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

Proceeding	91255001
Party	Plaintiff Trigon Turf Sciences LLC
Correspondence Address	JOSEPH A. URADNIK URADNIK LAW FIRM PC P.O. BOX 525 GRAND RAPIDS, MN 55744 UNITED STATES joe@iplawspot.com 612-865-9449
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Joseph A. Uradnik
Filer's email	joe@iplawspot.com
Signature	/Joseph A Uradnik/
Date	05/12/2020
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Serial No. 88649876 Mark: SAMURAI TINE (word) Filed: October 10, 2019	§	
TRIGON TURF SCIENCES, LLC Opposer,	§	Opposition No. 91255001
v.	§	
JRM, Inc. Applicant.	§	

OPPOSER'S MOTION TO DISMISS COUNTERCLAIMS AND STRIKE AFFIRMATIVE DEFENSES

Trigon Turf Sciences LLC ("Opposer") hereby moves to dismiss Applicant's two counterclaims and to strike Applicant's five affirmative defenses. As shown below, Opposer's motion should be granted in its entirety.

I. OPPOSER'S MOTION TO DISMISS UNDER FED. R. CIV. P. 12(b)(6)

Opposer hereby moves to dismiss Applicant's two counterclaims for failure to state a claim pursuant to FED. R. CIV. P. 12(b)(6).

In Applicant's first counterclaim for cancellation based on fraud in the application, Applicant has failed to plead a required element of any fraud claim. Applicant failed to plead that any individual acted with an intent to deceive the USPTO. The Board has stated:

> Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application *with intent to deceive the USPTO*.

Nationstar Mortgage LLC v. Ahmad, Opposition No. 91177036, 84 TTABVUE 7 (September 30, 2014) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)) (emphasis added).[1] Applicant's failure in pleading is fatal to its fraud in application claim, which should be dismissed.

In Applicant's second counterclaim for cancellation based upon a defective specimen of use, Applicant has pled a technical matter that is exclusively within the province of the Trademark Examining Attorney. Thus, Applicant's pleading cannot form the basis of a proceeding before the Board. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of ex parte examination and is not ground for an opposition); *Flash & Partners S.P.A. v. I.E. Manufacturing LLC*, Opposition No. 91191988, 19 TTABVUE 5 (July 14, 2010) (ex parte examination matters do not form a basis for cancellation). Thus, Applicant's second counterclaim also should be dismissed.

II. OPPOSER'S MOTION TO STRIKE AFFIRMATIVE DEFENSES

Applicant's five affirmative defenses are legally insufficiently pled. Striking those sections of Applicant's Answer will simplify discovery in this matter, and avoid prejudice to Petitioner of having to conduct discovery on the redundant and unsupported allegations in the Answer.

Pursuant to Federal Rule of Civil Procedure 12(f) and TBMP § 506.02, "the Board, upon its own initiative, and at any time, including during a discovery conference, may order stricken from a pleading any insufficient claim or defense or any redundant, immaterial, impertinent, or

[1] For the citations to TTABVUE, the Board's electronic docketing system, the number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page, paragraph or exhibit number(s) of that particular docket entry.

scandalous matter." TBMP § 506.02. The primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id.*

An affirmative defense is "[a] defendant's assertion raising new facts and arguments that, if true, will defeat the plaintiff's or prosecution's claim, even if all allegations in the complaint are true." *H.D. Lee Co. v. Maidenform Inc.,* Opposition No. 91168309, 39 TTABVUE 8 (May 6, 2008) *citing* Black's Law Dictionary, p. 430 (7th ed. 1999). Affirmative defenses must rise above the level of bald, conclusory allegations. See, e.g., *Heller Finance, Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294 (7th Cir. 1989) (upholding motion to strike affirmative defenses because they were bare bones, conclusory allegations)

As shown below, each of Applicant's affirmative defenses is legally insufficient and should be stricken.

A. <u>Applicant's Bald Assertion of Laches is Baseless</u>

Section 19 of the Trademark Act, 15 U.S.C. § 1069, provides that "[i]n all inter partes proceedings equitable defenses of laches, estoppel, and acquiescence, where applicable may be considered and applied." The elements of laches are (1) unreasonable delay in assertion of one's rights against another; and (2) material prejudice to another attributable to that delay. *Bridgestone/Firestone Research Inc. v. Automobile Club de L'Ouest de la France,* 245 F.3d 1359, 58 USPQ2d 1460, 1462 (Fed. Cir. 2001).

Here, Applicant failed to plead any delay at all, let alone an unreasonable delay. In fact, <u>no delay exists in this case</u>. It is beyond question that Applicant's SAMURAI TINE mark was published for opposition on February 25, 2020; an extension of time to oppose was received on March 23, 2020; and this opposition proceeding was instituted on April 1, 2020.

An affirmative defense of laches simply cannot be made out where, as here, the opposition proceeding was instituted timely during the statutory period for bringing an opposition. Accordingly, Applicant's laches affirmative defense is legally insufficient, baseless and should be stricken.

