TTAB

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

CENTRAL MFG. CO.
(a Delaware Corporation)
P.O.Box 35189
Chicago, IL 60707-0189

Opposer,

vs.

DBNA TRADEMARKS HOLDINGS, INC.
(a Delaware Corporation)
300 Delaware Avenue, Suite 1704
Wilmington, Delaware 19801

Applicant.

TTAB/NO FEE

Opposition No:	124,923
Trademark:	**STEALTH**
Application SN:	75-691,003
Int. Class No:	07
Filed:	April 26, 1999

MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

NOW COMES the Opposer and moves the Board to strike Applicant's Affirmative Defenses.

1. Opposer's Amended Notice of Opposition fails to state a claim upon which relief can be granted.

2. Opposer lacks standing to bring this opposition proceeding.

3. Opposer lacks priority of use over Applicant with respect to the use of the mark of the application.

4. Opposer has failed to show that it has established trademark rights in its alleged mark.

Fed. R. Civ. P. 12(f) provides for the striking from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. However, motions to strike are not favored, and the matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., Inc.*, 177 USPQ 401 (TTAB 1973); *Harsco Corp. v. Electrical Sciences, Inc.*, 9 USPQ2d 1570 (TTAB 1988).

The striking of the defense that a complaint fails to state a claim upon which relief could be granted fails to state a claim upon which relief could be granted may be appropriate when the legal insufficiency of this defense if readily apparent. See Wright & Miller, Federal Practice and Procedure: Civil 2d Section 1381 (1990> As stated by the Board in *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973):

> [w]hile Rule 12(b)(6) permits a defendant to assert in his answer the "defense" of failure to state a claim upon which relief can be granted, it necessarily follows that the plaintiff may utilize this assertion to test the sufficiency of the plaintiff's pleading in advance of trial by moving under Rule 12(f) ..... to strike the "defense" from the defendant's answer.

In the present case, the Board finds that opposer has set forth sufficient allegations to support a pleading of descriptiveness, non-use, fraud and non-ownership. See Board Order dated April 24, 2001, Opposition No. 110,672, *S Industries, Inc. v. JL Audio, Inc.* (TTAB 2001).

The Opposer asserts that its pleading in this case sets forth sufficient allegations to state the claims upon which relief should be granted. Therefore, the Board is requested to strike Applicant's paragraph one of its Affirmative Defenses.

Secondly, the Board must strike Applicant's paragraph two of its Affirmative Defenses which states that "Opposer lacks standing to bring this opposition proceeding". The Opposer has pled a real interest sufficient to establish, if proven, that Opposer has standing to bring this opposition.

The Board must also strike Applicant's paragraph three which states "Opposer lacks priority of use over Applicant with respect to the use of the mark of the application", for failure to state a claim upon which relief can be granted in this proceeding. The striking of this defense, that a complaint fails to state a claim upon which can be granted, may be appropriate when the legal insufficiency of this defense is readily apparent.

The Board must strike Applicant's paragraph four which states "Opposer has failed to show that it has established trademark rights in the alleged mark", for failure to state a claim upon which relief can be granted in this proceeding. The striking of this defense, that a com-

plaint fails to state a claim upon which can be granted, may be appropriate when the legal insufficiency of this defense is readily apparent.

WHEREFORE, the Opposer prays that the Board dismiss Applicant's affirmative defenses with prejudice for failure to state a claim upon which relief can be granted.

Respectfully submitted,

CENTRAL MFG. CO, Opposer
Leo Stoller, President
Trademark & Licensing Dept.
P.O. Box 35189
Chicago, Illinois 60707-0189
773 283-3880 FAX 708 453-0083

Dated: October 3, 2002

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Date: October 3, 2002

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Leo Stoller
October 3, 2002
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

KSK

Opposition No. 110,672

S Industries, Inc. and
Central Mfg, Co. joined
as a party plaintiff

v.

JL Audio, Inc.

Before Hairston, Chapman and Wendel, Administrative Trademark Judges.

By the Board.

This case now comes up on: (1) opposer's motion (filed August 21, 2000) to strike certain affirmative defenses; (2) opposer's motion (filed August 21, 2000) to suspend proceedings pending determination of opposer's petition filed with the Commissioner's Office; (3) opposer's motion (filed August 28, 2000) to compel discovery responses; (4) opposer's motion (filed September 5, 2000) for withdrawal of its motion to suspend; (5) opposer's motion (filed September 22, 2000) for judgment; (6) opposer's motion (filed October 10, 2000) to supplement its motion to compel; (7) opposer's motion (filed October 10, 2000) to test the sufficiency of applicant's responses to opposer's requests for admissions; (8) applicant's motion (filed October 10, 2000) to strike

opposer's reply brief in support of opposer's motion to compel; (9) opposer's motion (filed November 13, 2000) to compel; (10) opposer's motion (filed November 13, 2000) to suspend proceedings pending disposition of opposer's November 13, 2000 motion to compel; (11) opposer's motion (filed November 13, 2000) to quash a deposition; (12) applicant's motion (filed November 27, 2000) for leave to take a deposition outside of the discovery period; and (13) applicant's motion (filed December 11, 2000) to strike opposer's reply brief in support of its motion to quash.

