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

Proceeding	92071623
Party	Defendant True North Barber Shop
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Attachments	2019-09-03 Response to Motion to Strike - TRUE NORTH.pdf(103381 bytes)

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

In the matter of Trademark Registration No.: 5,763,450
Mark: TRUE NORTH (and design)
Registration Date: May 28, 2019

TRUE NORTH SALON AND SPA INC., **Petitioner,** **v.** **TRUE NORTH BARBER SHOP LLC,** **Respondent.**	**Cancellation No. 92071623**

RESPONSE TO PETITIONER'S MOTION TO STRIKE

Respondent True North Barber Shop, LLC responds to Petitioner's Motion to Strike paragraphs 24-26 of Respondent's Answer to the Petition for Cancellation (TTABVUE 6). The Motion is not well-founded and should be denied.

Petitioner moves to strike ¶ 24 of the Answer because it is "redundant." Paragraph 24 of the Answer states "there is no likelihood of confusion, mistake, or deception as to the source of the respective services associated with the respective marks." (TTABVUE 2)

Paragraph 24 of the Answer sets forth one of Respondent's defenses to the Petition for Cancellation – an assertion that there is no likelihood of confusion

between the marks at issue, which is the foundation for Petitioner's claim. "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." TBMP § 311.02; 37 C.F.R. § 2.106(b)(2).

Petitioner cites *Textron, Inc. v. Gillette Co.*, 180 U.S.P.Q. 152, 143 (TTAB 1973) for the proposition that "Allegations merely reiterating a denial of likelihood of confusion previously set forth in an answer are redundant and therefore should be stricken." However, in *Textron* the Board denied opposers motion to strike objectionable paragraphs in an answer as redundant, finding that

> [T]he paragraphs in question concerning the nature of the respective marks of the parties constitute an affirmative defense which amplifies the denial of likelihood of confusion previously set forth by applicant in its answer. Applicant's allegations, in fact, serve to apprise opposer with greater particularity of the position which applicant is taking in the defense of its right of registration.

See also TBMP § 506.01 ("[T]he 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.")

Paragraph 24 provides a fuller notice of Respondent's defense, is entirely appropriate, and should not be stricken.

Petitioner also moves to strike paragraphs 25-26 of the Answer as an insufficiently plead affirmative defense of "acquiescence." Petitioner misreads ¶¶ 25-26, which do not allege "acquiescence" as a type of estoppel to the claims by

Petitioner against Respondent. Rather, ¶¶ 25-26 allege that Petitioner has "acquiesced" (*i.e.*, submitted or acceded) to others using the same or similar marks for the same or similar services, which has made Petitioner's mark weak.

The strength of a trademark, determined in view of the number and nature of similar marks in use on similar goods and services, is one of the relevant factors in a likelihood of confusion analysis. See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Information concerning a party's awareness of third-party use and/or registration of the same or similar marks for the same or closely related goods or services as an involved mark is a relevant defense. See, *e.g.*, TBMP § 414 (such information is discoverable). The allegations of ¶¶ 25-26 place Petitioner on notice that Respondent will defend on grounds that Petitioner's mark is not strong and with evidence that others are using the same or similar marks for the same or similar services. Allegations in the answer concerning the strength of Petitioner's mark and the use of similar marks by third parties (with the knowledge of Petitioner) provides Petitioner with appropriate and "fuller notice of the basis for a claim or defense." TBMP § 506.01.

Paragraphs 24 and 25 assert the "Opposer has long acquiesced in one or more third party's uses of trademarks that include the words TRUE NORTH, or formatives thereof, for related goods or services" and, therefore, "Petitioner's rights in its alleged mark, if any, are of a narrow and limited scope because there are numerous

third-party users of similar marks." Respondent does not allege legal "estoppel by acquiescence," but a weak mark due to the number and nature of similar marks in use for the same or related goods or services without any action by Petitioner to stop those uses or protect the strength of Petitioner's mark.

Paragraphs 24 and 25 are appropriate and should not be stricken from the Answer.

RESPECTFULLY SUBMITTED this 3rd day of September, 2019.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing document was served via email (by agreement) this 3rd day of September, 2019, upon the following:

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