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

Proceeding	91177192
Party	Plaintiff NAUTICA APPAREL, INC. NAUTICA APPAREL, INC. NAUTICA APPAREL, INC. 40 West 57th Street New York, NY 10019 UNITED STATES
Correspondence Address	Stephen L. Baker Baker and Rannells, PA 575 Route 28, Suite 102 Raritan, NJ 08869 UNITED STATES s.baker@br-tmlaw.com,n.friedman@br-tmlaw.com,d.communale@br-tmlaw.com ,K.Hnasko@br-tmlaw.com,officeactions@br-tmlaw.com
Submission	Motion to Strike
Filer's Name	Brian M. Gaynor
Filer's e-mail	officeactions@br-tmlaw.com,b.gaynor@br-tmlaw.com,k.hnasko@br-tmlaw.com
Signature	/brian gaynor/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

NAUTICA APPAREL, INC.,			
	Opposer,	Mark:	GET NAUTI
	v.	Serial No.	78610037
MARTANNA LLC,		Filed:	April 15, 2005
	Applicant.		

OPPOSER'S MOTION TO STRIKE PARAGRAPH 5 AND AFFIRMATIVE DEFENSES ONE THROUGH FIVE, AND THIRTEEN THROUGH EIGHTEEN OF APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION

Opposer, Nautica Apparel, Inc. ("Opposer"), hereby moves to strike Paragraph 5 and Affirmative Defenses One through Five, and Thirteen through Eighteen of applicant's answer to the Notice of Opposition. The facts as pleaded in all the mentioned paragraphs, even if true, do not provide Applicant with adequate defenses to the Notice of Opposition. As such, the same are insufficient.

This motion is made within the time prescribed in F.R.Civ.P. Rule 12(c) and is thereby timely. Insofar as the motion falls under F.R.Civ.P 12(f), the Board has discretion to hear the same at this time. To the extent that the motion requires the Board to look beyond the pleadings, the motion may be considered a motion for partial summary judgment pursuant to F.R.Civ.P. Rule 56(c).

Opposer would not normally make the present motion but feels it will be helpful in narrowing and limiting the issues in this proceeding and thereby also serving as a

guide in conducting discovery. As stated in *2A Moores Federal Practice* paragraph 12.21[3]:

> Although courts are reluctant to grant motions to strike, where a defense if legally insufficient, the motion should be granted in order to save the parties unnecessary expenditure in time and money in preparing for trial.

Opposer's grounds for this motion are set forth below:

Paragraph 5 of Applicant's Answer Should Be Stricken

Opposer believes Paragraph 5 of Applicant's Answer should be stricken, and Opposer's allegations be deemed admitted. Paragraph 5 reads as follows:

5. The allegations in Paragraph 5 of the Opposition assert legal conclusions to which no response is required. To the extent that a response is required, the allegations are denied and Applicant demands strict proof thereof.

Paragraph 5 of the Opposition states:

5. Opposer is the owner of numerous trademarks in a variety and constantly expanding number of classes including the NAUTICA marks, marks that contain the word NAUTICA, and marks that contain the letters NAUT and variations thereof ("Opposer's Marks") as trademarks, trade names, and as service marks. Examples of Opposer's Marks are as follows:

The Opposition then provides a list of dozens of Opposer's registered trademarks.

First, identifying Opposer's registered trademarks, upon which the opposition is based, is not a legal conclusion. It is a statement of fact. By providing no response, the claim should therefore be admitted. In addition, Applicant cannot deny that opposer's registrations exist and are valid, as that amounts to an impermissible collateral attack. *Textron, Inc. v. The Gillette Company*, 180 USPQ 152 (TTAB 1973). *See also* 37 C.F.R.

§2.106(b). The Board in *Textron* stated: "There can be no doubt but that applicant in denying in its answer that opposer's registration was duly issued or that it is now valid or ever was valid is directly attacking the validity of this registration. Such assertion manifestly contravenes the basic requirement of Rule 2.106(b) that no defense attacking the validity of a pleaded registration may be raised except by way of cancelation of the registration." *Id.* at 153. This is precisely what Applicant has done here. Applicant first falsely claims that Opposer's claim of ownership of its valid registrations is a legal conclusion, and then goes on to deny the same. Therefore, Paragraph 5 of Applicant's Answer should be stricken, and the claims of Opposer's Paragraph be deemed admitted.

Applicant's Affirmative Defenses One through Four Should Be Stricken

Opposer believes Applicant's Affirmative Defenses One through Four in Applicant's Answer should be stricken. The Affirmative Defense reads as follows:

1. Opposer's has failed to state a valid claim upon which relief can be granted as to all claims/allegations of the Opposition.
2. Opposer does not have standing to bring any of its claims based on the word mark applications, including the "NAUTICARE" application, that are allegedly pending before the United States Patent and Trademark Office.
3. Opposer does not have standing to bring a claim based under Section 1052(d) of title 15 of the United States Code based on the word mark applications, including the "NAUTICARE" application, that are allegedly pending before the United States Patent and Trademark Office.
4. Opposer does not have standing to bring a claim based under Section 1125(c) of title 15 of the United States Code based on the word mark applications, including the "NAUTICARE"

application, that are allegedly pending before the United States Patent and Trademark Office.

