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Elgin

March 17, 2021

Opposition No. 91246962

*Richard Starkey aka Ringo Starr*

*v.*

*Pacific Coast Holdings IP, LLC*

**Before Mermelstein, Heasley, and Johnson,  
Administrative Trademark Judges.**

**By the Board:**

This case comes up on Opposer's motion for partial summary judgment (filed November 7, 2020) on claims of: (i) "waiver"; and (ii) fraud on the USPTO.<sup>1</sup> The parties have fully briefed the motion.<sup>2</sup>

On March 13, 2019, Opposer filed a notice of opposition<sup>3</sup> against Applicant's application Serial No. 87792537 for the mark RING O in standard characters for

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<sup>1</sup> 15 TTABVUE. 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).

<sup>2</sup> The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments. The parties' arguments and evidence are not summarized except as necessary to explain the Board's decision. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). The Board acknowledges the receipt of bar information filed by counsel for Applicant and Opposer on December 9 and 10, 2020, respectively, and has updated its records accordingly.

<sup>3</sup> 1 TTABVUE.

“adult sexual aids, namely, rubber rings for the penis; vibrating rubber rings for the penis; condoms” in International Class 10.<sup>4</sup> Following the Board’s order dismissing several of Opposer’s claims, Opposer filed an amended Notice of Opposition alleging six claims: (1) Applicant’s mark identifies a living individual without his consent under Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c); (2) priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); (3) false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a);<sup>5</sup> (4) dilution by blurring and tarnishment under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c); (5) fraud on the USPTO; and (6) misrepresentation of source.<sup>6</sup>

In support of his claims, Opposer pleads ownership of twelve registrations for the marks RINGO and RINGO STARR for a variety of goods and services, including toys and games; jewelry; purses, wallets, bags and backpacks; entertainment services; sound and video recordings; posters, brochures and catalogs; musical instruments, namely drumsticks; and clothing.<sup>7</sup> Opposer also asserts common-law rights since at

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<sup>4</sup> Serial No. 87792537, filed February 9, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. 1051(a), alleging dates of first use of July 2008.

<sup>5</sup> Opposer mistakenly cites to Section 2(c) rather than Section 2(a) of the Trademark Act in this claim. *See* 9 TTABVUE 8-9, ¶ 31.

<sup>6</sup> 9 TTABVUE.

<sup>7</sup> *Id.* at 3-4. We note Opposer’s pleaded registrations were not made of record in connection with his notice of opposition or his motion for summary judgment, *see* Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d) (records from the USPTO’s TSDR electronic database showing status and title); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1654 (TTAB 2010) (witness testimony that registrations are subsisting and are owned by opposer), *aff’d*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011). Rather, Opposer merely submitted copies of the original certificates of registration with its motion. *See* 15 TTABVUE 38-61 (certificates of registration); *see id.* at 30-31 (Nassim Declaration ¶¶ 3-14) (not attesting to

least 1962 in the registered marks for the registered goods, and “in the ‘RINGO®’ and ‘RINGO STARR®’ marks for use in connection with various additional goods and services.”<sup>8</sup>

Applicant denies the salient allegations in the Notice of Opposition.<sup>9</sup>

## **I. The Record**

In support of his motion for summary judgment, Opposer introduces the declarations of Bruce Grakal, Opposer’s General Counsel for over 40 years; and Sunny Nassim, counsel of record for Opposer in this proceeding.<sup>10</sup> Both declarations introduce exhibits in support of the motion.

In opposition to Opposer’s motion for summary judgment, Applicant submits the declarations of Justin Ross, sole owner of Applicant and nonparty Momentum Management, LLC (“Momentum”);<sup>11</sup> and Jesse Gessin and Sheila Mojtehed, both counsel of record for Applicant in this proceeding.<sup>12</sup> Mr. Ross’s and Mr. Gessin’s declarations introduce exhibits in opposition to the motion.

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status and current ownership), 25-26 (Grakal Declaration ¶¶ 6-17) (same). The certificates of registration are not sufficient to show the current status of and the current title to the registrations. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 704.03(b)(1)(A) (2020).

