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

Proceeding	91244449
Party	Plaintiff Lucasfilm Entertainment Company Ltd. LLC
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Submission	Motion to Strike Pleading/Affirmative Defense
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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LUCASFILM ENTERTAINMENT COMPANY LTD. LLC, Opposer, v. ILAN MOSKOWITZ AKA CAPTAIN CONTINGENCY, Applicant.	Opposition No.: 91244449 Mark: MILLENNIAL FALCON Application No.: 87066540 Filed: June 9, 2016

OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Pursuant to TBMP § 506 *et seq.,* Fed. R. Civ. P. 8 and 12(f), Lucasfilm Entertainment Company Ltd. LLC ("Lucasfilm") moves to strike each and every of Ilan Moskowitz AKA Captain Contingency's ("Applicant") five following affirmative defenses: (1) failure to state a claim; (2) laches, waiver, estoppel, and/or acquiescence, (3) abandonment, (4) mistake, and (5) defense of free speech rights.

All of Applicant's "affirmative defenses" should be stricken for a number of reasons. First, all of Applicant's affirmative defenses consist of naked, legally insufficient allegations, lacking enough detail to give Lucasfilm fair notice of the bases for these defenses. Second, Applicant's first "affirmative defense"—failure to state a claim—is not an affirmative defense and is thus improper. Third, Applicant's second affirmative defense—laches, waiver, estoppel, and/or acquiescence—is futile and deficient as a matter of law. Fourth, Applicant's third affirmative defense—abandonment—is an improper collateral attack on Lucasfilm's pleaded registration. Fifth, Applicant's fourth affirmative defense—mistake—includes no detail or facts to

support this "defense," and the two "mistakes" Applicant alleges are not mistakes. Finally, Applicant's fifth "affirmative defense"—defense of free speech rights—is not applicable in this proceeding and is not an affirmative defense and is thus improper. For these reasons, and those set forth below, Lucasfilm's motion should be granted, and all of Applicant's "affirmative defenses" should be stricken.

I. RELEVANT FACTUAL BACKGROUND

On October 29, 2018, Lucasfilm filed its notice of opposition (the "Notice of Opposition") against Application Serial No. 87066540 (the "Application") for the mark MILLENNIAL FALCON on the grounds of likelihood of confusion under Section 2(d) of the Lanham Act, and dilution by blurring under Section 43(c) of the Lanham Act, based on Lucasfilm's famous previously used and registered MILLENNIUM FALCON mark. (Dkt. 1 at ¶¶ 8–35.)

On December 7, 2018, Applicant filed an answer to the Notice of Opposition ("Answer") responding to each allegation in the Notice of Opposition and asserting the five affirmative defenses below (the "Affirmative Defenses"):

> **FIRST AFFIRMATIVE DEFENSE**
> (Failure to State Claim)
>
> Opposition fails to state a claim on which relief can be granted.
>
> **SECOND AFFIRMATIVE DEFENSE**
> (Laches, Waiver, Estoppel, and/or Acquiescence)
>
> Lucas Films [sic] has unreasonably delayed in bringing the opposition, thus barring Lucasfilm's opposition under the doctrines of Laches, Waiver, Estoppel, and/or Acquiescence.
>
> **THIRD AFFIRMATIVE DEFENSE**
> (Abandonment)
>
> Upon information and belief, Ilan Moskowitz alleges that Lucasfilm is not using and has abandoned the Millennium Falcon mark in connection with the goods

recited in one or more of Lucasfilm's registrations and in connection with goods and services alleged in the notice of opposition.

FOURTH AFFIRMATIVE DEFENSE
(Mistake)

The Opposition is barred in whole or in part by because Petitioner [sic] is mistaken as to the pertinent facts supporting the Opposition.

FIFTH AFFIRMATIVE DEFENSE
(Defense of Free Speech Rights)

The Opposition is barred in whole or in part by the First Amendment of the U.S. Constitution.

(Dkt. 4 at pp. 3-4.) Applicant failed to include a proof of service in his Answer.

On December 10, 2018, the Board issued an Order accepting Applicant's Answer and noting that Applicant failed to include proof of service as required by Trademark Rule 2.119(a). (Dkt. 5.) The Board's Order did not reset the trial dates.

