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

<b>Proceeding</b>	91164988
<b>Party</b>	Plaintiff ROLEX WATCH U.S.A., INC. ROLEX WATCH U.S.A., INC. 665 FIFTH AVENUE NEW YORK, NY 10022
<b>Correspondence Address</b>	BRIAN W. BROKATE GIBNEY, ANTHONY & FLAHERTY, LLP 665 FIFTH AVENUE NEW YORK, NY 10022
<b>Submission</b>	Motion to Strike
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<b>Signature</b>	/Brian W. Brokate/
<b>Date</b>	06/17/2005
<b>Attachments</b>	roll-x-speed motion to strike.pdf ( 6 pages )

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

ROLEX WATCH U.S.A, INC.     )  
  )     **Opposition No. 91164988**  
  )  
                          **Opposer,**     )  
  )  
  )  
BUGALLO, FERNANDO     )  
  )  
  )  
                          **Applicant.**     )  
\_\_\_\_\_                                  )

**OPPOSER’S MOTION TO STRIKE APPLICANT’S THIRD, FOURTH AND FIFTH  
AFFIRMATIVE DEFENSES**

**I. INTRODUCTION**

Rolex Watch U.S.A., Inc. (“Rolex” or “Opposer”) filed a Notice of Opposition on April 22, 2005 opposing the application of Fernando Bugallo (“Applicant”) for registration of the mark ROLL-X SPEED. In his Answer, Applicant asserts five “affirmative defenses,” at least three of which are legally insufficient, immaterial and/or otherwise improper and should be stricken under Fed.R.Civ.P. 12(f).<sup>1</sup> Applicant’s assertions create a pleading that does not reasonably well-define the defenses, and unless stricken, these defenses will unnecessarily complicate matters going forward, lead to wasteful, extended and largely aimless discovery, and increase the time spent by the Board and the parties in managing the opposition.

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<sup>1</sup> Fed.R.Civ.P. 12(f) provides that “[u]pon motion made by a party before responding to a pleading..., the court may order stricken from any pleading any insufficient defense or any redundant , immaterial, impertinent, or scandalous matter.”

**II. APPLICANT'S AFFIRMATIVE DEFENSES ARE LEGALLY INSUFFICIENT, IMMATERIAL AND/OR OTHERWISE IMPROPER AND SHOULD BE STRICKEN UNDER FED.R.CIV.P. 12(f).**

**A. Opposer's Notice of Opposition States a Claim for which Relief can be Granted**

Applicant's third affirmative defense, namely that the Notice of Opposition fails to state a claim for which relief can be granted is insufficient as a matter of law. 5A Wright, Miller & Marcus, Federal Practice and Procedure: Civil 2d Section 1381 (2d ed. 2004). In order to withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an opposer need only allege such facts as would, if proved, establish (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought. *See Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 1995 WL 596839, \*2 (Trademark Tr. & App. Bd.).

The initial inquiry as to whether an opposer has standing is directed solely to establish the personal interest of the opposer. *See id.* Opposer need only show "a personal interest in the outcome of the case beyond that of the general public." *See id.* citing *Estate of Biro v. Bic Corp.*, 18 USPQ 1382, 1385 (TTAB 1991), *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed.Cir.1987), and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

In this case, Opposer has pleaded its standing to be heard as well as valid grounds for its opposition. Opposer has alleged that it owns a registration for the mark ROLEX; that it has prior use of its ROLEX mark in connection with watches, clocks, parts of watches and clocks and their cases; that since its initial use of the ROLEX mark, it has made a substantial investment in advertising and promoting its goods under the ROLEX trademark; that its ROLEX mark is famous; that there is a likelihood of confusion between applicant's mark ROLL-X SPEED, and

that Applicant's ROLL-X SPEED mark would cause dilution of Opposer's ROLEX mark. For purposes of evaluating the sufficiency of pleadings, all averments must be taken as true and construed in the light most favorable to the pleading party. *See Order Sons of Italy*, 1995 WL 596839 at \*2 (citation omitted). Opposer's averments, if proved, would be sufficient to establish that opposer has a personal interest in this proceeding beyond that of the general public and are sufficient to allege a cause of action. *See id.* at \*3 citing *Susan Shawn Harjo, et. al. v. Pro Football, Inc.*, 30 USPQ2d 1828 (TTAB 1994).

