

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

BUO

Mailed: December 30, 2015

Opposition No. 91222404

Under Armour, Inc.

v.

American Silver, LLC

Benjamin U. Okeke, Interlocutory Attorney:

Now before the Board is Opposer's motion, filed September 8, 2015, to strike all of the affirmative defenses asserted by Applicant in its answer filed August 10, 2015. Opposer asserts that these defenses are "insufficient, immaterial, and redundant under Fed. R. Civ. P. 12(f)," and that striking the affirmative defenses would be "[i]n the interest of efficiency." 8 TTABVUE 2 AND 9.¹ Applicant contends that Opposer has been given "fair notice of the basis for [Applicant's] defenses," will face "no prejudice" and "will have plenty of opportunity to test the factual and legal

¹ Citations to the record are to TTABVUE, the docket history system for the Trademark Trial and Appeal Board. Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number. For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the TTABVUE docket entry number where such material or testimony is located should be included in any citation. See *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

merits of Applicant's defenses, as appropriate."² 10 TTABVUE 12-13. Applicant argues that its affirmative defenses have been pleaded sufficiently to the standards of the Federal Rules of Civil Procedure, or in the alternative should be considered amplifications of its denials. The motion has been fully briefed.³

The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. Therefore, the parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

The affirmative defenses at issue allege:

- 1) the notice of opposition fails to state a claim upon which relief can be granted;
- 2) the term ARMOUR is "highly diluted" and "exceptionally weak, and Opposer's purported rights extend no further, if at all, than to the specific marks" pleaded by Opposer;
- 3) public interest will be harmed if the notice of opposition is sustained;
- 4) Opposer's marks are not famous or did not become famous until after Applicant's first use of the involved mark;
- 5) the marks are dissimilar;
- 6) the goods or services are not related;
- 7) the applied-for mark "will not impair or harm any of Opposer's alleged trademark rights in any meaningful way;"

² Applicant's consent motion, filed on September 28, 2015, for extension of time to file a response to the motion to strike is noted and **GRANTED**.

³ Opposer's reply brief, filed October 22, 2015, is noted. However, the filing of reply briefs is discouraged, as the Board generally finds that reply briefs have little persuasive value and are often a mere reargument of the points made in the main brief. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000).

- 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 goods set forth” in the involved application;
- 9) estoppel, acquiescence, and failure to police; and
- 10) Applicant reserves its right to raise any affirmative defenses that may become available or apparent.

For the reasons set forth below Opposer’s motion is **GRANTED in part** and **DENIED in part**.

1) **Failure to State a Claim upon Which Relief Can be Granted.**

A defense alleging that a plaintiff has failed to state a claim upon which relief can be granted is an attack on the sufficiency of the plaintiff’s pleadings. The defense, when raised as an affirmative defense, is subject to a motion to strike, which sanctions the Board to determine the sufficiency of the pleadings. *See Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (*citing S.C. Johnson & Son Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973)).

To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an opposer need only allege such facts as would, if proved, establish that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

A. *Standing*

Opposer has sufficiently pleaded its standing by alleging ownership of thirty-four registrations for marks containing the term ARMOUR, with and without

design elements, and many including the term UNDER. However, of particular note are Registration Nos. 3392904,⁴ 3720012,⁵ 3766130,⁶ 3963256,⁷ 3970978,⁸ 4059967,⁹ and 4133248,¹⁰ all for the mark ARMOUR in standard character format, and Registration Nos. 3646904¹¹ and 3861988¹² for the marks ARMOURFUSION and ARMOURSIGHT, respectively, also in standard characters, and Registration Nos. 3501771,¹³ 3052160,¹⁴ and 3638277,¹⁵ for the mark UNDER ARMOUR, also in

⁴ Issued March 4, 2008, from an application filed May 2, 2005, for “[c]lothing, excluding golf clothing, namely, shorts, shirts, polo shirts, pants, jackets, vests and gloves,” in International Class 25.

⁵ Issued December 1, 2009, from an application filed September 12, 2008, for “[c]lothing, excluding golf clothing, namely, hooded sweat shirts, crew neck shirts, long sleeve shirts, pullover shirts, and sweat pants,” in International Class 25.

⁶ Issued March 30, 2010, from an application filed February 13, 2009, for “[p]rotective athletic cups,” in International Class 28.

⁷ Issued May 17, 2011, from an application filed March 1, 2010, for “[k]nee pads for athletic use,” in International Class 28.

⁸ Issued May 31, 2011, from an application filed September 12, 2008, for “[f]ootwear, excluding golf footwear,” in International Class 25.

⁹ Issued November 22, 2011, from an application filed April 21, 2011, for “[h]air accessories, namely, hair ties,” in International Class 26.

