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

Proceeding	91221493
Party	Plaintiff Shaklee Corporation
Correspondence Address	KEVIN M HAYES KLARQUIST SPARKMAN LLP 121 SW SALMON STREET, SUITE 1600 PORTLAND, OR 97204 UNITED STATES ptotmdocket@klarquist.com, kevin.hayes@klarquist.com
Submission	Motion to Strike
Filer's Name	Kevin M. Hayes
Filer's e-mail	ptotmdocket@klarquist.com, kevin.hayes@klarquist.com
Signature	/Kevin M. Hayes/
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Attachments	Motion to Strike.pdf(248600 bytes )

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

Shaklee Corporation,	)	
	)	
Opposer,	)	
	)	
v.	)	<b>SHAKLEE’S MOTION TO STRIKE</b>
	)	<b>SECOND, THIRD, AND FOURTH</b>
Mannatech, Incorporated,	)	<b>AFFIRMATIVE DEFENSES</b>
	)	
Applicant.	)	Opposition No. 91221493
	)	(Application Ser. No. 86/128507)

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**MOTION TO STRIKE AFFIRMATIVE DEFENSES**

Opposer, Shaklee Corporation, requests that the Board strike Applicant’s Second, Third, and Fourth affirmative defenses that:

1. Opposer’s pleaded Registration is invalid.
2. Opposer is barred by estoppel and/or laches from bringing an opposition; and
3. The Notice of Opposition fails to state a claim upon which relief can be granted.

**BRIEF IN SUPPORT OF MOTION TO STRIKE AFFIRMATIVE DEFENSES**

Applicant’s above noted defenses should all be stricken pursuant to Federal Rule of Civil Procedure 12(f) because they either are not affirmative defenses (invalidity of a trademark registration) or are inadequately pled (estoppel and failure to state a claim). Shaklee explains below in more detail why the defenses should be stricken.

**A. Applicant May Not Plead Invalidity As A Defense**

Applicant’s second affirmative defense is invalidity of Shaklee’s existing, in-force, and pleaded registration. It is insufficient and improper. A registration may only be challenged through a petition to cancel. Even though Applicant has brought a petition to cancel, its

affirmative defense is either an impermissible collateral attack or redundant and unnecessary. In either event, the defense should be stricken under Federal Rule of Civil Procedure 12(f) (“The court may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.”).

The Board’s Manual of Practice makes this clear in TBMP § 311.02(b) where the Board states: “When a defense is raised by way of a counterclaim, **it should not also be pleaded as an affirmative defense**, because the pleading of it as an affirmative defense is unnecessary and redundant.”) TBMP § 311.02(b) (emphasis added). *See also Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (motion to strike affirmative defense predicated on same facts alleged in counterclaim granted as representing, in effect, a collateral attack on registration); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm’r 1977) (motion to strike affirmative defense which allegations formed basis for counterclaim granted since, although Board did not find that applicant was attempting to collaterally attack registration, the affirmative defense was repetitious and unnecessary).

**B. Applicant Provides No Allegations That Make Out A Defense Of Laches Or Estoppel**

Applicant pleads a conclusory affirmative defense of estoppel and/or laches as its “Third Affirmative Defense” in ¶8 of its Answer consisting of: “The marks currently coexist without customer confusion. As such, delay in action by Opposer has caused prejudice to Applicant. Opposer’s claims are barred by the equitable doctrine of laches and or estoppel.”

As noted above, pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. This defense pleaded by Applicant is obviously insufficient as there are no facts pleaded which could support the defense.

First, with regard to estoppel, “[t]he elements of equitable estoppel are (1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2) reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted.” *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732, 734 (Fed. Cir.1992). Applicant fails to allege any of these elements in its defense of estoppel. Thus, the defense of estoppel should be stricken.

Second, with regard to alleged laches, this opposition was brought within the statutorily mandated period in which to do so. Laches should not be possible. Professor McCarthy explains in this regard that the defense of laches has been “effectively eliminated ... from an opposition proceeding.” 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 20:35 (4th ed., 2015 update).

In addition, under the defense of laches, “[m]ere delay in asserting a trademark related right does not necessarily result in changed conditions sufficient to support the defense of laches. There must also have been some detriment due to the delay.” *Bridgestone/Firestone Research Inc. v. Automobile Club de l’Ouest de la France*, 245 F.3d 1359 (Fed. Cir. 2001). Applicant alleges no such detriment. Therefore, not only is laches a dubious defense in an opposition, but Applicant also fails to properly allege laches.

