

ESTTA Tracking number: **ESTTA909016**

Filing date: **07/12/2018**

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

Proceeding	91240810
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Date	07/12/2018
Attachments	Motion to Strike Affirmative Defenses - N10RTH - 15754489_1.pdf(149567 bytes)

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

In the matter of Application Serial No.: 87/458,572

Filed: May 22, 2017

For the mark: **NORTH**

Published in the *Trademark Official Gazette* on October 24, 2017

Askov Holdings, LLC ,

Opposer,

v.

Opposition No. 91240810

Our Life 2.5 LLC,

Applicant.

**MOTION TO STRIKE AFFIRMATIVE DEFENSES
WITH MEMORANDUM IN SUPPORT**

Pursuant to Fed. R. Civ. P. 12(f), 37 C.F.R. § 2.116(a), and TMBP § 506 (2018), Opposer Askov Holdings, LLC (“**Opposer**”), through undersigned counsel, hereby respectfully requests that the Trademark Trial and Appeal Board (the “**Board**”) enter an order striking each of the six affirmative defenses made by Our Life 2.5 LLC (“**Applicant**”) in the answer filed by Applicant on June 4, 2018 (“**Answer**”):

PRELIMINARY STATEMENT

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, or impertinent matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TMBP § 506.

[Continued on next page]

ARGUMENT

1. Applicant's first affirmative defense states: "Notice of Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the Opposition."

The asserted defense of failure 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 the pleading of Opposer's claim, rather than a statement of a defense to a properly pleaded claim. Accordingly, this asserted defense must not be considered as such. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1738 n.7 (TTAB 2001).

Nonetheless, Opposer may use a motion to strike the defense of failure to state a claim upon which relief can be granted to test the sufficiency of its pleading. In determining whether to strike Applicant's assertion that Opposer's pleading fails to state a claim upon which relief can be granted, the Board must look at the sufficiency of the pleading.

In order to withstand Applicant's assertion that a pleading fails to state a claim, Opposer need only allege such facts that would, if proved, establish that (1) Opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing Applicant's mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle Opposer to the relief sought. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 U.S.P.Q.2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (CCPA 1982); and TBMP § 503.02. For the following reasons, Opposer's notice of opposition is legally sufficient and clearly contains allegations which, if proven, would establish Opposer's standing and a valid ground for opposing the involved mark.

First, regarding whether Opposer has asserted a proper Section 2(d) claim as grounds for opposition, the allegations set forth in paragraphs seven through 13 provide adequate notice of Opposer's reliance on federal trademark registrations and common law use of its several NORTH marks to establish priority. Further, paragraphs 20 through 30 provide adequate notice of Opposer's claim of likelihood of confusion. And if Opposer's allegations are later proved, they would establish that Opposer has a real interest in the outcome of the proceeding. *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 U.S.P.Q.2d 2021 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, supra. Whether these allegations are true is a question of fact to be determined at trial. In view of the foregoing, Opposer's motion to strike Applicant's first affirmative defense must be granted and said defense must be stricken as insufficient.

2. Applicant's second asserted defense states: "There is no likelihood of confusion because, inter alia, the Mark and the alleged trademarks of Opposer are not confusingly similar."

The asserted defense of "no likelihood of confusion" is not a true affirmative defense because it is merely a duplicative denial of the allegations in paragraphs 24 through 28 of Notice of Opposition, which Applicant denies in paragraphs 24 through 28 of its Answer. Therefore, resolution of the issues through such a duplicative affirmative defense would be redundant on its face. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial). In view thereof, Opposer's motion as to Applicant's second affirmative defense must be granted and such defense must be stricken as redundant.

3. Applicant's third asserted defense states: "Opposer is barred from any relief by its unclean hands."

The asserted defense is insufficient on its face as a bald assertion of "unclean hands" because it fails to give Opposer or the Board any factual basis for the defense. Accordingly, Opposer's motion to strike Applicant's third affirmative defense must be granted and such defense must be stricken as insufficient.