¹⁰ Issued April 24, 2012, from an application filed July 19, 2010, for “[c]lothing, excluding golf clothing, namely, headwear, hats, caps, baseball caps, beanies and bras,” in International Class 25.

¹¹ Issued June 30, 2009, from an application filed December 4, 2008, for “[s]unglasses,” in International Class 9.

¹² Issued October 12, 2010, from an application filed November 13, 2009, for “[e]yewear; sunglasses; lenses for sunglasses,” in International Class 9.

¹³ Issued September 16, 2008, from an application filed March 21, 2008, for “[b]ottled water,” in International Class 32.

¹⁴ Issued January 31, 2006, from an application filed November 26, 2003, for “[c]hin strap pads for use with protective helmets,” in International Class 9; “toiletry kits, sold empty,” in International Class 18; “sports bottles, sold empty,” in International Class 21; “[l]anyards for holding mouthpieces, water bottles, eyeglasses, badges, or keys,” in International Class 22; “sports towels,” in International Class 24; and “gloves,” in International Class 25.

¹⁵ Issued June 16, 2009, from an application filed September 17, 2008, for “[o]nline retail store services featuring apparel, footwear, sporting goods, eyewear, headwear, wrist bands, sweat bands, belts, gloves, hand-warmers, plastic water bottles sold empty, watches, sports bags, tote bags, travel bags, backpacks, messenger bags, duffel bags, shoe bags for travel, toiletry bags sold empty, wheeled bags, waist packs, sling bags, umbrellas, towels, posters; [m]obile retail store services featuring apparel, footwear, and sporting goods,” in International Class 35.

standard characters, (collectively “Opposer’s Marks”). 1 TTABVUE 20 and 25-29, ¶¶ 5, 19, and 21. Opposer’s claim of ownership of these registrations is sufficient to plead its standing, *i.e.* a personal interest in this proceeding. *See Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009); *Lipton Indus., Inc.*, 213 USPQ 185; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).¹⁶

B. Priority

Opposer attached copies of printouts from the USPTO’s electronic database records, showing current status and title of its pleaded registrations. *See* Trademark Rule 2.122(d)(1) (general rule that exhibits attached to pleadings are not evidence on behalf of the submitting party has two exceptions – current status and title copies, or photocopies of the pleaded registration(s) prepared by the USPTO, or current printouts of information from the electronic database records of the USPTO showing the current status and title of the registration(s)).

Accordingly, to the extent Opposer intends to rely on its pleaded registrations, priority is not an issue in this opposition. *See King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In other words, Opposer

¹⁶ Opposer also claims ownership of pending application Serial Nos. 85850855 and 85850816, both for the mark UNDER ARMOUR in standard characters, for “vitamin fortified beverages; protein supplements in the form of beverages; nutritionally fortified beverages; dietary supplemental drinks; dietary supplemental drinks in the nature of vitamin and mineral beverages,” in International Class 5; and “carbonated waters; drinking water with vitamins; energy drinks; flavored bottled water; fruit beverages; fruit drinks; fruit juices; herbal juices; isotonic beverages; isotonic drinks; smoothies; sports drinks,” in International Class 32. 1 TTABVUE 27-28, ¶ 20. Both applications were filed on February 15, 2013.

However, pending applications are evidence only that the applications were filed on a certain date; they are not evidence of use of the marks. *Nike Inc. v. WNBA Enters. LLC*, 85 USPQ2d 1187, 1193 n.8 (TTAB 2007); *Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).

need not prove (and therefore need not allege) that the marks in its registrations were “previously used ... and not abandoned” in order to prevail. *See* 15 U.S.C. § 1052(d).

Moreover, Opposer has also alleged that its marks were in use at least as early as 1996 and have been in continuous use. 1 TTABVUE 19, ¶ 2. This alleged date of use predates the constructive use date of the subject application – March 26, 2014.¹⁷ Therefore, Opposer has sufficiently pleaded its priority.

C. Likelihood Of Confusion

The notice of opposition alleges that the applied-for mark “so resembles [Opposer’s] prior used, filed, and/or registered ... [m]arks, as to be likely, when applied to Applicant’s goods, to cause confusion...” 1 TTABVUE 31, ¶ 27. However, Opposer’s reference to the marks being “applied to Applicant’s goods” is not sufficient to allege that the goods covered by the involved application are actually related to the goods and services covered by Opposer’s Marks. Therefore, Opposer’s claim of likelihood of confusion has been insufficiently pleaded. That is, Opposer has not alleged sufficient factual matter that, if proven, would entitle Opposer to the relief it seeks under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).¹⁸

¹⁷ The filing date of the application is the earliest date upon which Applicant could rely without proof by “competent evidence” of an earlier date of actual use. *See* Trademark Rule 2.122(b)(2) (the date of use in an application is not evidence on behalf of the applicant; “a date of use of a mark must be established by competent evidence”); *see also* *Coach Servs. Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1606 n.7 (TTAB 2010).

