UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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GCP

Mailed: August 6, 2015

Cancellation No. 92061648

Jerry's Famous Deli, Inc.

v.

Epicure Catering, LLC

By the Trademark Trial and Appeal Board:

This case now comes before the Board for consideration of Petitioner's motion (filed July 20, 2015) to strike Respondent's affirmative defenses set forth in its answer to Petitioner's petition to cancel. Respondent filed a timely response on August 3, 2015.

The Board carefully considered the arguments raised by the parties, as well as the supporting correspondence and the record of this case, in coming to a determination regarding Petitioner's motion to strike. The Board makes the following findings and determinations:

Petitioner's Motion to Strike

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible 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 (2015). Motions to strike are not favored, and matter will

not be stricken unless 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). Inasmuch as the primary purpose of pleadings under the Federal Rules of Civil Procedure is to give fair notice of the claims or defenses asserted, the Board may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. *See, e.g., Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (amplification of applicant's denial of opposer's claims not stricken). Further, a defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *See, generally,* Wright & Miller, 5C Fed. Prac. & Proc. Civ.3d § 1381 (2008). Nonetheless, the Board grants motions to strike in appropriate instances.

In its answer, Respondent asserts the following affirmative defenses:

Affirmative Defense No. 1

The Petition to Cancel fails to state a claim upon which relief may be granted.

Affirmative Defense No. 2

The claim set forth in the Petition to Cancel is barred in whole or in party [sic] by the doctrine of laches and unclean hands.

Affirmative Defense No. 3

The claim set forth in the Petition to Cancel is barred in whole or in part by the doctrines of waiver, acquiescence, and estoppel.

Affirmative Defense No. 4

Petitioners have not and will not be damaged by the registration of the EPICURE CATERING trademark and therefore lack standing to petition to cancel the registration.

Affirmative Defense No. 5

Petitioner's mark is not famous within the meaning of Section 43(c) of the Lanham Act, and thus it does not qualify for anti-dilution protection.

Affirmative Defense No. 6

Petitioner's marks are procured by fraud and thus invalid.

Affirmative Defense No. 7

Respondent's mark has a priority date which predates Petitioner's first use date.

Affirmative Defense No. 8

Petitioner's marks were abandoned.

Turning first to Respondent's Affirmative Defense No. 1, namely, that Petitioner's pleading fails to state a claim upon which relief may be granted, the Board notes that this asserted defense is not a true affirmative defense because it relates to an assertion of the insufficiency of Petitioner's pleading rather than a statement of a defense to a properly pleaded claim. In view thereof, this asserted defense will not be considered as such. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

Nonetheless, a motion to strike the defense of failure to state a claim upon which relief can be granted and/or insufficient notice pleading may be used by a plaintiff to test the sufficiency of its pleading in advance of trial. *Order of Sons of Italy in America*, 36 USPQ2d at 1222. Accordingly, in determining whether to strike

Respondent's Affirmative Defense No. 1, it is necessary to look at the sufficiency of Petitioner's petition to cancel.

In order to withstand the assertion that a pleading fails to state a claim, a plaintiff need only allege such facts that would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or canceling the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.***,** 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and TBMP § 503.02.

Following a careful review of Petitioner's petition to cancel, the Board finds that Petitioner's allegations regarding its standing, as well as its asserted claim of likelihood of confusion, are sufficiently pleaded. In view thereof, Petitioner's motion to strike Respondent's Affirmative Defense No. 1 is **GRANTED** and said defense is hereby stricken.

With regard to Respondent's Affirmative Defense Nos. 2 and 3, namely, the defenses of laches, unclean hands, waiver, acquiescence and estoppel, the Board finds that Respondent has failed to plead any facts to support these defenses and, therefore, these defenses are deficiently pleaded. *Topline Solutions, Inc. v. Sandler Systems, Inc.,* Civ. No. L–09–3102, 2010 WL 2998836, at *1 (D.Md. July 27, 2010)("After *Twombly* and *Iqbal,* an affirmative defense must be pled in a way that

is 'intelligible, gives fair notice, and is plausibly suggested by the facts.' " (citation omitted)); *Palmer v. Oakland Farms, Inc.,* 2010 WL 2605179, at *5–6 ("[T]he considerations of fairness, common sense and litigation efficiency underlying *Twombly* and *Iqbal* strongly suggest that the same heightened pleading standard should also apply to affirmative defenses."). Accordingly, Petitioner's motion to strike Respondent's Affirmative Defense Nos. 2 and 3 is **GRANTED** and these defenses are stricken.

