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

Mailed: September 5, 2009

Opposition No. 91188477

Carlos A. Castro

v.

Rick Cartwright

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up for consideration of opposer's motion (filed March 19, 2009[1]) to strike applicant's affirmative defenses set forth in applicant's answer. The motion is fully briefed.[2]

For purposes of this order, the Board presumes the parties' familiarity with the pleadings and the arguments submitted with respect to the subject motion.

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[1] The delay in acting upon this matter is regretted.

[2] It is clear from opposer's reply brief that applicant timely served opposer with its opposition brief to the subject motion. However, when submitting said brief electronically to the Board on March 30, 2009, applicant's counsel apparently inadvertently uploaded a copy of applicant's previously submitted answer instead of the opposition brief (the ESTTA cover sheet therefor refers to "opposition/response to motion"). On August 11, 2009, at the Board's request, applicant submitted a copy of its brief to the Board.

Opposer requests that the Board strike applicant's affirmative defenses[3] because they are allegedly insufficiently pleaded under Federal Rule 8(b). Specifically, opposer asserts that applicant has failed to state the elements of his defenses and that the alleged defenses are conclusory and boilerplate in nature, with the result that they fail to give opposer fair notice of the basis for the defenses.

Applicant essentially argues that opposer's motion should be denied because he has failed to show that the affirmative defenses are wholly unrelated to any of the facts framed in the pleadings or that he will suffer unfair prejudice as a result of their inclusion in the answer, and because the asserted defenses set forth the "short and plain" statements required under notice pleading. Should the Board find that applicant's defenses are not sufficiently pleaded, applicant also requests that the Board allow applicant to amend his answer.

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or

[3] Opposer requests that the Board strike applicant's "first seven (7) affirmative defenses". However, applicant only asserted six defenses, the seventh "defense" being a statement that applicant reserves the right to amend its answer to assert defenses that may become available, which is not an affirmative defense. The Board has considered all six of applicant's asserted defenses in the context of opposer's motion.

scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP 506 (2d ed. rev. 2004). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims not stricken). Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See, generally,* Wright & Miller, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008). Nonetheless, the Board grants motions to strike in appropriate instances.

Applicant asserts the following defenses:

1. That opposer has failed to state a claim upon which relief can be granted;

2. That opposer is barred, in whole or in part, from relief from the doctrine of waiver;
3. That opposer's claims are precluded by the doctrine of estoppel;
4. That opposer's claims are precluded because the plaintiff's mark has been abandoned;
5. That opposer has failed to adequately maintain, police or enforce any trademark or proprietary rights it may once have had in its alleged pleaded mark(s);
6. That opposer's alleged use of "NEVERTAP" does not constitute trademark use.

Turning first to affirmative defense number one, the asserted defense of failure to state a claim upon which relief can be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim. In view thereof, this asserted defense will not be considered as such. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

Nonetheless, a motion to strike the defense of failure to state a claim upon which relief can be granted may be used by the plaintiff to test the sufficiency of its pleading. Accordingly, in determining whether to strike applicant's assertion that opposer's pleading fails to state a claim upon

which relief can be granted, it is necessary to look at the sufficiency of the pleading.

In order to withstand the assertion that a pleading fails to state a claim, a plaintiff need only allege such facts that would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and TBMP § 503.02 (2d. ed. rev. 2004).

For the following reasons, the Board finds that the notice of opposition is legally sufficient and that it clearly contains allegations which, if proven, would establish opposer's standing and a valid ground for opposing the involved mark.

Considering first whether opposer has asserted a proper Section 2(d) claim, the Board finds that the allegations set forth in paragraphs one, two and four of opposer's notice of opposition provide adequate notice of opposer's reliance on common law use of the mark NEVERTAP to establish priority. Further, paragraphs five, nine and ten provide adequate notice

of opposer's claim of likelihood of confusion. If opposer's allegations are later proved, they would establish that opposer has a real interest in the outcome of the proceeding, that is, a personal interest in the outcome of the case beyond that of the general public. *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, *supra.* Whether these allegations are true is a question of fact to be determined at trial. In view of the foregoing, opposer's motion to strike applicant's first affirmative defense is granted and said defense is hereby stricken.

