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

Proceeding	92043499
Party	Plaintiff FUJITSU LIMITED
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Submission	P's Mot to Strike D's "Affirmative Defenses"
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Attachments	P's Motion to Strike.pdf (7 pages)

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

FUJITSU LIMITED,

Petitioner,

v.

FUJITRONIC MANUFACTURING, INC.,

Registrant.

Cancellation No.: 92-043,499
Registration No.: 2,843,641
Mark: 富士通

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PETITIONER'S MOTION TO STRIKE
REGISTRANT'S "AFFIRMATIVE DEFENSES"

Petitioner, Fujitsu Limited, hereby moves the Trademark Trial and Appeal Board ("Board") to enter an order striking, in whole or in part, Registrant's "Affirmative Defenses" pursuant to Fed. R. Civ. P. 12(f) and Trademark Rule 2.116(a).

Registrant's Answer contains, under the heading of "Affirmative Defenses," numerous statements that are redundant, immaterial, legally insufficient as purported defenses, and highly prejudicial to Petitioner. As will be discussed infra, Registrant's "Affirmative Defenses" are facially insufficient and improper, provide no further notice or amplification of Registrant's intended defense(s), and are prejudicial to Petitioner. TBMP § 506.01. Each of Registrant's purported "Affirmative Defenses" are reproduced below and discussed in turn.

27. Petitioner's claims are barred, in whole or in part, because the Petition for Cancellation fails to state a claim upon which relief can be granted.

It is well settled that a plaintiff/petitioner may utilize a defendant's assertion of "failure to state a claim" to test the sufficiency of the purported defense by moving to strike the defense

under Fed. R. Civ. P. 12(f). Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1222 (TTAB 1995); S.C. Johnson & Son, Inc. v. GAF Corp., 177 USPQ 720, 720 (TTAB 1973). A registrant's affirmative defense of "failure to state a claim" should be duly stricken where the petitioner has alleged that (1) it has standing to challenge the registration and (2) there is a valid ground why the registrant is not entitled to maintain the registration. Lipton Indus., Inc. v. Ralston Purina Co., 213 USPQ 185, 187 (C.C.P.A. 1982).

Furthermore, when evaluating the sufficiency of pleadings, all averments must be taken as true and construed in the light most favorable to the pleading party. See Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys. Inc., 26 USPQ2d 1038, 1041 (Fed. Cir. 1993)(reversing and remanding district court's granting of Rule 12(b)(6) motion).

In the Petition for Cancellation, Petitioner has clearly alleged facts sufficient to establish standing to challenge registration no. 2843641 and has clearly alleged numerous valid grounds why Registrant is not entitled to maintain registration no. 2843641, including for example, that continued maintenance of registration no. 2843641 is likely to cause confusion within the meaning of Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)), continued maintenance of registration no. 2843641 is likely to cause dilution in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c)), and registration no. 2843641 was procured and obtained through fraud in violation of Section 14 of the Trademark Act (15 U.S.C. § 1064(3)).

Registrant's first "Affirmative Defense," numbered paragraph twenty-seven of Registrant's Answer, is insufficient as a matter of law and should be stricken. 5C Wright, Miller & Marcus, Federal Practice and Procedure, § 1381 (3d ed. 2004); see also e.g. Central Mfg. Co. v. Stealth, Ltd., 2004 TTAB Lexis 348, Opp. No. 91158263 (TTAB 2004)(non-precedential)(striking the applicant's "affirmative defense" that the notice of opposition failed to state a claim for relief).

28. Petitioner's claims are barred, in whole or in part, because Petitioner has not and will not suffer any injury or damage from the registration and continued registration of Registrant's U.S. Registration No. 2,843,641.

Registrant's purported "Affirmative Defense" number twenty-eight is a redundant and immaterial repetition of Registrant's previous denials of the salient allegations of the Petition for Cancellation. "Affirmative Defense" number twenty-eight is a mere duplication of Registrant's denials of paragraphs 16, 17, 18, 19, 21, 22, and 26, of the Petition for Cancellation.

Redundant "Affirmative Defense" number twenty-eight adds nothing to Registrant's Answer and should be stricken. Order of Sons of Italy in America v. Profumi Fratelli Nostra AG, 36 USPQ2d 1221, 1223 (TTAB 1995); see also e.g. Beneficial Franchise Co. v. MasterCard Int'l Inc., 1999 TTAB Lexis 679, Opp. No. 91107241 (TTAB 1999)(non-precedential)(striking the applicant's bald affirmative defense of "no injury or damage" where such defense was not based upon a valid and available defense).

29. Petitioner's claims are barred, in whole or in part, by the doctrine of estoppel.

30. Petitioner's claims are barred, in whole or in part, by the doctrine of laches.

31. Petitioner's claims are barred, in whole or in part, by the doctrine of acquiescence.

32. Petitioner's claims are barred, in whole or in part, by the doctrine of unclean hands.

Registrant's "Affirmative Defenses" twenty-nine, thirty, thirty-one, and thirty-two, are all insufficient as a matter of law, are highly prejudicial and injurious to Petitioner, and should

therefore be stricken from Registrant's Answer.