<sup>8</sup> 9 TTABVUE 4, ¶ 5.

<sup>9</sup> 10 TTABVUE.

<sup>10</sup> *See* 15 TTABVUE.

<sup>11</sup> 18 TTABVUE 28-33. Applicant acquired certain trademark rights from, and now licenses the subject mark to, Momentum. 10 TTABVUE 13, ¶ 67 (Answer); 18 TTABVUE 28 (Ross Declaration ¶ 2).

<sup>12</sup> 18 TTABVUE 34-38.

In reply, Applicant submitted the declaration of Michael Saltz, counsel of record for Opposer in this proceeding, to controvert the declaration of Ms. Mojtehedei.<sup>13</sup>

## II. Review of Claims

A decision on summary judgment necessarily requires a review of the operative pleadings. *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009). Opposer has moved for summary judgment on two grounds. First, Opposer argues that Applicant committed fraud on the USPTO in the prosecution of his application.<sup>14</sup> Second, Opposer contends that he is entitled to summary judgment on “two irrevocable waivers . . . : 1) the equitable estoppel of subsequent applications pursuant to an abandonment, with prejudice, of a previous application for the exact same mark at issue here; and 2) an irrevocable waiver of all right, title and interest to file another application for the mark ‘RING O’ in any class.”<sup>15</sup>

### A. Unpleaded Claims

Opposer may not obtain summary judgment on an unpleaded or insufficiently pleaded claim. *See* Fed. R. Civ. P. 56(a); *Omega SA v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016) (“A party may not obtain summary judgment on an unpleaded claim or defense”); *Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010) (“the Board will not hesitate to deny any motion for summary judgment on an unpleaded claim or defense unless the motion for

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<sup>13</sup> 22 TTABVUE.

<sup>14</sup> *See* 15 TTABVUE 13-22.

<sup>15</sup> 15 TTABVUE 3. *See also id.* at 10 (“[S]uch conduct constitutes: 1) an irrevocable waiver of Applicant’s right to submit the Application. . . .”).

summary judgment is accompanied by an appropriate motion to amend or is withdrawn and refiled with such a motion to amend”). *See also* TBMP § 528.07(a).

Applicant argues that Opposer’s motion improperly seeks judgment on unpleaded claims of fraud based on Applicant’s application declaration, claims of “waiver” and “estoppel,” and—to the extent argued by Opposer—abandonment.<sup>16</sup>

As to the putative fraud claim, a plaintiff claiming that the declaration or oath in a defendant’s application for registration was executed fraudulently (in that there was another use of the same or a similar mark for the same or similar goods when the oath was signed) must allege particular facts which, if proven, would establish the following:

- (1) There was in fact another use of the same or similar mark at the time the oath was signed;
- (2) The other user had legal rights superior to Applicant’s;
- (3) Applicant knew that the other user had rights in the mark superior to applicant’s, and either believed that a likelihood of confusion would result from applicant’s use of its mark or had no reasonable basis for believing otherwise; and
- (4) Applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

*See Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). Considering the amended Notice of Opposition in its entirety, we agree that Opposer did not plead that Applicant knew that Opposer had rights in the mark superior to Applicant’s, and either believed that a likelihood of confusion would result from Applicant’s use of its mark or had no reasonable basis for believing otherwise.

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<sup>16</sup> *See* 18 TTABVUE 13-14, 19-20.