Applicant's asserted defenses question the sufficiency of Opposer's pleading. While Rule 12(b) permits Applicant to assert the above defenses, "it necessarily follows that a plaintiff may utilize this assertion to test the sufficiency of the defense in advance of trial by moving . . . to strike the 'defense' from the defendant's answer." *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, *at* 1222-1223 (TTAB 1995), *citing S.C. Johnson & Son Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973).

The following factors set forth in *Order of Sons of Italy* govern a motion to strike a defense of failure to state a claim upon which relief may be granted.

> 1. 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 that (1) the Opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration.
>
> 2. For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Opposer's well-pleaded allegations must be accepted as true, and the Notice of Opposition must be construed in the light most favorable to Opposer.
>
> 3. Dismissal for insufficiency is appropriate only if it appears certain that the Opposer is entitled to no relief under any set of facts which could be proved in support of its claim.
>
> 4. The standing question is an initial inquiry directed solely to establishing the personal interest of the plaintiff. An Opposer need only show "a personal interest in the outcome of the case beyond that of the general public."

Opposer, in its Notice of Opposition, has alleged, *inter alia*, the following:

- Ownership of numerous trademarks in a variety and constantly expanding number of classes including the NAUTICA marks,

marks that contain the word NAUTICA, and marks that contain the letters NAUT and variations thereof ("Opposer's Marks") (Not. Opp. ¶¶ 5).

- That the parties' respective marks are confusingly similar. (Not. Opp. ¶ 13, 15-16).
- That the parties' respective goods and services are very similar (Not. Opp. ¶ 14).
- The registration of Applicant's Mark, will cause the dilution of the distinctive quality of Opposer's Marks, all to Opposer's irreparable damage. (Not. Opp. ¶ 18).
- And, that Opposer will be damaged by issuance of a registration to Applicant. (Not. Opp. ¶¶ 19).

The foregoing allegations are specifically set forth in Opposer's pleading and, if proven, Opposer will be entitled to the relief which it is seeking. Opposer has stated a legally sufficient claim upon which relief can be granted and is entitled to an order striking Applicant's First Affirmative Defense. See, *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973).

Applicant's Fifth Affirmative Defense Should Be Stricken

Opposer believes Applicant's First Affirmative Defense Should Be Stricken. The Affirmative Defense reads as follows:

5. Opposer is not entitled to the relief it seeks because Applicant's "GET NAUTI" mark does not consist of or comprise matter that is immoral, deceptive or scandalous.

Paragraph 5 should be stricken, as Opposer does not allege that Applicant's "GET NAUTI" mark consists of or comprise matter that is immoral, deceptive or scandalous.

Applicant is claiming a defense to a claim that does not exist, and is wasting both Opposer's, and the Board's, time and expense.

Applicant's Thirteenth Affirmative Defense Should Be Stricken

Opposer believes Applicant's Thirteenth Affirmative Defense in Applicant's Answer should be stricken. The Affirmative Defense reads as follows:

> 13. Opposer's claims are barred because Opposer's Marks – considered separately or together – are functional.

Applicant's Thirteenth Affirmative Defense amounts to a collateral attack on Opposer's prior registered marks. The law is well settled that an applicant cannot collaterally attack an opposer's registration in the absence of a counterclaim for cancellation. *Textron, Inc. v. The Gillette Company*, 180 USPQ 152 (TTAB 1973). *See also* 37 C.F.R. §2.106(b). Therefore, Applicant's Thirteenth Affirmative Defense is insufficient and insupportable as a matter of law and should be stricken.

Applicant's Fourteenth, Fifteenth and Sixteenth Affirmative Defenses Should Be Stricken

Paragraphs 14 and 15 set forth as Affirmative Defenses in Applicant's Answer and which Opposer believes should stricken reads as follows:

> 14. Opposer's claims are barred by the doctrine of waiver.
> 15. Opposer's claims are barred because the equitable principals of laches, estoppel and acquiescence apply to this action.
> 16. Opposer's claims are barred due to its own misconduct and unclean hands.

The trademark application at issue was published for opposition on April 3, 2007. The Notice of Opposition to said registration was timely filed on May 1, 2007.

To succeed in a waiver, laches, estopple and/or acquiescence defense, the party alleging the same has the burden of establishing both unreasonable delay and prejudice from the delay. *See*, *Ralston Purina Co. v. Midwest Cordage Co., Inc.*, 153 USPQ 73, 75-76 (CCPA 1967). This takes on special meaning in an Opposition proceeding.

