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

Proceeding no.	91295794
Party	Plaintiff Penguin Random House LLC
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Submission	Motion to Strike Pleading/Affirmative Defense
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Date	02/06/2025
Attachments	Motion to Strike Answer to NOP -MATHLIBS.pdf(181250 bytes)

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

Marks Opposed: MATHLIBS
Applications Opposed: App. S.N. 98242543

PENGUIN RANDOM HOUSE LLC, Opposer, -against- JESSIKA JAKE, Applicant.	Opposition No. 91295794

MOTION TO STRIKE APPLICANT'S ANSWER
TO NOTICE OF OPPOSITION AND TO EXTEND ALL DEADLINES

Opposer Penguin Random House LLC ("Opposer"), pursuant to Federal Rule of Civil Procedure 12(f), Trademark Rules of Practice 2.106 and 2.127, 37 C.F.R. §§ 2.106 and 2.127, and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 506, hereby moves to strike in its entirety Applicant's Answer to Notice of Opposition and Affirmative Defenses filed by Applicant Jessika Jake ("Applicant") and to extend all deadlines in this case. The basis for the motion is set forth below.

STATEMENT OF FACTS

On December 18, 2024, Opposer, owner of the famous MAD LIBS trademark and multiple registrations for the same and other MAD LIBS-inclusive marks, filed its Notice of Opposition to Applicant's application to register the mark MATHLIBS for certain goods in International Classes 9 and 16 (Application Serial No. 98242543). (1 TTABVUE ("Notice of Opposition").) The Notice of Opposition sets forth a short and plain statement showing why Opposer believes it would be damaged by registration of the opposed mark, states the grounds for its opposition, and makes its

averments in twenty-eight (28) numbered paragraphs, consistent with the requirements of Federal Rule of Civil Procedure Rule 8(a) and Trademark Rule of Practice 2.104(a), 37 C.F.R. § 2.104(a).

On January 17, 2025, Applicant filed what she titled "Applicant's Answer to Notice of Opposition and Affirmative Defenses." (4 TTABVUE (the "Answer").) However, Applicant's Answer is *not* a proper answer under the applicable rules. The Answer specifically addresses only 13 of the 28 numbered paragraphs from Opposer's Notice of Opposition, namely paragraphs 1-13, and, moreover, it fails specifically to admit or deny the allegations contained in paragraph 2. (*See* Answer at ¶¶ 1-13.) As to the remaining 15 numbered paragraphs in Opposer's Notice of Opposition (*i.e.*, paragraphs 14-28), the Answer ignores and fails entirely to respond to them. The numbered paragraphs the Answer ignores include allegations that are important to this case, including, by way of example only, Opposer's allegations that it has priority and that its MAD LIBS trademark is famous. (*See* Notice of Opposition ¶¶ 15, 21-22, 24.) Nor does the Answer contain a general denial of the allegations in the Notice of Opposition. Instead, rather than admit or deny the majority of allegations contained in the Notice of Opposition, the Answer improperly seeks to argue the merits of the opposition. (*See* Answer at ¶¶ 14-30.)

ARGUMENT

A. The Requirements for a Proper Answer

Federal Rule of Civil Procedure 12(f) states in relevant part that "on motion made by a party . . . within 21 days after being served with the pleading . . . [t]he court may strike from a pleading any insufficient defense or any redundant [or] immaterial . . . matter." Fed. R. Civ. P. 12(f)(2). Here, because the Answer fails to comply with the relevant Federal Rules of Civil Procedure and Trademark Rules of Practice, it must be stricken in its entirety.

Trademark Rule of Practice 2.106(b)(2) states in relevant part that:

> An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial.

See also Fed. R. Civ. P. 8(b)(1)(A-B) & (5). TBMP § 311.01(a) further states that "[t]he answer *must* contain admissions and/or denials of the allegations in the complaint and may include any defenses to those allegations." (emphasis added).

Further, TBMP § 311.02(a) states that "[i]f the complaint consists of numbered paragraphs setting forth the basis of plaintiff's claim of damage, the defendant's admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint." *See also Sunrider Corp. v. Yangden Solar Holding Ltd.*, Opp. No. 91194464, 2010 WL 11413791, at *1 (T.T.A.B. Sept. 8, 2010) ("[I]t is incumbent on applicant to answer the notice of opposition by admitting or denying the allegations contained in each paragraph.")

Finally, it is well-established that "[t]he defendant should not argue the merits of the allegations in a complaint but rather should state . . . that the allegation is either admitted or denied." TBMP § 311.02(a).

B. Applicant's Answer Is Improper

Applicant's Answer does not comply with Federal Rule of Civil Procedure 8(b)(1), with Trademark Rule of Practice 2.106(b)(2), or with TBMP §§ 311.01(a) and 311.02(a).

The Answer does not admit, deny, or deny knowledge of each of "the averments upon which the opposer relies." Trademark Rule of Practice 2.106(b)(2); *see also* Fed. R. Civ. P. 8(b)(1)(B). It does not contain admissions and/or denials of *each* of the allegations in the Notice of Opposition in "numbered paragraphs corresponding to the numbered paragraphs in the

complaint." TBMP §§ 311.01(a), 311.02(a). Instead, it ignores the majority of Opposer's averments and numbered paragraphs and improperly seeks to argue the merits of this opposition in violation of TBMP § 311.02(a).

