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

Proceeding	91267444
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**IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Serial No. 88/578,182  
Filed: August 14, 2019  
For the mark: SKINNY BITCH  
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JIM BEAM BRANDS CO.,

Opposer,

v.

Opposition No.: 91267444

SKINNY BITCH, LLC,

Applicant.

**OPPOSER’S MOTION TO STRIKE APPLICANT’S AFFIRMATIVE DEFENSES NOS.  
1-7 AND MEMORANDUM IN SUPPORT THEREOF**

Pursuant to Federal Rule of Civil Procedure 12(f), 37 C.F.R. § 2.116, and Sections 506.01 and 506.02 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Opposer Jim Beam Brands Co. (“Jim Beam”) respectfully requests that the Board enter an order striking Applicant Skinny Bitch, LLC’s (“Applicant”) First through Seventh (1-7) Affirmative Defenses (collectively, the “Affirmative Defenses”), as asserted in Applicant’s Answer to Jim Beam’s Notice of Opposition (the “Answer”), 4 TTABVue. Jim Beam further requests that the Board suspend this proceeding pending disposition of this Motion to Strike (the “Motion”).

**I. BACKGROUND**

On February 3, 2021, Jim Beam filed a Notice of Opposition (the “Opposition”) requesting that the Board refuse Applicant’s application to register the mark SKINNY BITCH (the “Contested Mark”) in class 33 for use in connection with a “ready to drink vodka based

canned cocktail” on the grounds that, under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), the Contested Mark is likely to be confused with Jim Beam’s prior registrations in class 33 and common law rights in the mark SKINNYGIRL for use in connection with, among other things, prepared alcoholic cocktails and cocktail mixes. *See* Opposition, 1 TTABVue.

In its Answer, Applicant presented seven Affirmative Defenses numbered and stated as follows:

1. “Opposer’s Notice fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.” (First Affirmative Defense).
2. “There is no similarity between Applicant’s SKINNY BITCH mark and Opposer’s SKINNYGIRL marks as to sight, sound and commercial impression.” (Second Affirmative Defense).
3. “Purchasers of goods sold along with the relevant marks are careful and sophisticated, thus making any confusion or mistake amongst potential overlapping consumers highly unlikely.” (Third Affirmative Defense).
4. “The goods sold along with the relevant marks are completely unrelated, are not sold from similar channels of trade, and do not share similar consumers.” (Fourth Affirmative Defense).
5. “Other than sharing the word SKINNY, the Opposer’s marks do not sound like the Applicant’s mark.” (Fifth Affirmative Defense).
6. “Ordinary Consumers would not confuse or conclude that the parties’ products share a common source or affiliation or connection.” (Sixth Affirmative Defense).

7. “Opposer has no examples of any actual confusion amongst consumers with regards to Applicant’s mark and Opposer’s marks.” (Seventh Affirmative Defense).

## II. LEGAL STANDARD

The Federal Rules of Civil Procedure are applicable to Board proceedings under 37 C.F.R. § 2.116(a), and permit the Board to “strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter.” Fed. R. Civ. P. 12(f); *see Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014); *Am. Vitamin Prods. Inc. v. Dowbrands Inc.*, 22 USPQ2d 1313 (TTAB 1992) (motion to strike affirmative defenses granted); *see also* TBMP § 506. The Board also has the authority to strike an impermissible or insufficient claim or portion of a claim from a pleading. TBMP § 506.01 (citing cases).

Federal Rule of Civil Procedure 8(c) allows for permissibly pled affirmative defenses, and lists examples of what constitute proper affirmative defenses. Fed. R. Civ. Proc. R. 8(c). The TBMP similarly explains that “[a]ffirmative defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense.” TBMP 311.02(b)(1).

