

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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JLE

February 2, 2021

Opposition No. 91264338 (parent)

*emoji company GmbH*

*v.*

*Mattel, Inc.*

Cancellation No. 92074645

Cancellation No. 92075957

*Mattel, Inc.*

*v.*

*emoji company GmbH*

**Jennifer L. Elgin, Interlocutory Attorney:**

These cases come up for consideration of (i) the motion filed September 3, 2020 by Mattel, Inc. (“Mattel”) in Cancellation No. 92074645 (the ’645 Cancellation) to strike the affirmative defenses asserted by emoji company GmbH (“emoji”) under Fed. R. Civ. P. 12(f), and (ii) the motion filed November 11, 2020 by Mattel in Opposition No. 91264338 (the ’338 Opposition) to strike identical affirmative defenses asserted by emoji in its answer to Mattel’s counterclaims for cancellation, and consolidate the ’338 Opposition with the ’645 Cancellation. The motion to strike in the ’645 Cancellation is opposed. The motion to strike and consolidate in the ’338 Opposition

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is uncontested. The Board also notes a third recently-filed cancellation proceeding by Mattel against emoji, Cancellation No. 92075957 (the '957 Cancellation).

The Board has considered the parties' briefs and materials submitted therewith, but addresses the record only to the extent necessary to set forth the Board's analysis and findings and does not repeat or address all of the parties' arguments or materials.

*Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).<sup>1</sup>

## **I. Background**

### **A. The '645 Cancellation**

On July 6, 2020, Mattel filed a petition to cancel emoji's Registration No. 4766492 for the mark EMOJI in standard characters for goods and services in International Classes 27 and 41.<sup>2</sup> The petition to cancel asserts claims of abandonment, failure to function as a mark, mere descriptiveness, and lack of bona fide intent to use the mark in commerce prior to filing the underlying application.<sup>3</sup> emoji answered the petition

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<sup>1</sup> The Board reminds counsel for the parties that all text in submissions to the Board must be in at least 11-point type and double-spaced. Trademark Rule 2.126(a)(1), 37 C.F.R. § 2.126(a)(1). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 110.01 (June 2020). Future submissions that do not comply with the Board's rules may be denied consideration.

<sup>2</sup> Registration No. 4766492, filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on a request for extension of protection of International Registration No. 1216920, and registered July 7, 2015.

<sup>3</sup> '645 Cancellation, 1 TTABVUE 1-2. Record citations are to TTABVUE, the Board's publicly available docket history system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

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to cancel on August 17, 2020, generally denying the salient allegations of the complaint and asserting eight affirmative defenses.<sup>4</sup>

### **B. The '338 Opposition**

On August 19, 2020, emoji filed a notice of opposition against Mattel's application Serial No. 87005050 for the mark UNO EMOJI in standard characters for goods in International Class 28.<sup>5</sup> As grounds for opposition, emoji asserts claims for priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and dilution by blurring and dilution by tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), based on ownership of Registration Nos. 5343650, 5700040, and 5778247 for the mark EMOJI in standard characters, for goods and services in International Classes 9, 14, 20, 24, and 28.<sup>6</sup>

Mattel answered the notice of opposition on September 28, 2020, generally denying the salient allegations of the complaint and asserting affirmative defenses, and asserting counterclaims for cancellation of Registration Nos. 5343650, 5700040, and 5778247 based on abandonment, failure to function as a mark, mere

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<sup>4</sup> '645 Cancellation, 4 TTABVUE.

<sup>5</sup> Application Serial No. 87005050, filed April 18, 2016 based on an allegation of intent to use under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

<sup>6</sup> All filed under Section 66(a) of the Trademark Act based on a request for extension of protection of International Registration No. 1233267. Registration No. 5343650 registered November 28, 2017; Registration No. 5700040 registered March 19, 2019; and Registration No. 5778247 registered June 18, 2019.

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descriptiveness, and lack of bona fide intent to use the mark in commerce prior to filing the underlying application.<sup>7</sup>

On October 30, 2020, emoji filed an answer to the counterclaim, generally denying its salient allegations and asserting eight affirmative defenses identical to those asserted in the '645 Cancellation.<sup>8</sup>

### **C. Cancellation No. 92075957 (the '957 Cancellation)**

On December 11, 2020, Mattel filed a petition to cancel emoji's Registration No. 4868832 for the mark EMOJI in standard characters for goods in International Classes 3, 16, 17, 18, 21, 22, 25, 26, 27, 29, 30, and 32,<sup>9</sup> asserting claims identical to those pleaded in the '645 Cancellation.<sup>10</sup>

emoji answered the petition to cancel on January 25, 2021, generally denying the salient allegations of the complaint and asserting eight affirmative defenses identical to those asserted in the '645 Cancellation and to the counterclaims in the '338 Opposition.<sup>11</sup>

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<sup>7</sup> '338 Opposition, 4 TTABVUE.

