

ESTTA Tracking number: **ESTTA1278787**

Filing date: **04/16/2023**

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

Proceeding no.	91283434
Party	Plaintiff The Ohio State University
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Date	04/16/2023
Attachments	Ohio State v 1-Off - Motion to Strike.pdf(190755 bytes)

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

IN THE MATTER OF: Trademark Application Serial No. 97/155,253

DATE OF PUBLICATION: October 18, 2022

The Ohio State University,)	
)	
Opposer,)	
)	
v.)	Opposition Proceeding No. 91283434
)	
1-Off Creative Concepts, Inc.,)	
)	
Applicant.)	

MOTION TO STRIKE APPLICANT’S AFFIRMATIVE DEFENSES¹

THE OHIO STATE UNIVERSITY, an Ohio Educational Institution (“**Opposer**”) respectfully requests the Trademark Trial and Appeal Board (the “**Board**”) strike Applicant’s affirmative defenses pursuant to Federal Rule of Civil Procedure (“**Fed. R. Civ. P.**”) 12(f). Opposer submits the following memorandum in support of its motion.

I. Opposer’s Motion to Strike Applicant’s Affirmative Defenses

Opposer respectfully requests that the Board strike Applicant’s affirmative defenses pursuant to Fed. R. Civ. P. 12(f). As provided in Fed. R. Civ. P. 12(f), the Board “may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.” *See also* 37 C.F.R. § 2.116; TBMP § 506.01 (2022).

Applicant’s first and second affirmative defenses assert that Opposer has failed to state a

¹ While the section of Applicant’s Answer regarding its affirmative defenses is entitled, “Affirmative Defenses to Counterclaim,” Opposer presumes Applicant intended to entitle the section, “Affirmative Defenses to Notice of Opposition.” Accordingly, this motion is based on that presumption.

claim upon which relief can be granted based on the belief that Applicant's mark is not confusingly similar with the Opposer's Block O Mark and that the Opposer's Mark is not famous. 4 TTABVue 6, ¶¶ 1–2. While matter generally will not be stricken unless it clearly has no bearing on the issues involved, “the striking of the defense that a complaint fails to state a claim upon which relief could be granted may be appropriate when the legal insufficiency of this defense is readily apparent.” *Order Sons of Italy in America v. Marofa S.A.*, 38 U.S.P.Q.2d 1602, Opp. No. 98120, 1996 WL 253842, at *2 (T.T.A.B. Feb. 28, 1996). Stated differently, “while Rule 12(b)(6) permits a defendant to assert in his answer the ‘defense’ of failure to state a claim upon which relief can be granted, it necessarily follows that the plaintiff may utilize this assertion to test the sufficiency of the plaintiff's pleading in advance of trial by moving under Rule 12(f) to strike the ‘defense’ from the defendant's answer.” *Id.* Here, it is clearly evident Opposer has sufficiently stated a claim for likelihood of confusion and dilution by blurring.

“In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark.” *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, Opp. No. 91175571, 2007 WL 4162785, at *2 (T.T.A.B. Nov. 21, 2007). “Specifically, a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 U.S.P.Q.2d 1025, Opp. No. 91218512, 2015 WL 5721653, at *2 (T.T.A.B. Sept. 11, 2015). In determining a motion to dismiss for failure to state a claim, all of plaintiff's well-pleaded allegations must be accepted as true, and the notice of opposition must be construed in the light most favorable to the plaintiff. *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 988 F.2d 1157, 1161 (Fed. Cir. 1993). “Dismissal for insufficiency is appropriate only if it appears

certain that opposer is entitled to no relief under any set of facts which could be proved in support of its claim.” *Fair Indigo LLC*, 2007 WL 4162785, at *2.

