ESTTA Tracking number:	**ESTTA1144937**
Filing date:	**07/07/2021**

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

Proceeding	92077087
Party	Plaintiff Medical Depot, Inc.
Correspondence Address	PINA M. CAMPAGNA CARTER, DELUCA & FARRELL LLP 576 BROAD HOLLOW ROAD MELVILLE, NY 11747 UNITED STATES Primary Email: docket@carterdeluca.com Secondary Email(s): pcampagna@carterdeluca.com, crieder@carterdeluca.com 631-501-5700
Submission	Motion to Strike Pleading/Affirmative Defense
Filer's Name	Pina Campagna
Filer's email	pcampagna@carterdeluca.com, crieder@carterdeluca.com, dock- et@carterdeluca.com
Signature	/Pina M. Campagna/
Date	07/07/2021
Attachments	01861313.PDF(227970 bytes)

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

In re Registration No. 6,116,976
Mark: MEDAIR
Registered: August 4, 2020

MEDICAL DEPOT, INC.,

Petitioner, CANCELLATION NO. 92077087

v.

MED WAY US INC.,

Registrant.

PETITIONER'S MOTION TO STRIKE ALL OF REGISTRANT'S AFFIRMATIVE DEFENSES AND PLEADINGS AND MEMORANDUM IN SUPPORT THEREOF

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure and Sections 506.01 and 506.02 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Petitioner Medical Depot, Inc. (“Petitioner”) respectfully requests that the Trademark Trial and Appeal Board (the "Board") enter an order striking all four of Registrant Med Way US Inc.’s (“Registrant”) affirmative defenses as well as paragraph 3 in the allegations in the Answer filed on June 16, 2021.

PRELIMINARY STATEMENT

As demonstrated below, Registrant’s affirmative defenses are unsupported by the facts and the law and the Paragraph 3 allegations are without merit and are factually incorrect. Registrant’s affirmative defenses and paragraph 3 allegations are naked allegations that are insufficient to give Petitioner notice of the basis for the claimed defenses, and do not plead the elements necessary to establish the affirmative defenses and paragraph 3 allegations. Such

boilerplate, naked assertions are inadequately pleaded and should be stricken to allow the parties to focus on the claims and defenses that are properly before the Board in this case. *See*, *e.g.*, *Sidney-Vinstein v. A.H. Robins* Co., 697 F.2d 880, 885 (9th Cir. 1983) ("the function of a 12(f) motion to strike is to avoid the expenditure of time and money that must arise from litigating spurious issues by dispensing with those issues prior to trial . . ."). Accordingly, pursuant to Fed. R. Civ. P. 12(f), 37 C.F.R. § 2.116(a), and TBMP § 506, Petitioner hereby requests that the honorable Board strike all four of Registrant's affirmative defenses and paragraph 3 allegations set forth in Registrant's Answer filed on June 16, 2021.

I. LEGAL STANDARDS

Registrant's affirmative defenses are insufficiently pleaded and should be stricken. The elements of a defense "should be stated simply, concisely, and directly" and "should include enough detail to give the plaintiff fair notice of the basis for the defense." TMBP § 311.02(b); Fed. R. Civ. P. 8. In contrast, Registrant's unsupported, bald, and conclusory allegations should be stricken. TMBP 506.01; Fed. R. Civ. P. 12(f); *see also Great Adirondack Steak & Seafood Cafe, Inc. v. Adirondack Pub & Brewery, Inc.*, 2015 TTAB LEXIS 321, *12–13 (TTAB 2015) (striking "bald, conclusory allegations that are not supported by any facts"). While motions to strike are not favored, the Board does not hesitate to strike affirmative defenses that fail to plead the required elements, or fail to plead sufficient facts, or fail to be founded on rules or case law, or amount to redundant denials. TMBP § 506.01; Fed. R. Civ. P. 12(f); *see also McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 U.S.P.Q. 45, 47 (TTAB 1985) ("bald allegations in the language of the statute neither give respondent fair notice of the basis for petitioner's claim nor set forth sufficient facts to establish the elements necessary for recovery, if proven.").

Registrant's paragraph 3 allegations are factually incorrect, without merit, and have no bearing upon the issues in the case and should be stricken. The TTAB "may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. The Board also has the authority to strike an impermissible or insufficient claim or portion of a claim from a pleading. Motions to strike are not favored, and matter usually will not be stricken unless it clearly has no bearing upon the issues in the case." TBMP 506.01.

