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

Proceeding	91189629
Party	Plaintiff Borghese Trademarks Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Borghese Trademarks, Inc.

Opposition No.: 91189629

Opposer,

Mark: PRINCE LORENZO  
BORGHESE'S LA DOLCE  
VITA

v.

Application No.: 77/435,171

Multi Media Exposure, Inc.

Applicant.

-----X

**OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES PARAGRAPHS 20, 30,  
31 and 39 OF APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION**

Opposer, Borghese Trademarks, Inc. ("Opposer"), hereby moves to strike paragraphs 20, 30, 31 and 39 of Applicant, Multi Media Exposure, Inc.'s ("Applicant") Affirmative Defenses in its Answer to the Notice of Opposition. For the following reasons, the alleged affirmative defenses do not provide Applicant with legally sufficient or legally supportable defenses to the Notice of Opposition. As such, the same are insufficient and should be stricken.

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 requests suspension of this matter pending disposition of this motion.

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 is 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.

**Applicant's Paragraph 20 of Affirmative Defenses should be Stricken**

Opposer believes paragraph 20 of Applicant's First Affirmative Defense in Applicant's Answer should be stricken. It reads as follows:

20. As and for a First Affirmative Defense, Opposer has not opposed registration of third party marks incorporating the family name "Borghese."

In its First Affirmative Defense, Applicant claims that Opposer has not policed its marks. This amounts to an accusation of abandonment based on a failure to police its marks. Applicant's asserted defense therefore represents, in effect, a collateral attack on the validity of Opposer's Registrations, which contravenes the basic requirement of 37 CFR §2.114(b)(2)(i) that a defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. No defense attacking the validity of a pleaded registration may be raised except by way of cancellation of the registration. Such a defense as set forth in Applicant's First Affirmative Defense may only be asserted by way of a counterclaim to cancel the registration(s) in question. See, e.g., Textron, Inc. v. Gillette Co., 180 USPQ 152, 153 (TTAB 1973) (stating that the TTAB considers it to be mandatory that a party assert as a counterclaim any claim which, at the time of serving his pleading, he has against the adverse party if the counterclaim arises out of the subject matter of the transaction or occurrence which is the subject matter of the other party's claim). See also Food Specialty Co. v. Standard Products Co., 151 USPQ 46, 46 (CCPA 1969), Gillette Co. v. "42" Products Ltd., Inc., 158 USPQ 101, 104 (CCPA 1968) and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955, 961 (TTAB 1986).

Since Applicant's First Affirmative Defense violates Rule 2.114(b)(2)(i), Petitioner submits it is entitled to an order striking Applicant's First Affirmative Defense.

In the alternative, Applicant's First Affirmative Defense appears to be arguing waiver and acquiescence. However, there is no factual basis for this defense because Opposer has opposed every third party "BORGHESE" mark except for food and wine. In addition, Opposer suspects that Applicant has not specifically pled waiver and/or acquiescence because Applicant is not in privity with any of those entities they claim Opposer did not oppose.

Opposer notes that if acquiescence and waiver is what Applicant is alluding to, they should be reminded that in Board proceedings, a claim of laches and/or acquiescence can only begin from the first time when Opposer could object to registration; i.e. the date when an application is published for opposition, not from the time of knowledge of use. *See National Cable Television Association Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424, 1431-1432 (Fed.Cir. 1991); *Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762 (TTAB 2007) (holding that a laches/ acquiescence defense must be tied to a party's registration of a mark rather than its use of a mark). Likewise, "conduct which occurs prior to the publication of the application for opposition generally cannot support a finding of equitable estoppel." *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008) (citing *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992); *National Cable Television Ass'n Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991)).

Applicant filed its application, Serial No. 77/435,171 on March 30, 2008 and it was published on March 3, 2009. Opposer filed an extension of time to file a Notice of Opposition, then promptly and timely filed its Notice of Opposition against the mark on April 8, 2009. Opposer did not acquiesce to Applicant's use of its mark at any time and Opposer has been timely in opposing the registration of Applicant's mark.

Furthermore, it is well established that to prevail on an affirmative defense of laches or acquiescence, Applicant must plead (and later prove) that Opposer unreasonably delayed in asserting its rights and that Applicant was prejudiced by the delay. *See Bridgestone/Firestone Research, Inc.v. Automobile Club de L'Ouest de la France*, 58 USPQ2d 1460, 1463 (Fed. Cir. 1991). Applicant has not provided a single factual allegation upon which its alleged defenses of laches and acquiescence could be maintained.

Finally, to prevail on an affirmative defense of waiver, Applicant must establish that Opposer "relinquished a right with both knowledge of the existence of the right and an intent to relinquish it." *Christian Dior-New York, Inc. v. Koret, Inc.*, 229 USPQ 997, 1001 (2d Cir. 1986), see also *Bingham v. Zolt*, 823 F.Supp. 1126, 1132 (S.D.N.Y. 1993), *aff'd* 66 F.3d 553 (2d Cir. 1995). Applicant has not provided any factual basis on which this alleged defense could be maintained. Therefore, the defense should be stricken.

