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

Baxley

Mailed: August 24, 2012

Opposition No. **91204057**

Activision Publishing, Inc.

v.

Kabam, Inc.

Andrew P. Baxley, Interlocutory Attorney:

The parties' stipulation (filed July 19, 2012) to extend applicant's time to respond to opposer's motion (filed April 16, 2012) to strike affirmative defenses from applicant's answer is approved. The brief in response to such motion that applicant filed on August 2, 2012 is accepted as timely filed.

Applicant served the brief in response to the motion to strike by e-mail. Therefore, opposer's reply brief in support of that motion was due by August 17, 2012. See Trademark Rule 2.127(a).[1] Because the reply brief that opposer filed on August 22, 2012 is untimely and includes no showing of excusable neglect, that reply brief has received no consideration. See Fed. R. Civ. P. 6(b)(1)(B); TBMP Section 509.01(b) (3d ed. rev. 2012).

[1] Trademark Rule 2.119(c) is inapplicable to service by e-mail.

This case now comes up for consideration of opposer's motion to strike applicant's affirmative defenses from its answer. Applicant's affirmative defenses are set forth as follows.

1. Opposer's claims are barred by the doctrine of Acquiescence.

2. Opposer's claims are barred by the doctrine of Unclean Hands.

3. Applicant's acts are privileged and lawful.

4. Applicant hereby reserves all rights to assert additional defenses should Applicant learn of grounds for such defenses during the course of this proceeding.

Pleadings are intended to give fair notice of the claims and defenses asserted. See TBMP Section 506.01. Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. 12(f); *id.* Motions to strike, however, are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999).

Regarding applicant's pleaded defenses of acquiescence and unclean hands, such defenses are insufficiently pleaded because they are set forth as conclusory statements and include no allegations of specific conduct by opposer that, if proven, would

prevent opposer from prevailing on its claim. See *Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701 (Fed. Cir. 1992); *Heisch v. Katy Bishop Productions Inc.*, 45 USPQ2d 1219 (N.D. Ill. 1997); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067 (TTAB 1987); Wright & Miller, *Federal Practice and Procedure: Civil 2d,* Section 1274 (1990 & Supp. 2001).

To the extent that applicant intends to set forth a defense of acquiescence, applicant has identified no conduct upon which to base an assertion that opposer, expressly or by clear implication, assented to, encouraged, or furthered the activity on the part of applicant to which opposer now objects.[2] See *Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha,* 209 USPQ 1057 (TTAB 1981). Further, the doctrine of unclean hands would only apply where applicant has alleged inequitable conduct by opposer that occurred in a transaction directly related to this proceeding and which affects the equitable relationship between the

[2] The equitable defense of acquiescence is unavailable against opposer's pleaded claim of mere descriptiveness under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1). See *Nature's Way Products Inc. v. Nature's Herbs Inc.*, 9 USPQ2d 2077 (TTAB 1989). The Board notes, however, that opposer has also pleaded claims of priority/likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), and dilution under Trademark Act Section 43(c), 15 U.S.C. Section 1125(c).

parties.[3] See *Passport Health Inc. v. Travel Med Inc.*, 98 USPQ2d 1344 (E.D. Cal. 2011). In view of the foregoing, the motion to strike is granted with regard to applicant's first and second affirmative defenses.

Regarding applicant's third affirmative defense, applicant has failed to provide fair notice of what it intends to assert by alleging that its acts are privileged and lawful. See TBMP Section 506.01. Moreover, regarding applicant's assertion that its acts are "lawful," such lawfulness may not, by itself, overcome opposer's claims.[4] Cf. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) (the absence of an intent to trade on the goodwill of another does not avoid a ruling of likelihood of confusion). Accordingly, the

[3] Applicant argues in its brief in response that the MODERN WARFARE mark in opposer's pleaded Registration No. 3987485 was previously registered on the Supplemental Register and is descriptive. However, the pleaded registration is on the Principal Register with a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f). Opposer can rely upon its ownership of that pleaded registration in establishing proprietary rights in the MODERN WARFARE mark in seeking to demonstrate a likelihood of confusion between that mark and applicant's involved GLOBAL WARFARE mark. See *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). Any collateral attack upon that registration must be raised by way of a compulsory counterclaim. See Trademark Rule 2.106(b)(2); TBMP Section 313.

[4] The Board is empowered only to determine the right to register marks; it cannot resolve infringement issues or grant injunctive relief. See TBMP Section 102.01.

motion to strike is granted with regard to applicant's third affirmative defense.

Regarding applicant's fourth affirmative defense, applicant has no "right[]" to assert additional affirmative defenses. Rather, if applicant learns grounds for any additional defenses during this proceeding, applicant may seek to amend its answer to add affirmative defenses in accordance with Fed. R. Civ. P. 15(a); TBMP Section 507.02. Accordingly, the motion to strike is granted with regard to applicant's fourth affirmative defense.

In sum, opposer's motion to strike affirmative defenses is granted in full. The affirmative defenses are therefore stricken from applicant's answer.

Proceedings herein are resumed. Remaining dates are reset as follows.

Deadline for Discovery Conference	**9/21/2012**
Discovery Opens	**9/21/2012**
Initial Disclosures Due	**10/21/2012**
Expert Disclosures Due	**2/18/2013**
Discovery Closes	**3/20/2013**
Plaintiff's Pretrial Disclosures	**5/4/2013**
Plaintiff's 30-day Trial Period Ends	**6/18/2013**
Defendant's Pretrial Disclosures	**7/3/2013**
Defendant's 30-day Trial Period Ends	**8/17/2013**
Plaintiff's Rebuttal Disclosures	**9/1/2013**
Plaintiff's 15-day Rebuttal Period Ends	**10/1/2013**

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.l25.

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.l29.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.