ESTTA Tracking number: **ESTTA457663**

Filing date: **02/21/2012**

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

Proceeding	91203112
Party	Plaintiff San Francisco Baseball Associates L.P.
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Date	02/21/2012
Attachments	Motion to Strike Affirmative Defenses San francisco (Gogo) 2-21-12.pdf (10 pages)(44128 bytes)

Ref No. 21307.023

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

In re Application Serial No. 85/282,274
Filed: March 31, 2011
For Mark: SAN FRANCISCO and Design
Published in the Official Gazette: August 30, 2011

SAN FRANCISCO BASEBALL ASSOCIATES L.P.,	:	Opposition No. 91203112
Opposer,	:	
v.	:	
GOGO SPORTS INC.,	:	
Applicant.	:	

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

OPPOSER'S MOTIONS TO STRIKE THE FIRST, FIFTH, SIXTH, NINTH THROUGH ELEVENTH AND FOURTEENTH THROUGH SEVENTEENTH AFFIRMATIVE DEFENSES IN APPLICANT'S ANSWER AND TO SUSPEND PROCEEDINGS

MOTIONS

Opposer San Francisco Baseball Associates L.P. ("Opposer") hereby moves pursuant to Fed. R. Civ. P. 12(f) and TBMP § 503 to strike the first, fifth, sixth, ninth through eleventh, and fourteenth through seventeenth affirmative defenses set forth in the Answer of GoGo Sports Inc. ("Applicant") as immaterial, irrelevant or insufficient claims.

Additionally, as the Board's determination of Opposer's motion will affect the scope of discovery in this proceeding, Opposer moves that the proceeding be suspended pending consideration of its motion to strike and that, after the Board decides the motion, the deadlines for the initial discovery conference, discovery and trial be reset.

MEMORANDUM IN SUPPORT OF MOTIONS

Section 506.01 of the TBMP provides that the Board may, upon motion or upon its own initiative, "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." (3d ed. rev. 2011); s*ee also* Fed. R. Civ. P. 12(f).

On this basis, Opposer moves that the first affirmative defense for unclean hands be stricken as inadequately pled, as it consists of a conclusory statement without the factual allegations required for such a defense. Additionally, Opposer moves to strike the fifth, sixth, ninth through eleventh, and fifteenth through seventeenth affirmative defenses set forth in the Answer as immaterial. The defenses of waiver based on "undue delay" and laches set forth in the fifth and sixth defenses are unavailable in an opposition proceeding concerning registrability of a mark, in which publication for opposition first triggers the ability of an opposer to object to registration of a mark. Similarly, the failure to mitigate damages, fair use and the lack of a false designation of origin, trademark infringement or unfair competition set forth in Applicant's ninth, eleventh and fifteenth through seventeenth affirmative defenses are immaterial to an opposition proceeding concerning registration. The Board does not adjudicate questions of infringement, unfair competition and damages. Additionally, the Board lacks jurisdiction to adjudicate Applicant's tenth affirmative defense based on the First Amendment. Finally, the defense based on a lack of harm to the distinctiveness of a famous mark is irrelevant as Opposer has not included a dilution claim. Based upon the foregoing, and for the reasons discussed below, the Board should strike the first, fifth, sixth, ninth through eleventh, and fourteenth through seventeenth affirmative defenses in the Answer. [1]

[1] The facts upon which this motion is based are taken from Opposer's Notice of Opposition dated December 22, 2011 and Applicant's Answer To Notice of Opposition dated January 31, 2012.

Additionally, the Board should suspend the proceedings pending resolution of the Motion to Strike. Many of the defenses asserted by Applicant, such as allegations concerning damages, infringement and unfair competition, could significantly affect the scope of discovery in the proceeding. The motion should therefore be resolved before discovery opens. Opposer accordingly requests that the discovery and trial schedule be reset after a decision on the Motion to Strike.

