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

Proceeding	91217792
Party	Defendant ACP IP, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**Andale Energy Drink Co., LLC,**  
Opposer,

v.

**ACP IP, LLC,**  
Applicant.

Opposition No.: 91217792  
Application Serial No.: 85/891,919

Date of Publication: April 15, 2014  
Mark: **DALÉ**

**APPLICANT’S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER’S MOTION  
TO STRIKE APPLICANT’S FIRST COUNTERCLAIM AND AFFIRMATIVE  
DEFENSES**

Applicant ACP IP, LLC (“ACP” or “Applicant”) respectfully submits this memorandum of law in Opposition to the Motion to Strike Applicant’s First Counterclaim and Affirmative Defenses (the “Motion to Strike”)(Doc. No. 6), filed by Opposer Andale Energy Drink Co., LLC (“Andale” or “Opposer”).

**I. INTRODUCTION**

ACP is the trademark holding company for Armando Pérez p/k/a as Pitbull, a commercially successful and critically-acclaimed entertainer who performs and sells music and related merchandise throughout the United States and the world in connection with the mark **DALÉ**. As a result of ACP’s extensive use, the **DALÉ** trademark is extremely strong and has garnered international recognition among the consuming public.

Andale opposed ACP’s captioned trademark application to register **DALÉ** on the basis of likelihood of confusion with its purported ANDALE! trademark and ACP’s alleged “lack of *bona fide* intent to use” the **DALÉ** trademark. In response to Andale’s Notice of Opposition, ACP alleged six (6) Affirmative Defenses. ACP also filed two Counterclaims based on (i)

likelihood of confusion as the senior user of the **DALE** trademark, and (ii) Opposer's abandonment of ANDALE! though non-use. (Doc. No. 4)(ACP's "Counterclaims"). Andale subsequently moved to strike<sup>1</sup> ACP's First Counterclaim and four of Applicant's Affirmative Defenses on the ground that they are "legally insufficient and improper."<sup>2</sup> (Motion to Strike, p. 3).

As set forth herein, an application of the relevant legal standards to the allegations set forth in ACP's Counterclaims reveal that ACP's First Counterclaim and asserted Affirmative Defenses are sufficient and that striking them from the pleadings at this early stage would be unnecessary and prejudicial. Andale's position is meritless and the Motion to Strike should be **DENIED** by the Board.

## **II. ARGUMENT AND CITATION OF LEGAL AUTHORITY**

### **A. APPLICABLE LEGAL STANDARDS**

Rule 12(f) of the Federal Rules of Civil Procedure grants the Board the authority to strike from a pleading "any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." *See also* TBMP § 506.01. However, "[m]otions to strike are **not favored**, and matter will not be stricken unless it clearly has no bearing upon the issues in this case." *Id.* (emphasis added); *see also Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Elec. Sciences, Inc.*, 9 U.S.P.Q.2d 1570, 1571 (TTAB 1988); *Augustus v.*

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<sup>1</sup> Andale concurrently filed a Motion to Dismiss ACP's First Counterclaim (Doc. No. 7). The Motion to Strike parrots many of the same arguments raised in the Motion to Dismiss as to ACP's Counterclaim.

<sup>2</sup> Of particular interest, virtually the entirety of Andale's Motion to Strike ACP's Affirmative Defenses is plagiarized from "Petitioner's Motion to Strike Registrant's Affirmative Defenses," filed June 14, 2013 in connection with Cancellation Proceeding No. 92055910 (a proceeding to which Andale was not a party). The motion, attached hereto as Exhibit A, was summarily denied by the Board on October 30, 2013. The result should be no different here.

*Bd. Of Pub. Instruction of Escambia County*, 306 F.2d 862, 868 (5<sup>th</sup> Cir. 1962)(striking allegations from a pleading “is a drastic remedy to be resorted to only when required for the purpose of justice,” and only when the stricken allegations have “no possible relation to the controversy.”). The Board has broad discretion to “decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide further notice of the basis for a claim or defense.” TBMP § 506.01; *Ohio State Univ.*, 51 U.S.P.Q.2d at 1292.