In view thereof, we find the claim that Applicant committed fraud in the execution of its declaration insufficiently pleaded, and therefore decline to consider Opposer's argument in support of this claim.<sup>17</sup>

Turning next to Opposer's putative claim of "waiver," Opposer argues that two "irrevocable waivers" occurred: "1) the equitable estoppel of subsequent applications pursuant to an abandonment, with prejudice, of a previous application for the exact same mark at issue here; and 2) an irrevocable waiver of all right, title and interest to file another application for the mark 'RING O' in any class."<sup>18</sup> Opposer contends a claim of waiver "was expressly pled within the fraud claim. As such, factual allegations exist that permit the Board to draw more than a reasonable inference that waiver occurred."<sup>19</sup> Opposer points to the following allegations in Count V of his amended notice of opposition (allegations emphasized by Opposer in bold and underlined):

65. Pursuant to 37 C.F.R. § 11.1, 37 C.F.R. § 10.23(b)(4), and 37 C.F.R. § 10.23(d), Applicant committed a fraud by way of its Application for "RING O" because Applicant's statements did not reflect uncompromising candor since **Applicant concealed material facts related to a settlement agreement** that was entered into between Opposer and Applicant, **wherein Applicant surrendered any and all rights to apply for the trademark registration of the mark "RING O"**.

66. Specifically, on or about September 12, 2008, Applicant entered into an agreement to withdraw a prior application with the USPTO and agreed to "never [register] 'RING O' as a trademark or service mark (in connection with any goods or services) with any governmental office or agency, including but not limited to the United States Patent and Trademark

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<sup>17</sup> We do not construe Opposer's motion for summary judgment to contend that Applicant abandoned its mark. This claim also was not pleaded.

<sup>18</sup> 15 TTABVUE 3.

<sup>19</sup> 22 TTABVUE 10.

Office, the trademark offices of the 50 states, and any foreign trademark office or agency”. What is more, Applicant, at the time, also agreed in writing that the Agreement “is binding on and inures to the benefit of the parties and their respective representative, parent entities, subsidiaries, affiliates, division, heirs, administrators, predecessors, successors and assigns, each of whom shall be entitled to the benefit of and to enforce its provisions”.

67. PCH is a predecessor in interest and licensee of Momentum Management, LLC and is therefore bound, pursuant to the express terms of the Agreement. As Momentum Management, LLC’s predecessor in interest, PCH has no greater rights to file any application with the USPTO for the trademark “RING O” than did Momentum.

68. Applicant failed to disclose to the USPTO that Applicant’s then president, Justin Ross, signed the Agreement surrendering all such right, title and interest in making any Application to the USPTO for the subject mark.

**69. Applicant had an affirmative legal obligation to disclose to the USPTO that Applicant had previously surrendered, in a binding Agreement, any and all right, title or interest in making any application with the USPTO for the “RING O” Mark.**

**70. Applicant’s intent to deceive the USPTO is evident here by the fact that there is a valid and binding settlement agreement surrendering Applicant’s rights to file a trademark application for the mark “RING O”, yet Applicant proceeded in applying for the mark without informing the USPTO about the settlement agreement. As such, Applicant committed a fraud on the USPTO by concealing that it previously waived all right to file an Application for “RING O” in Class 10.**

**71. Based on the parties’ prior dealings and agreement, Applicant was made aware of Opposer’s prior rights in the “RINGO” Mark.<sup>20</sup>**

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<sup>20</sup> 22 TTABVUE 10 n. 2. Applicant argues that Opposer sought Applicant’s consent to amend its notice of opposition to assert a new claim of “waiver,” which Applicant refused. 18 TTABVUE 13 (citing *id.* at 37-38 (Mojtehedhi Declaration, ¶ 2)). Opposer’s counsel disputes this recounting of events, claiming, inter alia, he “offered to file an amended pleading to make the pleadings more clear if Applicant thought the current pleadings did not put forth enough factual allegations about Applicant’s waiver and surrender of its right to file an application for the subject mark.” 22 TTABVUE 15 (Saltz Declaration, ¶ 5).

We find that Opposer's amended Notice of Opposition fails to mention abandonment of application Serial No. 77409211 by Momentum at all, let alone plead the application as the basis for a claim of "waiver" or estoppel." Accordingly, this claim was not pleaded and is given no consideration.

