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

Proceeding no.	91283434
Party	Defendant 1-Off Creative Concepts, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The Ohio State University,

Opposer,

v.

1-Off Creative Concepts, Inc.,

Applicant.

Opposition No. 91283434

Serial No.: 97/155.253

**APPLICANT’S OPPOSITION TO
OPPOSER’S MOTION TO STRIKE
APPLICANT’S AFFIRMATIVE
DEFENSES**

Applicant 1-Off Creative Concepts, Inc. (“Applicant”), by and through its undersigned counsel, hereby opposes the Motion to Strike Applicant’s Affirmative Defenses (5 TTABVUE, the “Motion”) filed by opposer The Ohio State University (“Opposer”).¹

Motions to strike are disfavored. In opposition actions before the TTAB, a motion to strike an affirmative defense should only be granted if it is clear that the defense will have no bearing on the proceeding, i.e. raises no “factual issues that should be determined on the merits.” TTAB Manual of Procedure (“TBMP”) § 506.01. That is not the case here. Applicant’s affirmative defenses amplify its denials and go principally to Opposer’s inability to prove critical elements of its own case. Such defenses are routinely accepted in an answering pleading, and Applicant is entitled to discovery to rebut elements of Opposer’s case.

Importantly, no purpose is advanced by striking Applicant’s affirmative defenses at this very early stage in the proceeding because Applicant’s affirmative defenses cannot, and do not, prejudice Opposer, nor does Opposer make any allegation of prejudice in its Motion.

Accordingly, Opposer’s Motion should be denied in its entirety.

¹ Notably, although Opposer refers to its “Block O Mark” in the singular, it claims two distinct marks, i.e. the “ ‘Block O’ mark in standalone and outlined formats.” (1 TTABVUE at 3, ¶ 7.) As only the outlined O is registered (*see id.* citing Reg. No. 4,458,983), Applicant refers to that mark as “Opposer’s Registered Mark” and the standalone O as “Opposer’s Unregistered Mark.”

I. **APPLICABLE LEGAL STANDARD**

“An answer may also include a short and plain statement of any defenses, including affirmative defenses [such as] unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, **or any other matter** constituting an avoidance or affirmative defense.” TBMP § 311.02(b) (emphasis added).

Motions to strike are generally disfavored by the TTAB and matters are generally not stricken unless they clearly have no bearing upon the issues in the case. TBMP § 506.01; *Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570, 1571 (TTAB 1988). “Motions to strike are generally disfavored because they are often used as a delaying tactic and because of the limited importance of pleadings in federal practice.” *Shaterian v. Wells Fargo Bank, N.A.*, 829 F. Supp. 2d 873, 879 (N.D. Cal. 2011). Given the disfavored status of the motions to strike, “courts often require a showing of prejudice by the moving party before granting the requested relief.” *Sanchez v. City of Fresno*, 914 F. Supp. 2d 1079, 1122 (E.D. Cal. 2012). “If there is any doubt whether the portion to be stricken might bear on an issue in the litigation, the court should deny the motion.” *Holmes v. Elec. Document Processing, Inc.*, 966 F. Supp. 2d 925, 930 (N.D. Cal. 2013). As a result, motions to strike are infrequently granted. *FRA S. p. A. v. Surg-O-Flex of Am., Inc.*, 415 F. Supp. 421, 427 (S.D.N.Y. 1976).

The primary purpose of pleadings under the Federal Rules of Civil Procedure is simply to give fair notice of the claims or defenses asserted. *See* TBMP § 506.01. Accordingly, the Board, in its discretion, may decline to strike even objectionable affirmative defenses where their inclusion will not prejudice the adverse party and will provide fuller notice of the basis for a claim or defense. *Id.*; *Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289, 1292 (TTAB 1999); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d

1221, 1223 (TTAB 1995) (affirmative defense not stricken as it was an amplification of applicant's denial of opposer's claims); *Harsco Corp.*, 9 U.S.P.Q.2d at 1571 (reasonable latitude in notice pleading permitted).

