

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Mailed: November 4, 2015

Cancellation No. 92062064

Mark M. Youssef

v.

Younique

**M. Catherine Faint,  
Interlocutory Attorney:**

On October 28, 2015 the Board held a telephone conference involving Morland C. Fischer, Atty. counsel for Petitioner Mark M. Youssef,<sup>1</sup> and Adam D. Siegartel, Atty., counsel for Respondent Younique.<sup>2</sup> Counsel were seeking to extend the date for the discovery conference in light of the filing of Respondent's Answer and Counterclaim, and Petitioner's Answer to the Counterclaim. The Board reviewed those documents and determined the following.<sup>3</sup>

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<sup>1</sup> Petitioner's counsel's change of correspondence address, filed October 20, 2015, is noted and entered.

<sup>2</sup> The Board notes that its institution order, addressed to Respondent, was returned as undeliverable on September 3, 2015. On September 29, 2015, Respondent's counsel filed and served an answer to the petition to cancel. If Respondent's address has changed, counsel should file a change of address for Respondent to be entered into the record.

<sup>3</sup> Respondent's attorney objects to the Board proceeding to review the answer and counterclaim absent a motion to dismiss filed by Petitioner. Petitioner in its answer to the counterclaim noted, "Registrant's allegations listed in [its counterclaim] are actually

By way of background, Petitioner seeks to cancel Respondent Younique's registration for the drawing mark



for make-up in Class 3.<sup>4</sup> As ground for the cancellation Petitioner alleges priority and likelihood of confusion with his registered mark YOUNIQUE in standard character form for, “cosmetic surgery” in Class 44.<sup>5</sup> Petitioner also claims ownership of pending application Serial No. 86446733 for the mark YOUNIQUE in standard character form for a variety of non-medicated cosmetics in Class 3 and medicated cosmetics in Class 5.<sup>6</sup>

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affirmative defenses.” The Board has necessarily reviewed the subject documents to determine whether a resetting of the date for the discovery conference was appropriate, and has otherwise exercised its discretion to manage the case on its docket. In view thereof, Respondent’s objection is overruled.

<sup>4</sup> Registration No. 4504512, registered April 1, 2014 claiming a date of first use anywhere of July 1, 2012 and first use in commerce of November 1, 2012. A disclaimer of “PRODUCTS” is of record. Color is not claimed a feature of the mark.

<sup>5</sup> Registration No. 3543530, registered December 9, 2008, alleging dates of first use and first use in commerce of April 2007.

<sup>6</sup> Filed November 6, 2014 based on Trademark Act § 1(a) claiming dates of first use and first use in commerce of September 1, 2006. The goods are listed as, “non-medicated cosmetics, namely, facial cleansers, skin moisturizing creams, lotions and toners, facial masks and scrubs, anti-bruising gels and creams, makeup, makeup remover, skin foundation, eye cream and eyelash conditioner” in Class 3; and “cosmetics containing a medication, namely, facial cleansers, skin moisturizing creams and lotions, acne creams and pre-saturated pads containing acne medication, liquid eyelash conditioners and growth

***Counterclaim and Answer to Counterclaim are Stricken***

In its answer to the petition to cancel, Respondent filed a “counterclaim” for “withdrawal and cancellation” of Petitioner’s pending application Serial No. 86446733 for the mark YOUNIQUE. A review of the application file shows that the application is suspended pending the outcome of the current proceeding, and has not yet published for opposition. An unpublished application may not be “cancelled” nor may an opposition be filed prior to publication of the mark for opposition. *See* Trademark Act § 13, 15 U.S.C. § 1063. *See also Texas Dept. of Transp. v. Tucker*, 95 USPQ2d 1241, 1242 n.5 (TTAB 2010) (noting “no such procedure exists” for filing counterclaim in opposition to pending application suspended pending outcome of Board proceeding). While Respondent authorized charges to its deposit account, as the counterclaim may not be instituted, no fee has been charged.

In view thereof, Respondent’s counterclaim is **stricken**.

The Board notes that Petitioner filed an “answer” to the counterclaim. The answer to the counterclaim is hereby **stricken**.

***Review of the Answer and Affirmative Defenses***

The Board exercises its discretion to control the cases on its docket to review the answer and finds the following. *See Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067, 1071 (TTAB 2000) (“Board possesses the inherent authority to control the disposition of cases on its docket”); *see also*, TBMP § 502.06(a).

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enhancers, skin lightening creams, post-laser burn creams, sun block and sun screen liquids, eye creams, facial masks, shaving cream and skin bleaching creams” in Class 5.

Pursuant to Fed. R. Civ. P. 12(f)(1), the Board may order stricken from a pleading any insufficient or impermissible pleading or defense. *See Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); Trademark Rule 2.116(a); and TBMP § 506. 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) (amplification of applicant's denial of opposer's claims not stricken). 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, *Fed. Prac. & Pro. Civ. 3d* § 1381 (Westlaw update 2015).