By way of background, on July 17, 2000, the Board disposed of numerous motions pending in this case and entered judgment against opposer as to its claim of likelihood of confusion under Section 2(d). The Board also allowed applicant until August 16, 2000 to file an answer to the amended notice of opposition and reset the discovery and trial periods with discovery set to close on November 30, 2000.[1] Opposer, on August 21, 2000, filed a petition to the Commissioner requesting reversal of the Board's July 17, 2000 order.[2] On March 28, 2001, the Commissioner issued a

[1] The Board notes receipt of applicant's answer (filed August 21, 2000) to the amended notice of opposition.

[2] Opposer's motion (filed September 5, 2000) to withdraw its motion to suspend is granted and opposer's motion (filed August 21, 2000) to suspend proceedings pending determination of the petition will not be considered.

decision denying opposer's petition. In the interim the above-listed motions were filed in this case.

Opposer's Motion to Strike Affirmative Defenses

Opposer's motion to strike "paragraphs 1, 3, 4, 5 and the entire pray [sic] contained in the pray [sic] for relief" is granted in part and denied in part.

Paragraphs 1, 3, 4, 5 and the prayer for relief read as follows:

> 1. Applicant denies each and every statement in Opposer's Amended Notice of Opposition not hereinbefore specifically admitted.
>
> 3. The Notice of Opposition fails to state a claim upon which relief can be granted.
>
> 4. The Notice of Opposition fails to allege that a statutory ground exists for denying a registration to Applicant.
>
> 5. Applicant also incorporates by reference this Board's July 17, 2000 decision in this case, as it applies to numerous baseless allegations made by Opposer in the Amended Notice of Opposition.
>
> Wherefore, Applicant prays that this Opposition be dismissed in its entirety, with prejudice, in favor of Applicant and that Applicant be granted registration of its mark. Applicant also respectfully requests that the alleged registrations of Opposer be cancelled by the Board in view of Opposer's bad faith in this Opposition as well as in numerous opposition and cancellation proceedings Opposer has initiated in bad faith, with knowledge that it (Opposer) fails to possess any legitimate or lawful trademark rights. Applicant also respectfully requests any and all other relief the Board deems just.

Fed. R. Civ. P. 12(f) provides for the striking from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. However

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 Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., Inc.*, 177 USPQ 401 (TTAB 1973); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

With regard to paragraphs 1 and 5 of the affirmative defenses, we find that they merely serve to amplify the denials in the answer and apprise opposer with greater particularity of the position which applicant is taking in the defense of its application against opposer's claims. Accordingly, opposer's motion to strike paragraphs 1 and 5 is denied.

With regard to paragraph 3, we find that opposer's amended pleading sets forth a legally sufficient claim and applicant's defense of failure to state a claim upon which relief may be granted must fail as a legally insufficient defense.

The striking of the defense that a complaint fails to state a claim upon which relief could be granted may be appropriate when the legal insufficiency of this defense is readily apparent. See Wright & Miller, Federal Practice and Procedure: Civil 2d Section 1381 (1990). As stated by the Board in *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973):

> [w]hile Rule 12(b)(6) permits a defendant to assert in his answer the "defense" of failure to

> state a claim upon which relief can be granted, it necessarily follows that the plaintiff may utilize this assertion to test the sufficiency of the plaintiff's pleading in advance of trial by moving under Rule 12(f) . . . to strike the "defense" from the defendant's answer.

In the present case, the Board finds that opposer has set forth sufficient allegations to support a pleading of descriptiveness, non-use, fraud and non-ownership.[3] Accordingly, opposer's motion to strike paragraph 3 is granted.

Paragraph 4 asserts that plaintiff has not alleged a statutory ground. It is not required that the applicable section of the statute be recited and as stated above opposer has set forth allegations sufficient to state a claim upon which relief may be granted under the Trademark Act. *Steiger Tractor, Inc. v. Steiner Corporation*, 221 USPQ 165 (TTAB 1984). Accordingly, opposer's motion to strike paragraph 4 is granted.