**B. ACP HAS SUFFICIENTLY PLED A VALID COUNTERCLAIM FOR LIKELIHOOD OF CONFUSION**

Under 37 C.F.R. 11.18(b)(2)(iii), the factual basis for a pleading requires either that the pleader know of facts that support the pleading or that evidence showing the factual basis is “likely” to be obtained after a reasonable opportunity for discovery or investigation. Because the purpose of pleadings is to give fair notice to a claim, a party is allowed reasonable latitude in its statement of its claims. *Harsco*, 9 U.S.P.Q.2d at 1571. To state a claim for likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), a party must first plead that it has proprietary rights in its pleaded mark(s) that are superior to those of the other party. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 U.S.P.Q. 40 (C.C.P.A. 1981). In the case of an applicant relying on common law rights, the party must also plead priority of use or “use analogous to trademark use”<sup>3</sup> and either the inherent or acquired distinctiveness of its mark. *See Wella Corp. v. Clairol, Inc.*, 169 U.S.P.Q. 190 (T.T.A.B. 1971). The pleading should then set forth the basic facts supporting its claim of likelihood of confusion. *See In re E.I. du*

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<sup>3</sup> “There is no doubt that opposer has sufficiently stated a claim of likelihood of confusion based upon an allegation of use analogous to trademark use. In particular, opposer has sufficiently alleged that it has heavily promoted PURPLE HAZE in connection with a mixed alcoholic beverage consisting of sake and opposer's CHAMBORD liqueur.” *Chatam Int'l Inc. v. Abita Brewing Co.*, 1998 TTAB LEXIS 527, \*6 (TTAB Sept. 22, 1998).

*Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

Andale has taken the position, in its Motion to Strike, that ACP's goods and services offered in connection with its **DALÉ** trademark "are simply too different" from Andale's "energy drinks...to state a plausible claim for likelihood of confusion" and "allegations that these disparate goods 'overlap' is [sic] implausible and insufficient." (Motion to Strike, p. 4). While Andale throws around the terms "implausible" and "insufficient" throughout its brief, Andale is, in reality, asking the Board to prematurely determine the substance of ACP's Counterclaims. Such a determination is not appropriate at this juncture:

Whether opposer's allegations regarding the relatedness of the parties' respective goods and services are, in fact, true **is not a matter for determination at this time**. For purposes of evaluating the sufficiency of pleadings, all averments must be taken as true and construed in the light most favorable to the pleading party.

*Cent. Mfg. Co. v. Stealth, Ltd.*, 2004 TTAB LEXIS 348, \*3 (TTAB June 22, 2004)(citing *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993))(emphasis added).

ACP has pled that (i) it owns superior rights to those of Andale and priority of use of **DALÉ** (Counterclaims, ¶¶ 3-6); and (ii) Andale's continued use of its ANDALE! mark will cause ACP harm (Counterclaims, ¶¶ 7-9). These facts – taken as true in considering Andale's Motion to Strike – support ACP's claim of likelihood of confusion which, if proven, would warrant cancellation of Andale's registration. Andale's inappropriate attempt to delve into a substantive dispute over whether a likelihood of confusion exists between Applicant's **DALÉ** mark and Opposer's ANDALE! Mark, and whether Applicant's use of the **DALÉ** mark for beverages establishes priority use is misguided. The issue at this stage of the case is not whether ACP's counterclaim ultimately will succeed, but whether ACP is entitled to offer evidence to

support its claim. *See Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2D (BNA) 1536, \*5 (TTAB Nov. 21, 2007)(quoting *Advanced Cardiovascular Systems*, 988 F.2d at 1157). Accordingly, ACP respectfully submits that granting Opposer’s Motion to Strike at this early stage would be improper based on the allegations set forth in Applicant’s Counterclaims.

**C. APPLICANT’S AFFIRMATIVE DEFENSES ARE SUFFICIENT**

Rules 8(b)(1)(A) and 8(c), Fed.R.Civ.P., govern the pleading of affirmative defenses, and merely require that a party “affirmatively state any...affirmative defenses” and that they do so “in short and plain terms.”<sup>4</sup> Applicant has set forth its affirmative defenses in simple and direct terms for the accepted purpose of giving fair notice of the defenses asserted. *See Ohio State Univ.*, 51 U.S.P.Q.2d at 1292. An affirmative defense is not insufficient unless it clearly has *no possible bearing* on the issue under litigation. *Harsco*, U.S.P.Q.2D (BNA) 1570, \*3 (emphasis added). Each of the affirmative defenses raised in Andale’s Motion to Strike is addressed below.

