Trademark Trial and Appeal Board Electronic Filing System. https://estta.uspto.gov

ESTTA Tracking number: **ESTTA1206835**

Filing date: **05/04/2022**

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

Proceeding no.	91272381
Party	Plaintiff Stratasys, Inc.
Correspondence address	AUSTEN ZUEGE WESTMAN CHAMPLIN & KOEHLER PA 121 SOUTH EIGHTH STREET SUITE 1100 MINNEAPOLIS, MN 55402 UNITED STATES Primary email: azuege@wck.com Secondary email(s): jyoung@wck.com, wwhite@wck.com, rdoerrler@wck.com 612-330-0585
Submission	Opposition/Response to Motion
Filer's name	Austen Zuege
Filer's email	azuege@wck.com, wwhite@wck.com, jyoung@wck.com, rdoerrler@wck.com
Signature	/Austen Zuege/
Date	05/04/2022
Attachments	Reply-and-response_Motion_Strike-S697-8612L1.pdf(211069 bytes)

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

In the matter of:

Appl. Ser. No. 88/356,333

For the Mark: Stratsys
International Classes: 009, 042
Filing Date: March 26, 2019

Stratsys, Inc. Opposer, v. Stratsys AB, Applicant.	Opposition No. 91272381

OPPOSER'S COMBINED REPLY ON MOTION TO STRIKE AFFIRMATIVE DEFENSE AND RESPONSE TO APPLICANT'S MOTION FOR LEAVE TO FILE AN AMENDED ANSWER

Stratasys, Inc. ("Stratasys" or "Opposer") files this combined reply and response in reply to Stratasys' Motion to Strike Affirmative Defense (8 TTABVUE) and in response to applicant Stratsys AB's ("Applicant's") Motion for Leave to File an Amended Answer (17 TTABVUE). Proceedings are currently suspended except as to matters relevant to the motion to strike. (10 TTABVUE).

Background

Applicant's Response to the Motion to Strike was combined with a Motion for Leave to Amend the sole affirmative defense that Stratasys had moved to strike. In that combined submission, Applicant has provided no substantive arguments in response to the Motion to Strike

other to seek leave to amend that sole affirmative defense. In that respect, Applicant has conceded the grounds for striking the original affirmative defense, and waived any counterarguments as to the original affirmative defense, and has instead pursued only leave to amend that affirmative defense to attempt to add the required specificity that was originally lacking.

Amending Pleadings and Applicant's Proposed Amended Affirmative Defense

Stratasys acknowledges that the Board's practice is to liberally allow leave to amend an affirmative defense that seeks to present a restricted identification of goods/services pursuant to 15 U.S.C § 1068, 37 C.F.R § 2.133, and TBMP § 311.02(b)(1), when justice so requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party or would violate settled law. *See, e.g., Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ.2d 1825, 1828 (TTAB 2013). The pleading requirements for proper and sufficient affirmative defenses are discussed in Stratasys' opening brief. (8 TTABVUE).

With respect to the proposed amendments to the sole Affirmative Defense (17 TTABVUE at Exhibits A and B) in the Answer, which is presented in the alternative, Stratasys interprets Applicant's use of ellipses as denoting deletions of portions of the identifications of goods and services in International Classes 009 and 042, respectively. In other words, the proposed amended Affirmative Defense proposes a restriction of identified goods/services in the subject application that would omit (i.e., delete) certain recitations that currently appear in the subject application.

Precision/Detail Prong

To the extent that Applicant's proposed amended Affirmative defense deletes certain recitations in the identifications of goods/services of the subject application, as discussed above, Stratasys acknowledges that the requisite precision/detail for an affirmative defense seeking a restricted registration (in the alternative) would be met upon entry of that proposed amended

Affirmative Defense.[1] In this respect, Stratasys acknowledges that the proposed amended Affirmative Defense would satisfy what Stratasys called the "Precision/Detail Prong" in its opening brief. (8 TTABVUE 3-6).