Finally, with regard to the prayer for relief, applicant's "request" that the Board cancel opposer's "alleged registrations" is a collateral attack on opposer's pleaded registrations. Such an attack may only be asserted by way of a counterclaim to cancel the registration(s) in question. *Continental Gummi-Werke AG v. Continental Seal Corporation*, 222 USPQ 822, 825 (TTAB 1984). Accordingly,

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[3] The Board, in its July 17, 2000 order, already found that opposer has pleaded a real interest sufficient to establish, if proven, that opposer has standing to bring this proceeding.

opposer's motion to strike is granted as to that portion of the "prayer for relief."

The Parties' Discovery Motions[4]

A brief timeline history of the case is necessary to understand the discovery issues now before the Board. Applicant, on December 24, 1998, filed a summary judgment motion. Opposer, on December 29, 1998 served its first requests for admissions. On July 17, 2000, the Board granted applicant's motion to suspend proceedings pending disposition of the summary judgment motion and stated that the "proceedings are considered to have been suspended since the filing of applicant's summary judgment motion on December 24, 1998." Thereafter, on August 18, 2000, opposer served on applicant discovery requests which included interrogatories, requests for production of documents and requests for admissions. On August 21, 2000, opposer filed a petition regarding the July 17, 2000 Board order with the Commissioner's Office and filed a motion to suspend the Board proceeding. On August 28, 2000, opposer filed a motion to "compel" the requests for admissions served on December 29, 1998. On September 5, 2000, opposer filed a motion to withdraw its August 21, 2000 motion for

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[4] We note, as a preliminary matter, that, with regard to opposer's motion to compel, opposer has not satisfied the good faith effort requirement under Trademark Rule 2.120(e). Opposer's unsubstantiated and disputed telephone calls are insufficient to satisfy that requirement and opposer's motions to compel are denied on that basis alone. However, the Board believes it necessary to address the other procedural issues raised by these motions.

suspension. On September 22, 2000, applicant served discovery responses on opposer indicating that it would fully respond "once the Board rules on [opposer's] filings." Thereafter, several other papers relevant to discovery were filed, including a motion for judgment "based upon the Applicant's unanswered admissions which under FRCP 36 now stand as admitted."

Opposer's motion (filed on August 28, 2000) to compel (which is, in fact, a motion to deem admitted the requests for admissions) is denied.[5] This proceeding was in suspension at the time those requests were served, therefore, applicant was under no obligation to respond to them.

We now turn to opposer's motions (filed on October 10, 2000 and November 13, 2000) to compel discovery responses to the discovery requests served on August 18, 2000 and opposer's motion (filed October 10, 2000) to test the sufficiency of applicant's responses to the requests for admissions served on August 18, 2000.

Opposer, by its own multiple filings (including opposer's motion to suspend and subsequent withdrawal of that motion), created an ambiguous situation in which applicant could not discern the posture of the case. Applicant's ability to respond to the discovery requests was further hampered by opposer's filing of the petition, which,

[5] Applicant's motion (filed October 10, 2000) to strike opposer's September 22, 2000 reply brief is denied.

if granted, could have changed the scope of this opposition. Accordingly, opposer's multiple motions to compel and to test the sufficiency of the admission responses are denied.[6]

In view of the ambiguousness created by opposer's filing of the petition and its motion to suspend discussed above, and the filing of opposer's multiple discovery motions, including several filed prior to November 3, 2000, opposer's motion to quash the November 30, 2000 deposition, notice of which was served on November 3, 2000, is granted to the extent that opposer was not required to appear for a discovery deposition on November 30, 2000.[7]

Opposer's motion (filed November 13, 2000) to suspend proceedings pending a Board decision on its motion to compel is granted to the extent that proceedings are considered to have been in suspension since August 28, 2000, the filing date of opposer's first motion to compel.

Applicant is allowed until **THIRTY DAYS** from the mailing date of this order to serve its responses to opposer's discovery requests served on August 18, 2000.

Finally, in view of the voluminous and piece-meal motion practice evident in this case, the Board advises opposer that abusive motion practice is sanctionable conduct.

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[6] In view thereof, opposer's motion (filed on September 22, 2000) for judgment based on applicant's failure to serve responses to the admission requests is denied as premature.

[7] Applicant's motion (filed December 11, 2000) to strike opposer's December 4, 2000 reply brief is denied.

Discovery and trial dates are reset as indicated below.[8]

THE PERIOD FOR DISCOVERY TO CLOSE:	7/1/01
30-day testimony period for party in position of plaintiff to close:	9/29/01
30-day testimony period for party in position of defendant to close:	11/28/01
15-day rebuttal testimony period for plaintiff to close:	1/12/02

[8] Applicant's motion (filed November 27, 2000) to take a deposition outside of the discovery period is denied as premature. Under the new discovery and trial schedule there is ample time in which to take opposer's discovery deposition within the discovery period.