**1. FAILURE TO STATE A CLAIM**

As set forth in ACP’s First Affirmative Defense, Andale’s Notice of Opposition fails to state a claim upon which relief can be granted because Andale can prove no set of facts in support of its claims that would entitle it to the relief requested in the Notice of Opposition. Rule 12(b)(6), Fed.R.Civ.P., permits a defendant to assert in the answer the “defense” of failure to state a claim upon which relief can be granted, which tests the sufficiency of the plaintiff’s pleadings. *See S. C. Johnson & Son Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973); *see*

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<sup>4</sup> Andale’s Motion to Strike relies heavily on *McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45 (TTAB 1985), which involves a Rule 12(b)(6) motion to dismiss an affirmative defense of fraud and is clearly not applicable here. Rule 8(c) is a lesser requirement than Rule 8(a) governing affirmative claims or Rule 9(b) governing certain affirmative defenses that must be pleaded in “special detail.” The claim in *McDonnell* is subject to the more stringent pleading requirement governed by Rule 9(b). *Id.* Thus, the issue of whether ACP’s Counterclaims include “bald allegations in the language of the statute” is not relevant. (Motion to Strike, pp. 7, 11).

*also Chantelle v. De Millus Comercio e Industria De Roupas S.A*, 2004 TTAB LEXIS 6, \*2 n2 (TTAB Jan. 14, 2004)(“Applicant also asserted as "affirmative defenses" that the notice of opposition failed to state a claim upon which relief may be granted...Opposer moved to strike these ‘defenses’...Noting that applicant was not barred from pleading the[se] matters as affirmative defenses, even though these defenses may be similar or even identical to applicant's denials of opposer's allegations, the Board...denied the motion to strike.”). To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an opposer must allege such facts as would, if proved, establish that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

In the Notice of Opposition, Andale alleged that its “first use of the ANDALE! Mark in the U.S. [is] in 2011.” (Notice of Opposition, ¶ 11). Even accepting this assertion as truthful, Andale does not state a valid claim for priority over ACP, which has been using the **DALE** trademark since at least as early as 2004 in connection with “a variety of goods and services, including musical recordings, video recordings, live performances, apparel and in television commercials for products such as soft drinks, alcoholic beverages and automobiles.” (Counterclaims, ¶ 4); *see Cont'l Gummi-Werke AG v. Cont'l Seal Corp.*, 1984 TTAB LEXIS 111, \*8-9 (TTAB May 9, 1984)(“Applicant's pleading in this case is, however, inadequate. While applicant's counterclaim alleges that opposer's amendment to the pleaded registration acts to ‘affirmatively cause confusion, mistake and deception among the consuming public,’ applicant has made no claim in its pleading of priority of use. Applicant's pleading of likelihood of confusion with the mark in opposer's amended registration, in the absence of such an allegation, is insufficient to state a claim.”); *see also Zirco Corp. v. AT&T*, 1991 TTAB LEXIS 43, \*9

(TTAB Nov. 5, 1991)(“In view thereof, applicant's motion to dismiss the opposition under Fed. R. Civ. P.12(b)(6) is well taken. Opposer's allegations of common law rights in its mark as of April 15, 1990, a date subsequent to applicant's constructive use date, are inadequate to support the ground of priority of use and likelihood of confusion and accordingly opposer has failed to set forth a claim upon which it can prevail.”). Similarly, here, Andale’s allegations of “common law trademark rights in ANDALE! with priority of use in 2011”<sup>5</sup> is adequate to support the ground of priority of use and likelihood of confusion.

Furthermore, Andale asserted no facts to demonstrate its standing, as detailed below, to bring this opposition proceeding against ACP. In order to properly plead standing, a plaintiff must allege that it has a real interest in the outcome of the proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Harjo v. Pro Football, Inc.*, 1994 TTAB LEXIS 9, \*5 (TTAB Mar. 11, 1994)(“The purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, i.e., where a plaintiff is no more than a mere intermeddler.”). For example, Andale does not allege, nor could it, that ACP’s trademark application for **DALÉ** is obstructing the registration of its own mark. *Cf. Rooibos Ltd. v. Forever Young (Pty) Ltd.*, 2003 TTAB LEXIS 65, \*13-14 (TTAB Feb. 13, 2003)(“It is clear that petitioner has a real interest in this proceeding as the result of its ownership of an application which was refused registration on the basis of the registration herein sought to be cancelled, and that it has asserted proper grounds for cancellation.”). Thus, Andale’s Motion to Strike ACP’s First Affirmative Defense should be denied as baseless.

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<sup>5</sup> Notice of Opposition, ¶ 3.

