ESTTA Tracking number: **ESTTA813620**

Filing date: **04/14/2017**

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

Proceeding	92065406
Party	Plaintiff Plaza Izalco, Inc.
Correspondence Address	OLIVER A RUIZ MALLOY & MALLOY PL 2800 SW 3RD AVE MIAMI, FL 33129 UNITED STATES jcmalloy@malloylaw.com, oruiz@malloylaw.com, jnmcdonald@malloylaw.com, litigation@malloylaw.com
Submission	Motion to Strike Pleading/Affirmative Defense
Filer's Name	/Oliver A. Ruiz/
Filer's e-mail	jcmalloy@malloylaw.com, oruiz@malloylaw.com, jnmcdonald@malloylaw.com, litigation@malloylaw.com
Signature	/Oliver A. Ruiz/
Date	04/14/2017
Attachments	2017 04 14 Motion to Strike Affirmative Defenses.pdf(334064 bytes)

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

In the matter of Registration No. 4,581,604
For the mark "KOFAL"

PLAZA IZALCO, INC.,	)	
Petitioner,	)	
vs.	)	Cancellation No. 92065406
PHARMADEL, LLC	)	
Registrant.	)	

MOTION TO STRIKE REGISTRANT'S AFFIRMATIVE DEFENSES

Petitioner Plaza Izalco, Inc. ("Petitioner"), by and through its undersigned counsel, and pursuant to Section 506.01 of the TBMP and Rule 12(f) of the Federal Rules of Civil Procedure, hereby moves for an Order striking the Registrant's Affirmative Defenses, and in support thereof, Petitioner states as follows:

I. INTRODUCTION

On March 24, 2017, Registrant filed its Answer and Affirmative Defenses. As detailed below, the Registrant's seven Affirmative Defenses are deficient because they recite conclusory, one sentence allegations with no factual or legal support, lack relevancy to the proceeding, and/or do not state a valid affirmative defense. Based on the following arguments and legal authorities, Registrant's Affirmative Defenses should be stricken with prejudice.

II. ARGUMENT

Section 506.01 of the TBMP provides that the Board may "order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter." *See*

also Fed. R. Civ. P. 12(f). While an affirmative defense "does not need detailed factual allegations, [it] requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). Affirmative defenses "are subject to the general pleading requirements of Rule 8(a) and will be stricken if they fail to recite more than bare-bones conclusory allegations." *Home Mgmt. Solutions, Inc. v. Prescient, Inc.*, No. 07-20608-CIV, 2007 U.S. Dist. LEXIS 61608, at *4-5 (S.D. Fla. Aug. 21, 2007). Registrant failed to state the elements or give enough detail of its defenses and the alleged defenses are conclusory and boilerplate in nature. *See* TBMP § 311.02(b). In failing to provide any factual basis for its defenses, lack of even formulaic recitations of the elements, and/or valid affirmative defenses, Petitioner does not have fair notice and all affirmative defenses should be stricken.

A. Registrant's First Affirmative Defense (Failure to State a Claim) Should be Stricken Because It Is Not An Affirmative Defense

The asserted "defense" of failure "to state a claim upon which relief may be granted" should be stricken because it relates to insufficiency of the pleading rather than a state of defense to a properly pleaded claim. This is an alleged defect in the pleading, not an affirmative defense. *See Aachi Spices & Foods v. Kalidoss Raju*, Cancellation No. 92058629, p. 4 (September 13, 2016) [not precedential]; *Blackhorse v. Pro Football, Inc.*, 98 U.S.P.Q.2D 1633, 1637 (TTAB 2011) [precedential]. Accordingly, this asserted "defense" should be stricken. *See id.; Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 U.S.P.Q.2d 1733, 1738 n.7 (TTAB 2001) [precedential]. Furthermore, this defense should be stricken with prejudice, since it is clear that Petitioner has standing to bring the proceeding, and has plead valid grounds for cancelling the registration at issue. *See* Petition to Cancel ¶¶ 1-10; TBMP § 503.02. Therefore, particularly at this stage of the litigation, the Petition to Cancel is legally sufficient.