¹⁸ To state a claim of likelihood of confusion under Trademark Act Section 2(d), Opposer must allege facts from which it may be inferred that Applicant’s applied-for mark is similar to Opposer’s previously used or registered marks, and that the goods or services covered by those marks are related in such a way that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the parties’ respective goods or services. *See* 15 U.S.C. § 1052(d); *In re*

D. Dilution

However, paragraphs 16-18 and 29-31 of the notice of opposition allege sufficient facts that if proven would entitle Opposer to the relief that it seeks under Trademark Act Section 43(c), 15 U.S.C. § 1125(c), for dilution of its marks. That is, Opposer has alleged that its registered marks are well known and famous and that they attained such fame before Applicant's use of its mark, and that the applied-for mark is similar to its registered pleaded marks.

Inasmuch as Opposer has alleged that registration of Applicant's mark is likely to dilute the distinctive quality of Opposer's marks, it appears that Opposer's claim of dilution is sufficiently pleaded.¹⁹

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. *See also* Trademark Rule 2.116(a); TBMP § 506 (2014).

Therefore, Opposer's motion is **GRANTED** with respect to Applicant's affirmative defense asserting that the notice of opposition fails to state a claim upon which relief can be granted, inasmuch as it has been found that the notice of opposition sufficiently alleges a claim of dilution. Accordingly, paragraph 1 of the

E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); *see also* TMEP § 1207.01.

¹⁹ A claim of dilution under Section 43(c) of the Trademark Act requires a showing that: (1) Opposer's distinctive mark would be blurred or tarnished by use of Applicant's similar mark; (2) Opposer's mark is famous; and (3) Opposer's mark became famous prior to the earliest date of use (or constructive use) claimed by Applicant. *See* 15 U.S.C. 1125(c); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001).

section entitled “Affirmative Defenses” in the answer is **STRICKEN** and will be given no further consideration.

Additionally, it is the Board’s policy to allow amendment of pleadings found to be insufficient upon challenge under Fed. R. Civ. P. 12(b)(6), particularly where the challenged pleading is the initial pleading. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1208 (TTAB 1997). In view thereof, Opposer is allowed until **FIFTEEN DAYS** from the mailing date of this order to submit an amended notice of opposition repleading its likelihood of confusion claim, if possible, justified and appropriate. If Opposer fails to file an amended notice of opposition within the time allowed, its likelihood of confusion claim (*i.e.*, paragraphs 25-27) will be stricken from the notice of opposition with prejudice and will be given no further consideration. The proceeding would then go forward as to the operative pleadings, absent Opposer’s likelihood of confusion claim.

2) **“Affirmative Defense” Nos. 2 and 4-8**

The defenses advanced in paragraphs 2 and 4-8 of the section entitled “Affirmative Defenses” in the answer are not actually affirmative defenses. Instead, these are merely amplifications of Applicant’s denials with respect to Opposer’s allegations, and provide fuller notice of how Applicant intends to defend this opposition. *See Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999). Although these are not appropriate affirmative defenses, the Board does not find it necessary to strike this language from the answer.

Accordingly, Opposer's motion to strike is **DENIED** with respect to paragraphs 2 and 4-8 of the section entitled "Affirmative Defenses" in the answer.

3) **"Affirmative Defense" No. 10**

Applicant's tenth "affirmative defense" merely reserves Applicant's right to amend its answer to allege any additional affirmative defenses as may become available to Applicant. Similar to the prior discussion, although this is not an appropriate "affirmative defense," the Board does not find it necessary to strike this language from the answer.

Accordingly, Opposer's motion to strike is **DENIED** with respect to paragraph 10 of the section entitled "Affirmative Defenses" in the answer.

4) **Affirmative Defense No. 3**

Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ.*, 51 USPQ2d at 1292 (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"). A party must allege sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement,' to support its claims. *Cf. Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (*quoting Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)).

Applicant alleges that the "public interest will be harmed" if the opposition is sustained. However, Applicant has not provided sufficient factual background to support this defense. Indeed, the Board is left to guess the nature or manner of

public interest that will be harmed, and the extent to which such interest may in fact be harmed.

In any event, inasmuch as the defense has been insufficiently pleaded and deprives Opposer and the Board of the ability to expeditiously identify the issues it raises, Opposer's motion to strike is **GRANTED** with respect to paragraph 3 of the section entitled "Affirmative Defenses" in the answer; and affirmative defense no. 3 stands **STRICKEN** without prejudice.