II. ARGUMENT

A. Applicant's First Affirmative Defense of "Petitioner's Petition for Cancellation being barred by Registrant's prior and superior rights, including but not limited to Registrant's rights represented by Registrant's U.S. Registration No. 6,116,976" Should be Stricken as Immaterial

Registrant's first defense should be stricken because it is not a true affirmative defense and is immaterial because of Petitioner's prior common law rights. An assertion that "Petitioner's Petition for Cancellation being barred by Registrant's prior and superior rights, including but not limited to Registrant's rights represented by Registrant's U.S. Registration No. 6,116,976" is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading rather than a statement of a defense to a properly pleaded claim." *Great Adirondack Steak*, 2015 TTAB LEXIS 321 at *9 (citing *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1738 n.7 (TTAB 2015)). Registrant fails to allege any facts to supports its first purported defense and fails to point to any specific portion of Petitioner's Cancellation that is allegedly insufficient. As such, Applicant's first defense should be stricken as insufficiently pleaded. *See Great Adirondack Steak* at *9–12 (striking a similar defense of failure to state a claim upon which relief may be granted).

If Registrant was attempting to assert the *Morehouse* defense, also known as the prior-registration defense, which is an equitable doctrine that applies when an applicant[/registrant]

owns a prior registration "for essentially the same (or substantially similar) mark and goods or services, and which registration has not been challenged", the first affirmative defense then is not factually correct in that Registrant does not own a prior registration for essentially the same (or substantially similar) mark and goods or services, and which registration has not been challenged.

In essence, Registrant's first affirmative defense appears to relate to or equate with the "failure to state a claim upon which relief can be granted" defense. The Petition for Cancellation ("Cancellation") filed on May 7, 2021, clearly states a claim for relief. "To withstand a motion to dismiss for failure to state a claim upon which relief can be granted, an opposer need only allege such facts as would, if proved, establish that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration." *Order Sons of Italy in Am. v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1222, (TTAB 1995) (citing *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (CCPA 1982)). Opposer's[/Petitioner's] allegations must be accepted as true and the Cancellation must be construed in the light most favorable to Opposer[/Petitioner]. *Id*.

A party claiming prior use of a mark may petition to cancel a registration on the basis of such prior use pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064. Petitioner has sufficiently alleged both its standing and a valid ground for Cancellation by pleading its priority of use and common law rights, and a claim of likelihood of confusion. Petition for Cancellation at ¶¶1–17.

Consumers encountering Registrant's MEDAIR mark would likely be confused as to the source, origin, sponsorship and/or affiliation of Petitioner and/or Petitioners MED-AIRE Mark with Petitioner and/or Petitioner's MED-AIRE Mark. Petitioner has clearly stated a claim for

relief under section 2(d) of the Lanham Act based on likelihood of confusion. Therefore, Registrant's first affirmative defense of "prior registration rights" should be stricken since Petitioner's common law rights is priority over the Registrant's registration rights.

B. Applicant's Second Affirmative Defense of "No Likelihood of Confusion, Mistake or Deception" Should Be Stricken Because It Is Merely a Denial of Petitioner's Section 2(d) Claim

Registrant's second affirmative defense should be stricken because it is simply a denial of Petitioner's claim and is thus redundant matter under Fed. R. Civ. P. 12(f). *Textron, Inc. v. Gillette Co.*, 180 U.S.P.Q. 152, 154 (TTAB 1973) (striking an affirmative defense that merely reaffirmed Applicant's previous denial of Opposer's likelihood of confusion claim); *see also* TBMP § 506.01, n.7 (citing *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 U.S.P.Q.2d 1221, 1223 (TTAB 1995) (defense stricken as redundant, that is, as nothing more than a restatement of a denial in the answer and does not add anything to that denial)). Accordingly, Registrant's second affirmative defense should be stricken under Fed. R. Civ. P. 12(f).

C. Registrant's Third Affirmative Defense of "Unclean Hands" Consists of Mere Conclusory Allegations, Lacks the Requisite Particularity and Should Be Stricken as Insufficient

Registrant's third affirmative defense of unclean hands should be stricken because, as pled, it is merely conclusory and fails to state any facts whatsoever, let alone any facts that would give adequate notice of the basis for such defense. As TBMP § 300 makes clear, "[t]he elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis of the defense." Where a defense contains mere conclusory allegations that do not give an [petitioner] fair notice as to the

