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

Proceeding	92065406
Party	Defendant Pharmadel LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of:

Registration No.:	4,581,604
Registered:	August 5, 2014
Trademark:	KOFAL

Plaza Izalco, Inc.,	
Petitioner,	Cancellation No. 92065406
v.	
Pharmadel, LLC,	
Registrant.	

REGISTRANT'S RESPONSE IN OPPOSITION TO PETITIONER'S MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES

Registrant, Pharmadel, LLC ("Registrant"), by and through undersigned counsel, hereby responds to the Motion to Strike Affirmative Defenses (the "Motion" or "Motion to Strike") filed by Petitioner Plaza Izalco, Inc. ("Applicant"), and in support states as follows:

I. SUMMARY OF ARGUMENT

The weaknesses in Applicant's arguments can most easily be summarized in a short outline:

A. Registrant's first two defenses of failure to state a cause of action as to lack of standing are supported by case law and function as an amplification of the Fourth Affirmative Defense.

B. Registrant's Third Affirmative Defense is proper on its face as it raises factual issues that should be determined on the merits.

C. Applicant's Motion to Strike Registrant's *Morehouse* Defense should fail because:

i) Applicant has proper notice of the defense;

ii) a debate over the verbiage of the proper standard is not a basis for a strike;

iii) the KOFAL and KOFAL-T Marks are substantially identical, as the Examiner also argued;

iv) the goods for all three relevant marks at issue are substantially identical or substantially similar, as the Examiner also found.

D. Registrant's Fifth, Sixth, and Seventh Affirmative Defenses should not be stricken because they provide proper notice and are pled with specificity.

E. The reservation of rights clause should not be stricken because, insofar as Registrant can subsequently amend to add additional defenses, amendments should be freely given in the interest of justice.

Applicant's Motion to Strike cites to a litany of case law that is inapplicable to the affirmative defenses as pled by Registrant, and Applicant's arguments fail to substantiate that any of Registrant's affirmative defenses are "redundant, immaterial, impertinent, or scandalous" as a matter of law. *See* TBMP § 506.01. For the reasons set forth below, Applicant's Motion to Strike should be denied in its entirety.

II. RESPONSE IN OPPOSITION

"Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case." TBMP § 506.01; *see also, Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). "The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted." *Great Adirondack Steak & Seafood Cafe, Inc. v. Adirondack Pub & Brewery, Inc.*, 2015 TTAB LEXIS

321, *8 (TTAB Mar. 30, 2015); TBMP § 506.01. "A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises issues that should be determined on the merits." TBMP § 506.01. "Thus, the Board, in its discretion, 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." *Id.* Motions such as this, to strike defenses applicable to *inter partes* trademark proceedings pursuant to Trademark Act Section 19 (15 U.S.C. § 1069), are generally not received well by the Board. *Guardian Royalty LLC v. Guardian Prot. Devices, Inc.*, 2000 TTAB LEXIS 855, *8 (TTAB Nov. 30, 2000)(denying motion to strike affirmative defenses).

A. Registrant's First Affirmative Defense Is Proper, Both On Its Own And As An Amplification.

Failure to state a cause of action *is* an affirmative defense, itself subject to analysis regarding whether it is valid. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222-23 (TTAB 1995) ("While Fed. R. Civ. P. 12(b)(6) permits a defendant to assert in the answer the 'defense' of failure to state a claim upon which relief can be granted, it necessarily follows that a plaintiff may utilize this assertion to test the sufficiency of the defense in advance of trial by moving under Fed. R. Civ. P. 12(f) to strike the 'defense' from the defendant's answer."). While Registrant notes that the aforementioned opinion seems to contradict cases cited by Applicant for this point of law, Applicant's cases are nonetheless inapposite because in this matter Registrant's affirmative defense of failure to state a cause of action is an amplification of its *Morehouse* defense and is not merely directed at an alleged defect in the pleading. *See* Registrant's Answer and Affirmative Defenses, Aff. Def. 4.

Where one affirmative defense is seen as an amplification of another, both are addressed together. *See Nebraska Brewing Co. v. Emerald City Beer Company, LLC*, 2015 TTAB LEXIS 359 at *18 (TTAB 2015). Moreover, where an answer provides a "road map" for a party's defense through allegations that bear on the issues of the case, same will not be stricken. *See Disney Enterprises, Inc. v. Ronica Holdings Limited*, 2015 TTAB LEXIS 128, *6 (TTAB 2015) ("The broad scope of the allegations in Applicant's answer have a bearing on the issues of the case and will not be stricken. Specifically, Applicant has provided a "road map" for its defense."). Here, the unchallenged registration for KOFAL-T –cited by the Examiner in refusing registrant's application—is the foundation for four affirmative defenses in Registrant's Answer, including Applicant's failure to properly state a cause of action.

Applicant's inability to validly state a cause of action stems from its lack of standing, itself the product of Applicant's inability to achieve any relief in this matter due to the unchallenged registration of KOFAL-T that will continue to subsist and prevent registration of Applicant's mark COFAL. Therefore, because Registrant's Fourth Affirmative Defense is valid and not subject to attack (as more fully set forth *infra* and in Registrant's Motion for Summary Judgment filed contemporaneously with the instant Response), Applicant's Motion to Strike Registrant's First Affirmative Defense should be denied.

B. <u>Registrant's Second Affirmative Defenses Is Similarly Proper Because It Is An Amplification Of The Fourth Affirmative Defense</u>.

Registrant's Second Affirmative Defense is that Applicant does not have standing because "Petitioner does not have a real interest in this matter and does not have a direct and personal stake in the outcome of this cancellation action (or in the maintenance of the registration of the mark KOFAL)." As with Registrant's First Affirmative Defense, the Second Affirmative Defense

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