

ESTTA Tracking number: **ESTTA687157**

Filing date: **08/03/2015**

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

Proceeding	92061648
Party	Defendant Epicure Catering, LLC
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Date	08/03/2015
Attachments	2015-08-03 Response to Motion to Strike Affirmative Defenses.pdf(134606 bytes)

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

In the Matter of Registration No:
4,290,901

For the mark EPICURE CATERING

JERRY'S FAMOUS DELI, INC. and
EPICURE WITH LOVE, LLC,

Petitioners,

vs.

EPICURE CATERING, LLC
Respondent.

Cancellation No. 92061648
*Response to Motion to
Strike Affirmative Defenses*

RESPONDENT'S RESPONSE TO MOTION TO STRIKE AFFIRMATIVE DEFENSES

Respondent EPICURE CATERING, LLC, by and through its undersigned counsel, and in response to Petitioners' Motion to Strike Registrant's Affirmative Defenses filed in this proceeding, submits as follows:

BACKGROUND

On June 9, 2015, Petitioners filed a Petition to Cancel the Respondent's EPICURE CATERING registered trademark. The Respondent then filed its Answer to Petitioners' Petition to Cancel and Affirmative Defenses ("Answer") on July 16, 2015. Respondent's Answer included eight (8) Affirmative Defenses ("Affirmative Defenses"). On July 21, 2015, the Petitioners filed a Motion to Strike Respondent's Affirmative Defenses.

The Petitioners' Motion to Strike Respondent's Affirmative Defenses must be denied because Petitioners have failed to demonstrated that the Affirmative

Defenses are (1) devoid of any factual support, (2) legally insufficient, and that (3) Petitioners do not have fair notice of the defenses.

ARGUMENT

A. Standard on Motion to Strike

Pursuant to Fed. R. Civ. P. 12(f), the Board may strike from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. TTAB Manual of Procedure (“TBMP”) § 506.01. However, motions to strike are disfavored by the TTAB. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). Thus, motions to strike are infrequently granted. *FRA S.p.A v. Surgo-O-Flex of America, Inc.*, 194 USPQ 42 (SDNY 1976).

The primary purpose of pleadings under the Federal Rule of Civil Procedure is simply to give fair notice of the claims or defenses asserted. TBMP § 506.01.

Accordingly, the Board, in its discretion, 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. TBMP § 506.01; *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1299 (TTAB 1999). Further, an affirmative defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it **raises factual issues that should be determined on the merits**. TBMP § 506.01; *Harjo v. Pro Football Inc.*, 30 USPQ2d 1828 (TTAB 1994).

Because the Affirmative Defenses clearly have bearing upon this proceeding and raise factual issues that should be determined on the merits, Respondent respectfully submits that the Petitioners’ Motion to Strike should be denied.

B. Respondent’s Affirmative Defenses are Sufficient and Relate to Factual

Issues in this Matter

1. “Failure to State a Claim,” “No Damage” and “Priority” Affirmative Defenses

Petitioners’ state in their Motion that Respondent’s First, Fourth, and Seventh Affirmative 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” and request that these asserted defenses be stricken and not considered by the Board.

With regard to the First Affirmative Defense (the Petition to Cancel fails to state a claim upon which relief may be granted) and the Fourth Affirmative Defense (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) asserted in Respondent’s Answer, there are questions of fact and law concerning whether the claim has been fully pleaded in this proceeding. Specifically, the Petitioners’ have not sufficiently demonstrated a “real interest” in the outcome of this proceeding that would establish a reasonable basis for its belief of damage. Unlike Petitioners’ EPICURE (Reg. No. 2,754,745) and EPICURE and Design (Reg. No. 2,787,801) marks for “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, Respondent’s EPICURE CATERING mark is for “Services for providing food and drink, namely, **servicing food and drinks, providing of food and drinks for guests,**

catering of food and drinks” in International Class 43. Thus, Petitioners’ have insufficiently pleaded that they have standing to maintain the proceeding, and that they have a valid ground exists for opposing the mark. Accordingly, these two Affirmative Defenses should be maintained.

With regard to the Seventh Affirmative Defense (respondent’s mark has a priority date which predates Petitioner’s first use date) asserted in Respondent’s Answer, Respondent denied all allegations relating to Petitioners’ pleading their claim of priority and likelihood of confusion under Section 2(d). *See Answer* ¶ 14 and ¶ 16. Since this matter has a direct bearing on the issues of the proceeding and because this matter raises factual issues that should be determined on the merit, this Affirmative Defense should be maintained.