## 2. UNCLEAN HANDS

ACP's Second Affirmative Defense alleges that Andale's Notice of Opposition is barred "by the doctrine of unclean hands. [Andale] has unclean hands because [Andale] filed the Notice of Opposition for the purpose of harassment and extortion." (Counterclaims, p. 2). In its Motion to Strike, Andale asserts that ACP's defense is "highly inflammatory, improper, legally meaningless, and irrelevant to the Board's determination of the trademark registration issues in this proceeding." (Motion to Strike, p. 11).

Preliminarily, the defense of "unclean hands" is specifically recognized by the Trademark Trial and Appeal Board Manual of Procedure as an affirmative defense in trademark proceedings. *See* TBMP § 311.02(b). In this proceeding, ACP asserts that Andale filed the Notice of Opposition for the purpose of harassment and extortion, based on the fame and commercial success of Armando Pérez p/k/a Pitbull. This is evident from Andale's subsequent demands that Mr. Pérez agree to a "cross promotion of goods or services between Andale Energy Drink and Armando Pérez/Pitbull." ACP intends to demonstrate that Andale's conduct prevents it from succeeding on the claims in the Notice of Opposition. *See Cent. Mfg.*, 2004 TTAB LEXIS 348 at \*4 ("We find that applicant has sufficiently pleaded the defense of unclean hands. Whether or not applicant will be able to prove this defense remains for trial.")(citing *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); *Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625 (TTAB 1992)).

## 3. OPPOSER HAS NOT BEEN DAMAGED AND OPPOSER HAS NOT ESTABLISHED STANDING

Finally, Andale moved to strike ACP's Fourth and Fifth Affirmative Defenses that "Opposer has not been and will not be damaged by the registration of the mark **DALÉ**" and

“Opposer has not established that it has standing to maintain its claims against Applicant,” respectively. As noted above, Andale has not asserted any facts to demonstrate its standing to bring this opposition proceeding against ACP. The standing question is an initial inquiry directed solely to establishing the personal interest of the plaintiff. *See D. M. & Antique Imp. Corp. v. Royal Saxe Corp.*, 1965 TTAB LEXIS 96, \*3 (TTAB 1965)(“The affirmative averments sought to be stricken comprise, in effect, a claim by respondent that petitioner is without standing to contest the continued registration of the trademark under attack, and thus may well constitute a sufficient and proper defense. Respondent should be given every opportunity to establish its defenses. The motion to strike is accordingly denied.”). The Federal Circuit has stated that an opposer must show "a personal interest in the outcome of the case beyond that of the general public." *See Estate of Biro v. Bic Corp.*, 18 USPQ 1382, 1385 (TTAB 1991)(citations omitted). Here, Andale has no real interest in the outcome of the proceeding – particularly given Andale’s non-use of its alleged trademark – and is nothing more than a mere intermeddler.

Additionally, both defenses may also be construed as an “amplification or embellishment” of ACP’s denial of Andale’s claims in the Notice of Opposition. *In re Mavety Media Group Ltd.*, 33 F.2d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994); *see also Bondurant v. A.B. Dick Co.*, 2006 TTAB LEXIS 335, \*2 (TTAB Aug. 24, 2006)(“In addition, inasmuch as applicant's affirmative defenses merely amplify applicant's general denial of the grounds for opposition, and because the Board generally does not favor motions to strike, opposers' motion to strike applicant's affirmative defenses...is denied.”)(*citing Textron, Inc. v. Gillette Co.*, 180 USPQ2d 1221, 1223 (TTAB 1973)(applicant's affirmative defense amplifies denial of likelihood of confusion), and authorities cited in TBMP 506.01); *Benefit Franchise Co. v. MasterCard Int'l*, 1999 TTAB LEXIS 679, \*2-3 (TTAB Nov. 29, 1999)(“The Board will not strike allegations

from a pleading, even if they are objectionable, if they will not prejudice the adverse party and if such allegations provide fuller notice of the basis for a claim or defense. The paragraph which opposer seeks to strike relates to an asserted defense to the opposition: applicant's belief that opposer cannot establish any damage as a result of applicant's use and registration of the term and that there is no likelihood of confusion in light of these registrations.”)(citing TBMP Section 506 and *Harsco*, 9 USPQ2d at 1570); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987)(allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such). As such, ACP's Fourth and Fifth Affirmative Defenses must be considered a legally sufficient defense.

