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

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Mailed: October 20, 2016

Opposition No. 91228113 -86703172

Kiss My Face, LLC

v.

Alicia Vaca

By the Trademark Trial and Appeal Board:

This case now comes before the Board for consideration of Opposer's motion (filed July 21, 2016) to strike Applicant's affirmative defenses and to suspend proceedings pending consideration of the motion. Applicant filed a response to Opposer's motion on August 5, 2016.[1]

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any "insufficient defense or any redundant, immaterial, impertinent or scandalous matter." *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a), and TBMP § 506 (2016). Motions to strike, however, are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp.*

[1] Applicant's response fails to indicate proof of service on Opposer as required by Trademark Rule 2.119. Applicant is advised that strict compliance with Trademark Rule 2.119 is required by Applicant in all future papers filed with the Board.

v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims not stricken). Nonetheless, the Board grants motions to strike in appropriate circumstances.

First Affirmative Defense

Turning to Applicant's First Affirmative Defense, Applicant alleges that the notice of opposition fails to state a cause of action upon which relief can be granted. As Opposer notes, this asserted defense is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of Opposer's claims rather than a statement of a defense to a properly pleaded claims. Thus, the asserted defense will not be treated as such. *See Hornblower & weeks Inc. v. Hornblower & weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

However, a motion to strike the defense of failure to state a claim upon which relief can be granted may be used by a plaintiff to test the sufficiency of its pleading in advance of trial. *Order of Sons of Italy in America*, 36 USPQ2d at 1222. Accordingly, in determining whether to strike Applicant's Affirmative Defense No. 1, it is necessary to look at the sufficiency of Opposer's pleading.

In order to withstand the assertion that a pleading fails to state a claim, a plaintiff need only allege such facts that would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing the mark. The allegations in the pleading must be construed liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the relief sought. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009); and TBMP § 503.02 (2016).

Upon careful review of the notice of opposition filed on April 12, 2016, the Board finds that the notice of opposition contains legally sufficient allegations which, if proven, would establish Opposer's standing and a legally sufficient claim of likelihood of confusion.[2]

In view thereof, Opposer's motion to strike Applicant's First Affirmative Defense is **GRANTED**, and said defense is hereby stricken.

Second Affirmative Defense

By its Second Affirmative Defense, Applicant merely alleges a lack of likelihood of confusion between Applicant's mark and Opposer's pleaded registrations. The defenses is merely a restatement of Applicant's denial of Opposer's allegations of likelihood of confusion. While the Board generally allows a defense that amplifies a

[2] Priority is not at issue in an opposition proceeding where the opposer pleads and proves that it owns a registration for its pleaded mark. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 n.7 (TTAB 2012) (there can be no priority dispute when an opposer properly introduces its registrations into the record and there is no counterclaim).

denial and gives the plaintiff fuller notice of defendant's position, Applicant's defense is redundant and does not add anything to the denial. *See Order of Sons of Italy in America* 36 USPQ2d at 1223 (defense stricken as redundant).

In view thereof, Opposer's motion to strike Applicant's Second Affirmative Defense is **GRANTED** and said defense is stricken from the answer.

Third, Fourth and Fifth Affirmative Defenses

Applicant's Third, Fourth and Fifth Affirmative Defenses relate to Opposer's allegations of damages in the notice of opposition. With respect Applicant's Third Affirmative Defense, Applicant's alleges that Opposer fails to state a case for cognizable damages. Damage in inter partes proceedings relates to a party's standing, i.e., real interest in the proceeding. Inasmuch as the Board has found, *supra*, that Opposer has sufficiently alleged its standing based on its claim of likelihood of confusion, Opposer's allegations that it would suffer some kind of damage as a result of Applicant's mark are also reasonably based thereon. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *see also, Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999) (belief in damage must have "reasonable basis").

With respect to the Fourth Affirmative Defense that Opposer's damages are speculative and cannot be ascertained with certainty, the allegation is immaterial and insufficient as a defense inasmuch as actual damage need not be pleaded or proved in an opposition proceeding. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (striking affirmative defense that petitioner will not be

damaged; there is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in opposition or cancellation proceeding).

With respect to the Fifth Affirmative Defense, Applicant has failed to allege any facts to support its allegation that, even if there is a likelihood of confusion between the marks, Applicant's registration of its mark is privileged and justified. Thus, Applicant has failed to provide Opposer with fair notice of the defense. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (for pleading purposes, Section 18 defense must be specific enough in nature to provide fair notice); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007).

Accordingly, the motion to dismiss Applicant's Third, Fourth and Fifth Affirmative Defenses is **GRANTED** and said defenses are hereby stricken.