A defense “will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits.” TBMP § 506.01. Indeed, the Board specifically permits “Other Affirmative Pleadings –Amplifying Denials”:

An answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant’s denial of one or more of the allegations in the complaint. These amplifications of denials, whether referred to as “affirmative defenses,” “avoidances,” “affirmative pleadings,” or “arguments,” are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.

TBMP § 311.02(d) (citing cases).

Here, Applicant’s affirmative defenses are entirely appropriate and are sufficiently pled to put Opposer on notice of the nature of Applicant’s asserted defenses, and are related to the issues in this proceeding as framed by the parties’ pleadings. Moreover, even if the Board determines an affirmative defense is somehow insufficient, Opposer does not claim (let alone show) that it will suffer any prejudice from the inclusion of that affirmative defense, making it wholly unnecessary to strike any of the affirmative defenses from the Answer.

II. APPLICANT’S DEFENSES ARE PROPERLY PLED

A. The First Affirmative Defense is Proper

While the First Affirmative Defense is stated as failure to state a claim, it is in fact an assertion of an absence of likelihood of confusion. Such an assertion serves the function of amplifying Applicant’s denial of Opposer’s claim of likelihood of confusion and therefore should not be stricken. *See, e.g., Order of Sons*, 36 U.S.P.Q.2d at 1223 (finding no likelihood of

confusion is an adequate defense when “it is an amplification of applicant’s denial of opposer’s claims” and “gives opposer more complete notice of applicant’s position”). And, because this affirmative defense is merely the converse of the primary allegation by Opposer, which Opposer bears the burden of proving, there can be no prejudice to Opposer in retaining this defense. Therefore, there is no basis to strike this affirmative defense.

B. The Second, Third, Fourth, and Fifth Affirmative Defenses are Proper

The Second, Third, Fourth, and Fifth Affirmative Defenses relate to the weakness of Opposer’s asserted marks, including both Opposer’s Registered Mark (the outlined “O”) and Opposer’s Unregistered Mark (the standalone “O”; together “Opposer’s Marks”). The weakness of Opposer’s Marks bears upon key issues in this case. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 2015) (“The weaker an opposer’s mark, the closer an applicant’s mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection.”); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 U.S.P.Q.2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning.”); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Opposer does not and cannot argue that the relative strength/weakness of its marks (as raised by Applicant’s assertions *inter alia* that Opposer’s marks are “not famous” and “weak and thus entitled . . . only to a narrow scope of protection”) is not a key issue in this proceeding. Instead, Opposer attempts to construe all of Applicant’s affirmative defenses as “attack[ing] the

validity of a pleaded registration.” Motion at 5. Yet none of Applicant’s affirmative defenses attack Opposer’s marks as “invalid” (*see* Answer at 5), rendering Opposer’s authority inapposite. *Cf.* Motion at 5-6 (citing *Country Life, LLC v. Barlean’s Organic Oils, LLC*, Opp. No. 91231643, 2019 WL 4567854, at *4 (T.T.A.B. Sept. 18, 2019) (dealing with Applicant’s assertion that “Opposer’s mark is invalid . . .”).

Further, even to the extent some of these defenses might be construed as attacking the validity of the registration for Opposer’s Registered Mark (e.g. the third affirmative defense that Opposer’s Marks lack secondary meaning), such defenses remain pertinent and proper with respect to Opposer’s Unregistered Mark. Again, Opposer has asserted both a registered “outlined O” and a distinct, unregistered “standalone O” mark. (*See* 1 TTABVUE at 3, ¶ 7, setting forth the “‘Block O’ mark in standalone and outlined formats.”; *see also id.*, citing only one registration for the “outlined” format Reg. No. 4,458,983.) While the Notice of Opposition and the Motion refer to these two distinct marks as simply one “Block O Mark,” Opposer’s pleading makes clear that it is asserting both its registered “outlined O” mark and an unregistered “standalone O” mark. (*See id.*) Applicant may thus attack at least that unregistered mark as lacking secondary meaning, etc., as it did in asserting its affirmative defenses with respect to both of “Opposer’s Claimed Marks,” plural. (*See* 4 TTABVUE at 5, framing affirmative defenses with respect to “Opposer’s claimed common law mark (together with Opposer’s Registered Mark, ‘Opposer’s Claimed Marks’).”)

