

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**

Mailed: January 18, 2011

Cancellation No. 92053030

Jeffrey Kaplan

v.

Insight Pharmaceuticals LLC

Ann Linnehan, Interlocutory Attorney

This case now comes up for consideration of petitioner's motion (filed December 1, 2010) to strike all four of respondent's affirmative defenses from its answer. The motion is fully briefed.

In support of its motion, petitioner argues that with regard to the first affirmative defense, it has filed an intent-to-use application for a mark identical to the subject mark and so it clearly has standing; that with regard to the second affirmative defense, the defense has already been brought into issue by respondent's denial of certain allegations of the complaint; that with regard to the third affirmative defense, other unsubstantiated and unrelated prior Board matters between petitioner and other third-parties has no relevance to this proceedings; and that with regard to the fourth affirmative defense, respondent's

**Cancellation No. 92053030**

denial in paragraph 3 of the answer has already addressed this issue.

The Board may, upon motion or by its own initiative, order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See Fed. R. Civ. P. 12(f). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues under litigation. See, e.g., *FRA S.p.A. v. Surg-O-Flex of America, Inc.*, 194 USPQ 42, 46 (SDNY 1976); *Leon Shaffer Golnick Advertising, Inc. v. William G. Pendil Marketing Co., Inc.*, 177 USPQ 401, 402 (TTAB 1977).

After reviewing each of these defenses, the Board finds that the statements set forth by respondent in its first, second, and fourth affirmative defenses, while not technically affirmative defenses, amplify the denial of allegations previously set forth by respondent in its answer, and therefore have a bearing on the issues under litigation. Specifically, respondent's allegations apprise petitioner with greater particularity of the position which respondent is taking in the defense. See *Textron, Inc. v. The Gillette Company*, 180 USPQ 152 (TTAB 1973) and cases cited therein. Accordingly, respondent's first, second, and fourth purported "affirmative defenses" will not be stricken.

**Cancellation No. 92053030**

With regard to respondent's third affirmative defense concerning petitioner's lack of an intent to use its pleaded mark, the Board finds it appropriate to strike such defense to the extent that such an allegation constitutes an attempted collateral attack on the validity of opposer's pleaded mark and the only type of counterclaim that may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party (not an asserted application). See *Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055 (TTAB 1990); and *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983). Inasmuch as respondent's proposed attempted counterclaim does not seek cancellation of any registration owned by petitioner it is legally deficient.

In summary, petitioner's motion to strike is denied, in part, as to respondent's first, second, and fourth affirmative defenses, and granted, in part, as to respondent's third affirmative defense.

Proceedings are hereby resumed. Discovery and trial dates are reset as follows.

Deadline for Discovery Conference	2/18/2011
Discovery Opens	2/18/2011
Initial Disclosures Due	3/20/2011
Expert Disclosures Due	7/18/2011
Discovery Closes	8/17/2011
Plaintiff's Pretrial Disclosures	10/1/2011
Plaintiff's 30-day Trial Period Ends	11/15/2011

**Cancellation No. 92053030**

Defendant's Pretrial Disclosures	11/30/2011
Defendant's 30-day Trial Period Ends	1/14/2012
Plaintiff's Rebuttal Disclosures	1/29/2012
Plaintiff's 15-day Rebuttal Period Ends	2/28/2012

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Cancellation No. 92053030