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

Proceeding	91228577
Party	Defendant Solskyn Personal Care LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of:

Application Serial No. **86749213**
For the Mark **SOLSKYN**
Published in the Official Gazette on February 23, 2016

ANSELL LIMITED, Opposer, v. **SOLSKYN PERSONAL CARE LLC**, Applicant.	Opposition No. **91228577**

APPLICANT'S MOTION TO STRIKE AFFIRMATIVE DEFENSES
WITH BRIEF IN SUPPORT

Applicant SolSkyn Personal Care LLC ("SolSkyn") moves to strike Ansell Limited's ("Ansell") first eight affirmative defenses to SolSkyn's counterclaims, pursuant to TBMP § 506 and Fed. R. Civ. P. 12(f). The defenses are bald, conclusory allegations with no factual support and are otherwise improperly asserted against SolSkyn. They do nothing to put SolSkyn on notice of the alleged grounds for these defenses.

Further, the Board's determination of this Motion to Strike bears upon the scope of discovery and how the parties will expend their time (and the Board's resources) in this proceeding with regard to testimony, argument, and briefing. Therefore, for good

cause shown, SolSkyn also respectfully requests that the Board exercise its discretion to suspend this proceeding pending consideration of the relief requested in this Motion, and that the deadlines for discovery and trial be reset once the Board rules upon the Motion.

BACKGROUND AND PROCEDURAL HISTORY

On September 7, 2015, SolSkyn filed an intent-to-use application for the mark SOLSKYN (Ser. No. 86749213) in connection with a number of sunblock manufacturing services[1] in International Class 3, which was published for opposition on February 23, 2016. On June 22, 2016, Ansell filed a Notice of Opposition against the SOLSKYN application.

In its Notice of Opposition, Ansell, relying on two registrations it owns for the SKYN mark, contends that the SOLSKYN mark, if registered with the specified sunblock manufacturing services, is likely to be confused with Ansell's SKYN mark, even though the SKYN mark is registered in connection with condoms and sexual lubricants (Reg. Nos. 3525372; 4910850). In response, on August 2, 2016, SolSkyn filed its Answer and Counterclaims to Ansell's Notice of Opposition. By way of its Counterclaims, SolSkyn seeks to cancel Ansell's two SKYN registrations based on Ansell's fraud upon the USPTO and, as to Reg. No. 4910850, because the SKYN mark is merely descriptive of the associated sexual lubricant goods.

Specifically, SolSkyn contends that, as the USPTO stated in an office action

[1] Specifically, Manufacturing services for others in the field of after-sun gels, after-sun lotions, after-sun milks, after-sun oils, indoor sun tanning preparations, self-tanning preparations, spf sun block sprays, sun block, sun block preparations, sun screen, sun screen preparations, sun-block lotions, sun-tanning oils and lotions, sun-tanning preparations, suntan creams, tanning and after-sun milks, gels and oils.

during the prosecution of Reg. No. 4910850, the SKYN mark is phonetically equivalent to the word "skin" and is an intentional misspelling of that word, rendering the mark merely descriptive because Ansell's sexual lubricant goods are applied to one's skin. For example, Ansell uses the tag line "For That SKYN-TO-SKYN Sensation" for its sexual wellness goods. *See generally* Appl. Countercls.

SolSkyn contends that, in its effort to secure Reg. No. 4910850, Ansell made a false representation to the USPTO with the intent of deceiving the USPTO into believing that the SKYN mark is not a misspelling of the word "skin" and is not merely descriptive of the associated sexual lubricant goods applied to a person's skin. SolSkyn further alleges that Ansell's response to the office action constitutes a material misrepresentation that caused the USPTO to withdraw its refusal under Section 2(e)(1) and grant Ansell Reg. No. 4910850 for the SKYN mark. SolSkyn also alleges that by intentionally referring to and relying upon the translation for the "skyn" term in Ansell's Reg. No. 3525372 (for condoms) in the aforementioned office action response, Ansell also made that earlier SKYN registration an instrument of its fraud upon the USPTO. In sum, SolSkyn's counterclaims request that both registrations be cancelled. *See generally* Appl. Countercls.

On August 24, 2016, Ansell filed its Answer to SolSkyn's counterclaims. In its Answer, Ansell asserts the following eight affirmative defenses:

1. The doctrine of laches;
2. The doctrine of estoppel;
3. The doctrine of waiver;
4. The doctrine of acquiescence;
5. The doctrine of unclean hands;

6. Failure to state a claim upon which relief may be granted;
7. Failure to plead fraud with particularity; and
8. Failure to plead fraud pursuant to *DaimlerChrysler Corp. v. American Motors Corp.*, 94 U.S.P.Q.2d 1086 (TTAB 2010).

The first five affirmative defenses are boilerplate, conclusory defenses that are of the type routinely struck by the Board. The sixth defense (failure to state a claim) is a defense that is improper for this TTAB proceeding. Moreover, the Board can easily ascertain that SolSkyn's counterclaims properly state claims for relief. Likewise, because SolSkyn's counterclaim for fraud is pled with particularity, the seventh and eighth defenses should be struck, too.

