

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

Mailed: March 13, 2014

Cancellation No. **92054617**

Nouvelle Parfumerie Gandour

v.

Y.Z.Y., Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

This matter comes up on petitioner's motion (filed October 21, 2013) to strike the affirmative defenses in respondent's amended answer (filed October 3, 2013). The motion is contested.

A motion to strike is timely if made before responding to the pleading that is the subject of the motion or, if a response is not allowed, within twenty-one days after being served with the pleading plus five additional days if the pleading is served by first-class mail, "Express Mail," or overnight courier. See Fed. R. Civ. P. 12(f) and Trademark Rule 2.119(c). As petitioner's motion to strike was served and filed within twenty-one days of respondent's answer, the motion is timely.

Petitioner seeks to cancel Registration No. 3504398 on grounds of fraud and priority and likelihood of confusion.

As part of its amended answer to the petition, respondent has asserted the affirmative defenses of laches, acquiescence and abandonment. Petitioner moves to strike the laches and acquiescence defenses as "inappropriate given the marks and goods at issue" and the abandonment defense as "insufficient." Upon consideration and review of the pleadings and the parties' respective arguments, petitioner's motion is granted in part and denied in part.

Turning first to the laches and acquiescence defenses, they are unavailable as against a claim of fraud and a claim of likelihood of confusion where confusion is inevitable, and confusion is inevitable here as the parties' marks and goods are identical. See *Hornby v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008) ("laches will not lie against the ground of fraud"); *Allstate Insurance Co. v. DeLibro*, 6 USPQ2d 1220, 1224 (TTAB 1988) ("a laches defense is considered only in cases where there is a reasonable doubt as to likelihood of confusion. Where no such reasonable doubt exists, laches, even if it were proved, would be an insufficient reason to allow a mark to be registered which would be likely to confuse the public."); *Reflange, Inc. v. R-Con Intl.*, 17 USPQ2d 1125, 1131 (TTAB 1990) ("Even a well-taken defense of acquiescence would not preclude a judgment for plaintiff if it is determined that confusion is inevitable, and confusion between identical marks used for

identical goods is inevitable."); *Treadwell's Drifters, Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1991) ("equitable defenses are not available against ... fraud because it is in the public interest ... to prohibit registrations procured or maintained by fraud."). Accordingly, petitioner's motion to strike is hereby **GRANTED** as to the defenses of laches and acquiescence.

On the other hand, petitioner's motion to strike respondent's defense of abandonment is hereby **DENIED** as respondent has provided fuller notice of the basis of its abandonment claim, i.e., "unlawful use of the BIO CLAIRE mark in commerce of the United States," *Amended Answer, Affirmative Defenses* ¶ 4, and the Board sees no prejudice to petitioner in allowing the pleading of such defense to stand. Petitioner is reminded that 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 *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999).

The parties are hereby ordered to proceed to the discovery conference pursuant to the following schedule, as reset:

Deadline for Discovery Conference	4/18/2014
Discovery Opens	4/18/2014
Initial Disclosures Due	5/18/2014
Expert Disclosures Due	9/15/2014

Discovery Closes	10/15/2014
Plaintiff's Pretrial Disclosures Due	11/29/2014
Plaintiff's 30-day Trial Period Ends	1/13/2015
Defendant's Pretrial Disclosures Due	1/28/2015
Defendant's 30-day Trial Period Ends	3/14/2015
Plaintiff's Rebuttal Disclosures Due	3/29/2015
Plaintiff's 15-day Rebuttal Period Ends	4/28/2015

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 Rule 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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