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

Proceeding	91250852
Party	Plaintiff Cain Cellars Inc. dba Cain Vineyard & Winery
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of:
Serial No.: 88/236,481
Filed: December 20, 2018
Published: May 14, 2019
Mark: CAB FIVE

CAIN CELLARS, INC. DBA CAIN VINEYARD
AND WINERY,

Opposer,

v.

VINOCOPIA, INC.,

Applicant.

Opposition No. 91250852

**OPPOSER CAIN CELLARS' MOTION TO
STRIKE AFFIRMATIVE DEFENSES**

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Section 506 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Opposer CAIN CELLARS, INC. DBA CAIN VINEYARD AND WINERY ("Cain") respectfully moves the Trademark Trial and Appeal Board ("Board") to strike as insufficient certain purported affirmative defenses from the Answer and Counterclaim filed by Applicant VINOCOPIA, INC. ("Vinocopia").

I. BACKGROUND

Opposer Cain Cellars, Inc. is the owner of the well-known FIVE and CAIN FIVE marks—marks that have been used to designate Cain's wine since its first vintage in 1985. Indeed, Cain has federal trademark registrations for the marks that are incontestable, namely:

- CAIN FIVE (U.S. Registration No. 2903428) for "wine" in Class 33, which was registered on the Principal Register on November 16, 2004; and

- FIVE (U.S. Registration No. 3141106) for “wine” in Class 33, which was registered on the Principal Register on September 12, 2006.

Despite Cain’s longstanding rights in the FIVE and CAIN FIVE marks, Vinocopia filed an intent-to-use trademark application for the mark CAB FIVE (“CAB FIVE Mark”) for “wine” in Class 33 on December 20, 2018, which was assigned U.S. Serial No. 88/236,481 (the “Application”). Cain filed a Notice of Opposition against the Application on September 11, 2019. (Dkt. No. 1.)

In its Notice of Opposition, Cain alleged that the CAB FIVE Mark was likely to be confused with its FIVE and CAIN FIVE marks, and that Cain was likely to be damaged by registration of the CAB FIVE mark—which differs from CAIN FIVE by only two letters. (See *generally* Dkt. No. 1.) Cain further alleged that, among other things, its rights in the FIVE and CAIN FIVE trademarks predate Applicant’s by thirty years, and the public has learned to associate the marks CAIN FIVE and FIVE with Cain’s wine. (Dkt. No. 1, ¶ 4.)

In its Answer and Counterclaim (Dkt. No. 4), Vinocopia raises affirmative defenses, which are legally insufficient and improper, including the allegation that Cain “failed to state a claim upon which relief may be granted” (“Affirmative Defenses,” pg. 2, ¶ 1), and that Cain is precluded under “laches, waiver, unclean hands and/or estoppel” (“Affirmative Defenses,” pg. 2, ¶ 2). Cain respectfully requests that the Board strike these affirmative defenses without leave to amend, for the reasons discussed in detail below.

II. ARGUMENT

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Section 506 of the Trademark Board Manual of Procedure, the Board may strike from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. See also 37 C.F.R. § 2.116(a). Here, because they are legally insufficient and/or improper, Cain respectfully requests that the Board strike Vinocopia’s affirmative defenses, without leave to amend.

A. Cain’s Notice of Opposition Properly States a Claim for Relief—and Vinocopia’s Affirmative Defense to the Contrary Should Be Stricken.

Vinocopia’s first affirmative defense is that Cain’s Notice of Opposition failed to state a claim upon which relief may be granted. Because Cain properly pleaded that there is a likelihood of confusion between the CAB FIVE Mark and Cain’s FIVE and CAIN FIVE marks, and that it believes it will be damaged by registration of the CAB FIVE Mark, this defense is improper and should be stricken.

As an initial matter, as the Board has previously stated, failure to state a claim is not an affirmative defense “because it relates to an assertion of the insufficiency of the pleading of [petitioner’s] claim rather than a statement of defense to a properly pleaded claim.” *Castro v. Cartwright*, Opposition No. 91188477 (T.T.A.B. Sept. 5, 2009). Accordingly, this allegation would be better suited for a motion to dismiss. *See Motion Picture Ass’n of Am. Inc. v. Respect Sportswear Inc.*, 83 U.S.P.Q.2d 1555, 1557 n.5 (2007) (“Inasmuch as applicant did not file a motion to dismiss the instant opposition on the basis of Fed. R. Civ. P. 12(b)(6), we treat this ‘defense’ as having been waived.”).

Nevertheless, Cain’s Notice of Opposition properly states a claim. When evaluating whether a Notice of Opposition properly states a claim, the Board looks to see whether it alleges facts that “if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition).” T.B.M.P. § 503.02. “At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a ‘real interest’ in the proceeding, and a ‘reasonable basis for its belief of damage.’” T.B.M.P. § 309.03(b).

As pleaded, the Notice of Opposition properly states a claim. Cain pleaded, among other things, that it has standing to bring the claim based on its CAIN FIVE and FIVE registrations, and that registration of the CAB FIVE Mark would damage Cain because the CAB FIVE Mark “so resembles Opposer’s registered marks as to be likely to cause confusion, or to cause

mistake, or to deceive, as to source, sponsorship, or affiliation if used in connection with wine or wine-related products” (Dkt. No. 1, ¶2.) These allegations must be taken as true at the pleading stage and, as such, constitute valid grounds for denying registration of the CAB FIVE Mark.

Because the Notice of Opposition filed by Cain properly states a claim upon which relief may be granted, Vinocopia’s first affirmative defense should be stricken without leave to amend.

B. The Remaining Affirmative Defenses Should Be Stricken Because They Fail to Provide Any Notice to Cain of the Basis of the Claims.

The remaining affirmative defenses are also legally insufficient. An affirmative defense must “include enough detail to give the plaintiff fair notice of the basis for the defense.” TBMP § 311.02; *see also* Fed. R. Civ. P. 8(b). “[A] party must do more than make a bald allegation in the language of the statute . . . [to give] fair notice of the basis for petitioner’s claim.” *See Otto Int’l Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1864 (T.T.A.B. 2007).

Vinocopia’s affirmative defense reads, in its entirety, “Opposer is precluded from asserting its claims under the equitable doctrine of laches, waiver, unclean hands, and/or estoppel.” (“Affirmative Defenses,” pg. 2, ¶ 2.) There are no facts or details to support the claims—not even the basic elements of the individual defenses. Since these are nothing more than “bald allegations,” the affirmative defenses of laches, waiver, unclean hands, and estoppel should also be stricken.

Moreover, the affirmative defense of laches is inapplicable in opposition proceedings. *See National Cable Television Ass’n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

III. CONCLUSION

For the foregoing reasons, Opposer Cain Cellars, Inc. respectfully requests that the Board strike Applicant Vinocopia’s affirmative defenses because they are insufficiently pleaded, improper, or otherwise inapplicable. Further, because the defects of the purported affirmative defenses cannot be cured, Cain respectfully requests that the defenses be stricken with

prejudice and without leave to amend.

Date: November 15, 2019

Respectfully submitted,

CAIN CELLARS, INC. dba CAIN VINEYARD
AND WINERY

By /s/ Raffi Zerounian

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CERTIFICATE OF SERVICE

I, Laura Prongos, hereby certify that true and correct copies of the foregoing **OPPOSER CAIN CELLARS' MOTION TO STRIKE AFFIRMATIVE DEFENSES** were served on the parties listed below by mailing said copies on November 15, 2019 via email to:

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Dated: November 15, 2019

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