**D. APPLICANT'S AFFIRMATIVE DEFENSES HAVE NOT PREJUDICED OPPOSER AND, THEREFORE, A MOTION TO STRIKE IS NOT APPROPRIATE**

As set forth above, motions to strike a defense as insufficient are not favored by the Board because of their dilatory character. Thus, even when technically appropriate and well-founded, they often are not granted in the absence of a showing of prejudice to the moving party. 5A Wright and Miller Federal Practice and Procedure, § 1381, at 672 (2d ed. 1990). Andale makes no assertion that it would be prejudiced by the inclusion of ACP's affirmative defenses. Instead, Andale protests that the defenses do not provide enough detail, repeatedly basing its arguments on the higher standard expressed in *McDonnell*. (Motion to Strike pp. 3, 11). On the other hand, ACP *would* be prejudiced if its affirmative defenses were stricken before discovery. *Sabra Salads Food Indus. (1985) v. Blue & White Food Prods. Corp.*, 1999 TTAB LEXIS 647, \*5 (TTAB Nov. 18, 1999)(“Since the parties' arguments on this motion demonstrate that these critical facts are in dispute, striking all three paragraphs under Rule 12(f) would be an abuse of

discretion.”). If Andale is confused about ACP’s affirmative defenses, these matters may be settled in discovery, rather than stand as reason to prematurely strike an entire defense. *See Johnson & Johnson v. Rexall Drug Co.*, 1975 TTAB LEXIS 61, \*10 (TTAB 1975)(“It naturally follows...that applicant is entitled to take discovery to determine whether grounds exist for any affirmative defenses or counterclaims, including whether there are circumstances, or a course of conduct on the part of opposer....which might give rise to a new counterclaim to cancel opposer's registration....”).

### **III. CONCLUSION**

Based on the foregoing, ACP submits that its First Counterclaim and Affirmative Defenses are sufficiently pleaded in accordance with the requirements of the Federal Rules of Civil Procedure, the Trademark Trial and Appeal Board Manual of Procedure, and as interpreted by the Board and Courts. According, ACP respectfully requests that the Motion to Strike be **DENIED**.

Date: December 29, 2014

Respectfully submitted,

**FRIEDLAND VINING, P.A.**

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***Counsel for Applicant***

**CERTIFICATE OF SERVICE**

**I HEREBY CERTIFY** that the foregoing **APPLICANT'S MEMORANDUM OF LAW IN OPPOSITION TO OPPOSER'S MOTION TO STRIKE APPLICANT'S FIRST COUNTERCLAIM AND AFFIRMATIVE DEFENSES** was served upon the Opposer by delivering true and correct copies of same to Opposer via First class U.S. mail on December 29, 2014 as follows:

Paulo A. de Almeida  
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/s/Jaime Rich Vining \_\_\_\_\_  
Jaime Rich Vining

# **EXHIBIT A**

ESTTA Tracking number: **ESTTA543147**

Filing date: **06/14/2013**

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

Proceeding	92055910
Party	Plaintiff Software Development Solutions, Inc.
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Date	06/14/2013
Attachments	120039.tm.01.petitioner's motion to strike affirmative defenses.pdf(51642 bytes )

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

In the Matter of Trademark Registration No. 4,138,501  
For the mark: JamCast (standard character mark)  
Date registered: May 8, 2012

Software Development Solutions, Inc.	)	
	)	
Petitioner,	)	Cancellation No. 92055910
	)	
v.	)	
	)	
AirCast Mobile, Inc.	)	
	)	
Registrant.	)	
	)	

**PETITIONER’S MOTION TO STRIKE REGISTRANT’S AFFIRMATIVE DEFENSES**

Pursuant to Rule 12 of the Federal Rules of Civil Procedure (FRCP) and Section 506.01 of the Trademark Trial and Appeal Board Manual of Procedure (TBMP), Petitioner, Software Development Solutions, Inc. (hereinafter “SDS”), hereby moves the Trademark Trial and Appeal Board (hereinafter the “Board”) to strike the Affirmative Defenses as pleaded in Registrant’s Answer and Affirmative Defenses filed by Registrant, AirCast Mobile, Inc.’s., (hereinafter “Aircast”), as **they are legally insufficient and improper as a matter of law.**

## **BACKGROUND**

On July 20, 2012, Petitioner, SDS, commenced this cancellation proceeding by filing a Petition to Cancel the trademark JAMCAST, Registration Number 4,138,501, owned by Registrant, Aircast, to which Aircast filed its Answer and Affirmative Defenses on September 5, 2012. Petitioner, now files its Motion to Strike the affirmative defenses filed by Registrant, as Registrant's affirmative defenses are inappropriate and unfounded in law, in light of information revealed through discovery, and for the most part, are **merely bare bones, conclusory statements that do not provide any notice to Petitioner as to the basis for the respective defenses**, as required by the TBMP rules and the FRCP. As such, Petitioner moves to strike all of Registrant's Affirmative Defenses for the reasons set forth below.