Lack of Use on Goods/Services Being Excluded Prong

Applicant's combined Response/Motion does not explicitly address what Stratasys called the "Lack of Use on Goods/Services Being Excluded Prong" in its opening brief seeking to strike the sole affirmative defense. (8 TTABVUE 3-4 an 6-7). At most, Section III(C) of Applicant's combined Response/Motion makes the conclusory assertions that the "proposed amendment to is Answer is not futile" and that it "resolves issues raised by Opposer's Motion to Strike . . ." Nothing in the proposed amended Affirmative Defense itself specifically addresses lack of use either. TBMP § 311.02(b)(1); *see also DAK Industries Inc. v. Daiichi Kosho Co.,* 35 USPQ.2d 1434, 1437 (TTAB 1995); Jeffrey Handelman, HANDELMAN'S GUIDE TO TTAB PRACTICE §8.02[A] & [B] (2d Ed., Wolters Kluwer 2022). For instance, nothing in the proposed amended Affirmative Defense specifically alleges that Applicant actually uses its opposed mark only on a specific type of the goods/services (in this country). *See* TBMP § 311.02(b)(1).

In the absence of an allegation about lack of use (in this country), the proposed arbitrary deletion of goods cannot be separated from a relatedness analysis for likelihood of confusion. That is, when an original identification of goods/services by a given party establishes or at least suggests relatedness of the use of a mark on all the different goods/services identified, an arbitrary omission

[1] However, Stratasys expressly notes that this acknowledgement of adequate specificity of the proposed amended Affirmative Defense to survive being struck is strictly limited to the requirements to survive a motion to strike; Stratasys makes no admission as to the substantive merits of the amended Affirmative Defense with regard to the ultimate priority and likelihood of confusion issue in this proceeding. Opposer Stratasys has not consented, and does not at this time consent, to registration of the subject application with the proposed restriction of goods/services set forth in the proposed amended Affirmative Defense.

of certain goods/services with which the relevant mark is actually in use in a proposed restricted identification is nothing more than an end run around the likelihood of confusion analysis and thus insufficient—even at the pleading stage. In this sense, proposed restrictions in an affirmative defense must be commercially significant. *See Bd. of Regents, Univ. Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ.2d 1182 (TTAB 2014) (refusing to restrict asserted registrations in opposition counterclaim). The lack of use requirement is essentially a commercial significance requirement.

Because of the lack of an allegation of lack of use (in this country) in the proposed amended Affirmative Defense, the motion for leave to amend is futile. Accordingly, the Board should deny Applicant's Motion for Leave to Amend and grant Stratasys' Motion to Strike Affirmative Defense.

Conclusion

For all the reasons given above, Applicant's Motion for Leave to Amend (17 TTABVUE) should be ***denied*** and Stratasys' Motion to Strike Affirmative Defense (8 TTABVUE) should be ***granted***.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

WESTMAN, CHAMPLIN & KOEHLER, P.A.

Dated: May 4, 2022

By: /Austen Zuege/

Austen Zuege (MN Bar 330267, admitted 10/31/2003)
James L. Young (MN Bar 0131775, admitted 10/30/1981)
121 South Eighth Street, Suite 1100
Minneapolis, MN 55402
Phone: 612-334-3222
Fax: 612-334-3122
Email: azuege@wck.com

Email: jyoung@wck.com

ATTORNEYS FOR OPPOSER STRATASYS, INC.

CERTIFICATE OF SERVICE

I am over the age of 18 and am not a party to this action. My business address is Westman, Champlin & Koehler, P.A., 121 South Eighth Street, Suite 1100, Minneapolis, MN 55402.

On May 4, 2022**,** a copy of the following document:

- OPPOSER'S COMBINED REPLY ON MOTION TO STRIKE AFFIRMATIVE DEFENSE AND RESPONSE TO APPLICANT'S MOTION FOR LEAVE TO FILE AN AMENDED ANSWER

was delivered via e-mail to:

Ethan B. Vodde
LEE & HAYES PC
601 W. Riverside Ave., Suite 1400
Spokane, WA 99201
Primary Email: trademarks@leehayes.com
Secondary Email(s): rhettb@leehayes.com, karig@leehayes.com, ethan.vodde@leehayes.com

Executed on May 4, 2022.

/Austen Zuege/
Austen Zuege