In order to show that a plaintiff is entitled to oppose an application under Section 13 of the Trademark Act, the plaintiff must demonstrate that it has a “real interest in the proceeding and a reasonable belief in damage by the registration of the mark.” *Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, Cancellation No. 9207034, 2020 WL 6938378, at *1 (T.T.A.B. Nov. 23, 2020). In this case, Opposer has pleaded prior use of the Block O Mark as well as current ownership of a valid and subsisting registration for the Block O Mark, which was properly made of record, and has alleged that Applicant’s applied-for mark is highly similar to its Block O Mark in sight, sound, meaning and commercial impression and is intended to be use with goods that could be seen as originating from or otherwise affiliated with Opposer. *See* 1 TTABVUE 40–47. Such allegations are sufficient to show Opposer is entitled to a statutory cause of action. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000) (“In this case, as stated earlier, Laser Golf owns two prior registrations. These registrations and the products sold under the mark they register suffice to establish Laser Golf’s direct commercial interest and its standing to petition for cancellation of Cunningham’s LASERSWING mark.”); *Herman Miller, Inc. v. the Lane Co., Inc.*, 221 U.S.P.Q. 922, 1984 WL 63100, at *2 (T.T.A.B. Jan. 13, 1984) (stating that opposer’s “ownership of subsisting registrations alleged in the pleadings . . . is sufficient to prove standing to oppose”). *See also Danjaq, LLC v. Nancy Tiscareno*, Opp. No. 91217857, 2015 WL 9906653, at *3 (T.T.A.B. Jul. 15, 2015) (“Establishing ownership of an allegedly confusingly similar registration is sufficient to prove standing to oppose on the ground of likelihood of confusion.”).

In order to show a valid ground exists for opposing a mark under Section 2(d) of the

Trademark Act, an opposer must allege that is has registered or previously used a mark and that contemporaneous use of the parties' respective marks in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *RLP Ventures, LLC v. Life Line, Inc.*, Cancellation No. 9206748, 2018 WL 2445482, at *1 (T.T.A.B. May 22, 2018); *Nike, Inc.*, 2015 WL 5721653, at *4. As noted above, Opposer has alleged (1) prior use of its Block O Mark as well as a previous registration for same, (2) Applicant's applied-for mark is highly similar to its Block O Mark in sight, sound, meaning and commercial impression, (3) the applied-for mark is intended to be used with goods that could be seen as originating from or otherwise affiliated with Opposer, (4) Applicant's applied-for goods are presumed to travel in the same channels of trade to the same class of purchasers as those of the goods and services offered under the Block O Mark, and (5) if registered, the Applicant would have the presumptive right to use to use its applied-for mark in Opposer's distinctive school colors of scarlet and gray, which would further heighten the likelihood of confusion to arise from Applicant's use of its applied-for mark with the applied-for goods. Such allegations clearly establish Opposer has adequately pleaded priority and likelihood of confusion.

In order to show a valid ground exists for opposing a mark based on a claim of dilution by blurring, an opposer must allege: (1) the opposer owns a famous mark that is distinctive; (2) the applicant is using or intends to use a mark in commerce that allegedly dilutes opposer's famous mark; (3) the applicant's use of its mark began, or the filing date of its intent to use application, is after opposer's mark became famous; and (4) applicant's use of its mark is likely to cause dilution by blurring. *Nike, Inc.*, 2015 WL 5721653, at *4–5; *Am. Express Mktg. & Dev. Corp. v. Tung B. Vo*, Opp. No. 91230559, 2018 WL 6650136, at *15 (T.T.A.B. Dec. 13, 2018). In the case, Opposer has alleged that its Block O Mark is famous, the Block O Mark is distinctive, the Applicant intends

to use a mark in commerce that will dilute the fame of Opposer's Block O Mark, the filing date of Applicant's intent to use application is after Opposer's Block O Mark became famous, and Applicant's use of its applied-for mark will be likely to cause dilution by blurring. *See* 1 TTABVUE 43–44, 47, ¶¶ 22, 45–49. Accordingly, Opposer has adequately pleaded a dilution by blurring claim.

Therefore, Applicant's first and second affirmative defenses should be stricken as Opposer has established standing and plausible claims of likelihood of confusion and dilution by blurring.

