

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

MW

Mailed: February 22, 2016

Opposition No. 91223896

Nautica Apparel, Inc.

v.

AZ PL

Michael Webster, Interlocutory Attorney:

This case now comes before the Board for consideration of Opposer's motion (filed October 22, 2015) to strike Applicant's affirmative defense asserted in Applicant's answer, filed on October 20, 2015. On October 30, 2015, Applicant filed a statement of non-opposition to Opposer's motion to strike Applicant's affirmative defenses.

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. However, motions to strike 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). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, the Board

may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims not stricken).

Applicant has alleged the following affirmative defenses:

1. Applicant affirmatively alleges that Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.
2. Applicant affirmatively alleges that Opposer's Notice of Opposition is barred by the doctrine of laches, acquiescence and estoppel.
3. Applicant affirmatively alleges that the Opposer is estopped by the arguments and positions taken during the prosecution of the applications which resulted in the trademark registrations cited in Opposer's Notice of Opposition, and cannot now claim exclusive rights in Applicant's mark as detailed in the present application.

In view of Applicant's statement of non-opposition to Opposer's motion to strike, the motion to strike Applicant's affirmative defenses is hereby **granted** as conceded. Applicant's affirmative defenses are hereby **stricken** from its answer.

However, the Board notes that a motion to strike the defense of failure to state a claim upon which relief can be granted (affirmative defense No. 1) may be used by a plaintiff to test the sufficiency of its pleading in advance of trial. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). In view thereof, and for the purpose of judicial economy, the Board has, *sua sponte*, reviewed the notice of opposition for its legal sufficiency.

In its motion to strike, Opposer states that the allegations in its notice of opposition sufficiently support claims of likelihood of confusion, dilution, false connection, and fraud (i.e., no bona fide intent to use).¹ 6 TTABVUE at 6.

Upon careful review of Opposer's notice of opposition, the Board finds that Opposer's pleading clearly contains allegations which, if proven, would establish Opposer's standing.

The Board, however, finds that Opposer has not properly pleaded its claim of false suggestion of a connection under Trademark Act Section 2(a), 15 U.S.C. § 1052(a). "Section 2(a) bars registration of a mark that falsely suggests a connection with persons living or dead, or institutions, beliefs or national symbols." *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010). In order to properly assert a ground of false suggestion of a connection, Opposer must plead that (1) Applicant's mark is the same or a close approximation of Opposer's previously used name or identify (not Opposer's pleaded mark); (2) that Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) that Opposer is not connected with the goods sold by Applicant under the mark; and (4) that Opposer's name or identity (not its mark) is of sufficient fame or reputation that when Applicant's mark is used on its goods, a connection with Opposer would be presumed. *See id.*; *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008).

¹ The Board notes that fraud and lack of bona fide intent to use a mark are separate grounds for opposition. *See* TMEP § 309.03(c); *SmithKline Beecham Corp. v. Omnisource DDS LLS*, 97 USPQ2d 1300, 1305 (TTAB 2010).

Here, Opposer has not sufficiently pleaded the requisite allegations set forth above to support its claim of false suggestion of a connection under Section 2(a). Specifically, Opposer has not alleged that Applicant's mark is the same or a close approximation of Opposer's previously used name or identity, and that Opposer's identity and/or persona (not its pleaded marks) is of sufficient fame or reputation that when Applicant's mark is used on Applicant's goods, a connection with Opposer would be presumed. Additionally, Opposer has not alleged affirmatively that it is not connected with the goods sold by Applicant under Applicant's involved mark.

Accordingly, the Board finds that Opposer's asserted claim of false suggestion of a connection under Section 2(a) is deficiently pleaded.

The Board, however, freely grants leave to amend a pleading found to be insufficient. In view thereof, Opposer is allowed until FIFTEEN (15) DAYS from the mailing date of this order in which to file and serve an amended notice of opposition which properly states a claim of false suggestion of a connection, if applicable, failing which the claim under Section 2(a) will be **dismissed** with prejudice. In turn, Applicant is allowed FIFTEEN (15) DAYS from the date of service of Opposer's amended pleading in which to file its answer or otherwise respond to Opposer's amended notice of Opposition.

Proceedings are resumed. All subsequent discovery and trial dates are reset as follows:

Deadline for Discovery Conference	4/22/2016
Discovery Opens	4/22/2016
Initial Disclosures Due	5/22/2016
Expert Disclosures Due	9/19/2016

Discovery Closes	10/19/2016
Plaintiff's Pretrial Disclosures	12/3/2016
Plaintiff's 30-day Trial Period Ends	1/17/2017
Defendant's Pretrial Disclosures	2/1/2017
Defendant's 30-day Trial Period Ends	3/18/2017
Plaintiff's Rebuttal Disclosures	4/2/2017
Plaintiff's 15-day Rebuttal Period Ends	5/2/2017

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 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.