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

Proceeding	92064261
Party	Defendant John Groat dba Holly Shirt!
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Submission	Request for Reconsideration of Non-Final Board Order
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration Serial No. 4,099,565

-----X
Michael Spitzbarth,

Petitioner,

Cancellation No.
92064261

-vs-

JOHN GROAT
D/B/A HOLY SHIRT!,

Registrant.

-----X
**REGISTRANT'S MOTION FOR RECONSIDERATION OF THE BOARD'S DECISION
DATED JUNE 20, 2017**

Registrant, John Groat, (hereinafter "Groat") hereby moves for reconsideration of the Board's decision dated June 20, 2017 (hereinafter "Decision") in which Groat's motion for summary judgment was denied. Requesting reconsideration is permitted by 37 C.F.R. 2.127(b) and TBMP 518.

Overview

The Board committed clear error by noting that the summary judgment motion attacked Petitioner's standing, errantly pronouncing that the lack of standing is an affirmative defense that must be pleaded by Groat, noting that Groat had not pleaded in his answer or otherwise any purported affirmative defense of lack of standing, and denying the summary judgment motion on the sole basis that "A party may not obtain summary judgment on an issue that has not been pleaded."

Contrary to the Board's pronouncement, the TTAB has repeatedly held that lack of standing is not an affirmative defense and therefore need not be pleaded, that if a defense of lack of standing is asserted, it will be stricken, and that a party may attack an adverse party's standing without having pleaded a lack of standing in its answer or otherwise.

Groat asks the Board to vacate its Decision and address the merits of his motion for summary judgment.

Detailed Argument

The Decision pronounces that “Respondent did not plead any affirmative defenses, much less the affirmative defense that Petitioner did not have a *bona fide* intent to use his pleaded mark in commerce when his pleaded application was filed, that said application is void *ab initio* and, therefore, Petitioner has no standing. A party may not obtain summary judgment on an issue that has not been pleaded.”

In footnote 3 of the Decision, the Board correctly notes that a petitioner for cancellation must not only *formally allege or plead* a proper basis for standing, but also is required to *prove* that the petitioner actually possesses such standing. It has never been the law that if a Petitioner sufficiently *pleads* standing, then it is up to the registrant to *disprove* standing. Rather, as correctly recognized by the Board in the Decision, the burden is always on the petitioner to *prove* the sufficiency of its standing throughout the proceedings, through and including trial.

The issue about whether the lack of standing is an affirmative defense was not raised in Groat’s motion, the Petitioner’s opposition, or Groat’s reply. The Board seems to have been misdirected by Petitioner’s separate, later-filed cross-motion for summary judgment seeking judgment to the effect that Petitioner does have standing. Although Groat filed no opposition to that cross-motion, Petitioner filed a reply.¹ The Board noted in footnote 3 of its Decision that Petitioner’s (illegitimate) reply raised the idea that Groat’s attack on Petitioner’s standing was allegedly an affirmative defense that had not been pleaded. Thus, Groat never had an opportunity to address the issue of whether lack of standing is an affirmative defense. Nevertheless, the Board forged its Decision based solely on that issue.

As an initial overview of the applicable law, although the Federal Rules of Civil Procedure (see Fed. R. Civ. P. 8(c)) and the TBMP (see TBMP 311.02(b)) list a host of affirmative defenses, lack of standing is not among them. In *Nobelle.com, LLC v. Qwest Communications International, Inc.*, Cancellation No. 92030454, the TTAB issued a decision citable as precedent dated February 4, 2003 holding in part:

Turning now to the merits, we first find that petitioner has failed to establish its standing to bring this cancellation proceeding. Contrary to petitioner’s argument, respondent did not waive its right to challenge petitioner’s standing by waiting until its brief on the case to do so. **“Lack of standing” is not an affirmative defense;** rather, standing is an essential element of petitioner’s case which, if it is not proved at trial, defeats petitioner’s

¹ Groat filed a motion to strike the reply as being improper where no opposition was filed.

claim. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *No Nonsense Fashions, Inc. v. Consolidated Foods Corporation*, 226 USPQ 502 (TTAB 1985).

(emphasis added). If a registrant sets forth an affirmative defense of a petitioner's lack of standing, the TTAB will strike that pleading since lack of standing is not an affirmative defense:

2. Second Affirmative Defense - Petitioners lack standing. **Lack of standing is not an affirmative defense.** Standing is an element of petitioners' claim. Petitioners must prove standing as part of their case. In view of the foregoing, the second affirmative defense is stricken. See *Harjo v. Pro Football Inc.*, 30 USPQ2d at 1830.

