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6 UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON  
7 AT SEATTLE

8 ADVANCED HAIR RESTORATION LLC,

9 Plaintiff,

10 v.

11 BOSELY INC,

12 Defendant.

CASE NO. C23-1031-KKE

ORDER DENYING PLAINTIFF'S  
MOTION TO DISMISS DEFENDANT'S  
COUNTERCLAIM AND GRANTING IN  
PART AND DENYING IN PART  
PLAINTIFF'S MOTION TO STRIKE  
DEFENDANT'S AFFIRMATIVE  
DEFENSES

13 This matter comes before the Court on Plaintiff and Counterclaim Defendant, Advanced  
14 Hair Restoration LLC's ("AHR"), motion to dismiss Bosley Inc.'s ("Bosley") counterclaim and to  
15 strike Bosley's affirmative defenses. Dkt. No. 14. The Court heard oral argument on both motions  
16 on November 29, 2023. For the reasons provided below, the Court denies AHR's motion to  
17 dismiss Bosley's counterclaim and grants in part and denies in part AHR's motion to strike  
18 Bosley's affirmative defenses.

19 **I. BACKGROUND**

20 This is a trademark dispute between competitors in the hair restoration industry. Dkt. Nos.  
21 15 ¶¶ 6, 15; 16 at 1. Bosley has two registered trademarks relevant to this case (collectively  
22 "Bosley's Trademarks"). First is Bosley's registered trademark for "THE ART AND SCIENCE  
23 OF HAIR RESTORATION," which was first used in 1992 and registered on October 31, 2000.

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ORDER DENYING PLAINTIFF'S MOTION TO DISMISS DEFENDANT'S COUNTERCLAIM AND  
GRANTING IN PART AND DENYING IN PART PLAINTIFF'S MOTION TO STRIKE DEFENDANT'S  
AFFIRMATIVE DEFENSES - 1

1 Dkt. No. 15-1. That registration includes an explicit disclaimer stating, “NO CLAIM IS MADE  
2 TO THE EXCLUSIVE RIGHT TO USE ‘HAIR RESTORATION’, APART FROM THE MARK  
3 AS SHOWN.” *Id.* Second is Bosley’s registered trademark for “THE WORLD’S MOST  
4 EXPERIENCED HAIR RESTORATION,” which was first used in September 2005, and was  
5 registered December 19, 2017. Dkt. No. 15-2.

6 AHR has three trademarks relevant to this case (collectively, “AHR’s Trademarks”). First  
7 is AHR’s claimed common law mark for “ADVANCED HAIR,” which AHR alleges has been  
8 used in Washington state since 2011. Dkt. No. 1 ¶ 8. Second and third are AHR’s common law  
9 mark and registered trademark for “ADVANCED HAIR RESTORATION,” which were first used  
10 in 2011, and were registered on August 16, 2022. Dkt. No. 1-1. This registration includes an  
11 explicit disclaimer stating, “No claim is made to the exclusive right to use the following apart from  
12 the mark as shown: ‘HAIR RESTORATION.’” *Id.*

13 In July 2023, AHR filed its complaint alleging Bosley “pays for internet advertisements,  
14 including keyword advertisements...using Plaintiff AHR’s Mark, targeting internet searches that  
15 use the following keywords: ADVANCED HAIR RESTORATION and ADVANCED HAIR.”  
16 Dkt. No. 1 ¶ 21. AHR brought the following six causes of action: violation of the Washington  
17 Consumer Protection Act (RCW 19.86.20); federal unfair competition (25 U.S.C. § 1125(a));  
18 registered service-mark infringement (15 U.S.C. § 1115); counterfeiting (15 U.S.C. § 1116(d)(1));  
19 violation of anti-dilution statute (RCW 19.77.160); and federal dilution. Dkt. No. 1 ¶¶ 34–57.

