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

Proceeding	91228113
Party	Plaintiff Kiss My Face, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Kiss My Face, LLC,)
)
Opposer,)
) Opposition No. 91228113
v.)
) U.S. Application Serial No. 86703172
Alicia Vaca,)
)
Applicant.)

**OPPOSER’S MOTIONS TO STRIKE APPLICANT’S AFFIRMATIVE
DEFENSES 1-11 AND TO SUSPEND PROCEEDINGS**

Opposer, Kiss My Face, LLC (“Opposer”) hereby moves pursuant to Fed. R. Civ. P. 12(f) and TBMP § 506 to strike the Applicant’s affirmative defenses 1-11 set forth in Applicant’s Answer dated July 4, 2016 (the “Answer”) as immaterial or insufficient claims.

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

MEMORANDUM IN SUPPORT OF MOTIONS

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.” TBMP 506.01; see also Fed. R. Civ. P. 12(f). On this basis, Opposer moves that Applicant’s affirmative defenses 1-11 in the Answer be stricken as immaterial and/or insufficient.

A. Applicant’s First Affirmative Defense – That the Notice of Opposition Fails to State Sufficient Facts to State a Cause of Action – is Not a True Affirmative Defense.

Applicant’s first affirmative defense of failure to state a claim upon which relief can be granted (Dkt. 5, ¶10) is not a true affirmative defense because it relates to an assertion of the

insufficiency of the pleading of Opposer's claim rather than a statement of a defense to a properly pleaded claim.

Paragraphs 3-5 of the Notice of Opposition allege that Opposer is the owner of multiple valid and subsisting federal registrations for the mark KISS MY FACE for personal care products. Paragraph 9 alleges that Applicant's KISS MY BUTTER mark so resembles Opposer's KISS MY FACE marks as to be likely, when used with Applicant's goods, to cause confusion, to cause mistake, or to deceive the trade and public, and that Opposer will be damaged by the registration of Applicant's KISS MY BUTTER mark. If proven, these allegations would establish Opposer's standing and a valid ground for opposing Applicant's mark. The Notice of Opposition is legally sufficient on its face. Applicant's first affirmative defense should be stricken.

B. Applicant's Sixth, Eighth, and Ninth Affirmative Defenses of Statute of Limitations, Acquiescence, and Estoppel Should Be Stricken as Immaterial.

Applicant's sixth affirmative defense is the allegation that this proceeding is barred by the "applicable statute of limitations." (Dkt. 5, ¶15.) Applicant has not indicated which statute of limitations it contends applies to the institution of an opposition proceeding. Regardless, Opposer timely instituted this proceeding. Applicant's sixth affirmative defense is vague and immaterial and should be stricken.

Applicant's eighth and ninth affirmative defenses are acquiescence and estoppel. (Dkt. 5, ¶¶ 17-18.) These defenses are severely limited in opposition proceedings because the relevant time period for the purposes of these defenses is not measured from when an applicant begins using its mark but, rather, from when a mark is published for opposition because that is 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”); *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).

Here, the short time period between the publication of the application at issue and the filing of the Notice of Opposition is insufficient as a matter of law to constitute an unreasonable delay for the purposes of acquiescence or estoppel. *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). As such, Applicant’s eighth and ninth affirmative defenses of acquiescence and estoppel are immaterial and should be stricken.

C. Applicant’s 2-5 and 7-11 Affirmative Defenses Fail to Allege Sufficient Facts and/or are Mere Restatements of Applicant’s Denials of Opposer’s Allegations.

