UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: May 15, 2018

Opposition No. 91239923

Hundred Acre Wine Estate, LLC

v.

Hidden Acre Vines LLC

Michael Webster, Interlocutory Attorney:

On March 8, 2018, Hundred Acre Wine Estate, LLC ("Opposer") filed a notice of opposition to the registration of the standard character mark HIDDEN ACRE VINES for goods in International Classes 31, 32 and 33.[1] Opposer claims likelihood of confusion under Section 2(d), 15 U.S.C. § 1052(d), based on its alleged prior common law use of its pleaded marks and ownership of three existing registrations. In its answer, Applicant, Hidden Acre Vines, LLC, denies the salient allegations in the notice of opposition and asserts thirteen "affirmative defenses."

This case now comes before the Board for consideration of Opposer's motion (filed May 7, 2018) to strike Applicant's fifth, sixth, seventh, eighth, ninth, tenth, eleventh, twelfth, and thirteenth affirmative defenses. Opposer argues that the defenses are inadequately pled and fail to give Opposer notice of the basis for the defenses. In

[1] Application Serial No. 87595375 was filed on September 4, 2017, based on Applicant's bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

addition, Opposer contends that the twelfth and thirteenth defenses are not proper, even if pled with sufficient detail. Opposer's motion is well-taken. Thus, the Board exercises its discretion to decide the motion prior to the expiration of time for full briefing of the motion.

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP § 506 (3d ed. rev. 2012). The pleading of a defense "should include enough detail to give the plaintiff fair notice of the basis for the defense." TBMP § 311.02(b); *see* Fed. R. Civ. P. 8(d)(1); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); *see, e.g., IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (Section 18 claim or defense must be specific enough in nature so that the adverse party has fair notice of the restriction being sought).

In this case, Applicant's affirmative defenses consist of bald allegations of the defenses of consent, acquiescence, laches, equitable estoppel, unclean hands, fair use, and waiver. Applicant has failed to set forth any factual allegations to support the defenses. The Board further notes that equitable defenses, such as those asserted by Applicant are generally not available in an opposition proceeding because these defenses start to run from the time of knowledge of the application for registration (that is from the time the mark is published for opposition), not from the time of

knowledge of use. *See, e.g., Nat'l Cable Television Assoc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Rest. Inc. v. Coach and Six Rests. Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); and *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999). Further, the "fair use" defense is a defense to a federal action of infringement of a registered mark, and has no applicability in *inter partes* proceedings before the Board, which involve only the issue of registrability of a mark. *See, e.g., KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 72 USPQ2d 1833, 1836 (2004). Thus, amendment of the answer to assert any of the foregoing defenses is likely to be futile.

In addition, Applicant's allegation in the twelfth affirmative defense that Opposer is not likely to incur damages is an insufficient defense because damage need not be proved in *inter partes* proceedings. *See Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (striking affirmative defense that petitioner will not be damaged; there is no requirement that actual damage be pleaded and proved in order to establish standing or prevail in opposition or cancellation proceeding).

Finally, Applicant's thirteenth affirmative defense is unclear and insufficiently pleaded inasmuch as Applicant has failed to specifically identify a defense or set forth factual allegations to support the defense.

Accordingly, Opposer's motion to strike Applicant's fifth, sixth, seventh, eighth, ninth, tenth, eleventh, twelfth, and thirteenth affirmative defenses is **GRANTED**.

The Board also notes that, under the Federal Rules of Civil Procedure, Applicant may not reserve the right to amend its answer to allege additional defenses. *See FDIC v. Mahajan*, 923, F. Supp. 2d 1133, 1141 (N.D.Ill.2013) (reservation of right to add affirmative defenses at a later date is improper reservation under the Federal Rules). The proper way to plead additional defenses is to file a motion under Fed. R. Civ. P. 15. In addition, counterclaims to cancel pleaded registrations in opposition proceedings are governed by Trademark Rule 2.106(b)(3)(i). Thus, the right to file a counterclaim may not be reserved. In view of the foregoing, the Board *sua sponte* **strikes** paragraphs 14 and 15 under Applicant's Affirmative Defenses. *See* Rule 12(f); *see, e.g., NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may *sua sponte* dismiss any insufficiently pleaded pleading).

Proceedings herein remain as set forth in the Board's Notice of Institution.[2]

[2] *See* 2 TTABVUE 2.