

UNITED STATES PATENT AND TRADEMARK
OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

csg/fc

Mailed: September 20, 2007

Opposition No. 91177192

Nautica Apparel, Inc.

v.

Martanna LLC

Before Walters, Grendel and Wellington, Administrative
Trademark Judges.

By the Board:

This case now comes up on opposer's motion to strike applicant's affirmative defenses, filed June 21, 2007. The motion is fully briefed.

Opposer initially moved to strike affirmative defenses one through five and thirteen through eighteen as well as paragraph 5 of applicant's answer. In its response brief, applicant withdrew its second, third, fourth, and thirteenth affirmative defenses in full, provisionally withdrew its fifth affirmative defense, and withdrew its seventeenth affirmative defense in part as relates to the defenses of abandonment, functionality and fair use. Applicant also amended paragraph 5 of its answer in response to the motion to strike.¹

¹ Applicant's proposed amendment to paragraph 5 of its answer is accepted and entered. Fed. R. Civ. P. 15.

In its reply, opposer indicates that it still seeks to strike affirmative defenses one, five, fourteen through sixteen, the remaining defenses in seventeen, and eighteen. Opposer also seeks to strike and deem admitted the partial denial in amended paragraph five of applicant's answer.

Under Fed. R. Civ. P. 12(f), the board may strike from a pleading "any insufficient defense or any redundant, immaterial, impertinent or scandalous matter." An affirmative defense may be stricken as legally insufficient on the face of the pleadings if defendant can prove no set of facts in support of the affirmative defense that would defeat the complaint. See *Heller Fin., Inc. v. Midwhey Powder Co., Inc.*, 883 F.2d 1286, 1295 (7th Cir. 1989).
First Affirmative Defense

We turn to applicant's first affirmative defense, failure to state a claim upon which relief can be granted. An opposer may use a motion to strike this defense to test the sufficiency of the complaint in advance of trial.²
Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36, USPQ2d 1221, 1222 (TTAB 1995). If the pleading is legally sufficient in stating a claim, the Board will strike

² Although applicant has not responded specifically thereto, we shall consider the motion to strike this defense on its merits.

this defense. *S. C. Johnson & Son, Inc. v. GAF Corporation*,
177 U.S.P.Q. 720 (TTAB 1973).

The claims asserted by opposer under the heading
"Grounds for Opposition" on the ESTTA form are the
following:

- Deceptiveness - Trademark Act section 2(a)³
- False suggestion of a connection - Trademark
Act section 2(a)
- Priority and likelihood of confusion -
Trademark Act section 2(d)
- Dilution - Trademark Act section 43(c)

Opposer has sufficiently alleged a real interest in
this proceeding by its allegations of ownership of multiple
registrations in paragraph 5 of the notice of opposition.
With respect to the claim of priority of use and likelihood
of confusion, we find that paragraphs 6 through 16 of the
notice of opposition allege sufficient facts which, if
proved, would entitle opposer to the relief it seeks. With
respect to the claim of dilution, we find that paragraphs 17
and 18 of the notice of opposition allege sufficient facts
which, if proved, would entitle opposer to the relief it
seeks.

However, to the extent that opposer intends to pursue a
Section 2(a) false suggestion of a connection claim (as
identified in the ESTTA notice of opposition form), we find

³ See *infra* for discussion of opposer's deceptiveness claim under
Section 2(a).

such claim insufficient. To state a claim of false suggestion of a connection under Section 2(a), opposer must allege facts that set out the elements of such a claim, i.e., (1) that the mark (or part of it) is the same as or a close approximation of the person's previously used name or identity; (2) that the mark would be recognized as such (that is, the mark points uniquely to that person); (3) that the person in question is not connected with the goods or services of the applicant, and (4) that the person's name or identity is of sufficient fame that when it is used as part or all of the mark on applicant's goods/services, a connection would be presumed by someone considering purchasing the goods/services. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Although opposer has alleged in paragraphs 8, 9, and 14 of the notice of opposition that "Opposer's marks are famous"; that opposer "for many years is trading and is known by Opposer's marks"; and that applicant's use of its mark is "without the consent or permission of Opposer", we find that opposer has failed to sufficiently allege that applicant's mark is the same as or a close approximation of opposer's identity or persona; that applicant's mark would be recognized as such; and that opposer's identity or persona is of sufficient fame or reputation that when

applicant's mark is used on its goods, a connection to opposer would be presumed.

Inasmuch as applicant's first affirmative defense is valid with respect to opposer's Section 2(a) claim of a false suggestion of a connection with opposer, opposer's motion to strike applicant's first affirmative defense is denied.

Should opposer decide to amend its notice of opposition to include a valid claim of a false suggestion of a connection, such amended pleading must be submitted within THIRTY DAYS from the mailing date of this order. In the event opposer fails to file an amended notice of opposition to properly assert this claim, the opposition will go forward on the claim of priority of use and likelihood of confusion, and the claim of dilution.