<sup>8</sup> *Id.*, 7 TTABVUE.

<sup>9</sup> Registration No. 4868832, filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), based on a request for extension of protection of International Registration No. 1233267, and registered on December 15, 2015.

<sup>10</sup> '957 Cancellation, 1 TTABVUE 4.

<sup>11</sup> *Id.*, 4 TTABVUE.

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## II. Motion to Consolidate Proceedings

The Board first turns to Mattel's uncontested motion to consolidate the '338 Opposition with the '645 Cancellation. Mattel argues that its claims for cancellation of emoji's registrations of the mark EMOJI and emoji's affirmative defenses are identical.<sup>12</sup> Given the overlap in the proceedings, Mattel contends litigating the common questions of law and fact would save time, effort and expense.<sup>13</sup>

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Wis. Cheese Grp., LLC v. Comercializadora de Lácteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1889 and n.7 (TTAB 2007). Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g., Wis. Cheese Grp.*, 118 USPQ2d at 1264. Accordingly, the Board sua sponte also considers consolidation of the '957 Cancellation.

In determining whether to consolidate proceedings, the Board weighs the savings in time, effort, and expense which may be gained from consolidation against any prejudice or inconvenience which may be caused thereby. *World Hockey Ass'n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975). *See also* TRADEMARK

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<sup>12</sup> '338 Opposition, 8 TTABVUE 8.

<sup>13</sup> *Id.*

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TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (June 2020). A motion for consolidation may be denied if it will cause delay in the processing of one or more of the individual cases. *See, e.g., Lever Bros. Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1982) (consolidation denied where one case was in pleading stage, and testimony periods had expired in the other); *see also* WRIGHT & MILLER, 9A Fed. Prac. & Proc. Civ. § 2383 and cases cited in n.9 (3d ed.).

The '338 Opposition, '645 Cancellation and '957 Cancellation involve the same parties represented by the same counsel, the same mark, nearly identical claims and the same affirmative defenses. Accordingly, it is foreseeable that the cases may involve overlapping discovery, witnesses and evidence. Further, the proceedings are all in their initial stages.

Accordingly, and because emoji has not objected thereto, Mattel's motion to consolidate the '338 Opposition and '645 Cancellation is **granted**, and the Board sua sponte consolidates the '957 Cancellation. The '338 Opposition, '645 Cancellation, and '957 Cancellation may be presented on the same record and briefs. *Hilson Rsch. Inc. v. Soc'y for Hum. Res. Mgmt.*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in the '338 Opposition as the "parent case." From this point on, except as set forth below, only a single copy of all motions and

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submissions should be filed in the parent case only, but captioned with all consolidated proceeding numbers and identifying the “parent case” first.<sup>14</sup>

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.<sup>15</sup>

### **III. Motion to Strike Affirmative Defenses**

#### **A. Applicable Law**

Under Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter in response to a motion or on its own initiative. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); TBMP § 506. Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Elec. Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). Inasmuch as the primary purpose of pleadings under the Federal Rules is to give fair notice of the claims or defenses asserted, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party,

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<sup>14</sup> *See* note 32, *infra*.

<sup>15</sup> The parties should promptly inform the Board of any other Board proceedings or related cases (within the meaning of Fed. R. Civ. P. 42) so the Board can consider whether further consolidation is appropriate.

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but rather will provide fuller notice of the basis for a claim or defense. *Ohio State*, 51 USPQ2d at 1292. *See, e.g., Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (declining to strike amplification of applicant's denial of opposer's claims). *See also* TBMP § 309.03(a)(2).

Nonetheless, the Board grants motions to strike in appropriate instances. Notably, the pleading of affirmative defenses should include enough factual support to give the plaintiff fair notice of the basis for the defense. *See IdeasOne, Inc. v. Nationwide Better Health, Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (claim or defense must be specific enough to provide fair notice to adverse party of restriction being sought); *H.D. Lee Co. v. Maidenform, Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (finding affirmative defense unpleaded due to lack of specificity). *See also* TBMP § 311.02(b).