Federal Rule of Civil Procedure 8(b) requires all defenses to a claim be stated in short and plain terms, and affirmative defenses must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1289 (TTAB 1999) (primary purpose of pleadings “is to give fair notice of the claims or defenses asserted.”). To meet this pleading standard, a party “must allege sufficient facts beyond a tender of ‘naked assertion[s]’ devoid of ‘further factual enhancement,’ to support its

claims and defenses.” *Cards Against Humanity, LLC v. Vampire Squid Cards, LLC*, 2017 TTAB LEXIS 359, \*19 (TTAB Sept. 6, 2017) (citing *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007))). The TBMP similarly explains that “the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.” TBMP 311.02(b)(1). Conclusory and “bald allegations” are insufficient under the standard, in that they neither give fair notice of the basis for a claim nor set forth sufficient facts that, if proven, support the claim. *Id.* (citing *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1864 (TTAB 2007)).

Moreover, an affirmative defense should be stricken as redundant when it is merely a restatement of an earlier denial. *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (striking a restated defense that “does not add anything to the denial.”).

### **III. ARGUMENT**

#### **A. Applicant’s Affirmative Defenses Are Procedurally Improper**

As a threshold matter, Applicant has failed to adhere to the basic tenets of the Federal Rules of Civil Procedure by improperly presenting to the Board various denials masqueraded as affirmative defenses. Under the Federal Rules of Civil Procedure, a negative defense negates or denies an element of the claim, whereas an affirmative defense is an implicit admission of the factual allegations pled, but avoids liability, in whole or in part, based on additional allegations of excuse, justification or other negating matters. *Compare* Fed. R. Civ. P. 8(b) *with* Fed. R. Civ. P. 8(c); *see also Sloan Valve Co. v. Zurn Industries Inc.*, 712 F. Supp. 2d 743, 749 (N.D. Ill. 2010) (“the basic concept of an affirmative defense is an admission of the facts alleged in the complaint,

coupled with the assertion of some other reason defendant is not liable”); *Zivkovic v. Southern California Edison Co.*, 302 F.3d 1080, 1088 (9th Cir. 2002) (“A defense which demonstrates that plaintiff has not met its burden of proof [as to an element plaintiff is required to prove] is not an affirmative defense”); *Neylon v. County of Inyo*, No. 1:16-CV-0712 AWI JLT, 2017 WL 3670925, at \*3 (E.D. Calif., Aug. 25, 2017) (“‘negative’ defenses, i.e., defenses that simply negate an element of the plaintiff’s claim or defenses that state the plaintiff cannot meet her burden as to an element of proof, are not affirmative defenses.”).

Courts routinely strike negative defenses that are improperly presented as affirmative defenses. *See, e.g., Hill Country Bakery v. Honest Kitchens Grp., LLC*, No. 5:17-CV-334-DAE, 2017 U.S. Dist. LEXIS 221761, at \*15 (W.D. Tex. Dec. 11, 2017) (striking defendant’s affirmative defense that plaintiff’s trademark infringement claims are barred as defendant’s trademark use predated that of plaintiff, and finding that defendant’s affirmative defense was “actually a ‘negative defense’” and thus improper and redundant); *see also Chatam Int’l Inc. v. Abita Brewing Co.*, 49 USPQ2d 2021, 2023 (TTAB Sept. 22, 1998) (granting opposer’s motion to strike applicant’s improper affirmative defense).

Here, Applicant’s laundry list of affirmative defenses, all of which are negative defenses cast as affirmative defenses, should be stricken. Applicant’s Second through Seventh Affirmative Defenses simply attempt to negate the elements of Jim Beam’s claims of likelihood of confusion under Section 2(d), 15 U.S.C. § 1052(d). Applicant negates Jim Beam’s claims of likelihood of confusion by, for example, stating that “[t]here is no similarity between [the marks]” (Second Affirmative Defense) or that “the Opposer’s marks do not sound like the Applicant’s mark” (Fifth Affirmative Defense). These are procedurally defective negative defenses, not affirmative defenses.

