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

Proceeding	92074735
Party	Plaintiff Eastasia Food and Trading Inc.
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Date	09/23/2020
Attachments	Reply to Registrants Respond to Motion to Strike.pdf(152760 bytes)

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

Eastasia Food And Trading Inc.

Cancellation No.: 92074735

Petitioner,
v.

Mark: PADMA BRAND CLASSIC
Reg. No. 5843315

Mohammad B. Chowdhury, and
Noya Distributors Inc.

Issued: August 27, 2019

Registrant.

**REPLY TO REGISTRANT'S RESPONSE TO PETITIONER'S MOTION TO STRIKE
REGISTRANT'S FIRST TO SIXTH AFFIRMATIVE DEFENSES**

As to the First Affirmative Defense: The Petition for Cancellation fails to state a claim upon which relief can be granted must be stricken as Petitioner has clearly established standing.

Registrant's failed to respond to the motion to strike Registrant's motion to strike Registrant's First Affirmative Defense. As such the motion should be granted as conceded.

As to the Second (Laches), Fourth (Acquiescence), and Fifth (Estoppel) Affirmative Defenses, the same were not pled with sufficient particular and must be stricken.

To succeed in a laches, or estoppel defense, the party alleging the same has the burden of establishing both unreasonable delay and prejudice from the delay. *See, Ralston Purina Co. v. Midwest Cordage Co., Inc.*, 153 USPQ 73, 75-76 (CCPA 1967).

The Registrant's sole basis for "successfully" pleading the defenses of laches, acquiescence and estoppel is that Petitioner waited an "unreasonable" eleven (11) months to petition to cancel Reg. No. 5843315.

The elements of a laches defense are: (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the latter attributable to the delay. See *Lincoln Logs Ltd. v. Lincoln Pre-Cut Logs Homes Inc.*, 971 F.2d 732 , 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

In *Leonid Nahshin v. Product Source International, LLC*, 107 U.S.P.Q.2d 1257, (T.T.A.B. 2013) the period of delay in filing a petition for cancellation was 18-month period from the issuance of the registration until the filing of the petition to cancel. The Board held at page 1263:

The approximately 18-month period from the issuance of the registration until the filing of the petition to cancel is a rather limited amount of time. See *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2043 (TTAB 1989) (14 month delay not sufficient to establish laches); *Manpower, Inc. v. Manpower Information Inc.*, 190 USPQ 18, 23 (TTAB 1976) (3-4 year delay not sufficient to establish laches); and *Plymouth Cordage Company v. Solar Nitrogen Chemicals, Inc.*, 152 USPQ 202, 204 (TTAB 1966) (slightly less than 3 year delay not sufficient to establish laches.). It does not constitute unreasonable delay, and accordingly respondent has failed to meet the first element of a laches defense

Eleven (11) months unreasonable? Absolutely not as a matter of law. As such, there is no reason to address the second element, i.e. material prejudice. As such the motion to strike laches should be granted in its entirety.

Registrant failed to address its failure to adequately plead the elements of acquiescence estoppel. As such the motion should be granted as conceded as to acquiescence estoppel.

As to the Third (Unclean Hands) Affirmative Defense was not pled with sufficient particular and must be stricken.

The defense of unclean hands must be related to Petitioner's claim and, therefore, Registrant has not asserted a viable affirmative defense of unclean hands. See *Tony Lama Company, Inc. v. Anthony Di Stefano*, 206 USPQ 176 (TTAB 1980). See also *VIP Foods, Inc. v. V.I.P. Food Products*, 200 USPQ 105 (TTAB 1978), and cases cited therein.

Misidentifying Petition's legal entity type is unrelated to its claim of priority as asserted in the Petition for Cancellation.

Insofar as the allegation of use is concerned, it is the filing date of the application that is relevant to unclean hands as well as fraud is concerned. See *L. & J.G. Stickley, Inc. v. Ronald C. Cosser*, 81 U.S.P.Q.2d 1956, (T.T.A.B. 2007) wherein the Board held at note 17:

Petitioner also alleges that respondent's registrations should be cancelled because of respondent's fraudulent conduct by providing "false information in his applications before the Trademark Office when he executed false sworn statements that he was entitled to dates of use in commerce of May 1978 for furniture polish and of January 1982 for furniture." Brief at 3. We point out that inaccurate information regarding claimed dates of first use does not, by itself, constitute fraud. *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1141 (TTAB 1990) ("The Board repeatedly has held that the fact that a party has set forth an erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing of the [Section 1(a)] application").

See also *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1141 (TTAB 1990) "The Board repeatedly has held that the fact that a party has set forth an erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing of the [Section 1(a)] application.

As to the Sixth (Fraud) Affirmative Defense was not pled with sufficient particular and must be stricken.

As regards Registrant's assertion that Petitioner committed fraud when it misstated the nature of its legal entity (limited liability company instead of incorporation) and its claimed date of first use, the assertion is entirely immaterial, and Petitioner's dates given are entirely proper. See above re: unclean hands.

In view of the paltry "facts" set forth in Registrant's response to Petitioner's motion to strike, it would be futile to grant Registrant leave to amend its answer in an attempt to plead its several affirmative defenses unclean hands defense predicated on a claim of infringement. See generally *Foman v. Davis*, 371 U.S. 178, 183 (1962) ("futility of amendment" is a reason to deny a Rule 15(a) motion); see also, *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1300 (TTAB 2010) (leave to amend answer to plead an additional affirmative defense denied as futile).

CONCLUSION


For the aforesaid reasons as well as the reasons set forth in Petitioner's Motion to strike, Petitioner's motion should be granted in its entirety and Registrant's motion for leave to mend its answer should be denied as futile

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WHEREFORE, Petitioner prays its motion is granted in all respects.

Respectfully submitted,
Baker and Rannells, PA

Dated: September 23, 2020



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served via e-mail upon WENSHENG MA, Attorney of Record for Registrant at lfdisputes@legalforcelaw.com, vincent@legalforcelaw.com, nick@legalforcelaw.com on this, the 23th day of September 2020.



Stephen L. Baker