Next, we construe Opposer's argument that Momentum waived its rights to file an application in its settlement agreement with Opposer, and that such waiver is binding on Applicant, as a claim of contractual estoppel. "[W]hether a mark otherwise entitled to registration is, nevertheless, *barred* therefrom by an agreement between the parties . . . [is an issue] within the jurisdiction of the board and may constitute an independent basis for sustaining the opposition. . . ." *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36, 38 (Fed. Cir. 1985). The Board may consider "the agreement, its construction, or its validity if necessary to decide the issues properly before [the Board] . . . including the issue of estoppel." *See M-5 Steel Mfg. Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1095 (TTAB 2001) (quoting *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 647 (Fed. Cir. 1983)). *Cf.* 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:82 (5th ed., March 2021 update) ("McCarthy") ("Many consent agreements also embody a promise not to use a trademark in a certain format or on a certain line of goods. Such agreements are routinely upheld and enforced.").

Our review of the operative pleadings confirms, and as Opposer admits, the facts supporting a claim of contractual estoppel based on Opposer's agreement with Momentum are buried in the pleaded fraud claim. We conclude that Applicant was

not fairly placed on notice of the claim. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice of the claim).

In view thereof, Opposer's motion for partial summary judgment as to the construed claim of contractual estoppel is given no consideration.

### **B. Pleded Fraud Claim**

We turn to the only pleaded claim that is the subject of Opposer's motion: fraud based on the failure of Applicant to disclose its settlement agreement with Momentum to the USPTO.

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with the application with the intent to deceive the USPTO, in order to obtain a registration to which it otherwise is not entitled. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986).<sup>21</sup>

Opposer's fraud claim is based on a failure to disclose information to the USPTO. Opposer has failed, however, to identify in the notice of opposition any explicit

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<sup>21</sup> To the extent Opposer applies an alternative legal standard set forth by the District Court for the Northern District of California, *see AirWair Int'l Ltd. v. Schultz*, 84 F. Supp. 3d 943, 952 (N.D. Cal. 2020), Opposer again confuses the standard for fraud based on the Applicant's declaration or oath with fraud based on other material misrepresentations of fact. Moreover, the *AirWare* decision expressly distinguishes the *Intellimedia* standard followed by the Board. *See id.* at 952, n.4. Opposer is further advised that proceedings before the Board are governed, to a large extent, by precedential decisions of the Board as well as decisions of the Court of Appeals for the Federal Circuit; the Court of Customs and Patent Appeals; and the Director of the U.S. Patent and Trademark Office. *See* TBMP § 101.03. Accordingly, we have given the argument no consideration.

statements he alleges to be fraudulent.<sup>22</sup> Moreover, pleadings of fraud must allege sufficient underlying facts from which the Board may reasonably infer that a party acted with the requisite state of mind. *Asian & W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009).<sup>23</sup> Opposer fails to plead sufficient facts from which the Board could reasonably infer that Applicant, in failing to disclose the agreement, intended to deceive the USPTO.

Because Opposer's fraud claim is insufficiently pleaded, the motion for partial summary judgment as to this claim is **denied**. See *Consol. Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 621 (TTAB 1986) (denying summary judgment due to insufficiently pleaded fraud claim).

We note, in any event, that even if we were to consider the motion for summary judgment on the merits, the motion would have to be denied because genuine disputes of material fact remain with respect to whether Applicant knowingly made a false, material representation of fact in connection with its application with the intent to

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<sup>22</sup> Opposer relies on a so-called "duty of candor" in the procurement of a trademark registration, citing to 37 C.F.R. § 10.23. See, e.g., 15 TTABVUE 13. Part 10 of the Trademark Rules was removed and reserved in 2013. See *Changes to Representation of Others Before The United States Patent and Trademark Office*, 78 FR 20, 180-01 (Apr. 3, 2013). The new corresponding rules are found in Part 11, which concerns professional misconduct of a practitioner before the USPTO. There is no allegation in the pleadings that Applicant's attorney committed professional misconduct, or that such misconduct can form the basis for a claim of fraud on the USPTO in the procurement of a trademark registration. Trademark Rule 11.804, 37 C.F.R. § 11.804. Opposer's argument suggests that he may be equating fraud in the procurement of a trademark registration with a breach of the duty to disclose in patent matters. The two are very different in concept and application. See 6 McCarthy § 31:62 (comparing fraud in trademark and patent procurement).