Eighth and Ninth Affirmative Defense

Applicant's Eighth and Ninth Affirmative Defense consist of bald allegations that the opposition is barred by the doctrines of acquiescence (Eighth), and estoppel (Ninth).[3] Because Applicant's answer does not contain factual allegations to provide fair notice of the basis of these defenses, said defenses are insufficiently pleaded. *See Ideas One Inc.* 89 USPQ2d at 1953. In addition, the equitable defenses of

[3] A pleading of acquiescence requires allegations of the following: (1) that plaintiff actively represented that it would not assert a right or a claim; (2) that delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused the defendant undue prejudice. *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-5 (11th Cir 1991). In an opposition proceeding, an acquiescence defense starts to run from the time the mark is published for opposition and must be tied to the registration of the mark, not a party's use the mark. *See National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

acquiescence and estoppel are generally not available in an opposition proceeding. *See Bakery Inc. v. Landesman,* 82 USPQ2d 1283, 1292 n.14 (TTAB 2007); *see, e.g., Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-5 (11th Cir 1991) (acquiescence). In Board opposition proceedings, these defenses start to run from the time the mark is published for opposition, not from the time of knowledge of use. *See National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

Accordingly, the motion to dismiss Applicant's Eighth and Ninth Affirmative Defenses is **GRANTED** and said defenses are hereby stricken.

Sixth, Seventh, Tenth and Eleventh Affirmative Defenses

By the same token, Applicant's allegations that the opposition is barred by the applicable statute of limitations (No. 6); that Opposer failed to mitigate the alleged damages (No. 7); that the opposition is barred by the doctrine of unclean hands (No. 10)[4]; and that the opposition is barred by comparative fault (No. 11) are unsupported by facts that would provide Opposer with fair notice of the basis each defense. *See Ideas One Inc.*, 89 USPQ2d at 1953.[5]

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[4] A defense of unclean hands must be supported by specific allegations of misconduct by plaintiff that, if proved, would prevent the plaintiff from prevailing on its claim. *See Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories Inc.*, 5 USPQ2d 1067, 1069 (TTAB 1980). In addition, the misconduct must be related to the plaintiff's claim. *See Tony Lama Co., Inc. v. Di Stefano*, 206 USPQ 176, 179 (TTAB 1980); 6 McCarthy on Trademarks and Unfair Competition, § 31: 48 (4th ed. 2015).

[5] In addition, inasmuch as damages need not be pleaded or proved, mitigation of damages is not an available defense in Board opposition proceedings. In addition, comparative fault is a process by which courts sort out liability to trademark licensors in tort negligence cases. It

Accordingly, the motion to dismiss Applicant's Sixth, Seventh, Tenth and Eleventh Affirmative Defenses is **GRANTED** and said defenses are hereby stricken.

Twelfth Affirmative Defense

The Board notes that, as its Twelfth Affirmative Defense, Applicant has reserved the right to assert additional affirmative defenses as they are discovered. However, the assertion of the right to put forward additional defenses or counterclaims is an improper reservation under the Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923, F. Supp. 2d 1133, 1141 (N.D.Ill.2013) (reservation of right to add affirmative defenses at a later date is improper reservation under the Federal Rules). The proper way to plead additional affirmative defenses or counterclaims is to file a motion under Federal Rule of Civil Procedure 15. *Id.* In view thereof, the Board *sua sponte* **strikes** Applicant's Twelfth Affirmative Defense.

Summary

In summary, Opposer's motion to strike Applicant's pleaded affirmative defenses is **GRANTED** in its entirety. Additionally, the Board *sua sponte* **strikes** Applicant's Twelfth Affirmative Defense.

The Board generally grants leave to amend pleadings that have been found insufficient when justice so requires. *See generally* TBMP § 507.02 (2016). Accordingly, Applicant is allowed until FIFTEEN (15) DAYS from the mailing date of this order in which to file and serve an amended answer that states a legally sufficient defense of unclean hands, if Applicant can make the factual allegations that

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is not applicable as a defense in a Board inter partes proceeding where the Board determines registrability of the subject mark, not fault. Thus, these "defenses" are immaterial.

support such a defense, *see* Fed. R. Civ. P. 11, failing which this affirmative defense will remain stricken. The remainder of the stricken defenses are either immaterial to this proceeding or lack plausibility and the Board, in its discretion, finds that to allow Applicant the opportunity to amend such defenses at this time would serve no useful purpose. *See* Fed. R. Civ. P. 15 and Trademark Rule 2.107. *See* TBMP § 507.

Proceedings are resumed. Discovery and trial dates are reset as follows:

Deadline for Discovery Conference	**11/27/2016**
Discovery Opens	**11/27/2016**
Initial Disclosures Due	**12/27/2016**
Expert Disclosures Due	**4/26/2017**
Discovery Closes	**5/26/2017**
Plaintiff's Pretrial Disclosures	**7/10/2017**
Plaintiff's 30-day Trial Period Ends	**8/24/2017**
Defendant's Pretrial Disclosures	**9/8/2017**
Defendant's 30-day Trial Period Ends	**10/23/2017**
Plaintiff's Rebuttal Disclosures	**11/7/2017**
Plaintiff's 15-day Rebuttal Period Ends	**12/7/2017**

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD ("BOARD") RULES OF PRACTICE WILL BE **EFFECTIVE JANUARY 14, 2017**

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7 2016, at 81 F.R. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and ex parte appeal proceedings.

For complete information, the parties are referred to resources available on the Board's home page, https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab.

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by mail. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.

- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.101 and 2.111.

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.

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