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

Proceeding	92054055
Party	Plaintiff FK Republika Srpska, NFP
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration Nos. 3,823,417 and 3,823,424: FK REPUBLIKA SRPSKA
Registration Date: July 20, 2010

FK REPUBLIKA SRPSKA, NFP,)	
)	
Petitioner,)	Cancellation No. 92054055
)	
v.)	
)	
ATHLETIC FOUNDATION SRPSKA,)	
INC.,)	
)	
Registrant.)	

**FK REPUBLIKA SRPSKA, NFP'S MOTION TO STRIKE
AFFIRMATIVE DEFENSES FROM APPLICANT'S ANSWER**

I. Introduction

In accordance with Rule 12(f) of the Federal Rules of Civil Procedure and § 506 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Petitioner, FK Republika Srpska, NFP ("FRS"), moves to strike both affirmative defenses asserted by Registrant, Athletic Foundation Srpska, Inc. ("AFS"), in its Answer. These affirmative defenses are legally and factually insufficient and fail to conform to pleading requirements. Their inclusion will increase discovery costs, confuse the issues properly before the Board, and cause prejudice to FRS.

Specifically, FRS moves to strike the following affirmative defenses (reproduced in their entirety) from AFS's Answer:

First Affirmative Defense - Acquiescence

Petitioner has failed to adequately protect its alleged rights in "FK Republika Srpska" for Class 25 (Reg. No. 3,823,417) and Class 41 (Reg. No. 3,823,424), and has acquiesced to the use of the phrase FK REPUBLIKA SRPSKA by Registrant, in that prior to Registrant's application, Petitioner failed to object to the application or registration of the trademark or the Registrant's prior use of FK REPUBLIKA SRPSKA.

Second Affirmative Defense - Estoppel

Petitioner has failed to adequately protect its alleged rights in "FK REPUBLIKA SRPSKA" for Class 25 and Class 41, and is estopped from claiming exclusive rights to the use of "FK REPUBLIKA SRPSKA" by Registrant, in that prior to Registrant's application, Petitioner failed to object to the application or registration of the trademark or to Registrants' prior use of "FK REPUBLIKA SRPSKA."

II. Argument

The Board may strike from a pleading "any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." Fed. R. Civ. P. 12(f); TBMP § 506; *The Ohio State University v. Ohio University*, 51 U.S.P.Q.2d 1289, 1292 (T.T.A.B. 1999). Here, the allegations supporting both of AFS's defenses do not provide enough detail to give FRS fair notice of the basis for each defense. TBMP § 311.02(b); *Ohio University*, 51 U.S.P.Q.2d at 1292; *see also Bell Atlantic Corp. v. Twombly*, 127 S.Ct. 1955, 1965 n.3 (2007) ("Without some factual allegation... it is hard to see how a claimant could satisfy the requirement of providing not only 'fair notice' of the nature of the claim, but also 'grounds' on which the claim rests."); *see also Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1950 (2009) (*Twombly* "was based on our interpretation and application of Rule 8," which, "in turn governs the pleading standard in all civil actions and proceedings") (citations and internal quotation marks omitted). FRS will be prejudiced by these insufficient defenses because they will expand discovery and waste the parties' and the Board's resources.

(1) AFS Fails to State a Factual Basis for its Acquiescence Defense

AFS has not pled any facts suggesting that FRS expressly or by clear implication consented, assisted, or encouraged AFS's use and registration of FRS's trademark. *Hitachi Metals International v. Yamakyu Chain Kabushiki*, 209 USPQ 1057, 1067 (T.T.A.B. 1981).

Specifically, AFS must plead that: (1) FRS actively represented that it would not assert its rights in the FK REPUBLIKA SRPSKA mark; (2) the delay between FRS's active representation and its assertion of rights was not excusable; and (3) the delay caused AFS undue prejudice. *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1564, 19 U.S.P.Q.2d 1401, 1409 (11th Cir. 1991). AFS does not allege any such facts.

AFS states that FRS did not object to AFS's trademark applications. This fact alone would not be legally sufficient to plead a defense of acquiescence, even if it were relevant in the context of a petition to cancel a supplemental registration. 37 C.F.R. § 2.111(b). AFS's registrations are on the Supplemental Register, and thus could not have been opposed. 15 U.S.C. § 1092. FRS has, therefore, timely objected to AFS's registration.

(2) AFS Fails to State a Factual Basis for its Estoppel Defense

Estoppel requires "some affirmative act by plaintiff which led defendant to reasonably believe that plaintiff would not oppose defendant's registration of its mark." *DAK Indus., Inc. v. Daiichi Kosho Co., Ltd.*, 25 U.S.P.Q.2d 1622, 1625 (T.T.A.B. 1993); *see also National Cable Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1582 (Fed. Cir. 1991) (rejected defense of estoppel as a matter of law where there is insufficient evidence about the affirmative acts upon which the registrant relied to its detriment). Further, estoppel requires the defendant to show that it has suffered prejudice as a result of its reliance on the plaintiff's acts. *Burroughs Wellcome Co. v. Warner-Lambert Co.*, 203 USPQ 191 (T.T.A.B. 1979). AFS does not allege any affirmative acts by FRS, nor what prejudice AFS suffered.

III. Conclusion

AFS has pled almost no facts upon to support its alleged defenses of acquiescence and estoppel. FRS, therefore, does not have fair notice of the basis for each defense. Unless the

defenses are stricken, FRS will be prejudiced because AFS will be permitted to take discovery and introduce evidence that is irrelevant to the issues in this proceeding. This would confuse the issues properly before the Board, call for the adjudication of facts and conclusions of law not relevant to this proceeding, and waste the parties' and the Board's resources.

For the reasons stated above, FRS's affirmative defenses of acquiescence and estoppel are legally insufficient and fail to conform to pleading requirements. Accordingly, FRS requests that the Board grant its Motion to Strike them.

Respectfully submitted,

Dated: July 25, 2011

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **PETITIONER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES FROM REGISTRANT'S ANSWER** was served by first-class mail on July 25, 2011, postage prepaid, upon the following:

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