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

Proceeding no.	91281934
Party	Defendant Chia Network Inc.
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Date	02/03/2023
Attachments	Applicant Response to Motion to Strike Affirmative Defenses_02-03-23. pdf(347303 bytes)

CATERPILLAR INC.,	)	**Opposition No.**: 91281934
	)	
Opposer,	)	**Serial No.**: 97/123,673
	)	
	)	**Mark**: CAT
vs.	)	
	)	
	)	
CHIA NETWORK INC,	)	
	)	
Applicant.	)	

RESPONSE TO OPPOSER'S MOTION TO STRIKE APPLICANT'S FIRST, THIRD, FOURTH, AND FIFTH AFFIRMATIVE DEFENSES AND RESERVATION OF RIGHTS

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicant Chia Network Inc. ("Chia" or "Applicant") respectfully submits this

Memorandum in Opposition to Caterpillar Inc.'s ("Caterpillar" or "Opposer") Opposer's Motion to

Strike Applicant's First, Third, Fourth, and Fifth Affirmative Defenses (the "Motion"). As shown

below, Applicant has properly pleaded legally cognizable affirmative defenses as required at this

stage of these proceedings. Applicant respectfully submits that the Board deny the Motion.

I.   BACKGROUND

On November 13, 2021, Applicant filed intent-to-use Trademark Application Serial No.

97123673 for the mark CAT covering the following goods and services (as amended):

> "*Downloadable computer application software for servers, computers and mobile
> devices, namely, software for secure aggregation, processing, monitoring and analyzing
> data and for facilitating and managing digital currency and financial transactions;*

downloadable computer software for secure aggregation, processing and analyzing data for the purpose of providing customized tracking and reporting in the field of finance, digital currency and cryptocurrency; downloadable computer software for the exchange of digital currency and cryptocurrency; downloadable computer software for the secure storage of financial information, digital currency and cryptocurrency; downloadable computer software for financial management and for facilitating and processing financial, digital currency and cryptocurrency transactions; downloadable computer software for secure financial data aggregation; downloadable computer software for secure mining, tracking and storage of digital currency and cryptocurrency; downloadable computer software platforms for the exchange of digital currency and cryptocurrency for enterprise blockchains; downloadable computer software platforms for the design, testing, deployment and management of blockchain systems; downloadable computer software platforms for the deployment, transfer and management of digital currency and cryptocurrency; downloadable computer software for creating, managing, storing, analyzing and providing data on distributed public ledgers and peer-to-peer payment networks in the fields of cryptocurrency, digital currency, blockchain based technologies and decentralized applications; downloadable software for use in database management, financial record keeping and processing, tracking and reporting transactions in the digital currency, cryptocurrency and blockchain markets; downloadable virtual goods, namely, computer programs featuring clothing, art, toys, books, accessories and bags for use online and online virtual worlds" in **Class 009**;

"*Financial exchange services, namely, a financial exchange for trading and selling digital currency and cryptocurrency; financial services in the fields of digital currency and cryptocurrency, namely, providing currency exchange services, electronic payment transaction processing services, and currency tracing and tracking services between accounts, all in the fields of digital currency and cryptocurrency; financial services, namely, providing digital currency and cryptocurrency in the nature of virtual currency, the foregoing being for use by members of an on-line community via a global computer network; online monitoring services of financial data for financial reporting, namely, monitoring the financial status of digital currency and cryptocurrency transactions; providing financial data tracking of digital currency and cryptocurrency transactions; financial services, namely, financial analysis of financial records over electronic communications networks; providing financial information in the fields of financial affairs, digital currency and cryptocurrency; providing online personal banking and currency exchange services; providing online electronic funds transfer services; financial transaction services, namely, providing secure commercial transactions in the nature of digital currency and cryptocurrency transactions; providing financial information in the fields of finance, digital currency and cryptocurrency acquisition and transactions and in the field of blockchain technology; providing an online searchable database featuring financial information about digital currency and cryptocurrency; providing a website featuring financial information in the fields of blockchain, digital currency and cryptocurrency; financial transaction services, namely, providing secure electronic commercial transactions and payment options utilizing virtual currencies in the nature of digital currency and cryptocurrency*" in **Class 036**; and

