

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

wbc

Mailed: February 19, 2014

Cancellation No. 92057845

Multisorb Technologies, Inc.

v.

Clariant International AG

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of petitioner's motion (filed December 15, 2013) to strike registrant's first through eighth affirmative defenses in the October 22, 2013 answer. The motion has been fully briefed.

Registrant's first through eighth affirmative defenses at issue, read as follows:

1. Petitioner has failed to state a claim upon which relief may be granted.
2. Petitioner lacks standing to assert the claims contained in the Notice of Cancellation.
3. Petitioner's claims are barred by the doctrine of waiver.
4. Petitioner's claims are barred by the doctrine of laches.
5. Petitioner's claims are barred by the doctrine of estoppel.
6. Petitioner's claims are barred by the doctrine of acquiescence.
7. Petitioner's claims are barred by the doctrine of unclean hands in that Petitioner has engaged in

inequitable conduct directly relating to the subject matter of this proceeding.

8. Petitioner's claims are barred because Registrant's mark is inherently distinctive.

In support of its motion, petitioner contends that registrant's affirmative defenses as pleaded "are entirely insufficient, immaterial and irrelevant."

The Board may, upon motion or by its own initiative, order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See, e.g., *FRA S.p.A. v. Surg-O-Flex of America, Inc.*, 194 USPQ 42, 46 (SDNY 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977). 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 Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995). Further, a defense will not be stricken as

insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. See generally, 5C Wright & Miller, *Federal Practice & Procedure Civil 3d* § 1381 (Westlaw update 2013).

As noted by petitioner, motions to strike matter from a pleading should be filed within the time for, and before, the moving party's responsive pleading. Fed. R. Civ. P. 12(f); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); TBMP § 506.02 (3d ed. rev.2 2013). If no responsive pleading is required, the motion should be filed within 21 days after service upon the moving party of the pleading that is the subject of the motion. Inasmuch as petitioner filed its motion to strike nearly two months after service of respondent's answer, the motion is **untimely and will receive no further consideration.**

Notwithstanding the foregoing, the Board has *sua sponte* reviewed the pleadings herein. See Fed. R. Civ. P. 12(f).

Respondent's first affirmative defense is failure to state a claim. A complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009) (quoting *Bell*

Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007)). In particular, the claimant must allege well-pleaded factual matter and more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 555).

Upon careful review of the petition to cancel, the Board finds that petitioner has set forth sufficient allegations to establish, if proven, that petitioner has standing to bring this proceeding and to support at least one ground upon which relief may be granted. Namely, petitioner has pleaded standing by alleging it is engaged in the sale of goods similar to those of respondent of which the mark at issue is equally descriptive. See *Consolidated Foods Corp. v. Big Red, Inc.*, 226 USPQ 829, 831 (TTAB 1985) (citing *Mars Money Systems v. Coin Acceptors, Inc.*, 217 USPQ 285, 287 (TTAB 1983)); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987).

“A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *In re Chamber of Commerce of the United States of America*, 102

USPQ2d 1217, 1219 (Fed. Cir. 2012) (*quoting In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 82 USPQ2d 1828 (Fed. Cir. 2007)). Inasmuch as petitioner alleges in its petition to cancel that respondent's mark is merely descriptive because it "describes the qualities, features, functions, purpose and use" of respondent's goods and includes therewith additional allegations in support of this claim, petitioner has adequately pleaded a claim of descriptiveness under Section 2(e)(1).

In view thereof, the Board *sua sponte* **strikes the first affirmative defense**. See TBMP § 506.01.

In respondent's second affirmative defense, respondent argues that the petitioner lacks standing. "Lack of standing is not an affirmative defense. Standing is an element of [opposer's] claim." *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011). Accordingly, the Board *sua sponte* **strikes respondent's second affirmative defense**. See TBMP § 506.01.

Respondent's third, fourth,¹ fifth and sixth affirmative defenses are insufficiently pleaded. The allegations of the

¹ Respondent's fourth affirmative defense is that of laches.¹ The elements of laches are (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to the latter attributable to the delay. *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1572 (TTAB 2007); *Bridgestone/Firestone Research Inc. v. Automobile Club d l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462-1463 (Fed. Cir.

affirmative defense are merely conclusory in nature without providing facts which constitute a basis therefor, and which provide fair notice thereof. *See Midwest Plastic Fabricators*, 5 USPQ2d 1067; *Heisch*, 45 USPQ2d 1219; TBMP § 311.02(b). Accordingly, respondent's **third, fourth, fifth and sixth affirmative defenses are hereby sua sponte stricken.** *See* TBMP § 506.01.

Respondent's seventh affirmative defense is that of unclean hands. "It is a rule of equity that a plaintiff must come with 'clean hands', i.e., he must be free from reproach in his conduct. But there is this limitation to the rule: that his conduct can only be excepted to in respect to the subject matter of his claim; everything else is immaterial." *VIP Foods, Inc. v. V.I.P. Food Products*, 200 USPQ 105, (TTAB 1978) (quoting *Black's Law Dictionary*, Third Edition (1933)). Thus, the concept of unclean hands must be related to a plaintiff's claim, and misconduct unrelated to the claim in which it is asserted as a defense does not constitute unclean hands. *Tony Lama Company, Inc. v. Anthony Di Stefano*, 206

2001). Respondent has neither alleged unreasonable delay nor material prejudice. Rather, respondent has merely asserted the defense in a conclusory fashion without providing facts which constitute a basis therefor, and which provide fair notice thereof. *See Midwest Plastic Fabricators*, 5 USPQ2d 1067; *Heisch v. Katy Bishop Prod.*, 45 USPQ2d 1219 (N.D. Ill. 1997); TBMP § 311.02(b).

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USPQ 176, 179 (TTAB 1980); see *Phonak Holding AG v. Resound GMBH*, 56 USPQ2d 1057, 1059 (TTAB 2000).

Although respondent alleges misconduct by petitioner, it has not alleged how that misconduct, if proven, prevents petitioner from prevailing on its pleaded claim of descriptiveness. See *Green Spot (Thailand) Ltd. v. Vitasoy Internat'l Holdings Ltd.*, 86 USPQ2d 1283, 1285 n.4 (TTAB 2008); *Midwest Plastic Fabricators Inc.*, 5 USPQ2d at 1069 (TTAB 1987). Accordingly, the Board *sua sponte* **strikes the seventh affirmative defense**. See TBMP § 506.01.

Respondent's eighth affirmative defense argues that respondent's mark is "inherently distinctive" and therefore, petitioner's claims are barred. The defendant in a Board proceeding should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied. See Trademark Rule 2.106(b)(1); TBMP § 311.02. Notwithstanding the foregoing, inasmuch as applicant's allegations give opposer a more complete notice of its position, the Board treats applicant's allegations and this eighth "affirmative defense" as amplifications of its denials. See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223

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(TTAB 1995); *Harsco Corp. v. Electrical Sciences, Inc.*, 9 USPQ2d 1570 (TTAB 1988).

In sum, respondent's first, second, third, fourth, fifth, sixth and seventh affirmative defenses are hereby **stricken**. If respondent wishes to later amend its pleading to raise any affirmative defenses or otherwise, it will need to do so pursuant to Fed. R. Civ. P. 15. See Trademark Rule 2.107; TBMP § 507.²

Dates remain as previously set.

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.

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.

² "The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02 and cases cited therein.