## **ARGUMENT - GENERAL:**

**Under TBMP § 506.01, "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(t); See also Harsco Corp. v. Electrical Sciences Inc., 9 USPQ 2d 1570 (TTAB 1988). Although motions to strike are not favored, *Id.*, they are permissible and will be granted when appropriate. *Id.*** Here, as each purported affirmative defense is either **legally insufficient** and/or improper, it is appropriate for them each to be stricken, prior to the parties expending their time, and the Board's time, on unnecessary discovery, testimony, argument and briefing.

A. **Registrant's First Affirmative Defense Should Be Stricken as Legally Insufficient**

Registrant's First Affirmative Defense reads:

The Petition to Cancel fails to state a claim upon which relief can be granted.

Answer at 7. As an initial matter, Registrant's First Affirmative Defense is merely a bare bones conclusory assertion which the courts have held as legally insufficient as it does not provide proper notice to the Petitioner. *See Northwestern Corp. v. Gabriel Mfg. Co., Inc.*, Not Reported in F.Supp., 1996 WL 732519 (N.D. Ill. 1996) (striking bare bones affirmative defense of failure to state a claim upon which relief can be granted); *Tome Engenharia E. Transportes, Ltd v. Malki*, Not Reported in F.Supp., 1996 WL 172286 (N.D. Ill 1996), *Flazsa v. TNT Holland Motor Exp., Inc.*, 155 F.R.D. 612, 614 (N.D.Ill 1994), and *In re Olympia Brewing Co. Securities Litigation*, Not Reported in F.Supp., 1985 WL 3928 (N.D. Ill 1985). While affirmative defenses should be stated simply, concisely, and directly, Fed. R. Civ. P. 8(d)(1), they must provide enough detail to give the plaintiff fair notice of the basis for the defense. *Fair Indigo*, 85 USPQ2d at 1538; *McDonnell Douglas Corp.*, 228 USPQ at 47 (bald allegations in the language of the statute do not provide fair notice of the basis of the defense); TBMP §311.02(b). Here, Petitioner's First Affirmative Defense baldly states "The Petition to Cancel fails to state a claim upon which relief can be granted," Answer at 7, without providing Petitioner with any specifics regarding how or why the Registrant believes the claim to be insufficient. The Board has held, as it should here, that such a bare, conclusory statement fails to properly notify the Petitioner of any specific issues within the Petition to Cancel and as such Registrant's First Affirmative Defense is legally insufficient and should be stricken.

However, even ignoring the fact that the First Affirmative Defense is legally insufficient, this "defense" does not actually amount to an affirmative defense at all. **An affirmative defense is a defense that assumes the allegations in a complaint to be true and then goes on to assert new matter that eliminates or limits the defendant's ordinary liability stemming from those allegations. *Amanda Blackhorse, Marcus Briggs, Phillip Gover, Julian Pappan, and Courtney Tsotigh v. Pro Football, Inc.*, 98 USPQ2d 1633 (TTAB 2011); *See Black's Law Dictionary* 451 (8th ed. 2004). Such a defense does not negate the elements of the cause of action, but rather provides an explanation that bars the claim entirely. *Id.* As such, the Board has consistently held that failure to state a claim upon which relief can be granted is not an appropriate affirmative defense, as "it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than a statement of a defense to a properly pleaded claim." *Castro v. Cartwright*, Opposition No. 91188477 (September 5, 2009); *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1738 n. 7 (TTAB 2001) (The pleaded "affirmative defense" of failure to state a claim upon which relief can be granted, is not a true affirmative defense and shall not be considered as such).**

Nevertheless, **it is well settled that this "defense" may be used by the party asserting same to test the sufficiency of the initial pleading prior to trial. *Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222-23 (TTAB 1995); *Harjo v. Pro Football, Inc.*, 1994 WL 262249, 30 USPQ2d 1828, 1830 (TTAB 1994); *S.C. Johnson & Son, Inc. v. GAF Corporation*, 177 USPQ 720 (TTAB 1973). Accordingly, to withstand the "defense" of failure to state a claim upon which relief can be granted, Petitioner need only allege that (1) the Petitioner has standing to maintain the proceeding, and (2) a valid ground exists for canceling the mark. *Id.*; *Young v. AGB Corp.*, 152 F.3d 1377; 47 USPQ 2d 1752, 1754 (Fed. Cir. 1998); *Intersat***

*Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985); *Fair Indigo*, 85 USPQ2d at 1538; *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Additionally, the Notice to Cancel must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief sought. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus.*, 670 F.2d 1024; TBMP § 503.02. In this case, Petitioner has clearly met this standard.