5) Affirmative Defense No. 9

With respect to the affirmative defenses asserted in paragraph 9, advancing the equitable doctrines of estoppel, acquiescence and failure to police, Applicant has similarly failed to plead sufficient facts to support these defenses, and therefore, the defenses fail to place Opposer on notice of the basis of the defenses. *See Fed. R. Civ. P. 12(b)(6); Iqbal*, 556 U.S. at 663.²⁰

²⁰ Indeed, these equitable defenses are severely limited in opposition proceedings because the time for consideration of these defenses begins to run from the time the mark is published for opposition, not from the time of knowledge of use. *See Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008) (conduct which occurs prior to publication of application for opposition generally cannot support a finding of equitable estoppel); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding). For example, given the brief period allowed for filing an opposition, *see* Trademark Rule 2.101(c), laches would be all but impossible to prove. Moreover, these defenses must be pleaded with respect to conduct relating to Applicant and not third-parties.

To the extent that estoppel may be alleged in a way that is not time dependent, but instead turns on the plaintiff's conduct, Applicant has failed to sufficiently plead such a defense. *See Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 23 USPQ2d 1701 (Fed. Cir. 1992) ("The 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."); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 590-91 (TTAB 1977). Opposer may well have taken some action prior to or during the prosecution of the subject application that may directly have given Applicant the impression that Opposer did not

Accordingly, Opposer's motion to strike is **GRANTED** with respect to paragraph 9 of the section entitled "Affirmative Defenses" in the answer; and affirmative defense no. 3 stands **STRICKEN** without prejudice.

However, as previously stated, it is the Board's policy to allow amendment of pleadings found to be insufficient upon challenge. *See Intellimedia Sports Inc.*, 43 USPQ2d at 1208. In view thereof, Applicant is allowed until **FIFTEEN DAYS** from the service of any amended notice of opposition, if any, but not later than **THIRTY DAYS** from the mailing date of this order, to submit an amended answer repleading only its affirmative defense nos. 3 and 9, if possible, justified and appropriate.²¹ If Applicant fails to file an amended answer within the time allowed, its "public policy" and "estoppel, acquiescence and failure to police" defenses (paragraphs 3 and 9 of the section entitled "Affirmative Defenses" in the answer) will stand stricken

intend to assert its rights against the involved application. However, while such a claim is not categorically inapposite to the case, it nonetheless lacks factual support in the pleadings.

As to failure to police, however, (which appears to be the defense most closely implicated by the facts supplied by Applicant) such a "defense" is not appropriate inasmuch as it constitutes a collateral attack on Opposer's pleaded registrations. *See Trademark Rule 2.106(b)(2); Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007) (applicant's contentions in its brief that opposer's marks are functional, non-distinctive, and lack source-indicating significance constitute an impermissible collateral attack on opposer's pleaded registrations, and cannot be considered absent a counterclaim for cancellation).

Under Trademark Act Section 45(2), 15 U.S.C. § 1127, a mark is deemed to be abandoned when the course of conduct of the owner of the mark causes the mark to lose its significance as an indication of origin. *See Woodstock's Enter. Inc. (Cal.) v. Woodstock's Enter. Inc. (Or.)*, 43 USPQ2d 1440, 1445-46 (TTAB 1997). *Cf. Univ. Book Store v. Univ. of Wis. Board of Regents*, 33 USPQ2d 1385, 1393 (TTAB 1994) (citing *Wallpaper Mfrs., Ltd. v. Crown Wallcovering Corp.*, 680 F.2d 755, 214 USPQ 327, 336 (CCPA 1982) ("If there are numerous products in the marketplace bearing the alleged mark, purchasers may learn to ignore the 'mark' as a source indication. When that occurs, the conduct of the former owner, by failing to police its mark, can be said to have caused the mark to lose its significance as a mark.")). Thus, an allegation of "failure to police" one's mark is akin to a claim of abandonment of the mark. Nonetheless, Applicant has failed to at least allege to which of Opposer's thirty-four pleaded marks such a claim refers.

²¹ Applicant is cautioned to carefully consider the efficacy of maintaining these defenses in light of the explanation provided by the Board in this order.

with prejudice and will be given no further consideration. The proceeding would then go forward as to the operative pleadings, absent Applicant's defenses stricken by this order.

Schedule

The proceeding is **RESUMED**. The remaining conferencing, disclosure, discovery and trial dates are reset as follows:

Deadline for Discovery Conference	2/12/2016
Discovery Opens	2/12/2016
Initial Disclosures Due	3/13/2016
Expert Disclosures Due	7/11/2016
Discovery Closes	8/10/2016
Plaintiff's Pretrial Disclosures	9/24/2016
Plaintiff's 30-day Trial Period Ends	11/8/2016
Defendant's Pretrial Disclosures	11/23/2016
Defendant's 30-day Trial Period Ends	1/7/2017
Plaintiff's Rebuttal Disclosures	1/22/2017
Plaintiff's 15-day Rebuttal Period Ends	2/21/2017

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.