In addition, Applicant's First Affirmative Defense for "failure to state a claim" has frequently been recognized as an improper negative defense . See *Unigestion Holding S.A. v. UPM Technology Inc.*, 305 F.Supp.3d 1134 (D. Or. 2018); see also *Hiramanek v. Clark*, No. 13- 00228, 2015 WL 693222, at \*2 (N.D. Cal., Feb. 18, 2015) ("Failure to state claim: [defendants] agree to remove this affirmative defense, which is an improper negative defense."); *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001) (an affirmative defense which asserts that the notice of opposition fails to state a claim upon which relief can be granted "is not a true affirmative defense and shall not be considered as such.").

For this reason alone, Applicant's improper Affirmative Defenses should be stricken.

**B. Applicant's Affirmative Defenses Are Insufficiently Pled**

Applicant's Affirmative Defenses also fail to meet the sufficiency of the pleading standards governed by Federal Rule of Civil Procedure 8(b).

All of Applicant's Affirmative Defenses tender the "naked assertions" and unacceptable "bald allegations" that are widely regarded as insufficient under the applicable rules. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985). Applicant's boilerplate-type language, even if taken as true, does not support a well-pled claim. For example, conclusory statements that the trademarks are unlikely to be confused "[due to their differences in] sight, sound and commercial impression," because consumers are "careful and sophisticated," because "[the] goods sold [are] completely unrelated, are not sold from similar channels of trade, and do not share similar consumers," because "[the] marks do not sound [alike]," and because "[there would be no confusion as to] common source or affiliation or connection" do not provide Jim Beam proper notice of the basis of Applicant's assertions. *Id.* (Legal conclusions and "bald allegations" are insufficient under the standard).

Further, Applicant's First Affirmative Defense that Jim Beam allegedly fails to state a claim is also "insufficient as a matter of law." *Cent. Mfg. Co. v. Stealth, Ltd.*, 2004 TTAB LEXIS 348, \*2 (TTAB Jun. 22, 2004) (striking a similarly pled affirmative defense that Opposer "failed to state a claim" of likelihood of confusion as Opposer's factual "pleadings are sufficient to *allege* a cause of action"); *see also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Beam has alleged, *inter alia*, that it owns several incontestable registrations for the mark SKINNYGIRL, that it has prior use of its SKINNYGIRL marks in connection with a wide variety of goods, that its SKINNYGIRL marks are well-known and distinct, that Applicant's claimed goods are identical to Jim Beam's covered goods, that there is a likelihood of confusion between Jim Beam's SKINNYGIRL marks and Applicant's SKINNY BITCH mark as used in connection with Applicant's identical goods, and that Jim Beam would be damaged by registration of the Contested Mark. *See* Opposition, 1 TTABvue at 1-4. These pleadings are more than sufficient to allege a claim of likelihood of confusion as a matter of law.

Therefore, the Board should strike all of Applicant's Affirmative Defenses as insufficiently pled.

### **C. Applicant's Affirmative Defenses 2-6 Are Redundant**

Applicant's Second through Sixth (2-6) Affirmative Defenses are also redundant of earlier denials already provided by Applicant in its Answer, and do no more than restate prior denials of Jim Beam's claims. Restating prior denials as defenses adds nothing more to those denials, and any corresponding alleged defenses should therefore be stricken. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

For example, Applicant's Second Affirmative Defense stating that "[t]here is no similarity . . . as to sight, sound and commercial impression", is simply a repeat of Applicant's denial of Jim

Beam’s claim that the trademarks are “highly similar . . . in sight, sound and meaning.” Opposition, at ¶ 7; Answer, at ¶ 7 (denying allegation). This redundancy is true for each and every one of Applicant’s Second through Sixth Affirmative Defenses. Below is a list of Applicant’s affirmative defenses mapped to their respective earlier denials of Jim Beam’s claims.

