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

Proceeding	91212653
Party	Plaintiff Nautica Apparel, Inc.
Correspondence Address	STEPHEN L BAKER BAKER AND RANNELLS PA 575 ROUTE 28 RARITAN, NJ 08869 UNITED STATES officeactions@br-tmlaw.com, s.baker@br-tmlaw.com,p.chang@br-tmlaw.com,k.worosila@br-tmlaw.com,k.hnasko@br-tmlaw.com,Margaret_Bizzari@vfc.com
Submission	Motion to Strike
Filer's Name	Neil B. Friedman
Filer's e-mail	Officeactions@br-tmlaw.com, k.hnasko@br-tmlaw.com,
Signature	/Neil B. Friedman/
Date	11/08/2013
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**AFFIRMATIVE DEFENSES 1, 2, 3, 6, 8 & 10 SHOULD BE STRICKEN**

Affirmative Defense No. 1: Applicant states that “Opposer incorporates herein by reference all denials and averments contained in the preceding answers to the Opposition and made them part of these affirmative defenses” (emphasis added).

This is not an affirmative defense. Applicant may not incorporate by reference all denials and averments on behalf of another party that is not itself (i.e. on behalf of the Opposer). Furthermore, Applicant may not plead on behalf of Opposer in any other way. The affirmative defense should be stricken.

Affirmative Defense No. 2: Applicant asserts the Opposition fails to state a claim upon which relief can be granted against Applicant.

A motion to strike the defense of failure to state a claim upon which relief can be granted may be used by the plaintiff to test the sufficiency of its pleading. *Rooibos Limited v. Forever Young (Pty) Limited and Virginia Burke-Watkins*, 2003 TTAB LEXIS 65, 11-12 (Trademark Trial & App. Bd. Feb. 13, 2003). Accordingly, in determining whether to strike affirmative defenses, it will be necessary to look at the sufficiency of petitioner’s pleading. *Id.*

At the pleading stage, Opposer must allege facts in its Notice of Opposition demonstrating its real interest in the proceeding. Those facts must thereafter be proven by Opposer as part of its case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

To plead a real interest a plaintiff must allege a “direct and personal stake” in the outcome of the proceeding. *Id.* at 1026. The allegations in support of the plaintiff’s

belief of damage must have a reasonable basis “in fact.” *Id.* at 1927 (citing *Universal Oil Products. V. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458-459-60 (CCPA 1972) The belief of damage alleged by plaintiff must be more than a subjective belief).

Applicant’s asserted defense therefore questions the sufficiency of Opposer’s pleading. This is quite similar to a motion to dismiss for failing to plead a cause of action under Rule 12(b). As such, Rule 12(b) permits an applicant to assert this defense and “it necessarily follows that a plaintiff may utilize this assertion to test the sufficiency of the defense in advance of trial by moving . . . to strike the ‘defense’ from the defendant’s answer.” *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, at 1222-1223 (TTAB 1995), citing *S.C. Johnson & Son Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973).

The following factors set forth in *Order of Sons of Italy* govern a motion to strike a defense of failure to state a claim upon which relief may be granted.

1. To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an Opposer need only allege such facts as would, if proved, establish that (1) Opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration.
2. For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Opposer’s well-pleaded allegations must be accepted as true, and the Notice of Opposition must be construed in the light most favorable to Opposer.
3. Dismissal for insufficiency is appropriate only if it appears certain that Opposer is entitled to no relief under any set of facts which could be proved in support of its claim.
4. The standing question is an initial inquiry directed solely to establishing the personal interest of the plaintiff. An Opposer need only show “a personal interest in the outcome of the case beyond that of the general public.”

Opposer, in its Notice of Opposition, established its standing, and thus the sufficiency of its pleading, and has alleged several causes of action, *inter alia*, the following:

- Opposer is now and for many years prior to any date which may be claimed by Applicant, engaged in the use of Opposer's Marks for Opposer's Goods and Services (*Notice of Opposition* at ¶ 9);

- Opposer's Marks and Applicant's Mark are confusingly similar when applied to the goods of the parties (*Notice of Opposition* at ¶14);

- The registration of Applicant's Mark to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's Goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), all to Opposer's irreparable damage (*Notice of Opposition* at ¶ 18).

