convince the Trademark Examining Attorney during ex parte examination to pass applicant's mark to publication." *Miss Universe L.P., LLLP v. Cmty. Mktg., Inc.*, 82 U.S.P.Q.2d 1562, 1571 (T.T.A.B. 2007) (finding a likelihood of confusion); *see also Super Bakery, Inc. v. Benedict*, 96 U.S.P.Q.2d 1134, 1135 n.1 (T.T.A.B. 2010) ("A decision by an examining attorney during examination of an application as to whether or not there is likelihood of confusion with another registered mark has no preclusive effect."); *Formica Corp. v. Saturn Plastics & Eng'g Co.*, 185 U.S.P.Q. 251, 253 (T.T.A.B. 1975) ("[I]t is well settled that a finding by the Examiner of Trademarks on the basis of an ex parte showing is not binding on the [Board] in a subsequent inter partes proceeding[.]"). That being the case, Applicant's Tenth and Eleventh Affirmative Defenses should be stricken as immaterial. *See Glanbia Nutritionals (Ir.) Ltd. v. Finkelstein*, No. 91254757, 2020 WL 5870294, at *3 (T.T.A.B. Sept. 30, 2020) (nonprecedential) (striking as immaterial an

affirmative defense asserting that "the examining attorney's decision to approve the involved application for publication 'provides strong evidence' that the application is registrable").

D. Applicant's Reservation of the Right to Assert Additional, Unspecified Defenses in Future Should Be Stricken as Nakedly Pleaded and Factually Unsupported.

Finally, in an unnumbered paragraph at the top of Page 5 of the Answer, Applicant "reserves the right to assert additional affirmative defenses as they may become known through the process of discovery." 4 TTABVUE 6. This paragraph obviously "fails to provide [WW] with notice of the basis for any potential defense." *Grupo Bimbo, S.A. B. de C.V. v. Advanced Total Mktg. Sys., Inc.*, No. 91233593, 2019 WL 2404516, at *4 (T.T.A.B. June 6, 2019) (nonprecedential) (citing TBMP § 311.02(b)). Further, the question "[w]hether Applicant may, at some future point, add an affirmative defense, is a matter that it must raise by means of a motion for leave to amend the answer under Fed. R. Civ. P. 15"—not an unsupported reservation of rights in advance of discovery. *Id.*

III. CONCLUSION

For the foregoing reasons, WW respectfully requests that the Board strike Applicant's First, Second, Tenth, and Eleventh Affirmative Defenses from the Answer, as well as the unnumbered paragraph at the top of Page 5.

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This 14th day of September, 2021.

Respectfully submitted,

/*Sara K. Stadler*/

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CERTIFICATE OF TRANSMITTAL

I hereby certify that a true and correct copy of the foregoing OPPOSER'S MOTION TO STRIKE APPLICANT'S FIRST, SECOND, TENTH, AND ELEVENTH AFFIRMATIVE DEFENSES AND RESERVATION OF RIGHTS is being filed electronically with the Trademark Trial and Appeal Board via ESTTA on this, the 14th day of September, 2021.

/Alberto Garcia/
Alberto Garcia

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing OPPOSER'S MOTION TO STRIKE APPLICANT'S FIRST, SECOND, TENTH, AND ELEVENTH AFFIRMATIVE DEFENSES AND RESERVATION OF RIGHTS has been served on Applicant's counsel, Devin Miller, Esquire, Miller IP Law, 4030 W. 5800 N, Morgan, Utah 84050, by electronic mail to the following email addresses:

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This 14th day of September, 2021.

/Alberto Garcia/
Alberto Garcia