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

Proceeding	92074645
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Docket No. 0PX7-317535

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

In re Registration No. 4,766,492 for the trademark EMOJI in Classes 27 and 41 Mattel, Inc., Petitioner, vs. emoji company GmbH, Registrant.	Cancellation No. 92-074645 **PETITIONER MATTEL, INC.'S MOTION TO STRIKE REGISTRANT EMOJI COMPANY GMBH'S AFFIRMATIVE DEFENSES**

I. INTRODUCTION

Petitioner Mattel, Inc. ("Mattel") hereby moves pursuant to Fed.R.Civ.P. 12(f) and TBMP § 503 to strike Registrant emoji company GmbH's ("Registrant") affirmative defenses. 4 TTABVUE 3-4.

Each of Registrant's affirmative defenses are facially deficient. First, Affirmative Defense Nos. 1-3 allege that Mattel has failed to state a claim or lacks standing. These are not affirmative defenses. More importantly, Mattel has pleaded non-conclusory facts establishing its standing, which facts Registrant has not denied.

Second, Affirmative Defense Nos. 4-6 claim that Mattel is barred from relief because it has not pleaded certain facts. These affirmative defenses are meritless because none of the facts cited by Registrant need to be established to establish a right to relief.

Third, and finally, Affirmative Defense No. 7 for waiver and/or acquiescence is inadequately pled and consists of a conclusory statement without the factual allegations required

for such a defense. Also, equitable defenses like waiver and acquiescence cannot defeat a claim of abandonment.

Because the Board's determination of Mattel's motion will affect the scope of discovery in this proceeding, Mattel requests that the proceeding be suspended pending consideration of its motion to strike and that, after the Board decides the motion, all pending deadlines in this proceeding be reset.

II. MATTEL'S MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES SHOULD BE GRANTED

A. The Standard for Adjudicating Motions to Strike

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." *See also* Fed. R. Civ. P. 12(f) ("The court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.") Motions to strike are granted in appropriate cases, particularly as in the present case where meritless affirmative defenses that will only waste the parties' time and expense at trial can be summarily adjudicated as insufficient well before then. *See American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (granting motion to strike insufficient affirmative defenses); *Heller Fin., Inc. v. Midwhey Powder Co.,* 883 F.2d 1286, 1294 (7th Cir. 1989) ("where . . . motions to strike remove unnecessary clutter from the case, they serve to expedite, not delay.")

B. Registrant's Affirmative Defense Nos. 1-3 Should be Stricken

Registrant's first three affirmative defenses, all of which are variations on "failure to state a claim," are not affirmative defenses. "Failure to state a claim" is not an affirmative defense "because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather

than a statement of a defense to a properly pleaded claim." *John W. Carson Foundation v. Toilets.com Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010). Although Fed.R.Civ.P. 12(b)(6) allows a registrant to raise this defense, a petitioner may use the assertion to test the sufficiency of the defense in advance of trial by moving to strike it from the registrant's answer. *See S.C. Johnson & Son v. GAF Corporation,* 177 USPQ 720, 720 (TTAB 1973). Accordingly, an affirmative defense for failure to state a claim will be stricken if the petitioner alleges such facts that would, if proved, establish that (1) the petitioner has standing to maintain the proceeding, and (2) a valid ground exists for canceling the registration. *American Vitamin*, 22 USPQ2d at 1314; TBMP § 503.02. In determining the motion, all of the petitioner's well-pleaded claims must be accepted as true. *See* SA Wright & Miller, *Federal Practice and Procedure: Civil 2d Section* (1990). Further, the petition for cancellation must be construed in the light most favorable to Mattel. *Id.*

Mattel has pleaded non-conclusory facts establishing its standing, that is, that it will be damaged by Registrant's registration at issue. *See* 37 C.F.R. § 2.111(b) ("Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part."). Here, Mattel has filed an application to register UNO EMOJI[1] and has received a letter from Registrant demanding Mattel cease use of UNO EMOJI because it purportedly infringes Registrant's rights in the EMOJI mark. 1 TTABVUE 2. Moreover, in that letter, Registrant alleged that it "owns almost 1,000 trademarks and trademark applications for designation emoji®, standalone and with other word and/or figurative elements in nearly any and all relevant jurisdictions of the world including (but not limited to) the U.S. …" *Id.* Based on these allegations, Mattel pleaded that it has been and will be damaged by the registration at issue. 1

[1] Since Mattel filed its petition, Registrant has filed a notice of opposition to Mattel's application to register UNO EMOJI. See Opp. No. 91-264338.

TTABVUE 4-5. Registrant did not deny any of these allegations in its answer. 4 TTABVUE 1-2. Accordingly, Mattel has established its standing in this proceeding. *Cunningham v. Laser Golf Corp.,* 222 F.3d 943, 945 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina,* 670 F.2d 1024, 1028-29 (CCPA 1982).

Second, Mattel has pleaded facts supporting claim for abandonment, failure to function, descriptiveness, and lack of a bona fide intent to use. 1 TTABVUE 2-4. Accordingly, Mattel has pleaded valid grounds for petitioning to cancel the registration.

Because Mattel has alleged facts that establish its standing and grounds for canceling the registration, the Board should strike Registrant's Affirmative Defense Nos. 1-3.

C. Registrant's Affirmative Defense Nos. 4-6 Should Be Stricken

Each of Registrant's Affirmative Defense Nos. 4-6 claims that Mattel is barred from relief because Mattel has not pleaded and cannot establish certain facts. Mattel need not prove any of these facts to state any of the claims it has asserted for cancellation.