As stated in *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424, *at* 1432 [937 F2d 1572] (CAFC 1991):

> Laches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made. In an Opposition or Cancellation proceeding the objection is to the rights which flow from registration of the mark. . . . Moreover, an objection to registration does not legally equate with an objection to use, that is, a charge of infringement. [citing cases]

In the present case, laches, estopple and/or acquiescence would begin to run from the date Applicant's mark was published for opposition. Since a Notice of Opposition was timely filed, there can be no unreasonable delay in asserting rights against the registration in issue that would support a defense of laches, estopple and/or acquiescence. Accordingly, the alleged defenses are insufficient and insupportable as a matter of law and should be stricken.

In addition, the equitable defenses of acquiescence, estoppel, misconduct, and unclean hands, require an affirmative act upon which the Applicant relied to its detriment. See, *National Cable*, *supra*, 19 USPQ2d at 1432, citing *MCV, Inc. v. King-Seeley Thermos Co.*, 10 USPQ2d 1287, 1290 (Fed. Cir. 1989). See also *DAK Industries Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622 (TTAB 1992). No such affirmative act and no such detrimental reliance has been pled by Applicant. Again, Applicant's sole cognizable but insufficient claim is that Opposer is charged with constructive knowledge

of the publication of Applicant's mark. Accordingly, the defenses of acquiescence and estoppel, as pled by Applicant, are insufficient as a matter of law and should be stricken.

Applicant's Seventeenth Affirmative Defenses Should Be Stricken

Paragraph 17 set forth as Affirmative Defenses in Applicant's Answer and which Opposer believes should stricken reads as follows:

> 17. Opposer's claims are barred due to the doctrines of abandonment, erosion, functionality, fair use and/or good faith.

This Paragraph is unintelligible and does not present an adequate defense and therefore should be stricken. Opposer has no idea what "erosion" and "good faith" means as a defense to Opposer's allegations in a Notice of Opposition. As stated above, Opposer's Marks are valid and subsisting, and therefore Applicant cannot make a claim of functionality as a defense, as it constitutes a collateral attack. Opposer is unaware of any fair use defense in an opposition proceeding involving a trademark as applied to commercial goods.

With respect to Applicant's affirmative defense of abandonment, as long as the registration relied upon by Opposer in an opposition proceeding remains uncanceled, it is treated as valid and entitled to the statutory presumptions, and Applicant cannot allege abandonment as an affirmative defense. *Cosmetically Yours, Inc. v. Clairol Incorporated*, 165 USPQ 515, 517 (C.C.P.A. 1970). Therefore, Opposer's Seventeenth Affirmative Defense should be stricken.

Applicant's Eighteenth Affirmative Defenses Should Be Stricken

Paragraph 18 set forth as Affirmative Defenses in Applicant's Answer and which Opposer believes should stricken reads as follows:

18. To the extent evidence developed during the discovery supports any of the following, Applicant reserves the right to rely upon the defenses of: fraud, illegality, res judicata, failure to mitigate, preemption, statute of limitations, statute of frauds, or any other matter constituting an avoidance or affirmative defense.

This Paragraph is unintelligible and does not present an adequate defense and therefore should be stricken. In any event, res judicata is not a sufficient defense, as there is no prior litigation, claim or issue between the parties. There can be no failure to mitigate defense, since Applicant's trademark application is an intent-to-use application, and Opposer is alleging damage that will result if it registers. The statute of limitations is not an issue, because the opposition was timely filed. As stated previously, the trademark application at issue was published for opposition on April 3, 2007. The Notice of Opposition to said registration was timely filed on May 1, 2007. Lastly, there can be no statute of frauds defense, because there is no contract claim or issue in this case.

It is obvious that Applicant is using the "shotgun" method of defense in this proceeding. Applicant is offering every affirmative defense it can think of, regardless of relevance, or even if the defense is legally permissible. Applicant should be admonished for its behavior as being wasteful of the parties, and the Board's, valuable time and resources.

WHEREFORE, Opposer respectfully demands that its motion set forth herein be granted in all respects.

Respectfully submitted,

By: /stephen baker/
Stephen L. Baker
BAKER & RANNELLS PA
626 North Thompson Street
Raritan, NJ 08869
(908) 722-5640
Attorneys for Opposer,
Nautica Apparel, Inc.

Dated: June 21, 2007

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion to Strike was forwarded by first class postage pre-paid mail by depositing the same with the U.S. Postal Service on this 21st day of June, 2007 to the attorneys for the Applicant at the following address:

Howard G. Slavit, Esq.
Shannon H. Bates, Esq.
2600 Virginia Avenue, NW
Suite 1000 – The Watergate
Washington, D.C. 20037

/stephen baker/
Stephen L. Baker