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

Proceeding no.	92079334
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

Vincent A. Scavo

Petitioner

v.

Comfort Research, LLC

Registrant

Cancellation Proceeding No.:  
92079334

Mark: GOLIATH

U.S. Trademark Reg. No.  
5,882,052

**REGISTRANT’S MOTION TO STRIKE INSUFFICIENT DEFENSES**

Pursuant to Federal Rule of Civil Procedure 12(f) and Trademark Trial and Appeal Board Manual of Procedure § 506, Petitioner Vincent A. Scavo (“Petitioner”) moves to strike several insufficient defenses from the Answer filed by Comfort Research, LLC (“Registrant”) in response to the Petition for Cancellation of U.S. Trademark Reg. No. 5,882,052 filed by Petitioner on March 28, 2022. Specifically, Petitioner respectfully requests that paragraphs 2, 3, 4, 5, and 6 of the section labeled “COMFORT RESEARCH’S DEFENSES” in Respondent’s Answer (“Respondent’s Defenses”) be stricken.

**MEMORANDUM OF LAW**

**I. Standard of Motion to Strike**

In a cancellation proceeding, the Federal Rules of Civil Procedure apply. *See* 37 C.F.R. § 2.116(a). The purpose of the motion to strike under Rule 12(f) are to strike “an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.” Fed. R. Civ. P. 12(f). The Board is able to act in order to strike such matter either in response to the motion, or on its

own without specific direction of any petitioner. *Id.* Courts and the Board have found affirmative defenses to be insufficient in several different situations. In some instances, the board has stricken affirmative defenses where those defenses were not available in a particular type of proceeding. *See e.g., Lacteos de Honduras S.A. v. Industrias Sula, S. De R.L. de C.V.*, 2020 USPQ.2d 10087 (TTAB 2020) (granting motion to strike due to unavailability of defense of priority based on Article 7 in an opposition proceeding where opposer pleads registrations); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (granting motion to strike laches, bad faith, and unclean hands defenses, as such defenses are unavailable in a cancellation proceeding based on an allegation of abandonment). In other instances, the board has stricken defenses where such a defense does not actually negate the allegations alleged by petitioner. *See e.g., American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (granting motion to strike defense of “no likelihood of confusion” as likelihood of confusion was not a pleaded issue in the case). The primary function of Fed. R. Civ. P. 12(b)(6) “is to allow the court to eliminate actions that are fatally flawed in their legal premise and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys.*, 26 U.S.P.Q.2d at 1041.

## **II. Paragraph 2 of Respondent’s Defenses should be stricken as laches and unclean hands defenses are unavailable for a cancellation proceeding based on abandonment**

In paragraph 2 of Respondent’s Defenses, Respondent asserts that Petitioner’s claims are barred due to, among several other reasons that are addressed further separately, laches and unclean hands. The elements of a laches defense require a respondent to show 1. Petitioner is delayed in asserting its trademark rights, 2. The delay is inexcusable, and 3. The delay caused undue prejudice. *Kars 4 Kids Inc. v. America Can!*, 8 F.4<sup>th</sup> 209, 220 (3d Cir. 2021). Here, the

defendant merely stated a laches defense, without alleging any delay or any reason such a delay would cause Respondent any undue prejudice. In this case, it is unclear how Petitioner possibly could have delayed in asserting any trademark rights, as U.S. Application Serial Number 90/378,162 is still pending before the USPTO in light of an office action rejection based on Respondent's mark that was only issued on January 12, 2022.

However, even if the elements of laches had been properly plead, the Board has consistently held that laches defenses are unavailable against any claim of abandonment in a trademark proceeding, as the Board has noted that it is against public policy to allow a laches defense as there is a public interest in removing abandoned marks from the trademark register. *See e.g., American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2 1313 (TTAB 1992); *DSM IP Assets B.V. v. Neurohacker Collective, LLC*, 2019 WL 912221, at \*2 (T.T.A.B. Feb. 21, 2019).

Therefore, Petitioner respectfully requests that the laches defense be stricken from Paragraph 2, as such a defense is insufficient and superfluous, and would only serve to distract from the main focus of the proceedings.

