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EJW

October 27, 2023

Opposition No. 91286753

*Gencor Industries, Inc.*

*v.*

*Arteris, Inc.*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

On October 27, 2023, Opposer (represented by Sheryl De Luca of Nixon & Vanderhye P.C.), Applicant (represented by Britt L. Anderson of Perkins Coie LLP), and Elizabeth Winter, the assigned Interlocutory Attorney, participated in a discovery conference regarding this proceeding pursuant to Trademark Rule 2.120(a), 37 C.F.R. § 2.120(a). This order sets forth a summary of the significant points addressed during the conference.<sup>1</sup>

**CONFERENCE SUMMARY**

Initially, the Board asked whether there exists any other Board proceeding or a civil action in Federal district court related to this proceeding. The Board also inquired as to whether the parties had engaged in any settlement discussions. The

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<sup>1</sup> The Board reminded the parties that the conference should not be recorded.

parties advised that there is no related Board proceeding or civil action, and the parties had not conducted any recent settlement discussions.

The Board recommended that should the parties engage in settlement discussions, one of the parties should submit a consent motion using ESTTA to extend or suspend the trial schedule.

Should any civil action between the parties or other Board proceeding be instituted related to these proceedings, the parties were required to so inform the Board so that it can determine whether suspension or consolidation is appropriate.

## **PLEADINGS**

Applicant seeks registration under Trademark Act Section 1(b) of the mark GENCORE in standard characters for various types of downloadable computer software related to integrated circuits, electrical and electronic components, and semiconductor IP cores and the like, in International Class 9, and for “development of new electronic technology for others in the fields of system-on-chip devices, integrated circuits, and functional design verification platforms for such devices and circuits; design and development of computer hardware and software for the electronics industry directed to system-on-chip devices and integrated circuits and for use by chip designers; engineering services in the field of system-on-chip devices and integrated circuits for others; computer systems analysis and product research and system-on-chip device and integrated circuit analysis, research and engineering services for others; computer software design and development services for others,” in International Class 42.

**A. Notice of Opposition**

Opposer has sufficiently pleaded its entitlement to a statutory cause of action, as well as claims of likelihood of confusion and dilution in opposition to the registration of the applied-for mark. In support of its claims, Opposer has pleaded, in part, ownership of six trademark registrations, including for the following marks:

- G GENCOR INDUSTRIES INC. & DESIGN, for asphalt manufacturing machines in International Class 7;
- GENCOR for electronic controls for hot mix asphalt production machines and weighing devices, namely, scales, and hot mix asphalt production machines and electronic controls therefor, sold as a unit, conveyors, conveyors with scales and thermal soil remediation machines, in International Class 9;
- GENCO ULTRA II & DESIGN for electronic controls for burners used in the production of hot mix asphalt and in the remediation of contaminated soils in International Class 9;
- G & FLAME DESIGN GENCOR (UNDERLINED & STYLIZED) for electronic control systems for hot mix asphalt production machines and electronic control systems for weighing devices, namely, scales, in International Class 9;
- GENCOR GREEN (STYLIZED) WITH TRIANGLE & TREE DESIGN for “electronic controls for industrial burners used in the production of hot mix asphalt and in the thermal remediation of contaminated soils; electronic

controls for thermal fluid heaters for heating asphalt for paving materials,”  
in International Class 9; and

- and related goods and services in International Classes 6, 7, 9, 11, 37, 40, 41 and 42, including “consultation and engineering in the field of asphalt production, soil decontamination and air pollution control; calibration services.”

Opposer also alleges that the parties’ goods and services are related and are likely to be offered to the same or overlapping classes of purchasers; that it owns rights accrued at common law in the mark GENCOR since June 1987, and through its predecessors in interest since January 1957; and that it has expanded its use of its trademarks to other services including transportation and servicing of contaminated soil remediation equipment and related consulting services, coal energy production, and road construction machinery.

Because Opposer attached TSDR printouts regarding its pleaded registrations, there is no issue as to priority with respect to the marks identified therein in connection with the goods and services identified in those registrations. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

However, to the extent that Opposer alleges common law rights in any of its six pleaded marks, those allegations will need to be proven at trial or on summary judgment.

