

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

June 2, 2021

Cancellation No. 92076108

*Summit Tech Multimedia
Communications, Inc.*

v.

Anne-Marie El-Boustani

J. Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of Petitioner's February 16, 2021 motion to strike each of Respondent's five affirmative defenses. The motion is fully briefed. 5 TTABVUE 2.¹

Relevant Background

This proceeding involves Respondent's two Section 66(a) Principal Register registrations for the standard character mark ODIENCE, namely:

Registration No. 4929787, registered on April 5, 2016, for goods and services in International Classes 9 and 45; and

¹ When referring to the record (motions, briefs, exhibits, etc.) in an inter partes proceeding, the Board cites to the TTABVUE docket electronic database entry number and page number, e.g., 12 TTABVUE 20. *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). TBMP §§ 110.02(b) and 801.01. Also, filings, attachments and exhibits may be in PDF, TIFF or TXT format; however, searchable PDF is preferred. TBMP §§ 110.02(b) and 703.01(i).

Registration No. 4801594, registered on September 1, 2015, for services in International Classes 35 and 42.

Petitioner filed a petition to cancel on the sole ground of abandonment pursuant to Trademark Act § 45, 15 U.S.C. § 1127.

On February 2, 2021, Respondent filed a timely answer in which she denies all allegations, and sets forth five matters captioned as affirmative defenses. 4 TTABVue 3-4. Petitioner moved to strike the affirmative defenses pursuant to Fed. R. Civ. P. 12(f).²

Analysis

Trademark Rule 2.114(b)(2) provides for the pleading of various affirmative defenses in an answer to a petition to cancel. TBMP § 311.02. The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f); TBMP § 506; *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Internet Inc. v. Corp. for Nat'l Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996); *Am. Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). The Board has the authority to strike from a pleading an impermissible or insufficient claim, or portion of a claim. TBMP § 506.01. Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d at 1292.

² The Federal Rules of Civil Procedure cited herein are applicable to this inter partes proceeding pursuant to Trademark Rule 2.116(a). TBMP § 101.02.

The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d at 1292. *See also*, TBMP §§ 309.03, 311.02(b)(1) and 506.01. The Board 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. *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

The Board turns to the matters which Respondent set forth as affirmative defenses, and Petitioner's motion to strike.³

First Affirmative Defense: The Petition to Cancel fails to state a claim upon which relief may be granted.

The assertion that the petition to cancel fails to state a claim upon which relief can be granted is not an affirmative defense. Such an assertion is a challenge to the legal sufficiency of the pleading, a challenge which may be properly brought by way of filing a motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6) before or concurrently with the answer. TBMP § 503.01. Respondent filed an answer; Respondent did not file a Fed. R. Civ. P. 12(b)(6) motion.

Accordingly, Petitioner's motion is **granted**. The affirmative defense is stricken and will be given no consideration.

³ The Board has reviewed and considered the briefs on the motion, but does not repeat or discuss all of the arguments, and does not discuss irrelevant arguments. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

The exhibits submitted with the briefs, as well as the parties' extensive arguments that go to the exhibits and thus to the merits of the allegations, have been given no consideration in adjudicating the motion to strike. The parties may properly introduce and discuss their exhibits at trial, as timely and appropriate pursuant to the Rules of Procedure governing trial.

In its discretion, and to clarify the record going forward, the Board has reviewed the petition to cancel and finds that in its allegations Petitioner sufficiently alleges its entitlement to a statutory cause of action,⁴ and the ground of abandonment, and thus states a claim upon which relief can be granted. In relation to its entitlement - more specifically its interest in the proceeding and claim of damage - Petitioner specifically alleges that it “has a bona fide intent to use of the same, or a similar mark, for the same or related goods and services, for which Petitioner is about to file an intent-to-use application,” that it “believes registration will be refused in view of Respondent’s registration if Respondent’s abandoned mark is not cancelled,” and that it “intends to use and register the mark ODIENCE for goods and services that include some or all of the goods and services listed in” the subject registrations. 1 TTABVue 4. By way of these allegations which essentially set forth that it is a competitor of Respondent, Petitioner alleges a reasonable belief of damage that would result from the continued registration of Respondent’s registrations. *See, e.g., M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd.*, 2019 U.S.P.Q.2d 149090, at *4 (TTAB 2019) (“standing” may be established by alleging and proving that plaintiff is a competitor of defendant and has a present or prospective right to use the name).

⁴ The parties discuss various matters that go to Petitioner’s “standing.” Board decisions previously analyzed the requirements of Sections 13 and 14 under the rubric of “standing.” However, mindful of the United States Supreme Court’s decision and direction in *Lexmark Int’l., Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014), the Board now refers to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, the Board’s prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain equally applicable.

Also, Petitioner sufficiently alleges the elements of the statutory ground of abandonment. *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015, 1020 (TTAB 2018) (discussing pleading requirements for a legally sufficient claim of abandonment). Thus, the petition to cancel states a claim upon which relief can be granted.