General rules of notice pleading are equally applicable to claims for relief under Fed. R. Civ. P. 8(a) and affirmative defenses under Fed. R. Civ. P. 8(c). See 5 Charles Alan Wright and Arthur R. Miller, Federal Practice and Procedure § 1274 (3d ed. 2004). An affirmative defense will be considered to be sufficient, and therefore not subject to a motion to strike, where the plaintiff is given fair notice of the nature and general basis of the affirmative defense(s). Id.; see also TBMP § 311.02(b)("However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.").

Registrant's "Affirmative Defenses" do nothing more than state the name of the purported defenses. Such bare bones, conclusory statements, without even an attempt to provide supporting facts, do not provide Petitioner with fair notice of the nature or bases of Registrant's alleged defenses. See 5 Charles Alan Wright and Arthur R. Miller, Federal Practice and Procedure § 1274, n. 7 (3d ed. 2004)("Affirmative defenses are subject to the pleading requirements of the rules generally requiring only **a short and plain statement of the facts**")(emphasis added).

Registrant's mere recitation of the names of certain affirmative defenses, which may not be available in the present *inter partes* proceeding, is insufficient an inadequate as a matter of law. See Shechter v. Comptroller of City of New York, 79 F.3d 265, 270 (2d Cir. 1996)("Affirmative defenses which amount to nothing more than mere conclusions of law and are not warranted by any asserted facts have no efficacy."(citations omitted)); Heller Financial, Inc. v. Midwhey Powder Co., 883 F.2d 1286, 1294-95 (7th Cir. 1989)(affirming the district court's decision to strike certain affirmative defenses consisting of "bare bones conclusory allegations" and noting that the district court properly ordered Rule 11 sanctions against the proffering attorney); Servpro Indus., Inc. v. Schmidt, 905 F. Supp. 475, 482-83 (N.D. Ill.

1995)(finding that merely stating the name of the legal theory on which an affirmative defense is based is insufficient).

Furthermore, as discussed above, Petitioner has properly and fully alleged that registration no. 2843641 was procured and obtained through fraud. Registrant's attempt to assert certain equitable defenses in "Affirmative Defenses" twenty-nine, thirty, thirty-one, and thirty-two, is improper as equitable defenses are not available against claims of fraud. Treadwell's Drifters Inc. v. Marshak, 18 USPQ2d 1318, 1320 (TTAB 1990)("equitable defenses are not available against the claims of fraud"); The Ohio State Univ. v. Ohio Univ., 51 USPQ2d 1289, n. 16 (TTAB 1999).

34. Registrant's use of its 富士通 mark does not create a likelihood of confusion among consumers that its goods are offered by, are sponsored by or are otherwise endorsed by Petitioner. Nor does Registrant's use of its mark create a likelihood that consumers falsely will believe that Registrant and Petitioner are affiliated in any way.

Similar to Registrant's purported "Affirmative Defense" number twenty-eight, "Affirmative Defense" number thirty-four is a redundant and immaterial repetition of Registrant's previous denials of the salient allegations of the Petition for Cancellation. "Affirmative Defense" number thirty-four is a mere duplication of Registrant's denials of paragraphs 16, 17, and 18, of the Petition for Cancellation, and should be stricken from Registrant's Answer.

35. Registrant's use of its 富士通' mark does not create a likelihood of dilution or actual dilution of any trademark rights properly claimed by Petitioner in the United States.

Registrant's "Affirmative Defense" thirty-five is once again a redundant and immaterial repetition of Registrant's previous denials of the salient allegations of the Petition for

Cancellation. "Affirmative Defense" number thirty-five is a mere duplication of Registrant's denials of paragraphs 20, 21, and 22, of the Petition for Cancellation, and should be stricken from Registrant's Answer.

Petitioner acknowledges that motions to strike are not favored, but also notes that the Board has repeatedly granted such motions in appropriate cases. TBMP § 506.01, n. 91. For the reasons discussed above, Petitioner asserts that Registrant's "Affirmative Defenses" contain numerous statements that are redundant, immaterial, legally insufficient as purported defenses, and highly prejudicial to Petitioner. Furthermore, striking the insufficient and improper "Affirmative Defenses" will remove unnecessary clutter from the present *inter partes* proceeding and will serve to expedite the proceeding. See Surface Shields, Inc. v. Poly-Tak Protection Sys., Inc., 213 F.R.D. 307, 307 (N.D. Ill. 2003)(striking numerous conclusory affirmative defenses and stating that "where motions to strike remove unnecessary clutter from the case, they serve to expedite, not delay"(quotations omitted)).

WHEREFORE, Petitioner prays that the Board strike, in whole or in part, Registrant's "Affirmative Defenses" contained within Registrant's Answer to the Petition for Cancellation.

Respectfully submitted,

FUJITSU LIMITED

Dated: 9/21/2004

By: ______________________

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of September, 2004, a true and correct copy of the foregoing PETITIONER'S MOTION TO STRIKE REGISTRANT'S "AFFIRMATIVE DEFENSES" was served on Registrant by sending the same via first class mail, postage prepaid, in an envelope addressed as follows:

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