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

Proceeding	91208855
Party	Plaintiff Greater Louisville Convention & Visitors Bureau
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Attachments	91208855-Opposition to Strike Motion.pdf ( 4 pages )(126216 bytes )

<b>Greater Louisville Convention and Visitor's Bureau</b>	)	<b>IN THE UNITED STATES</b>
	)	<b>PATENT AND TRADEMARK OFFICE</b>
	)	
<b>Opposer</b>	)	
	)	<b>TRADEMARK TRIAL AND APPEAL BOARD</b>
<b>v.</b>	)	
	)	
<b>The Wine Group LLC</b>	)	<b>APPL. NO. 85/736,374</b>
	)	
<b>Applicant</b>	)	<b>OPPOSITION NO. 91208855</b>
_____	)	

**OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO STRIKE**

Greater Louisville Convention and Visitor's Bureau ("Louisville", "Opposer", or "Plaintiff"), by and through its below-identified attorneys, hereby opposes The Wine Group LLC's ("Wine Group", "Applicant", or "Defendant") motion to strike, and states as follows:

**I. The Board Does Not Favor Motions to Strike.**

The Board does not favor motions to strike, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. TBMP 506.01 and Note 3 thereto. A pleading needs only to give fair notice of the claims or defenses asserted. TBMP 506.01 and Note 4 thereto. 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. TBMP 506.01 and Note 6 thereto.

**II. Louisville's Amended Affirmative Defenses are Sufficient for Fair Notice.**

Louisville's amended affirmative defenses are sufficient to give Wine Group fair notice of the bases for the defenses. Louisville's motion to amend, and amended answer, are being filed contemporaneously with this opposition.

Specifically, Louisville's Second Affirmative Defense has been amended to clearly set forth the basis for the defense, and is sufficient to give Wine Group fair notice. The amended defense raises factual issues concerning Wine Group's prior knowledge of the use and registration of Louisville's marks, and these factual issues should be determined on the merits.

It must also be noted that Wine Group asserts that a laches defense is insufficient here because the claim against Louisville's URBAN BOURBON mark is that Louisville engaged in naked licensing. Appl.'s Mot. at 4. This is incorrect. Wine Group lists multiple bases in its cancellation counterclaim, and naked licensing is just one of those bases. Also included are claims that Louisville has never used its URBAN BOURBON mark for the specified services; that Louisville's URBAN BOURBON mark was not in use at the time it filed the specimen of use; that Louisville's URBAN BOURBON mark was not in use at the time of registration; that Louisville has abandoned its URBAN BOURBON mark; and that Louisville did not have a *bona fide* intention to use its URBAN BOURBON mark as of the filing date. Appl.'s Cntrelm. at 2-3, paragraphs 3 and 4.

Regarding Louisville's Third Affirmative Defense (Unclean Hands), Wine Group asserts that this defense is insufficient because it sounds in fraud. Appl.'s Mot. at 6. However, this is incorrect. An unclean hands defense does not necessarily sound in fraud. A party can have unclean hands if it has acted unethically or in bad faith with respect to the subject matter of the dispute. In short, unclean hands and fraud are two separate and distinct defenses, as set forth in 37 C.F.R. 2.114(b)(1):

“An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense.”

TBMP 311.02(b) lists them separately as well:

“Affirmative defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense.”

Moreover, nowhere in Fed. R. Civ. P. 9(b) does it state that unclean hands is a special matter requiring particularity of pleading:

“9(b) Fraud or Mistake; Conditions of Mind. In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally.”

In any case, Louisville’s amended Third Affirmative Defense clearly sets forth the basis for the defense, and is sufficient to give Wine Group fair notice. It raises factual issues concerning Wine Group’s motivation in this matter, and these factual issues should be determined on the merits.

Regarding Louisville’s Fourth Affirmative Defense (Express or Implied Waiver), that defense has been deleted in the amended answer, and thus the motion to strike it is moot. Louisville reserves the right to amend its answer to reinstate this defense based on further relevant information that is obtained during discovery.

### **CONCLUSION**

For all the above reasons, Wine Group’s motion to strike should be denied.

Respectfully submitted,

/John A. Galbreath/

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Certificate of Service: I certify that on the date below, the foregoing Opposition to Motion to Strike and referenced attachments, if any, were sent by first-class mail to:

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26 March 2013

/John A. Galbreath/  
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