**B. Registrant's Second and Third Affirmative Defenses Should be Stricken as Legally Insufficient and Inappropriate for an Opposition Proceeding.**

Registrant's Second Affirmative Defense reads:

The Petition to Cancel is barred by the doctrine of estoppel, waiver, and acquiescence.

Registrant's Third Affirmative Defense reads:

The Petition to Cancel is barred by the doctrine of laches.

Answer at 8 and 9. These affirmative defenses are not only legally insufficient, as they are merely bare bones, conclusory statements that do not meet the standards set forth by Fed. R. Civ. P. 8(b) and TBMP §311.02(b), but they are also inappropriate for this cancellation proceeding and should be stricken as such.

TBMP § 311.02(b) states, in pertinent part, "the elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the

plaintiff fair notice of the basis for the defense." See Fed. R. Civ. P. 8(d)(1); See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *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); and *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). Bald allegations, such as those asserted in Registrant's Second and Third Affirmative Defenses, have repeatedly been stricken as legally insufficient to provide fair notice to Petitioner. See *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985) (bald allegations in the language of the statute, did not provide fair notice of basis of petitioner's Trademark Act § 2(a), 15 U.S.C. § 1052(a) claim); and Cf. *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1864 (TTAB 2007) (bald allegations of misrepresentation of source did not provide fair notice). As the Second and Third Affirmative Defenses do not meet the standard to provide fair notice to Petitioner, as set forth in Fed. R. Civ. P. 8(b) and TBMP § 311.02(b), these defenses should be stricken as being legally insufficient.

Additionally, Registrant's Second and Third Affirmative Defenses are also inappropriate for this cancellation proceeding, and should be stricken as such. The TBMP explains, and the Board has held, that the availability of the affirmative defenses of laches, estoppel, and acquiescence are "severely limited in Board proceedings." TBMP § 311.02 (b); See *Turner v. Hops Grill and Bar, Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999). Moreover, laches and estoppel are not a defense to a cancellation case where the marks are identical and the goods are essentially the same, leading to the inevitability of confusion. *Reflange, Inc. v. R-Con Int'l*, 17 USPQ2d 1125 (TTAB 1990). Equitable Defenses are a factor only where likelihood of confusion is reasonably in doubt. *Richdel, Inc. v. Mathews Co.* 190 USPQ 37 (TTAB 1976).

Here the marks are identical and the goods are essentially the same, as such Registrant's Second and Third Affirmative Defenses should be stricken accordingly.

C. **Registrant's Fourth and Fifth Affirmative Defense Should be Stricken as Legally Insufficient**

Registrant's Fourth Affirmative Defense reads:

Aircast's Trademark Registration, No. 4138501, as being registered, is inherently distinctive.

Registrant's Fifth Affirmative Defense reads:

SDS's mark is not famous.

Answer at 10 and 11. These two "defenses" are merely conclusory statements. They state nothing more than conclusive statements about the status or alleged status of the respective marks, without amplifying the reasons behind Registrant's conclusion.

As discussed in greater detail above, these "defenses" are legally insufficient, as they are merely bare bones, conclusory statements that do not meet the standards set forth by Fed. R. Civ. P. 8(b) and TBMP §311.02(b), and as such, they should both be stricken as legally insufficient.

D. **Registrant's Sixth Affirmative Defense Should be Stricken as Legally Insufficient and Inappropriate for an Opposition Proceeding.**

Registrant's Sixth Affirmative Defense reads:

Aircast's mark has been adopted and utilized in good faith.

Answer at 12. This affirmative defense is not only legally insufficient, as it is merely a bare bones, conclusory statement that does not meet the standards set forth by Fed. R. Civ. P. 8(b) and TBMP §311.02(b), but it is also inappropriate for this cancellation proceeding and should be stricken as such. This “defense” is basically an equitable defense. As addressed above in the discussion regarding estoppel, waiver, acquiescence, and laches, equitable defenses are not applicable in cancellation proceedings when the marks are identical and the goods are essentially the same. *Reflange, Inc. v. R-Con Int’l*, 17 USPQ2d 1125 (TTAB 1990). Equitable Defenses are a factor only where likelihood of confusion is reasonably in doubt. *Richdel, Inc. v. Mathews Co.* 190 USPQ 37 (TTAB 1976). As such, Registrant’s Sixth Affirmative Defense should be stricken accordingly.