A. Applicant's First Affirmative Defense of Unclean Hands Consists of Mere Conclusory Allegations, Lacks the Requisite Particularity and Should Be Stricken as Insufficient

Applicant's first affirmative defense of unclean hands should be stricken because, as pled, it is merely conclusory and fails to state any facts whatsoever, let alone any facts that would give adequate notice of the basis for such defense. As TBMP § 300 makes clear, "[t]he elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis of the defense." Where a defense contains mere conclusory allegations that do not give an opposer fair notice as to the specific conduct which provides the basis for the defense, the defense will be stricken by the Board. *See e.g., Veles Int'l Inc. v. Ringing Cedars Press LLC,* Consolidated Opp. Nos. 91182303 and 91182304 (T.T.A.B. June 2, 2008) (Board struck, *sua sponte*, applicant's affirmative defenses of waiver, estoppel, and unclean hands, finding affirmative defenses legally insufficient where applicant provided no specific allegations of conduct in support of its affirmative defenses that would, if proven, prevent opposer from prevailing on its claims), *citing Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc.*, 971 F.2d 732, 23 U.S.P.Q.2d 1701 (Fed. Cir. 1992) and *Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 U.S.P.Q.2d 1067 (T.T.A.B. 1987); *Activision Publ'g, Inc. v. Oberon Media, Inc.*, Opp. No. 91195500, at 3-4

(T.T.A.B. September 10, 2010) (dismissing affirmative defense of unclean hands where applicant failed to allege specific conduct providing basis for defense).

Moreover, Applicant's defense of unclean hands is legally insufficient for the additional reason that defenses based on fraud have a heightened pleading standard in that they must state the factual basis for such defenses with particularity. *See* 37 C.F.R. §2.106(b)(1); TBMP 311.02(b) (where fraud is pleaded, the provisions of Fed. R. Civ. P. 9 governing the pleading of that matter should be followed). The doctrine of unclean hands is rooted in the principle that equity demands "that its suitors . . . [act] fairly and without fraud or deceit as to the controversy in issue." *Precision Instrument Mfg. Co. v. Auto Maint. Mach. Co.*, 324 U.S. 806, 815 (1945). Conclusory statements that an Opposer has unclean hands, absent a recitation of the facts reflecting the basis for the alleged inequitable conduct, do not meet the pleading requirements of Fed. R. Civ. P. 9. *See e.g.*, *Cent. Admixture Pharm. Servs. v. Advanced Cardiac Solutions, P.C.*, 482 F.3d 1347, 1356 (Fed. Cir. 2007) ("inequitable conduct, while a broader concept than fraud, must be pled with particularity"). Since Applicant does not cite a single underlying fact in support of its defense of unclean hands, this defense does not meet the pleading requirements of Fed. R. Civ. P. 9.

In sum, since Applicant has failed to allege any facts or specific conduct in support of this affirmative defense that would, if proven, prevent Opposer from prevailing on its claims, its affirmative defense of unclean hands should be stricken as insufficient.

B. Applicant's Fifth and Sixth Affirmative Defenses of Waiver and Laches Should Be Stricken as Immaterial

Applicant's fifth and sixth affirmative defenses allege waiver and laches respectively. The basis of Applicant's waiver defense is "knowing delay." However, both these defenses are unavailable in opposition proceedings because the relevant time period is not measured from

when an applicant begins using its mark but, rather, from when a mark is published for opposition. Any delay prior to publication is irrelevant because publication marks the first time that an opposer could challenge the registration of the mark. *See* TBMP §311.02(b) (acquiescence and laches "start to run … from the time the mark is published for opposition, not from the time of knowledge of use"); *Nat'l Cable Television Assoc., Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1582, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991) (measure for laches runs no earlier than publication for opposition, not from knowledge of use); *Sunkist Growers, Inc. v. Smile Factory, LLC*, 2009 TTAB LEXIS 683, at *7 (T.T.A.B. 2009) (time periods for laches and acquiescence do not begin to run until the mark is published for opposition); *Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 U.S.P.Q.2d 1789, 1797 (T.T.A.B. 2009) (in an opposition, estoppel defense must be tied to the registration of applicant's marks, not applicant's use of its marks); *Krause v. Krause Publ'ns Inc.*, 76 U.S.P.Q.2d 1904, 1914 (T.T.A.B. 2005) (the equitable defense of acquiescence in an opposition or cancellation proceeding does not begin to run until the mark is published for opposition).

