ESTTA Tracking number: **ESTTA1423603**
Filing date: **03/24/2025**

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

Proceeding no.	91296488
Party	Plaintiff Top Tobacco, L.P.
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Submission	Motion to Strike Pleading/Affirmative Defense
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Date	03/24/2025
Attachments	Motion to Strike Applicants Affirmative Defenses.pdf(24009 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the Matter of Application Serial No.: 90/242,522 for TOP SHELF CANNABIS	)	
TOP TOBACCO, L.P.,	)	Opposition No. 91296488
Opposer,	)	
v.	)	
PODWORKS CORP.,	)	
Applicant.	)	

OPPOSER'S MOTION TO STRIKE
APPLICANT'S AFFIRMATIVE DEFENSES

Applicant's Answer purports to set forth six affirmative defenses, each of which is legally insufficient on its face, requires unnecessary discovery and associated motion practice and serve only to clutter this proceeding. Accordingly, pursuant to Federal Rule of Civil Procedure 12(f) and TBMP §506, Top Tobacco, L.P. ("Top Tobacco") hereby moves for an order striking each of Applicant's affirmative defenses.

Top Tobacco appreciates that motions to strike are generally disfavored; however, motions to strike should be granted when they simplify the pleadings and save time and expense by excising any redundant, immaterial, or impertinent matter which will not have a bearing on the outcome of a proceeding. *Garlanger v. Verbeke*, 223 F. Supp. 2d 596, 609 (D.N.J. 2002); *see also Heller Fin., Inc. v. Midwhey Powder Co*., 883 F.2d 1286, 1294 (7th Cir. 1989) ("where… motions to strike remove unnecessary clutter from the case, they serve to expedite, not delay"). Here, as set forth more fully below, each of Applicant's affirmative defenses is either a "bare bones, conclusory" assertion of an affirmative defense that is not available to it in an opposition proceeding or merely

a redundant denial of Opposer's allegations that do nothing to amplify its defense of the proceeding.

In support of this Motion, Top Tobacco states as follows:

I. Applicant's Third and Fourth Affirmative Defenses for Laches and Acquiescence are Legally Untenable.

It has long been settled that neither defense is available to a defendant in a timely filed opposition proceeding. *See, e.g.,* TBMP 311.02(b)(1) ("In Board opposition proceedings, [equitable] defenses start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use"); *see also Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 2021 USPQ2d 1069, at *8 (Fed. Cir. 2021) ("Laches and acquiescence are generally not available as defenses in an opposition proceeding, given that the clock for laches begins to run from the date the application is published for opposition"); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches and acquiescence not available in opposition proceeding).

Here, Top Tobacco, as a matter of law, did not delay in initiating this Opposition on January 24, 2025, within its timely filed extension of time to oppose Applicant's mark. *See James Burrough Ltd. v. Lajoie, 174 USPQ 329, 331* (CCPA 1972) (holding that where Opposer timely filed opposition proceeding, the defense of acquiescence was inapplicable). Thus, these affirmative defenses cannot stand. Allowing them to remain in this proceeding will also require the parties to engage in unnecessary discovery and associated motion practice and otherwise waste the parties' and the Board's resources. They should therefore be stricken with prejudice.

II. Applicant's Fifth Affirmative Defense for Unclean Hands is Legally Untenable.

Applicant's Fifth Affirmative Defense of unclean hands also does not lie in this action as a matter of law and should be stricken with prejudice. An affirmative defense must contain

sufficient detail to provide fair notice of the basis for the defense to an opposer. *See* Fed. R. Civ. P. 8(b)(1). *See also Nike, Inc. v. Palm Beach Crossfit, Inc.*, Opp. No. 91218512, 2015 TTAB LEXIS 314, at *10 (TTAB 2015). Indeed, under Rule 8, affirmative defenses must do more than merely assert bare bones, conclusory allegations that fail to put a party on notice of the underlying bases for the purported defenses. *See Linc. Fin. Corp. v. Onwuteaka*, No. 95C4928, 1995 U.S. Dist. LEXIS 17825, at *8 (N.D. Ill. Nov. 30, 1995) (holding that "if an affirmative defense contains no more than 'bare bones conclusory allegations,' it must be stricken."). The defense of unclean hands, in particular, requires "specific allegations of misconduct by a plaintiff that, if proved, would prevent the plaintiff from prevailing on its claim." *See Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, Can. No. 92015133, 1987 TTAB LEXIS 22 at 5. (TTAB 1987).