<sup>23</sup> The Board previously dismissed Opposer's insufficiently pleaded fraud claim on the same basis and allowed Opposer to replead the claim, see 8 TTABVUE 9-11. Applicant did not challenge the amended claim.

deceive the USPTO.<sup>24</sup> See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987); see also *Copelands' Enters., Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991) (“As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment.”).

### **III. Sua Sponte Review of Remaining Claims and Defenses**

We next undertake a review of the remaining claims and defenses in the pleadings sua sponte in an effort to streamline these proceedings for trial.

#### **A. Notice of Opposition**

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).

We find that, by pleading ownership of twelve registrations comprising the terms “RINGO” and “RINGO STARR,” Opposer sufficiently pleads that his interest in opposing registration of Applicant’s mark is squarely within the zone of interests

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<sup>24</sup> Evidence submitted in connection with the motion for summary judgment is of record for purposes of that motion only. To be considered at trial, the parties must make all evidence properly of record during their testimony periods. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet, Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981); see also TBMP § 528.05(a).

protected by the statute and he has a reasonable belief that damage would be proximately caused by registration of the mark.<sup>25</sup> *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*6-7 (Fed. Cir. 2020) (standard for entitlement to a statutory cause of action).<sup>26</sup>

Turning to the remaining grounds for opposition, we find that Opposer sufficiently pleads the first (Applicant's mark identified a living individual without his consent), third (false suggestion of a connection); and fourth (dilution by blurring and tarnishment) claims.

As to Opposer's claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, Opposer alleges he registered his RINGO and RINGO STARR marks long prior to the use or filing dates of Applicant's RING O mark and application, and Applicant's RING O mark so resembles Opposer's marks previously used in interstate commerce, and not abandoned, so as to be likely to cause confusion, or to cause mistake or to deceive.<sup>27</sup> Accordingly, Opposer sufficiently pleads a Section 2(d) claim as to his registered rights. However, as to his alleged common-law rights, Opposer merely states he has used the RINGO and RINGO STARR marks in commerce since at least 1962 "in connection with a *wide variety* of goods and services" and "also has common law rights in the RINGO® and RINGO STARR® marks for use

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<sup>25</sup> Board decisions previously have 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, our 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).

<sup>26</sup> *See* 9 TTABVUE.

<sup>27</sup> *Id.* at 7-8, ¶¶ 21-28.

in connection with *various additional* goods and services.”<sup>28</sup> These allegations are vague, and insufficient to provide Applicant with fair notice of the basis of Opposer’s claim of common law rights for goods and services other than those which are the subject of his registrations. *See Fair Indigo*, 85 USPQ2d at 1538 (TTAB 2007); *Phillies v. Phila. Consol. Holding Corp.*, 107 USPQ2d 2149, 2153 (TTAB 2013) (“Language in the notice of opposition such as ‘including, but not limited to,’ or ‘wide variety of goods and services’ ... is vague and indefinite and does not provide fair notice of the specific marks on which opposer is relying in support of its 2(d) claim and/or the specific goods and/or services upon which those marks are used[.]”). In view of the foregoing findings, Opposer’s Section 2(d) claim is **dismissed without prejudice** as to his common law rights other than as to the goods and services recited in his registrations.

Finally, we consider Opposer’s claim of misrepresentation of source. In Board proceedings, a party may bring a claim of misrepresentation of source under Trademark Act Section 14(3), 15 U.S.C. § 1064(3), “if the **registered mark** is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used” (emphasis added). This language expressly limits claims of misrepresentation of source to registered marks. Accordingly, such claims may only be entertained in the context of a cancellation proceeding or counterclaim to cancel a pleaded registration. In view thereof, Opposer’s misrepresentation of source claim is **dismissed with prejudice**.

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<sup>28</sup> *Id.* at 3, 4, ¶¶ 1, 5 (emphasis supplied).

## B. Answer and Affirmative Defenses

Applicant denies the salient allegations of the notice of opposition and asserts fourteen “affirmative defenses.”<sup>29</sup> 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.

