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

In the matter of Application Serial No.: 78/180,241
Filed October 30, 2002
For the mark ECOSPHERE
Published in the *Official Gazette* (Trademarks) on July 22, 2003

02-06-2004
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #22

ECOLAB INC.,

Opposer,

v.

BIG PLANET, INC.,

Applicant.

Opposition No. 91158647

BOX TTAB – NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

CERTIFICATE OF MAILING 37 C.F.R. 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA22202-3514, on the date below:

Date: February 3, 2004 Colleen R. Hannigan
Signature

OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES PURSUANT TO FED. R. CIV. P. 12(f) AND 37 C.F.R. § 2.127

I. INTRODUCTION

Opposer Ecolab Inc. ("Ecolab" or "Opposer") moves, pursuant to Fed. R. Civ. P. 12(f) and 37 C.F.R. § 2.127, to strike the Affirmative Defenses of untimeliness, acquiescence and laches pled in Applicant Big Planet, Inc.'s ("Applicant") Answer to Notice of Opposition on the grounds that those defenses are immaterial, impertinent, and insufficient as a matter of law.

II. APPLICANT'S "UNTIMELINESS" AFFIRMATIVE DEFENSES SHOULD BE STRICKEN

Rule 12(f) of the Federal Rules of Civil Procedure provides in pertinent part that "[u]pon motion made by a party . . . within 20 days after the service of the pleading upon the party or upon the court's own initiative at any time, the court may order stricken from any pleading any insufficient defense or any . . . immaterial, impertinent . . . matter."[1] Fed. R. Civ. P. 12(f). When defenses cannot succeed under any circumstances, they are legally insufficient and should be stricken. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222-23 (T.T.A.B. 1995) (stating that a plaintiff may use the assertion of failure to state a claim upon which relief may be granted in a Rule 12(f) motion to strike a defense) (citation omitted). "One of the purposes of a motion to strike is to gain an early adjudication as to the legal sufficiency of defenses set forth in the answer of the defendant." *Angel v. Ray*, 285 F. Supp. 64, 65 (E.D. Wis. 1968). The untimeliness affirmative defenses alleged in Applicant's Answer are immaterial, impertinent, and insufficient as a matter of law and cannot serve as defenses under any circumstances.

It is within the Board's discretion to strike insufficient affirmative defenses, and immaterial and impertinent matter. *See American Vitamin Products, Inc. v. Dow Brands, Inc.*, 22 U.S.P.Q.2d 1313, 1314 (T.T.A.B. 1992). That discretion should be freely exercised here, especially since doing so would save the parties unnecessary expenditure of time and money conducting discovery on legally insufficient issues and preparing irrelevant issues for trial. *See FDIC v. Eckert Seamans Cherin & Mellott*, 754 F. Supp. 22, 23 (E.D.N.Y. 1990) (granting plaintiff's motion to strike the defendant's legally insufficient affirmative defenses under Rule 12(f) to avoid delay and unnecessary expense, noting that discovery on those issues could take

[1] Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), incorporates the Federal Rules of Civil Procedure in the procedure and practice in *inter partes* proceedings before the Trademark Trial and Appeal Board. Because Applicant served its Answer to Notice of Opposition via first-class mail, an additional five (5) days is added to the 20-day period prescribed by Rule 12(f).

many months and cause substantial delay and additional cost); *Narragansett Tribe of Indians v. Southern Rhode Island Land Development Corp.*, 418 F. Supp. 798, 801 (D.R.I. 1976) ("Weeding out legally insufficient defenses at an early stage of a complicated law suit may be extremely valuable to all concerned 'in order to avoid the needless expenditures of time and money,' in litigating issues which can be foreseen to have no bearing on the outcome.") (citing *Purex Corp., Ltd. v. General Foods Corp.*, 318 F. Supp. 322, 323 (C.D. Cal. 1970)).

Applicant's first alleged affirmative defense is "untimeliness." *See* Answer to Notice of Opposition, Affirmative Defense 1. Applicant also alleges two additional equitable defenses relating to the timeliness of Opposer's conduct: acquiescence and laches. *See id.*, Affirmative Defenses 3 and 5.[2] Although Applicant fails to allege any specific facts or conduct to support any of the affirmative defenses, each defense rises and falls on some proof of Opposer's undue delay or untimeliness. *See National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1580-82, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991) (stating that laches and acquiescence require proof that the party seeking to enforce its trademark rights unreasonably delayed pursuing litigation); *see also Kellogg Co. v. Exxon Corp.*, 209 F.3d 562, 568-69, 54 U.S.P.Q.2d 1413 (6th Cir. 2000) (same). In other words, each defense requires proof of some conduct on Opposer's part – an act or a failure to act – in temporal relation to Applicant's efforts to register the ECOSPHERE trademark. These affirmative defenses fail as a matter of law because Opposer timely filed its Notice of Opposition in accordance with applicable law.