Mattel moves to strike each of emoji's eight affirmative defenses in the '338 Opposition and '645 Cancellation; the Board sua sponte considers the identical affirmative defenses in the '957 Cancellation.

## **B. Analysis**

### **1. First, Second, Third, and Fourth Affirmative Defenses--Failure to State a Claim and "Standing"**

emoji's first and second affirmative defenses allege Mattel's claims and counterclaims fail to state a cause of action upon which relief may be granted. emoji's third affirmative defense alleges Mattel lacks "standing" to seek cancellation of emoji's registration, in that Mattel "is not likely to be damaged or injured by [emoji's]

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use or registration of the marks in the Registration[s].”<sup>16</sup> Similarly, emoji’s fourth affirmative defense states, “[Mattel] cannot merit cancellation of the Registration[s] because [Mattel] has not sufficiently used any mark that is the subject of the Registration[s], in United States commerce in connection with Mattel’s] goods so as to establish exclusive rights therein.” The Board construes this allegation as asserting that Mattel is not entitled to a statutory cause of action because it cannot be damaged due to lack of proprietary rights in the term “emoji”.

Failure to state a claim for relief and lack of entitlement to a statutory cause of action are not true affirmative defenses because they relate to an assertion of the insufficiency of the pleading rather than a statement of a defense to a properly pleaded claim. *See John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1949 (TTAB 2010) (failure to state a claim is not an affirmative defense); *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011) (lack of standing is not an affirmative defense as it is an element of the plaintiff’s asserted claim that it must prove as part of its case).

Further, a party need not assert a proprietary interest in its own mark to sufficiently plead a real interest in a proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020

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<sup>16</sup> ’338 Opposition, 7 TTABVUE 4; ’645 Cancellation, 4 TTABVUE 4; ’957 Cancellation, 4 TTABVUE 5. Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, the Board’s prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020).

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USPQ2d 10837 at \*4 (Fed. Cir. 2020) (“In sum, neither § 1064 nor our precedent requires that a petitioner in a cancellation proceeding must prove that it has proprietary rights in its own mark in order to demonstrate a real interest in the proceeding and a belief of damage.”); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1592 (TTAB 2009) (failure to allege use of petitioner’s mark in the United States not fatal to allegation of standing to bring a misrepresentation of source claim); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988) (cease and desist letter sent by applicant found sufficient to demonstrate opposer’s standing although opposer did not have proprietary rights in a mark). Accordingly, Mattel’s motion is **granted** as to emoji’s first, second, third and fourth affirmative defenses in each proceeding, which are **stricken**.

Nonetheless, in an effort to avoid future motion practice, the Board reviews the sufficiency of Mattel’s claims. Stating a claim upon which relief can be granted merely requires a legally sufficient pleading of entitlement to a statutory cause of action and existence of a valid ground for denying or the registration sought or for cancelling the involved registration. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Doyle v. Al Johnson’s Swedish Rest. & Butik, Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012). Mattel need not set forth exactly how it intends to prove its case at the pleading stage. *See Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1017 (TTAB 2018). Whether Mattel can prevail on the merits is a matter to be resolved at trial or upon a properly filed motion for summary judgment. *See Prosper Bus. Dev. Corp. v. Int’l Bus. Machs., Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014).

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**a. Entitlement to a Statutory Cause of Action**

Mattel has sufficiently pleaded its entitlement to a statutory cause of action in the two cancellation proceedings by pleading (1) ownership of application Serial No. 87005050 for UNO EMOJI for “Card games and accessories therefor” in Class 28, to which emoji filed an extension of time in which to oppose and later the ’338 Opposition;<sup>17</sup> and (2) receipt of a cease and desist letter from emoji asserting infringement of emoji’s federally-registered rights in its EMOJI marks, including the registrations sought be cancelled in the ’645 Cancellation.<sup>18</sup>

Mattel’s counterclaims for cancellation of emoji’s pleaded registrations in the ’338 Opposition are compulsory counterclaims and its entitlement to maintain the counterclaims is inherent; it “need not allege its standing to challenge the pleaded registrations.” *Finanz St. Honore, B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007).

**b. Abandonment**

Mattel’s first claim alleges that emoji has abandoned its EMOJI marks due to nonuse.<sup>19</sup> To sufficiently plead a claim for cancellation of emoji’s registrations under Section 66(a) of the Trademark Act on grounds of abandonment for nonuse, the plaintiff must allege, as of the date the claim is filed, either: (a) three or more

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<sup>17</sup> ’645 Cancellation, 1 TTABVUE 4, 6-7, 9-14 (Ex. A) ¶¶ 2, 4, 5, 21; ’957 Cancellation, 1 TTABVUE 6, 8-9, 11-16 (Ex. A), ¶¶ 2, 4, 5, 7, 22.