Here, the short time period between the publication of the application at issue and the filing of the opposition is insufficient as a matter of law to constitute an unreasonable delay for the purposes of laches or waiver (which is based on alleged delay here). *See, e.g., Sunkist Growers, Inc.*, 2009 TTAB LEXIS 683, at *7 (defenses of laches and acquiescence dismissed since the short period of delay between publication and institution of the opposition cannot be viewed as an unreasonable delay); *Panda Travel Inc*, 94 U.S.P.Q.2d at 1797 (because Opposer's Notices of Opposition were timely filed, there can be no delay for purposes of laches or estoppel); *Ironman Magazine v. World Triathlon Corp.*, 2009 TTAB LEXIS 35, at *18 (T.T.A.B. 2009) (because proceeding was brought during opposition period, laches does not apply);

Callaway Vineyard & Winery v. Endsley Capital Group Inc., 63 U.S.P.Q.2d 1919, 1923 (T.T.A.B. 2002) (since opposer promptly opposed registration of applicant's mark, applicant has no basis for the defenses of laches, estoppel, or acquiescence); *Nicholson v. Gott Bros. Dev., LLC*, 2008 TTAB LEXIS 612, at *13 (T.T.A.B. 2008) (short period of time between publication and institution of opposition does not constitute unreasonable delay for purposes of acquiescence). As such, Applicant's affirmative defenses of laches and waiver are immaterial and should be stricken.

C. Applicant's Ninth, Eleventh and Fifteenth Through Seventeenth Affirmative Defenses Should Be Stricken As Immaterial to an Opposition Proceeding

Several of Applicant's affirmative defenses, namely, Applicant's ninth, eleventh and fifteenth through seventeenth affirmative defenses, pertain to an infringement or unfair competition action rather than to an opposition proceeding and should be stricken as immaterial. The ninth defense relies on "fair use," which is applicable only in an infringement context when a defendant is using a term descriptively in good faith. Section 33(b)(4) of the Lanham Act provides that the fair use defense is available to a party whose

> *use* of the name, term, or device charged to be an *infringement* is a *use, otherwise than as a mark,*… of a term or device which is descriptive of and *used* fairly and in good faith only to describe the goods or services of such party, or their geographic origin…

15 U.S.C. § 1115(b)(4)(emphasis added). Applicant cannot rely on this defense in this proceeding for two reasons. First, this proceeding does not address Applicant's use of its mark as an infringement. Instead, Opposer is challenging the registration of Applicant's mark. Second, the fact that Applicant is applying to register its mark as a trademark constitutes an admission that it is claiming trademark rights. Applicant therefore fails to satisfy the defense's requirement that use be "otherwise than as a mark." Accordingly, the fair use defense should be stricken as immaterial.

