ESTTA Tracking number: **ESTTA757421**
Filing date: **07/11/2016**

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

Proceeding	91227686
Party	Plaintiff Under Armour, Inc.
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Submission	Motion to Strike Pleading/Affirmative Defense
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Date	07/11/2016
Attachments	91227686 7.11.2016 Motion to Strike Applicant Third Aff Defense.pdf(213437 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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UNDER ARMOUR, INC., Opposer, v. ICANIWILL AB, Applicant.	Opposition No. 91227686 Mark: ICANIWILL Filing Date: April 27, 2016

UNDER ARMOUR'S MOTION TO STRIKE
APPLICANT'S THIRD AFFIRMATIVE DEFENSE

Under Armour, Inc. ("Under Armour") moves to strike ICANIWILL AB's ("Applicant") third affirmative defense alleging ownership of a foreign trademark registration on the grounds that it is irrelevant, insufficient, and immaterial under Fed. R. Civ. P. 12(f) and Section 506 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP").

I. RELEVANT FACTUAL BACKGROUND

On April 27, 2016, Under Armour filed a Notice of Opposition against Application No. 79170719 for the mark ICANIWILL for athletic clothing, underwear, and accessories in Class 25. As grounds for its opposition, Under Armour alleged a likelihood of confusion between Applicant's mark and Under Armour's famous I WILL mark under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d), and dilution of its mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

On June 13, 2016, Applicant filed an Answer to the Opposition. Applicant's Answer includes an affirmative defense based on Applicant's ownership of a European Registration ("Applicant's Third Affirmative Defense"). In particular, Applicant alleges that because its European Community Registration No. 013864616 co-exists on the European Register with

Under Armour's mark, Under Armour's Swedish counsel allegedly had knowledge of Applicant's mark prior to registration of the mark in Europe, and there has allegedly been no actual confusion abroad, Applicant's mark is entitled to registration in the United States. (Answer p. 11).

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 Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 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 U.S.P.Q.2d 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.*

In its Answer, Applicant argues that because it holds a registration in another country (and there has purportedly been no confusion abroad), this somehow serves a defense in an opposition proceeding with the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office, which deals solely with the right to register Applicant's mark in the United States. It is well established that evidence of foreign trademarks and activities are irrelevant and inadmissible in U.S. trademark proceedings. *See, e.g., Person's Co. v. Christman*, 900 F.2d 1565, 1568-69 (Fed. Cir. 1990) (holding a party's foreign trademark use irrelevant and explaining "[t]he concept of territoriality is basic to trademark law; trademark rights exist in each

country solely according to that country's statutory scheme."); *Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d. 1609, 1612-13 (TTAB 1991) ("Information concerning applicant's foreign activities, including foreign trademark applications and/or registration, is not relevant to the issues in an opposition proceeding."); *Vanity Fair Mills, Inc. v. T. Eaton Co. Ltd.*, 109 U.S.P.Q. 438, 441 (2d Cir. 1956) ("when trademark rights within the United States are being litigated in an American court, the decision of foreign courts concerning the respective trademark rights of the parties are irrelevant and inadmissible"); *E. Remy Martin & Co., S.A. v. Shaw-Ross Int'l Imports, Inc.*, 756 F.2d 1525, 1532 (10th Cir. 1985) (holding that decisions of foreign tribunals concerning the trademark rights of the parties is irrelevant).

The fact that Applicant may own a registration in another country has no bearing on its right (or lack thereof) to register and/or use the mark in the U.S. If that were the case, the availability of a U.S. trademark registration would depend on others' use throughout the *world.* The law prevents such a result because, among other things, market conditions, scope of trademark rights, and consumer perceptions vary from country to country. Applicant's claim that two marks should co-exist in the United States because they purportedly co-exist in another jurisdiction, even if true, violates the basic principle that trademark rights are territorial in nature. Consequently, Applicant's "Third Affirmative Defense" based on its ownership of a foreign registration is legally insufficient, irrelevant, and should be stricken.

III. CONCLUSION

Under Armour respectfully requests that the Board strike Applicant's Third Affirmative Defense from its Answer.

Dated: July 11, 2016

By: /Douglas A. Rettew/

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing UNDER ARMOUR'S MOTION TO STRIKE APPLICANT'S THIRD AFFIRMATIVE DEFENSE was served on July 11, 2016 via first class mail, postage prepaid, on counsel for Applicant at the following address of record:

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