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6 **IN THE UNITED STATES DISTRICT COURT**  
7 **FOR THE DISTRICT OF ARIZONA**

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9 BBK Tobacco & Foods LLP,  
10 Plaintiff,  
11 v.  
12 Skunk Incorporated, et al.,  
13 Defendants.

No. CV-18-02332-PHX-JAT

**ORDER**

14  
15 Pending before the Court is Plaintiff BBK Tobacco & Foods LLP (“BBK”) Motion  
16 to Strike Defendant Vatra, Inc.’s (“Vatra”) Affirmative Defenses. (Doc. 67). Vatra has  
17 responded, (Doc. 76), and BBK has replied, (Doc. 87). The Court now rules on the motion.

18 **I. BACKGROUND**

19 BBK uses the Skunk and Skunk Brand names to identify various smoking-related  
20 accessories. (Doc. 46 at 2). BBK filed a complaint in this Court against Defendants Skunk,  
21 Inc. and Vatra alleging in pertinent part: (1) federal trademark infringement; (2) federal  
22 false designation of origin and representation; (3) trademark infringement under Arizona  
23 common law; and (4) unfair competition under Arizona common law. (Doc. 49 at 10-26).  
24 Vatra’s answer pleaded five affirmative defenses in response. (Doc. 55 at 35-42). BBK  
25 now moves to strike all five affirmative defenses. (Doc. 67).

26 **II. DISCUSSION**

27 **a. Legal Standard**

28 Motions to strike are governed by Federal Rule of Civil Procedure (“Rule”) 12(f).

1 Under Rule 12(f), the Court has discretion to “strike from a pleading an insufficient  
2 defense,” Fed. R. Civ. P. 12(f), such as those that are not, in fact, affirmative defenses, see  
3 *Craten v. Foster Poultry Farms Inc.*, No. CV-15-02587-PHX-DLR, 2016 WL 3457899, at  
4 \*3 (D. Ariz. June 24, 2016), or those that are insufficiently pleaded, *Verco Decking, Inc. v.*  
5 *Consol. Sys., Inc.*, No. CV-11-2516-PHX-GMS, 2013 WL 6844106, at \*4 (D. Ariz. Dec.  
6 23, 2013). Because “the only pleading requirement for an affirmative defense . . . is that ‘a  
7 party must affirmatively state’ it,” *id.* at \*5 (quoting Fed. R. Civ. P. 8(c)(1)), “[t]he key to  
8 determining the sufficiency of pleading an affirmative defense is whether it gives plaintiff  
9 fair notice of the defense,” *Wyshak v. City Nat’l Bank*, 607 F.2d 824, 827 (9th Cir. 1979).  
10 Thus, contrary to BBK’s position, courts in this district have consistently declined to apply  
11 the heightened “plausibility” standard coined in *Twombly* and *Iqbal* to affirmative  
12 defenses. See *Craten*, 2016 WL 3457899, at \*3 (collecting cases).

13 In addition, given the generally “limited importance of pleading in federal practice,”  
14 motions to strike are disfavored because they seek a drastic remedy and are often used as  
15 a delaying tactic. *XY Skin Care & Cosmetics, LLC v. Hugo Boss USA, Inc.*, No. CV-08-  
16 1467-PHX-ROS, 2009 WL 2382998, at \*1 (D. Ariz. Aug. 4, 2009) (quoting *Mag*  
17 *Instrument, Inc. v. JS Prods., Inc.*, 595 F. Supp. 2d 1102, 1106 (C.D. Cal. 2008)). As such,  
18 even when a motion to strike an insufficient defense is “technically appropriate and well-  
19 founded, Rule12(f) motions often are not granted in the absence of a showing of prejudice  
20 to the moving party.” 5C Charles A. Wright & Arthur R. Miller, *Federal Practice and*  
21 *Procedure* § 1381 n.34 (3d ed. 2019) (collecting cases); see also *J & J Sports Prods., Inc.*  
22 *v. Vargas*, No. CV 11-2229-PHX-JAT, 2012 WL 2919681, at \*1 (D. Ariz. July 17, 2012);  
23 *XY Skin Care & Cosmetics*, 2009 WL 2382998, at \*1. Prejudice can be found “where  
24 superfluous pleadings may confuse the jury, or where a party may be required to engage in  
25 burdensome discovery around frivolous matters.” *Harris v. Chipotle Mexican Grill, Inc.*,  
26 303 F.R.D. 625, 628 (E.D. Cal. 2014) (quoting *J & J Sports Prods., Inc. v. Luhn*, Civ No.  
27 2:10-3229 JAM CKD, 2011 WL 5040709, at \*1 (E.D. Cal. Oct. 24, 2011)).

