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

Proceeding	91222404
Party	Defendant American Silver, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>UNDER ARMOUR, INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>AMERICAN SILVER, LLC,</p> <p style="text-align: center;">Applicant,</p>	<p>Opposition No. 91222404</p> <p>Mark: ARMOR GEL</p> <p>Int'l Class: 005</p> <p>Serial No.: 86/232,097</p> <p>Filed: March 26, 2014</p> <p>Published: February 17, 2014</p>
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**AMERICAN SILVER, LLC'S RESPONSE TO
OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES**

Applicant American Silver, LLC ("American Silver"), by and through its counsel, hereby respectfully submits its Response to Opposer's Motion to Strike Applicant's Affirmative Defenses filed by Under Armour, Inc. ("Under Armour" or "Opposer") and states now as follows:

BACKGROUND

On June 17, 2015 Opposer filed a Notice of Opposition ("Opposition") to Applicant's Trademark Application for ARMOR GEL, Serial No. 86/232,097. On August 10, 2015 American Silver submitted an Answer to the Notice of Opposition, which includes ten (10) paragraphs under the heading "Affirmative Defenses" which the Answer identifies as "defenses, affirmative *or otherwise*." (emphasis added). On September 8, 2015 Opposer filed its Motion to Strike Applicant's Affirmative Defenses seeking to have these paragraphs stricken from Applicant's Answer. These ten (10) paragraphs are sufficient and proper as defenses and/or amplifications of denials. Whether referred to as "defenses," "affirmative defenses," "avoidances," "affirmative pleadings," or "arguments," these ten paragraphs should be permitted

at a minimum because they serve to give the Opposer fuller notice of the position which Applicant plans to take in defense of its right to registration. Accordingly, Opposer's Motion to Strike should be denied.

DEFENSES AT ISSUE

The following ten (10) paragraphs identified in the Answer as "defenses, affirmative or otherwise" ("Defenses") are presently the subject of Opposer's Motion to Strike:

1. Opposer's Notice of Opposition fails to state a claim upon which relief may be granted.
2. The term ARMOUR is highly diluted as a trademark formative, and hence exceptionally weak, and Opposer's purported rights extend no further, if at all, than to the specific marks for which Opposer alleges it owns trademark registrations, none of which are the same as or confusingly similar to Applicant's mark in terms of connotation, appearance, and/or pronunciation, and none of which are for related goods or services.

3. The public interest will be harmed if Opposer's Notice of Opposition is granted.

4. Opposer's alleged trademarks are not famous in any relevant field of goods or services.

To the extent any of Opposer's marks have become famous in any relevant field of goods or services, which is hereby expressly denied, on information and belief, such alleged fame arose, if at all, after Applicant's first use of its ARMOR GEL mark.

5. Opposer's alleged trademarks and Applicant's ARMOR GEL mark are dissimilar in appearance, sound, connotation, and/or overall commercial impression and will not create a likelihood of confusion or dilution when applied to the relevant goods.

6. Opposer does not have or own any trademark registrations or common law trademark rights covering any goods or services related to the goods or services identified in U.S.

Trademark Registration Application No. 86/232,097, which is the subject of the Notice of Opposition.

7. Applicant's ARMOR GEL mark as set forth in the U.S. Trademark Registration Application No. 86/232,097, which is the subject of the Notice of Opposition, does not

and will not impair or harm any of the Opposer's alleged trademark rights in any meaningful way and would not result in any dilution of Opposer's alleged trademarks.

8. Opposer does not have or own any trademark registrations or common law trademark rights for any mark in International Class 005 or for any goods or services that are related to the good set forth in U.S. Trademark Registration Application No. 86/232,097, which is the subject of the Notice of Opposition.
9. Opposer's claims are barred under the doctrines of estoppel and acquiescence and/or because of Opposer's failure to police its mark in any relevant fields. On information and belief, Opposer routinely fails to object to marks which contain the terms "Armour" and/or "Armor" and numerous other third parties have used such terms as part of their trademarks with the Opposer's knowledge and acquiescence thereto.
10. Application reserves all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the Lanham Act, and any other defenses at law or in equity that may now exist or in the future be available based on discovery and further factual investigation in this case.