Second Affirmative Defense: The Claims set forth in the Petition to Cancel are barred in whole or in part by the Doctrine of Laches.

Fourth Affirmative Defense: The Claims set forth in the Petition to Cancel are barred in whole or in part by the Doctrine of Acquiescence.

The equitable defenses of laches and acquiescence are not available against certain claims, including claims of abandonment. *See, e.g., TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (it is in the public interest to remove abandoned registrations from the register). TBMP § 311.02(b)(1). These defenses are not available against abandonment for, at a minimum, public policy reasons. *Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (it is within the public interest to have certain registrations removed from the register, and this interest (*quoting W. D. Byron & Sons, Inc. v. Stein Brothers Mfg. Co.*, 146 USPQ 313, 316 (TTAB 1965)) "cannot be waived by the inaction of any single person or concern no matter how long the delay persists," *aff'd*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967). As the Board reiterated in *Am. Vitamin Prods. Inc. v. DowBrands, Inc.*, 22 USPQ2d at 1314, "Where the ground for cancellation is abandonment, equitable defenses such as laches, bad faith and unclean hands, are

not available in light of the overriding public interest in removing abandoned registrations from the register."

Furthermore, Respondent's arguments that her defenses "satisfy the notice provision giving fair notice of the defenses asserted" and that they are "legally sufficient and permissible to give fair notice" are incorrect. 7 TTABVUE 6, 9-11. It is axiomatic that in inter partes proceedings a pleading of *any* affirmative defense must include enough detail in the supporting factual allegations to give the plaintiff fair notice of the basis for the defense. *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (Trademark Act § 18, 15 U.S.C. § 1068 claim or defense must be specific enough to provide fair notice to adverse party of restriction being sought); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim must include enough detail to give fair notice of claim). But Respondent set forth no allegations whatsoever to provide the requisite notice of the alleged factual basis for the attempted defenses; rather, she lists boilerplate, pro forma statements that merely identify the doctrines of "laches" and "acquiescence," and that set forth nothing further. The purported pleadings of the defenses fail to meet the requisite legal standard and are insufficient.

Accordingly, Petitioner's motion is **granted**. The affirmative defenses are stricken and will be given no consideration.

Third Affirmative Defense: The Claims set forth in the Petition to Cancel are barred in whole or in part by the Doctrine of Waiver.

As noted, a pleading of any affirmative defense must include enough detail in the supporting factual allegations to give the plaintiff fair notice of the basis for the

defense. *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d at 1953; *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d at 1538. Here again, Respondent failed to set forth any factual allegations, merely listing a boilerplate, pro forma identification of “the doctrine of waiver.” The pleading fails to meet the requisite legal standard and is insufficient. Consequently, Respondent failed to satisfactorily plead this affirmative defense.

Accordingly, Petitioner’s motion is **granted**. The affirmative defense is stricken and will be given no consideration.

Fifth Affirmative Defense: The Claims set forth in the Petition to Cancel are barred in whole or in part by the Doctrine of Assumption of Risk.

Respondent fails to set forth an authority which states that the principle of assumption of risk is a cognizable affirmative defense in Board inter partes proceedings in defense of a claim of abandonment. This is not a cognizable affirmative defense in Board proceedings. Furthermore, she fails to set forth any factual allegations which would place Petitioner on fair notice of the basis for asserting the principle and for its applicability to this proceeding.

Accordingly, Petitioner’s motion is **granted**. The affirmative defense is stricken and will be given no consideration.

Resumption and Schedule

The filing of the motion relating to the pleading pursuant to Fed. R. Civ. P. 12 stayed the parties’ obligation to conference and to serve initial disclosures. TBMP § 316. Proceedings are **resumed** and dates are reset on the following schedule to which the parties are expected to adhere:

Deadline for Required Discovery Conference	7/1/2021
Discovery Opens	7/1/2021
Initial Disclosures Due	7/31/2021
Expert Disclosures Due	11/28/2021
Discovery Closes	12/28/2021
Plaintiff's Pretrial Disclosures Due	2/11/2022
Plaintiff's 30-day Trial Period Ends	3/28/2022
Defendant's Pretrial Disclosures Due	4/12/2022
Defendant's 30-day Trial Period Ends	5/27/2022
Plaintiff's Rebuttal Disclosures Due	6/11/2022
Plaintiff's 15-day Rebuttal Period Ends	7/11/2022
Plaintiff's Opening Brief Due	9/9/2022
Defendant's Brief Due	10/9/2022
Plaintiff's Reply Brief Due	10/24/2022
Request for Oral Hearing (optional) Due	11/3/2022

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, the manner and timing of taking testimony, matters in evidence, 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).

It is the responsibility of each party to ensure that the Board has the party's current correspondence address, including an email address. TBMP § 117.07. The Board must be promptly notified of any address or email address changes for the parties or their attorneys.