20 AHR attached to its complaint multiple exhibits, including its original cease and desist  
21 letter to Bosley and Bosley’s response. Dkt. Nos. 1-1–1-4. In response to AHR’s two-page cease  
22 and desist letter, Bosley provided an extensive ten-page explanation for why AHR’s infringement  
23 claim would fail. Dkt. No. 1-4. More specifically, Bosley’s response includes (1) an explanation  
24 for why “advanced” and “hair restoration” are generic or descriptive (Dkt. No. 1-4 at 2, 4–5, 8–

1 10); (2) examples of third-party use of the term “advanced” with hair goods (*id.* at 8, 10); and (3)  
2 a summary of AHR’s prior unsuccessful attempt to register ADVANCED HAIR RESTORATION  
3 (*id.* at 9–10).

4 In response to AHR’s complaint and its exhibits, Bosley filed an answer with fourteen  
5 affirmative defenses. Dkt. No. 11 at 7–9. Bosley also filed a counterclaim for declaration of  
6 invalidity for each of AHR’s Trademarks: AHR’s “ADVANCED HAIR RESTORATION”  
7 registered trademark, and AHR’s common law trademark rights to ADVANCED HAIR  
8 RESTORATION and ADVANCED HAIR. Dkt. No. 11 ¶¶ 58–71. Bosley alleges two theories  
9 for why these trademarks are invalid: Bosley’s Trademarks were used in commerce before AHR’s  
10 Trademarks and AHR’s Trademarks are “confusing similar” to Bosley’s Trademarks; and AHR’s  
11 Trademarks are “generic and/or merely descriptive of the goods and services.” Dkt. No. 11 at 12.  
12 AHR then filed the pending motion to dismiss Bosley’s counterclaim and to strike all of Bosley’s  
13 affirmative defenses.

## 14 **II. ANALYSIS**

### 15 **A. AHR’s Motion to Dismiss Is Denied.**

16 A motion to dismiss under Federal Rule of Civil Procedure 12(b)(6) may be based on either  
17 a lack of a cognizable legal theory or the absence of sufficient facts under such a theory. *Balistreri*  
18 *v. Pacifica Police Dep’t*, 901 F.2d 696, 699 (9th Cir. 1990). To survive a Rule 12(b)(6) motion,  
19 “a complaint must contain sufficient factual matter, accepted as true, to state a claim for relief that  
20 is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). A claim is plausible on its  
21 face “when the plaintiff pleads factual content that allows the court to draw the reasonable  
22 inference that the defendant is liable for the misconduct alleged.” *Id.* The court must accept all  
23 facts alleged in the complaint as true and make all inferences in the light most favorable to the  
24 non-moving party. *In re Fitness Holdings, Int’l, Inc.*, 714 F.3d 1141, 1144–45 (9th Cir. 2013).

1 But “conclusory allegations of law and unwarranted inferences will not defeat an otherwise proper  
2 motion to dismiss.” *Vasquez v. Los Angeles Cty.*, 487 F.3d 1246, 1249 (9th Cir. 2007). “A motion  
3 to dismiss a counterclaim brought pursuant to Federal Rule of Civil Procedure 12(b)(6) is  
4 evaluated under the same standard as a motion to dismiss a plaintiff’s complaint.” *AirWair Int’l*  
5 *Ltd. v. Schultz*, 84 F. Supp. 3d 943, 949 (N.D. Cal. 2015).

6 1. Bosley’s first legal theory is not impossible as a matter of law.

7 Bosley argues the AHR Trademarks are invalid because they are confusingly similar to  
8 Bosley’s trademarks for “THE ART AND SCIENCE OF HAIR RESTORATION” and “THE  
9 WORLD’S MOST EXPERIENCED HAIR RESTORATION,” both of which were used by Bosley  
10 before AHR claims to have used the AHR Trademarks. Dkt. No. 11 at 12.<sup>1</sup> AHR argues this legal  
11 theory is “impossible as a matter of law” because the only terms in common between the two  
12 groups of marks (“hair” or “hair restoration”) are generic and/or expressly disclaimed. Dkt. No.  
13 14 at 6; *see id.* at 6–9. Bosley responds that courts do not perform a word-by-word comparison  
14 for the likelihood of confusion test. Dkt. No.16 at 3, 8–9.