ARGUMENT

I. Standard on Motions to Strike

"An answer may also include a short and plain statement of *any* defenses, including affirmative defenses . . . Affirmative defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (Morehouse) defense, prior judgment, *or any other matter constituting an avoidance or affirmative defense.*" TBMP § 311.02(b) (emphasis added). Moreover, "[a] defendant may state as many separate defenses as it has, regardless of consistency; a defendant may also set forth two or more statements of a defense alternately or hypothetically, either in one count or in separate counts." *See Id.*

Pursuant to Fed. R. Civ. P. 12(f), the Board may strike from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. TTAB Manual of

Procedure (“TBMP”) § 506.01. However, *motions to strike are generally disfavored* by the TTAB and matters are generally not stricken unless they clearly have no bearing upon the issues in the case. *Id.*; *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). As a result, motions to strike are infrequently granted. *FRA S.p.A. v. Surgo-O-Flex of America, Inc.*, 194 USPQ 42 (SDNY 1976).

The primary purpose of pleadings under the Federal Rules of Civil Procedure is simply to give fair notice of the claims or defenses asserted. *See* TBMP § 506.01. Accordingly, the Board, in its discretion, may decline to strike even objectionable affirmative defenses where their inclusion will not prejudice the adverse party and will provide fuller notice of the basis for a claim or defense. TBMP § 506.01; *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (affirmative defense not stricken as it was an amplification of applicant’s denial of opposer’s claims); *Harsco Corp.*, 9 USPQ2d at 1571 (reasonable latitude in notice pleading permitted); *FRA S.P.A.*, 194 USPQ at 46.

Indeed, as set forth in TBMP §311.02(d):

An answer may include affirmative assertions that, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant's denial of one or more of the allegations in the complaint. These ***amplifications of denials, whether referred to as “affirmative defenses,” “avoidances,” “affirmative pleadings,” or “arguments,” are permitted by the Board*** because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration.”

See TBMP §311.02(d) (emphasis added).

American Silver’s Defenses are sufficient, proper, and at a minimum are permissible amplifications of its denials and satisfy the requirements laid out by the TBMP and the Federal Rules of Civil Procedure. Accordingly, Opposer’s Motion to Strike should be denied.

II. American Silver's Defenses are Properly Pled

Under Armour filed its Motion to Strike prior to the exchange of initial disclosures or the production of any discovery. At best, Under Armour's Motion to Strike is premature.

Nonetheless, American Silver's Defenses, however termed, are properly pled and provide Opposer fuller notice of the position which the Applicant plans to take in defense of its right to registration. Accordingly, Opposer's Motion to Strike should be denied.

A. American Silver's First Defense is Not Insufficient or Improper and should not be dismissed.

Under Armour seeks to dismiss American Silver's first defense which alleges a failure to state a claim upon which relief may be granted on the basis that this defense is allegedly insufficient and improper. Fed.R.Civ.P. 12(b)(6) permits a defendant to assert in the answer the "defense" of failure to state a claim upon which relief can be granted. *Order of Sons of Italy in America*, at 1222. In the present Opposition proceeding, Opposer has failed to state a claim for dilution of its alleged ARMOUR mark or alleged ARMOUR formative-mark.

In order to prevail on a dilution claim, an opposer must demonstrate that: (1) it owns a famous mark that is distinctive; (2) the applicant is using a mark in commerce that allegedly dilutes the opposer's famous mark; (3) the applicant's use of its mark began after the opposer's mark became famous; and (4) the applicant's use of its mark is likely to cause dilution by blurring or tarnishment. *See New York Yankees Partnership v. IET Products and Services, Inc.*, Opposition No. 91189692, * 6 (TTAB May 8, 2015) citing *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012); *See also* § 1125(c)(1).

Under Armour's Opposition fails to adequately plead the first element necessary to prevail on a dilution claim. It has not alleged that its purported ARMOUR mark or purported ARMOUR-formative marks, separate and apart from the UNDER ARMOUR mark, are famous marks. Instead, Opposer alleges only that "the UNDER ARMOUR mark has been well known and famous for years" and that allegedly "the Trademark Trial and Appeal Board of the United

States Patent and Trademark Office (PTP) expressly acknowledged the fame of the UNDER ARMOUR mark.” Opp. ¶ 17-18. No allegation was made that the purported ARMOUR mark is independently famous.