ARGUMENT AND CITATION TO AUTHORITY

SolSkyn acknowledges that motions to strike are not favored. TBMP § 506.01. This principle, however, typically applies in situations where the insufficiency of an affirmative defense is not apparent and the defense otherwise raises factual issues that amplify the defending party's allegations or otherwise clearly raises a factual dispute to be resolved on the merits. *Id.* Here, however, Ansell's bare bones affirmative defenses do nothing to inform SolSkyn or the Board of legitimate factual issues that require discovery or resolution on the merits. Rather, each of Ansell's first eight affirmative defenses constitutes an "insufficient defense, or . . . immaterial, impertinent . . . matter" that should be struck pursuant to Fed. R. Civ. P. 12(f). *See Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 U.S.P.Q.2d 1313, 1314 (TTAB 1992); TBMP § 506 n.7 (listing cases in similar circumstances where motion to strike was granted).

I. The first five defenses are conclusory and should be stricken.

Because Ansell pleads no facts in support of its first five affirmative defenses, these affirmative defenses should be stricken under TBMP § 506 and Fed. R. Civ. P. 12(f). Affirmative defenses must be supported by enough factual background and detail to fairly place the claimant on notice of the basis for the defenses. *See Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1292 (TTAB 1999); *accord* TBMP § 311.02(b). Bald, conclusory allegations that are not supported by any facts should, therefore, be stricken. *See Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc.*, 5 U.S.P.Q.2d 1067, 1069 (TTAB 1987); *see also Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (naked assertions devoid of factual enhancement are insufficient).

Ansell's first five affirmative defenses (laches, estoppel, waiver, acquiescence, and unclean hands) are each bald, conclusory allegations, unsupported by any facts. *See Midwest Plastic Fabricators*, 5 U.S.P.Q.2d at 1069. Moreover, Ansell's affirmative defense of unclean hands is not pleaded with the requisite level of particularity. *See 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"). In sum, none of these defenses put SolSkyn on notice of Ansell's purported grounds for each defense. And they do not otherwise amplify Ansell's claims or defenses in this proceeding in any way. Therefore, it would be improper to allow these defenses to remain within the scope of this proceeding. They should be stricken.

II. Ansell's sixth affirmative defense is improperly raised and without merit.

An assertion that a pleading fails to state a claim upon which relief can be granted is not a true affirmative defense because it relates to an assertion of the insufficiency of a pleading rather than a statement of a defense to a properly pleaded claim. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1738 n.7 (TTAB 2001). This defense may be resolved via a motion to strike. *Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222-23 (TTAB 1995).

Moreover, SolSkyn need only allege facts sufficient, if proved, to establish that: 1) it has standing to bring its counterclaims; and 2) a valid ground exists for cancelling the issued SKYN registrations. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (CCPA 1982). Ansell fails to allege in its sixth affirmative defense any facts to demonstrate that SolSkyn has not met these elements. Indeed, a review of SolSkyn's counterclaims would demonstrate that both of these elements are met here. *See generally* Appl. Countercls.

The reality is that Ansell has stated its sixth affirmative defense without any basis in fact. This defense, like the others discussed above, does nothing to inform SolSkyn or the Board about Ansell's grounds to defend against SolSkyn's counterclaims. Therefore, it, too, should be stricken.

III. Ansell's seventh and eighth affirmative defenses are baseless.

Ansell alleges, in its seventh and eighth affirmative defenses, that SolSkyn has not pled its counterclaim for fraud with particularity. Yet, Ansell does not set forth a single factual assertion in those defenses to explain what, if anything, is missing from

SolSkyn's counterclaim for fraud.

In reality, SolSkyn has met the pleading standard for its counterclaim for fraud in accordance with *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009). A review of SolSkyn's counterclaim and the factual allegations supporting it demonstrate that SolSkyn has alleged that, in connection with its application to register the SKYN mark for sexual lubricant goods, Ansell knowingly made a specific false, material representation of fact as to the genesis of the SKYN mark, with the intent of obtaining a registration to which it was not otherwise entitled. Paragraphs 25-28 of SolSkyn's counterclaims make these allegations quite explicitly. Moreover, the factual allegations recited at Paragraphs 1 – 24 of the counterclaims provide detailed factual support to meet the heightened pleading standard set forth in the *Bose* decision.

Having alleged nothing at all that would contradict the above, Ansell's seventh and eighth affirmative defenses cannot be maintained. They should be stricken as well.

CONCLUSION

For the foregoing reasons, SolSkyn respectfully requests that Ansell's first eight affirmative defenses be stricken under TBMP § 506 and Fed. R. Civ. P. 12(f).

Further, to ensure that discovery and the parties' (and Board's resources) in this proceeding are not expended upon matters raised in these eight groundless affirmative defenses, SolSkyn also respectfully requests that, for good cause shown, the Board exercise its discretion to suspend this proceeding pending its resolution of this Motion, and that the deadlines for discovery and trial be reset once the Board rules upon the Motion.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that, on September 13, 2016, a copy of the foregoing pleading was sent via United States Mail to Opposer Ansell Limited's counsel of record, as follows:

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