A defense of unclean hands requires that the respondent show that 1. The petitioner engaged in misconduct, and 2. That the misconduct relates to the claim or defense it seeks to assert. *See e.g., 1-800-Contacts, Inc. v. Lens.com, Inc.*, 722 F.3d 1229, 1255 (10<sup>th</sup> Cir. 2013). In TTAB actions, the Board has stated that unclean hands defenses should be rejected when the defending party fails to specifically plead the alleged misconduct that is the basis of its defense. *See e.g., Club Amenities, LLC v. Pettenon Cosmetici SNC*, 2005 WL 7054527, at \*2-3 (TTAB Nov. 29, 2005). The Respondent does not allege any misconduct on behalf of the Petitioner, nor

any facts regarding this accusation whatsoever. Furthermore, the defense of unclean hands has been held to be unavailable as a defense against abandonment claims before the TTAB and claims of unclean hands have been stricken in the past in such cases, as in *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2 1313 (TTAB 1992).

Therefore, Petitioner respectfully requests that the unclean hands defense be stricken from Paragraph 2, as such a defense is insufficient and superfluous, and would only serve to distract from the main focus of the proceedings.

**III. Paragraph 2 of Respondent's Defenses should be stricken as Respondent fails to allege any factual basis or details regarding its defense based on estoppel, waiver, or unfair competition**

Paragraph 2 also alleges that Petitioner's claims are barred due to waiver, estoppel, and unfair competition. In order to show a defense of equitable estoppel before the TTAB, Respondent must show 1. Misleading action or inaction by the plaintiff indicating that the plaintiff is not challenging the defending party's right to obtain a registration, 2. That the defendant relied on the plaintiff's action or inaction, and 3. That the defendant would be materially prejudiced if the plaintiff is permitted to pursue its claim. *See e.g., Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 734 (Fed. Cir. 1992). The Respondent fails to allege any factual basis for its claim of estoppel, despite that the fact that any action or inaction that the defendant allegedly relied upon would inherently be known by the Respondent at the time of filing the Answer, and before discovery.

Therefore, Petitioner respectfully requests that the estoppel defense be stricken from Paragraph 2, as such a defense is insufficiently plead, and has no factual basis presented in the Answer.

Petitioner is unclear as to the meaning of “waiver” in the context of affirmative defenses to the abandonment action. Assuming *arguendo* that waiver means that Petitioner has waived its right to challenge the registration of Respondent’s mark, Respondent has presented no evidence at all regarding what action or inaction in the past would have constituted such waiver.

Furthermore, Petitioner respectfully submits that the defense of waiver is likely invalid as a defense to a cancellation on the basis of abandonment, as the court has previously noted that it is in the public interest to remove abandoned trademarks from the register. *See e.g., American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2 1313 (TTAB 1992).

Therefore, Petitioner respectfully requests that the waiver defense be stricken from Paragraph 2, as such a defense is insufficiently plead, and has no factual basis presented in the Answer.

Petitioner notes that it is unclear what a defense based on “unfair competition” means. Unfair competition cases are often brought as cases alleging unlawful, deceitful, or fraudulent business actions, and preventing unfair competition is often cited as one of the main purposes of trademark law, but, to Petitioner’s knowledge, there does not exist any defense to abandonment based on unfair competition. Furthermore, Respondent does not provide any additional details or factual allegations regarding what this defense might involve, insufficiently informing Petitioner of any allegations.

Therefore, Petitioner respectfully requests that the unfair competition defense be stricken from Paragraph 2, as it does not seem that such a defense exists to allegations of non-use or abandonment, and, if it does, the Respondent has provided insufficient factual basis in support of such defense.

**IV. Paragraph 3 of Respondent's Defenses should be stricken as Respondent fails to allege any factual basis or details regarding its defense based on the doctrine of acquiescence and the doctrine of acquiescence is an improper defense to claims of abandonment**

In Paragraph 3 of Respondent's Defenses, Respondent asserts that Petitioner's claims are barred, in whole or in part, by the doctrine of acquiescence. The doctrine of acquiescence is meant to be used as a defense for situations in which a respondent relied on a petitioner's affirmative words or conduct indicating it would not assert its trademark rights against the defendant. A defense under the doctrine of acquiescence requires the respondent show 1. Plaintiff's affirmative words or conduct amounted to express or implied assurance that the plaintiff would not assert a claim against defendant, 2. Delay between assurance and claim is not excusable, and 3. Delay caused the defendant undue prejudice. *See e.g., Sellar Agency Council, Inc. v. Kennedy Ctr. for Real Estate Educ., Inc.*, 621 F.3d 981, 988-89 (9th Cir. 2010). In the TTAB, the Board has held that respondents must show that the petitioner expressly or by clear implication consented to or encouraged the defendant's use of the mark. *See e.g., Hitachi Metal Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 U.S.P.Q. 1057, 1981 WL 48128, at \*12 (T.T.A.B. Apr. 14, 1981). The Respondent fails to allege any facts regarding a defense under doctrine of acquiescence, despite the fact that what alleged words or conduct the Respondent relied upon would be knowledge particularly available to the Respondent before the beginning of