<sup>18</sup> ’645 Cancellation, 1 TTABVUE 4, ¶ 6; ’957 Cancellation, 1 TTABVUE 4, ¶ 6.

<sup>19</sup> ‘see ’338 Opposition, 4 TTABVUE 7, ¶¶ 28-30, ’645 Cancellation, 1 TTABVUE 4-5, ¶¶ 7-10; ’957 Cancellation, 1 TTABVUE 6-7, ¶¶ 8-11.

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consecutive years of nonuse commencing no earlier than the date on which the registration was issued; or (b) if the period of nonuse commencing no earlier than the date of registration and extending to the filing date of the claim is less than three years, facts supporting nonuse after the date of registration, coupled with an intent not to resume use. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1931 (TTAB 2014).<sup>20</sup>

The Board finds the claims of abandonment in the '645 Cancellation and the '957 Cancellation to be sufficiently pleaded.<sup>21</sup> However, in its counterclaim in the '338 Opposition, Mattel alleges in relevant part:

On information and belief, [emoji] has never used or is not currently using the EMOJI mark for the goods or all of the goods identified in the Registrations in the United States.

On information and belief, if Opposer has used the EMOJI mark, it does not intend to resume use of the EMOJI mark for the goods or many of them listed in the Registrations within the reasonably foreseeable future.<sup>22</sup>

The three registrations challenged in the counterclaim registered less than three years prior to the filing date of the counterclaim (September 28, 2020).<sup>23</sup> Accordingly, Mattel's allegations of nonuse, based only "on information and belief," fail to plead

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<sup>20</sup> Use of an applied-for mark in United States commerce is not a prerequisite to registration of a mark filed under Section 66(a); see Trademark Act Section 68(a)(3), 15 U.S.C. § 1141h(a)(3) ("Extension of protection shall not be refused on the ground that the mark has not been used in commerce.").

<sup>21</sup> See '645 Cancellation, 1 TTABVUE 4-5, ¶¶ 8-10; '957 Cancellation, 1 TTABVUE 6-7, ¶¶ 9-11.

<sup>22</sup> '338 Opposition, 4 TTABVUE 7, ¶¶ 29-30.

<sup>23</sup> Registration Nos. 5778247 (registered June 18, 2019), 5700040 (registered March 19, 2019), 5343650 (registered November 28, 2017).

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sufficient facts supporting nonuse after the date of registrations. Therefore Mattel's claim of abandonment in the '338 Opposition is insufficiently pleaded, and is **dismissed without prejudice**.

**c. Failure to Function as a Mark**

Second, Mattel claims emoji's EMOJI mark fails to function as a mark.<sup>24</sup> The claim is based on an assertion that, due to the inherent nature or the manner of use of the matter sought to be registered, such matter does not function as a mark to identify and distinguish a party's goods. *See* Trademark Act Sections 1, 2, and 45, 15 U.S.C. §§ 1051, 1052, and 1127. *See also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1202 (Oct. 2018).

Here, Mattel alleges the term "emoji" is a common term used in an informational and/or ornamental manner on a variety of goods and services offered by third parties that does not function as a trademark or service mark to indicate the source of goods or services and to identify or distinguish them from others.<sup>25</sup> This is sufficient to allege that the term fails to function as a mark. *See, e.g. In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at \*1 (TTAB 2020) ("Widely used commonplace messages are those that merely convey ordinary, familiar concepts or sentiments and will be understood as conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function.").

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<sup>24</sup> *See* '338 Opposition, 4 TTABVUE 7-8, ¶¶ 31-34, '645 Cancellation, 1 TTABVUE 5, ¶¶ 11-14; '957 Cancellation, 1 TTABVUE 7, ¶¶ 12-15.

<sup>25</sup> *Id.*

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#### **d. Mere Descriptiveness**

Mattel next alleges the EMOJI mark is merely descriptive and lacks acquired distinctiveness under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). A plaintiff asserting mere descriptiveness must affirmatively plead that the mark merely describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015). Mattel alleges in relevant part:

On information and belief, Registrant's alleged EMOJI trademark, when used on or in connection with the goods and services identified in the Registration, is merely descriptive of said goods or services. Specifically, each of the goods or services at issue depict or feature emoji, that is, "any of various small images, symbols, or icons used in text fields in electronic communication (as in text messages, e-mail, and social media) to express the emotional attitude of the writer, convey information succinctly, communicate a message playfully without using words, etc." Definition of "Emoji", Merriam-Webster.com, July 6, 2020, <https://www.merriamwebster.com/dictionary/emoji>.