As to Applicant's third, fourth, and fifth affirmative defenses, it is well established that defenses which attack the validity of a pleaded registration are not heard by the Board in the absence of a counterclaim or a separate petition to cancel. *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 1331 n.3 (Fed. Cir. 2008) ("The Board's rules of procedure in trademark cases provide that invalidity of a registration pleaded in an opposition or cancellation proceeding is a compulsory counterclaim."); 37 C.F.R. § 2.106 ("An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration."). Here, each of Applicant's aforementioned affirmative defenses claim Opposer's registered Block O Mark is descriptive or otherwise fails to function as a trademark, which is clearly an attack on the validity of the Block O Mark registration. *See* 4 TTABVUE 6, ¶¶ 3–5. Therefore, Applicant's third, fourth and fifth affirmative defenses should be stricken. *See, e.g., Pure & Simple Concepts Inc. v. Gryphon Groupe, LLC*, Opp. No. 91238034, 2019 WL 975116, at *4 (T.T.A.B. Feb. 26, 2019) ("Applicant pleads that Opposer's marks have not acquired secondary meaning. Inasmuch as Opposer has pleaded ownership of eight registrations, this affirmative defense would constitute an impermissible collateral attack on Opposer's pleaded registrations."); *Country Life, LLC v. Barlean's Organic Oils, LLC*, Opp. No.

91231643, 2019 WL 4567854, at *4 (T.T.A.B. Sept. 18, 2019) (finding claim that opposer’s mark was invalid “to the extent that it ha[d] become invalid, generic, merely descriptive, or ha[d] failed to gain the alleged acquired/distinctiveness/secondary meaning, relative to the goods and services provided” constituted “an impermissible collateral attack on the validity of Opposer’s pleaded registration in the absence of a counterclaim”); *Truserv Corp. v. Advanced Impact Marketing Service, LLC*, Opp. No. 91124078, 2005 WL 363415, at *6 n.7 (T.T.A.B. Feb. 4, 2005) (“While applicant has also pleaded, as a putative affirmative defense, that ‘Opposer’s mark is descriptive and therefore entitled to a very narrow scope of protection,’ such defense constitutes a collateral attack on the validity of opposer’s pleaded registrations.”).

It is worth noting that even if Applicant were to assert the arguments of its third, fourth and fifth affirmative defenses via counterclaims, such claims would still fail given Opposer’s asserted Block O Mark registration is incontestable. “Once a mark gains incontestable status, its registration can only be challenged on the grounds stated in § 14 of the Lanham Act, 15 U.S.C. § 1064, such as, ‘if the registered mark becomes the generic name for the goods or services, ... has been abandoned, ... or its registration was obtained fraudulently.’” *Sunrise Jewelry Mfg. Corp. v. Fred S.A.*, 175 F.3d 1322, 1324 (Fed. Cir. 1999) (citing 15 U.S.C. § 1064(3)). As such, “an incontestable mark cannot be challenged . . . for mere descriptiveness, or on the basis that the mark lacks secondary meaning.” *Sunrise Jewelry*, 175 F.3d at 1324.

Finally, Applicant’s sixth “affirmative defense” is merely a reservation of rights to assert additional affirmative defenses at a later date. It is well established that such a reservation of rights is improper. An applicant cannot reserve unidentified defenses in its answer because it does not provide an opposer fair notice of such defenses. *Philanthropist.com, Inc. v. The General Conf. Corp. of Seventh-Day Adventists*, Cancellation Nos. 92065178 and 92065255, 2021 WL 2472776,

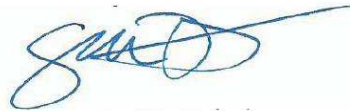
at *7 n.6 (T.T.A.B. June 15, 2021) (“Respondent's attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give Petitioner fair notice of such defenses.”); *DC Comics v. Cellular Nerd LLC*, Opp. No. 91246950, 2022 WL 17832492, at *33 n.14 (T.T.A.B. Dec. 20, 2022) (“A defendant cannot reserve unidentified defenses because that does not provide a plaintiff fair notice of such defenses.”). Therefore, the Applicant’s sixth affirmative defense should be stricken.

II. Conclusion

Accordingly, for the foregoing reasons, Opposer respectfully requests the Board strike the Applicant’s affirmative defenses, pursuant to Fed. R. Civ. P. 12(f).

Date: April 16, 2023

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that on April 16, 2023, I caused a true and correct copy of the Motion to Strike Applicant's Affirmative Defenses to be served by email upon Applicant's counsel of record with the TTAB:

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