15 Bosley is correct. Courts in the Ninth Circuit do not analyze whether marks are confusingly  
16 similar by only comparing the words in common between the marks. “[W]hat is critical is the  
17 *overall* appearance of the mark as used in the marketplace, not a deconstructionist view of the  
18 different components of the marks.” *Playmakers, LLC v. ESPN, Inc.*, 297 F. Supp. 2d 1277, 1283  
19 (W.D. Wash. 2003), *aff’d*, 376 F.3d 894 (9th Cir. 2004). Thus, the Court cannot limit its consumer  
20 confusion analysis to the words “hair” or “hair restoration.”

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23 <sup>1</sup> As a threshold matter, both parties seem to agree that Bosley’s legal theory could be a proper avenue to find a  
24 trademark invalid. *See Pinkette Clothing, Inc. v. Cosm. Warriors Ltd.*, 894 F.3d 1015, 1021 (9th Cir. 2018) (“[A]ny  
ground that would have prevented registration in the first place qualifies as a valid ground for cancellation,” including  
that there exists a “likelihood of confusion between the mark sought to be canceled and a mark for which the party  
seeking cancellation can establish either prior use or prior registration.”).

1 Likewise, AHR's argument that the Court should ignore any disclaimed words and  
2 compare the remaining words ignores this Circuit's law. The Ninth Circuit does not ignore  
3 disclaimed terms when considering whether a likelihood of confusion exists. *See Sleeper Lounge*  
4 *Co. v. Bell Mfg. Co.*, 253 F.2d 720, 722 n.1 (9th Cir. 1958) ("Disclaimed material forming part of  
5 a registered trade-mark cannot be ignored. It is still part of the composite trade-mark which must  
6 be considered in its entirety.").

7 When comparing AHR's Trademarks and Bosley's Trademarks as a whole, it is possible  
8 that consumers could be confused between "ADVANCED HAIR" or "ADVANCED HAIR  
9 RESTORATION" and "THE ART AND SCIENCE OF HAIR RESTORATION" and "THE  
10 WORLD'S MOST EXPERIENCED HAIR RESTORATION." These trademarks are not as  
11 different as "Pepsi" and "Coke." *See* Dkt. No. 14 at 8 (citing *Brookfield Commc'ns, Inc. v. W.*  
12 *Coast Ent. Corp.*, 174 F.3d 1036, 1054 (9th Cir. 1999)). That is enough at this stage of the  
13 proceedings.<sup>2</sup>

14 AHR also argues Bosley's first legal theory fails because it contradicts Bosley's second  
15 legal theory. Dkt. No. 14 at 8. This Court does not need to determine whether the legal theories  
16 are inconsistent because the Federal Rules of Civil Procedure explicitly allow the pleading of  
17 inconsistent legal theories. Fed. R. Civ. P. 8(d) ("A party may state as many separate claims or  
18 defenses as it has, regardless of consistency."). Inconsistency is not a basis to dismiss Bosley's  
19 first legal theory.<sup>3</sup>

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21 <sup>2</sup> A likelihood of confusion analysis "is often not appropriate at the motion to dismiss stage." *Universal Prot. Serv.,*  
22 *LP v. Coastal Fire & Integration Sys., Inc.*, No. 22-CV-1352-JES-KSC, 2023 WL 4042582, at \*4 (S.D. Cal. June 15,  
2023) (collecting cases).

23 <sup>3</sup> AHR's motion repeatedly argues Bosley's first legal theory is "incurable" and "impossible as a matter of law." Dkt.  
24 No. 14 at 5, 6, 8. For the first time in its reply, AHR argues, regarding the first legal theory, that "Defendant Bosley  
fails to plead sufficient facts to satisfy the elements of its counterclaim." Dkt. No. 17 at 4. "The district court need  
not consider arguments raised for the first time in a reply brief." *Zamani v. Carnes*, 491 F.3d 990, 997 (9th Cir. 2007)  
(citing *Koerner v. Grigas*, 328 F.3d 1039, 1048 (9th Cir. 2003)).

