

UNITED STATES PATENT AND TRADEMARK OFFICE  
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Baxley

November 16, 2021

Opposition No. 91270510

*WW International, Inc.*

*v.*

*Key Point Technologies, Inc.*

**Andrew P. Baxley, Interlocutory Attorney:**

This case now comes up for consideration of Opposer's motion (filed September 14, 2021, 5 TTABVUE) to strike the first, second, tenth and eleventh affirmative defenses and the reservation of rights to add affirmative defenses from Applicant's answer. The motion has been fully briefed.

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. *See 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 (2021). 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). Nonetheless, the Board may strike matter where appropriate.

In the first defense, Applicant alleges failure to state a claim upon 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.”<sup>1</sup> *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010). In any event, stating a claim upon which relief can be granted requires only pleading facts which would show entitlement to a cause of action<sup>2</sup> and a valid ground for opposition. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Opposer has sufficiently stated a claim upon which relief can be granted in the notice of opposition, 1 TTABVUE, by alleging its entitlement to a cause of action based on its pleaded registrations and a claim of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on its marks consisting of or including POINT or POINTS for the goods and services recited in its pleaded registrations and application.<sup>3</sup> *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842,

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<sup>1</sup> Indeed, the Board has treated such defense as waived where the defendant did not file a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6). *See Motion Picture Ass’n of America Inc. v. Respect Sportswear Inc.*, 83 USPQ2d 1555, 1557 n.5 (TTAB 2007). The Board has also determined that a plaintiff may test the sufficiency of a defense of failure to state a claim by filing a motion to strike that defense. *See Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995).

<sup>2</sup> Board decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14 under the rubric of “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020).

<sup>3</sup> Opposer submitted copies its pleaded registrations obtained from the USPTO’s TSDR database showing the current status and title thereof as exhibits to the notice of opposition. 1 TTABVUE 17-74. *See* Trademark Rule 2.122(d)(1). So long as these registrations are valid and subsisting when this case is decided (either by summary judgment or at trial), they will establish Opposer’s entitlement to a cause of action and remove priority as an issue requiring

1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 109-10 (CCPA 1974). Accordingly, the motion to strike is granted with regard to the first defense.

In the second defense, Applicant alleges that the “opposition is barred by the equitable doctrines of estoppel and/or acquiescence.” 4 TTABVUE 5. This defense is insufficient because Applicant has failed to allege any specific conduct which provides a basis therefor.<sup>4</sup> See *Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5

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proof for each registered mark for the goods and/or services identified in those registrations. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). If Opposer’s pleaded application Serial No. 87499989, 1 TTABVUE 75-80, matures into a registration during this proceeding, Opposer need not amend its pleading to assert that registration herein; however, Opposer must make that registration properly of record to rely thereon. See *United Global Media Group, Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014); TBMP § 704.03(b)(1)(A).

To the extent that Applicant indicates in its brief in response that it may seek discovery regarding Opposer’s motives in commencing this proceeding, 7 TTABVUE 4-5, Opposer, as a trademark owner, is entitled to protect rights in its registered trademarks by seeking to preclude registration of what it believes to be a confusingly similar mark. See *Cook’s Pest Control, Inc. v. Sanitas Pest Control Corp.*, 197 USPQ 265, 268 (TTAB 1977). At the same time, Opposer is not required to act against every conceivable similar mark; indeed, requiring such action would clutter the Board’s docket. Cf. *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 336 (CCPA 1982) (a party need not take action against every possibly infringing use to avoid abandonment through failing to police its mark).

<sup>4</sup> The elements of equitable estoppel are (1) misleading conduct, through action or inaction, which leads another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this 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). The elements of acquiescence are that: (1) plaintiff actively represented that it would not assert a right or claim; (2) delay between the active representation and assertion of the right or claim was not excusable; and (3) delay caused the defendant undue prejudice. See *Coach House Rest. Inc. v. Coach and Six Rest., Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991).

In its brief in response, Applicant refers to collateral estoppel. 8 TTABVUE 7. However, Applicant has identified no litigation that could provide a basis for an assertion of collateral estoppel (otherwise known as issue preclusion). See *Jet, Inc. v. Sewage Aeration Sys.*, 223

USPQ2d 1067, 1069 (TTAB 1987). Moreover, these defenses are generally inapplicable in opposition proceedings because Opposer could not act against the involved application until it was published for opposition on March 23, 2021.<sup>5</sup> See *Nat'l Cable Tel. Ass'n v. Am. Cinema Eds., Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Accordingly, the motion to strike is granted with regard to the second defense.

In the tenth and eleventh defenses, Applicant alleges that the examining attorney did not cite Opposer's pleaded registrations or applications against the involved application and that the examining attorney's determination that there is no likelihood of confusion between the parties' marks is consistent with Applicant's position in this case. 4 TTABVUE 5. However, the Board is in not bound by examining attorney determinations during ex parte examination and must decide each case on its own record. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Accordingly, the motion to strike is granted with regard to the tenth and eleventh defenses.

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F.3d 1360, 55 USPQ2d 1854, 1858-59 (Fed. Cir. 2000) (collateral estoppel bars relitigation of issues that were already fully litigated).

Applicant also refers in its brief in response to a laches and acquiescence defense under *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969) (otherwise known as a prior registration defense). 8 TTABVUE 7. *Morehouse* stands for the proposition that an opposer has no reasonable belief of damage by the issuance to an applicant of a second registration where that applicant already owns a registration of the same mark for the same goods and/or services. See *id.*, 160 USPQ at 717. However, Applicant has not identified any registration that it owns for the same mark for the same goods and/or services that would provide a basis for a *Morehouse* defense.

<sup>5</sup> After receiving a ninety-day extension of time to oppose, Opposer timely filed the notice of opposition on July 15, 2021. 1 TTABVUE.

Regarding Applicant’s statement that it “reserves the right to assert additional affirmative defenses as they may become known through the process of discovery,” 4 TTABVUE 5, this statement is of no effect. A defendant’s ability to amend its answer is governed by Fed. R. Civ. P. 15. *See* TBMP § 507. Moreover, a defendant cannot reserve unidentified defenses because so reserving does not provide a plaintiff fair notice of the basis for such defenses. *See* TBMP § 506.01 (a purpose of pleadings is to provide fair notice of the claims and defenses asserted). Because the statement at issue is of no effect, the motion to strike is granted.

In sum, Opposer’s motion to strike is granted in full. If Applicant has a factual basis for the stricken defenses or any other additional defenses, it may file a motion for leave to file an amended answer. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02.

Proceedings are resumed. Remaining dates are reset as follows.

Deadline for Discovery Conference	12/12/2021
Discovery Opens	12/12/2021
Initial Disclosures Due	1/11/2022
Expert Disclosures Due	5/11/2022
Discovery Closes	6/10/2022
Plaintiff's Pretrial Disclosures Due	7/25/2022
Plaintiff's 30-day Trial Period Ends	9/8/2022
Defendant's Pretrial Disclosures Due	9/23/2022
Defendant's 30-day Trial Period Ends	11/7/2022
Plaintiff's Rebuttal Disclosures Due	11/22/2022
Plaintiff's 15-day Rebuttal Period Ends	12/22/2022
Plaintiff's Opening Brief Due	2/20/2023
Defendant's Brief Due	3/22/2023
Plaintiff's Reply Brief Due	4/6/2023
Request for Oral Hearing (optional) Due	4/16/2023

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).

#### **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.<sup>6</sup> 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.

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<sup>6</sup> To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.