4. Applicant's fourth asserted defense states: "Alternatively, any similarity between the Mark and Opposer's alleged trademark(s) is restricted to that portion of the Mark consisting of the word "North," which is not distinctive as used by the Opposer."

Inasmuch as Applicant's fourth asserted defense is a collateral attack on the validity of Applicant's registrations other than Registration No. 5,226,141, Opposer's motion to strike must be granted because such an attack by Applicant may only be asserted in a counterclaim to cancel the registration(s) in question, which Applicant has not sought except for with regard to Registration No. 5,226,141. *See* TMBP § 311.02(b) and 313.01; *Textron, Inc. v. Gillette Co.*, 180 USPQ 152 (TTAB 1973). Furthermore, with regard to Applicant's fourth affirmative defense applied to Registration No. 5,226,141, the asserted defense is redundant because Applicant has filed a counterclaim to cancel that registration and asserted those identical grounds in paragraphs 40 through 42 of its counterclaim; therefore, Opposer's motion to strike Applicant's fourth affirmative defense must be granted because Applicant's fourth affirmative defense is redundant in that remaining regard. *See Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (affirmative defense stricken because identical to counterclaim); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim).

5. Applicant's fifth asserted defense states: "Opposer's rights in and to the portion of it's alleged "North" mark are generic at best, or in the alternative, merely geographically descriptive of the goods or services offered under the mark. Opposer's alleged word mark for the word "North" as well as other asserted marks only using the word "North" with limited design features, is therefore inherently unprotectable absent acquired distinctiveness which most of their marks lack."

Inasmuch as Applicant's fifth asserted defense, like Applicant's fourth asserted defense, is a collateral attack on the validity of Applicant's registrations other than Registration No. 5,226,141, Opposer's motion to strike must be granted because such an attack by Applicant may only be asserted in a counterclaim to cancel the registration(s) in question, which Applicant has not sought except for with regard to Registration No. 5,226,141. *See* TMBP § 311.02(b) and 313.01; *see, e.g., Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1174 n.17 (TTAB 2011) (plaintiff's mark is registered without either a disclaimer of the term at issue or a claim of acquired distinctiveness, and there is no counterclaim so Board cannot entertain any attack on the term as being merely descriptive); *Textron*, 180 USPQ 152. Furthermore, with regard to Applicant's fifth affirmative defense applied to Registration No. 5,226,141, the asserted defense is redundant because Applicant has filed a counterclaim to cancel that registration and asserted those grounds in paragraphs 40 through 43 of its counterclaim; therefore, Opposer's motion to strike Applicant's fifth affirmative defense must be granted because Applicant's fifth affirmative defense is redundant in that remaining regard. *See Continental Gummi-Werke AG* at 825 (affirmative defense stricken because identical to counterclaim); *see also, W. R. Grace & Co.* at 671 (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim).

6. Applicant's sixth asserted defense states: "The trademark office has already decided this fact in inferred [sic] within the decision to allow the Applicant's mark to proceed to publication. There was no finding of confusion in the record and therefore this prior decision should be given weight in this proceeding."

The asserted defense is an evidentiary matter that is improper for pleadings. *See* TMBP § 311.02(b) (citing *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959)). Therefore, Opposer's motion as to Applicant's sixth affirmative defense must be granted and such defense must be stricken as impermissible and insufficient.

CONCLUSION

Each of Applicant's six affirmative defenses fails to sufficiently plead a permissible defense or are redundant, immaterial, or impertinent and should be stricken by the Board pursuant to Fed. R. Civ. P. 12(f). *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TMBP § 506.

WHEREFORE, Opposer respectfully requests that the Board enter an order striking each of the affirmative defenses made by Applicant in its Answer.

Dated: July 12, 2018

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion to Strike Affirmative Defenses with Memorandum in Support has been served on counsel for Applicant by forwarding said copy on July 12, 2018, via email to:

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___/DHW/_____
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