1 AHR's motion to dismiss Bosley's first legal theory for its counterclaim is denied.

2 2. Bosley's second legal theory is sufficiently pled.

3 Bosley also argues the AHR Trademarks are invalid "because they are generic and/or  
4 merely descriptive of the goods and services offered by [AHR] who cannot establish secondary  
5 meaning." Dkt. No.11 at 12. AHR argues this legal theory should be dismissed because it is  
6 "devoid of factual allegations." Dkt. No. 14 at 9. AHR cites *Davis v. Hollywood & Ivar, LLC*,  
7 No. 2:21-CV-01235-VAP (JPRx), 2021 WL 4816823 (C.D. Cal. Aug. 30, 2021) as identifying the  
8 "minimum factual bases for sufficiently pleading" descriptiveness or genericness. Dkt. No. 14 at  
9 10. There, the Court explains:

10 Defendant does, however, provide a specific explanation of why the term  
11 "Jamaica Gold" is descriptive, arguing that "'Jamaica' is merely descriptive  
12 of the geographic source of the type of music presented and 'gold' is merely  
13 laudatory." (Answer at 9). Likewise, for genericness Defendant argues that  
14 the term "Jamaica Gold" is akin to a "generic name for the type of music  
15 offered." (*Id.*). The Court does not agree with Plaintiff's claim that  
16 Defendant's explanations constitute only "bare bones, conclusory  
17 allegations."

18 *Hollywood & Ivar*, 2021 WL 4816823, at \*8 (cleaned up).

19 Here, it is true that Bosley's second theory of invalidity is stated briefly in its Answer.  
20 However, AHR attached to its complaint Bosley's letter in response to AHR's cease and desist  
21 notice. At oral argument on AHR's motions, counsel for both parties agreed that Bosley's response  
22 letter had become part of the pleadings by virtue of its attachment to and reference in the complaint,  
23 and therefore the Court could consider the factual allegations set forth therein. *See Swartz v.*  
24 *KPMG LLP*, 476 F.3d 756, 763 (9th Cir. 2007) ("In ruling on a 12(b)(6) motion, a court may  
generally consider only allegations contained in the pleadings, exhibits attached to the complaint,  
and matters properly subject to judicial notice.").

1 Bosley’s response letter fleshes out the factual bases supporting the counterclaim far more  
2 extensively than what the *Hollywood & Ivar* court found sufficient to state a claim. For example,  
3 Bosley’s response letter alleges:

- 4 • “Further, ADVANCED is a laudatory term defined as ‘being at a higher level than  
5 others’. See the enclosed dictionary definition. Marks that include such terms are  
6 regarded as being descriptive because ‘[s]elf-laudatory or puffing marks are  
7 regarded as a condensed form of describing the character or quality of the goods [or  
8 services].’” Dkt. No. 1-4 at 4.
- 9 • “Additionally, the terms ‘hair solution’ are disclaimed and are generic for the  
10 services at issue and the relevant public would understand the wording ‘hair  
11 restoration’ to be the generic name of their hair loss treatment services.” *Id.* at 5.

12 In light of the factual allegations in Bosley’s response letter and the standard applied to  
13 counterclaims under Federal Rule 12(b)(6), the Court finds Bosley has stated sufficient facts to  
14 support the second legal theory for its counterclaim.

15 **B. AHR’s Motion to Strike Bosley’s Affirmative Defenses Is Granted in Part and**  
16 **Denied in Part.**

17 “In responding to a pleading, a party must affirmatively state any avoidance or affirmative  
18 defense....” Fed. R. Civ. P. 8(c)(1) (listing examples of affirmative defenses). Bosley pled  
19 fourteen affirmative defenses. “The key to determining the sufficiency of pleading an affirmative  
20 defense is whether it gives plaintiff fair notice of the defense.” *Garcia v. Salvation Army*, 918  
21 F.3d 997, 1008 (9th Cir. 2019) (cleaned up).<sup>4</sup> “Fair notice generally requires that the defendant  
22 state the nature and grounds for the affirmative defense.” *Tollefson v. Aurora Fin. Grp., Inc.*, No.  
23 C20-0297JLR, 2021 WL 462689, at \*2 (W.D. Wash. Feb. 9, 2021) (quoting *Kohler v. Islands*  
24 *Rests.*, 280 F.R.D. 560, 564 (S.D. Cal. 2012)).

