

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

December 20, 2022

Opposition No. 91281119

*Classic Media, LLC*

*v.*

*Aqua Haze LLC*

**Lawrence T. Stanley, Jr., Interlocutory Attorney:**

On December 19, 2022, at Opposer's request, the Board participated in the parties' discovery conference, which was conducted by phone. The participants were Phil Kim and Zayde Khalil, counsel for Opposer, Abraham Lichy, counsel for Applicant, and Lawrence T. Stanley, Jr., Interlocutory Attorney for the Board.

**I. Related Proceedings**

The parties confirmed that they are not currently involved in any other litigation concerning the marks at issue in this proceeding. As set forth in the institution order, the parties must notify the Board promptly in writing if they become parties to another Board proceeding, or a civil action, which involves the same or related marks or issues of law or fact which overlap with this case.

## **II. Settlement**

The parties indicated that they have not discussed settlement. The Board is liberal in granting stipulations to suspend proceedings to allow settlement discussions. Stipulations to suspend a proceeding should be filed promptly because, absent suspension, the Board expects the parties to adhere to the proceeding deadlines set by the Board. *See Atlanta-Fulton County Zoo Inc. v. De Palma*, 45 USPQ2d 1858, 1859 (TTAB 1998) (“[I]t is well established that the mere existence of settlement negotiations alone does not justify a party’s inaction or delay.”).

## **III. Pleadings Claims and Defenses**

### **A. Notice of Opposition**

Applicant, a limited liability company organized under the laws of Texas, is the applicant for application Serial No. 97282502 for the mark CASPER, in standard characters, for “gummy vitamins” in International Class 5 and “electronic cigarettes” in International Class 34.<sup>1</sup>

Opposer, a limited liability company organized under the laws of Delaware, alleges prior use and ownership of the following marks (collectively, “Opposer’s Marks”):

- CASPER, in standard characters, for “prerecorded DVD's, and prerecorded CD-Roms featuring live action and animated children's shows and feature films; interactive multimedia software programs for entertainment featuring video games; prerecorded compact discs

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<sup>1</sup> Filed February 24, 2022, based upon Applicant’s allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act.

featuring music; decorative magnets; sunglasses; screen saver and wallpaper software for mobile telephones: in International Class 9;<sup>2</sup>



- for “prerecorded DVDs” in International Class 9;<sup>3</sup>



- for “comic periodical and comic strip” in International Class 16;<sup>4</sup>
- CASPER AND THE SPECTRALS, in standard characters, for “comic books” in International Class 16;<sup>5</sup>
- CASPER, in typeset form,<sup>6</sup> for “T-shirts, sweatshirts, sweatpants, sweatsuits, caps, pajamas, shorts, trousers, hosiery, shoes, Halloween costumes and masks sold in connection therewith, sleepwear” in International Class 25;<sup>7</sup> and
- CASPER'S SCARE SCHOOL, in standard characters, for “Entertainment services, namely, television series in the nature of animated, live action, drama, comedy, and variety television series” in International Class 41.<sup>8</sup>

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<sup>2</sup> Registration No. 3023822; issued December 6, 2005; renewed.

<sup>3</sup> Registration No. 3234730; issued April 24, 2007; renewed.

<sup>4</sup> Registration No. 722258; issued October 3, 1961; renewed.

<sup>5</sup> Registration No. 3848797; issued September 14, 2010; renewed.

<sup>6</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed or typeset mark is the legal equivalent of a standard character mark. *See In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

<sup>7</sup> Registration No. 1960832; issued March 5, 1996; renewed.

<sup>8</sup> Registration No. 3745121; issued February 2, 2010; renewed.

1 TTABVUE 7-10, ¶¶ 4-24. As grounds for opposition, Opposer pleads claims of: (1) likelihood of confusion under Section 2(d) of the Trademark Act and (2) dilution under Section 43(c) of the Trademark Act. *Id.* at 10-11, ¶¶ 25-35.

**1. Entitlement to a Statutory Cause of Action**

Opposer has pleaded its entitlement to a statutory cause of action, formerly referred to as standing, through its registration and use of Opposer's Marks, and the alleged damage that will occur by registration of Applicant's mark. *Id.* at 7-11, ¶¶ 8-32.