The forgoing allegations are specifically set forth in Opposer's pleading and, if proven, Opposer establishes standing and shows entitlement to relief. Applicant's first defense is insupportable as a matter of law, and thus should be stricken.

**Affirmative Defense No. 3:** Applicant asserts that Opposer has failed to join an indispensable party.

This is not an appropriate affirmative defense to the instant opposition. The opposition has named the applicant. There has been no assignment recorded with United States Patent and Trademark Office. Therefore, it is unclear what additional party should be named in this proceeding. Applicant fails to identify any indispensable party and or provide fair notice otherwise. The affirmative defense should be stricken. *See for e.g., Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should include enough detail to give fair notice of claim).

Affirmative Defense No. 6: Applicant asserts that there is no similarity between the “marketing methods and channels of distribution used for the respective goods”

The instant application is for “adult novelty gag clothing item, namely, socks; athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; athletic footwear; belts; belts for clothing; bottoms; clothing shields, namely, pads applied to the underarms of shirts, blouses and sweaters; footwear; footwear for men and women; footwear not for sports; headbands for clothing; jackets; leather belts; short sets; ties; tops; travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; wearable garments and clothing, namely, shirts; women's clothing, namely, shirts, dresses, skirts, blouses. The description of goods and services is not limited in any fashion and on that basis it is presumed that Applicant's goods travel or may travel in all channels of distribution and may be marketed to all people. Likewise, Opposer's Marks have no limitation and on that basis, the channels of distribution and marketing are the deemed same or similar. The affirmative defense should be stricken.

Affirmative Defense No. 8: Applicant asserts “there is no likelihood of confusion between both brand names Nautica and Sailor and between Applicant's mark and Opposer's mark.”

This is not an affirmative defense and, if anything, confuses the issues. First, Applicant's alleged brand name “Sailor” does not appear in the mark being challenged. The NAUTICA mark is not alleged in this proceeding. The “defense” must be stricken because it is impertinent, immaterial and or has no bearing upon the issues in the case. *See Fed. R. Civ. P. 12(f); Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570

(TTAB 1988)(matter will be stricken if it clearly has no bearing upon the issues in the case).

Affirmative Defense No. 10: Applicant asserts “there is no similarity in the pronunciation of the designations”.

The defense is nonsensical and should be stricken because the marks at issue do not have a pronunciation as neither comprises words. However, to the extent that the doctrine of legal equivalents applies, Applicant’s mark and Opposer’s mark both consist of sails, among other things, and on that basis they are both pronounced in the same fashion. See, e.g., *In re Rolf Nilsson AB*, 230 USPQ 141 (TTAB 1986) (design comprising the silhouette of the head of a lion and the letter "L" for shoes held likely to be confused with LION for shoes); *Puma-Sportschuhfabriken Rudolf Dassler KG v. Garan, Inc.*, 224 USPQ 1064 (TTAB 1984) (designs of mountain lion, for shirts and tops, held confusingly similar to PUMA, for items of clothing; the design of a puma, for items of sporting goods and clothing; and PUMA and design, for T-shirts).

**CONCLUSION**

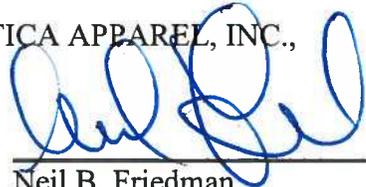
WHEREFORE, Opposer respectfully moves that its motion to strike the above enumerated affirmative defenses in Applicant's Answer be granted in all respects.

Dated: November 8, 2013

Respectfully submitted for Opposer,

NAUTICA APPAREL, INC.,

By:



Neil B. Friedman  
BAKER & RANNELLS, P.A.  
575 Route 28, Suite 102  
Raritan, NJ 08869  
(908) 722-5640

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing MOTION TO STRIKE was sent to attorneys for Applicant this 8<sup>th</sup> day of November via first class mail, postage prepaid, to the following:

GINO NEGRETTI LAW OFFICES  
670 PONCE DE LEON AVE.  
CARIBBEAN TOWERS, STE. 17  
SAN JUAN, PR 00907-3207



Neil B. Friedman