

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

MAB/MW

Mailed: January 19, 2016

Opposition No. 91221822

Seven S.p.A

v.

Seven For All Mankind, LLC

Before the Trademark Trial and Appeal Board:

By way of background, Seven S.p.A (“Opposer”) filed a notice of opposition opposing registration of application Serial No. 86129387 for the mark SEVEN FOR ALL MANKIND, owned by Seven For All Mankind, LLC (“Applicant”). As grounds for opposition, Opposer alleges priority and likelihood of confusion with its pleaded Registrations Nos. 1708062 and 4061897.¹ Applicant, in its first amended answer (filed July 6, 2015), denied the salient allegations in the notice of opposition, asserted affirmative defenses, and counterclaimed to cancel Opposer’s pleaded registrations on the grounds of abandonment and fraud. On August 19, 2015, Opposer, as counterclaim defendant, filed its answer to the counterclaims and asserted affirmative defenses.

This case now comes before the Board for consideration of Applicant’s motion to strike Opposer’s affirmative defenses and several of Opposer’s denials in its answer

¹ Both of Opposer’s registrations consist of the wording 7SEVEN in stylized form.

to Applicant's counterclaims ("Opposer's answer"). The motion has been fully briefed.

Under Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any "insufficient defense or any redundant, immaterial, impertinent or scandalous matter." *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a) and TBMP § 506 (2015). 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, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

Affirmative Defenses

Turning first to Applicant's motion to strike Opposer's affirmative defenses of laches, acquiescence and estoppel, Applicant, as counterclaim plaintiff, seeks to strike Opposer's affirmative defenses on the grounds that the equitable defenses are unavailable against the claims of fraud and abandonment, as a matter of law.²

Opposer argues, among other things, that the facts of the present case are such that Opposer should not be precluded from asserting equitable defenses.³

Under Fed. R. Civ. P. 8(b)(1), the elements of a defense should be stated directly and concisely. A legally sufficient pleading of each defense must include enough factual detail to provide the plaintiff with fair notice of the defense. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Midwest*

² 8 TTABVUE at 5.

³ 9 TTABVUE at 3-4.

Plastic Fabricators, Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067, 1069 (TTAB 1980)

Here, Opposer's affirmative defenses consist of bald allegations that Applicant's counterclaims are barred by laches, acquiescence and estoppel.⁴ Inasmuch as Opposer's answer to the counterclaim does not contain any factual allegations that would provide fair notice of the basis of the affirmative defenses, the affirmative defenses of laches, acquiescence and estoppel are insufficiently pleaded. *See, e.g., 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 the basis of the claim); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992) (insufficient affirmative defenses stricken).

In addition, equitable defenses such as laches, acquiescence and estoppel are not available against the claims of abandonment and fraud because "it is in the public interest to prohibit registrations procured or maintained by fraud and to remove abandoned registrations from the register." *Treadwell Drifters, Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989); *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1499-1500 (TTAB 1986) (public interest precludes equitable defenses such as prior registration, laches or acquiescence against a claim of fraud). *Cf. Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919,

⁴ Answer to Counterclaim at ¶¶23-24, 7 TTABVUE at 4.

1923 (TTAB 2002) (equitable defenses of laches, estoppel and acquiescence cannot be asserted against descriptiveness).

In view thereof, Applicant's motion to strike Opposer's affirmative defenses is **granted**.

Opposer's Denials Based on Information and Belief

The Board turns next to Applicant's motion to strike paragraphs 4, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 21 and 22 in Opposer's answer. Applicant argues that Opposer's denials of the corresponding allegations were improperly made "upon information and belief." The allegations in the counterclaim relate to whether Opposer abandoned its mark and whether Opposer made false representations to the USPTO in its Section 8, 9 and 15 affidavits. Applicant contends that these allegations are matters "within the personal knowledge of Opposer."⁵ As such, Applicant argues, Opposer's equivocal denials were improper.

Opposer argues that Applicant's allegations of fraud and abandonment involve the actions of various employees and executives over several years. Therefore, Opposer's denials upon information and belief are reasonably based on an investigation of the actions and intentions of several people within the short period of time required to submit its answer.⁶

Pursuant to Fed. R. Civ. P. 8(b)(2), made applicable to Board cancellation proceedings by Trademark Rule 2.114(b)(1), a respondent's denial to an averment "must fairly respond to the substance of the allegation." Any party presenting to

⁵ 8 TTABVUE at 6-8.

⁶ 9 TTABVUE at 6.

the court, or in this case the Board, a pleading “certifies that to the best of the person’s knowledge, information, and belief, formed after and inquiry reasonable under the circumstances . . . the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or lack of information.” Fed. R. Civ. P. 11(b).