**Applicant's Paragraph 30 of Applicant's Fourth Affirmative Defense and Paragraph 31 of Applicant's Fifth Affirmative Defense should be Stricken**

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

30. As and for a Fourth Affirmative Defense, the Opposer's Marks and the PRINCE LORENZO Mark are not confusingly similar because they are marketed to different consumers.

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

31. As and for a Fifth Affirmative Defense, 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 notes that the marks in its registrations are not limited to any particular end user, nor are the goods listed in its registrations limited in the manner in which the end user uses them. Nor are Opposer's Marks limited to particular channels of trade. Paragraph 30 of Applicant's Fourth Affirmative Defense as set forth in its Answer alleges that the goods provided under Applicant's Mark are directed at different types of ultimate consumers than those targeted by Opposer's trademarks. And Paragraph 31 of Applicant's Fifth Affirmative Defense as set forth in its Answer alleges that the goods provided under Applicant's Mark travel through different channels of trade. Such defenses are inadequate to the Notice of Opposition in this case. When evaluating the likelihood of confusion in proceedings concerning the registrability of marks, the identifications of goods set forth in the relevant application and/or registration(s) must be considered, regardless of what the record may reveal as to the particular nature of the parties' goods, their actual channels of trade, or the class of purchasers to which their sale is, in fact, directed. *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 U.S.P.Q.2d 1445, 1450 (TTAB 1986). *See also: CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); *Broderick & Bascom Rope Co. v. Goodyear Tire & Rubber Co.*, 531 F.2d 1068, 189 USPQ 412, 413 (CCPA 1976); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). In *Miles*, the Board ruled that it must be presumed that the goods

move in all channels of trade that are appropriate for goods so identified and may be sold to all classes of purchasers. *Miles* at 1450.

Opposer is the owner of numerous International Class 3 registrations including, but not limited to, Registration No. 3,369,371 for PRINCESS MARCELLA BORGHESE for numerous beauty care and bath products, make up, and cosmetics including fragrances, hair conditioner, hair cleaning preparations, perfume, and hair care preparations; Reg. No. 1,134,398 for BORGHESE for perfume, skin cream and lotion, make up, lipstick, hair shampoo and conditioner, as well as other beauty and personal care products; Reg. No. 3,387,006 for BORGHESE for cosmetics, skin care products, hair shampoo and conditioner, as well as other beauty and personal care products, which contain no further limitations. Applicant has similarly applied for pet shampoo, conditioners, and body sprays in International Class 3 without limitations.

Both parties' goods are in part legally identical and otherwise related and/or complementary. Moreover, it is an established rule that where goods are recited in a registration, without any restriction as to classes of purchasers or trade channels, it creates the following legal presumptions: (1) that the description encompasses all goods or types of goods embraced by the broad terminology; (2) that the goods move through all of the channels of trade suitable for goods of that type; and (3) that they reach all potential users or customers for such goods. See *Warnaco v. Adventure Knits, Inc.*, 210 USPQ 307, 314-315 (TTAB 1981); and *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738, 741 (TTAB 1978).

The Board must consider Applicant's description of pet shampoo, conditioner and body sprays and all that they entail, including the presumption that the goods move in *all* channels of trade that are appropriate for the goods so identified, and may be sold to *all classes of purchasers*. Such is sufficiently related to all of Opposer's registrations that a likelihood of confusion may result. Thus, as a matter of law it must be presumed that both parties' sets of goods move in the same or similar channels of trade and are directed to the same and/or similar types of ultimate consumers.

Opposer is entitled to judgment striking Applicant's Fourth and Fifth Affirmative Defenses. The defenses pleaded are insufficient as a matter of law.

**Applicant's Paragraph 39 of Applicant's Eighth Affirmative Defense should be Stricken**

Opposer believes paragraph 39 of Applicant's Eighth Affirmative Defense in Applicant's Answer should be stricken. It reads as follows:

39. As and for an Eighth Affirmative Defense, Mr. Borghese is a direct descendant of a noble Italian family and is literally entitled to be called "Prince".

Whether Applicant is or is not entitled to be called "Prince" is irrelevant and immaterial to this case. As far as Opposer is aware, Italy is a republic no longer ruled by nobility and, therefore, Applicant's use of the honorific title "Prince" is a non-political use, intended to create confusion. All that matters with regard to the inclusion of the term PRINCE in Applicant's trademark is whether it helps create a mark that is confusingly similar to Opposer's. Whether or not Applicant is entitled to be called "Prince" is immaterial and as such, paragraph 39 of Applicant's Eighth Affirmative Defense should be stricken.

WHEREFORE, Opposer respectfully requests that its Motion to Strike Paragraphs 20, 30, 31 and 39 of Applicant's Affirmative Defenses in its Answer to the Notice of Opposition be granted in all respects.

Respectfully submitted,

BAKER and RANNELLS, PA

Dated: June 9, 2009



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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES PARAGRAPHS 20, 30, 31 and 39 OF APPLICANT'S ANSWER TO THE NOTICE OF OPPOSITION in re Borghese Trademarks, Inc. v. Multi Media Exposure, Inc., Opposition No. 91189629 was served on counsel for Applicant, this 9<sup>th</sup> day of June, 2009, by sending same via First Class Mail, postage prepaid, to:

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