

ESTTA Tracking number: **ESTTA694193**

Filing date: **09/08/2015**

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

Proceeding	91222404
Party	Plaintiff Under Armour, Inc.
Correspondence Address	DOUGLAS A RETTEW FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP 901 NEW YORK AVENUE NW WASHINGTON, DC 20001-4413 UNITED STATES docketing@finnegan.com, doug.rettew@finnegan.com, danny.awdeh@finnegan.com, anna.naydonov@finnegan.com, TTAB-Legal-Assistants@finnegan.com
Submission	Motion to Strike
Filer's Name	Douglas A. Rettew
Filer's e-mail	docketing@finnegan.com, doug.rettew@finnegan.com, danny.awdeh@finnegan.com, anna.naydonov@finnegan.com, TTAB-Legal-Assistants@finnegan.com
Signature	/Douglas A. Rettew/
Date	09/08/2015
Attachments	9-8-15 Opp Motion to Strike App Affirmative Defenses.pdf(410640 bytes)

- In Paragraph 2, Applicant alleges that the term ARMOUR is “highly diluted as a trademark formative, and hence exceptionally weak” and, as such, Applicant’s mark is not confusingly similar to Opposer’s marks.
- In Paragraph 3, Applicant alleges that “the public interest will be harmed if Opposer’s Notice of Opposition is granted.”
- In Paragraph 4, Applicant alleges that Opposer’s alleged marks “are not famous in any relevant field of goods or services.”
- In Paragraph 5, Applicant alleges that Opposer’s alleged marks and Applicant’s mark “are dissimilar in appearance, sound, connotation, and/or overall commercial impression and will not create a likelihood of confusion or dilution when applied to the relevant goods.”
- In Paragraph 6, Applicant alleges that Opposer lacks any trademark rights covering the goods/services related to Applicant’s mark.
- In Paragraph 7, Applicant alleges that its mark “does not and will not impair or harm any of Opposer’s alleged trademark rights in any meaningful way and would not result in any dilution of Opposer’s alleged trademarks.”
- In Paragraph 8, Applicant alleges that Opposer lacks trademark rights in any mark in International Class 5 or covering goods/services related to Applicant’s mark.
- In Paragraph 9, Applicant alleges that Opposer’s claims “are barred under the doctrines of estoppel and acquiescence and/or because of Opposer’s failure to police its marks in any relevant fields.”

- Finally, in Paragraph 10, Applicant states that it “reserves all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the Lanham Act, and any other defenses at law or in equity that may now exist or in the future be available based on discovery and further factual investigation in this case.”

II. ARGUMENT

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense or redundant, immaterial, impertinent, or scandalous matter. *See also* TBMP § 506.01. The Board may grant a motion to strike or, on its own initiative, strike from a pleading any insufficient defense and any matter that clearly has no bearing on the issues in the case. *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999). An affirmative defense assumes the allegations in the complaint to be true but nevertheless constitutes a defense to those allegations. *Blackhorse v. Pro Football, Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011). Stated another way, “[a]n affirmative defense does not negate the elements of the cause of action; it is an explanation that bars the claim.” *Id.*

A. Applicant's First Affirmative Defense Should Be Stricken as Insufficient and Improper

Applicant's First Affirmative Defense, which alleges that Opposer has failed to state a claim upon which relief may be granted, is insufficient and improper under Fed. R. Civ. P. 12(f). *See also Blackhorse*, 98 USPQ at 1637 (“Failure to state a claim upon which relief can be granted is not an affirmative defense.”). To state a proper claim, Opposer need only allege such facts that would, if proven, establish that it: (1) has standing to challenge Applicant's applied-for mark, and (2) a valid ground exists for opposing the application. *Lipton Industries, Inc. v.*

Ralston Purina Co., 213 USPQ 185 (CCPA 1982); *American Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ 1313, 1314 (TTAB 1992).