specific conduct which provides the basis for the defense, the defense will be stricken by the Board. See e.g., *Veles Int'l Inc. v. Ringing Cedars Press LLC*, Consolidated Opp. Nos. 91182303 and 91182304 (T.T.A.B. June 2, 2008) (Board struck, sua sponte, applicant's affirmative defenses of waiver, estoppel, and unclean hands, finding affirmative defenses legally insufficient where applicant provided no specific allegations of conduct in support of its affirmative defenses that would, if proven, prevent opposer from prevailing on its claims), citing *Lincoln Logs Ltd. v. Lincoln Precut Log Homes, Inc*., 971 F.2d 732, 23 U.S.P.Q.2d 1701 (Fed. Cir. 1992) and *Midwest Plastic Fabricators Inc. v. Underwriters Labs. Inc*., 5 U.S.P.Q.2d 1067 (T.T.A.B. 1987); *Activision Publ'g, Inc. v. Oberon Media, Inc*., Opp. No. 91195500, at 3-4 (T.T.A.B. September 10, 2010) (dismissing affirmative defense of unclean hands where applicant failed to allege specific conduct providing basis for defense). Moreover, Registrant's defense of unclean hands is legally insufficient for the additional reason that defenses based on fraud have a heightened pleading standard in that they must state the factual basis for such defenses with particularity. See 37 C.F.R. §2.106(b)(1); TBMP 311.02(b) (where fraud is pleaded, the provisions of Fed. R. Civ. P. 9 governing the pleading of that matter should be followed). The doctrine of unclean hands is rooted in the principle that equity demands "that its suitors . . . [act] fairly and without fraud or deceit as to the controversy in issue." *Precision Instrument Mfg. Co. v. Auto Maint. Mach. Co.,* 324 U.S. 806, 815 (1945). Conclusory statements that a Petitioner has unclean hands, absent a recitation of the facts reflecting the basis for the alleged inequitable conduct, do not meet the pleading requirements of Fed. R. Civ. P. 9. See e.g., *Cent. Admixture Pharm. Servs. v. Advanced Cardiac Solutions, P.C.,* 482 F.3d 1347, 1356 (Fed. Cir. 2007) ("inequitable conduct, while a broader concept than fraud, must be pled with particularity"). Since Registrant does not cite a single underlying fact in support of its defense of unclean hands,

this defense does not meet the pleading requirements of Fed. R. Civ. P. 9. In sum, since Registrant has failed to allege any facts or specific conduct in support of this affirmative defense that would, if proven, prevent Petitioner from prevailing on its claims, its affirmative defense of unclean hands should be stricken as insufficient.

D. Registrant's Fourth Defense of "Reservation of Rights to Raise Other Defenses" Should Be Stricken

Registrant's alleged fourth affirmative defense of reservation of rights is not an affirmative defense and does not provide fair notice to Petitioner because it is unaccompanied by any factual allegations supporting the claims. Such bare conclusory allegations, unsupported by any factual basis, should be stricken. *Great Adirondack Steak & Seafood Cafe, Inc. v. Adirondack Pub & Brewery, Inc.,* 2015 TTAB LEXIS 321, *12–13 (TTAB 2015). Affirmative defenses, like claims in a notice of opposition or petition for cancellation, must be supported by enough factual background and detail to fairly place the claimant on notice of the basis for the defenses. *See id*. at *8 (noting that "the primary purpose of pleadings is to give fair notice of the claims or defenses asserted"); *see also* TBMP §§ 309.03 and 311.02(b). Here, Registrant's defense of the right to raise further defenses are bald, conclusory allegations that are not supported by any facts. Even if this was an affirmative defense, none of the additional elements needed to support such a defense are even alleged. Thus, Registrant's fourth defense should be stricken because it is not an affirmative defense to begin with and its unsupported by any factual background to fairly place Petitioner on notice of the basis for the defenses.

E. Registrant's Paragraph 3 Pleadings Providing Baseless Allegations That Petitioner Did Not Consider the Term MED-AIRE To Be A Trademark Is Unfounded and Should be Stricken

Petitioner inadvertently failing to file a trademark application for the mark is not an indication that the Petitioner does not regard its use of the term MED-AIRE as that not of a trademark. As Registrant alleges, Petitioner is very diligent in applying for registrations of all of its marks and thus, this was simply an inadvertent error in failing to apply for registration since its use of the mark MED-AIRE in 2007. In addition, since Petitioner has recently applied for registration of its mark MED-AIRE and has filed this cancelation action against Registrant to enforce its priority and common law rights, Petitioner is illustrating consideration of the term MED-AIRE as a trademark contrary to Registrant's allegations.

Since there is no punishment or laches defense for failing to register a mark with the USPTO within a certain time frame, and in view of the fact that trademark rights arise in the United States from actual use of the mark, i.e., when a product is sold under a brand name, common law rights are created, and consumers view the brand name as an indicator of the product's source, Registrant's paragraph 3 allegations should be stricken as immaterial and baseless.

WHEREFORE, Petitioner respectfully requests that the honorable Board grant Petitioner's Motion to Strike in full and strike all of Registrant's affirmative defenses and at least paragraph 3 of the allegations. Moreover, the proceeding should be suspended pending consideration of Petitioner's Motion to Strike, and the deadlines for the initial discovery conference, discovery and trial periods should be reset accordingly.

DATED: July 7, 2021

Respectfully submitted,

/Pina M. Campagna/

Pina M. Campagna
David Carter
CARTER, DELUCA & FARRELL, LLP
576 BROAD HOLLOW ROAD
MELVILLE, NEW YORK 11747
Tel: (631) 501-5700
Fax: (631) 501-3526

CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of July, 2021, I caused a true and correct copy of the foregoing Motion to Strike to be served by email, upon the following domestic representative:

Frank J. Catalano
Gable Gotwals
1100 ONEOK Plaza
100 West Fifth Street
Tulsa, Oklahoma 74103-4217
fcatalano@gablelaw.com

/Pina M. Campagna/
Pina M. Campagna
Attorney for Petitioner