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

Proceeding	91195500
Party	Plaintiff Activision Publishing, Inc.
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Date	08/30/2010
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ACTIVISION PUBLISHING, INC.,	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91195500
	)	App. No. 77616864
OBERON MEDIA, INC.	)	Mark: HIP HOP HERO
	)	
Applicant	)	

OPPOSER'S MOTION TO STRIKE APPLICANT'S AFFIRMATIVE DEFENSES

Pursuant to Rule 12(f) of the Federal Rules of Civil Procedure, Opposer brings this motion to strike the three Affirmative Defenses pleaded in the Answer dated August 5, 2010 by Applicant. The applicable defenses are pleaded as follows:

1. Opposer fails to state a claim upon which relief can be granted.

2. There is no likelihood of confusion herein.

3. Opposer's claims are barred by the doctrine of unclean hands.

Within the meaning of Rule 12(f), the first and third defenses are insufficient and the second defense is redundant. Accordingly, all three should be stricken for the reasons set forth below.

A. The "No Likelihood of Confusion Defense" is Redundant

Opposer's Notice of Opposition in paragraphs 9 and 10 pleaded a likelihood of confusion between Opposer's marks and Applicant's mark, and Applicant denied those allegations in the corresponding paragraphs of its Answer. Accordingly, the second affirmative defense is simply redundant of Applicant's denials and therefore should be stricken. *See Textron, Inc. v. Gillette Co.,* 180 USPQ 152, 154 (TTAB 1973).

B. Opposer has Stated a Claim Upon Which Relief can be Granted

To state a claim upon which relief can be granted, an opposer needs only to allege standing and a valid ground to oppose. *See Order Sons of Italy in America v. Profumi Fratelli Nostra AG,* 36 USPQ2d 1221, 1222 (TTAB 1995). When those elements are met, an applicant's affirmative defense of failure to state a claim upon which relief can be granted must be stricken. *Id.* at 1222; *American Vitamin Products Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973).

Opposer has pleaded that it is the owner of various marks having at least one component word—HERO—that is identical to that component in Applicant's mark; that Opposer has priority of use over Applicant; that the goods identified by Applicant's mark ("computer and electronic game software") are identical or essentially the same as the goods identified by Opposer's marks; that a likelihood of confusion will result from the use of Applicant's mark; and that Opposer would be harmed by the issuance of any registration for Applicant's mark. *See* Notice of Opposition ¶¶ 2, 3, and 7-11. Opposer clearly has asserted a valid ground to oppose under Sections 2(d) and 43(c) of the Trademark Act, 15 U.S.C. §§ 1052(d) and 1125(c), and has established standing in that it is a competitor in the field of relevant goods and not a mere intermeddler. Thus, this opposition is proper under Section 13, 15 U.S.C. § 1063, and Applicant's second affirmative defense should be stricken as insufficient.

C. The Unclean Hands Defense is Insufficient

The pleading of an affirmative defense "should include enough detail to give the plaintiff fair notice of the basis for the defense." TBMP § 311.02(b) at n. 223 (2d Ed.). Applicant's third affirmative defense is merely a bald allegation of "unclean hands" without any supporting facts. Thus, its defense does not provide the requisite fair notice. This deficiency alone is sufficient basis for striking the defense. *See Board of Education of Thornton Township High School District 205 v. Board of Education of Argo Community High School District 217*, 2006 WL 2460590 at *4 (N.D. Ill.), *Global Poly Inc. v. Fred's Inc.*, 2004 WL 532844 at *6 (N.D. Ill.). *See also Cynergy Ergonomics, Inc. v. Ergonomics Partners, Inc.*, 2008 WL 2817106 at *5 (E.D. Mo.) (pleading of unclean hands and inequitable conduct). *Compare MPC Containment Systems, Ltd. v. Moreland*, 2008 WL 1775501 at *5-6 (N.D. Ill.) (in copyright infringement action, insufficient facts to support defense), *Safe Bed Technologies Co. v. KCI USA, Inc.*, 2003 WL 21183948 at *5 (N.D. Ill.) (in patent infringement action, insufficient facts to support defense).*

The lack of specificity in this affirmative defense is demonstrated by the additional unknown defenses that may be encompassed within the allegation of unclean hands. For example, Applicant's unspecified defense may harbor a collateral attack on the validity of one or more of Opposer's registrations and, in that event, the grounds must be stated by way of a counterclaim. *See* 37 CFR § 2.106(b)(2). Additionally, Applicant's defense may harbor a defense based on fraud. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.* 60 USPQ2d 1733, 1738 (TTAB 2001) ("[a]ssertion of the

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* Copies of all of the foregoing cases published electronically by Westlaw are submitted in an Appendix hereto.

defense of unclean hands … [is] often based on allegations of fraud"). In that regard, Rule 9(b) of the Federal Rules of Civil Procedure would require pleading with particularity.

The defense of unclean hands also must relate directly to Opposer's claim. "It thus seems clear that misconduct in the abstract, unrelated to the claim in which it is asserted as a defense, does not constitute unclean hands." *Warnaco Inc. v. Adventure Knits, Inc.*, 210 USPQ 307, 313 (TTAB 1981). *See also VIP Foods Inc. v. V.I.P. Food Products,* 200 USPQ 105, 113 (TTAB 1978) ("the defense of unclean hands may not be considered independently of the merits of the plaintiff's claim"). In the absence of specifics, Applicant's pleading must be regarded as insufficient to meet the relatedness requirement. This is another, independent basis for striking the unclean hands defense.

In short, Applicant's unspecified allegation of unclean hands does not provide fair notice of the defense and fails to indicate how the defense relates to Opposer's claim. Further, this defense may refer to conduct that should be pleaded by counterclaim or with particularity under Rule 9(b). Accordingly, this defense is insufficient and should be stricken.

D. Conclusion

In view of the foregoing deficiencies is Applicant's pleading and in consideration of the applicable law, Opposer respectfully submits that Applicant's three affirmative defenses must be stricken from its Answer, and that this motion must be granted.

Date: August 30, 2010

By: Michael Culver

Scott J. Major
Michael Culver

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