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

Proceeding	91255847
Party	Plaintiff Forever, Inc.
Correspondence Address	ROCHELLE D. ALPERT MORGAN, LEWIS & BOCKIUS LLP ONE MARKET, SPEAR ST. TOWER, 5TH FL. SAN FRANCISCO, CA 94105 UNITED STATES Primary Email: rochelle.alpert@morganlewis.com Secondary Email(s): sftrademarks@morganlewis.com, nina.dutta@morganlewis.com, sharon.smith@morganlewis.com, yelena.lolua@morganlewis.com 415 442-1326
Submission	Other Motions/Papers
Filer's Name	Rochelle D. Alpert
Filer's email	rochelle.alpert@morganlewis.com, sharon.smith@morganlewis.com, nina.dutta@morganlewis.com, sftrademarks@morganlewis.com, yelena.lolua@morganlewis.com
Signature	/RDA/
Date	07/15/2020
Attachments	Motion to Suspend and Motion to Strike Applicant Affirmative Defenses and Exhibits A-B.pdf(2353919 bytes)

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

In the matter of Application Serial No. 88/619,740
Filed September 17, 2019
For the mark **FOREVERNOTE**
Published in the OFFICIAL GAZETTE on January 21, 2020

Forever, Inc., Opposer, v. Forevernote Inc., Applicant	Opposition No. 91255847

MOTION TO SUSPEND AND MOTION TO STRIKE
APPLICANT'S AFFIRMATIVE DEFENSES

Pursuant to TBMP § 510.02(a), Forever, Inc. ("Forever" or "Opposer") hereby moves to suspend this opposition proceeding pending resolution of the opposition and litigation between Forevernote, Inc. ("Applicant") and Evernote Corporation ("Evernote") on two separate grounds: (a) the prior pending opposition and litigation involving the mark EVERNOTE; and (b) this Motion to Strike.

Additionally, pursuant to Federal Rule of Civil Procedure 12(f) and TMBP § 506.01, Forever moves to strike affirmative defenses that Applicant stated in its Answer filed on June 24, 2020. To the extent the Board does not suspend pending the prior filed opposition/litigation proceeding, as resolution of this Motion to Strike should nonetheless narrow the issues in this proceeding in terms of both discovery and trial in this opposition, Forever alternatively requests

that the Board suspend this proceeding pending ruling on the motion to strike the affirmative defenses, pursuant to TBMP § 510.03(a).

I. Factual Background

As alleged in the Notice of Opposition Forever owns and uses valid and existing federal trademark registrations for the word mark FOREVER® (U.S. Reg. No. 5,456,075) and the mark FOREVER® and design (U.S. Reg. No. 4,598,177) both for "downloadable computer software that allows for the storage, organization and sharing of electronic data and media by others" in International Class 09, "storage services for archiving documents, media and other electronic data" in International Class 39, and "providing temporary use of online non-downloadable computer software for use in electronic storage of data and media; conversion of data or documents from physical to electronic media" in International Class 42. In this regard, the FOREVER and design mark has become incontestable. Forever also owns and uses and alleged the mark FOREVER STORAGE® (U.S. Reg. No. 5,137,771) for "storage services for archiving electronic data" in International Class 39. In addition, beyond its federal registrations, Forever alleged in its Notice of Opposition common law rights arising from its Forever trade name and its Forever.com domain name, and the other related uses of its FOREVER marks, registered and unregistered, that are prior in time to any rights of Applicant.

On September 17, 2019, years after Forever began use of its FOREVER marks and names, Applicant filed an intent-to-use application for FOREVERNOTE, Serial No. 88/619,740, for "[d]ownloadable mobile application for ordering custom print and digital memory books, scrapbooks, personal archives, family archives, wedding albums, diaries, vacation albums, family albums, family histories, photograph albums, birthday albums, and special event albums for others and for delivery thereof" in International Class 9, and "[p]reparation of custom print

and digital memory books, scrapbooks, personal archives, family archives, wedding albums, diaries, vacation albums, family albums, family histories, photograph albums, birthday albums, and special event albums for others" in International Class 45 (the "Application").

On January 28, 2020, the third party, Evernote, timely opposed the Application in TTAB Proceeding No. 91/253,702 based on its EVERNOTE marks. On May 22, 2020, Forevernote filed suit against Evernote in the United States District Court for the Southern District of California for declaratory judgment. *Forevernote, Inc. v. Evernote Corp.*, Docket No. 3:20-cv-00970 (S.D. Cal. June 26, 2020). A copy of the complaint filed by Applicant against Evernote in that matter is attached as **Exhibit A**. In that proceeding, Evernote subsequently filed counterclaims against Forevernote for federal and common law trademark infringement and unfair competition regarding the EVERNOTE marks. A copy of the answer with counterclaims filed by Evernote against Applicant is attached as **Exhibit B**.

Based on the pending litigation, Evernote and Forevernote jointly filed a motion to suspend their Trademark Trial and Appeal Board ("TTAB" or "Board") proceeding pending resolution of *Forevernote, Inc. v. Evernote Corp.*, Docket No. 3:20-cv-00970 (S.D. Cal. June 26, 2020). The TTAB granted this motion on June 2, 2020, stating that "proceedings are suspended pending final disposition of the civil action."

After properly filing an extension of time to oppose, Forever timely opposed Forevernote's same intent-to-use Application on May 15, 2020. Applicant filed its Answer on June 24, 2020, asserting certain affirmative defenses and then more broadly stating that "Applicant reserves its right to raise any and all affirmative defenses based on information it learns, through discovery or otherwise, which would serve as the basis for an additional defense up to the time including after trial." Answer, p. 5.

The so-called affirmative defenses do not state a valid defense since they do not reflect a cognizable affirmative defense under the standard of law in the TTAB. Similar marks to provide any defense must be for similar services. That is not the case with the allegations alleged in the affirmative defenses.

Similarly, in yet another defense, Applicant claims that Registrant is attempting to monopolize the use of the FOREVER mark. *Id*. at 4. That is not a supportable claim as a matter of law either. Enforcing trademark rights does not create any monopoly.

Finally, Applicant states that Registrant has not suffered any harm based on its Application. *Id.* at 5. That is not a sustainable affirmative defense where Registrant has shown its standing to bring this Opposition through pleading common law rights as well as federal trademark rights. Harm is not a required element for an opposition.

II. Proceedings Should Be Suspended Until a Final Determination in the Evernote Opposition

When a party to a pending TTAB case is involved in another proceeding "that may have a bearing" on the TTAB case, the Board may suspend proceedings until a final determination in the external matter. TBMP § 510.02(a). Judicial economy is generally served by a grant of suspension where civil proceedings bear on the application or a mark, even if the issues in the civil proceeding are not dispositive of those in the Board proceeding. *Id.*; *see also New Orleans Louisiana Saints LLC v. Who Dat? Inc.,* 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011) ("[T]he civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board."). Moreover, any decision in the prior pending opposition filed by Evernote also qualifies as a type of proceeding that warrants suspension here.

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