

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

April 22, 2024

Opposition No. 91287935

Genesco Brands LLC

v.

Chalk Warrior, LLC

J. Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Opposer's March 1, 2024 motion to strike Applicant's affirmative defense.¹ The motion is fully briefed.

Background

¹ Opposer shall note the proper method of citation to the proceeding record. In its orders, the Board cites to the record by the TTABVUE docket entry number and TTABVUE page number. Each party should cite in this manner, wherever possible, throughout a proceeding. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 106.03, 110.02(b) and 801.01 (2023). *See also Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *15 (TTAB 2022) (failure to use the Board's method of citation to the record lengthened the time for review of the record and issuance of the Board's decision).

The certificates of service do not include the date on which service was made. Proof of service must include the date of service. Among other reasons, inclusion of the date aids in ascertaining the timeliness of any brief or response filed thereafter. Proof of service should also include the address(es) to which service was directed. As stated in TBMP § 113.03: "The Board will accept, as prima facie proof that a party filing a document in a Board inter partes proceeding has served a copy of the document upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, **clearly stating the date** and manner in which service was made. The statement should also specify the **name** of each party or person upon whom service was made, and the **address**, including the email address." (emphasis added).

On March 30, 2022 Applicant filed Serial No. 97338936, based on Trademark Act Section 1(a), to register the design mark shown below for the following International Class 25 goods: “Athletic apparel, namely, leotards, hooded sweatshirts, sweatpants, leggings, shirts.”² It alleges a date of first use of the mark anywhere, and date of first use in commerce, of November 29, 2020.



Opposer filed a notice of opposition on the ground of priority and likelihood of confusion under Trademark Act Section 2(d). In support thereof it alleges common law rights in the mark shown below (identified in the pleading as “Handprint Design Mark”) for “footwear, clothing, and other goods, as well as retail store services, since at least as early as December 31, 1987” (1 TTABVUE 4), as well as ownership of the following two registrations:

Registration No. 2054259, registered on April 22, 1997, for the mark shown below for “shoes and clothing, namely, shirts, T-shirts, sweatshirts, jackets, socks and hats” in International Class 25; and

Registration No. 3232063, registered on April 24, 2007, for the mark shown below for “retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 35.

² Applicant also seeks registration in International Class 42, a class which is not opposed herein.



In its answer filed on February 7, 2024, Applicant denied the salient allegations of the claim, and set forth matter identified as an affirmative defense as follows: “Opposer fails to state a claim on which relief may be granted.” 7 TTABVUE 4.

On March 1, 2024 Opposer filed a motion to strike the affirmative defense pursuant to Fed. R. Civ. P. 12(f).³

Opposer’s Untimely Motion

Trademark Rule 2.106(b)(2) provides for the pleading of various affirmative defenses in an answer to a notice of opposition. TBMP § 311.02. Pursuant to Fed. R. Civ. P. 12(f), which is made applicable to this proceeding by Trademark Rule 2.116(a),

The court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. The court may act: (1) on its own; or (2) on motion made by a party either before responding to the pleading or, if a response is not allowed, within 21 days after being served with the pleading.

Accordingly, a motion to strike matter from an answer should be filed within 21 days after service upon the moving party. *See also* TBMP 506.02.

Opposer’s motion was filed after the time allowed, and therefore is untimely. Applicant contests the motion on the basis of untimeliness. 10 TTABVUE 2.

³ Federal Rules of Civil Procedure cited in Board orders are applicable to Board proceedings under Trademark Rule 2.116(a).

Nonetheless, upon its own initiative, and at any time, the Board may, per the Rule, order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or scandalous matter. The Board may, in its discretion, entertain an untimely motion to strike matter from a pleading. *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995). TBMP § 506.01. Here, to advance this proceeding and assure focused discovery, the Board exercises its discretion to entertain Opposer's motion.

Authorities and Analysis

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id.* See also TBMP §§ 309.03 and 506.01. Thus, 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. *Morgan Creek Prod. Inc. v. Foria Int'l. Inc.*, 91 USPQ2d 1134, 1136 (TTAB 2009) (applicant's "affirmative defenses" for the most part amplified its denials of opposer's allegations regarding likelihood of confusion); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such).

Fed. R. Civ. P. 12(b)(6) permits a defendant to assert in its answer a "defense" of failure to state a claim, thereby allowing a plaintiff to test sufficiency of the defense by moving to strike the "defense" pursuant to Fed. R. Civ. P. 12(f). *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d at 1222. To be clear, the assertion that a pleading fails to state a claim upon which relief can be granted is not a true affirmative defense because it is an assertion of the sufficiency of a pleading, not a statement of a defense to a properly pleaded claim. *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010), citing *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001) ("[P]aragraph 11, which asserts that the notice of opposition fails to state a claim upon which relief can be granted, is not a true affirmative defense and shall not be considered as such."). See also *Blackhorse v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011) ("Failure to state a claim upon which relief can be granted is not an affirmative defense.").