Respondent's answer contains a "preliminary statement" that is more in the nature of an argumentative statement. However, the Board construes the statement as an amplification of Respondent's denials and does not strike the statement.

Respondent alleges ten affirmative defenses and a "reservation of rights."

By its First Affirmative Defense, Respondent alleges Petitioner has failed to state a claim upon which relief may be granted. An assertion that a pleading fails to state a claim upon which relief can be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading rather than a

statement of a defense to a properly pleaded claim. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001). Nonetheless, the Board has reviewed the petition to cancel and finds that Petitioner has adequately pleaded facts, which, if proven at trial, would establish its standing. Specifically, Petitioner has alleged ownership of a registration, and a pending application that has been refused registration based on Respondent's registration. Pleading of a belief in damage is adequate for pleading standing. Also Petitioner has adequately alleged grounds for relief by its claims of priority and likelihood of confusion.

In view thereof, Respondent's First Affirmative Defense is **stricken**.

By its Fourth Affirmative Defense, Respondent alleges abandonment of Petitioner's "trademark rights;" and by its Fifth Affirmative Defense, Respondent alleges unclean hands and "fraudulent conduct." A defendant may not assert affirmative defenses that are essentially meant as a form of collateral attack on Petitioner's registered mark. *See Trademark Rule 2.106(b)(2)(ii)*. *See also TBMP* § 311.02(b).

Accordingly, Respondent's Fourth and Fifth Affirmative Defenses are hereby **stricken**.

By its Sixth Affirmative Defense, Respondent asserts bare allegations of laches, waiver and estoppel. By its Eighth Affirmative Defense, Respondent asserts bare allegations of consent, acquiescence and/or legal justification. By its Ninth Affirmative Defense Respondent asserts bare allegations of filing for an improper

purpose and lack of a reasonable good faith basis in fact. By its Tenth Affirmative Defense, Respondent asserts bare allegations of bar by Petitioner's express or implied agreements, knowledge, promises or permission.

Affirmative defenses, like claims in a petition to cancel, must be supported by enough factual background and detail to fairly place the Petitioner on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). Here, Respondent's Affirmative Defenses are bald, conclusory allegations that are not supported by any facts. In view of the foregoing, Respondent's Sixth, Eighth, Ninth and Tenth Affirmative Defenses are **stricken**.

Respondent's unnumbered "Affirmative Defense" "reserves the right" that Respondent may in the future rely upon any other affirmative defenses or counterclaims that may arise. Respondent should note that a defendant cannot reserve some unidentified defenses or claims, because such a "reservation" does not provide plaintiff with fair notice of any such defenses. Whether or not Respondent may, at some future point, add an affirmative defense or claims would be resolved by way of a motion to amend for Board approval. *See Fed. R. Civ. P. 15(a)*. In view thereof, Respondent's "reservation of rights" is **stricken**.

Respondent may, however, raise any reasonable argument in its defense.

***Respondent Allowed Time to Amend its Answer***

The Board freely grants leave to amend pleadings found to be insufficient, particularly where the pleading is the initial pleading.

In view thereof, Respondent is allowed until **THIRTY DAYS** from the mailing date of this order to file an amended pleading. If no amended pleading is filed, this proceeding will go forward with the pleading as construed herein.

***Summary***

Respondent's counterclaim is **stricken**.

Petitioner's answer to the counterclaim is hereby **stricken**.

Respondent's First Affirmative Defense is **stricken**.

Respondent's Fourth and Fifth Affirmative Defenses are hereby **stricken**.

Respondent's Sixth, Eighth, Ninth and Tenth Affirmative Defenses are **stricken**.

Respondent's "reservation of rights" is **stricken**.

Respondent is allowed until **THIRTY DAYS** from the date of this teleconference to file an amended pleading. If no amended pleading is filed, this proceeding will go forward with the pleading as construed herein.

***Schedule***

As the counterclaim and answer have created confusion regarding the schedule, and Respondent is allowed time to amend its answer, the Board resets dates as set out below.

Time to Answer

11/27/2015

Deadline for Discovery Conference	12/27/2015
Discovery Opens	12/27/2015
Initial Disclosures Due	1/26/2016
Expert Disclosures Due	5/25/2016
Discovery Closes	6/24/2016
Plaintiff's Pretrial Disclosures Due	8/8/2016
Plaintiff's 30-day Trial Period Ends	9/22/2016
Defendant's Pretrial Disclosures Due	10/7/2016
Defendant's 30-day Trial Period Ends	11/21/2016
Plaintiff's Rebuttal Disclosures Due	12/6/2016
Plaintiff's 15-day Rebuttal Period Ends	1/5/2017

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.

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