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<sup>4</sup> AHR’s motion to strike Bosley’s affirmative defenses includes footnotes asserting that affirmative defenses must state a “plausible claim for relief.” Dkt. No. 14 at 11–12, nn.3, 4. However, AHR admits to focusing “this motion on the lack of ‘fair notice.’” *Id.* at 11, n.3. Accordingly, the Court analyzes Bosley’s affirmative defenses under the “fair notice” standard often used in this District. See *White v. Univ. of Washington*, No. 2:22-CV-01798-TL, 2023 WL 3582395, at \*4 (W.D. Wash. May 22, 2023).

1 AHR seeks to strike each of Bosley’s fourteen defenses. Dkt. No. 14 at 11–21. Under  
2 Federal Rule of Civil Procedure 12(f), a district court “may strike from a pleading an insufficient  
3 defense or any redundant, immaterial, impertinent, or scandalous matter.” An immaterial matter  
4 “has no essential or important relationship to the claim for relief or the defenses being pleaded,”  
5 while an impertinent matter “consists of statements that do not pertain, and are not necessary, to  
6 the issues in question.” *Fantasy, Inc. v. Fogerty*, 984 F.2d 1524, 1527 (9th Cir. 1993), *rev’d on*  
7 *other grounds*, 510 U.S. 517 (1994). “The function of a 12(f) motion to strike is to avoid the  
8 expenditure of time and money that must arise from litigating spurious issues by dispensing with  
9 those issues prior to trial.” *Whittlestone, Inc. v. Handi-Craft Co.*, 618 F.3d 970, 973 (9th Cir. 2010)  
10 (cleaned up). Rule 12(f) motions to strike are generally disfavored because the motions may be  
11 used as delay tactics and because of the strong policy favoring resolution on the merits. *See, e.g.*,  
12 *Chao Chen v. Geo Grp., Inc.*, 297 F. Supp. 3d 1130, 1132 (W.D. Wash. 2018).

13 AHR seeks to strike Bosley’s first affirmative defense, failure to state a claim, for being  
14 “immaterial and impertinent.” Dkt. No. 14 at 13. The Court finds Bosley’s “failure to state a  
15 claim” defense is material and pertinent, even though the deadline to move to dismiss has passed.  
16 *See, e.g.*, Fed. R. Civ. P. 12(c) (allowing for judgment on the pleadings “after pleadings are  
17 closed”). At this early stage of the litigation, and with the parties providing conflicting authority  
18 on the appropriateness of striking this defense (Dkt. Nos. 14 at 12–13, 16 at 13), the Court is not  
19 persuaded that striking this defense is necessary or appropriate.

20 Regarding Bosley’s seventh affirmative defense (“Third-Party Use/Abandonment”), AHR  
21 argues that acquiescence, waiver, and abandonment are separate defenses and the mere allegation  
22 that the marks have been used by third parties fails to address other required elements of each  
23 claim. Dkt. No. 14 at 15–17. The Court agrees that this affirmative defense is too conclusory and  
24



1 vague to give Bosley fair notice. The Court strikes Bosley’s seventh affirmative defense with  
2 leave to amend.

3 AHR next argues that Bosley’s eighth affirmative defense (“Fair Use”) improperly lists  
4 nominative fair use as an affirmative defense, when nominative fair use is an “alternative multi-  
5 factor test to assess the likelihood of confusion.” Dkt. No. 14 at 17. Bosley does not provide any  
6 authority to the contrary. Dkt. No. 16 at 18–19. This Circuit does not treat nominative fair use as  
7 an affirmative defense. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1182 (9th Cir.  
8 2010) (“The district court treated nominative fair use as an affirmative defense to be established  
9 by the Tabaris only after Toyota showed a likelihood of confusion under *Sleekcraft*. This was  
10 error....”). Accordingly, the Court strikes Bosley’s eighth affirmative defense with leave to amend  
11 to assert descriptive fair use as an affirmative defense.

