

UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF NEW YORK

The Sam Bernstein Law Firm, PLLC v. Better Call Sam, The Law Office of Samantha Maguire, PLLC, and Samantha Maguire

25-CV-0252-MAV (W.D.N.Y. Jan. 8, 2026) · No. 25-CV-0252-MAV · Decided January 8, 2026

SUMMARY

The United States District Court for the Western District of New York addresses the plaintiff’s motion to strike affirmative defenses and dismiss counterclaims in a trademark infringement action involving the marks “CALL SAM” and “Better Call Sam.” The court denies the motion as to the parody, First Amendment, and weakness-of-mark defenses without prejudice, but strikes the defenses of laches, estoppel, acquiescence, and unclean hands. The court also dismisses the defendant’s declaratory-judgment counterclaims without prejudice, primarily because they duplicate the trademark infringement claims and the court declines to exercise declaratory-judgment jurisdiction.

CASE DETAILS

COURT	United States District Court for the Western District of New York
WRITING FOR THE COURT	Meredith A. Vacca
JURISDICTION	United States District Court for the Western District of New York
DECIDED	January 8, 2026
DOCKET	25-CV-0252-MAV
DISPOSITION	other
PROCEDURAL POSTURE	Plaintiff moved under Federal Rule of Civil Procedure 12(f) to strike portions of Defendant Samantha Maguire's affirmative defenses and under Rule 12(b)(6) to dismiss her counterclaims for declaratory judgment of non-infringement.
STANDARD OF REVIEW	On a Rule 12(f) motion, an affirmative defense may be stricken when there is no question of fact or law that could allow the defense to succeed and the plaintiff would be prejudiced by litigating it. Counterclaims under Rule 12(b)(6) must satisfy Rule 8(a)'s plausibility standard under Twombly and Iqbal. The court also has broad discretion under the Declaratory Judgment Act to decline jurisdiction after weighing the relevant factors.

TOPICS

trademark infringement

motions to dismiss

pleadings

first amendment

civil procedure

PRACTICE AREAS

trademark law

civil procedure

constitutional law

QUESTIONS PRESENTED

1. Whether Maguire's parody and First Amendment defenses should be stricken under Rule 12(f).
2. Whether Maguire's laches, estoppel, and acquiescence defenses were sufficiently pleaded and legally supported to survive a Rule 12(f) motion.
3. Whether Maguire's unclean-hands defense was legally available based on allegations concerning Plaintiff's enforcement of its trademark rights.
4. Whether Maguire's non-dilution/weakness-of-mark defense should be stricken as irrelevant or prejudicial to the trademark-infringement claims.
5. Whether the court should dismiss Maguire's declaratory-judgment counterclaims by declining jurisdiction under the Declaratory Judgment Act.

HOLDINGS

1. The court denied without prejudice the motion to strike Maguire's parody and First Amendment defenses because, although the defenses appeared potentially redundant to the likelihood-of-confusion issue and the court was skeptical that parody had been plausibly alleged, Plaintiff had not shown sufficient prejudice from litigating them at that stage.
2. The court struck Maguire's fourth affirmative defense asserting laches, estoppel, and acquiescence.
3. The court struck Maguire's fifth affirmative defense asserting unclean hands.
4. The court denied without prejudice the motion to strike Maguire's sixth affirmative defense concerning non-dilution and weakness of the mark.
5. The court dismissed Maguire's counterclaims for declaratory judgments of non-infringement without prejudice because it declined to exercise jurisdiction under the Declaratory Judgment Act.

KEY QUOTATIONS

"In a traditional trademark infringement suit founded on the likelihood of confusion rationale, the claim of parody is not really a separate 'defense' as such, but merely a way of phrasing the traditional response that customers are not likely to be confused as to source, sponsorship or approval." (at 9)

"Motions to strike affirmative defenses under Rule 12(f) are disfavored, and the standard for a plaintiff to prevail is demanding." (at 10)

“Unclean hands must relate to the getting or using the alleged trademark rights.” (at 13)

“the Counterclaim’s request for declaratory relief of non-infringement “is entirely duplicative of [TCG’s] [trademark infringement] claim -- and any resolution of the merits of [TCG’s] claim will necessarily resolve [666P’s] counterclaim.”” (at 17)

FACTUAL BACKGROUND

Plaintiff owns federally registered CALL SAM and 1-800-CALL-SAM trademarks, which it alleges have become incontestable, and uses them extensively in advertising its personal-injury law practice. Defendants began promoting legal services under the slogan “Better Call Sam” and used the domain name bettercallsam.net. Plaintiff sued for trademark infringement, after which Maguire asserted affirmative defenses based on parody, the First Amendment, lack of confusion, laches, estoppel, acquiescence, unclean hands, and weakness or non-dilution of the mark.