Applicant's second asserted defense is that opposer's claim is barred by the doctrine of waiver. This assertion is insufficient on its face inasmuch as it fails to give opposer or the Board any factual basis for the defense. Further, applicant has not cited to any Federal Circuit or Board cases that support a finding that the bald assertion of waiver is sufficient. In view thereof, opposer's motion as to affirmative defense number two is granted and such defense is hereby stricken as insufficient.

As to the third asserted defense, namely, estoppel, it has been consistently held that the doctrine of estoppel may be invoked only by one who has been prejudiced by the conduct relied upon to create the estoppel, and a party may not

therefore base its claim for relief on the asserted rights of strangers with whom it is not in privity of interest. *See Textron, Inc. v. The Gillette Company*, 180 USPQ 152, 154 (TTAB 1973) (internal citations omitted).

In this case, because applicant has not alleged that he was induced to select his mark because of the conduct of opposer or that applicant is in privity with the third parties who have assertedly used similar marks for similar goods with opposer's acquiescence thereto, applicant's pleading is insufficient. *See Gastown Inc. of Delaware v. Gas City Ltd.*, 187 USPQ 760 (TTAB 1975).

Likewise, in regard to affirmative defense number five, which asserts that opposer has failed to maintain, police or enforce its trademarks or proprietary rights, the Board construes this defense to essentially restate that applicant has acquiesced to or not asserted its trademark rights, if any, against third parties. As discussed, applicant cannot assert that opposer is estopped from bringing this opposition because he has not objected to the alleged use by third parties of a portion of applicant's involved mark unless the answer also includes the allegations discussed above, that is, those regarding applicant's privity with third parties and applicant's prejudicial reliance on opposer's conduct.

In view of the foregoing, opposer's motion to strike affirmative defense numbers three and five is granted and

those defenses are hereby stricken as insufficient. Nonetheless, applicant will be allowed time at the conclusion of this order to file an amended answer to address these insufficient defenses, should he choose to do so.

Applicant's fourth and sixth defenses assert, respectively, that opposer's mark has been abandoned and that opposer's alleged use of the term "NEVERTAP" does not constitute trademark use. These affirmative defenses, which involve an absence of proprietary rights in an alleged mark, provide opposer with notice of applicant's position with respect to opposer's claim of priority and, thus, primarily function to amplify applicant's denial of opposer's claim of likelihood of confusion and do not prejudice opposer. In view thereof, opposer's motion to strike applicant's fourth and sixth affirmative defenses is denied.

Accordingly, opposer's motion to strike is granted in part and denied in part, as noted herein. Further, applicant's request to amend his answer is granted to the extent that applicant is allowed until approximately **THIRTY DAYS** from the mailing date of this order, as specified below, to submit an amended pleading that states a proper affirmative defense of estoppel, as discussed *supra*, assuming applicant can make the factual allegations that support such a defense. *See* Fed. R. Civ. P. 11.

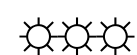
Proceeding Resumed; Dates Reset[4]

This proceeding is **resumed**. Trial dates, including conferencing, disclosures and the discovery period, are reset as shown in the schedule set forth below.

Time to File Amended Answer (as discussed herein)	**10/8/2009**
Deadline for Discovery Conference	**10/23/2009**
Discovery Opens	**10/23/2009**
Initial Disclosures Due	**11/22/2009**
Expert Disclosures Due	**3/22/2010**
Discovery Closes	**4/21/2010**
Plaintiff's Pretrial Disclosures	**6/5/2010**
Plaintiff's 30-day Trial Period Ends	**7/20/2010**
Defendant's Pretrial Disclosures	**8/4/2010**
Defendant's 30-day Trial Period Ends	**9/18/2010**
Plaintiff's Rebuttal Disclosures	**10/3/2010**
Plaintiff's 15-day Rebuttal Period Ends	**11/2/2010**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. *See* Trademark Rule 2.l25, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29, 37 C.F.R. § 2.129.



[4] This proceeding is deemed to have been suspended since the filing date of opposer’s motion. *See* Trademark Rule 2.117(c). In view thereof, the Board’s order mailed August 27, 2009, which reset the trial schedule in accordance with the opposer’s consented motion, is *vacated*.