"Computer services, namely, creating computer network-based indexes of information and resources; Software as a service (SAAS) services featuring software for financial management, for securing financial information, for processing and tracking digital currency transactions and cryptocurrency transactions, for processing and tracking online financial transactions and managing personal banking, and for keeping a record of personal records and aggregating financial data; Software as a service (SAAS) services featuring software for database management, file management and data processing; computer security services in the nature of providing secure and optimized electronic data storage in the field of digital currency, cryptocurrency and blockchain; advisory services in the field of product development and quality improvement of software; Platform as a service (PAAS) featuring computer software platforms for the development of improved quality and optimized digital security software ; Platform as a service (PAAS) featuring computer software platforms for authenticating, facilitating, matching, processing, clearing, storing, receiving, tracking, transferring and submitting trade data and trading transaction details; application services provider featuring application programming interface (API) software for facilitating and managing interactions between digital currency and cryptocurrency, and blockchain information databases; collaborative computer programming for others in the nature of development of blockchain technology and digital security optimization technology; computer services, namely, remote management of information technology (IT) systems of others comprised of software, databases and applications in the field of digital currency, cryptocurrency and blockchain; computer software development; computer software design; computer software development in the field of mobile applications; computer software development in the field of digital currency and cryptocurrency creation and mining, and blockchain; computer programming and maintenance of computer software for digital currency and cryptocurrency mining and blockchain purposes; customizing computer software by developing custom technology and application software in the field of blockchain; product design and development in the field of digital currency, cryptocurrency and blockchain technology" in **Class 042** (the "'673 Application").

The '673 Application published on July 26, 2022, and, after seeking the maximum allowable extension of time to oppose, Opposer filed a Notice of Opposition on November 22, 2022. 1 TTABVUE.

On January 1, 2023, Applicant timely filed its Answer to Opposers' Notice of Opposition.

In its Answer, Applicant included the following among its affirmative defenses:

First Affirmative Defense: "The Opposition fails to state a claim for which relief can be granted."

Third Affirmative Defense: "Opposer has acquiesced to similar competitive marks which exist in the marketplace."

Fourth Affirmative Defense: "Opposer is barred by laches as it has failed to enforce its alleged rights against similar parties with identical or substantially similar marks."

Fifth Affirmative Defense: "The Opposition is barred by the doctrine of unclean hands."

4 TTABVUE.

Applicant also reserved the right to amend its Answer to add affirmative defenses: "There may be additional affirmative defenses to the claims in the Opposition that are currently unknown to Applicant. Therefore, Applicant reserves the right to amend its Answer to the Opposition to allege additional affirmative defenses in the event that discovery of additional information indicates they are appropriate." 4 TTABVUE.

On January 20, 2023, Opposers moved to strike the aforementioned affirmative defenses under Rule 12(f).

As a threshold matter, Opposer cites to *Sidney-Vinstein v. A.H. Robbins Co.*, 697 F.2d 880, 885 (9th Cir 1983) to stand for the proposition that "naked assertions are inadequately pleaded and should be stricken to allow the parties to focus on the claims and defenses that are properly before the Board." *See* Motion at 5. This proposition is contained nowhere in that case, which primary covers standards for striking a post judgment decision from a judgement derived in a medical device malfunction personal injury claim. In addition, the provided quote, ("the function of a 12(f) motion to strike is to avoid the expenditure of time and money that must arise from litigating spurious issues by dispensing with those issues prior to trial…"), is used in that context to support a decision to strike a motion to reconsider which was ultimately denied.

II. LEGAL STANDARDS

An answer, in addition to responding to initial allegations, may also include a short and plain statement of any defenses, including affirmative defenses that the defendant may have to the claim or claims asserted by the plaintiff. Affirmative defenses are sufficiently pled if they "give fair notice" of the defense. *See, e.g.*, *Harsco Corp. v. Elec. Sci. Inc.*, 9 USPQ2d 1570 (TTAB

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