Mattel also alleges the mark lacks "secondary meaning."<sup>26</sup> The Board finds Mattel's allegations to be sufficiently pleaded.

#### **e. Lack of Bona Fide Intent to Use**

Finally, Mattel claims emoji lacked the bona fide intent to use its marks in commerce "at the time of filing the application in the United States or at any relevant time thereafter."<sup>27</sup> Trademark Act Sections 60(5) and 66(a) require applicants to

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<sup>26</sup> See '338 Opposition, 4 TTABVUE 8-9, ¶¶ 35-37, '645 Cancellation, 1 TTABVUE 5-6, ¶¶ 15-17; '957 Cancellation, 1 TTABVUE 8, ¶¶ 16-18.

<sup>27</sup> See '338 Opposition, 4 TTABVUE 7-8, ¶¶ 31-34, '645 Cancellation, 1 TTABVUE 6, ¶¶ 18-20; '957 Cancellation, 1 TTABVUE 9, ¶¶ 38-40.

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verify that they have a bona fide intent to use the applied-for mark in U.S. commerce as of the application filing date. 15 U.S.C. §§ 1141(5), 1141f(a). *See also* TBMP § 1904.01(c). Therefore, lack of bona fide intent is a proper statutory ground on which to challenge a request for extension under Section 66(a) of the Act. In determining whether an applicant under Section 66(a) possesses the requisite bona fide intention to use the mark in commerce, the Board will employ the analysis suggested or required by the legislative history and case law pertaining to Section 1(b) applications. *Société Des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, 2020 BL 293820, at \*12 (TTAB 2020).

Here, Mattel’s allegations are conclusory and based solely “on information and belief,” without any factual underpinnings to support such belief. *Cf. Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506-07 (TTAB 1993) (absence of documents evidencing an applicant’s claimed bona fide intent to use the mark provides a sufficient basis for pleading claim). Accordingly, the claims are insufficiently pleaded, and therefore are **dismissed without prejudice**.

## **2. Fifth, Sixth, and Seventh Affirmative Defenses—Unclean Hands, Estoppel, Waiver, and Acquiescence**

emoji’s fifth, sixth, and seventh affirmative defenses assert “unclean hands” based on Mattel’s lack of proprietary rights in a similar mark, estoppel, and “waiver and/or acquiescence.”<sup>28</sup>

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<sup>28</sup> *See* ’338 Opposition, 7 TTABVUE 4, ¶¶ 5-7, ’645 Cancellation, 4 TTABVUE 4-5, ¶¶ 5-7; ’957 Cancellation, 4 TTABVUE 4, ¶¶ 5-7.

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The asserted defenses of unclean hands,<sup>29</sup> estoppel, waiver, and acquiescence are conclusory allegations lacking any factual bases and specific alleged misconduct on the part of Mattel.<sup>30</sup> Accordingly, Mattel’s motion is **granted** as to the fifth, sixth and seventh affirmative defenses in each proceeding, which are **stricken**.

### 3. Eighth Affirmative Defense—Reservation of Rights

emoji’s eighth affirmative defense in each proceeding attempts to reserve the right to assert other claims and defenses that may be uncovered during discovery.<sup>31</sup> A reservation of the right to amend its answer to add affirmative defenses or counterclaims is an improper reservation under the Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923 F. Supp.2d 1133, 1141 (N.D. Ill. 2013) (reservation of right to add affirmative defenses at a later date is improper). The proper way to plead

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<sup>29</sup> To the extent emoji’s “unclean hands” restates its fourth affirmative defense, it is also insufficiently pleaded.

<sup>30</sup> To plead the defense of acquiescence, a defendant must allege: (1) an active representation that a right or claim would not be asserted; (2) the delay between the active representation and assertion of the right or claim was not excusable; and (3) the delay caused the undue prejudice. *Coach House Rest. Inc. v. Coach and Six Rests. Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404 (11th Cir. 1991). By “waiver,” the Board generally assumes that the defending party is attempting to assert a defense based on “estoppel by agreement” or “contractual estoppel,” i.e., that a prior agreement between the parties estops the plaintiff from filing the present opposition or cancellation proceeding. *See, e.g., Danskin, Inc. v. Dan River, Inc.*, 498 F.2d 1386, 182 USPQ 370, 372 (CCPA 1974); *M-5 Steel Mfg. Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001). A defense of unclean hands must be supported by specific allegations of misconduct by plaintiff that, if proved, would prevent the plaintiff from prevailing on its claim. *See Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1987). In addition, the misconduct must be related to the plaintiff’s claim. *See Tony Lama Co. v. Di Stefano*, 206 USPQ 176, 179 (TTAB 1980); 6 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:48 (5th ed. Mar. 2019).