**E. Registrant’s Seventh Affirmative Defense Should be Stricken as Redundant of Denials Already Made in the Answer.**

Registrant’s Seventh Affirmative Defense reads:

Upon information and belief, SDS does not have prior usage before AirCast’s usage of the mark JAMCAST upon computer application software for mobile phones, namely, software for recording, streaming, distributing, and listening to music and live concerts in class 009 to support its grounds for cancellation of AirCast’s mark JAMCAST.

Answer at 13. The Federal Rules of Civil Procedure are clear that the Board may strike any redundant, superfluous material. Fed. R. Civ. P. 12(f); TBMP § 506.01. Case law further clarifies that mere reiterations of denials that were previously set forth in the answer and do not add anything of substance to the answer- such as Registrant’s Seventh "Affirmative Defenses"- are

redundant and should be stricken as such. *Textron, Inc. v. Gillette Company*, 180 USPQ 152, 154 (TTAB 1973).

Registrant's Seventh "defense" merely reiterates Registrant's position stated earlier in the Answer through the denials. *See* Answer at 5. This "defense" states nothing more than a conclusive denial of the date of first use alleged by Petitioner in its Petition to Cancel, without amplifying the reasons behind Registrant's conclusion.

The Board distinguishes between mere reiterations, which should be stricken, and "defenses" that amplify denials and serve to give the plaintiff fuller notice of the position the defendant plans to take in defense of its right to registration. *See Morgan Creek Productions, Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 (TTAB 2009) (applicant's "affirmative defenses" for the most part amplified its denials of opposer's allegations regarding likelihood of confusion); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986) (same); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973). However, in all the cases where the Board held that the "affirmative defenses" amplified the defendant's position, rather than merely reiterated a denial, the "defense" included facts to support the defendant's position. Such facts and circumstance are allowed as an "affirmative defense", the Board has held, as they further elucidate defendant's position and serve to put the plaintiff on fuller notice. Here, however, no such facts exist. Rather, Registrant's Seventh "Affirmative Defense" merely repeats the earlier denials relating to Petitioner's date of first as alleged in the Petition to Cancel (as was previously done in the body of the Answer at 5) without adding any facts as to why Registrant believes this to be the case. As

such, the Seventh Affirmative Defense is a mere reiteration of the denial in the Answer, without putting Petitioner on fuller notice of Registrant's case, and should be stricken as redundant.

**F. Registrant's Eighth Affirmative Defense of Reservation of Rights is Improper, Impertinent and Should be Stricken.**

Registrant's Eighth Affirmative Defense reads:

AirCast reserves the rights to add, to amend, and to withdraw its affirmative defenses as its further investigation or discovery so leads.

Answer at 14. As with Registrant's Seventh claimed "Affirmative Defense", Registrant's Eighth claimed "Affirmative Defense" is not a defense at all. Rather, it is merely a statement that Registrant reserves the right to raise, amend or withdraw additional or current affirmative defenses, if they can think of any at a later time. This "reservation" is not only not a defense, but simply adding it into the Answer is unnecessary, improper, and illogical. If, at a future point, the rules permit Registrant to raise additional affirmative defenses, then this right already exists and the addition of this "defense" is superfluous. If, however, the rules do not allow Registrant to raise certain additional defenses in the future, then the addition of this language does not - and cannot - create such a right. Allowing such a right to be created through "affirmative defenses" not only avoids the well-established trademark law, but would also highly prejudice Petitioner as there would be no safeguard from improper, immaterial, impertinent, scandalous, or redundant defenses. As such, Registrant's Eighth "Affirmative Defense" should be stricken.

## CONCLUSION

For the foregoing reasons Petitioner respectfully requests that all of Registrant's Affirmative Defenses be stricken.

Respectfully submitted,

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## CERTIFICATE OF SERVICE

Pursuant to mutual agreement, TTAB Rules 2.101(b), 2.119(a), and Federal Rule of Civil Procedure 4(h)(1) it is hereby certified that a copy of the foregoing **PETITIONER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES** was served by electronic mail to Registrant, AirCast Mobile, Inc., by forwarding same to Registrant's attorney Charles McCloskey on June 14, 2013 at [ccmlaw@socket.net](mailto:ccmlaw@socket.net).

/Craig Kirsch/

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