“A party who lacks first-hand or personal knowledge of the validity of one or more of the allegations in the preceding pleading, but who has sufficient information to form a belief concerning the truth or falsity of those allegations may interpose a denial upon ‘information and belief.’” 5 Charles Alan Wright et al., *Federal Practice & Procedure* § 1263 (3d ed. 20115). Pleadings provided by an officer or agent of a corporate defendant, who must rely on information received from subordinates, are properly based upon information and belief. *Id.*; see *General Motors Corp. v. California Research Corp.*, 8 F.R.D. 568, 570 (D.C. Del 1948); *National Millwork Corporation v. Preferred Mutual Fire Ins. Co.*, 28 F. Supp. 952, 953 (E.D.N.Y 1939) (where the defendant is a corporation, pleading upon information and belief is a good pleading even if the officer is in position to know the facts).

In this case, Opposer is a foreign corporation whose pleadings were signed and submitted by its domestic counsel. In accordance with Fed. R. Civ. P. 11, Counsel for Opposer was obligated to obtain the information used to admit or deny the allegations in its answer from an officer or agent of Opposer after “inquiry reasonable under the circumstances.” Inasmuch as the officer or agent who

supplied the information to Counsel for Opposer has not been identified, the Board cannot determine whether the information needed to unequivocally admit or deny the allegations in the counterclaims is within his or her personal knowledge. Additionally, to investigate Opposer's knowledge at this time would be to make factual determinations that relate to the merits of the case, which are inappropriate under a Rule 12(f) motion to strike. *Guifu Li v. A Perfect Franchise, Inc.*, 2011 WL 2971046, at 4 (N.D. Cal. 2011). Accordingly, Applicant's motion to strike the denials in paragraphs 4, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 21 and 22 is **denied**.

Paragraphs 12 & 13

With respect to paragraphs 12 and 13 of Opposer's answer, Applicant requests that the Board strike the denials in the paragraphs and deem the allegations admitted because Opposer's denials conflict with declarations made in Opposer's Section 8, 9 and 15 affidavits. Inasmuch as Applicant's motion is based on the veracity of the statements and not whether the matter is redundant, immaterial, impertinent, or scandalous under Section 12(f), the motion to strike is inappropriate. In addition, the motion to strike must be decided on the pleadings alone. *See Zaloga v. Provident Life and Acc. Ins. Co. of America*, 2009 WL 4110320 at 8 (M.D. Pa. 2009). Accordingly, Applicant's motion to strike paragraphs 12 and 13 in Opposer's answer is **denied**.

Paragraphs 18, 19 & 20

Finally, Applicant requests that the Board strike paragraphs 18, 19 and 20 of Opposer's answer and deem them admitted because the denials are not credible and

conflict with statutory requirements.⁷ The Board finds that none of Opposer's responses in the identified paragraphs are redundant, immaterial, impertinent or scandalous. The credibility of Opposer's answers to the allegations in the complaint is not an issue to be determined on a motion to strike but rather at final hearing. Moreover, an admission to the allegation in paragraph 20 would be an admission that the statements in Opposer's Section 8 and 15 affidavits were false.⁸ Thus, deeming Opposer's response to this allegation as an admission would not be construing the pleadings "so as to do justice" for Opposer in accordance with Fed. R. Civ. P. 8(e). Accordingly, Applicant's motion to strike paragraphs 18, 19 and 20 from Opposer's answer is **denied**.

In summary, the motion to strike is **granted** with respect to Opposer's affirmative defenses of laches, acquiescence and estoppel. The motion to strike is **denied** with respect to paragraphs 4, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21 and 22 in Opposer's answer to the counterclaims.

Conferencing, discovery and trial dates are reset as set forth below.

Deadline for Discovery Conference	February 14, 2016
Discovery Opens	February 14, 2016
Initial Disclosures Due	March 15, 2016
Expert Disclosures Due	July 13, 2016
Discovery Closes	August 12, 2016
Plaintiff's Pretrial Disclosures	September 26, 2016
30-day testimony period for plaintiff's testimony to close	November 10, 2016

⁷ 8 TTABVUE at 10-13.

⁸ Paragraph 20 of Applicant's counterclaim states, "The USPTO would not have issued acceptance of Opposer's Section 8 and 15 filings and renewals for Registration No. 1,708,062 but for the false statements of use by Opposer." 6 TTABVUE at 8.

Defendant/Counterclaim Plaintiff's Pretrial Disclosures	November 25, 2016
30-day testimony period for defendant and plaintiff in the counterclaim to close	January 9, 2017
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	January 24, 2017
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	March 10, 2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	March 25, 2017
15-day rebuttal period for plaintiff in the counterclaim to close	April 24, 2017
Brief for plaintiff due	June 23, 2017
Brief for defendant and plaintiff in the counterclaim due	July 23, 2017
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	August 22, 2017
Reply brief, if any, for plaintiff in the counterclaim due	September 6, 2017

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 2.125.

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 2.129.