ESTTA Tracking number: **ESTTA1394667**
Filing date: **11/08/2024**

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

Proceeding no.	91291070
Party	Defendant IMC B.V.
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Date	11/08/2024
Attachments	Response Motion to Strike IMC.docx.pdf(155761 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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INVESTORS MANAGEMENT CORPORATION, Opposer, v. IMC B.V., Applicant.	Opposition No. 91291070 Application Ser. No. 79349464 Marks: IMC INVESTMENTS

APPLICANT'S RESPONSE IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE

Applicant IMC B.V., by its counsel, hereby submits its response in opposition to Opposer's motion to strike[1] filed on October 22, 2024 (the "Motion").

I. Background

Applicant's affirmative defenses of acquiescence and estoppel are predicated on a consent and coexistence agreement (the "Trademark Consent and Coexistence Agreement") between Applicant and Opposer, Investors Management Corporation, in which Opposer expressly agreed that the parties' respective IMC marks are not confusingly similar and that it would not object to Applicant filing an application for IMC on its own or as part of a composite mark (without limitation). As a result, Opposer's likelihood of confusion claim is without merit.

The Trademark Consent and Coexistence Agreement finalized a prior TTAB dispute between the parties (see TTAB Cancellation No. 92068528). Opposer then

[1] Opposer is not moving to strike Applicant's affirmative defense based on prior registration. See FN 1 at 10 TTABVUE 2.

submitted the Trademark Consent and Coexistence Agreement into the USPTO record for Application Ser. No. 87263818 in order to overcome an Examiner refusal based on a prior registration owned by Applicant. The USPTO accepted the Trademark Consent and Coexistence Agreement, withdrew the refusal, and approved Opposer's application for registration. See USPTO record for Application Ser. No. 87263818.

In its Motion, Opposer claimed (1) that the Trademark Consent and Coexistence Agreement does not exist, (2) that the affirmative defense should be struck because Applicant failed to include the Trademark Consent and Coexistence Agreement with its Answer, and (3) that Opposer has not received fair notice. All of these claims are provably false and/or without merit.

First, the Trademark Consent and Coexistence Agreement does exist. As stated, Opposer even included it with its own USPTO trademark application (Application Ser. No. 87263818, September 11, 2018 entry) after resolving a prior TTAB dispute with Applicant. It is unclear why Opposer's counsel is unaware of its existence. Opposer's counsel did not reach out to Applicant's counsel to seek a copy of the alleged agreement prior to filing its Motion (and, to date, has not). The Trademark Consent and Coexistence Agreement is clearly in Opposer's possession (or at least was and should be) and Opposer made it publicly accessible via the USPTO database by including it in the record for one of its own trademark filings.

Moreover, Applicant is under no obligation to include any agreement with its Answer and affirmative defenses. As stated in TBMP Section 311.02(b)(1): "Evidentiary matters … should not be pleaded in an answer. They are matters for proof, not for pleading." *Citing McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17

(TTAB 1959).

Finally, Opposer has been on fair notice of Applicant's defenses since before it initiated the instant opposition. The parties were involved in lengthy settlement discussions with both U.S. and EU counsel involving the issues raised in this proceeding, including all defenses. These settlement discussions were ongoing when Opposer filed the instant opposition, and the parties agreed to several suspensions of the instant proceeding pending these settlement negotiations.

II. Analysis

An affirmative defense is "[a] defendant's assertion raising new facts and arguments that, if true, will defeat the plaintiff's or prosecution's claim, even if all allegations in the complaint are true." *H.D. Lee Co. v. Maidenform Inc.*, Opp. No. 91168309, 2008 WL 1976596, at *3 (TTAB 2008) *citing Black's Law Dictionary*, p. 430 (7th ed. 1999). A legally sufficient pleading of an affirmative defense must include enough factual detail to provide a plaintiff fair notice of the basis for the defense. Fed. R. Civ. P. 8(b)(1) and 12(f); *see DoorDash, Inc. v. Greenerside Holdings, LLC*, Opp. No. 91285160, 2024 WL 2723179, at *2 (TTAB 2024); *IdeasOne Inc. v. Nationwide Better Health Inc.*, Can. No. 92049636, 2009 WL 663070, at *2 (TTAB 2009); *Fair Indigo LLC v. Style Conscience*, Opp. No. 91175571, 2007 WL 4162785, at *3 (TTAB 2007); *Ohio State Univ.*, 1999 WL 517202, at *3 (noting that the primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); *Midwest Plastic Fabricators, Inc. v. Underwriters Labs. Inc.*, Can. No. 92015133, 1987 WL 123860, at *2 (TTAB 1980); see also TBMP § 311.02(b).

Contractual estoppel applies in Board proceedings where one party has agreed not

to challenge registration of another's mark. *See Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 1388 (CCPA 1974) (affirming granting of summary judgment dismissing the opposition due to the terms of the parties' settlement agreement); *see also Ron Cauldwell Jewelry Inc. v. Clothestime Clothes Inc.*, Opp. No. 91121784, 2002 WL 745591, at *5 (TTAB 2002) (Board ruling on summary judgment that the parties' agreement prevented opposer from objecting to registration of applicant's mark); *M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, Opp. No. 91109470, 2001 WL 1167788, at *9 (TTAB 2001) (considering whether opposer was contractually estopped from opposing registration of applicant's mark).

Whether the parties entered into an agreement that bars Opposer from opposing registration of Applicant's involved mark is a matter that falls within the jurisdiction of the Board. *Cf. Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 863 (Fed. Cir. 1985) (Board has jurisdiction to consider whether an agreement between the parties constitutes an independent basis for sustaining the opposition).

Applicant has sufficiently alleged its affirmative defense of contractual estoppel. Applicant alleges that (1) there is an agreement between Applicant and Opposer (2) in which Opposer consented to Applicant's use of the subject mark, (3) the parties agreed that their respective marks are not confusingly similar, and (4) that Opposer would not oppose Applicant's subject mark. These allegations are sufficient to provide Opposer with fair notice of the nature of Applicant's contractual estoppel defense. *Cf. Ron Cauldwell Jewelry, Inc.*, 2002 WL 745591, at *5 (agreement clearly stated that opposer had no objection to applicant's "use and registration" of the subject mark).

As noted, Opposer's assertion that the parties have never entered into an agreement is false, and that the agreement should have been included with Applicant's Answer is without any merit. At this stage, Applicant is merely required to allege enough factual detail to provide a plaintiff fair notice of the basis for the defense, which Applicant has done. *See Ohio State Univ.*, 1999 WL 517202, at *3 (noting that the primary purpose of pleadings "is to give fair notice of the claims or defenses asserted").

III. Conclusion

In view of the above, justice requires that Opposer's Motion to Strike be denied and Applicant be allowed to proceed with its affirmative defenses.

IMC B.V.

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Date: November 8, 2024

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was served upon Opposer this 8th day of November, 2024, by emailing a copy to:

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