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

Proceeding no.	91282214
Party	Plaintiff FUN WINE (USA) LLC
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Submission	Motion to Strike Pleading/Affirmative Defense
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Date	05/02/2023
Attachments	FUN OLA Motion to Strike - 5.2.2023.pdf(127885 bytes)

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

Fun Wine (USA) LLC, Opposer, v. Obshchestvo s ogranichennoy otvetstvennostyu "Beverages from Chernogolovka-Aqualife", Applicant,	Opposition No.: 91282214 Mark: FUN + OLA U.S. Serial No.: 90876773

OPPOSER'S MOTION TO STRIKE APPLICANT'S IMPROPER AFFIRMATIVE DEFENSES IN APPLICANT'S ANSWER

Fun Wine (USA) LLC ("Opposer") hereby files its Motion to Strike Obshchestvo s ogranichennoy otvetstvennostyu "Beverages from Chernogolovka-Aqualife"'s ("Applicant's") Affirmative Defenses made in Applicant's Answer to Opposer's Notice of Opposition ("Applicant's Answer"). Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Sections 506.01 – 506.02 of the Trademark Trial and Appeal Board Manual of Procedure ("TMBP"), Opposer requests that the Trademark Trial and Appeal Board enter an order striking Applicant's "Affirmative Defenses" in Applicant's Answer.

ARGUMENT

Opposer now files this Motion to Strike portions of Applicant's Answer. A defendant should state the elements of an affirmative defense simply, concisely, and directly and should include enough detail to give the Opposer fair notice of the basis for the defense. TBMP 311.02(b); *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009).

Applicant provides the Affirmative Defenses under the header "**DEFENSES AND AMPLIFICATIONS.**" However, none of the so-called Affirmative Defenses and Amplifications are valid or appropriate in this matter. Opposer asks that they be stricken.

In Paragraph 14, Applicant gives a recitation of Applicant's Answer from Paragraphs 1 through 13. Evidentiary matters should not be pleaded in an answer. It does not amplify Applicant's claims and does not provide any information related to a valid affirmative defense.

In Paragraph 15, Applicant states Opposer's Notice of Opposition does not set forth a claim upon which the relief sought may be granted. Opposer claims that relief sought may be granted if the Notice of Opposition be sustained and that the USPTO refuses registration of Applicant's Application.

In Paragraph 16, Applicant states its arguments against likelihood of confusion. It does not amplify Applicant's claims and does not provide any information related to a valid affirmative defense.

In Paragraph 17, Applicant states Opposer should be denied all relief because it is before the Trademark Trial and Appeal Board with unclean hands. The equitable doctrine of "unclean hands" specifically prevents a plaintiff from relying on its pleaded registration if it "made a false statement during the prosecution of its application for registration or maintenance of its registration." *Aachi Spices & Foods v. Kalidoss Raju*, Cancellation No. 92058629 (TTAB Aug. 31, 2016); *See Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422, 425 (CCPA 1970). Applicant has not filed counterclaims for cancellation nor alleged any misconduct in the procurement of Opposer's marks. Therefore, Applicant's defense of "unclean hands" should be stricken from Applicant's Answer.

In Paragraph 18, Applicant states Opposer should be denied all relief on the grounds of laches, estoppel, unreasonable delay, and acquiescence. None of these defenses are generally available in the context of an opposition. TBMP 311.02(b)(2) Note 4; *see also Barbara's Bakery Inc. v. Landesman*, 82

USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding).

Moreover, Applicant's estoppel and laches claims are conclusory allegations. To prevail on its affirmative defense of laches, Applicant must allege "that there was undue or unreasonable delay [by Opposer] in asserting its rights, and prejudice to [Applicant] resulting from the delay." *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359 (Fed. Cir. 2001); *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes Inc.*, 971 F.2d 732 (Fed. Cir. 1992). Here, Applicant does not claim an undue or unreasonable delay or any other basis for a claim of laches.

To prevail on a claim of estoppel, Applicant is required to assert some affirmative act by Opposer that would lead Applicant to reasonably believe Opposer would not oppose Applicant's registration. *See DAK Industries Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1625 (TTAB 1992). Here, Applicant does not allege any activity or conduct by Opposer that could constitute an affirmative act to support a claim of estoppel.

Acquiescence is generally unavailable in opposition proceedings because the start date for which Opposer can be charged with inexcusable delay begins to run from the date the mark is published for opposition. *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG, 87* USPQ2d 1526, 1531 (TTAB 2008).

Further, acquiescence is a type of estoppel that is based upon the plaintiff's conduct that expressly or by clear implication consents to, encourages, or furthers the activities of the defendant, that is not objected to. *Christian Broad. Network, Inc. v. ABS-CBN Int'l,* 84 U.S.P.Q.2d 1560, 1573 (TTAB 2007). A successful claim of acquiescence requires proof of three elements, namely that: (1) the plaintiff actively represented that it would not assert a claim; (2) the delay between such active representation and the assertion of a claim was not excusable; and (3) the delay caused the defendant

undue prejudice. *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1409 (11th Cir. 1991) (holding that acquiescence requires active consent). *See also Hitachi Metals International, Ltd. v. Yamakyu Chain Kabushiki Kaisha,* 209 USPQ 1057 (TTAB 1981). Because Applicant has not argued any of the required elements to show acquiescence, this Affirmative Defense must also be stricken from the Answer.

Finally, Applicant argues that the Opposition should be dismissed on the grounds of "abandonment." It is unclear what Applicant means by this Affirmative Defense, as "abandonment" is not a defense, but an attack on the trademark rights of the opposing party. Applicant does not set forth any facts or claims in support of the "abandonment" affirmative defense. Therefore, it does not sufficiently put Opposer on notice of the defense and should be stricken from the Answer.

In Paragraph 19, Applicant states that Opposer lacks standing because the allegations in support of Opposer's belief that it will suffer damage do not have a reasonable basis in fact. It is clear that Opposer has a real interest in this proceeding as Opposer believes that, should Applicant's Application proceed to registration, Applicant will be given at least a prima facie right to exclusive use of the mark on related goods and services. Such use will cause a likelihood of confusion between Opposer's Marks and Applicant's Mark that would irreparably harm the Opposer's senior marks. Therefore, Opposer has asserted proper grounds for cancellation. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

As none of Applicant's "defenses" are permissible affirmative defenses that add additional information or amplify Applicant's position, Opposer asks that the Board strike Applicant's Affirmative Defenses and Amplifications in Applicant's Answer.

WHEREFORE, Opposer asks that the Applicant's Defenses and Amplifications be stricken from Applicant's Answer and that the Board grant this Motion to Strike.

Respectfully submitted,

Dated: May 2, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on May 2, 2023, a true and correct copy of the foregoing OPPOSER'S MOTION TO STRIKE is being served by electronic mail on Applicant as shown in the correspondence record in the Office, as follows:

mvoltchenko@kbsiplaw.com, trademarks@kbsiplaw.com, max.voltchenko@gmail.com

Respectfully submitted,

Dated: May 2, 2023

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