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

Proceeding	91236481
Party	Plaintiff HRHH IP, LLC
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Date	04/12/2018
Attachments	HRHH - Reply to Pinnacle Opposition to M2Strike.pdf(148338 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Matter of Application No. 87/088,678 for the mark: **AMERICAN VINYL** in Class 41 HRHH IP, LLC, Opposer, vs. PINNACLE ENTERTAINMENT, INC., Applicant.	Opposition No. 91-236481 **OPPOSER HRHH IP LLC'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO STRIKE CERTAIN AFFIRMATIVE DEFENSES**

I. INTRODUCTION

Opposer HRHH IP, LLC ("Opposer") hereby files its reply to Pinnacle Entertainment, Inc.'s ("Applicant") opposition to Opposer's motion to strike.

Applicant's brief does not dispute the authorities cited by Opposer, arguing only that the Board has the discretion to allow certain alleged affirmative defenses. Yet, Applicant's brief fails to provide any adequate reason for the Board to do so.

Applicant's first, second, fourth, sixth, seventh and eighth affirmative defenses are either improper, insufficient, or redundant, acting as unnecessary clutter that will only waste the parties' time and expense before and at trial. Any alleged notice provided by these superfluous and unfounded defenses cannot be considered fair under FRCP 8(c) and TBMP §311.02 where the allegations do not, and cannot, support the elements required for the respective defense. Striking Applicant's first, second, fourth, sixth, seventh and eighth affirmative defenses will not

prejudice Applicant in any way, as Applicant will have ample opportunity to fully argue its denials of Opposer's material allegations at trial.

Accordingly, the Board should strike Applicant's subject affirmative defenses to expedite this proceeding and avoid the unnecessary prejudice, time, and expense imposed on HRHH by Applicant's extraneous and boilerplate affirmative defenses.

II. THE BOARD SHOULD STRIKE APPLICANT'S FIRST AFFIRMATIVE DEFENSE OF FAILURE TO STATE A CLAIM

An affirmative defense for failure to state a claim will be stricken if the opposer alleges such facts that would, if proved, establish that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing the application. *American Vitamin Products, Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); TBMP § 503.02. Because Opposer has alleged facts that establish standing and grounds for opposing Applicant's application, Applicant's claim of a failure to state a claim cannot survive.

Applicant's arguments to the contrary misses the point. Although a defense of failure to state a claim may be included as an affirmative defense, that defense cannot survive and must stricken where, as here, Opposer has provided facts establishing standing and proper grounds for opposition. *Id.* Applicant's cited case supports this premise. *See Oppel v. Empire Mutual Ins. Co.*, 92 F.R.D. 494, 496 (S.D.N.Y. 1981) (the plaintiff may prevail on the motion to strike an affirmative defense of failure to state a claim if "it appears that there is no question of law or fact that should be heard on the merits.") Accordingly, the Board should strike Applicant's first affirmative defense.

III. THE BOARD SHOULD STRIKE APPLICANT'S SECOND AFFIRMATIVE DEFENSE OF LACHES, ACQUIESCENCE, AND ESTOPPEL

Applicant's second affirmative defense of laches, acquiescence, and estoppel are not mere "amplifying denials." These defenses do not amplify any of Applicant's denials but,

instead, can only be supported by additional facts, none of which have been pleaded or are appropriate to assert in an opposition proceeding. *See Callaway Vineyard & Winery v. Endsley Capital Group Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002) (since opposer promptly opposed registration of applicant's mark, applicant has no basis for the defenses of laches, estoppel, or acquiescence). [1]

Also, as explained more fully in Opposer's motion to strike, Applicant's reliance on Opposer's alleged inaction or acquiescence with respect to certain third party registrations is an improper basis for these defenses. *See Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973); *Plus Products v. General Mills, Inc.*, 188 USPQ 520, 522 (TTAB 1975). In short, the Board often strikes the affirmative defenses of laches, estoppel, or acquiescence when they clearly have no basis in law or fact. The same result should happen here.

These defenses – as a matter of law – have no merit and will only complicate the issues before the Board and introduce unwarranted inferences.

IV. THE BOARD SHOULD STRIKE APPLICANT'S FOURTH, SIXTH, SEVENTH, AND EIGHTH AFFIRMATIVE DEFENSES AS REDUNDANT

A defense that is redundant or is otherwise nothing more than a restatement of a denial in the answer and does nothing to add anything to that denial, should be stricken. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1223 (TTAB 1995). "While Defendant is free to challenge these elements of Plaintiff's case-in-chief at trial, it is inappropriate and redundant for Defendant to rehash its general denials under the guise of affirmative defenses." *Twin Rivers Eng'g, Inc. v. Fieldpiece Instruments, Inc.,* 2016 WL

[1] Opposer notes, however, that "under certain circumstances, a laches defense in an opposition proceeding may be based upon opposer's failure to object to an applicant's earlier registration of substantially the same mark for substantially the same goods."). *See Aquion Partners L.P. v. Envirogard Prod. Ltd*., 43 USPQ2d 1371, 1373 (TTAB 1997). Here, Applicant has not alleged ownership of an earlier-issued registration of substantially the same mark for substantially the same goods as its involved mark and identified goods to form a valid basis for a laches defense.

7042232, at *2 (E.D. Tex. Apr. 6, 2016); *See F.T.C. v. Think All Pub. L.L.C.*, 564 F. Supp.2d 663, 665-66 (E.D. Tex. 2008). Applicant's fourth, sixth, seventh, and eighth defenses are merely denials of Opposer's allegations of likelihood of confusion and likelihood of dilution. Striking these affirmative defenses will not prejudice Applicant in any way, as Applicant will have ample time to fully argue its denials of Opposer's allegations at trial, while retaining the option to bring proper affirmative defenses if they become apparent during this proceeding.

V. CONCLUSION

For the reasons stated above and in Opposer's motion to strike, the Board should strike Applicant's first, second, fourth, sixth, seventh, and eighth affirmative defenses.

Respectfully submitted,

Dated: April 12, 2018

By:/Jill M. Pietrini/

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 12th day of April, 2018.

/LaTrina A. Glenn/
LaTrina A. Glenn

CERTIFICATE OF SERVICE

I hereby certify that the **OPPOSER HRHH IP, LLC'S MOTION TO STRIKE CERTAIN AFFIRMATIVE DEFENSES OF APPLICANT PINNACLE ENTERTAINMENT, INC.** is being sent by electronic mail addressed to:

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on this 12th day of April, 2018.

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