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

Proceeding	92061648
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Jerry's Famous Deli, Inc.,  
and Epicure With Love, LLC,**  
Petitioners,

Cancellation No.: 92061648  
Registration No.: 4,290,901  
Mark: **EPICURE CATERING**  
Registration Date: February 19, 2013

v.

**Epicure Catering, LLC,**  
Registrant.

**PETITIONERS' MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES  
AND INCORPORATED MEMORANDUM OF LAW**

Pursuant to the provisions of Rule 12(f), Fed.R.Civ.P., Petitioners, Jerry's Famous Deli, Inc. ("JFD") and Epicure With Love, LLC ("EWL") (collectively, "Petitioners"), respectfully move to strike each of the affirmative defenses asserted by Registrant, Epicure Catering, LLC ("Registrant")

**I. INTRODUCTION**

Petitioners filed their Petition to Cancel against Registrant on June 9, 2015 (Doc. No. 1), and Registrant filed its Answer to Petitioner's Petition to Cancel and Affirmative Defenses ("Answer") on July 16, 2015 (Doc. No. 4). Registrant's Answer included eight (8) boilerplate "Affirmative Defenses." As discussed below, each of Registrant's purported Affirmative Defenses is completely devoid of any factual support. The Affirmative Defenses are no more than bare-bone, conclusory assertions, lacking *any* details, let alone any facts sufficient to plead the elements necessary to establish each asserted defense. Because these bald allegations fail to give Petitioners fair notice of the defenses, Petitioners cannot ascertain what conduct Registrant claims gives rise to each purported defense or how the defenses are relevant to the proceeding.

Moreover, certain of the Affirmative Defenses are so legally insufficient that they would fail as a matter of law even if additional facts were alleged.

Put simply, Registrant's asserted Affirmative Defenses collectively amount to no more than a distraction from the merits of this case. Allowing Registrant to proceed with its vague, unsupported and legally deficient defenses will unnecessarily expand the scope of this proceeding, prejudice Petitioners and waste judicial resources. Accordingly, Petitioners respectfully request that the Board enter an Order striking Registrant's Affirmative Defenses in their entirety.

## **II. LEGAL STANDARD**

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. See also Trademark Rule 2.116(a) and TBMP § 506.01 (2014). A motion to strike should be filed within 21 days of service of an answer upon a party. Fed. R. Civ. P. 12(f). Registrant's Answer was filed July 16, 2015, so the instant Motion to Strike is timely.

Affirmative defenses, like claims in a petition for cancellation, must be supported by enough factual background and detail to fairly place the petitioner on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). A party must allege sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement,' to support its claims. *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009), quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

As noted above, none of Registrant's Affirmative Defenses are supported by *any* factual background and detail to fairly place Petitioners on notice of the basis for the defenses. Each defense is discussed below.

### **III. ARGUMENT**

#### **A. Registrant's "Failure to State a Claim," "No Damage" and "Priority" Affirmative Defenses**

Registrant's First Affirmative Defense alleges that the Petition to Cancel "fails to state a claim upon which relief can be granted." Registrant's Fourth Affirmative Defense alleges that Petitioners' claims are barred because "Petitioners have not and will not be damaged by the registration of the EPICURE CATERING trademark and therefore lack standing to petition to cancel the registration." Similarly, Registrant's Seventh Affirmative Defense alleges that Registrant's EPICURE CATERING trademark "has a priority date which predates Petitioner's [sic] first use date." These three of Registrant's asserted defenses are not true affirmative defenses because they relate to an assertion of the insufficiency of the pleading of Petitioners' claims rather than a statement of a defense to a properly pleaded claim. In view thereof, these asserted defenses should be stricken and not considered by the Board. *Mango's Tropical Cafe, Inc. v. Paradise Restaurant Group, Inc. of St. Augustine*, 2013 WL 9541236, \*2 (TTAB 2013), citing *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

An assertion of "no damage" goes to the question of standing. *See, e.g., Universal City Studios Inc. v. Cleveland Museum of Natural History*, 39 USPQ2d 1382, 1384 (TTAB 1996). Failure to state a claim upon which relief can be granted and lack of standing are not affirmative defenses. *See Harjo v. Pro Football Inc.*, 30 USPQ2d 1828, 1830 (TTAB 1994). Nevertheless,

because Registrant is permitted under Fed. R. Civ. P. 12(b)(6) to assert “failure to state a claim” as a defense, Petitioners may test the sufficiency of their pleading prior to trial by moving under Fed. R. Civ. P. 12(f) to strike the defense from the answer. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995).