Turning to Respondent's Affirmative Defense No. 5, i.e., that Petitioner's mark is not famous within the meaning of Section 43(c) of the Trademark Act and, therefore, Petitioner is not entitled to anti-dilution protection, the Board notes that Petitioner has not asserted a claim of dilution as a ground for cancellation. Accordingly, this defense is not relevant to the issues in this case. In view thereof, Petitioner's motion to strike Affirmative Defense No. 5 is **GRANTED** and said defense is stricken.

With regard to Respondent's defenses that Petitioner's marks were procured by fraud and have been abandoned, i.e., Affirmative Defense Nos. 6 and 8, the Board finds that these defenses constitute an impermissible collateral attack on the validity of Petitioner's pleaded registrations, which will not be heard in the absence of a counterclaim.[1] *See* Trademark Rule 2.106(b)(2)(ii) and TBMP § 303.01 and the cases cited therein. Because Respondent has not asserted counterclaims of fraud

[1] To the extent these defenses are being asserted against Petitioner's pleaded pending applications, the Board notes that it does not have jurisdiction over Petitioner's pleaded pending applications so as to entertain their validity. *See* TBMP § 605.03(c); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 n.7 (TTAB 1986).

and abandonment in this matter, Petitioner's motion to strike Respondent's Affirmative Defense Nos. 6 and 8 is **GRANTED** and these defenses are hereby stricken.

Turning to Respondent's Affirmative Defense No. 4 where Respondent maintains that Petitioner will not be damaged by the registration of Respondent's involved registered mark and, therefore, does not have standing in this case, the Board notes that because standing is an element of Petitioner's case that Petitioner must prove, there is no need for Respondent to plead lack of standing as an affirmative defense. Nevertheless, we see no harm in leaving this defense in the pleading since it puts Petitioner on notice that Respondent considers this to be an issue. Accordingly, Petitioner's motion to strike, as it pertains to Respondent's Affirmative Defense No. 4, is **DENIED**.

Finally, with regard to Respondent's Affirmative Defense No. 7, namely, that Respondent's mark has a priority date which predates Petitioner's first use date, the Board construes this defense as a mere amplification of Respondent's denials to the corresponding allegations in the petition to cancel and sees no harm in allowing this defense to remain since it provides Petitioner more complete notice of Respondent's position regarding Petitioner's asserted claim of likelihood of confusion. *See Order of Sons of Italy in America, supra,* 36 USPQ2d at 1223 (amplification of applicant's denial of opposer's claims not stricken). Accordingly, Petitioner's motion to strike, as it pertains to this defense, is **DENIED**.

Summary

In summary, Petitioner's motion to strike Respondent's affirmative defenses is **GRANTED**, in part, and **DENIED**, in part. Respondent's Affirmative Defense Nos. 1-3, 5-6, and 8 are stricken from Respondent's answer. Respondent's Affirmative Defense Nos. 4 and 7, however, may remain as part of Respondent's answer for the reasons set forth herein.

Trial Schedule

Proceedings are hereby resumed. Trial dates are reset as follows:

Deadline for Discovery Conference	**8/24/2015**
Discovery Opens	**8/24/2015**
Initial Disclosures Due	**9/23/2015**
Expert Disclosures Due	**1/21/2016**
Discovery Closes	**2/20/2016**
Plaintiff's Pretrial Disclosures Due	**4/5/2016**
Plaintiff's 30-day Trial Period Ends	**5/20/2016**
Defendant's Pretrial Disclosures Due	**6/4/2016**
Defendant's 30-day Trial Period Ends	**7/19/2016**
Plaintiff's Rebuttal Disclosures Due	**8/3/2016**
Plaintiff's 15-day Rebuttal Period Ends	**9/2/2016**

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 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.