28 **b. First Affirmative Defense**

1 Vatra's First Affirmative Defense contends that BBK's action is barred by the  
2 doctrine of unclean hands because U.S. Registration No. 2,434,666 ("Reg. No. '666") was  
3 fraudulently procured, and BBK deceptively included the federal registration symbol on  
4 goods that it possessed no registration for. (Doc. 55 at 35). BBK contends this is not a  
5 proper affirmative defense because Vatra can still be liable for infringement even if BBK's  
6 registrations are invalid. (Doc. 67 at 5). Vatra responds that: (1) its answer fully provides  
7 BBK with fair notice; (2) BBK fails to identify how the presence of this defense in the  
8 answer causes it prejudice; and (3) BBK's contention misstates the law. (Doc. 76 at 6).

9 Although it is generally true that affirmative defenses preclude liability despite the  
10 truth of a plaintiff's allegations, see *G & G Closed Circuit Events, LLC v. Nguyen*, No. 10-  
11 CV-00168-LHK, 2010 WL 3749284, at \*5 (N.D. Cal. Sept. 23, 2010), even if BBK is  
12 correct that the First Affirmative Defense would not achieve this end,<sup>1</sup> it fails to show how  
13 the presence of the defense in Vatra's answer causes it prejudice. In its reply brief, BBK  
14 raises a global objection that "if the [C]ourt were to permit legally unsustainable defenses  
15 to survive, [BBK] would be required to conduct expensive and potentially unnecessary  
16 discovery." (Doc. 87 at 3).<sup>2</sup> Yet BBK does not even attempt to explain why Vatra's  
17 allegations that BBK deceptively misused the federal registration symbol or fraudulently  
18 procured Reg. No. '666, "could have 'no possible bearing on the subject matter of the  
19 litigation.'" *J & J Sports Prods.*, 2012 WL 2919681, at \*1 (quoting *Rosales v. Citibank*,  
20 *Fed. Sav. Bank*, 133 F. Supp. 2d 1177, 1180 (N.D. Cal. 2001)). Indeed, far from raising  
21 frivolous matters, the allegations of Vatra's First Affirmative Defense may "provide  
22 additional context . . . [or] useful background information relevant" to the various claims  
23 involved in this case, particularly Skunk's counterclaims based on fraud. See *Martinez v.*

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25 <sup>1</sup> Although courts have held that fraudulent procurement will not preclude a plaintiff from  
26 enforcing any of its common-law trademark rights, 6 J. Thomas McCarthy, *McCarthy on*  
27 *Trademarks and Unfair Competition* § 31:60 & n.1 (5th ed. 2019) (collecting cases), other  
28 courts have reasoned that intentional misuse of a federal registration symbol is "a form of  
inequitable 'unclean hands' so as to bar . . . the maintenance of an infringement case," 3  
id. § 19:146 & n.8 (collecting cases).

<sup>2</sup> Although BBK first raised this argument in its reply brief, the Court can consider it  
because it responds to arguments set forth in the opposition brief. *Rawls v. Maricopa*  
*County*, No. CV-10-231-PHX-GMS, 2010 WL 2927309, at \*1 (D. Ariz. July 23, 2010).

1 County of Sonoma, No. 15-cv-01953-JST, 2016 WL 39753, at \*6 (N.D. Cal. Jan. 4, 2016).  
2 The Court also finds unpersuasive BBK’s general contention that discovery would be  
3 unduly burdensome. As the Court recently reminded the parties, a party propounding an  
4 overly burdensome discovery request may be required to bear the costs of its request.