In order to withstand the assertion that Petitioners have failed to state a claim for relief, Petitioners need only allege such facts as would, if proved, establish (1) that they have standing to maintain the proceeding, and (2) that a valid ground exists for opposing the mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). On the question of standing, a plaintiff need only demonstrate that it has a “real interest,” i.e., a personal stake, in the outcome of the proceeding and a reasonable basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A belief in likely damage can be shown by establishing a direct commercial interest. *See International Order of Job’s Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984). The purpose of the standing requirement is to avoid litigation where there is no real controversy between the parties, i.e., to weed out intermeddlers. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Here, Petitioners have pleaded JFD’s ownership of Registration Nos. 2,754,745 for **EPICURE** in standard characters and 2,787,801 for **EPICURE and Design**, registered in connection with “pre-packaged frozen entrees consisting primarily of meat, fish, poultry or vegetables, excluding shellfish,” in International Class 29; “pre-packaged frozen entrees consisting primarily of pasta or rice; bread,” in International Class 30; and “retail food store services,” in International Class 35. Petition to Cancel, ¶ 2. Additionally, Petitioners have

pleaded that JFD partnered with celebrity chef, author and culinary guru Michael Love, and formed EWL with the purpose of launching a new line of co-branded, all-natural gourmet food products under the mark **EPICURE WITH LOVE** (the “EWL Marks”), which incorporates JFD’s **EPICURE** Marks. EWL has since filed several U.S. trademark applications to register the **EWL** Marks (i.e., Application Serial Nos. 86/219,950; 86/219,974; 86/219,990; and 86/522,313), and, on or about January 15, 2015, the PTO refused certain of EWL’s pending applications on the basis of confusion with Registrant’s EPICURE CATERING trademark. *Id.*, ¶¶ 9, 13.

Petitioners’ respective trademark registrations and applications are sufficient to demonstrate their direct commercial interest in this proceeding and, therefore, their standing. *See Cunningham*, 55 USPQ2d at 1844. Moreover, JDF and EWL’s partnership further demonstrates that they have a “real interest,” i.e., a personal stake, in the outcome of the proceeding and a reasonable basis for their belief of damage. *Ritchie*, 50 USPQ2d at 1025. In the Petition to Cancel, Petitioners sufficiently pleaded their claim of priority and likelihood of confusion under Section 2(d). They have alleged a prior proprietary right, vis-à-vis Registrant, and that Registrant’s use of its mark in connection with related services is likely to cause confusion with Petitioners’ respective trademarks. *See* Petition to Cancel, ¶¶ 14-17. Accordingly, the First, Fourth and Seventh Affirmative Defenses should be stricken.

**B. Registrant’s “Laches,” “Unclean Hands,” “Waiver,” “Acquiescence” and “Estoppel” Affirmative Defenses**

Registrant’s Second Affirmative Defense alleges that Petitioners’ claims are barred by the doctrine of laches and unclean hands. Likewise, Registrant’s Third Affirmative Defense alleges that Petitioners’ claims are barred by the doctrines of waiver, acquiescence, and estoppel.

As a preliminary matter, the availability of the affirmative defenses of laches, estoppel, and acquiescence are "severely limited in Board proceedings." TBMP § 311.02(b); *see also Turner v. Hops Grill and Bar, Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999).

Registrant's cobbled Second and Third Affirmative Defenses are not supported by *any* factual background and detail to fairly place Petitioners on notice of the basis for the defenses. "[I]nstead of merely pleading the legal conclusion of laches, [waiver, acquiescence, and estoppel], [Registrant] should plead facts in connection with this defense which, if proven, would entitle [Registrant] to prevail on th[ese] affirmative defense[s]." *Rooibos Ltd. v. Forever Young (Pty) Ltd.*, 2003 TTAB LEXIS 65, \*15 (TTAB Feb. 13, 2003)(granting motion to strike affirmative defenses).

Even if Registrant had alleged *any* factual background to supports its defenses based on Petitioners' purported delay, such defenses would still remain futile. Under *National Cable Television Ass'n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991), it is well settled that laches runs from the date of publication of the challenged mark. As a matter of law, laches in this Cancellation proceeding may only run from the date of publication of Registrant's EPICURE CATERING mark (i.e., December 4, 2012). Here, the Petition to Cancel was filed less than three years after the mark was published for opposition. Because Registrant does not assert, nor can it, that Petitioners should be precluded from now seeking cancellation as the result of any delay in opposing the EPICURE CATERING mark or in seeking earlier cancellation, Registrant's affirmative defense is legally insufficient and should be stricken. *Rooibos*, 2003 TTAB LEXIS 65 at \*15; *see also Ohio State Univ.*, 51 USPQ2d at 1295 (striking laches affirmative defense).

With respect to Registrant's Affirmative Defenses of acquiescence and estoppel, the Board's decision in *DAK Industries Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622 (TTAB 1992) requires some affirmative act by Petitioners that would lead Registrant to reasonably believe Petitioners would not oppose Registrant's registration of EPICURE CATERING. *Id.* at 1625. Again, Registrant does not allege, nor could it, any activity or conduct by Petitioners that could constitute an affirmative act on which Registrant relied to its detriment. *See Software Dev. Solutions, Inc. v. Aircast Mobile, Inc.*, 2013 TTAB LEXIS 573, \*18 (TTAB Oct. 30, 2013)(citing *CBS, Inc. v. Man's Day Publishing Company, Inc.*, 205 USPQ 470, 473-474 (TTAB 1980) (to establish the defense of acquiescence, a defendant must prove that the plaintiff's conduct amounted to "an assurance by the plaintiff to the defendant, either express or implied that the plaintiff will not assert his trademark rights against the defendant.")).