Regarding standing, Opposer must show a “real interest” in the nature of a direct and personal stake in the outcome of the proceeding to establish standing. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1377 (Fed. Cir. 2012) (affirming standing where Board found that “because opposer’s registrations are of record, oppose has established its standing”); *Ritchie v. Simpson*, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). Opposer has clearly stated a “real interest” by pleading that it owns numerous valid and subsisting registrations for its UNDER ARMOUR and ARMOUR-formative marks (Opposition ¶¶ 19-21.). Opposer has also alleged prior use of the marks UNDER ARMOUR and ARMOUR-formative marks long before the filing date of the opposed application and any date of first use alleged by Applicant.

To state a claim of likelihood of confusion, Opposer must plead that (1) the opposer's mark, as applied to its goods or services, so resembles the applicant’s mark as to be likely to cause confusion, mistake, or deception; and (2) priority of use and/or registration. *See King Candy Co., Inc. v. Eunice King’s Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974).

Here, Opposer has stated a legally sufficient claim of likelihood of confusion. In particular, Opposer has pleaded prior use and registration of its UNDER ARMOUR and ARMOUR-formative marks (Opposition ¶ 26); Opposer has also alleged that “Applicant’s ARMOR GEL mark so resembles Under Armour’s prior used, filed and/or registered ARMOUR Marks, as to be likely, when applied to Applicant’s goods, to cause confusion, to cause mistake,

or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d)(c) (Opposition ¶ 27).

To state a claim of dilution, the Board “look[s] to the following elements: (1) whether the opposer’s mark is famous; (2) whether the opposer’s mark became famous prior to the date of the application to register the applicants’ mark; and (3) whether the applicants’ mark is likely to blur the distinctiveness of the opposer’s famous mark.” *Research in Motion Ltd. v. Defining Presence Mktg.*, 102 USPQ2d 1187 (TTAB 2012).

Here again, Opposer has alleged facts sufficient to satisfy each of the required elements. Opposer has alleged, among other things, that (1) its UNDER ARMOUR mark “has been well known and famous for years” (Opposition ¶ 17); (2) the mark became famous well before the filing date of the opposed intent-to-use application (Opposition ¶ 30); and (3) Applicant’s ARMOR GEL mark is “likely to dilute the distinctive quality” of Opposer’s mark (Opposition ¶ 31). Thus, contrary to Applicant’s contention, Opposer has sufficiently stated a claim of dilution.

Accordingly, Applicant’s First Affirmative Defense should be stricken as insufficient and immaterial. *See American Vitamin Products*, 22 USPQ2d at 1314 (striking affirmative defense of failure to state a claim where Opposer established standing and a statutory ground for relief).

B. Applicant’s Second, Fourth, Fifth, Sixth, Seventh, and Eighth Affirmative Defenses Should Be Stricken as Redundant

The Board may strike affirmative defenses as redundant if they do nothing more than restate a denial in the answer and do not add anything to such denials. *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). Applicant’s Fourth and Seventh Affirmative Defenses allege that Opposer’s asserted trademarks are not famous

and that Applicant's mark will not result in any dilution of Opposer's asserted marks, respectively. These affirmative defenses do nothing more than restate Applicant's previous denials of Opposer's dilution claim in the Notice of Opposition, specifically Applicant's denials of Paragraphs 17, 29, 30, and 31.

Similarly, Applicant's Fifth Affirmative Defense—the dissimilarities in appearance, sound, connotation, and/or overall commercial impression of Opposer's and Applicant's marks—merely restates Applicant's denial of Opposer's likelihood-of-confusion claim (Paragraph 27). Likewise, Applicant's Second, Sixth, and Eighth Affirmative Defenses merely repackage and amplify Applicant's denial that there is no likelihood of confusion with Opposer's mark. *See Promark Brands Inc. & H.J. Heinz Co.*, 114 USPQ2d 1232 (TTAB 2015) (The bulk of Applicant's listed defenses are *not true affirmative defenses* but . . . constitute amplifications of Applicant's denials of the allegations of likelihood of confusion and likelihood of dilution.") (emphasis added).