II. ARGUMENT

A. Applicant Inadequately Pleaded All of His Affirmative Defenses

"Affirmative defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses." *21st Century Brands LLC v. LXR Biotech, LLC*, Opp. No. 91205970, 2013 WL 11247296, at *4 (TTAB Aug. 12, 2013) (citations omitted). "A party must allege sufficient facts beyond a tender of 'naked assertion[s]' devoid of 'further factual enhancement' to support its claims or defenses." *Id.*, *citing Ashcroft v, Iqbal*, 556 U.S. 663 (2009), *quoting Bell Atl. Corp. v. Twombly*, 550 U.S. 570 (2007). Under these standards, all of Applicant's Affirmative Defenses are insufficiently pleaded. Instead of including factual background and details to support his alleged Affirmative Defenses, Applicant merely includes cursory allegations that are devoid of any details or facts to

place Lucasfilm on notice of the basis of Applicant's Affirmative Defenses.

On their face, all of Applicant's bare-bones Affirmative Defenses are insufficient as a matter of law and all should be stricken on that basis alone.

B. Failure to State a Claim Is Not an Affirmative Defense

Failure to state a claim is an assertion of the insufficiency of the pleading of claims. It is thus "not a true affirmative defense and shall not be considered as such." *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

Moreover, Lucasfilm's Notice of Opposition sufficiently states claims of likelihood of confusion and dilution by blurring. With respect to the likelihood of confusion claim, Lucasfilm's Notice of Opposition pleads standing and priority of use based on Lucasfilm's prior common law use and valid registration for Lucasfilm's MILLENNIUM FALCON mark (Dkt. 1 at ¶¶ 8-15), and that Applicant's MILLENNIAL FALCON mark shown in the Application is likely to cause confusion with Lucasfilm's MILLENNIUM FALCON mark (*Id.* at ¶ 30). The Board has held such allegations are sufficient to state standing and a claim of likelihood of confusion. *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974) (priority pleading based on prior registration rights); *see also* Lanham Act Section 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 209 USPQ 40 (CCPA 1981) (to state a claim of likelihood of confusion, plaintiff need only allege it has priority of use and that the defendant's mark so resembles plaintiff's mark as to be likely to cause confusion).

Similarly, for the dilution claim, Lucasfilm's Notice of Opposition further properly pleads that Lucasfilm's MILLENNIUM FALCON mark is famous and distinctive (Dkt. 1 at

¶ 32), that Lucasfilm's MILLENNIUM FALCON mark became famous and distinctive before the filing date of the Application and any date of first use that Applicant may allege or attempt to prove (*Id*. at ¶ 34), and that Applicant's use of its MILLENNIAL FALCON mark shown in the Application, which closely resembles Lucasfilm's famous MILLENNIUM FALCON mark, is likely to dilute the distinctive quality of Lucasfilm's famous MILLENNIUM FALCON mark (*Id*. at ¶ 35). The Board has held that such allegations are sufficient to state a claim of dilution. *See UMG Recordings Inc. V. Mattel Inc.*, 100 USPQ2d 1868, 1886 (TTAB 2011). Accordingly, Applicant's "affirmative defense" that Lucasfilm's Notice of Opposition fails to state a claim is thus baseless and frivolous, and should be stricken from the Answer.

C. Applicant's Laches, Waiver, Estoppel, and/or Acquiescence Defense is Futile

Even if Applicant had included the requisite supporting detail, Applicant's second affirmative defense of the equitable defenses of laches, waiver, estoppel, and/or acquiescence is deficient as a matter of law for multiple reasons.

It is well settled that the defenses of laches, estoppel, and acquiescence are generally not available in opposition proceedings. *See Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991) ("[L]aches, with respect to protecting the issuance of the registration for a mark, could not possibly start to run prior to …when [the] application for registration was published for opposition"); *Callaway Vineyard & Winery v. Endsley Capital Grp., Inc.*, 63 USPQ 2d 1919, 1923 (TTAB 2002) ("[I]nasmuch as opposer promptly opposed registration of applicant's mark, applicant has no basis for the defense of laches, estoppel, or acquiescence."); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ 2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches,

acquiescence or estoppel are generally not available in an opposition proceeding, and "that amendment of applicant's answer to assert any such defense therefore would be futile").

Further, Lucasfilm only had constructive knowledge of the mark and goods in the Application when it published for opposition on October 16, 2018. Accordingly, Lucasfilm could not have prospectively waived its right to oppose and/or acquiesced to the Application and in fact, Lucasfilm timely filed its Notice of Opposition against the Application. Applicant's second affirmative defense of laches, waiver, estoppel, and/or acquiescence should thus be stricken from the Answer.