Opposer further notes that Fed. R. Civ. P. 8(b) and TBMP §311.02(b) require Applicant to identify the bases for its affirmative defenses with sufficient definiteness to provide Opposer and the Board with fair notice of the bases for the defenses. Fed. R. Civ. P. 8(b); TBMP §311.02(b) (stating, “[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 for the defense,” and citing *McDonnell Douglas Corp. v. National Data Corp.*, 228 U.S.P.Q. 45,

47 (TTAB 1985) (bald allegations in the language of the statute, did not provide fair notice of basis of petitioner's Section 2(a) claim)).

In this case, Applicant's defense is devoid of any factual support. There are no facts pleaded which allow Shaklee to determine how estoppel or laches might apply. Thus, the alleged defense fails to provide Opposer and the Board with any notice of the alleged base for the defense. In view of the bald and conclusory allegation, the Board should strike Applicant's Third affirmative defense of estoppel and/or laches.

**C. Applicant Provides No Allegations That Make Out A Defense Of Failure To State A Claim**

Applicant pleads a conclusory affirmative defense of failure to state a claim as its "Fourth Affirmative Defense" in ¶9 of its Answer. Its defense consists of: "The Notice of Opposition fails to state a claim upon which relief can be granted." However, Applicant fails to plead any facts that could make out such a defense.

Not only is such a conclusory defense improper, it is wrong based on the pleadings in this matter. A claim for opposition requires only that an opposer plead that it will be damaged by a registration. This is met by pleading, as Shaklee has done, that it has prior rights and that the opposed application will damage it. 15 U.S.C. §1063(a) ("Any person who believes that he would be damaged by the registration of a mark upon the principal register, ... may ... file an opposition in the Patent and Trademark Office, stating the grounds therefor"); *and see* TBMP § 303.03 ("The term 'damage,' as used in Trademark Act § 13 and Trademark Act § 14, 15 U.S.C. § 1063 and 15 U.S.C. § 1064, concerns specifically a party's standing to file an opposition or a petition to cancel, respectively. A party may establish its standing to oppose or to petition to cancel by showing that it has a 'real interest' in the case.") *and* TBMP § 309.03(b) ("A real interest in the proceeding and a reasonable belief of damage may be found, for

example, where plaintiff pleads (and later proves): A claim of likelihood of confusion that is not wholly without merit, including claims based upon current ownership of a valid and subsisting registration or prior use of a confusingly similar mark.”) (Citations omitted, emphasis in original).

Shaklee has, without question, pleaded facts that make out its claims in this case as can be seen in Paragraphs 1-5 of Opposer’s Notice of Opposition (alleging that it uses YOUTH and has federally registered YOUTH before the opposed application was filed) and Paragraphs 25 and the WHEREFORE clause of Opposer’s Notice of Opposition alleging that the mark of the opposed application is likely to cause confusion and that registration of the opposed application will damage Opposer.

As Applicant’s Fourth Affirmative Defense of Failure to State a Claim is both insufficiently plead and plainly wrong on its face, the Board should strike it.

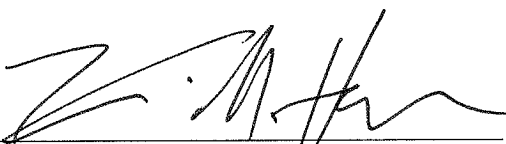
**D. Conclusion**

In view of the foregoing, it is clear that Applicant Second affirmative defense is not a defense at all, and that is has failed to allege sufficient facts to bring its Third and Fourth affirmative defenses. All of these defenses should be stricken and the Board is respectfully requested to strike them.

Respectfully submitted,

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 595-5300  
Facsimile: (503) 595-5301

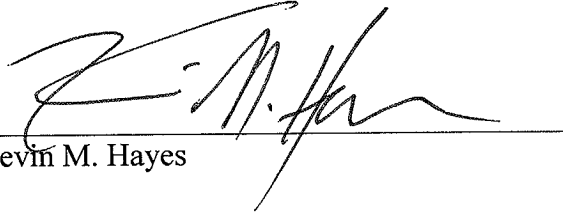
KLARQUIST SPARKMAN, LLP

By   
Kevin M. Hayes  
Oregon State Bar No. 01280

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on June 12, 2015, a true copy of the foregoing MOTION TO STRIKE was served on Applicant by first class mail, postage prepaid, to:

Sanford E. Warren, Jr.  
Warren Rhoades LLP  
1212 Corporate Drive, Suite 250  
Irving, Texas 75038

A handwritten signature in black ink, appearing to read "K. M. Hayes", is written over a horizontal line. The signature is stylized and cursive.

Kevin M. Hayes