A challenge to the sufficiency of a pleading should be brought by way of a motion to dismiss said pleading pursuant to Fed. R. Civ. P. 12(b)(6). Here, Applicant did not file a motion to dismiss. However, to fully ascertain the merits of the motion to strike, the Board has reviewed the notice of opposition for the sufficiency of the pleading.

Entitlement

Any person who believes it is or will be damaged by registration of a mark has an entitlement to a statutory cause of action to file a complaint. the U.S. Court of

Appeals for the Federal Circuit adopted the framework set forth by the U.S. Supreme Court in *Lexmark Int'l., Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061 (2014). *Lexmark* established two requirements for determining whether a party is entitled to bring or maintain a statutory cause of action: a party must demonstrate (i) an interest falling within the zone of interests protected by the statute, and (ii) proximate causation. *See, e.g., Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4-8 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671(2021); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *reh'g en banc denied*, 981 F.3d 1083, 2020 USPQ2d 11438 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021). Demonstrating a real interest in opposing or cancelling a registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Spanishtown Enterprises, Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020) (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *7 (Fed. Cir. 2020)). *See also* TBMP § 309.03(b).

As discussed below, Opposer alleges a claim of likelihood of confusion that is not wholly without merit, based on current ownership of registrations and prior use of a confusingly similar mark. Thus, it sufficiently alleges matter which, if proven, would establish Opposer's entitlement to a statutory cause of action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Grounds

To state a claim under Section 2(d), a plaintiff must allege, in addition to entitlement to a statutory cause of action, 1) it has proprietary rights from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights, and 2) the contemporaneous uses of the parties' respective marks on or in connection with their respective goods and services is likely to cause confusion, mistake or to deceive consumers as to the source of the goods and services. *Herbko Int'l., Inc., v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Here, Opposer alleges proprietary rights in its "Handprint Design Mark" by way of use of the mark in commerce in connection with "the advertising, promotion, distribution, and sale of footwear, clothing, and other goods, as well as retail store services, since at least as early as December 31, 1987," and alleges such rights are prior to Applicant's rights in the opposed mark. 1 TTABVUE 4. Opposer also alleges prior proprietary rights in the mark by pleading ownership of its two incontestable registrations (having underlying application filing dates prior to any date of first use on which Applicant can rely). *Herbko Int'l. Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1378.

Furthermore, in Paragraph 11 of its pleading, Opposer alleges Applicant's use of the opposed mark will be likely to cause confusion as to the source of the parties' goods and services. 1 TTABVUE 6.

In summary, Opposer sufficiently alleges a basis for entitlement, as well as the required elements of a ground for opposition. Thus, the notice of opposition states a claim upon which relief may be granted. In view of this, Opposer's motion to strike Applicant's purported affirmative defense is granted. The defense is stricken and will be given no consideration.

Resumption and Schedule

Proceedings are resumed. Conference,⁴ discovery and trial dates are reset as indicated below:

Deadline for Required Discovery Conference	5/13/2024
Discovery Opens	5/13/2024
Initial Disclosures Due	6/12/2024
Expert Disclosures Due	10/10/2024
Discovery Closes	11/9/2024
Plaintiff's Pretrial Disclosures Due	12/24/2024
Plaintiff's 30-day Trial Period Ends	2/7/2025
Defendant's Pretrial Disclosures Due	2/22/2025
Defendant's 30-day Trial Period Ends	4/8/2025
Plaintiff's Rebuttal Disclosures Due	4/23/2025
Plaintiff's 15-day Rebuttal Period Ends	5/23/2025
Plaintiff's Opening Brief Due	7/22/2025
Defendant's Brief Due	8/21/2025
Plaintiff's Reply Brief Due	9/5/2025
Request for Oral Hearing (optional) Due	9/15/2025

⁴ Inasmuch as the parties do not state they held their required discovery conference, the Board reset this deadline. In the event the parties did hold the conference, they have complied with this requirement.

Generally, the Federal Rules of Evidence, Federal Rules of Civil Procedure and Trademark Rules of Practice 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, matters in evidence, the manner and timing of taking testimony, 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); 37 C.F.R. § 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a); 37 C.F.R. § 2.129(a).

It is the responsibility of each party to ensure that the Board has the party's current correspondence address, including an email address, at all times during the proceeding. TBMP § 117.07.