Although Opposer conflates its registered and unregistered rights in distinct “O” marks to claim that Applicant has somehow attacked only an incontestable, registered mark, both the third and the remaining affirmative defenses related to the relative weakness of Opposer’s Marks raise relevant fact issues at least as to Opposer’s Unregistered Mark, and so should not be stricken.

Nor does the supposed incontestability of Opposer's registration render the strength of its registered mark irrelevant. On the contrary, "[w]hile an incontestable registration may not be *challenged as invalid* for mere descriptiveness, for purposes of determining the inherent strength of a mark as a factor relevant to likelihood of confusion, incontestability does not preclude" finding an incontestable mark is descriptive. *Couch/braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 U.S.P.Q.2d 1458 (T.T.A.B. Mar. 24, 2014) (emphasis in original) (finding that "PERKS is descriptive" and the "weakness of the term 'Perks' . . . is an important factor," and holding that registered marks PERKS and PERKSCARD "are entitled to only a very narrow scope of protection or exclusivity of use" as "consumers are likely able to distinguish between different PERKS marks based on small differences in the marks"). In other words, although Opposer's pleaded incontestable registration cannot be cancelled based on descriptiveness, Applicant is not precluded from arguing that Opposer's Registered Mark is descriptive and, therefore, inherently weak. And here, again, Applicant's descriptiveness defense is certainly valid vis-à-vis Opposer's Unregistered Mark. Opposer has not provided any authority to the contrary, pretending that it has asserted only one registered mark when its pleading, in fact, asserts both a registered and an unregistered mark.

Inclusion of these affirmative defenses as to the strength of "Opposer's Claimed Marks" (i.e. both Opposer's Registered Mark and Opposer's Unregistered Mark), therefore, is proper. These affirmative defenses raise factual issues to be determined by the Board on the merits and provide Opposer with fuller notice as to Applicant's defenses regarding the weakness of Opposer's marks, including its asserted unregistered mark. Accordingly, there is no basis to strike these affirmative defenses.

C. The Sixth Affirmative Defense is Proper

Applicant's Sixth Affirmative Defense is a reservation of rights to assert additional affirmative defenses that may become apparent during the proceeding. Contrary to Opposer's position regarding Applicant's Sixth Affirmative Defense, Applicant properly pled a reservation of rights to provide notice to Opposer that if new evidence or facts arise through the course of discovery, Applicant will amend its Affirmative Defenses. *See Trenton Tech., Inc. v. Tronton LLC*, 91218360, 2016 WL 6833485, at *2 (TTAB 2016) (finding an affirmative defense comprised of "a reservation of rights to assert any affirmative defenses that may become apparent during the proceeding" need not be stricken).

III. OPPOSER WILL NOT BE PREJUDICED BY INCLUSION OF ANY OF THE AFFIRMATIVE DEFENSES

Even assuming Applicant's allegations in its affirmative assertions are somehow "objectionable" per TBMP § 506.01 (they are not), the Board "may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense." TBMP § 506.01 (citing cases).

Opposer has not claimed that it will be prejudiced by inclusion of any of the affirmative defenses. Nor can Opposer make such claims when the affirmative defenses asserted by Applicant merely provide fuller notice of its anticipated positions in defense of its right to registration. Indeed, no further effort is required from Opposer or the Board by leaving the affirmative defenses as they stand. By failing to argue prejudice, Opposer effectively concedes that it will not be prejudiced by inclusion of any of the affirmative defenses and the Board should decline to strike them on this basis alone. *Id.*

IV. CONCLUSION

For the reasons set forth herein, Applicant respectfully requests that Opposer's Motion be denied in its entirety. Opposer has fair notice of the basis for Applicant's defenses, with respect to both of its asserted registered and unregistered "O" marks. It will have plenty of opportunity to test the factual and legal merits of Applicant's defenses, as appropriate. No prejudice will occur if the Answer remains as it is. Accordingly, the Motion should be denied in its entirety.

Dated: May 8, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Applicant 1-Off Creative Concepts, Inc., in the above-captioned proceeding and that on the date which appears below, she caused a copy of the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES** to be served on the following, via electronic filing with the TTAB via ESTTA as well as via electronic mail:

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