### *First, Second, Third, Fourth Seventh, and Ninth Defenses*

Applicant’s first (failure to state a claim upon which relief can be granted), second (lack of damage—i.e., entitlement to a statutory cause of action), and third (failure to state a fraud claim) defenses are not true affirmative defenses because they assert purported insufficiencies in Opposer’s pleading, rather than a statement of a defense to a properly pleaded claim. *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738, n.7 (TTAB 2001). Accordingly, the first, second and third affirmative defenses are **stricken**.

Applicant’s fourth (lack of confusion), seventh (lack of dilution), ninth (no false suggestion), and thirteenth (no actual confusion) defenses also are not affirmative defenses. They are permissible, however, as amplifications of Applicant’s denials of Opposer’s claims to give Opposer more complete notice of Applicant’s position. *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1236 n.11 (TTAB 2015); *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); *see also* TBMP § 311.02(d).

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<sup>29</sup> 10 TTABVUE 15-19.

***Fifth and Eleventh Defenses***

Applicant’s fifth and eleventh defenses are based in equity. The fifth affirmative defense asserts that Opposer’s claims “are barred in whole or in part by the doctrines of waiver, acquiescence and/or estoppel” because Opposer has failed to police its marks in connection with goods in International Class 10.<sup>30</sup> The eleventh affirmative defense states that the claims are barred by laches.<sup>31</sup>

“A waiver is ordinarily an intentional relinquishment or abandonment of a known right or privilege.” *Johnson v. Zerbst*, 304 U.S. 458, 464 (1938). Here, Applicant has failed to plead any allegations supporting Opposer’s *intentional* relinquishment or abandonment of rights.

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 & Six Rests., Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404 (11th Cir. 1991). Applicant has not pleaded these allegations or facts supporting them.

Further, the defense of “estoppel” is not pleaded with the appropriate particularity—Applicant has not indicated which type of estoppel it is asserting affirmatively nor provided enough information concerning the nature of the

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<sup>30</sup> *Id.* at 16.

<sup>31</sup> *Id.* at 18.

purported estoppel and the underlying factual circumstances, even in general terms, which may give rise to the purported estoppel.<sup>32</sup>

As to laches, as applied in trademark opposition or cancellation proceedings, the defense (which requires pleading unreasonable delay in assertion of one's rights against another and material prejudice to the latter attributable to the delay, not asserted here) must be tied to a party's registration of a mark, not to a party's *use* of the mark. *Lincoln Logs, Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). Applicant does not support its defense with any allegations relating to its application.

Further, the affirmative defenses of laches, acquiescence, and estoppel generally are not applicable in opposition proceedings because these defenses start to run from the time a mark is published for opposition, not from the time of knowledge of use. *See Nat'l Cable Television Ass'n Inc. v. Am. Cinema Eds., Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ 1283, 1292, n.14 (TTAB 2007); *Krause v. Krause Publ'ns, Inc.*, 76 USPQ2d 1904, 1914

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<sup>32</sup> There are various types of estoppel recognized by law, including: collateral estoppel, estoppel by laches, equitable estoppel, licensee estoppel, and contractual estoppel. We note that estoppel is not available against an opposer based on that opposer's alleged acquiescence in a third party's use or registration, as Applicant appears to assert here, in the absence of a showing that the applicant is in privity with that third party. *See Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973) (because estoppel may be invoked only by one who has been prejudiced by the conduct relied upon to create the estoppel, a party may not base its claim for relief on the asserted rights of strangers with whom it is not in privity of interest). In addition, to the extent Applicant's defenses can be construed as an assertion that Opposer's pleaded marks have been abandoned by course of conduct, the defenses also must be stricken because the allegation would constitute a collateral attack on Opposer's registrations, which the Board may not entertain in the absence of a timely counterclaim to cancel Opposer's registrations. *See Trademark Rule 2.106(b)(3)(ii)*, 37 C.F.R. 2.106(b)(3)(ii); *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325, 1329 n.5 (TTAB 2013).