<sup>31</sup> *See* ’338 Opposition, 7 TTABVUE 4, ¶ 8, ’645 Cancellation, 4 TTABVUE 5, ¶ 8; ’957 Cancellation, 4 TTABVUE 5, ¶ 8.

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additional affirmative defenses or counterclaims is to file a motion under Fed. R. Civ.

P. 15. Accordingly, Mattel's motion is **granted** as to the eighth affirmative defense in each proceeding, which are **stricken**.

#### **4. Summary; Leave to Replead**

Mattel's counterclaim in the '338 Opposition for abandonment and claims for lack of bona fide intent to use in the '338 Opposition, '645 Cancellation and '957 Cancellation are **dismissed without prejudice**. Petitioner's motion to strike Respondent's affirmative defenses is **granted**.

Nonetheless, it is the Board's practice, when finding a pleading deficient, to grant leave to amend the pleading, if leave to replead is not futile. *Dragon Bleu*, 112 USPQ2d at 1929 n.10. Accordingly, Mattel is allowed **20 days** from the date of this order to file and serve amended petitions to cancel in the '645 Cancellation and '957 Cancellation and amended counterclaims in the '338 Opposition which address the deficiencies noted herein, to the extent claims may be properly asserted based on the facts of the case.

emoji is allowed **20 days** from the date of Mattel's amended petitions and counterclaims to file and serve amended answers and affirmative defenses thereto which address the deficiencies noted herein, to the extent the same may be properly asserted based on the facts of the case.<sup>32</sup>

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<sup>32</sup> Amended pleadings should be filed in the appropriate proceeding only, captioned with that proceeding number. emoji should note that certain affirmative defenses (such as laches and acquiescence) are severely limited in inter partes proceedings. See TBMP § 311.02(b)(1) and cases cited therein.

Opposition No. 91264338 (parent)  
Cancellation No. 92074645  
Cancellation No. 92075957

If the parties fail to timely submit amended pleadings, the current pleadings remain the operative pleadings, as modified herein. In the event facts are uncovered during the discovery process that would support additional claims or defenses, a party may file a motion for leave to amend the pleading under Fed. R. Civ. P. 15(a). *See* TBMP § 507.

The remaining proceeding dates are reset as follows:<sup>33</sup>

Deadline for Discovery Conference	4/8/2021
Discovery Opens	4/8/2021
Initial Disclosures Due	5/8/2021
Expert Disclosures Due	9/5/2021
Discovery Closes	10/5/2021
Pretrial Disclosures Due for Party in Position of Plaintiff in Original Claim	11/19/2021
30-day Trial Period Ends for Party in Position of Plaintiff in Original Claim	1/3/2022
Pretrial Disclosures Due for Party in Position of Defendant in Original Claim and in Position of Plaintiff in Counterclaim	1/18/2022
30-day Trial Period Ends for Party in Position of Defendant in Original Claim, and in Position of Plaintiff in Counterclaim	3/4/2022
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Original Claim and in Position of Defendant in Counterclaim	3/19/2022
30-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Original Claim, and in Position of Defendant in Counterclaim	5/3/2022
Pretrial Disclosures Due for Rebuttal of Party in Position of Plaintiff in Counterclaim	5/18/2022
15-day Trial Period Ends for Rebuttal of Party in Position of Plaintiff in Counterclaim	6/17/2022
Opening Brief for Party in Position of Plaintiff in Original Claim Due	8/16/2022

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<sup>33</sup> References are to the parties' positions in the '338 Opposition.

Opposition No. 91264338 (parent)

Cancellation No. 92074645

Cancellation No. 92075957

Combined Brief for Party in Position of Defendant in Original Claim and Opening Brief as Plaintiff in Counterclaim Due	9/15/2022
Combined Rebuttal Brief for Party in Position of Plaintiff in Original Claim and Brief as Defendant in Counterclaim Due	10/15/2022
Rebuttal Brief for Party in Position of Plaintiff in Counterclaim Due	10/30/2022
Request for Oral Hearing (optional) Due	11/9/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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