Fifth Affirmative Defense

We now turn to applicant's fifth affirmative defense by which applicant alleges that applicant's mark "does not consist of or comprise matter that is immoral, deceptive or scandalous." Opposer seeks to strike this defense arguing that applicant is "claiming a defense to a claim that does not exist." In response, applicant points to the "form Notice of Opposition" which identifies one of the grounds for opposition as Section 2(a) deceptiveness but advises that it withdraws this defense to the extent that "Opposer

is not claiming that Applicant's 'Get Nauti' mark consists or comprises material that is immoral, deceptive or scandalous." Inasmuch as opposer has indicated in its brief on the motion that it is not bringing a Section 2(a) deceptiveness claim, we consider this affirmative defense withdrawn. Accordingly opposer's motion to strike is moot with respect to this defense. However, to further clarify matters, we sua sponte strike the "Section 2(a) deceptiveness" claim from the "ESTTA" Notice of Opposition form which is considered part of the notice of opposition. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926 (TTAB 2005) (ESTTA filing form and any attachments thereto comprise a single document filed with the Board). *Fourteenth, Fifteenth and Sixteenth Affirmative Defenses*

We turn next to the fourteenth (waiver), fifteenth (laches, estoppel and acquiescence) and sixteenth (unclean hands) affirmative defenses. Opposer seeks to strike these affirmative defenses as insufficient. We agree with opposer that these defenses are insufficient inasmuch as they are vague, conclusory and lack specificity. Accordingly, opposer's motion is granted and applicant's fourteenth, fifteenth and sixteenth affirmative defenses are hereby stricken with leave to amend with requisite particularity,

if appropriate.⁴ See *Heller*, 883 F.2d at 1294, (a court may strike affirmative defenses that are “nothing but bare bones conclusory allegations”).

Seventeenth Affirmative Defense

We now turn to the remaining defenses in applicant’s seventeenth affirmative defense, which are good faith and erosion.

We agree with opposer that good faith is not an adequate defense to a likelihood of confusion claim. With regard to the defense of erosion, we find this defense to be so vague and ambiguous that it cannot possibly give opposer fair notice of the basis for this defense. Accordingly, the seventeenth affirmative defense is stricken as insufficient.

Eighteenth Affirmative Defense

Turning next to applicant’s eighteenth affirmative defense, applicant has attempted to reserve its right to assert various affirmative defenses in the future, if evidence produced during discovery supports them. We find such defense to be mere surplusage. Accordingly, applicant’s eighteenth affirmative defense is stricken on that basis.

⁴ We note that the affirmative defenses of laches, acquiescence and estoppel are generally inapplicable in opposition proceedings. See *National Cable Television Ass'n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1578, 19 USPQ2d 1424 (Fed. Cir. 1991); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) and cases cited therein.

Amended Paragraph 5, Applicant's Answer

Turning finally to opposer's motion to strike the partial denial in amended paragraph 5 of applicant's answer,⁵ opposer's basis for striking this denial is that it is improper for applicant to deny opposer's ownership of its pleaded trademark applications. In response, applicant argues that opposer is not entitled to a presumption of ownership for pending trademark applications and "applicant is permitted to deny in its answer that Opposer owns those 11 alleged marks."

We see nothing improper in applicant's denial of opposer's ownership of its pleaded trademark applications inasmuch as the denial merely creates an issue of fact that opposer is required to prove at trial. Accordingly, opposer's motion to strike the partial denial in applicant's amended paragraph 5 of its answer is denied. We also note that in amended paragraph 5 applicant has attempted to reserve the right to assert a counterclaim or file a petition to cancel against opposer's pleaded registrations. Inasmuch as we find this allegation to be mere surplusage,

⁵ In amended paragraph 5 of the answer, applicant states in part that applicant "denies that Opposer owns the remainder of the marks listed in the table in paragraph 5 of the Notice including those marks pleaded as having serial numbers 77085787, 77085720, 78763730, 77085766, 78963691, 78275470, 78275303, 78912365, 78713715, 77081234, and 77081223."

we strike the reservation of rights pleaded in amended paragraph 5 of the answer.⁶

Applicant is advised that if it wants to later assert new affirmative defenses or counterclaims based on new facts obtained through discovery, it must file and adequately support a timely Fed. R. Civ. P. 15 motion.

In summary, opposer's motion to strike is granted with respect to applicant's affirmative defenses fourteen, fifteen, sixteen, seventeen, and eighteen.⁷ Opposer's motion to strike is denied with respect to the first affirmative defense and the partial denial in amended paragraph 5 of the answer. Opposer's motion to strike the fifth affirmative defense is moot. Applicant's reservation of rights to assert a counterclaim in amended paragraph 5 of the answer is stricken, as is opposer's Section 2(a) deceptiveness claim in the ESSTA notice of opposition.

As stated above, should it decide to amend its Section 2(a) claim for false suggestion of a connection, opposer is allowed until THIRTY DAYS from the mailing date of this order to make such a filing.

⁶ Applicant states in part: "but Applicant reserves its right to later assert a counterclaim and/or a petition to cancel any and/or all of the registered marks recited herein if Applicant should discover through the course of this opposition proceeding that such grounds exist for cancellation of such pleaded registered marks."

⁷ Affirmative defenses six through twelve were not the subject of the motion to strike, have not been withdrawn, and remain in the pleadings.

Applicant is allowed until TWENTY days from the date of service of an amended notice of opposition to file an answer thereto.

Discovery and trial dates remain as set in the Board's institution order dated May 9, 2007.

* * * *

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>