Section 19 of the Lanham Act provides that "in inter partes proceedings equitable principles of laches, estoppel, and acquiescence, *where applicable*, may be considered and applied." 15 U.S.C. § 1069 (1997) (emphasis added). Applicant's affirmative defenses invoke these equitable principles to the extent they are all premised on the timeliness of Opposer's

[2] Applicant's Answer also fails to plead any facts supporting its other affirmative defenses of waiver, estoppel and unclean hands. To the extent Applicant bases these defenses on the alleged untimeliness of Opposer's response, then these defenses should also be stricken or withdrawn by Applicant.

conduct. *See, e.g.*, *National Cable*, 937 F.2d at 1580-82 (stating that laches and acquiescence require proof that the party seeking to enforce its trademark rights unreasonably delayed pursuing litigation). The period of untimeliness for purposes of evaluating Applicant's equitable defenses is measured from the date of *publication* of the mark in the Official Gazette for opposition purposes, and the applicant has the burden of proving excessive delay and prejudice from and after that date. *See National Cable*, 937 F.2d at 1582 (holding that the period to measure excessive delay and prejudice for laches affirmative defense begins when the registration is published for opposition); *DAK Indus., Inc. v. Daiichi Kosho Co., Ltd.*, 25 U.S.P.Q.2d 1622, 1624 (T.T.A.B. 1992) (same).

Applicant's intent-to-use Application Serial Number 78/180,241 in International Class 3 was published for opposition in the *Official Gazette* on July 22, 2003. Opposer filed its Notice of Opposition only four months after the application was published for opposition, and in full compliance with Trademark Rule 1.102. By its Orders dated July 28, 2003, September 23, 2003 and October 29, 2003, the Board granted Opposer an extension of time to oppose, and the Notice of Opposition was filed on November 19, 2003, prior to the expiration of the extension period. The Board's December 2, 2003 Order instituting this opposition proceeding confirms the timeliness of Opposer's Notice of Opposition.

Because of Opposer's timely filing of the Notice of Opposition, the Board should strike Applicant's affirmative defenses of untimeliness, acquiescence and laches. S*ee National Cable*, 937 F.2d at 1580-82 (granting summary judgment on laches and acquiescence affirmative defense); *DAK Industries*, 25 U.S.P.Q.2d at 1624 (granting opposer's motion for summary judgment on laches, acquiescence and estoppel affirmative defenses); *accord American Vitamin Products*, 22 U.S.P.Q. at 1314 (granting petitioner's motion to strike respondent's "equitable" defenses of bad faith and unclean hands); *Care Corp. v. Nursecare Int'l, Inc.*, 216 U.S.P.Q. 993,

995-96 (T.T.A.B. 1982) (granting opposer's motion to strike applicant's "equitable" defense of laches and acquiescence pursuant to Rule 12(f)). Because Opposer fully complied with Trademark Rule 1.102 in obtaining extensions of time within which to file timely its Notice of Opposition, Applicant has not and cannot allege a factual basis for any defense premised on Opposer's untimeliness. In other words, all of these affirmative defenses are *not* applicable and insufficient as a matter of law, and should therefore be stricken. *See DAK Industries,* 25 U.S.P.Q.2d at 1624-25 (holding that delay between publication and filing of opposition prior to expiration of extension period was not undue or prejudicial to applicant's rights; granting summary judgment for opposer on applicant's laches, acquiescence and estoppel affirmative defenses).

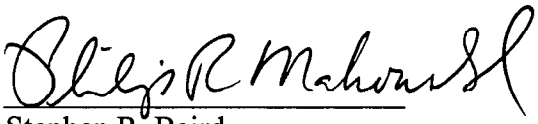
III. CONCLUSION

For all of the foregoing reasons, Opposer respectfully requests that Applicant's untimeliness, acquiescence and laches Affirmative Defenses be stricken from its Answer to Notice of Opposition.

Respectfully Submitted,

WINTHROP & WEINSTINE, P.A.

Date: February 3, 2004

By: 

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ATTORNEYS FOR ECOLAB INC.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer's Motion to Strike Affirmative Defenses Pursuant to Fed. R. Civ. P. 12(f) and 37 C.F.R. § 2.127 and embodied memorandum was served by first class mail, postage prepaid on this 3rd day of February, 2004 upon Applicant's counsel in an envelope addressed as follows:

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Todd E. Adler
Heller Ehrman White & McAuliffe LLP
333 Bush Street
San Francisco, CA 94104-2878

Colleen R. Harrigan

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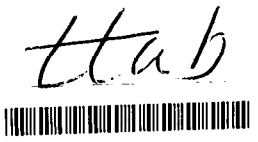

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WINTHROP WEINSTINE

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February 3, 2004

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Dear Sir or Madam:

Enclosed for filing please find the original of **Opposer's Motion to Strike Affirmative Defenses Pursuant to Fed. R. Civ. P. 12(f) and 37 C.F.R. § 2.127** with regard to the above matter.

We also enclose an additional copy of the Certificate of Service as well as a postcard to acknowledge receipt of this Opposer's Motion. Please date stamp and return the enclosed postcard to acknowledge receipt of the same. Should any fees be required relating to this document, the Commissioner is authorized to deduct said fees from the Deposit Account of Winthrop & Weinstine, P.A., Deposit Account No. 502789.

Very truly yours,

WINTHROP & WEINSTINE, P.A.

Philip R. Mahowald

Philip R. Mahowald

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Enclosures
cc: Beth M. Goldman/ Todd E. Adler (w/encl.)

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