Applicant’s 2-5 and 7-11 affirmative defenses should be stricken for the reason stated in the chart below:

	Defense	Ground(s) to Strike Defense
Dkt. 5, ¶11	<u>Second Affirmative Defense:</u> Applicant alleges the lack of a cognizable likelihood of confusion between Applicant’s trademark and Opposer’s trademarks.	Mere restatement of Applicant’s denial of paragraph 9 of the Notice of Opposition.
Dkt. 5, ¶12	<u>Third Affirmative Defense:</u> Applicant alleges that the Notice of Opposition fails to state a case for cognizable damages upon which relief can be granted.	Mere restatement of Applicant’s denial of paragraph 9 of the Notice of Opposition. Failure to allege sufficient facts to support this defense and provide fair

		notice of the basis of the defense.
Dkt. 5, ¶13	<u>Fourth Affirmative Defense:</u> Applicant alleges that Opposer's damages, as alleged against Applicant in the Notice of Opposition, are speculative and cannot be ascertained with certainty.	Mere restatement of Applicant's denial of paragraph 9 of the Notice of Opposition. Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.
Dkt. 5, ¶14	<u>Fifth Affirmative Defense:</u> Applicant denies liability for Opposer's alleged damages, as Applicant's actions are privileged and justified.	Mere restatement of Applicant's denial of paragraph 9 of the Notice of Opposition. Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.
Dkt. 5, ¶16	<u>Seventh Affirmative Defense:</u> Applicant alleges that the Opposer failed to mitigate alleged damages	Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.
Dkt. 5, ¶17	<u>Eighth Affirmative Defense:</u> Applicant alleges that the Opposition is barred by the doctrine of acquiescence.	Immaterial. Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.
Dkt. 5, ¶18	<u>Ninth Affirmative Defense:</u> Applicant alleges that the Opposition is barred by the doctrine of estoppel.	Immaterial. Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.
Dkt. 5, ¶19	<u>Tenth Affirmative Defense:</u> Applicant alleges that the Opposition is barred by the doctrine of unclean hands.	Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.
Dkt. 5, ¶20	<u>Eleventh Affirmative Defense:</u> Applicant alleges that the Opposition is barred by comparative fault.	Failure to allege sufficient facts to support this defense and provide fair notice of the basis of the defense.

As indicated in TBMP § 300, “[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). See also, *Hiesch v. Katy Bishop Prods., Inc.*, 45 U.S. P.Q.2d 1219, 1221 (N.D. Ill. 1997) (affirmative defenses of waiver and estoppel stricken on the ground that they consisted of mere conclusory allegations); *Illini Dairy Queen, Inc., et al. v. McCullough's Dairy Queen*, 115 U.S.P.Q. 18, 21 (Comm'r of Patents 1957) (“estoppel must be pleaded with particularity and precision, every essential fact being set forth, for nothing can be supplied by inference or intendment ... The pleading must be certain in every particular, and to every intent, or no estoppel can be adjudged.”). Here, where no facts whatsoever are stated, there can be no question that Opposer has not received notice as to Applicant’s basis for these defenses and, accordingly, they must be stricken.

Applicant’s tenth affirmative defense (Dkt. 5, ¶ 19) 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 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 principal 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).

Thus, 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”); *Reid-Ashman Mfg. v. Swanson Semiconductor Serv., LLC*, 2007 U.S. Dist. LEXIS 37665, *18 (N.D. Cal. 2007) (unclean hands defense subject to Rule 9 since inequitable conduct 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 Fed. R. Civ. P. 9.

In sum, since Applicant has failed to allege any facts or specific conduct in support of these affirmative defenses that would, if proven, prevent Opposer from prevailing on its claims, Applicant’s 2-5 and 7-11 affirmative defenses should be stricken as insufficient and/or mere restatements of Applicant’s denial of the allegations of the Notice of Opposition.

CONCLUSION

For the foregoing reasons, Applicant’s 1-11 affirmative defenses should be stricken. Moreover, the proceeding should be suspended pending consideration of Opposer’s motion, and the deadlines for the initial discovery conference, discovery and trial should be reset accordingly.

Date: July 21, 2016

Respectfully submitted,

/s/ Carrie A. Johnson

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on July 21, 2016, I caused a true and correct copy of the foregoing Opposer's Motion to Strike Applicant's Affirmative Defenses 1-11 and to Suspend Proceedings to be sent via First Class Mail, postage prepaid, to Applicant's Attorney/Correspondent of Record:

The Winston Bertani Law Group
Attention: Pamela Winston Bertani, Esq.
728 Texas St.
Fairfield, CA 94533-5560

Date: July 21, 2016

/s/ Carrie A. Johnson
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