12 AHR argues the following affirmative defenses are “redundant, immaterial, and  
13 impertinent” (Dkt. No. 14 at 20): (11) not famous, (12) non-infringement, and (13) no enhanced  
14 damages or attorneys’ fees. The Court finds these defenses are material and pertinent because, as  
15 AHR admits, they speak directly to AHR’s affirmative claims. Dkt No. 14 at 20 (describing these  
16 defenses as merely repeating Bosley’s denial of AHR’s claim). Likewise, AHR’s understanding  
17 that these affirmative defenses are directly responding to AHR’s allegations demonstrates Bosley  
18 has pled sufficient facts to provide “fair notice” to AHR. At this early stage, and with the parties  
19 providing conflicting authority on the appropriateness of affirmative defenses that merely deny  
20 elements of the affirmative claim (Dkt. Nos. 14 at 20, 16 at 21), the Court is not persuaded that  
21 striking these defenses is appropriate.

22 AHR seeks to strike the remaining affirmative defenses for failing to set forth sufficient  
23 facts: (2) unclean hands (Dkt. No. 14 at 13), (3) estoppel (*id.*), (4) laches (*id.* at 14), (5) bad faith  
24 (*id.* at 15), (6) genericness and descriptiveness (*id.*), (9) misuse and antitrust violation (*id.* at 17–

1 19), and (10) priority (*id.* at 19–20). Taking the pleadings in full, including Bosley’s detailed  
2 response letter, the Court finds that Bosley has included sufficient facts to describe the “nature and  
3 grounds” for each of these defenses. The Court is confident AHR understands Bosley’s arguments  
4 and their factual bases.

5 In addition to alleging a failure to plead sufficient facts, AHR also argues Bosley’s ninth  
6 affirmative defense (“Misuse or Antitrust Violation”) is improperly pled because “misuse” is the  
7 same defense as “unclean hands.” Dkt. No. 14 at 17. Under Federal Rule of Civil Procedure 8  
8 (d), a party may set out a claim or defense “alternatively or hypothetically.” At this early stage,  
9 the Court will not strike this affirmative defense for mere duplication.

10 Lastly, AHR argues Bosley’s “reservation of rights” is not an affirmative defense “and is  
11 therefore unnecessary and immaterial.” Dkt. No. 14 at 20–21. The Court strikes Bosley’s  
12 reservation of rights affirmative defense because, in this District, such a reservation is not a proper  
13 affirmative defense. *See Ohio Sec. Ins. Co. v. Garage Plus Storage Aviation LLC*, 600 F. Supp.  
14 3d 1164, 1170 (W.D. Wash. 2022) (striking a reservation of rights affirmative defense).

15 In sum, the Court grants AHR’s motion to strike Bosley’s seventh affirmative defense of  
16 “Third Party Use/Abandonment” with leave to amend; eighth affirmative defense of “Fair Use”  
17 with leave to amend; and fourteenth affirmative defense of “Reservation of Rights” without leave  
18 to amend. The motion to strike Bosley’s remaining defenses is denied.

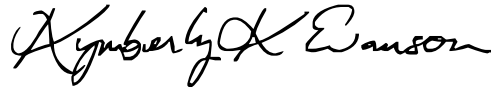
### 19 **III. CONCLUSION**

20 For the foregoing reasons, the Court DENIES Plaintiff’s motion to dismiss. Dkt. No. 14.

21 The Court further GRANTS IN PART AND DENIES IN PART Plaintiff’s motion to  
22 strike. Dkt. No. 14. The motion is GRANTED as follows: Bosley’s seventh and eighth affirmative  
23 defenses are STRICKEN with leave to amend, and Bosley’s fourteenth affirmative defense is

1 STRICKEN without leave to amend. The motion to strike the remaining affirmative defenses is  
2 DENIED.

3 Dated this 29th day of December, 2023.

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7 Kymberly K. Evanson  
8 United States District Judge  
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