B. Applicant's Unclean Hands Defense is Legally Insufficient

Unclean hands is an affirmative defense that is available in Board proceedings. See Trademark Rule 2.106(b)(1) and Fed. R. Civ. P. 8(b); *Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, 1157-58 (TTAB 2003); *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001); See also *Duffy-Mott Company v. Cumberland Packing Company*, 424 F2d 1095, 165 USPQ 422, 425 (CCPA 1972) ("Trademark rights under the statute are no longer divorced from equitable principles.").

The unclean hands defense, however, requires plaintiff misconduct which causes the defendant to take action. *United States Postal Service v. RPost Communication Limited*, Opposition No. 91210479, 43 TTABVUE 7 (November 2, 2015) (non-precedential) (citing *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000)). Here, Applicant has failed to plead that Applicant took any action as a result of Opposer's actions. Accordingly, Applicant's pleading of an unclean hands defense is legally insufficient and should be stricken.

C. Applicant's "Waiver and/or Estoppel" Defense is Legally Insufficient

Affirmative defenses that are bare bones, conclusory allegations should be stricken. See *Heller Finance, Inc. v. Midwhey Powder Co.*, 883 F.2d 1286, 1294 (7th Cir. 1989) (upholding motion to strike affirmative defenses because they were bare bones, conclusory allegations); *Fleet Business Credit Corp. v. National City Leasing Corp.*, 191 F.R.D. 568, 570

(N.D. Ill. 1999) (bare bones waiver and estoppel defenses fail to sufficiently plead the affirmative defenses). Applicant's "waiver and/or estoppel" defenses are nakedly pled and should be stricken.

As noted in *Cards Against Humanity, LLC v. Vampire Squid Cards*, LLC, Opposition No. 91225576, 26 TTABVUE 10-11 (September 6, 2017) (non-precedential):

> Trademark Act § 19, 15 U.S.C. § 1069, provides, in relevant part, that the equitable principles of estoppel may be considered and applied. However, there are various types of estoppel recognized by law, including: collateral estoppel, estoppel by laches, equitable estoppel, licensee estoppel, and contract estoppel. Applicant has not indicated which type of estoppel it is asserting affirmatively nor provided enough information concerning the nature of the purported estoppel and the underlying factual circumstances, even in general terms, which may give rise to the purported estoppel. Applicant has not provided sufficient allegations of fact to put Opposer on notice of the bases upon which the estoppel defense is being asserted.

In *Cards Against Humanity, LLC v. Vampire Squid Cards, LLC*, the Board found the waiver and estoppel defenses were not pleaded with sufficient particularity, and the defenses were stricken. *Id.* Applicant's "waiver and/or estoppel" defenses here similarly should be stricken.

D. Applicant's Fourth Affirmative Defense of No Likelihood of Confusion Should Be Stricken Because it is Merely a Restatement of its Denials.

The Board may strike redundant material from a pleading. Fed. R. Civ. P. 12(f); TBMP § 506.01. Allegations merely reiterating a denial of likelihood of confusion previously set forth in an answer are redundant and therefore should be stricken. *Textron, Inc. v. Gillette Co.*, 180 U.S.P.Q. 152, 153 (TTAB 1973); *Order Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2D 1221, 1223 (TTAB 1995).

Applicant's fourth affirmative defense of "no likelihood of confusion" is redundant in view of the earlier denials in its Answer. Applicant's fourth affirmative defense should be stricken.

E. Applicant's Fifth Affirmative Defense Has Been Waived and Should Be Stricken

Applicant pleaded as a fifth affirmative defense the failure to state a claim pursuant to FED. R. CIV. P. 12(b)(6). However, Applicant failed to file any motion under FED. R. CIV. P. 12(b)(6) prior to filing its Answer and Counterclaim. The opportunity to file such a motion now is gone. See FED. R. CIV. P. 12(b)(6) ("A motion asserting any of these defenses must be made before pleading if a responsive pleading is allowed."). Thus, Applicant's defense is waived and should be stricken. See *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, Opposition No. 91153147, 265 TTABVUE 3 (July 9, 2014) ("As applicant did not pursue the affirmative defense[] of failure to state a claim ... by motion, [this defense is] waived.")

CONCLUSION

Petitioner respectfully requests that the Board dismiss Applicant's two counterclaims and strike Applicant's five affirmative defenses.

Petitioner also respectfully requests that no schedule dates be reset.

Respectfully submitted,

Date: May 12, 2020

/s/ *Joseph A Uradnik*

Joseph A. Uradnik
URADNIK LAW FIRM PC
P.O. Box 525
Grand Rapids, Minnesota 55744
Tel.: (612) 865-9449

ATTORNEY FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing

OPPOSER'S MOTION TO DISMISS COUNTERCLAIMS AND STRIKE AFFIRMATIVE DEFENSES

has been duly served by emailing a copy to:

BLAKE P. HURT
TUGGLE DUGGINS P.A.
100 N. GREENE STREET, SUITE 600
GREENSBORO, NC 27401
bhurt@tuggleduggins.com, pdillon@tuggleduggins.com

Attorney for Applicant

on May 12, 2020.

/s/*Joseph A. Uradnik*