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

RK

Mailed: February 8, 2013

Cancellation No. **92054617**

Nouvelle Parfumerie Gandour

v.

Y.Z.Y., Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

On January 29, 2013, the Board held a telephone conference to hear argument and rule on petitioner's motion (filed October 31, 2012) to strike respondent's affirmative defenses. Scott Austin, Esq., appeared on behalf of petitioner and Richard Ross, Esq., appeared on behalf of respondent.

As a preliminary matter, the notice of appearance filed by Justin Aida as secondary counsel for petitioner on November 20, 2012, is noted and the Board's records have been accordingly updated. Scott Austin remains as the primary counsel for petitioner.

It is further noted that petitioner filed its initial disclosures with the Board on December 11, 2012. As noted during the conference, initial disclosures, like requests for discovery, responses thereto, and materials or

depositions obtained through the discovery process, should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or in response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery. *See* Trademark Rule 2.120(j)(8). Accordingly, petitioner's initial disclosures will be given no further consideration.

Petitioner's Motion to Strike

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); and TBMP § 506.01 (3d ed. rev. 2012). While motions to strike are not favored, matter will be stricken if it clearly has no bearing upon the issues in the case. *See, e.g., Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988).

Turning then to petitioner's motion to strike, respondent's answer (filed October 11, 2012) lists four "affirmative defenses": 1) lack of standing; 2) laches; 3)

acquiescence; and 4) abandonment. Petitioner seeks to strike all four "affirmative defenses".

As to the first "affirmative defense" of standing, petitioner's motion to strike is hereby **GRANTED**. The Board has already determined in its order of September 6, 2012, that petitioner had sufficiently pleaded its standing. Standing is an element of opposer's substantive case-in-chief and is subject to proof. *See, e.g., Demon Intl LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008). Standing, therefore, is not an affirmative defense and Affirmative Defense No. 1 is hereby **STRICKEN**.[1]

As to the remaining defenses of laches, acquiescence, and abandonment, and as noted by the Board during the conference, it is insufficient to merely allege a defense without providing enough detail to give petitioner fair notice of the basis therefor. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999)(primary purpose of pleadings "is to give fair notice of the claims

[1] During the conference, respondent characterized its "affirmative defense" of lack of standing as "inartfully" pled and clarified that it was seeking to assert the defense of lack of subject matter jurisdiction based on its contention that petitioner lacks standing. As noted *supra*, standing must be proven by petitioner as part of its case-in-chief and contrary to respondent's assertions, standing in a Board proceeding is not a question of subject matter jurisdiction under Fed. R. Civ. P. 12(b)(1), as the Board has subject matter jurisdiction by virtue of Trademark Act §§ 13 and 14, 15 U.S.C. §§ 1063 and 1064. *See Humanetics Corp. v. Neways, Inc.*, 2003 WL 22022072 (TTAB 2003).

or defenses asserted"). Accordingly, Affirmative Defense Nos. 2, 3 and 4 are hereby **STRICKEN**.

Respondent is granted leave to replead Affirmative Defense Nos. 2, 3 and 4, if it believes it can sufficiently allege a basis therefor. However, and as discussed during the conference, the Board declines at this time to consider respondent's request to amend its pleading to include the defense of lack of subject matter jurisdiction without proper briefing. Notwithstanding the Board's comments in footnote 1 of this order, if respondent remains of the belief that it has a basis for raising the defense of lack of subject matter jurisdiction, it is allowed until **February 15, 2013**, to submit a brief in support thereof and briefing will proceed in accordance with Trademark Rule 2.127(a). Alternatively, if respondent opts to forego the defense of subject matter jurisdiction, respondent is allowed until **February 15, 2013**, to serve and file its amended pleading.

Proceedings herein are otherwise **SUSPENDED**.

* * *