**2. “Laches,” “Unclean Hands,” “Waiver,” “Acquiescence,” and “Estoppel”
Affirmative Defenses**

Petitioners’ state in their Motion that Respondent’s “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.” In addition, the Petitioners’ argue in their Motion that 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).”

With regard to the Second Affirmative Defense (the claim set forth in the Petition to Cancel is barred in whole or in part by the doctrine of laches and unclean hands) and the Third Affirmative Defense (the claim set forth in the Petition to Cancel is barred in whole or in part by the doctrines of waiver, acquiescence, and

estoppel) asserted in Respondent's Answer, these are factual issues that should be resolved on the merits. For example, even though the Petition to Cancel was filed less than three years after the mark was published for opposition, laches can succeed as a defense even if only a relatively short period of time has elapsed from the publication of a mark to assertion of a claim of infringement. *Ava Ruha Corp. d/b/a Mother's Market & Kitchen v. Mother's Nutritional Center, Inc.*, 113 U.S.P.Q.2d 1575 (TTAB, Jan. 29, 2015) (TTAB held that a petitioner's three-year, two-month delay in petitioning to cancel the respondent's trademark registrations was unreasonable and sufficiently support respondent's laches affirmative defense). Accordingly, these two Affirmative Defenses deal with questions of fact and should be maintained.

3. "Not Famous" Affirmative Defense

Petitioners' state in their Motion that Respondent's Fifth Affirmative Defense is "merely a conclusory statement about the alleged status of Petitioners' trademark(s), without amplifying the reasons behind Registrant's conclusion."

With regard to the Fifth Affirmative Defense (petitioner's 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) asserted in Respondent's Answer, this is also a factual issues that should be resolved on the merits. In the Petition to Cancel, the Petitioners' specifically stated that their EPICURE marks are famous trademarks. *See Petitioners' Petition to Cancel* ¶ 4 and ¶ 8. Respondent expressly denied these allegations in its Answer. It is well-established that whether acquired distinctiveness has been established in a mark is a question of fact. TMEP § 1212.01; *In re Loew's Theatres, Inc.*, 769 F.2d 764, 769-70, 226 USPQ 865, 869 (Fed. Cir. 1985).

Thus, this Affirmative Defense raises factual issues and should be maintained.

4. “Fraud” Affirmative Defense

Petitioners’ state in their Motion that Respondent’s Sixth Affirmative Defense “is not supported by an factual background and detail to fairly place Petitioners on notice of the basis for the defense.”

With regard to the Sixth Affirmative Defense (Petitioner’s marks are procured by fraud and thus invalid) asserted in Respondent’s Answer, this defense raises factual issues that should be determined on the merits. Thus, Respondent respectfully submits that this Affirmative Defense should be maintained.

Based on the Respondent’s denials to the claims and allegations in the Petition to Cancel Respondent’s EPICURE CATERING trademark, there are questions of fact and law concerning said claims and allegations. Respondent’s Affirmative Defenses are all related to these claims and allegations. Given these factual disputes, striking these Affirmative Defenses would be inappropriate.

For the reasons set forth hereinabove, the Petitioners’ Motion should be denied.

C. Respondent Should be Given Leave to Amend its Pleadings

A party may amend its pleading by leave of the Board and leave must be freely given when justice so requires. Fed. R. Civ. P. 15(a). The Board grants leave to amend the pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *Boral Ltd. V. FMC Corp.*, 59 USPQ 1701 (TTAB 2001). To

the extent the Board finds that Respondent's Affirmative Defenses are not pled with requisite particularity, the Respondent requests the Board for leave to amend these Affirmative Defenses.

CONCLUSION

The Respondent respectfully requests that the Board deny Petitioners' Motion to Strike Affirmative Defenses.

Alternatively, to the extent that this Board concludes that the Respondent has not satisfied applicable pleading requirements regarding any of its Affirmative Defenses, Respondent requests the Boards for leave to amend those Affirmative Defenses.

Respectfully submitted,

TRAVERSE LEGAL, PLC

A handwritten signature in black ink, appearing to be 'ES', enclosed within a large, stylized circular flourish.

Date: July 30, 2015

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CERTIFICATE OF SERVICE

I hereby certify that service of the foregoing ***RESPONDENT'S RESPONSE TO MOTION TO STRIKE AFFIRMATIVE DEFENSES*** which was filed electronically on this date with the TTAB, was made on this 3rd day of August , 2015, by delivering a true and correct copy of same via U.S. First Class Mail postage prepaid, and also via email to the following:

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