UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

mbm

Mailed: November 30, 2017

Opposition No. 91235047

LEGO Juris A/S

v.

REXSITT Italia s.r.l.

Mary Beth Myles, Interlocutory Attorney:

Now before the Board is Opposer's motion (filed August 9, 2017) to strike each of the affirmative defenses asserted by Applicant in its answer to Opposer's notice of opposition. The motion is fully briefed.[1] Additionally, the Board notes Applicant's counsel's request to withdraw as counsel, filed October 24, 2017, which is also addressed herein.

I. Motion to Strike

The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. Therefore, the parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

[1] Applicant filed two copies of a brief in response to Opposer's motion to strike on August 23 and September 7, 2017. Although the responses appear to be identical, the Board has considered the timely August 23, 2017 response to be the correct submission for consideration.

Opposer has moved to strike each of Applicant's affirmative defenses, which are as follows:

> **First Affirmative Defense**
> Opposer's claims fail to state a cause of action upon which relief may be granted.
>
> **Second Affirmative Defense**
> Opposer's claims are barred by the doctrine of waiver.
>
> **Third Affirmative Defense**
> Opposer's claims are barred by the doctrine of laches.
>
> **Fourth Affirmative Defense**
> Opposer's claims are barred by the doctrine of estoppel, including equitable estoppel.
>
> **Fifth Affirmative Defense**
> Applicant reserves the right after further discovery to amend its Answer to Notice of Opposition and Affirmative Defenses and/or to add counterclaims.

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. Fed. R. Civ. P. 12(f); *Am. Vitamin Prods. Inc. v. DowBrands Inc.,* 22 USPQ2d 1313, 1314 (TTAB 1992); TBMP § 506.01 (June 2017). Motions to strike are not favored, and as such, 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. TBMP § 506.01. Moreover, the primary purpose of the pleadings is to give fair notice of the claims or defenses asserted. *Id; see also* TBMP §§ 309.03 and 311.02. 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. *See Order of Sons of Italy in Am. v. Profumi Fratelli,* 36 USPQ2d 1221, 1223 (TTAB 1995).

A. First Affirmative Defense—Failure to State a Claim

Applicant's first affirmative defense provides that the notice of opposition fails to state a claim upon which relief may be granted. A statement that the notice of opposition fails to state a claim upon which relief may be granted is not actually an affirmative defense, but is rather an attack on the sufficiency of the pleadings, which is properly asserted by separate motion filed prior to or concurrently with the answer. *See* Fed. R. Civ. P. 12(b)(6). The defense, when raised as an affirmative defense, is subject to a motion to strike, which sanctions the Board to determine the sufficiency of the pleadings. *See Order of Sons of Italy in Am.*, 36 USPQ2d at 1222 (citing *S.C. Johnson & Son Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973)).

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 proven, establish that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for opposing registration. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Specifically, a complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, a plaintiff must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," to state a claim plausible on its face. *Id.*

(*citing Twombly*, 550 U.S. at 555). Further, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. *See, e.g., Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.,* 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Fair Indigo LLC v. Style Conscience,* 85 USPQ2d 1536, 1538 (TTAB 2007).

1) Standing

Opposer must allege facts in the notice of opposition that, if ultimately proved, would establish that Opposer has a real interest in the proceeding and a reasonable basis for the belief that it will be damaged by the issuance of a registration. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Herbko Int'l v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *Ritchie v. Simpson*, 170 F.3d 1092, 1098, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

In support of its claims, Opposer has pleaded, *inter alia*, ownership of 11 registrations for marks consisting of or containing the word LEGO for a variety of goods and services. Opposer also alleges that it will be damaged by registration of the subject mark LEGOLA. These allegations, read in conjunction with the other allegations in the complaint, demonstrate that Opposer has a real interest in this opposition proceeding and thus, if proved, would establish its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) (registrations sufficient to establish direct commercial interest and standing). In view thereof, Opposer has sufficiently pleaded its standing.

2) Grounds for Opposition

The notice of opposition indicates that the grounds for opposition are: (1) likelihood of confusion pursuant to Section 2(d) of the Trademark Act; (2) dilution by blurring pursuant to Section 43(c) of the Trademark Act; and (3) dilution by tarnishment pursuant to Section 43(c) of the Trademark Act.

A. Likelihood of Confusion

In order to properly state a claim of likelihood of confusion, Opposer must plead that (1) Applicant's mark, used in connection with its goods, so resembles Opposer's mark as to be likely to cause confusion, mistake or deception; and (2) Opposer has either priority of use or a federal registration of Opposer's pleaded mark. *See* Fed. R. Civ. P. 8(a); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

The Board finds that Opposer has sufficiently pleaded a claim of likelihood of confusion. Opposer pleads that Applicant's mark is similar to Opposer's LEGO mark and that the goods and services are closely related. *See* Notice of opposition ¶¶ 9-10. The pleading is legally sufficient to the extent that it clearly contains allegations that, if proved, would establish Opposer's claim of likelihood of confusion under Section 2(d) of the Trademark Act.

B. Dilution by Blurring and Tarnishment

Pursuant to Section 43(c) of the Trademark Act:

> the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, ***commences use of***

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