

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

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Mailed: October 28, 2009

Opposition No. 91189629

Borghese Trademarks Inc.

v.

Multi Media Exposure, Inc.

**Elizabeth A. Dunn, Attorney (571-272-4267):**

This case comes up on several pending matters:

- i. opposer's motion to strike applicant's affirmative defenses filed June 6, 2009;
- ii. the stipulated protective order filed July 17, 2009; and
- iii. applicant's motion for summary judgment filed September 23, 2009.

On April 8, 2009, Borghese Trademarks Inc. filed a notice of opposition bringing a claim of likelihood of confusion between opposer's pleaded registrations for its PRINCESS MARCELLA BORGHESE and BORGHESE marks for a variety of products, including shampoo, conditioner, and fragrances, and applicant's mark PRINCE LORENZO BORGHESE'S LA DOLCE VITA for "pet shampoo, conditioners, and body sprays", the subject of opposed ITU Application Serial No 77435171.

On May 18, 2009, applicant filed an answer which denied the salient allegation of the notice of opposition and asserted affirmative defenses including:

20. Opposer has not opposed registration of third party marks incorporating the family name BORGHESE.

30. The Opposer's Marks and the PRINCE LORENZO Mark are not confusingly similar because they are marketed to different consumers.

31. The Opposer's Marks and the PRINCE LORENZO mark are not confusingly similar because, upon information and belief, they are sold through different channels of trade.

OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Upon motion filed within twenty days after service of an answer upon a party, or upon its own initiative, the Board may 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 in the case. See *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Here, opposer seeks to strike the affirmative defenses listed in paragraphs 20, 29, and 30 of the answer as legally insufficient.<sup>1</sup>

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<sup>1</sup> Inasmuch as applicant agreed (Opposition to Motion to Strike, p. 9) to strike the affirmative defense listed in paragraph 39, opposer's motion to strike that affirmative defense is denied as moot.

With respect to the affirmative defense listed in paragraph 20, the Board agrees with applicant that the affirmative defense is a clarification of applicant's denial of the claim of likelihood of confusion. More specifically, the defense is not a collateral attack on opposer's pleaded registration but an allegation that opposer's pleaded marks are weak as shown by third party use. With respect to the affirmative defenses listed in paragraphs 29 and 30, neither defense is an impermissible restriction of the goods listed in opposer's pleaded registrations. Opposer's argument that its unrestricted personal care products are legally identical to applicant's personal care products for pets is a point to be proven at trial, or in connection with a motion for summary judgment, and not in connection with a motion to strike. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1296 ("Because the affirmative defense provides opposer with notice of applicant's position with respect to one of opposer's specific claims, opposer's motion to strike ... is denied."); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, at 1270 (TTAB 1992) ("Applicant, in its answer, denied the claim of likelihood of confusion, and amplified its denial in allegations captioned as 'affirmative defenses'").

Accordingly, opposer's motion to strike is denied.

STIPULATED PROTECTIVE ORDER

The stipulated protective agreement filed on July 17, 2009 is noted and its use in this proceeding is approved. The parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Proceedings herein are suspended pending disposition of applicant's unserved motion for summary judgment, with the suspension retroactive to the date of filing of the motion.<sup>2</sup> Any paper filed during the pendency of this motion which is

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<sup>2</sup> On a case-by-case basis, the Board may find that the filing of a motion for summary judgment provides a party with good cause for not complying with an otherwise outstanding obligation, for example, responding to discovery requests. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 965 (TTAB 1986).

not relevant thereto will be given no consideration. See Trademark Rule 2.127(d).

Inasmuch as the motion does not include proof of service, opposer is allowed until thirty days from the mailing date of this order in which to file its response.<sup>3</sup>

The Board notes that applicant is represented by counsel and has already been advised, in connection with its unserved answer to the notice of opposition, that all papers filed with the Board must include proof of service. Any subsequent paper filed by applicant without proof of service will be given no consideration AND will result in entry of sanctions against applicant.

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<sup>3</sup> Opposer's motion, filed October 26, 2009, to extend its time to respond to the motion for summary judgment is denied as moot.