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

Proceeding	91228578
Party	Defendant Solskyn Personal Care LLC
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Date	10/24/2016
Attachments	91228578 Reply re Motion to Strike.pdf(114504 bytes)

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

In the matter of:

Application Serial No. **86749204**
For the Mark **SOLSKYN**
Published in the Official Gazette on February 23, 2016

ANSELL LIMITED, Opposer, v. **SOLSKYN PERSONAL CARE LLC**, Applicant.	Opposition No. **91228578**

REPLY IN SUPPORT OF
APPLICANT'S MOTION TO STRIKE AFFIRMATIVE DEFENSES

In its opposition brief, Opposer Ansell Limited ("Ansell") relies upon three well-known opinions of this Board to assert that Ansell's affirmative defenses should not be stricken from this proceeding. In each opinion, however, the Board did, in fact, grant a motion to strike. And, as explained below, the Board's reasoning in those cases is the very same rationale advanced by Applicant SolSkyn Personal Care LLC ("SolSkyn") here.

In sum, Ansell's defenses are bald, conclusory allegations with no factual support. They (and Ansell's opposition brief) do nothing to put SolSkyn on notice of Ansell's alleged grounds for these defenses. Not striking these defenses would

certainly prejudice SolSkyn by allowing a groundless expansion of the scope of discovery, testimony, argument, and briefing, as well as materially impact the Board's resources in resolving the same. Therefore, as the Board has ruled in similar situations in the past, SolSkyn respectfully requests that its Motion to Strike be granted.

ARGUMENT AND CITATION TO AUTHORITY

Ansell relies upon the Board's precedent for the proposition that Ansell's affirmative defenses should not be stricken "unless it is clear that [they have] no possible bearing upon the subject matter of the litigation, and that [their] inclusion shall prejudice [SolSkyn]." (Opp.'s Mot., p. 3). A complete reading of the Board's decisions would illustrate that this is not the entirety of the Board's consideration when evaluating a motion to strike.

An affirmative defense will always have some theoretical bearing upon the claim at issue. Therefore, as the authority cited by both parties demonstrates, the real analysis the Board undertakes is whether there are sufficient factual underpinnings to the defenses that would fairly place the claimant on notice of the basis for the defenses, and also whether the defenses are otherwise permissible as a matter of law. When this standard is not met, the Board routinely strikes deficient and improper defenses to avoid the mischief and burden such defenses might create later in the proceeding – namely, broader and more expensive discovery, testimony, argument, and briefing than what is actually merited by the actual dispute before the Board. Those same considerations are present here.

I. Ansell's affirmative defenses should be stricken as they allege absolutely no factual grounds relevant to the issues in the case.

Ansell cites *Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1292 (TTAB 1999) to argue against the striking of its defenses. In *Ohio Univ.*, however, the Board refused to strike certain paragraphs in a pleading because they contained factual allegations that "suppl[ied] the necessary factual basis for applicant's claims of fraud . . . ." *Id.* at 1293. Likewise, the Board refused to strike certain affirmative defenses because they provided factual support for dates of first use of the trademark at issue. *Id.* at 1293-1294.

Likewise, in the *Harsco Corp. v. Electrical Sciences Inc.*, 9 U.S.P.Q.2d 1570, 1572 (TTAB 1988), case cited by Ansell, the Board refused to strike certain affirmative defenses because they were well supported by factual allegations and "g[a]ve respondent a more complete notice of petitioner's claim." Also, in the *Order Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222-23 (TTAB 1995), case relied upon by Ansell, because the affirmative defense sought to be stricken set forth a factual allegation concerning the perspective of a "reasonable prudent buyer," the Board found it to be an "amplification of applicant's denial of opposer's claims," and denied the motion to strike it.

As noted in the *Harsco* case, "[i]f evidentiary facts are pleaded, and they aid in giving a full understanding of the [pleading] as a whole they need not be stricken." 9 U.S.P.Q.2d at 1571 (citing 2A *Moore's Federal Practice*, Section 12.21[2] (2nd ed. 1985)). By contrast, Ansell's eight affirmative defenses are, as follows:

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 insufficiency of each of these affirmative defenses *is* apparent. These defenses do not raise factual issues that amplify Ansell's allegations. Nor do they raise a factual dispute to be resolved on the merits. Indeed, there is not a single iota of factual support for any of these defenses. Ansell does not provide SolSkyn with fair notice of any actual basis for each defense. These defenses, therefore, should be stricken.

II. Ansell's affirmative defenses are also improperly raised.

Notwithstanding the clear prejudice presented by Ansell's affirmative defenses, it is well established that the Board will strike improperly raised defenses. For example in the *Ohio Univ.* case relied upon by Ansell, the Board struck the affirmative defenses of estoppel and laches as impermissible and unavailable in the opposition proceeding before it. 51 U.S.P.Q.2d at 1294. Likewise, in the *Harsco* case relied upon by Ansell, the Board struck an affirmative defense that "would have no effect on the outcome of th[e] proceeding . . . ." 9 U.S.P.Q.2d at 1572. Similarly, in the *Profumi Fratelli Nostra AG* case, the Board struck the affirmative defense of failure to state a claim when the pleading was, in fact, "legally sufficient in stating a claim . . . ." 36 U.S.P.Q.2d at 1223.

Here, in addition to being factually inadequate, Ansell's sixth, seventh, and eight affirmative defenses have also been raised improperly. As to Ansell's sixth affirmative

defense of failure to state a claim, SolSkyn has alleged 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's affirmative defense and opposition brief fail to allege otherwise.

Likewise, Ansell states, in its seventh and eighth affirmative defenses, that SolSkyn has not pled its counterclaim for fraud with particularity. 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). Indeed, Ansell does not set forth a single factual assertion in those defenses or in its opposition brief to explain what, if anything, is missing from SolSkyn's counterclaim for fraud.

All three of these defenses should be stricken on these grounds, too.

III. Ansell should not be granted leave to replead its affirmative defenses.

If Ansell truly had meritorious affirmative defenses, one would expect that it would have presented some factual allegations in support of them in its Answer. It did not. At a minimum then, one would expect that Ansell would have supplied the missing factual bases for its affirmative defenses in its opposition brief. It did not. Given this clear indication that Ansell has no grounds for its affirmative defenses, it has not demonstrated any good cause to permit the filing of amended affirmative defenses

at this time.[1] Its request to amend its Answer is improper, would only serve to unnecessarily delay this proceeding if granted, and, therefore, should be denied.

CONCLUSION

As noted in the *Harsco* case, additional factual allegations, even if immaterial, "need not be stricken if their presence in the pleading cannot prejudice the adverse party." U.S.P.Q.2d at 1571. Here, by contrast, Ansell has set forth eight bald, conclusory defenses that do nothing to inform SolSkyn of Ansell's position, but rather these defenses serve only to unjustifiably expand the scope and expense of discovery, testimony, briefing, and this proceeding overall.

In sum, all of Ansell's affirmative defenses are groundless, improperly raised, and prejudicial. They should be stricken consistent with the Board's practice in similar circumstances under TBMP § 506 and Fed. R. Civ. P. 12(f).

[1] Of course, Ansell could always seek leave to amend its Answer consistent with the TBMP later in the proceeding if it believes it has proper grounds to do so.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that, on October 24, 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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