(TTAB 2005) (“It is clear, therefore, that the equitable defense of acquiescence in an opposition or cancellation proceeding does not begin to run until the mark is published for opposition.”).

In view of the foregoing, Applicant’s fifth and eleventh defenses are **stricken**.<sup>33</sup>

***Sixth Defense***

Applicant’s sixth defense states that “the claims set forth in the Opposition are barred in whole or in part, or abated substantially by the doctrine of unclean hands.”<sup>34</sup> 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); *VIP Foods, Inc. v. V.I.P. Food Prods.*, 200 USPQ 105, 112-13 (TTAB 1978). Here, Applicant asserts that Opposer’s failure to police his marks as previously represented to Applicant resulted in Applicant’s desire to register its mark to protect it and enhance its ability to enforce and police its mark against third parties. We find the sixth affirmative defense to be sufficiently pleaded.

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<sup>33</sup> We also note that certain equitable defenses are not available against claims of fraud. *Saint-Gobain Abrasives Inc. v. Unova Indus. Automation Sys. Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003).

<sup>34</sup> 10 TTABVUE 17.

***Eighth, Tenth, and Twelfth Defenses***

Applicant’s eighth defense states the “omissions, conduct and voluntary acts of Opposer proximately caused, or otherwise contributed to, the matters of which it complains.”<sup>35</sup> The tenth affirmative defense states, “Opposer would be unjustly enriched if it prevailed.”<sup>36</sup> The twelfth affirmative defense provides, “Applicant’s actions, statements or conduct were justified and privileged.”<sup>37</sup>

These defenses might be appropriately asserted in response to a claim in federal or state court for infringement; however, because the Board’s jurisdiction is limited to determining the registrability of a mark, it does not have jurisdiction over questions of right to use, infringement, or unfair competition. *See, e.g., McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) (“As to the litany of criminal or civil wrongdoings . . . the Board is not the proper venue for bringing such objections—the Board’s jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings.”); *see also* TBMP § 102.01. Accordingly, Applicant’s eighth, tenth and twelfth defenses are **stricken**.

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<sup>35</sup> *Id.* at 18.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at 19.

### ***Fourteenth Defense***

As its fourteenth defense, Applicant “reserves the right to assert additional defenses in the event discovery and/or investigation indicated that additional affirmative defenses are applicable.”<sup>38</sup> This 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 additional affirmative defenses or counterclaims is to file a motion under Fed. R. Civ. P. 15.

Accordingly, the asserted reservation is **stricken** from the answer.

### **IV. Amended Pleading**

Opposer is allowed until twenty days from the date of this order to file and serve an amended notice of opposition properly alleging claims of fraud based on Applicant’s declaration or oath, or contractual estoppel.<sup>39</sup> If Opposer files an amended pleading as allowed herein, Applicant is allowed until thirty days from the date of service thereof to file an answer, or otherwise respond, to Opposer’s amended pleading in accordance with this order.

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<sup>38</sup> *Id.* at 19.

<sup>39</sup> The declarant in an application declaration states that to the best of his or her “knowledge and belief” no other person or entity “has the right to use” the mark or a confusingly similar mark in U.S. commerce. Thus, the verification is phrased in terms of the declarant’s subjective belief and is very difficult to prove. *See* 6 McCarthy § 31:76. Moreover, all claims of fraud on the USPTO carry a very high burden of proof, one that is higher than other grounds in inter partes proceedings. Specifically, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *In re Bose*, 91 USPQ2d at 1939 (citing *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)).

Proceedings herein are otherwise **suspended**. The Board will reset remaining dates upon resumption of the proceeding.<sup>40</sup>

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<sup>40</sup> Pursuant to the Board's September 9, 2020 order, discovery has closed. *See* 14 TTABVUE. If either party seeks additional discovery on newly asserted claims, the party may file a motion to reopen discovery for a limited purpose. *See* Fed. R. Civ. P. 6(b)(1)(B); *see also* TBMP § 509.01(b) and authorities cited therein.