Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA1096476**

Filing date: **11/19/2020**

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

Proceeding	91264338
Party	Defendant Mattel, Inc.
Correspondence Address	JILL M PIETRINI SHEPPARD MULLIN RICHTER & HAMPTON LLP 1901 AVE OF THE STARS STE 1600 LOS ANGELES, CA 90067-6017 UNITED STATES Primary Email: jpietrini@sheppardmullin.com Secondary Email(s): pbost@sheppardmullin.com 310-228-3700
Submission	Motion to Strike
Filer's Name	Paul A.Bost
Filer's email	pbost@smrh.com
Signature	/Paul A. Bost/
Date	11/19/2020
Attachments	Motion to Strike and Consolidate - emoji company v. Mattel.pdf(24592 bytes)

Docket No. 0PX7-317535

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

In re Matter of Application Serial No. 87/005,050 for the trademark: **UNO EMOJI in Class 28** emoji company GmbH, Opposer, v. Mattel, Inc., Applicant.	Opposition No. 91-264338 **APPLICANT AND PETITIONER MATTEL, INC.'S MOTION TO (a) STRIKE OPPOSER AND REGISTRANT EMOJI COMPANY GMBH'S AFFIRMATIVE DEFENSES AND (b) CONSOLIDATE WITH CANCELLATION NO. 92-074645**
In re Matter of Registration Nos. 5,778,247, 5,700,040, and 5,343,650 for the trademarks: **EMOJI in Classes 9, 14, 20, 24, and 28; EMOJI in Class 28; and EMOJI in Class 28** Mattel, Inc. Petitioner, v. emoji company GmbH, Registrant.	

I. INTRODUCTION

Applicant and Petitioner Mattel, Inc. ("Mattel") hereby moves pursuant to Fed.R.Civ.P. 12(f) and TBMP § 503 to strike Opposer and Registrant emoji company GmbH's ("Registrant") affirmative defenses asserted in response to Mattel's counterclaims. 7 TTABVUE 3-4. Mattel also moves to consolidate this action with Mattel's pending petition to cancel Registrant's registration of EMOJI in Classes 27 and 41, Cancellation No. 92-074645.

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.

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."). Most notably, Registrant has asserted its registrations at issue in support of its notice of opposition. 1 TTABVUE 1; 4 TTABVUE 4. Also, Mattel received a letter from Registrant

demanding Mattel cease use of UNO EMOJI because it purportedly infringes Registrant's rights in the EMOJI mark. 4 TTABVUE 4. 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. 4 TTABVUE 6. 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. 4 TTABVUE 3-6. Accordingly, Mattel has pleaded valid grounds for petitioning to cancel the registrations.

Because Mattel has alleged facts that establish its standing and grounds for canceling the registrations, 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." 7 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." 7 TTABVUE 3 (emphasis in original). 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." 7 TTABVUE 3.

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 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 MOTION TO CONSOLIDATE THE PROCEEDINGS

Pursuant to TBMP § 511, Mattel hereby moves to consolidate these proceedings with Mattel's pending petition to cancel Registrant's registration of EMOJI in Classes 27 and 41, Cancellation No. 92-074645. The proceedings sought to be consolidated are:

- *emoji company GmbH v. Mattel, Inc.*, Opposition No. 91-264338; and
- *Mattel, Inc. v. emoji company GmbH*, Cancellation No. 92-074645.

In both of the above-identified proceedings, Mattel seeks to cancel Registrant's registrations of EMOJI on the grounds that Registrant has abandoned its mark, the purported mark fails to function as a mark, the purported mark is descriptive, and Registrant lacked a bona fide intent to use EMOJI at all relevant times. Highlighting the similarity between the actions, Registrant has asserted identical affirmative defenses in each proceeding.

Because the allegations and defenses in each of the proceedings pending between the parties are predominantly the same, there are common questions of law or fact and law. In addition, the parties are identical. Given these facts, consolidation would save time, effort, and expense for all involved.

In view of the similarity of issues and identity of parties in the pending opposition and cancellation proceedings and in the interest of judicial economy, Applicant requests that the

Board consolidate Opposition No. 91-264338 and Cancellation No. 92-074645 pursuant to TBMP § 511, and reset the pre-trial and trial dates.

IV. CONCLUSION

For the reasons stated above, the Board should strike Registrant's affirmative defenses and consolidate this proceeding with Cancellation No. 92-074645.

Respectfully submitted,

Dated: November 19, 2020

By:/Paul A. Bost/
Jill M. Pietrini
Paul A. Bost
SHEPPARD MULLIN RICHTER HAMPTON, LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017
Tel.: (310) 228-3700
Attorneys for Applicant and Petitioner Mattel, Inc.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that **APPLICANT AND PETITIONER MATTEL, INC.'S MOTION TO STRIKE OPPOSER AND REGISTRANT EMOJI COMPANY GMBH'S AFFIRMATIVE DEFENSES AND TO CONSOLIDATE** 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 19th day of November, 2020.

/Paul A. Bost/
Paul A. Bost

CERTIFICATE OF SERVICE

I hereby certify that the **APPLICANT AND PETITIONER MATTEL, INC.'S MOTION TO STRIKE OPPOSER AND REGISTRANT EMOJI COMPANY GMBH'S AFFIRMATIVE DEFENSES AND TO CONSOLIDATE** is being sent by electronic mail addressed to m.hucke@huckelaw.com and e.sal@huckelaw.com on this 19th day of November, 2020.

/Paul A. Bost/
Paul A. Bost

SMRH:4825-8548-6034.1