B. Registrant's Second Affirmative Defense (Lack of Standing) Should be Stricken Because It Is Not An Affirmative Defense

This asserted "defense" is deficient because it is also not an affirmative defense. Similar to the arguments above, standing is an element of Petitioner's claim and an alleged defect in the pleading is not an affirmative defense. *See Blackhorse*, 98 U.S.P.Q.2D at 1637.

This defense should likewise be stricken with prejudice, because Petitioner alleged facts to show it has a "real interest" in the proceeding and a "reasonable basis" for being damaged by the registration of "KOFAL". *See* Petition to Cancel ¶¶ 4, 5, 6, 7. More specifically, Petitioner stated in its Petition to Cancel that its application to register the mark "COFAL" received a Section 2(d) refusal prefaced in part on the mark at issue in this proceeding. Petitioner has also alleged priority. *See id.*; TBMP § 309.03(b). Therefore, Petitioner has established standing.

C. Registrant's Third Affirmative Defense (Registrant's Marks "KOFAL" and "KOFAL-T" Began Use Prior to Petitioner Applying For Registration) Should be Stricken Because It Is Not An Affirmative Defense and Irrelevant

Registrant's third affirmative defense is not a recognized affirmative defense and asserts rights based on another registration that is not at issue in the current proceeding. Registrant claims rights based on the registration of "KOFAL-T", which are not relevant to the cancellation of the "KOFAL" mark. Furthermore, even if the registration was somehow relevant, this is not an affirmative defense under TBMP § 311.02(b), and therefore, should be stricken.

D. Registrant's Fourth Affirmative Defense (*Morehouse* Defense) Should be Stricken Because the Allegations are Improper, Insufficient, and Not Applicable

This asserted defense should be stricken for two primary reasons. First, Registrant misrepresents the *Morehouse* defense by alleging that Registrant owns an unchallenged registration for "the same *or* similar mark (KOFAL-T) on the same *or* similar goods," (emphasis added) which is a lower standard than that set out in *Morehouse Manufacturing Corp. v. J.*

Strickland and Co., 160 U.S.P.Q. 715, 717 (C.C.P.A. 1969) and TBMP § 311.02(b) n.2. Instead, the *Morehouse* standard requires that Registrant to show that it "owns a prior registration for ***essentially the same mark*** registered in connection with ***essentially the same services*** that are the subject of the involved registration". *Id.* (emphasis added).

Here, even if the proper standard was pled, neither the prior registration nor the goods identified in it can plausibly be characterized as "essentially the same" or "substantially the same" (as noted in other cases), when compared to the registration at issue in this proceeding. This is evident from a review of the two registrations, as set forth in the chart below:

MARK	"KOFAL"	"KOFAL-T"
CLASS(ES)	5, 10	5
GOODS	IC 5: Adhesive bandages; Adhesive bands for medical purposes; Analgesic and muscle relaxant pharmaceutical preparations; Analgesic balm; Anti-inflammatory gels; Anti-inflammatory salves; Anti-inflammatory sprays; Balms for medical purposes; Balms for pharmaceutical purposes; Curare for use as a muscle relaxant; Herbal topical creams, gels, salves, sprays, powder, balms, liniment and ointments for the relief of aches and pain; Medicaments for promoting recovery from tendon and muscle injuries and disorders and sports related injuries; Multipurpose medicated antibiotic cream, analgesic balm and mentholated salve; Muscle relaxants; Sports cream for relief of pain; Therapeutic spray to sooth and relax the muscles. IC 10: Drug delivery patches sold without medication; Elastic bandages.	IC 5: Analgesic balm.

As shown in the chart above, in addition to the additional and dissimilar elements in the "KOFAL-T" mark as compared to the alleged "KOFAL" mark, the goods are indisputably not

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.