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

Proceeding	91228288
Party	Plaintiff ALK-Abello A/S
Correspondence Address	B. Brett Heavner Finnegan Henderson Farabow Garrett & Dunner, LLP 901 New York Avenue, NW Washington, DC 20001 UNITED STATES docketing@finnegan.com, b.brett.heavner@finnegan.com, TTAB-Legal-Assistants@finnegan.com
Submission	Other Motions/Papers
Filer's Name	B. Brett Heavner
Filer's e-mail	docketing@finnegan.com, b.brett.heavner@finnegan.com, samuel.eichner@finnegan.com, TTAB-Legal-Assistants@finnegan.com
Signature	/B. Brett Heavner/
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**B. “Amplification” Requires More Than Mere Reiteration of Denials**

Applicant asserts that both of its affirmative defenses are proper because they amplify its denials of the allegations in the notice of opposition. However, while amplifications of denials may *sometimes* be allowed, this is only where they do not prejudice Opposer and where they provide more complete notice of how Applicant intends to defend against an opposition. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (“Thus, the Board, in its discretion, 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.” (emphasis added))

The Board applied this test in *Order Sons of Italy in Am.*, 38 USPQ2d 1602 (TTAB Feb. 28, 1996), where Petitioner alleged a mark was disparaging, and Registrant denied the supporting allegations while also pleading the following affirmative defense:

(2) Applicant has a right under the pertinent international treaties to register its mark in the United States, notwithstanding any alleged inconvenience or morally obtuse perception that the mark may have with a small segment of the country's population.

*Order Sons of Italy in Am.*, 38 USPQ2d 1602 (TTAB Feb. 28, 1996)

The Board noted that “applicant is asserting that its mark would not be viewed as disparaging by other than a small segment of the population, rather than the requisite substantial composite,” an argument that goes beyond mere denial of an allegation of disparagement. *Id.* While the denial itself left Applicant’s position unclear, Applicant’s affirmative defense amplified that denial by stating its position, which went beyond mere denial that the mark was disparaging, to argue that an appreciable portion of the relevant population would not find it disparaging. Further still, that defense raised the

issue of whether international law would allow registration of an otherwise disparaging mark. Such embellishment is precisely the sort of “amplification” of denials that is permitted by the Board in the form of an “affirmative defense.” TBMP § 506.01.

Thus, the key inquiry to the propriety of Applicant’s affirmative defenses is whether they actually embellish or provide fuller explanations for its denials of the allegations of the notice of opposition.

**C. Applicant’s First Affirmative Defense Does Not Amplify Its Denials Of The Similarity Of The Marks Because It Adds Nothing To Those Denials**

Applicant claims that its first affirmative defense—that the marks are sufficiently different to avoid likely confusion—amplifies its position “that there is no likelihood of confusion.” Opp. Br. at 3. Yet Applicant cannot credibly argue that its first affirmative defense provides “fuller” notice of any factual explanation of its position. See *Ohio State Univ.*, 51 USPQ2d at 1292 (objectionable pleadings permitted only where they provide “fuller notice of the basis for a claim or defense.”)

Opposer is aware that Applicant denies the similarity of the marks at issue. See Not. of Opp., TTABVUE 1, at ¶ 9 ; see also Answer, TTABVUE 6, at ¶ 9. Specifically, Applicant denies the assertion that AEK “is identical to Opposer’s ALK mark except for the substitution of the letter E for the letter L.” See *id.* Applicant, by restating this denial in the form of an affirmative defense, does not give Opposer notice of anything more than Applicant’s denials of paragraphs 9, 10, and 12 of the Notice of Opposition.

In short, this “affirmative defense” must be stricken because it does not provide Opposer with notice of any defense or theory beyond the mere denials contained in

Applicant's answer, and because it is clearly redundant of those denials. See *Order Sons of Italy*, 36 USPQ2d 1221,1223 (TTAB 1995).

**D. Applicant's Second Affirmative Defense Does Not Amplify Its Denial Of The Similarity Of The Marks Because It Does Not Plead a Legal Defense**

Applicant claims in its second affirmative defense that the Opposition is barred by waiver, estoppel, unclean hands, and/or acquiescence. Applicant argues that this affirmative defense "puts Opposer on notice that the defense may be relied upon to support its position that there is no likelihood of confusion." Opp. Br., TTABVUE 8, at 3 (emphasis added). Yet Applicant's assertion lacks foundation in the law, as none of the equitable remedies pled in Applicant's second affirmative defense can prove or disprove confusion, a squarely legal issue. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1365 (Fed. Cir. 2012); *Holmes v. Allison Mfg. Corp.*, 865 F.2d 269 (Fed. Cir. 1988).

Moreover, these remedies are "generally are not available in opposition proceedings." See *Great Adirondack Steak & Seafood Cafe, Inc.*, 91219162, 2015 WL 9906660, at \*5 (Mar. 30, 2015) (citing *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007)). Certainly, such remedies are unavailable absent any factual support, and Applicant has not provided any such support. See *id* ("Affirmative defenses, like claims in a notice of opposition or petition for cancellation, must be supported by enough factual background and detail to fairly place the claimant on notice of the basis for the defenses."); see also *The Worlds Pageants, LLC & Camila Prods. Ltd.*, 91200183, 2016 WL 4437725, at \*2 (Aug. 3, 2016) (NOT PRECEDENTIAL) (striking unclean hands defense for lack of factual support); see also *Bell Atlantic v.*

*Twombly*, 550 U.S. 554, 570 (2007) (fair notice of the basis for a claim or defense is required by Rule 8).

Applicant's arguments of waiver, estoppel and acquiescence are inapposite where default rules of trademark practice prescribe the time to file an adversarial proceeding, and where Opposer has timely filed such proceeding. See e.g. *Panda Travel Inc. v. Resort Option Enters. Inc.*, 94 USPQ2d 1789, 1797-98 (TTAB 2009). Further a single bare reference to "unclean hands" cannot be said to "amplify" a denial when none of the preceding denials include any facts that would give rise to an "unclean hands" defense. The pleadings are completely devoid of any alleged improper conduct by Opposer that would support such an equitable defense. Against this backdrop, Applicant must allege something more if its claims are to provide notice of a non-frivolous defense. Here, Applicant has not done so, and so its second affirmative defense must be stricken.

#### **E. Opposer Is Prejudiced By Applicant's "Affirmative Defenses"**

Opposer is prejudiced by Applicant's affirmative defenses because it must expend additional resources to address them, which will lead to "unnecessary forays into immaterial matters." *In re Gabapentin Patent Litig.*, 648 F. Supp. 2d 641, 647 (D.N.J. 2009). As one court explained, "[t]he possibility that issues will be unnecessarily complicated or that superfluous pleadings will cause the trier of fact to draw unwarranted inferences at trial is the type of prejudice that is sufficient to support the granting of a motion to strike." *Benham v. Am. Servicing Co.*, 2009 WL 4456386, \*8 (N.D. Cal. 2009). Specifically, as long as these affirmative defenses remain in the



**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing OPPOSER'S REPLY IN SUPPORT OF ITS MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES was served on December 8, 2016 via first class mail, postage prepaid, on counsel for Applicant at the following address of record:

Robert L. Brewer, Esq.  
Paige W. Mills, Esq.  
Martha B. Allard, Esq.  
BASS, BERRY & SIMS PLC  
150 Third Avenue South, Suite 2800  
Nashville, Tennessee 37201

/Judy Valusek/  
Trademark Legal Assistant