## **B. Answer**

Applicant denies Opposer's salient allegations and has set forth putative affirmative defenses as follows:

**(1) Failure to State a Claim:** Applicant's first affirmative defense, "failure to state a claim upon which relief [can] be granted" is not a true affirmative defense; rather, it is an assertion that the plaintiff's pleaded claims are insufficiently pleaded, rather than setting forth a defense to a properly pleaded claim. *See, e.g., Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*4, n.5 (TTAB 2021) (citing *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at \*4 (TTAB 2021)); *Topco Holdings, Inc. v. Hand 2 Hand Indus., LLC*, 2022 USPQ2d 54, at \*10-11 (TTAB 2022) ("The asserted defense of failure 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.") (citing *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010)); *see also Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

In any event, because the Notice of Opposition is sufficiently pleaded, Applicant's first putative affirmative defense is **STRICKEN**. *See* Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a).

## **(2) Amplifications of Denials**

In paragraphs 2-4 of the Affirmative Defenses, Applicant has set forth allegations that constitute amplifications of Applicant's denials of Opposer's allegations. *See*

*Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant’s denial of opposer’s claims not stricken).

**(3) Reservation of right to add more defenses**

Applicant’s reservation of “the right to amend its Answer to add affirmative defenses or counterclaims that are not now known but may later become known through discovery or other means,” 5 TTABVUE 8, is also **STRICKEN** pursuant to Fed. R. Civ. P. 12(f). The putative right to add defenses is improper under the Federal Rules of Civil Procedure because that would not give Opposer fair notice of such defenses. *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at \*4 n.6 (TTAB 2021), *aff’d per curiam*, 2022 WL 3147202, No. 2021-2208, (Fed. Cir. Aug. 8, 2022); *see also FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) (“[A]ffirmative defenses that purport to reserve the right to add affirmative defenses at a later date ... are stricken because they are improper reservations under the Federal Rules.”).

Whether Applicant may, at some future point, amend its answer to include affirmative defenses and/or counterclaims would be resolved by way of a motion for leave to amend under Fed. R. Civ. P. 15(a).

**STIPULATIONS**

Various stipulations may be agreed to by the parties, either during the course of the conference or during the pendency of the proceeding. By way of example, the

parties may agree or stipulate in writing to the following measures to facilitate the progress of this proceeding:<sup>2</sup>

- Discovery depositions may be submitted in lieu of testimony depositions;
- The parties may agree to allow additional time to respond to discovery requests;
- Matter that is otherwise improperly submitted by a notice of reliance may be introduced by a notice of reliance;
- That a party may rely on its own discovery responses;
- That documents are deemed authenticated;
- That a notice of reliance can be filed after the testimony periods are closed;
- That electronic evidence will be exchanged in a certain manner; and/or

See TBMP §§ 403.01, 501, 704.03(b) and 705.

- **The parties agreed that each will acknowledge receipt of written discovery requests and responses received from the other party.**
- **Opposer agreed to consider Applicant's requests to stipulate to serve responsive documents in native format and to use a cloud-based service for transmitting documents produced during discovery.**

## **STANDARD PROTECTIVE ORDER**

The Board reminded the parties that the Board's standard protective order, which may be viewed on the Board's webpage, automatically applies to this proceeding and may be modified by the parties in writing. The parties may also submit an executed

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<sup>2</sup> Parties must inform the Board, by stipulation or motion, any time they agree to modify their obligations under the rules governing disclosures and discovery, as well as when they agree to modify deadlines or schedules that involve disclosures, discovery, trial or briefing. See TBMP §§ 403.01 and 501.02.

copy of the order. Should the parties modify the standard agreement, the Board requests that the parties identify which clause or provision has been modified.

### **INITIAL DISCLOSURES**

The Board reminded the parties that the next deadline in the proceeding is for serving their respective initial disclosures. Such disclosures should not be filed with the Board; they are served only on the adverse party. *See generally* TBMP § 401.02.