For its Affirmative Defense No. 4, Registrant alleges that Mattel "cannot merit cancellation of the Registration because [Mattel] has not sufficiently used any mark that is the subject of the Registration, in United States commerce in connection with [Mattel's] goods so as to establish exclusive rights therein." 4 TTABVUE 3. Mattel, however, need not plead that it has used the supposed "Emoji" mark with its goods in order to state any of its claims against Registrant, and Registrant cannot cite any authority in support of this position. Likewise, Registrant cannot avoid cancellation on the grounds asserted by Mattel by establishing that Mattel does not own exclusive rights in the EMOJI mark.

For its Affirmative Defense No. 5, Registrant alleges that Mattel's "unclean hands prevent it from being held to be the prior user of the marks {sic} of the Registration, because

[Mattel] has not engaged in the bona fide use of those marks or confusingly similar marks in the ordinary course of business so as to fairly assert recognizable prior rights to those marks in connection with the same or similar goods as are specified in the Registration." 4 TTABVUE 3. The premise of this affirmative defense is flawed; Mattel need not prove that it owns prior rights in the supposed "Emoji" mark, or any mark, to establish any of the grounds for cancellation it has asserted. Notably, Mattel has not asserted any claims based on a likelihood of confusion, likelihood of dilution, or false suggestion of a connection. Likewise, Registrant cannot avoid cancellation on these grounds by establishing that Mattel does not own prior rights.

For its Affirmative Defense No. 6, Registrant alleges that Mattel "is estopped from asserting that the mark of the Registration, when used in connection with Registrant's goods creates a likelihood of confusion with respect to [Mattel's] use of the mark in the Registration either alone or in combination with other terms." Again, the premise of this affirmative defense is flawed; Mattel need not prove a likelihood of confusion to establish any of the grounds for cancellation it has asserted. Likewise, Registrant cannot avoid cancellation on these grounds by establishing a lack of likelihood of confusion.

Accordingly, the Board should strike each of these affirmative defenses.

D. Registrant's Affirmative Defense No. 7 Should Be Stricken

Registrant asserts that Mattel's claims are barred by "waiver and/or acquiescence."

TBMP § 300 makes clear that "[t]he elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis of the defense." Where a defense contains mere conclusory allegations that do not give an opposer or petitioner fair notice as to the specific conduct which provides the basis for the defense, the defense will be stricken by the Board. *See Lincoln Logs Ltd. v. Lincoln*

Precut Log Homes, Inc., 971 F.2d 732, 735 (Fed. Cir. 1992) (affirming dismissal of applicant's asserted defenses of laches and estoppel because applicant failed to allege facts supporting the necessary elements of each alleged defense).

Registrant's affirmative defense of "waiver and/or acquiescence" should be stricken because, as pled, it is merely conclusory and fails to state facts that would give adequate notice of the basis for such defenses.

It is also well established that such equitable defenses "are unavailable against a ground of abandonment." *Linville v. Rivard*, 41 USPQ2d 1731, 1733, n.5 (TTAB 1996). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) ("Where the proposed ground for cancellation is abandonment, equitable defenses should be unavailable for the same reason they have been held unavailable when the ground asserted is descriptiveness or fraud. It is in the public interest to remove abandoned registrations from the register."); *Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) ("It is well established that the equitable defenses of laches and acquiescence are not available against claims of genericness, descriptiveness, fraud, and abandonment.").

This rule makes particular sense when it comes to claims of abandonment which are, by their very nature, based on *and validated* by the passage of time. Registrant's position would only allow claims of abandonment to proceed against recently abandoned marks, not marks that have been long abandoned. This is nonsensical.

Accordingly, the Board should strike these affirmative defenses.

III. MATTEL'S REQUEST TO SUSPEND PROCEEDINGS

Registrant's first affirmative defense of failure to state a claim is not an affirmative defense, but, rather, an attack on the sufficiency of Mattel's pleading of its grounds. As such, the

Board should treat the disposition of this motion to strike in the same manner in which it would treat a motion to dismiss. That is, it should suspend all deadlines pending its adjudication. *See* TBMP § 503.01 (filing a motion to dismiss for failure to state a claim upon which relief can be granted "effectively stays the time for the parties to conduct their required discovery conference because the pleadings must be complete and issues joined before the conference is held."); TBMP § 316 (any potentially dispositive motion, such as a failure to state a claim, directed to the pleadings suspends the case "for decision on the motion and the Board will reset the deadline for the discovery conference as well as all subsequent dates, as appropriate, when the motion is decided.").

As the Board's determination of Mattel's motion will affect the scope of discovery in this proceeding, Mattel requests that the proceeding be suspended pending consideration of its motion to strike and that, after the Board decides the motion, the deadlines for all pending deadlines in this proceeding be reset.

IV. CONCLUSION

For the reasons stated above, the Board should strike Registrant's affirmative defenses and suspend the proceedings pending disposition of this motion.

Respectfully submitted,

Dated: September 3, 2020

By:/Paul A. Bost/

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that **PETITIONER MATTEL, INC.'S MOTION TO STRIKE CERTAIN OF REGISTRANT EMOJI COMPANY GMBH'S AFFIRMATIVE DEFENSES** is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 3rd day of September, 2020.

/Paul A. Bost/
Paul A. Bost

CERTIFICATE OF SERVICE

I hereby certify that the **PETITIONER MATTEL, INC.'S MOTION TO STRIKE CERTAIN OF REGISTRANT EMOJI COMPANY GMBH'S AFFIRMATIVE DEFENSES** is being sent by electronic mail addressed to m.hucke@huckelaw.com and e.sal@huckelaw.com on this 3rd day of September, 2020.

/Paul A. Bost/
Paul A. Bost

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