


ESTTA Tracking number: **ESTTA1348522**

Filing date: **03/26/2024**

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

Proceeding no.	91287935
Party	Plaintiff Genesco Brands LLC
Correspondence address	TYWANDA HARRIS LORD KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE STREET NE, SUITE 2800 ATLANTA, GA 30309 UNITED STATES Primary email: tlord@ktslaw.com Secondary email(s): tbillups@ktslaw.com, kteilhaber@ktslaw.com, tmad- min@ktslaw.com, spdesai@ktslaw.com 404-815-6500
Submission	Reply in Support of Motion
Filer's name	Erica C. Chanin
Filer's email	echanin@ktslaw.com
Signature	/Erica C. Chanin/
Date	03/26/2024
Attachments	2024.03.26 Reply to Applicants Opposition to Opposers_91287935.pdf(158071 bytes)

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

GENESCO BRANDS, LLC,)	
)	Serial No.: 97/338,936
Opposer,)	Mark:
)	
v.)	
)	Opposition No. 91287935
CHALK WARRIOR, LLC,)	
)	
Applicant.)	

REPLY TO APPLICANT’S OPPOSITION TO OPPOSER’S MOTION TO STRIKE

Pursuant to Sections 506.01 and 506.02 of this Board’s Manual of Procedure (TBMP), Opposer Genesco Brands, LLC (“Opposer” or “Genesco”) respectfully requests the Board to deny Applicant’s Opposition to Opposer’s Motion to Strike, and to enter an order striking Chalk Warrior, LLC’s (“Applicant”) affirmative defense (“Motion to Strike”)

I. INTRODUCTION AND PROCEDURAL BACKGROUND

On March 30, 2022, Applicant filed the Subject Application on the basis of Applicant’s use of the mark in commerce pursuant to 15 U.S.C. § 1051(a), and on May 2, 2023, the United States Patent and Trademark Office published the Subject Application in the Official Gazette in connection with “athletic apparel, namely, leotards, hooded sweatshirts, sweatpants, leggings, shirts” in International Class 25 and “providing a website that gives gymnasts the ability to create customized webpages featuring user-defined profiles and information about their careers” in International Class 42. On May 31, 2023, Genesco timely took a 90-day extension of time to oppose the Application. On August 28, 2023, Genesco took a second extension of time with Applicant’s consent. On October 30, 2023, Genesco timely filed a Notice of Opposition. *See*

Dkt. 1. On December 8, 2023 Applicant filed a consented motion to extend its deadline to file an Answer. *See* Dkt 5. On February 7, 2024 Applicant filed its Answer. *See* Dkt. 7. On March 1, 2024 Applicant filed a Motion to Strike the affirmative defense that Applicant asserts in its Answer, and on March 4, 2024 opposition proceedings were suspended pending disposition of Opposer’s Motion to Strike. *See* Dkt. 8, 9. Applicant filed an Opposition to Opposer’s Motion to Strike on March 21, 2024. *See* Dkt. 10.

II. ARGUMENT AND CITATION TO AUTHORITY

The Board may strike from any pleading any insufficient or impermissible defense or any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f); TBMP § 506.01. In fact, “the Board, upon its own initiative, ***and at any time***...may order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or scandalous matter. Thus, the Board, in its discretion, may entertain ***an untimely motion*** to strike matter from a pleading.” TBMP 506.02 (emphasis added); *see also Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222 (T.T.A.B. 1995) (“Rule 12(f) also provides that the court (or in this instance the Board) may act on its own initiative at any time to strike certain types of material from pleadings. The Board hereby exercises its discretion and we will review applicant's “affirmative defenses” pursuant to Rule 12(f).”).

As described in Opposer’s Motion to Strike, Applicant’s affirmative defense is not a valid affirmative defense, and it should be stricken. *See* Dkt. 8 at 2-4. Although Opposer’s Motion to Strike was filed on March 4, 2024, that detail should be immaterial to the Board’s independent assessment that the affirmative defense of “failure to state a claim” is not a true affirmative defense. *See John W. Carson Found. v. Toilets.com, Inc.*, 94 U.S.P.Q.2d 1942, 1949 (T.T.A.B. 2010) (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”); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 U.S.P.Q.2d 1733 at *6 n.7 (T.T.A.B. 2001). As previously stated, to the extent Applicant maintains that Opposer failed to state a claim in its Notice of Opposition, the proper vehicle would have been to file a motion to dismiss under Federal Rule of Civil Procedure 12, which Applicant has not done. As the board in *Order of Sons of Italy in America* exercised its discretion under Rule 12(f) and granted the opposer’s motion to strike the applicant’s affirmative defense that the notice of opposition fails to state a claim upon which relief can be granted, 36 U.S.P.Q.2d at 1222, so too should this Board grant Opposer’s motion to strike the identical affirmative defense.

III. CONCLUSION

For the foregoing reasons, Genesco respectfully requests that the Board deny Applicant’s Opposition to Opposer’s Motion to Strike Applicant’s Affirmative Defense, and that Applicant’s affirmative defense be stricken in its entirety.

Dated: March 26, 2024

Respectfully Submitted,

/Erica C. Chanin/
Tywanda H. Lord
Erica C. Chanin
Ta’lor Billups
Kilpatrick Townsend & Stockton LLP
1100 Peachtree Street NE, Suite 2800
Atlanta, Georgia 30309
(404) 815-6500
tlord@ktslaw.com
echanin@ktslaw.com
tbillups@ktslaw.com

Attorneys for Opposer