Similarly, Applicant's eleventh and fifteenth through seventeenth defenses, namely, failure to mitigate damages, no false designation of origin, no trademark infringement and no unfair competition respectively, are only applicable in the context of a civil action based on infringement or unfair competition and not in an opposition proceeding about registration. These defenses are totally immaterial to this proceeding and should be stricken by the Board. The Board has no authority to consider claims for a false designation of origin under section 43(a) of the Lanham Act, trademark infringement under section 32 of the Lanham Act and/or common law unfair competition. *See, e.g., Paramount Pictures Corp. v. White*, 31 U.S.P.Q.2d 1768, 1771 n.5 (T.T.A.B. 1994) (Board has no jurisdiction over claims of trademark infringement and unfair competition), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); *Andersen Corp. v. Therm-O-Shield Int'l, Inc*., 226 U.S.P.Q. 431, 432 n.5 (T.T.A.B. 1985) (Board may not entertain any claim based on section 43(a)); *Electronic Water Conditioners, Inc. v. Turbomag Corp*., 221 U.S.P.Q. 162, 163-64 (T.T.A.B. 1984) (unfair competition and Trademark Act § 43(a) claims are outside the Board's jurisdiction); TBMP § 102.01 (Board "is not authorized to determine the right to use, nor may it decide questions of infringement or unfair competition"). Accordingly, Applicant's fifteenth through seventeenth defenses should be stricken as immaterial. Further, the Board has no authority to award damages, *see, e.g., Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC,* 88 USPQ2d 1541, 1544 n.6 (T.T.A.B. 2008); TBMP § 502.05 ("The Board will not hold any person in contempt, or award attorneys' fees, other expenses, or damages to any party"), and thus the eleventh defense of failure to mitigate damages should also be stricken as immaterial.

D. Applicant's Tenth Affirmative Defense Based on the First Amendment should Be Stricken as Not Within the Jurisdiction of the Board

Applicant's tenth affirmative defense relies on Applicant's claim that its "use of the subject mark is permissible and protected under the First Amendment of the Constitution of the United States." Such a defense is not cognizable before the Board. This opposition proceeding is not an infringement suit before a court based on Applicant's use of its mark. Rather, it is an administrative proceeding about the registrability of Applicant's mark. As an administrative tribunal, the Board lacks jurisdiction to adjudicate constitutional claims and defenses. *See, e.g., Blackhorse v. Pro Football, Inc.*,98 U.S.P.Q.2d 1633 (T.T.A.B. 2011) ("the Board does not have authority to determine constitutional claims")*; Harjo v. Pro Football Inc.*, 30 U.S.P.Q.2d 1828, 1833 (T.T.A.B. 1994) (striking an affirmative defense based on the First Amendment as beyond the authority of an administrative tribunal). Accordingly, the Board should strike Applicant's defense based on First Amendment rights in this case as beyond its authority.

E. Applicant's Fourteenth Affirmative Defense Based on Lack of Impairment to the Distinctiveness of a Famous Mark Should Be Stricken as Irrelevant and Immaterial

Applicant's fourteenth affirmative defense states that Opposer cannot show that Applicant's use "creates a likelihood of impairment to the distinctiveness of any alleged famous mark owned by Opposer." This defense is irrelevant and immaterial because it is addressed to a claim of dilution of the distinctiveness of a famous mark. The crux of a dilution claim is ownership of a famous mark whose distinctiveness is impaired by the similarity of another's mark. 15 U.S.C. § 1125(c). However, the Notice of Opposition does not include a claim for dilution. Accordingly, this affirmative defense should be stricken as irrelevant.

CONCLUSION

For the foregoing reasons, Applicant's first, fifth, sixth, ninth through eleventh, and fourteenth through seventeenth affirmative defenses should be stricken. Moreover, the

proceeding should be suspended pending consideration of Opposer's motion to strike, and the deadlines for the initial discovery conference, discovery and trial periods should be reset accordingly.

Dated: New York, New York
February 21, 2012

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.
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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on February 21, 2012, I caused a true and complete copy of the foregoing *Opposer's Motions to Strike the First, Fifth, Sixth, Ninth Through Eleventh and Fourteenth Through Seventeenth Affirmative Defenses in Applicant's Answer and to Suspend Proceedings* to be sent via First Class Mail, postage prepaid, to Applicant's attorney and Correspondent of Record, Al Mohajerian, Esq., Mohajerian Inc., 2029 Century Park East 19th Floor, Los Angeles, CA 90067.

Dated: New York, New York
February 21, 2012

/Seth Shaifer /