5 Accordingly, the Court will deny BBK’s motion as to Vatra’s First Affirmative  
6 Defense.

7 **c. Second Affirmative Defense**

8 Vatra’s Second Affirmative Defense alleges that BBK’s action is barred by the  
9 doctrines of “laches, estoppel, waiver, and/or acquiescence.” (Doc. 55 at 37). BBK argues  
10 that the Court must strike this affirmative defense because Vatra failed to allege facts  
11 sufficient to state a plausible defense. (Doc. 67 at 6). In its response, Vatra quarrels with  
12 BBK’s use of the “Twombly/Iqbal framework” and maintains that it has pleaded sufficient  
13 facts. (Doc. 76 at 9).

14 BBK’s assertion that Vatra’s answer failed to allege facts to support every element  
15 of acquiescence, waiver, and estoppel is inapposite. “The Federal Rules . . . do not require  
16 a defendant to set out the specific elements of each defense pleaded,” so long as the  
17 pleading still provides the plaintiff with fair notice of the defense. *Roxbury Entm’t v.*  
18 *Penthouse Media Grp., Inc.*, No. 2:08-cv-03872-FMC-JWJx, 2009 WL 2950324, at \*6  
19 (C.D. Cal. April 3, 2009). A court may even deny a motion to strike when the defendant  
20 has provided no more than an unadorned list of affirmative defenses, because such a list  
21 still “affirmatively state[s]” the defenses. *FTC v. Elec. Payment Sols. of Am., Inc.*, No. CV-  
22 17-02535-PHX-DJH, 2017 WL 10505266, at \*1 (D. Ariz. Dec. 13, 2017); *Mag Instrument*,  
23 595 F. Supp. 2d at 1108 (recognizing that in some cases “merely pleading the name of the  
24 affirmative defense . . . may be sufficient” (quoting *Woodfield v. Bowman*, 193 F.3d 354,  
25 361 (5th Cir. 1999)). The absence of facts in Vatra’s answer supporting the specific  
26 elements of these legal doctrines does not deprive BBK of fair notice here because, as its  
27 own motion indicates, BBK is evidently aware of the elements of these defenses and what  
28 facts will be necessary to establish them. *See Roxbury Entm’t*, 2009 WL 2950324, at \*6–7

1 (declining a motion to strike on this basis).

2 BBK also fails to show that the presence of these allegations in Vatra’s answer will  
3 subject it to prejudice. Similar to the allegations discussed in the previous section, Vatra’s  
4 allegation that BBK was aware that Skunk was using the word “Skunk” and a Skunk tail  
5 to identify its products as early as 2014, but did not attempt to enforce its mark until 2018,  
6 may provide additional context and useful background information relevant to this  
7 lawsuit.<sup>3</sup> (Doc. 55 at 37). Therefore, BBK not only fails to show that Vatra did not comply  
8 with the pleading standards for affirmative defenses, it also fails to show that it is  
9 prejudiced by the Second Affirmative Defense.

10 Accordingly, the Court will deny BBK’s motion as to Vatra’s Second Affirmative  
11 Defense.

12 **d. Third Affirmative Defense**

13 In its Third Affirmative Defense, Vatra alleges that BBK has either never used, or  
14 has ceased using, its marks in connection with some or all of the goods listed in BBK’s  
15 federal trademark registrations. (Doc. 55 at 38-39). BBK asks the Court to strike this  
16 defense, contending it merely asserts a “defect in Plaintiff’s prima facie case . . . that does  
17 not excuse . . . Vatra’s liability.” (Doc. 67 at 13). Vatra maintains that abandonment is a  
18 proper affirmative defense and, in any event, BBK fails to explain what prejudice would  
19 occur if the defense was not stricken. (Doc. 76 at 10-11).