**Until the party seeking to serve discovery or to file a motion for summary judgment has served its initial disclosures, discovery may not be served, nor may a summary judgment motion be filed.**

### **EVIDENCE**

The parties were reminded that each party has a duty to preserve material evidence and to avoid spoliation or destruction of evidence.<sup>3</sup>

### **ACCELERATED CASE RESOLUTION (ACR)**

The Board recommended that the parties consider using the Board's Accelerated Case Resolution procedure. Should the parties need assistance to develop the

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<sup>3</sup>“While a litigant is under no duty to keep or retain every document in its possession ... it is under a duty to preserve what it knows, or reasonably should know, is relevant in the action, is reasonably calculated to lead to the discovery of admissible evidence, is reasonably likely to be requested during discovery and/or is the subject of a pending discovery request.” *Healthcare Advocates, Inc. v. Harding, Earley, Follmer & Frailey, et al.*, 497 F.Supp.2d 627, 639 (E.D. Pa. 2007) (addressing law firm’s failure to preserve temporary electronic files); *see also Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 100 USPQ2d 1904 (TTAB 2011) (“ESI must be produced in Board proceedings where appropriate, notwithstanding the Board's limited jurisdiction and the traditional, *i.e.*, narrow, view of discovery in Board proceedings”) (internal citations omitted).



appropriate stipulation, please contact the Interlocutory Attorney<sup>4</sup> who can assist the parties in doing so.

If the parties are interested in the summary judgment model of ACR, they would need to submit to the Board a stipulation on the following issues:

- that cross-motions for summary judgment and accompanying evidentiary submissions would substitute for a trial record and traditional briefs at final hearing;
- that the parties would forego trial; and
- that the Board may make determinations of genuine disputes of material fact on the basis of the final record and may issue a final ruling based thereon in accordance with the evidentiary burden at trial, that is, by a preponderance of the evidence.

The parties are advised that other approaches have been adopted by parties that realize the efficiencies sought through the ACR process and should, therefore, be considered as falling under the ACR umbrella. *See, e.g., Target Brands, Inc. v. Shaun N.G. Hughes*, 85 USPQ2d 1676 (TTAB 2007), in which the parties stipulated to 13 paragraphs of facts, including Applicant's dates of first use, channels of trade for Applicant, extent and manner of Applicant's use, recognition by others of Applicant's use, as well as the dates, nature and extent of descriptive use by the Opposer's parent; and the parties stipulated to the admissibility of business records, government documents, marketing materials and internet printouts.<sup>5</sup> Information concerning use of ACR in Board proceedings is available online at the following URL:

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<sup>4</sup> The parties should contact the assigned Interlocutory Attorney, Elizabeth Winter, at elizabeth.winter@uspto.gov or 571-272-9240.

<sup>5</sup> By way of example only, the parties may view ACR related stipulations and orders in the following cases on Ms. Winter's docket: Opposition No. 91222612 (see no. 14); Opposition No.

<http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

Additionally, the parties may find the following cases helpful in crafting their ACR stipulation, if any:<sup>6</sup>

1. 92068515: The parties agreed to the summary judgment model of ACR.
2. 92068150: The parties agreed to an informal discovery exchange and the summary judgment model of ACR, and stipulated to what the issues in dispute were. The petition to cancel was subsequently withdrawn.
3. 92068042: The parties agreed to make initial disclosures, forgo discovery, and use the summary judgment model of ACR.
4. 92068841: The parties agreed to waive initial disclosures, move up the discovery deadline, limit discovery, and use the summary judgment model of ACR.
5. 92068970: The parties agreed to a schedule for discovery and to use the summary judgment model of ACR.
6. 92069524: The parties agreed that they would produce documents with their initial disclosures, limit discovery, forgo expert testimony, and use the summary judgment model of ACR. The petition to cancel was subsequently withdrawn.
7. 92069629: The parties stipulated to the petitioner's standing and agreed to informally exchange documents, limit discovery, and use the summary judgment model of ACR.
8. 92069904 & 92069906: The parties stipulated to the petitioner's standing and agreed to limit discovery and use the summary judgment model of ACR.

**Trial dates remain as set in the Board's order issued on August 23, 2023.**

2 TTABVUE 3.

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91227798 (see no. 8); 91219403 (see no. 34); 91214266 (see nos. 5, 7 and 13); 92054446 (see no. 20 in case history); and 91199733 (see nos. 12 and 18 in case history). The parties are directed also to review *Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (Opposition No. 91214266, nos. 5 and 21).

<sup>6</sup> If the parties do not decide to use ACR early in the proceeding, it can be adopted later.