Applicant's allegation of unclean hands does not even attempt to meet this standard. Rather, it is merely a statement that Top Tobacco's claims are barred under the doctrine of unclean hands. It is precisely the type of "bare bones" allegation regularly stricken as an insufficiently pled affirmative defense. Moreover, there is nothing Applicant has plead or can plead that that would support an unclean hands defense in this action. Top Tobacco's position in this proceeding reflects the current strength of its marks more than twenty years after its registration and follows the result of its effective enforcement of its rights over those two decades.

III. Applicant's Remaining Affirmative Defenses Improperly Clutter this Proceeding.

Applicant's remaining affirmative defenses are not proper affirmative defenses and should be similarly stricken with prejudice. An affirmative defense is an "assertion raising new facts and arguments that, if true, will defeat the plaintiff's . . . claim, *even if all allegations in the complaint are true*." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (emphasis added); *see also Royal Palm Sav. Ass'n v. Pine Trace Corp.*, 716 F. Supp. 1416, 1420 (M.D. Fla.

1989) (an affirmative defense is "one that admits to the complaint, but avoids liability, wholly or in partly, by asserting new allegations of excuse, justification, or other negating matters"). An affirmative defense is not an opportunity to challenge the sufficiency of a pleading. *See, e.g., Great Adirondack Steak & Seafood Cafe, Inc. v. Adirondack Pub & Brewery, Inc.*, 2015 TTAB LEXIS 321, at *9 (TTAB 2015) (citing *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n. 7 (TTAB 2001)). However, Applicant's First, Second, and Sixth Affirmative Defenses do just that.

Applicant's First Affirmative Defense alleges that Top Tobacco fails to state a claim upon which relief may be granted. But the Board has repeatedly stricken such a "defense" where, as here, the opposer has alleged facts that, if proven, would establish that "(1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration." *Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995). Top Tobacco's standing is established by its use of and registrations for its TOP mark in connection with similar smokers' products. *See* Notice of Opp. at ¶¶ 2-4. Top Tobacco has also alleged a likelihood of confusion in violation of 15 U.S.C. §1052(d) and that it will be harmed by the issuance of a registration to Applicant for the subject mark. *Id.* at ¶¶ 6-7. Thus, Top Tobacco's pleading is legally sufficient in stating a claim and Applicant's First Affirmative Defense should be stricken with prejudice.

Applicant's Second and Sixth Affirmative Defenses – that there is no likelihood of confusion and that Top Tobacco will not sustain damage, injury, or prejudice as a result of the registration – fail for the same reason. They are not proper affirmative defenses, but merely redundant denials of the merits of Top Tobacco's claim. An affirmative defense must raise matters that are distinct from, and not merely denials of, the elements of the opposing party's claims. *See*

Order of Sons of Italy in Am. v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1223 (TTAB 1995) (striking defense because it was "nothing more than a restatement of the denial"), *Royal Palm Sav. Ass'n v. Pine Trace Corp.*, 716 F. Supp. 1416, 1420 (M.D. Fla. 1989). While Top Tobacco recognizes that the TTAB has allowed technically deficient affirmative defenses to stand where they amplify the factual basis for an applicant's general denials, these bare bones assertions provide no such amplification. Applicant's Second Affirmative Defense is simply a restatement of its denial of the allegations in Paragraph 6 of the Notice of Opposition ("Applicant's TOP SHELF CANNABIS mark is likely to cause confusion with Top Tobacco's TOP mark"). Its Sixth Affirmative Defense is merely a restatement of its denial of the allegation in Paragraph 7 in the Notice of Opposition ("Top Tobacco believes that it would be damaged by registration of the TOP SHELF CANNABIS mark"). Neither provides any application of Applicant's position in this proceeding.

All of Applicant's Affirmative Defenses are unavailable to it in these proceedings or insufficient as a matter of law. All are precisely the type of invalid allegations that serve only to require unnecessary discovery and motion practice and serve only to clutter the proceeding. Striking these affirmative defenses will best serve the interests of the parties and the Board by removing irrelevant and unnecessary issues from the proceeding and allowing this case to move forward in a more efficient and focused manner.

WHEREFORE, Top Tobacco requests that the Board enter an Order striking each of Applicant's Affirmative Defenses from its Answer.

Respectfully submitted,

Dated: March 24, 2025

By: */s/ Alexandra R. Maloney*
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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES upon:

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