Blackhorse v. Pro Football, Inc., 98 USPQ2d 1633, Cancellation No. 92046185 (TTAB May 5, 2011) (may be cited as precedent; emphasis added).

Footnote 7 in Petitioner's (illegitimate) reply to its own cross-motion cites to the *Garbinicius* case for the proposition that lack of standing is an affirmative defense. However, that case is based on Fed. R. Civ. P. 9(a), which Rule deals solely with pleading the "special matters" of a party's capacity to be sued or bring suit, a party's authority to be sued in a representative capacity, and the legal existence of an organized association of persons that is made a party – none of which is relevant here. Additionally, Petitioner's footnote cites the *Society of Lloyds* case which is also far from being on point. The Decision relies on neither the *Garbinicius* case nor the *Society of Lloyds* case for its pronouncement that the lack of standing is an affirmative defense that must be pleaded. Indeed, the Decision fails to cite to any authority for such a proposition. The failure to cite to any authority is understandable since no such authority exists, and the overwhelming authority is to the contrary.

A petitioner always has the burden of not only going forward initially with some proof that the petitioner has sufficient standing, but also ultimately persuading an adjudicator that the petitioner in fact possesses standing by the appropriate standard of proof after the adjudicator considers and weighs all of the evidence on that issue. After a petitioner presents its initial evidence in an attempt to show standing and the registrant has been able to cross-examine and impeach the petitioner's witnesses and after a registrant is allowed to present impeaching or other contrary evidence to the effect that standing does not exist, the overall evidence can warrant the adjudicator's finding that standing does not exist. The evidence contrary to standing is not something that must be set forth in an affirmative defense. Otherwise a defendant would need to set forth in an affirmative defense every flaw, contradiction, inconsistency, and other

reason why each one of a plaintiff's elements of proof are suspect -- obviously, and for good reason, such is not the law. Rather, affirmative defenses are those issues on which a defendant bears the burden of going forward with proof and persuasion and which are separate and distinct from the issues on which the plaintiff bears such burdens. The burden of proving standing never shifts to the registrant, and there is never a burden on the registrant to disprove standing.

Here, when Petitioner alleges and even provides evidence of a filed application that has been blocked the Registrant's registration, Registrant is entitled to chip away at and present evidence contradicting the evidence proffered by Petitioner, including such evidence as Petitioner did not own the application, or that the application was fatally defective. Although once Petitioner makes a *prima facie* showing that it owns such an application, Registrant is entitled to proffer evidence contradicting and rebutting such proof. The presentation of such contradictory and rebuttal evidence is not an affirmative defense; it is simply other evidence relevant to the standing issue -- in this instance, evidence that as a matter of law destroys Petitioner's alleged standing.

In this cancellation proceeding, Petitioner alleged/pleaded standing by asserting that his application for registration, filed on an intent to use basis and supported by a declaration that Petitioner had a *bona fide* intention to use the trademark (in connection with all the recited goods) as of the filing date of the application, was blocked and denied registration by the existence of Groat's registration. Regardless of whether the Petitioner sufficiently *pleaded* standing, the discovery in this cancellation proceeding evidenced that Petitioner would be unable to carry its burden of proving its standing after a consideration of all of the evidence. Registrant's discovery was pin-pointed to extract evidence of Petitioner's purported *bona fide* intention to use the trademark forming a necessary basis for his application for registration. Petitioner's discovery responses revealed undisputed material facts demonstrating that Petitioner had insufficient evidence as a matter of law of such an intent, and therefore Petitioner's application was void *ab initio*. Thus, it is as though Petitioner's application never existed. As a matter of law, Petitioner would be unable to satisfy its burden of demonstrating standing when considering all of the evidence.

Wherefore, Groat prays that the Board issue an order vacating the Decision and that the Board address the merits of his motion for summary judgment.

Dated: June 27, 2017

By: 
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CERTIFICATE OF SERVICE

I certify that on the 27 day of June, 2017 a copy of the foregoing REGISTRANT'S MOTION FOR RECONSIDERATION OF THE BOARD'S DECISION DATED JUNE 20, 2017 was sent via E-Mail and First Class U.S. Mail, postage pre-paid, to the following:

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