Although it is true that "[i]f a defendant intends in good faith to controvert all of the allegations contained in a complaint . . . the defendant may do so by general denial," TBMP § 311.02(a), Applicant has provided no such general denial in her Answer.

Because Applicant's Answer provides neither specific admissions nor denials of each of the allegations in the Notice of Opposition, Applicant has failed to satisfy the applicable rules of pleading and its Answer should be stricken in its entirety. *See Sunrider Corp.*, 2010 WL 11413791, at *1. Alternatively, Applicant should be deemed to have admitted each allegation not specifically denied. Fed. R. Civ. P. 8(b)(6); TBMP § 311.02(a); *see, e.g.*, *Westfield High Sch. L.I.F.E. Club v. City of Westfield*, 249 F. Supp. 2d 98, 102 n.4 (D. Mass. 2003) (treating defendant's failure to deny plaintiff's averments as admissions).

Moreover, the arguments and gratuitous factual allegations contained in Applicant's Answer, (*see* Answer at ¶¶ 14-30), violate Federal Rule of Civil Procedure 8(b)(1)(A) and Trademark Rule of Practice 2.106(b)(2), both of which require that an answer "state in short and plain terms" the applicant's defenses, if any. Because these gratuitous statements and arguments do not constitute any cognizable affirmative defense—and, instead, are asserted by Applicant "in support of [her] position", (*see id.* at p. 3), on the merits of the opposition—this material should be stricken, and Applicant should be admonished to not include such material in any amended Answer. *See, e.g.*, *McCormick & Co. v. Hygrade Food Prods. Corp.*, 124 U.S.P.Q. 16, 18 (T.T.A.B. 1959) (striking from answer list of third-party registrants and users).[1]

[1] Applicant's Answer also asserts two purported "Affirmative Defenses," namely that (1) Applicant has allegedly made "continuous use" of its MATHLIBS mark since 2004 and has

C. Dates Should Be Extended Until Applicant Filed a Proper Answer

Opposer further requests that the dates in this case, starting with the February 26, 2025 deadline for the discovery conference (*see* 2 TTABVUE at p. 3), be extended, with the discovery conference deadline reset for 30 days from the date by which Applicant is required to submit a proper answer to the proceedings and all other deadlines extended accordingly. Until a proper answer has been submitted in connection with this case, the parties cannot properly conduct a discovery conference or serve discovery addressed to the allegations, claims, and defenses actually raised by the parties.

CONCLUSION

For the reasons set forth above, Opposer's motion should be granted and Applicant's Answer should be stricken in its entirety. If the Board grants Applicant leave to file an amended answer, and if that answer once again fails to comply with the requirements of the relevant Federal Rules of Civil Procedure and Trademark Rules of Practice, Opposer respectfully requests that the Board refuse to accept the deficient answer and enter judgment in this opposition for Opposer.

"developed significant goodwill" in the mark ("First Affirmative Defense") and (2) purchasers of the parties' respective goods are allegedly "careful and sophisticated" ("Second Affirmative Defense"). (*See* Answer at pp. 2-3.) Neither of these are true affirmative defenses. *See, e.g.*, *Itty Bitty City, LLC v. Microduino, Inc.*, Opp. No. 91240993, 2019 WL 440239, at *1 (T.T.A.B. Sept. 12, 2019) (applicant's affirmative defense that consumers are "sophisticated and discerning" was "not [a] true affirmative defense"); *ETW Corp v. Sunburst Prods., Inc.*, Opp. No. 91111490, 2001 WL 12839, at *1-2 (T.T.A.B. Jan. 5, 2001) (applicant's affirmative defense that it "has used its existing mark . . . since at least as early as May 1986" was not a true affirmative defense and was "legally insufficient"). Applicant should be admonished to not include these purported "affirmative defenses" in any amended Answer. Moreover, the Answer purports to "reserves the right . . . to assert additional affirmative defenses" in the future. (*See* Answer at p. 3.) However, it is well-established that an "attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give . . . [Opposer] fair notice of such defenses." *Made in Nature, LLC v. Pharmavite LLC*, 2022 U.S.P.Q.2d 557, 2022 WL 2188890, at *3 (T.T.A.B. June 15, 2022).

Finally, Opposer requests that the discovery conference, opening of discovery, deadline for initial disclosures, and all other discovery and trial dates in this case be reset based on the deadline for Applicant to submit a proper answer to the Notice of Opposition.

Dated: New York, New York
February 6, 2025

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that, on this 6th day of February, 2025, a copy of the foregoing **MOTION TO STRIKE APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND TO EXTEND ALL DEADLINES** was sent by e-mail on counsel for Applicant as follows:

Alan Kendrick, Esq.
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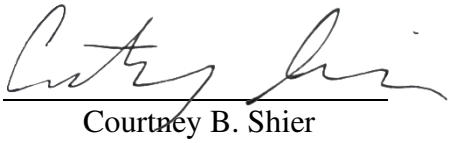

Courtney B. Shier