Moreover, "to be famous within the meaning of the statute, the mark must have achieved a high degree of acquired distinctiveness, meaning that it must have become very widely recognized by the U.S. consumer public as the designator of the plaintiff's goods." *TCPIP Holding Co., Inc. v. Haar Commc'ns, Inc.*, 244 F.3d 88, 97 (2d Cir. 2001). Opposer has failed in its Opposition to plead specifically that the alleged ARMOUR and/or alleged AMOUR-formative marks have achieved the high degree of recognition needed to constitute a famous mark within the United States. As such, Under Armour’s dilution claim as to the alleged ARMOUR and/or alleged ARMOUR-formative marks fails to state a claim for which relief can be granted.

For the foregoing reasons, Applicant’s First Defense should not be stricken and Opposer’s Motion to Strike should be denied as to Applicant’s First Defense.

B. Paragraphs 2, 4, 5, 6, 7, and 8 of American Silver’s Defenses Amplify Details of Applicant’s Avoidances or Defenses to the Opposition.

American Silver has asserted ten paragraphs detailing its defenses and positions of avoidance to Under Armour’s Opposition which further detail the approach Applicant anticipates taking in defending itself. As noted above, this is clearly anticipated and permitted under TBMP §311.02(d). *See also, Bd. of Trustees of the University of Arkansas v. Olin Corp.*, Opp. No. 91204016 at 3-4 (TTAB June 28, 2012) (construing affirmative defenses as “mere amplifications of applicant’s denial to the corresponding allegations in the notice of the opposition” and permitting those affirmative defenses to remain “since they provide Opposer more complete notice of [applicant’s] position regarding opposer’s asserted claims.”) Under Armour, in an improper attempt to foreclose American Silver’s right to seek discovery on relevant issues, claims that such defenses are redundant and summarily should be dismissed. Under Armour’s arguments are unsound and without merit.

Under Armour argues that ¶¶ 4 and 7 of American Silver's Defenses merely "restate Applicant's previous denials of Opposer's dilution claim in the Notice of Opposition, specifically Applicant's denials of Paragraphs 17, 29, 30, and 31." Motion to Strike at 6. However, ¶¶ 4 and 7 of American Silver's Defenses go beyond a mere denial of those allegations and instead clarify that American Silver intends to focus its defense on Under Armour's overreaching as to the specific field of goods and services of the marks for which Opposer alleges its UNDER ARMOUR mark is famous. Paragraphs 4 and 7 also provide Under Armour with notice that American Silver intends to dispute the dates by which Opposer claims that it became "famous" as well as Opposer's claim that this alleged "fame" predates Applicant's first use of the ARMOR GEL mark or other rights that Applicant may have in the term ARMOR. Applicant is entitled to discovery on these points. These defenses therefore go beyond and further amplify any denials of Opposer's purported dilution claim, provide defenses which American Silver will need discovery on, and are therefore permissible under TBMP §311.02(d)

Moreover, Opposer seeks to have ¶¶ 2, 6, and 8 of American Silver's Defenses dismissed but expressly admits that these Defenses "amplify Applicant's denial that there is no likelihood of confusion with Opposer's mark." Motion to Strike at 6. As noted above, such amplifications are explicitly provided for under TBMP §311.02(d) and thus, cannot serve as a basis for dismissing an affirmative defense. See *Bd. of Trustees of the University of Arkansas* at 3-4. It is well established that the purpose of affirmative defenses is to provide the opposing party with fair notice of the claims or defenses asserted. *Hormel Foods Corporation and Hormel Foods LLC. v. SPAM Arrest, LLC.*, 2007 WL 4287254, at *2 (T.T.A.B. Nov. 21, 2007); *Ohio State Univ. v. Ohio Univ.*, at 1289; *Harsco Corp.*, 9 U.S.P.Q.2d at 1570 ("Under the Federal Rules of Civil Procedure the function of pleadings is to give fair notice of the claim asserted--preferably, as provided by Fed. R. Civ. P. 8(a)(2), in a form which contains "a short and plain statement of the claim.") Applicant's Defenses accomplish those objectives: they amplify the denials contained in its Answer and provide notice of Applicant's defense theories. Since the Defenses are inherently related to the merits of the case, Applicant should be allowed to take discovery

related to the issues set for in its defenses. Accordingly, Opposer has provided no valid basis for its argument that §§ 2, 4, 5, 6, 7, and 8 of American Silver's Defenses should be stricken.

