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

Proceeding	92070823
Party	Defendant Ikonix USA LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ICware Systems, Inc. dba BatchTest Corporation,

Petitioner,

v.

Ikonix USA, LLC,

Registrant

Cancellation No. 92070823

RESPONDENT’S OPPOSITION/RESPONSE TO MOTION TO STRIKE

Registrant, Ikonix USA, LLC (“Ikonix”), opposes Petitioner’s, ICware Systems, Inc. (“ICware”), Motion to Strike filed on April 30, 2019. Specifically, Ikonix’s Affirmative Defenses in its Answer filed April 22, 2019 were stated with sufficient particularity as a matter of law.

Background

ICware initiated the present proceeding by filing a Petition for Cancellation on March 12, 2019 seeking to cancel Ikonix’s Trademark Registration Number 4,499,170 for the mark “BatchTEST.” Ikonix filed its Answer to the Petition for Cancellation on April 22, 2019 along with an Affirmative Defense of Laches. ICware’s currently pending Motion to Strike was filed April 30, 2019, which seeks to strike Ikonix’s Affirmative Defense.

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Argument

The Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 311.02(b) states, in pertinent part, “[a]n answer may also include a short and plain statement of any defenses, including affirmative defenses that the defendant may have to the claim or claims asserted by the plaintiff.” Available “[a]ffirmative defenses may include unclean hands, laches, estoppel, acquiescence, . . . or any other matter constituting an avoidance or affirmative defense.” *See Id.* “[T]he pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.” *See Id.*

In order to prevail on the affirmative defense of laches, Ikonix is required ‘to establish that there was undue or unreasonable delay [by ICware] in asserting its rights, and prejudice to [Ikonix] resulting from the delay. *Bridgestone/Firestone Research, Inc. v. Automobile Club De L’Ouest de la France*, 245 F.3d 1359, 1361 (Fed. Cir. 2001). By statute, the defense of laches is available in trademark proceedings, and the party raising the defense has the burden of proof. *Id.*

Pursuant to Fed. R. Civ. P. 12(f), the Board “may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.” *See* TBMP § 506.01. However, “[m]otions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case.” *See* TBMP § 506.01. “Thus, 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.” *Id.* “A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or it raises factual issues that should be determined on the merits.” *Id.*

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In this case, Ikonix has provided enough factual detail of the affirmative defense of laches in short and plain statements to provide sufficient notice to ICware as a matter of law. *See* TBMP § 311.02(b). On its face, the affirmative defense asserted has a clear bearing upon the issues in the case. *See* TBMP § 506.01.

As asserted in paragraphs 10 and 11 of ICware's Petition for Cancellation, and admitted in Ikonix's Answer, Registration Number 4,499,170 was issued on March 18, 2014, almost five years before the Petition for Cancellation was filed, where the registered mark's date of first use was at least as early as July 8, 2013. Accordingly, enough factual detail is provided in the pleadings on its face to provide fair notice of the affirmative defense of laches in Ikonix's Answer, where the affirmative defense of laches includes an undue or unreasonable delay in filing the petition for cancellation from when the registration was granted, which clearly has prejudiced Ikonix since it has been using the mark at least as early as July 8, 2013.

Moreover, while the courts have held that "the court should decline to apply laches to protect the public interest," *see Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 208 Fed.Appx 886, 890 (Fed. Cir. 2006), a determination whether a likelihood of confusion is inevitable or reasonably debatable is a decision by the Board based on the evidence of record. *See The Christian Broadcasting Network, Inv. V. ABS-CBN International*, 84 U.S.P.Q.2d 1560, 16-17 (TTAB 2007) (precedential), *see also Jansen Enterprises, Inc. v. Israel Rind and Stuart Stone*, 85 U.S.P.Q.2d 1104, 18 (TTAB 2007) (precedential). That is, Ikonix submits that the equitable defense of laches should be declined only after finding that a likelihood of confusion is inevitable, which has not been found in the present case. *See Bigfoot 4x4 Inc. v. Bear Foot, Inc.*, 5 U.S.P.Q.2d 1444, 4 (TTAB 1987) ("While the Board has stated that the equitable defense

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of laches and/or acquiescence cannot bar judgment in favor of a prior user if the marks and goods and/or services of the parties are such that confusion is inevitable, the defense will be considered where likelihood of confusion is reasonably in doubt.”).

Therefore, since the issues involving the affirmative defense of laches has clear bearing upon issues in this case, e.g., superior rights and likelihood of confusion, and ICware would not be prejudiced if the affirmative defense of laches would be included, Ikonix respectfully requests this Board, in its discretion, decline to strike the affirmative defense of laches.

Accordingly, Ikonix respectfully requests that ICware’s Motion to Strike be denied.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this document is being served on Petitioner by emailing it on the undersigned date addressed to the correspondence address of record in the TTABVUE database at the website of the U.S. Patent and Trademark Office as follows:

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May 17, 2019

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