

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

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Mailed: December 20, 2011

Cancellation No. 92054055

FK Republika Srpska, NFP

v.

Athletic Foundation Srpska, Inc.

**Yong Oh (Richard) Kim, Interlocutory Attorney:**

On December 8, 2011, the Board held a telephone conference to hear argument and rule on petitioner's motion (filed July 25, 2011) to strike respondent's affirmative defenses and respondent's motion (filed August 5, 2011) for leave to amend its answer. Daniel I. Hwang, Esq., appeared on behalf of petitioner and Kenneth S. McLaughlin, Jr., Esq., appeared on behalf of respondent.

Respondent's Motion for Leave to Amend

At the start of the conference, the Board informed the parties that it would first take up respondent's motion for leave to amend before considering petitioner's motion to strike. By its motion for leave to amend, respondent seeks to add a third affirmative defense, namely, laches, and to allege additional facts in further support of all three affirmative defenses. Considering that petitioner had

already argued the merits of its motion to strike as to the newly added affirmative defense as well as to the original two affirmative defenses notwithstanding the additional facts alleged, in the interest of efficiency, respondent's motion for leave to amend its answer is **GRANTED**.

Petitioner's Motion to Strike

Pursuant to 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 (3d ed. 2011). While motions to strike are not favored, matter will be stricken if 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).

Turning then to petitioner's motion to strike, respondent confirmed during the conference that it is asserting, as part of its amended answer<sup>1</sup>, three affirmative defenses: 1) acquiescence, 2) estoppel, and 3) laches. The Board then inquired as to the particular factual allegations that form the basis of these affirmative defenses to which

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<sup>1</sup> The Board notes that the amended "pleading" is limited to respondent's affirmative defenses and additional factual allegations in support thereof and therefore intended to amend the original answer only as to the affirmative defenses.

respondent pointed to petitioner's alleged actions between 2001 and 2009.

The Board noted that the defenses of acquiescence, estoppel and laches are equitable defenses and, therefore, not available against petitioner's claim of fraud.<sup>2</sup> See, e.g., *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989). The Board further noted that these defenses, in the context of an opposition or cancellation proceeding, are tied to a defendant's registration of a mark as opposed to use of that mark. See *National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Accordingly, these equitable defenses begin to run no earlier than the date the involved marks are published for opposition. See *id.*

The involved registrations<sup>3</sup> in this proceeding are both on the Supplemental Register. Marks on the Supplemental Register are not published for opposition and, therefore, are not subject to opposition under 15 U.S.C. § 1063. See TMEP § 815 (8th ed. 2011). Rather, they are issued as registered marks on the date that they are printed in the *Official Gazette*. *Id.* Since respondent's marks were both

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<sup>2</sup> Petitioner also asserts claims of priority and likelihood of confusion and a claim that the involved registrations are void *ab initio*.

<sup>3</sup> Registration Nos. 3823417 and 3823424. Both were registered on the Supplemental Register on July 20, 2010.

registered on the Supplemental Register on July 20, 2010, the earliest date that respondent can rely in support of its affirmative defenses is July 20, 2010. As respondent's affirmative defenses are based on petitioner's alleged actions and inactions from 2001 through 2009, the defenses of acquiescence, estoppel and laches are insufficient and are hereby **STRICKEN**.

As discussed during the conference, respondent is allowed until **January 9, 2012**, to replead its answer and to reassert the defenses stricken herein provided that respondent can allege such facts in support thereof.

Proceedings are **RESUMED** and dates are **RESET** as follows:

Amended Answer Due	1/9/2012
Deadline for Discovery Conference	2/8/2012
Discovery Opens	2/8/2012
Initial Disclosures Due	3/9/2012
Expert Disclosures Due	7/7/2012
Discovery Closes	8/6/2012
Plaintiff's Pretrial Disclosures Due	9/20/2012
Plaintiff's 30-day Trial Period Ends	11/4/2012
Defendant's Pretrial Disclosures Due	11/19/2012
Defendant's 30-day Trial Period Ends	1/3/2013
Plaintiff's Rebuttal Disclosures Due	1/18/2013
Plaintiff's 15-day Rebuttal Period Ends	2/17/2013

**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.

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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.

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