In view of the foregoing, Applicant's Second, Fourth, Fifth, Sixth, Seventh, and Eighth affirmative defenses should be stricken as redundant.

C. Applicant's Third Affirmative Defense Should Be Stricken as Insufficient and Immaterial to the Issues in This Case

Affirmative defenses must include sufficient detail to "give the plaintiff fair notice of the basis for the defense." TBMP § 311.02(b). Applicant's Third Affirmative Defense fails to do so. It alleges that "The public interest will be harmed if Opposer's Notice of Opposition is granted." This ambiguous claim fails to provide any specificity or fair notice as to how the "public interest" might be harmed if the opposition is sustained. As such, Applicant has failed to plead facts sufficient to meet the pleading standards under Rule 8(a)(2), and this defense should

also be stricken. *See Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (holding that a pleading must include enough detail to give the adversary fair notice of the basis for each claim or defense); *Ohio State University*, 51 USPQ2d at 1294 (explaining that the primary purpose of pleadings under the Federal Rules is to give fair notice of the claims and defenses asserted).

D. Applicant's Ninth Affirmative Defense Should Be Stricken as Insufficient

Applicant's Ninth Affirmative Defense—that Opposer's claims are barred by estoppel, acquiescence, and/or by a "failure to police"—is also insufficient and should be stricken. Applicant's claims are tied to its allegation that Opposer has acquiesced to the use of third-party marks containing the terms "Armour" and "Armor." But estoppel by acquiescence is a personal defense. The Board has consistently held that "estoppel may be invoked only by one who has been prejudiced by the conduct relied upon to create the estoppel." *See Andersen Corp. v. Therm-O-Shield Int'l*, 226 USPQ 431, 435 (TTAB 1985); *Textron, Inc. v. The Gillette Company*, 180 USPQ 152, 154 (TTAB 1973) (citing cases). As such, "a party may not therefore base its claim for relief on the asserted rights of strangers." *Textron*, 180 USPQ at 154. Here, Applicant has not asserted that it was induced to select its mark because of Opposer's conduct or that Applicant was in privity with the "numerous other third parties" who allegedly used similar marks for similar goods with Opposer's acquiescence. As such, applicant's pleading is insufficient. *See Gastown Inc. of Delaware v. Gas City Ltd.*, 187 USPQ 760, 763 (TTAB 1975). Likewise, Applicant's assertion that Opposer has failed to police its marks should also be stricken, as it essentially restates that Opposer has acquiesced to, or not asserted, its trademark rights against third parties, and Applicant has not asserted that it was in privity with those parties.

E. Applicant's Tenth Affirmative Defense Should Be Stricken as Insufficient and Immaterial

Finally, Applicant has "reserve[d] all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the Lanham Act, and any other defenses at law or in equity that may now exist or in the future be available based on discovery and further factual investigation in this case." (Answer p. 8 ¶ 10.) This reservation of rights should also be stricken as insufficient and immaterial as it does not constitute proper matter for a pleading. *See The Solomon-Page Grp. LLC & the Clinical Res. Network LLC*, Opp. No. 91195692, 2012 WL 1267963, at *5 (TTAB Mar. 12, 2012) ("A defendant cannot reserve unidentified defenses since it does not provide a plaintiff fair notice of such defenses.")

III. CONCLUSION

In the interest of efficiency, and for the reasons and authorities discussed above, Opposer respectfully requests that the Board strike all of Applicant's "Affirmative Defenses."

Respectfully submitted,

Dated: September 8, 2015

By: /Douglas A. Rettew/
Douglas A. Rettew
Danny M. Awdeh
Anna B. Naydonov
FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413
Telephone: (202) 408-4000

Attorneys for Opposer
UNDER ARMOUR, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S MOTION TO STRIKE APPLICANT'S "AFFIRMATIVE DEFENSES" was served on September 8, 2015 via first class mail, postage prepaid, on counsel for Applicant at the following address of record:

Perry S. Clegg
Clegg, P.C.
P.O. Box 1198
Salt Lake City, Utah 84110-1198