<b>Affirmative Defense</b>	<b>Opposer’s Claim</b>	<b>Applicant’s Denial</b>
Second Affirmative Defense  (“There is no similarity . . . as to sight, sound and commercial impression.”)	Opposition, at ¶¶ 7, 9, 14  (“[the marks are] highly similar . . . in sight, sound and meaning.”)	Answer, at ¶¶ 7, 9, 14  (Applicant denies the allegations . . . .)
Third Affirmative Defense  (“any confusion or mistake amongst potential overlapping consumers [is] highly unlikely.”)	Opposition, at ¶¶ 10, 15  (“use of a highly similar trademark . . . will inevitably lead consumers to mistakenly believe that Jim Beam is the source of Applicant’s goods . . .”)	Answer, at ¶¶ 10, 15  (Applicant denies the allegations . . . .)
Fourth Affirmative Defense  (“The goods sold along with the relevant marks are completely unrelated . . . .”)	Opposition, at ¶¶ 9, 10, 14, 15  (“[Applicant’s mark] is proposed to be used in connection with identical goods.”)	Answer, at ¶¶ 10, 15  (Applicant denies the allegations . . . .)
Fifth Affirmative Defense  (“Opposer’s marks do not sound like the Applicant’s mark.”)	Opposition, at ¶¶ 7  (“[the marks are] highly similar . . . in sight, sound and meaning.”)	Answer, at ¶¶ 7  (Applicant denies the allegations . . . .)
Sixth Affirmative Defense  (“Ordinary Consumers would not confuse or conclude that the parties’ products share a common source or affiliation or connection.”)	Opposition, at ¶¶ 10  (“[Applicant’s mark] will inevitably lead consumers to mistakenly believe that Jim Beam is the source of Applicant’s goods and that Applicant is affiliated with, endorsed by, or sponsored by Jim Beam.”)	Answer, at ¶¶ 10  (Applicant denies the allegations . . . .)

Therefore, in addition to being procedurally defective and insufficiently pled, the Board should also strike Applicant’s Second through Sixth (2-6) Affirmative Defenses as redundant.

**D. Applicant's Seventh Affirmative Defense Is An Evidentiary Matter**

Finally, Applicant's Seventh Affirmative Defense stating that "[o]pposer has no examples of any actual confusion amongst consumers with regards to Applicant's mark and Opposer's marks" is an evidentiary matter and not a proper affirmative defense. Evidentiary matters are matters for proof, not for pleading. *See McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959). Therefore, Applicant's Seventh Affirmative Defense should be stricken on the additional basis that it is an evidentiary claim that will be proven or disproven after fact discovery rather than a viable affirmative defense to be raised at the pleading stage of this proceeding.

**E. The Current Proceeding Should be Suspended**

Jim Beam further moves the Board to suspend this Opposition until this Motion, which seeks dismissal of all Affirmative Defenses asserted by the Applicant, is resolved. In accordance with the TMBP, "[w]hen a party to a Board proceeding timely files a motion that is potentially dispositive of the proceeding . . . the case is considered automatically suspended by operation of 37 C.F.R. § 2.127(d) with respect to all matters not germane to the motion." TBMP § 510.03(a) (citing Fed. R. Civ. P. 12(b)); *Hollow form Inc. v. Delma Aeh*, 180 USPQ 284, 285 (TTAB 1973), *aff'd*, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975)). A suspension tolls the time for the parties to respond to outstanding discovery requests and to make required disclosures, thus deferring potentially unnecessary time and expense for both parties. *Id.*

**IV. CONCLUSION**

Jim Beam respectfully requests that the Board strike Applicant's First, Second, Third, Fourth, Fifth, Sixth, and Seventh Affirmative Defenses. As described more fully above, these defenses are: (i) procedurally defective (Affirmative Defenses Nos. 1-7), insufficiently pled

(Affirmative Defenses Nos. 1-7), redundant (Affirmative Defenses Nos. 2-7), and incapable of functioning as viable affirmative defenses because they are evidentiary claims (Affirmative Defense No. 7). Jim Beam further requests that the Board suspend this proceeding effective as of the filing of this Motion.

Dated: April 6, 2021

Respectfully submitted,

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