

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

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Mailed: June 23, 2009

Opposition No. 91188704

iLike, inc.

v.

DHC Assets Limited Partnership

**Before Zervas, Walsh, and Ritchie,
Administrative Trademark Judges.**

By the Board:

This case now comes up for consideration of opposer's motion (filed March 30, 2009) to strike applicant's affirmative defenses nos. 1-4, 6-10, and 13-14.¹ The motion is fully briefed.²

The following affirmative defenses are at issue:

[1] Opposer is barred by the doctrine of laches from opposing Applicant's mark.

[2] Opposer is barred by the doctrine of Estoppel from opposing Applicant's mark.

[3] Opposer is barred by the doctrine of Acquiescence from opposing Applicant's mark.

[4] Opposer's file wrapper history estops Opposer from asserting the claims set forth in the opposition.

...

¹ Opposer titled its motion as one for judgment on the pleadings, but the motion is actually one to strike.

[6] The market is crowded with "GARAGE BAND" marks.

[7] Opposer's mark "GARAGEBAND" is weak, and there are various pending applications and uses of marks containing the words "garage band," including a registration by Apple, Inc. for "GARAGE BAND" for software, and a registration by The Garage Band Network for "THE GARAGE BAND NETWORK."

[8] Opposer has instituted this action in bad faith. There are many other similar marks on the market, even more similar than that of Applicant's, which Opposer, to Applicant's knowledge, has not pursued.

[9] The Opposer is barred by its own unclean hands.

[10] The Opposer's registration is invalid or void *ab initio* due to a fraudulent Statement of Use or other invalidity or cancellation.

...

[12] The Opposer has acted fraudulently to the Trademark Office by filing applications for its GARAGEBAND mark based on a bona fide intent when in fact it does not have a bona fide intent to use its mark for all goods and services identified in the Registration or in the Opposer's other pending applications.

[13] Opposer's Opposition fails to state a claim upon which the relief sought may be granted.

[14] Opposer is barred by the doctrine of waiver from opposing Applicant's mark.

In support of its motion, opposer contends that applicant "seems to list each of these so-called affirmative defenses without facts or explanation as if going through a checklist" and that each of these affirmative defenses cannot withstand legal scrutiny.

The Board may, upon motion or by its own initiative, order stricken from a pleading any insufficient defense or

any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See, e.g., *FRA S.p.A. v. Surg-O-Flex of America, Inc.*, 194 USPQ 42, 46 (SDNY 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977).

With regard to applicant's first affirmative defense of laches, we note that such a defense is futile and, accordingly, strike this defense. The mark which is the subject of the current proceeding was published for opposition on October 7, 2008 and, after obtaining an extension of time, opposer filed the instant opposition on February 4, 2009. Laches begins to run from the time the plaintiff could take action against the registration of the mark, i.e., the date the mark is published for opposition. By the very nature of an opposition proceeding, an opposition represents the prompt taking of action. See *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 19 USPQ2d 1424, 937 F2d 1572 (Fed. Cir. 1991). Accordingly, except in limited circumstances not alleged by applicant in this proceeding, the defense of laches is inapplicable.

With regard to applicant's affirmative defenses concerning estoppel, acquiescence, unclean hands, and waiver (affirmative defense nos. 2-4, 8-9, and 14) we find applicant's pleading of these bare legal conclusions to be insufficient to give opposer notice of the basis of each of these defenses. "The elements of a defense should be stated simply, concisely, and directly" and "should include enough detail to give the plaintiff fair notice of the basis for the defense." TBMP §311.02(b) (2nd ed. rev. 2004). Applicant's mere allegations of these defenses do not include enough detail to give opposer fair notice of the basis therefor. Thus, the affirmative defenses of estoppel, acquiescence, unclean hands, and waiver are hereby stricken.

If applicant desires to reassert its defenses of estoppel, acquiescence, unclean hands, and waiver in an amended answer, applicant may assert proper affirmative defenses. In this regard, instead of merely pleading the legal conclusion of each of these defenses, applicant should plead facts in connection with each defense which, if proven, would entitle applicant to prevail on these affirmative defenses.

With regard to applicant's affirmative defense nos. 6-7, we find that the statements set forth by applicant, while not technically affirmative defenses, amplify the denial of likelihood of confusion previously set forth by applicant in

its answer, and therefore have a bearing on the issues under litigation. Specifically, applicant's allegations apprise opposer with greater particularity of the position applicant is taking in this proceeding. See *Textron, Inc. v. The Gillette Company*, 180 USPQ 152 (TTAB 1973) and cases cited therein. Accordingly, affirmative defense nos. 6-7 will not be stricken.

With regard to applicant's affirmative defense no. 13 that the notice of opposition fails to state a claim, the question to be determined is whether the notice of opposition does indeed set forth facts which, if proved, would entitle opposer to the relief it is seeking.³ Upon careful review of the notice of opposition, we find that opposer has set forth sufficient allegations to establish, if proven, that opposer has standing to bring this proceeding and to support a pleading of likelihood of confusion under Section 2(d) of the Trademark Act. Applicant's defense of failure to state a claim is, therefore, without merit.

With regard to affirmative defense nos. 10 and 12, inasmuch as such allegations constitute a collateral attack on the validity of opposer's pleaded registration, they are

³ A plaintiff may utilize the defendant's assertion of failure to state a claim to test the sufficiency of its pleading by moving under Rule 12(f) of the Federal Rules of Civil Procedure to strike this defense from the answer. *S.C. Johnson & Sons, Inc. v. GAF.*, 177 USPQ 720 (TTAB 1973).

required to be raised by way of a counterclaim.⁴ See Trademark Rule 2.106(b)(2)(ii), and TBMP Section 313 (2d ed. rev. 2004).

In summary, opposer's motion to strike is granted, in part, as to applicant's affirmative defense nos. 1-4, 8-10, and 12-14 and denied, in part, as to applicant's affirmative defense nos. 6-7, which we construe as amplifications of its denial of the salient allegations of the notice of opposition.

Proceedings are hereby resumed. Discovery and trial dates are reset as follows.

Deadline for Discovery Conference	7/17/2009
Discovery Opens	7/17/2009
Initial Disclosures Due	8/16/2009
Expert Disclosures Due	12/14/2009
Discovery Closes	1/13/2010
Plaintiff's Pretrial Disclosures	2/27/2010
Plaintiff's 30-day Trial Period Ends	4/13/2010
Defendant's Pretrial Disclosures	4/28/2010
Defendant's 30-day Trial Period Ends	6/12/2010
Plaintiff's Rebuttal Disclosures	6/27/2010
Plaintiff's 15-day Rebuttal Period Ends	7/27/2010

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. Trademark Rule 2.125.

⁴ To the extent that affirmative defense no. 12 also contains an allegation in opposition to opposer's pleaded pending application, applicant must file a separate notice of opposition against such application.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.1