Finally, Opposer alleges that ¶ 5 of American Silver's Defenses "merely restates Applicant's denial of Opposer's likelihood-of-confusion claim." Motion to Strike at 6. Again, Under Armour errs. Opposer's likelihood of confusion claim generally alleges that "Applicant's ARMOR GEL mark so resembles Under Armour's prior used, filed, and/or registered ARMOUR Marks, as to be likely when applied to Applicant's goods, to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended 15 U.S.C. § 1052(d)." Opposition at ¶ 27. In response to Paragraph 27, American Silver denied the allegations. However, in ¶ 5 of its Defenses, American Silver provides further detail or amplification for the basis of its denial of Opposer's likelihood of confusion claim, noting that there are numerous reasons why there is no likelihood of confusion between the Opposer's Marks and the ARMOR GEL Mark including: (1) differences in the appearance of the ARMOR GEL Mark and Opposer's marks, (2) differences in sound of the ARMOR GEL Mark and any of Opposer's Marks, and (3) the difference between the commercial impression of the ARMOR GEL mark and the commercial impression of Opposer's alleged marks.

Accordingly, this defense further bolsters the denials American Silver provided to the likelihood of confusion claim by enumerating several categories of differences that American Silver believes will demonstrate that no likelihood of confusion exists. Thus, amplification by American Silver of any of its denials of Opposer's claims is appropriate as it provides Opposer more complete notice of American Silver's position. Accordingly, Opposer's Motion to Strike should be denied.

C. Paragraph 3 of American Silver's Defenses is Proper.

Opposer argues that ¶ 3 of American Silver's Defenses should be stricken because it is allegedly ambiguous and fails to provide any specificity or fair notice regarding the harm to the public interest if the opposition should be sustained. However, Fed. R. Civ. P. 8(d)(1) clearly

details that “each allegation must be simple, concise, and direct. No technical form is required.” Moreover, it is well-settled that a defense may be pled in general terms and will be sufficient, and therefore invulnerable to a motion to strike so long as it gives the plaintiff fair notice of the nature of the defense. *See* Wright, Miller, Kane, and Marcus, *5 Fed. Prac. & Proc. Civ.* § 1274. Paragraph 3 of American Silver’s Defenses gives Under Armour notice that Applicant will be seeking discovery on the balance of public interest in free enterprise and Under Armour’s interest in opposing registration of marks containing the term “Armor” or “Armour” with respect to fields of goods outside of those set forth in Opposer’s registrations or outside of the field of goods wherein Opposer has previously used its marks. As noted above, this case is yet in its infancy. No discovery has occurred. Applicant should be given sufficient time to investigate this defense. Accordingly, Opposer’s request to strike ¶ 3 of American Silver’s Defenses should be denied.

D. Paragraph 9 of American Silver’s Defenses Properly puts Opposer on Notice of Defense Theories.

Paragraph 9 of American Silver’s properly puts Opposer on Notice regarding defense theories. Opposer’s failure to police its mark in a field for which it alleges distinctiveness or fame is evidence of the weakness of its mark in those fields and/or evidence of its lack of trademark rights in those fields or related goods. An applicant’s reliance on opposer’s failure to police can rise to the level of acquiescence and/or estoppel. Opposer’s failure to object to marks which contain the terms “Armour” and/or “Armor” used in fields or with goods relevant to the present opposition proceeding and with which Opposer has not used its marks is relevant to the strength (*e.g.*, weakness) of Opposer’s mark and its lack of applicable trademark rights. Accordingly, Opposer’s request to strike ¶ 9 should be denied.