**2. Likelihood of Confusion**

Opposer has pleaded a claim for likelihood of confusion in that Opposer alleges that it has priority in Opposer's Marks and that Applicant's mark so closely resembles Opposer's Marks that consumers are likely to be confused as to the source of origin of Applicant's goods and services or the affiliation between Applicant and Opposer. *Id.* at 10-11, ¶¶ 25-32.

**3. Dilution**

Opposer has pleaded a claim for dilution by alleging that: (1) it owns a famous mark that is distinctive (*id.* at 10-11, ¶¶ 23-24 and 34); (2) Applicant is using a mark in commerce that allegedly dilutes Opposer's famous mark (*id.* at 11, ¶ 35); (3) Opposer's mark became famous prior to the filing date of Applicant's application (*id.* at 10-11, ¶¶ 23-24 and 34); and (4) Applicant's use of its mark is likely to cause dilution (*id.* at 11, ¶ 35). *See Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1723-1724 (Fed. Cir. 2012).

**B. Answer**

Applicant denies the salient allegations of the notice of opposition and purports to plead four affirmative defenses. 5 TTABVUE. An affirmative defense is “[a] defendant’s assertion raising new facts and arguments that, if true, will defeat the plaintiff’s or prosecution’s claim, even if all allegations in the complaint are true.” *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (citing Black’s Law Dictionary, p. 430 (7th ed. 1999)).

**1. First Affirmative Defense: Failure to State a Claim**

For its first defense, Applicant asserts that “[t]he Opposition fails to state a claim upon which relief can be granted.” 5 TTABVUE 6. Failure to state a claim is not a true affirmative defense because it asserts the insufficiency of the pleading of Opposer’s claims rather than a statement of a defense to a properly pleaded claim. *See Blackhorse et al. v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Furthermore, Opposer has sufficiently pleaded its entitlement to a statutory cause of action and a claim for relief.

Accordingly, Applicant’s first affirmative defense (failure to state a claim) is **stricken**.

**2. Second and Third Affirmative Defenses: Amplifications**

For its second defense, Applicant asserts that “[t]here is no likelihood of confusion, mistake or deception between Opposer’s Mark and Applicant’s Mark.” 5 TTABVUE 6. For its third defense, Applicant alleges that “[a]ny and all acts alleged to have been

committed by Applicant were performed with lack of knowledge and lack of willful.” *Id.* Applicant’s second and third defenses are not true affirmative defenses. However, to the extent they amplify the denials in Applicant’s answer, they are permissible. *See ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n.11 (TTAB 2015).

### **3. Fourth Affirmative Defense: Laches**

For its fourth defense, Applicant asserts that “the Opposition is barred by the doctrine of laches.” 5 TTABVUE 6. Applicant’s conclusory allegations are legally insufficient because they do not provide Opposer with fair notice of the factual bases for the defense. Fed. R. Civ. P. 8(b)(1) and 12(f); *see e.g., IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007); *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1980); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 311.02(b) (2022) (“The elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.”). Applicant has done no more than list the defense of laches by name. Applicant has provided no further facts upon which the defense might plausibly be based.

Furthermore, equitable defenses such as laches, generally are not applicable in opposition proceedings because these defenses start to run from the time a mark is published for opposition, not from the time of knowledge of use. *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); TBMP § 311.02(b). In the answer, Applicant has not alleged any facts or events occurring between the time its mark was published for opposition and the filing of the notice of opposition. Inasmuch as the opposition was filed within the time allowed therefor, it does not appear that a laches defense is available to Applicant.

Accordingly, Applicant's fourth defense (laches) is **stricken**.

#### **4. Reservation of Rights Defense**

In the introduction to Applicant's affirmative defenses, Applicant purports to reserve the right to assert other defenses that will be developed through discovery. 5 TTABVUE 5-6. The Board finds that this is not an affirmative defense but merely an advisory statement that Applicant may amend its pleading at some future date after conducting discovery or further independent investigation in this matter. A defendant cannot reserve unidentified defenses since it does not provide a plaintiff fair notice of such defenses. Whether or not Applicant may, at some future point, add an affirmative defense must be resolved by way of a motion for leave to amend.