20 As noted, it is generally true that affirmative defenses excuse liability even if the  
21 plaintiff’s allegations are all proven true, *G & G Closed Circuit Events*, 2010 WL 3749284,  
22 at \*5, but BBK’s argument here is contrary to the scheme of the Lanham Act which  
23 envisions abandonment as an affirmative defense to the enforcement of a registered mark.  
24 Under 15 U.S.C. § 1115(a), registration on the principle register is “prima facie evidence  
25 of the validity of the registered mark and of the registration of the mark, of the registrant’s

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27 <sup>3</sup> As the Court reads the answer, Vatra alleges that BBK had notice of Skunk’s use of the  
28 Skunk word mark in 2014. (Doc. 55 at 37). At this stage, the Court must presume the truth  
of that allegation, meaning that the Court must reject BBK’s contrary argument that Vatra’s  
own admissions establish that BBK filed suit within the applicable statute of limitations,  
rendering laches entirely inapplicable. (Doc. 67 at 7).

1 ownership of the mark, and of the registrant’s exclusive right to use the registered mark in  
2 commerce or in connection with the goods or services specified in the registration” but  
3 such registration “shall not preclude another person from proving any legal or equitable  
4 defense or defect, including those set forth in subsection(b).” Because §1115(a) places the  
5 burden on the party asserting any defense, including those under § 1115(b), defenses under  
6 § 1115(b) are affirmative defenses. 6 J McCarthy, supra, § 32:149.<sup>4</sup> Given that  
7 abandonment is specifically listed at § 1115(b)(2), the Court rejects BBK’s contention that  
8 it is not a proper affirmative defense. See, e.g., Novadaq Techs., Inc. v. Karl Storz GmbH  
9 & Co. K.G., 143 F. Supp. 3d 947, 953–54 (N.D. Cal. 2015) (describing abandonment as a  
10 permissible affirmative defense); G & G Closed Circuit Events, 2010 WL 3749284, at \*3  
11 (same); *Roxbury Entm’t*, 2009 WL 2950324, at \*6 (same).

12 Moreover, just as with its other arguments, BBK provides the Court with no basis  
13 to conclude that it would suffer prejudice if the Third Affirmative Defense is not stricken  
14 beyond its global assertion that it would have to engage in discovery. Because whether  
15 BBK abandoned some or all of the goods for which its marks were registered remains  
16 relevant to this litigation, BBK will not be prejudiced by any discovery related to this issue.

17 Accordingly, the Court will deny the motion to strike as to Vatra’s Third  
18 Affirmative Defense.

19 **e. Fourth Affirmative Defense**

20 Vatra’s Fourth Affirmative Defense alleges that BBK has no enforceable rights in  
21 its marks because they are generic or, alternatively, merely descriptive. (Doc. 55 at 39).  
22 BBK asserts that Vatra’s defense is both implausible and improper because it attacks  
23 BBK’s prima facie case. (Doc. 67 at 12-14). Vatra responds that genericness and mere  
24 descriptiveness are proper affirmative defenses and that it properly pleaded them. (Doc. 76  
25 at 11-13).

26 The Court first rejects BBK’s contention that Vatra’s Fourth Affirmative Defense  
27 is not a proper affirmative defense. Courts have allowed defendants to raise both

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28 <sup>4</sup> To be clear, the statutory language indicates that the list of defenses listed in § 1115(b) is not exhaustive.

1 genericness, *TE-TA-MA Truth Found.—Family of URI, Inc. v. World Church of the*  
2 *Creator*, 297 F.3d 662, 665 (7th Cir. 2002), and descriptiveness, *Marketquest Grp., Inc. v.*  
3 *BIC Corp.*, 316 F. Supp. 3d 1234, 1265–66 (S.D. Cal. 2018), as affirmative defenses in  
4 trademark disputes. As discussed in the previous section, doing so is supported by language  
5 in the Lanham Act contemplating that the party defending against trademark infringement  
6 of a registered mark must “prove[] any legal or equitable defense or defect . . . which might  
7 have been asserted if such mark had not been registered.” 15 U.S.C. § 1115(a); see also 2  
8 *McCarthy*, supra, § 11:43; 6 *id.* § 32:149.

9       Turning to whether Vatra adequately pleaded its Fourth Affirmative Defense, the  
10 Court observes that the parties raise essentially the same arguments concerning these  
11 allegations as they did in their briefs on BBK’s motion to dismiss Skunk’s counterclaims.  
12 (Doc. 120 at 7-12). The Court resolved that motion, in pertinent part, by dismissing most  
13 of Skunk’s counterclaims for cancellation based on genericness and leaving those based on  
14 descriptiveness intact. (*Id.* at 12, 16).