E. Paragraph 10 of American Silver’s Defenses is Proper and Should Not Be Stricken.

Paragraph 10 of American Silver’s Defenses is a general statement that does not prejudice Opposer and therefore should not be stricken. Motions to strike are generally disfavored by the TTAB and matters are generally not stricken unless they clearly have no bearing upon the issues in the case. *Id.*; *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988). Moreover, the Board, in its discretion, may decline to strike even objectionable affirmative defenses where their inclusion will not prejudice the adverse party. TBMP § 506.01; *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999).

In *American Residential Services L.L.C. v. Rescue Response Group Inc.*, Opposition No. 91199269 (June 12, 2012), the Board decided against striking an alleged affirmative defense that was substantially the same as the statement in ¶ 10 of American Silver’s Defenses. As stated by the Board in *American Residential Services*, “while the Board agrees that such an assertion is really not a defense, but rather merely an expression of opposer’s rights to modify or supplement the answer. Given the general nature of this statement, however, the Board sees no need to strike it.” *See Id.* at 4.

Likewise, the Board should follow the decision made in *American Residential Services* and decline to strike ¶ 10 of American Silver’s Defenses.

III. Under Armour has Not Established the Requisite Prejudice from the Defenses.

To succeed on its Motion to Strike American Silver’s defenses, Opposer must prove that the (1) there is no question of fact which might allow the defense to succeed; (2) there is no question of law which might allow the defense to succeed; ***and*** (3) the defense is so wholly unrelated to the issues of the opposition that the Opposer would be prejudiced by the defense.

See SEC v. Alexander, 248 F.R.D. 108, 109 (E.D.N.Y. 2007); *Harsco Corp.*, 9 USPQ2d at 1571; *see also*, TBMP § 506.01. Even if Opposer could established that any of American Silver’s defenses suffer from factual or legal defects, which American Silver expressly denies, Opposer has not established that it would be subject to any prejudice resulting from the defenses asserted. As noted above, discovery has not yet begun in this case. Indeed, even if Opposer’s arguments were taken as true, which they are not, and ¶¶ 1-10 of American Silver’s Defenses are “immaterial and redundant” of Applicant’s Answer to the claims, then this would not result in increased discovery demands. As shown above, American Silver’s Defenses directly relate to Opposer’s alleged likelihood of confusion and purported dilution claims. Additionally, “their inclusion will not prejudice the Opposer, but rather will provide fuller notice of the basis for” American Silver’s defenses. *See* TBMP § 506.01. The burden rests on Under Armour to establish that it is prejudiced by Applicant’s defenses. It has failed to do so, and accordingly its Motion to Strike should be denied.

IV. Alternatively, American Silver Should be Granted Leave to Amend Its Answer

Parties may amend their pleadings by leave of the Board, and leave must be freely given when justice so requires. *See* Fed. R. Civ. P. 15(a). The Board may grant leave to amend the pleadings at any stage of the proceeding when justice so requires, unless the entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *Boral Ltd. v. FMC Corp.*, 59 USPQ 1701 (TTAB 2000). At this early state of the case, Under Armour would not be harmed if the Board granted leave for American Silver to amend its Answer. Accordingly, if the Board finds that American Silver’s defenses are not pled with requisite particularity or are otherwise insufficient, American Silver respectfully requests leave to file an Amended Answer to Under Armour’s Opposition.

CONCLUSION

For the reasons set forth herein, American Silver respectfully requests that Opposer’s Motion to Strike Affirmative Defenses be denied in its entirety. Under Armour has fair notice of

the basis for American Silver's defenses. Opposer will have plenty of opportunity to test the factual and legal merits of Applicant's defenses, as appropriate. No prejudice will occur if the Answer remains as it is. Accordingly, the Motion to Strike should be denied in its entirety. In the alternative, to the extent that the Board finds that Petitioners' defenses are insufficient or not pled with requisite particularity, American Silver requests that it be given leave to Amend its Answer to the Opposition.

DATED: October 2, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing AMERICAN SILVER, LLC'S RESPONSE TO OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES and this CERTIFICATE OF SERVICE were served on Opposer on this 2nd day of October, 2015, by e-mail to Opposer's counsel pursuant to stipulation of the parties as follows:

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