Accordingly, Applicant's reservation of rights defense is **stricken**.

#### **IV. Accelerated Case Resolution (ACR) Procedures**

The Board briefly addressed how cases can be streamlined using Accelerated Case Resolution ("ACR"). In a traditional ACR proceeding, parties forego a formal trial in favor of submitting briefs with attached evidence, and agreeing that the Board may

resolve any genuine disputes of material fact raised by the parties' filings or the record, and issue a final decision. *See, e.g., Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1776 (TTAB 2013). Short of traditional ACR, parties may stipulate to various facts and procedures. *Target Brands, Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007) (parties stipulated to entire record of the case including business records, public records, government documents, marketing materials and materials obtained from the Internet as well as thirteen paragraphs of facts; the parties agreed to reserve the right to object to such facts and documents on the bases of relevance, materiality and weight).

The following materials provide additional information regarding ACR:

1. General description of ACR:

[https://www.uspto.gov/sites/default/files/trademarks/process/appeal/Accelerated Case Resolution ACR notice from TTAB webpage 12 22 11.pdf](https://www.uspto.gov/sites/default/files/trademarks/process/appeal/Accelerated_Case_Resolution_ACR_notice_from_TTAB_webpage_12_22_11.pdf).

2. FAQs on ACR:

<https://www.uspto.gov/sites/default/files/documents/acr-faq-updates.doc>.

3. TBMP §§ 528.05(a)(2), 702.04 and 705.

The assigned Interlocutory Attorney is available for telephone conferences to further discuss ACR and to assist the parties in crafting an ACR stipulation, if the parties are interested.

## **V. Arrangements for Disclosure, Discovery, and Trial**

The Board expects cooperation from the parties throughout disclosures, discovery, and trial.

Pursuant to Trademark Rule 2.116(g), the Board's standard protective order is automatically in effect for this proceeding and may be accessed here: [https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order\\_02052020.pdf](https://www.uspto.gov/sites/default/files/documents/Standard%20Protective%20Order_02052020.pdf).

Since the Board's standard protective order automatically applies, parties cannot withhold properly discoverable information on the basis of confidentiality. *Amazon Techs., Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009); TBMP §412.01.

The parties may seek only discovery that is relevant to the disputed issues and proportional to the needs of the case. Fed. R. Civ. P. 26(b)(1). The parties should not assert boilerplate or blanket objections in response to discovery requests. Fed. R. Civ. P. 34(b)(2)(B) (party responding to a document request must "state with specificity the grounds for objecting to [a] request, including the reasons"); *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 222 USPQ 80, 83 (TTAB 1984) ("[I]t is incumbent upon a party who has been served with interrogatories to respond by articulating his objections (with particularity) to those interrogatories which he believes to be objectionable, and by providing the information sought in those interrogatories which he believes to be proper."). If a party withholds information or documents in response to a discovery request based on the attorney/client privilege and/or work product doctrine, the party must produce a privilege log. *Amazon Techs.*, 93 USPQ2d at 1706 n.6; *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1556 (TTAB 2000).

**VI. Proceeding Dates**

Dates remain as set in the Board’s October 10, 2022 order, which are as follows:<sup>9</sup>

Initial Disclosures Due	1/18/2023
Expert Disclosures Due	5/18/2023
Discovery Closes	6/17/2023
Plaintiff’s Pretrial Disclosures Due	8/1/2023
Plaintiff’s 30-day Trial Period Ends	9/15/2023
Defendant’s Pretrial Disclosures Due	9/30/2023
Defendant’s 30-day Trial Period Ends	11/14/2023
Plaintiff’s Rebuttal Disclosures Due	11/29/2023
Plaintiff’s 15-day Rebuttal Period Ends	12/29/2023
Plaintiff’s Opening Brief Due	2/27/2024
Defendant’s Brief Due	3/28/2024
Plaintiff’s Reply Brief Due	4/12/2024
Request for Oral Hearing (optional) Due	4/22/2024

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). Oral argument at

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<sup>9</sup> As a reminder, a party must serve initial disclosures before serving discovery or filing a motion for summary judgment.

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final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).