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

Proceeding	91256500
Party	Plaintiff Roberto Giordani
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Submission	Motion to Strike
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ROBERTO GIORDANI,

Opposer,

v.

Tapa Reef Pty Ltd.,

Applicant,

and

Tapareef, LLC.

Opposition No.: 91256500

**MOTION TO STRIKE AFFIRMATIVE DEFENSE
(NOS. 2 & 3)**

COMES NOW, the Opposer, by and through the undersigned and pursuant to Fed. R. Civ. P. 8, 12 and TBMP 506, file this motion requesting the Board strike Applicant's Affirmative Defense nos. 2 and 3 (21 TTABVUE at 7-8).

STANDARD

The Board may strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. Fed. R. Civ. P. 12(f); TBMP 506. The Board may act on its own or on motion made by a party either before responding to the pleading or, if a response is not allowed, within 21 days after being served with the pleading. *Id.*

This motion is timely filed within 21 days of Applicant's pleading 21 TTABVUE filed September 2, 2021. Defenses should be stricken for not complying with pleading requirements of Fed. R. Civ. P. 8 in that is unclear what Applicant is asserting and/or for being subject to Rule 12 as explained in the following,

Affirmative Defense No. 2

Applicant argues *inter alia* that its "primary use of the mark is in association with the Class 003 goods...a highly niche product." That "because of the niche goods...Applicant's average buyer is an avid beachgoer...that is likely to recall the commercial impression of the mark, which is *generally displayed in an aqua blue to conjure images of the water*" (emphasis added). Applicant defends that it is unlikely goods of the parties will be "encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source as Opposer's."

As an initial matter, IC 003 is not being opposed. Second, Applicant's defense that its trade channels and purchasers are further or more specifically limited to a "niche" group is immaterial, because (1) no such limitation (e.g., to a segment of an industry or service or a particular channel of trade) appears in Applicant's recitation of goods or services; notwithstanding, (2) there is no limitation in the Opposer's registrations. Third, Applicant's mark is not limited to a color claim.

Affirmative Defense No. 3

Applicant alleges *inter alia* use of the opposed mark since at least June 23, 2015 both in the U.S. and Australia. Notwithstanding use outside the U.S. is unavailing,

Opposer's registrations were filed in the U.S. well prior to June 2015 (see, Registration No. 3436202 filed July 2006, registered May 2008; Registration No. 4705703 filed July 2013, registered March 2015). Based on the foregoing, it is unclear if Applicant asserts laches. If so, the defense is not applicable in opposition proceedings because the defense starts to run from the time the mark is published. See, *Muwafak H. Kaki & Kaki Inc.*, No. 91224191, 2018 WL 4044092, at *2 (Aug. 22, 2018) citing *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) and *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008).

WHEREFORE, to the extent the "defenses" are amplifications of denials is unclear. Based on allegations as highlighted, Applicant's Affirmative Defense Nos. 2 and 3 consist of allegations that are in whole or in part insufficient, immaterial, impertinent and should be stricken.

Dated: September 20, 2021

Respectfully submitted,
HILL WALLACK LLP

/Jason DeFrancesco/
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For Opposer,
Roberto GIORDANI

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing was served via e-mail on
CHRISTINE DEVENEY <christine.deveney@tapareef.com> on September 20, 2021.

/Jason DeFrancesco/
Jason DeFrancesco