Turning to Registrant's allegations of unclean hands, such a defense must be supported by specific allegations of misconduct by the plaintiff that, if proved, would prevent the plaintiff from prevailing on its claim. *See Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987). Furthermore, the misconduct must be related to the plaintiff's claim. *See Tony Lama Co., Inc. v. Di Stefano*, 206 USPQ 176, 179 (TTAB 1980). It is insufficient to simply assert that Petitioners are guilty of unclean hands without pleading any specific allegations to support such claims. But, even if more specific allegations had been pleaded, the defense is inapplicable herein as Registrant's claims of unclean hands are unrelated to Petitioners' claims of priority and likelihood of confusion. *See Andale Energy Drink Co., LLC v. ACP IP, LLC*, Opposition No, 91217782 (May 11, 2015)(unreported). In view thereof, Registrant's Second and Third Affirmative Defenses should be stricken.



### C. Registrant's "Not Famous" Affirmative Defense

Registrant's Fifth Affirmative Defense alleges that "Petitioner's [sic] mark is not famous within the meaning of Section 43(c) of the Lanham Act, and thus it does not qualify for anti-dilution protection." Registrant's "defense" – which references dilution and is **wholly irrelevant** to the likelihood of confusion issue before the Board<sup>1</sup> – is merely a conclusory statement about the alleged status of Petitioners' trademark(s), without amplifying the reasons behind Registrant's conclusion. Thus, the Fifth Affirmative Defense does not fulfill the requirement of alleging "sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement.'" *Ashcroft*, 556 U.S. at 663, quoting *Twombly*, 550 U.S. at 570. Consequently, Petitioners respectfully request that the Board strike Registrant's Fifth Affirmative Defense.

### D. Registrant's "Fraud" Affirmative Defense

Registrant's Sixth Affirmative Defense alleges "Petitioner's [sic] marks are procured by fraud and thus invalid." Allegations of fraud must satisfy the heightened pleading standard of Federal Rule of Civil Procedure 9(b) to survive a motion to dismiss (or strike). *See* Fed. R. Civ. P. 9(b). Rule 9(b) provides that: "In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally." *Id.* "Because fair notice is perhaps the most basic consideration underlying Rule 9(b), the plaintiff who pleads fraud must reasonably notify the defendants of their purported role in the scheme." *Siever v. BWGaskets*,

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<sup>1</sup> *See Blue Collar Records, Inc. v. Lawron, LLC*, 2013 TTAB LEXIS 272, \*4 (TTAB May 24, 2013) ("Applicant also asserts that opposer's mark is not famous under Section 43(c), **which pertains to a dilution claim not present in this case.**") (emphasis added). The instant proceeding does not include assertion of a dilution claim by Petitioners.

*Inc.*, 2009 U.S. Dist. LEXIS 20691, \*6-7 (M.D. Fla. Mar. 2, 2009)(citing *Vicom, Inc. v. Harbridge Merch. Servs., Inc.*, 20 F.3d 771, 777-78 (7th Cir. 1994)).

The Federal Circuit has addressed the fraud issue as follows:

[A] trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the U.S. Patent and Trademark Office.

*In Re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009). The *Bose* Court held that a subjective intent to deceive the Trademark Office must be proven through “clear and convincing evidence.” *Id.* at 1244. “Unless the challenger can point to an evidence of an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim.” *Id.* Moreover, it is not enough to merely establish that a statement is false; the statement must also be material and known to be false. “The falsity and intent prongs are separate, so absent the requisite intent to mislead the USPTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation.” *Spin Master, Ltd. v. Zobmondo Entm’t, LLC*, 2011 U.S. Dist. LEXIS 25261, at \*21 (C.D. Cal. Feb. 22, 2011)(internal citations omitted); *see also King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009)(“[A]llegations fail to meet the Fed. R. Civ. P. 9(b) requirements as they are unsupported by any statement of facts providing the information upon which petitioner relies or the belief upon which the allegation is founded (i.e., known information giving rise to petitioner's stated belief, or a statement regarding evidence that is likely to be discovered that

would support a claim of fraud.”); 5A Fed. Prac. & Proc. Civ.3d § 1298 (April 2013) (discussing particularity requirement of Fed. R. Civ. P. 9(b)).

Again, Registrant’s Sixth Affirmative Defense is not supported by *any* factual background and detail to fairly place Petitioners on notice of the basis for the defense. Thus, Registrant cannot, as a matter of law, maintain its affirmative defense of fraud.

#### **IV. CONCLUSION**

For the foregoing reasons, Petitioners respectfully request that the Board enter an Order **GRANTING** the instant Motion to Strike.

Date: July 20, 2015

Respectfully submitted,

**FRIEDLAND VINING**

/s/ David K. Friedland

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**CERTIFICATE OF SERVICE**

**WE HEREBY CERTIFY** that the foregoing **PETITIONERS' MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES AND INCORPORATED MEMORANDUM OF LAW** was served upon the Registrant by delivering true and correct copies of same to Registrant's counsel via U.S. mail on July 20, 2015, as follows:

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/s/ David K. Friedland  
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