15       Despite its prior conclusion on Skunk’s genericness counterclaim, the Court will not  
16 strike Vatra’s Fourth Affirmative Defense. Once again, aside from its global objection to  
17 further discovery, BBK fails to show it will suffer prejudice if the Court does not strike the  
18 affirmative defense. Vatra’s genericness affirmative defense is intertwined with its  
19 allegations regarding descriptiveness. Those allegations clearly satisfy the pleading  
20 requirements of Rule 8(c) and remain relevant to the parties’ dispute. Thus, BBK’s global  
21 objection to further discovery fails to demonstrate it will suffer prejudice such that the  
22 Court must strike the Fourth Affirmative Defense.

23       Accordingly, the Court will not grant BBK’s motion to strike as to Vatra’s Fourth  
24 Affirmative Defense.

25       **f. Fifth Affirmative Defense**

26       In its Fifth Affirmative Defense, Vatra alleges that BBK “has not plead[ed]  
27 allegations necessary to support an assertion that [it] has common law rights in these marks,  
28 much less common law rights that pre-date Skunk’s first use.” (Doc. 55 at 41-42). BBK

1 argues that this is neither a proper affirmative defense nor did Vatra properly plead it. (Doc.  
2 67 at 14). Vatra claims that it has provided BBK with “fair notice that it has not adequately  
3 alleged [its] common law rights” in the relevant marks. (Doc. 76 at 13-14).

4 Vatra’s Fifth Affirmative Defense essentially amounts to a contention that BBK has  
5 failed to set forth sufficient facts to constitute a cause of action. As courts in this and other  
6 districts have reasoned, this allegation is not a proper affirmative defense; instead, it is  
7 more properly brought as a motion to dismiss under Rule 12(b)(6). See, e.g., Craten, 2016  
8 WL 3457899, at \*3; Barnes v. AT & T Pension Benefit Plan-Nonbargained Program, 718  
9 F. Supp. 2d 1167, 1174 (N.D. Cal. 2010). Nonetheless, this Court will not strike the Fifth  
10 Affirmative Defense because—here too—BBK fails to show prejudice stemming from the  
11 presence of this affirmative defense in Vatra’s answer. Vatra’s allegations generally  
12 concern when BBK first used its marks and with what goods. This information will be  
13 relevant to the scope and priority of any common law rights that BBK may have in the  
14 marks at issue. As BBK’s own repeated assertions demonstrate, (See Docs 67 at 5-6; 87 at  
15 4, 5, 8), the nature of its common law rights will be of great importance to this litigation  
16 because a mark need not necessarily be registered to be enforceable—a plaintiff may still  
17 be able to enforce his mark under the common law. *Specialized Seating, Inc. v. Greenwich*  
18 *Indus., LP*, 616 F.3d 722, 728 (7th Cir. 2010); *Far Out Prods., Inc. v. Oskar*, 247 F.3d 986,  
19 996 (9th Cir. 2001); see also 6 McCarthy, *supra*, § 31:60. Because Vatra’s allegations are  
20 relevant to determine the nature and extent of BBK’s purported common law rights in its  
21 marks, BBK’s global objection to further discovery also fails to demonstrate it will suffer  
22 prejudice from the Fifth Affirmative Defense.

23 Accordingly, the Court will deny BBK’s motion to strike as to the Fifth Affirmative  
24 Defense.

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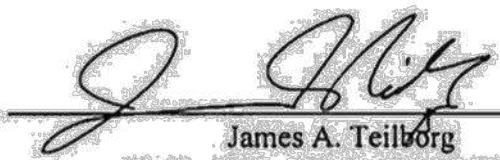
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**III. CONCLUSION**

Based on the foregoing,

**IT IS ORDERED** that Plaintiff BBK Tobacco & Foods, LLP's Motion to Strike Defendant Vatra's Affirmative Defenses (Doc. 67) is **DENIED**.

Dated this 15th day of November, 2019.



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James A. Teilborg  
Senior United States District Judge