discovery or any litigation. Additionally, the Board has stated “it is well established that the equitable defenses of laches and acquiescence are not available against claims of genericness, descriptiveness, fraud, and **abandonment.**” *Saint-Gobain Abrasives, Inc. v. Unova Indus. Automation Sys., Inc.*, 66 U.S.P.Q.2d 1355, 2003 WL 880554, at \*5 (T.T.A.B. Mar. 4, 2003) (emphasis added).

Therefore, as insufficient facts are plead and as the defense under the doctrine of acquiescence is improper as a defense to claims of abandonment, Petitioner respectfully requests that Paragraph 3 of Respondent’s Defenses be stricken.

**V. Paragraph 5 of Respondent’s Defenses should be stricken as cancellation is an appropriate remedy for the alleged harm in addition to, or in lieu of, any remedy at law**

In Paragraph 5 of Respondent’s Defenses, Respondent asserts that Petitioner is not entitled to injunctive or equitable relief as it has not suffered irreparable harm and because, if Petitioner had been injured, he would have an adequate remedy at law.

The idea that Petitioners must bring a case to court in order to cancel registration of a trademark due to abandonment or non-use rather than bringing an action through the TTAB is contrary to the intentions of the TTAB as a means to resolve particular disputes related to trademark registration as an alternative to the Article III court system. Furthermore, Petitioner notes that it is unclear what damages would be sufficient to resolve the issue in this case, as damages alone would not cause cancellation of Respondent’s mark and therefore would not assist in allowing Petitioner’s own trademark application to be registered.

As Respondent's allegations in Paragraph 5 of Respondent's Defenses have no bearing on the merits of the case, Petitioner respectfully requests that Paragraph 5 of Respondent's Defenses be stricken.

**VI. Paragraph 6 of Respondent's Defenses should be stricken as Petitioner is not stating a claim for relief on the basis of "likelihood of confusion, infringement, and/or willful infringement."**

In Paragraph 6 of Respondent's Defenses, Respondent asserts that Petitioner's claims for relief fail to properly set forth a claim of likelihood of confusion, infringement, and/or willful infringement. This appears to be form language for an unrelated case, as the Petition for Cancellation is based on non-use of the Respondent's Mark and abandonment of the Respondent's Mark, not on likelihood of confusion with an existing registered mark.

Petitioner notes that the only relevance likelihood of confusion has in the present case is that Petitioner receiving an office action refusing registration of U.S. Application Serial No. 90/378,162 on the basis of Trademark Act Section 2(d). However, Petitioner need not show the elements of likelihood of confusion in order to prevail in this case, as the Examining Attorney's refusal to allow registration of '162 application provides sufficient basis for harm to the Petitioner in this matter.

Therefore, as Respondent's points in Paragraph 6 of Respondent's Defenses are irrelevant to the present Petition for Cancellation, Petitioner respectfully requests Paragraph 5 of Respondent's Defenses be stricken.

WHEREFORE, Petitioner respectfully requests that paragraphs 2, 3, 4, 5, and 6 of the section labeled "COMFORT RESEARCH'S DEFENSES" in Respondent's Answer be stricken, and that

Petitioner be awarded such other and further relief as the Trademark Trial and Appeal Board shall deem just and proper.

Respectfully submitted,

Vincent Scavo  
By his Attorneys,

Dated: May 25, 2022

/Neil M. Barnes/  
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**CERTIFICATE OF TRANSMISSION**

I, Neil M. Barnes, hereby certify that the foregoing **MOTION TO STRIKE** is being transmitted to the USPTO Trademark Trial and Appeal Board through ESTTA on May 25, 2022 for filing in the following proceeding:

**Cancellation Proceeding No.:** 92079334

Mark: GOLIATH  
Registration No.: 5,882,052  
Filed: July 25, 2018  
Registered: October 15, 2019

Dated: May 25, 2022

By: /Neil M. Barnes/  
Neil M. Barnes

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing, **MOTION TO STRIKE** is being served on Comfort Research, LLC on May 25, 2022, via email to counsel for Respondent, addressed as follows:

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Attorneys for Respondent, Comfort Research, LLC

Dated: May 25, 2022

By: /Neil M. Barnes/  
Neil M. Barnes