Because Opposer's pleading is legally sufficient in stating a claim, applicant's third defense should be stricken.

**B. Applicant's Affirmative Defense Based On An Alleged Violation Of The Antitrust Laws By Opposer Should Not Be Heard.**

In his Answer, applicant also asserts, as an affirmative defense, that opposer's opposition to applicant's mark is an antitrust violation and, essentially, that opposer is misusing its mark and registration thereby restraining trade and creating a monopoly.

This alleged violation of the antitrust laws by opposer should not be heard by the Board because the Board has no jurisdiction over such issues. *See Time Warner Entertainment Co. v. Karen L. Jones*, 2002 WL 1628168, \*12 at FN 4 (Trademark Tr. & App. Bd.) and citing *Yasutomo & Co. v. Commercial Ball Pen Co., Inc.*, 184 USPQ 60 (TTAB 1974). The Trademark Trial and Appeal Board is an administrative tribunal, established by statute for narrow and specific purposes, and is not a court of general jurisdiction. To that end, the Board and its primary reviewing court have long rejected claims not specifically grounded in statute. *See e.g., Yasutomo & Co. v. Commercial Ball Pen Co.*, 184 USPQ 60, 61 (TTAB 1974) (no authority to hear antitrust claims).

Accordingly, Applicant's fourth defense should be stricken.

### **C. Applicant's Unclean Hands Affirmative Defense Is Insufficient**

With regard to applicant's fifth affirmative defense of unclean hands, which solely is premised on opposer's antitrust violation, this defense is also insufficient and should be stricken. Applicant has failed to make out the defense and sets forth no allegations to support it. As the Board has noted in previous cases wherein such a defense was asserted, "[t]here is nothing in the record to suggest that [opposer] has done anything other than seek to protect its rights in its registered marks, and preclude the registration of what it believes to be a confusingly similar mark, a right which every trademark owner possesses under the Lanham Act." See *Time Warner*, 2002 WL 1628168 at \* 12, FN 4 citing *Avia Group International, Inc. v. Faraut*, 25 USPQ 2d 1625, 1627 (TTAB 1992), *Cook's Pest Control, Inc. v. Sanitas Pest control Corp.*, 197 USPQ 265, 267 (TTAB 1977), and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4<sup>th</sup> Ed. 6/2001) at 31:101-102.

Accordingly, Applicant's fifth defense should be stricken.

### **III. CONCLUSION**

Applicant's legally deficient and irrelevant "affirmative defenses" unnecessarily complicate the opposition and if permitted to remain will lead to overly broad and contested discovery and the consequent waste of resources. The Board has the power to narrow and define the issues from the earliest stages of the dispute to promote the orderly, efficient and economic disposition of the opposition. These are just the types of pleadings that warrant the Board's exercise of its power and duty to define the issues at the earliest stages. Applicant's "affirmative

defenses” are legally insufficient, immaterial and/or otherwise improper and should be stricken pursuant to Fed.R.Civ.P. 12(f).

Respectfully Submitted,



Dated: June 17, 2005

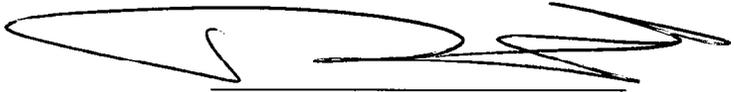
By: \_\_\_\_\_

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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

**I HEREBY CERTIFY** that a true and correct copy of the foregoing has been furnished via First Class United States Mail, postage prepaid, to Applicant's attorney, Daniel S. Polley of Daniel S. Polley, P.A., 1215 East Broward Boulevard, Fort Lauderdale, Florida 33301, this 17<sup>th</sup> day of June, 2005.



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