PROCEDURAL HISTORY

Plaintiff filed a Lanham Act trademark infringement complaint in March 2025. Maguire, who was not admitted to practice before the court, filed an answer and counterclaims on behalf of herself and the entity defendants; the court held that the filing operated only as Maguire’s responsive pleading because she could not represent the entities. Plaintiff then moved to strike affirmative defenses and dismiss the counterclaims. The court denied the motion as to the parody/First Amendment and non-dilution/weakness defenses, struck the fourth and fifth defenses, and dismissed the counterclaims without prejudice after declining declaratory-judgment jurisdiction.

DISPOSITION

other

CASES CITED

- Menaker v. Hofstra University, 935 F.3d 20, 26 (2d Cir. 2019)
- Lattanzio v. COMTA, 481 F.3d 137, 140 (2d Cir. 2007)
- Jones v. Niagara Frontier Transportation Authority, 722 F.2d 20, 22 (2d Cir. 1983)
- Tracy v. Freshwater, 623 F.3d 90, 101 (2d Cir. 2010)
- Holtz v. Rockefeller & Co., 258 F.3d 62, 82 n.4 (2d Cir. 2001)
- Bank v. Alarm.com Holdings, Inc., 828 F. App’x 5, 7 (2d Cir. 2020)
- Knopf v. Esposito, 803 F. App’x 448, 454 n.1 (2d Cir. 2020)
- Vans, Inc. v. MSCHF Product Studio, Inc., 88 F.4th 125, 135-36, 185-86 (2d Cir. 2023)
- Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, 696 F.3d 206, 216-17 (2d Cir. 2012)
- Polaroid Corp. v. Polarad Electronics Corp., 287 F.2d 492, 495 (2d Cir. 1961)
- Shunock v. Apple, Inc., 738 F. Supp. 3d 371, 377 (S.D.N.Y. 2024)
- GEOMC Co. v. Calmare Therapeutics Inc., 918 F.3d 92, 96-99 (2d Cir. 2019)
- Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 555, 570 (2007)

- Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009)
- Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc., 109 F.3d 1394, 1405 (9th Cir. 1997)
- Coach, Inc. v. Kmart Corps., 756 F. Supp. 2d 421, 426-28 (S.D.N.Y. 2010)
- Legislator 1357 Ltd. v. Metro-Goldwyn-Mayer, Inc., 452 F. Supp. 2d 382, 391 (S.D.N.Y. 2006)
- Excelled Sheepskin & Leather Coat Corp. v. Oregon Brewing Co., 897 F.3d 418, 419 (2d Cir. 2018)
- Rd. Dawgs Motorcycle Club of the U.S., Inc. v. Cuse Rd. Dawgs, Inc., 679 F. Supp. 2d 259, 279-80 (N.D.N.Y. 2009)
- Emmpresa Cubana Del Tabaco v. Culbro Corp., 213 F. Supp. 2d 247, 276 (S.D.N.Y. 2002)
- ProFitness Physical Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy P.C., 314 F.3d 62, 67 (2d Cir. 2002)
- Alcon Vision, LLC v. Lens.com, Inc., 2022 WL 1665453, at *9 (S.D.N.Y. May 25, 2022)
- Liz Claiborne, Inc. v. Mademoiselle Knitwear, Inc., 13 F. Supp. 2d 480, 445 (S.D.N.Y. 1998)
- Warner Bros. Inc. v. Gay Toys, Inc., 724 F.2d 327, 334 (2d Cir. 1983)
- Savin Corp. v. Savin Group, 391 F.3d 439, 449 (2d Cir. 2004)
- Pinehurst, Inc. v. Wick, 256 F. Supp. 2d 424, 431 (M.D.N.C. 2003)
- Louis Vuitton Malletier v. Burlington Coat Factory Warehouse Corp., 426 F.3d 532, 539 (2d Cir. 2005)
- Jack Daniel's Properties, Inc., 599 U.S. 140, 159 (2023)
- Yankee Publishing Inc. v. News America Publishing Inc., 809 F. Supp. 267, 276 (S.D.N.Y. 1992)
- Admiral Insurance Co. v. Niagara Transformer Corp., 57 F.4th 85, 99-100 (2d Cir. 2023)
- Continuum Group LLC v. 666 Performance, LLC, 2025 WL 1489255, at *2 (S.D.N.Y. May 23, 2025)
- Bank v. NFL Properties LLC, 2025 WL 2961849, at *7 (S.D.N.Y. Oct. 20, 2025)
- Duffy v. WM Resources, Inc., 2025 WL 219107 (W.D.N.Y. Jan. 16, 2025)
- United States v. Weathers, 2024 WL 3431054, at *11 (W.D.N.Y. July 16, 2024)