D. Applicant's Abandonment Affirmative Defense Is an Improper Collateral Attack

"A defense attacking the validity of any one or more registrations pleaded in the opposition shall be a compulsory counterclaim . . .and will not be heard unless a counterclaim or separate petition is filed to seek cancellation of such registration." 37 C.F.R. § 2.106(b)(3)(i-ii); *Cosmetically Yours, Inc. v. Clairol, Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970) ("[I]n the absence of a counterclaim for cancellation . . .it is not open to an applicant to prove abandonment of opposer's registered mark."); *Nasdaq Stock Market, Inc. v. Antartica, S.R.L.*, 69 USPQ2d 1718, 1735 (TTAB 2003) ("The law, of course, is well settled that an applicant cannot collaterally attack opposer's registration in the absence of a counterclaim for cancellation."). In this case, Applicant has not raised a counterclaim for cancellation, and thus Applicant's third affirmative defense of abandonment is improper.

Even if Applicant properly stated a counterclaim of abandonment, such claim would be futile and fail as a matter of law. As detailed in the Notice of Opposition,

Lucasfilm for decades has used and/or licensed and continues to use and/or license its MILLENNIUM FALCON mark across a wide variety of goods and services, including toys and toy vehicles. (Dkt. 1 at ¶¶ 10-13, 15.) Even a cursory review of Lucasfilm's publicly available information, including its famous *Star Wars* film franchise, related toys, and publicity, all supporting the facts alleged in the Notice of Opposition show that Applicant's allegations are without merit. Thus, there is not factual basis of support for Applicant's suggestion of abandonment and any such claim is frivolous and should be stricken.

E. Applicant's "Mistake" Defense is Inaccurate and Fails as a Matter of Law

Applicant's fourth affirmative defense—mistake—is a naked assertion devoid of any facts and, moreover, any "mistakes" Applicant alleges in its Answer are in fact not mistakes. Applicant's Answer alleges two "mistakes" in Lucasfilm's Notice of Opposition: (1) that Applicant is located at a different address (Dkt. 4 at ¶ 19), and (2) that Applicant's "services are as amended on October 6, 2016" (*Id*. at ¶ 20). Neither of these are mistakes. First, Lucasfilm's Notice of Opposition includes Applicant's address listed currently on the Patent and Trademark Office's records for the Application. (Dkt. 1 at ¶ 19.) Second, Lucasfilm's Notice of Opposition lists Applicant's services as amended on October 6, 2016. (*Id*. at ¶ 20.) Neither of these "mistakes"—which are not mistakes—put Lucasfilm on notice of Applicant's alleged affirmative defense of mistake, and Applicant's fourth affirmative defense should be stricken.

F. There is No First Amendment Defense in an Opposition

Applicant's fifth affirmative defense—defense of free speech rights—is not applicable in this proceeding and is a misunderstanding by Applicant of the federal

trademark registration process. By applying to register the mark MILLENNIAL FALCON, Applicant is not seeking to merely make an *expressive* use of his mark, but rather Applicant himself is applying to register the mark MILLENNIAL FALCON as a *source identifier* for the services in the Application. *See New York Yankees P'ship v. IET Prod. & Serv., Inc.* 114 USPQ2d 1497, 1509 (TTAB 2015). Applicant's alleged First Amendment and free speech rights in the term MILLENNIAL FALCON, if any, are not a defense to Applicant's trademark use of MILLENNIAL FALCON in a way that is likely to cause consumer confusion and conflict with Lucasfilm's long-standing rights in its famous MILLENNIUM FALCON mark. *See, e.g., Columbia Pictures Indust., Inc. v. Miller*, 211 USPQ 816, 820 (TTAB 1981) ("The right of the public to use words in the English language in a humorous and parodic manner does not extend to use of such words as trademarks if such use conflicts with the prior use and/or registration of substantially the same mark by another.").

Moreover, the Board has consistently held that First Amendment defenses, such as parody, are not true "affirmative defenses." *Nike, Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011) ("To the extent applicants argue that their mark is a protected parody, we note that parody is not a defense if the marks would otherwise be considered confusingly similar."); *Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1754 (TTAB 2006) ("[P]arody is unavailing to applicant as an outright defense and, further, does not serve to distinguish the marks."); *Stokely-Van Camp, Inc. v. Wooten*, Opp. No. 91183146, 2009 WL 1017294, at *5 (TTAB March 24, 2009) ("[A]ny claim applicant may make to the use of his HATER-AID mark as a parody is not a true 'defense.'").

Accordingly, Applicant's fifth affirmative defense that Lucasfilm's Notice of Opposition against the Application is barred by the First Amendment should be stricken from the Answer.

III. CONCLUSION

For the reasons and authorities above, Lucasfilm respectfully requests that the Board grant its Motion to Strike all of Applicant's Affirmative Defenses.

Respectfully Submitted,

Dated: December 21, 2018

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES was served by email on December 21, 2018 upon Applicant at the addresses below:

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